Music and Copyright

Ronald S. Rosen

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Florence and Daniel Rosen
Who Started All This

Judith
Spouse, Partner, and In-House Editor

Matthew, Philip, and Galit
The Generation in Whom We Take Great Pride

and

Chloe, Gilad, and Eitan
The Generation in Whom
We Place Our Faith
and Hope for a
Better World

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Preface

The genesis of this treatise occurred in 1984 when a complaint captioned *Leslie T. Baxter, an individual plaintiff vs. MCA Inc. etc. John T. Williams et. al.* was filed in the United States District Court for the Central District of California. Leslie T. "Les" Baxter, a motion picture composer and recording artist, claimed that John Williams, in composing the score for the motion picture *E.T. The Extraterrestrial*, had copied a phrase from Baxter's composition *Joy*, which occupied one cut on a long playing album released in 1954 entitled *The Passions*. Each selection recorded on *The Passions* represented, in the mind of the composer, various moods of women. I was retained to defend John Williams while my colleagues Louis P. Petrich and Edward A. Ruttenberg defended MCA Inc. and its related entities. The following four years were spent by counsel in preparing and arguing a summary judgment motion, the appeal in which the appellate court reversed the grant of summary judgment in favor of the defendants, preparation for and participation in a trial in which a jury of non-musicians was asked to determine whether one composer had infringed the work of another. Thus, six jurors and two alternates were charged with the responsibility of evaluating two diametrically differing opinions of dueling experts. After four years of litigation this dispute over the protectability of a commonplace musical phrase—a phrase encompassing no more than four, six, eight or twelve notes—ended with a successful defense of the entertainment companies and the composer. The jury's verdict was affirmed on the parties' second foray before the United States Court of Appeals for the Ninth Circuit.

The law—with all its precedents—provided no easy answers for either the plaintiff or the defendants. The demands on counsel for both sides of this litigation, never the easiest of tasks when dealing with copyright infringement litigation, was made more daunting by the task of explaining to a lay jury what constituted a musical idea, like any idea unprotected under copyright, as distinguished from musical expression of the idea, which is entitled to protection under copyright laws. Although the laws of the United States, beginning with the Constitution, can provide profound principles for a free society, the implementation of those principles is not so easily attained.

This book is a creature, not only of the lengthy history during which copyright was developed through legislative action and judicial precedents, but also my personal experience as a practicing lawyer who has been involved in music during my entire life. My training in both the law and music came together in a specific and unique experience in which I was an active participant: a trial in which my client—a composer—was alleged to have copied from the work of another composer. This treatise, however, is not limited to that one case which served as a strong impetus to reconsider areas of the copyright law, in particular the ways in which music and language are analyzed by experts to aid judges and juries in determining whether a defendant has allegedly copied protectable expression or used ideas and concepts available to all creators.

The scope of this project draws upon the vast literature found in the opinions of appellate courts and commentaries of eminent scholars and the rich history of music found in the scores of composers over the centuries—in treatises on harmony, structure, composition theory and related subjects. An understanding of music is dependent upon knowledge of musical ideas and the expression of those ideas through musical language which has its own "linguistic" notation, structure and meaning. In this challenging endeavor I am grateful to the late Earl V. Spielman and the late Harold Barlow, two pioneers of forensic musicology with whom I worked and who added to my knowledge about the interrelationship between musical ideas, on the one hand, and the language of copyright law, on the other. Thanks also to Dr. Douglas Wadle for many of the musical examples contained in this book and to Dr. Veronika Krausas for her advice and counsel.

I am thankful to Sharon R. Gold, my valued colleague and friend who read many drafts of this treatise for content and form, and whose ideas, corrections and editorial contributions were essential to the completion of this text.

Special thanks to Professor Paul Goldstein of Stanford Law School without whose encouragement and help this book never would have been written.

Three people who must be singled out for their contribution are Kathryn Francis, Wes Gasele and Robin Middleton, word processors extraordinaire. Their patience and understanding—particularly in deciphering my handwritten notes—was essential to giving life and expression to my thoughts. My firm, TroyGould PC, is also to be commended for providing the facilities, time and space which created the opportunity to write this text.

I have been blessed with a wonderful editor, Matthew Gallaway and his staff at Oxford University Press: William Cherry, Ninell Silberberg, Michelle Lipinski, Laura Inman, Niamh Cunningham and Diem Bloom.

Lastly, to my wife, Judith, for encouragement and inspiration in all my endeavors in music, law and life.

Prelude

I. Music and Copyright: The Search To Separate Idea from Expression
   A. Idea and Expression In Music
   B. *Vivaldi v. Bach*: A Paradigm For The Ages

II. The Rise of Copyright: A Brief Review

"Every composer begins with a musical idea—a musical idea . . . not a mental, literary, or extramusical idea."

Aaron Copland

What to Listen for in Music

I. Music and Copyright: The Search To Separate Idea from Expression

A. Idea and Expression In Music

In music copyright infringement cases, lawyers and courts are confronted with an additional issue which is not present in other infringement actions: the need to learn and comprehend an unfamiliar language—music. The reason: Music is unlike traditional languages—including those as diverse as German, Russian and Chinese—which are a part of everyday communication, ranging from the exchange of ideas and concepts to the most basic of linguistic tools by which people conduct their daily lives and businesses. Music presents an initial hurdle to be surmounted in copyright litigation because in the analyses required by the courts, counsel and juries, it is not a language which most people have studied in school, nor is there a general awareness of the ideas and concepts expressed through the medium of musical language. Although the courtroom is the venue where copyright law is interpreted and, in many cases, made, the building blocks all composers use to create their original works must also be understood to avoid potential infringement of the musical expressions of other creators.

In the search to distinguish protectable from unprotectable elements in a musical composition, it is vitally important to treat music as a language with its own vocabulary and structure, to be understood as such and, by analogy, analyzed in light of how we approach infringement involving traditional languages. As is the case in any analysis regarding copyright protection, it is essential to gain an understanding of those analytic tools and devices developed under the copyright law pursuant to the guiding principle of the idea/expression dichotomy, with its constitutional mandate that only protectable expression is entitled to copyright protection and not the ideas embodied in that expression. To state the obvious, commencing a story with "once upon a time" cannot result in a viable infringement action because that phrase embodies a standard literary device and is found in examples of prior art too numerous to mention. Similarly, if Author Number 1 were to use the phrase "last year I traveled to Budapest" and Author Number 2, the phrase "last week

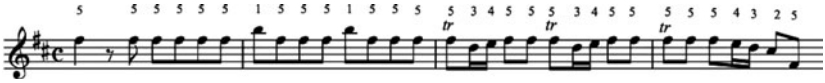
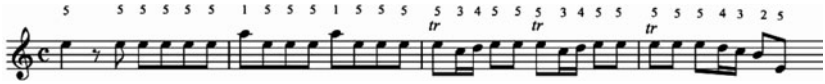
I traveled to Cleveland," it would be absurd if Author Number 1 could withstand a summary judgment motion simply because the idea of traveling from one place to another is expressed in the identical words used by Author Number 2. That phrase merely expresses an unprotectable idea, is undoubtedly commonplace, and in any event is *de minimis*, even assuming that Author Number 2 has copied it from the work of Author Number 1. As such it should, as unprotectable expression, be filtered out of protectable areas of expression. Likewise, musical ideas and commonplace building blocks and motifs should be found unprotectable upon analytic dissection of the composition involved. In other words, we must isolate the musical equivalents of "once upon a time" and "I traveled to" and remove them from consideration in order to properly analyze infringement claims involving musical compositions. Once again, to do so requires an understanding of musical ideas and of the language embodying those ideas.

But how did we arrive at this state where it becomes necessary—even essential—to analyze "musical language" and "musical ideas"? Why have our courts and scholars developed the complex test of separating ideas from expression with the formulaic term "idea/expression dichotomy" which requires deciphering by a musicologist or other high priest or priestess of music? Why not side with the internet denizens who, through the late and (to them) lamented Napster and other currently operating systems, get their music free and argue that they should continue to do so? The answer lies in (1) humankind's desire for both fairness to the creative artist and encouragement of the free flow of ideas for the benefit of the public at large; and (2) the great economic value works of art—and in particular American popular music—have attained in the global marketplace. As to the former, the United States Constitution stated the aims of copyright law perfectly:

> UNITED STATES CONSTITUTION, Art. I, §8, cl.8
>
> The Congress shall have Power . . . (8) To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . .

But still there are those whose concerns about the extension of copyright terms echo the views of the Napster-type user; these concerns historically make them soulmates with a previous age—the early eighteenth century and before. Thus, the question: How did we get here and now, a time when the value of copyright in all media has reached its zenith, especially in the popular music industry, which generates vast sums from recordings and other exploitation of copyrighted compositions, and fights to maintain control over the economic value attributed to those copyrights? Perhaps a good starting point would be to look at and listen to the music of Bach and Vivaldi.

B. *Vivaldi v. Bach:* A Paradigm For The Ages

In 1712 Vivaldi, in his collection of twelve concertos entitled *L'Estro Armonico*, began his Concerto for Four Violins, Strings and Harpsichord Continuo with this phrase[1]:

In 1730, Johann Sebastian Bach composed a Concerto for Four Harpsichords using the following opening phrase:

These two concertos are scored for different solo instruments and are in different keys (Vivaldi in B minor and Bach in A minor). The pitch (or note) sequence and the context in which each is used, with each pitch having the same duration,[2] and with the trills occurring at the same times and places, are not merely "substantially similar" as that term is used in the copyright law, but (except for the transposition[3] from one key to another) are also virtually identical.[4] As musical expression—even though pitch sequence alone is for the most part unprotectable under copyright—Vivaldi's phrase satisfies the requirement of minimal creativity for protection under the copyright laws of the United States. When we ask the questions: Did Bach create his concerto for four keyboards independently of Vivaldi's concerto? Was this one of those situations similar to the invention of the electric lightbulb created almost simultaneously by Edison and Swan? The simple—and to some shocking—answer is no: Bach copied this phrase and, with minor emendations, the entirety of Vivaldi's B minor Concerto. If such blatant copying had taken place in the twentieth century, we would have been treated to a case filed in a Federal District Court under either the 1909 or 1978 Copyright Acts (assuming the

1. The numbers above the staff correspond to the pitches (or notes). For example, "1" refers to the root (or first note) of the scale, "2" to the second, "3" to the third, etc.
2. Duration refers to the length or time value allocated to each note: One whole note [𝅝] equals two half-notes [𝅗𝅥 𝅗𝅥], or four quarter-notes [♩ ♩ ♩ ♩] or eight eighth-notes [♫ ♫] or sixteen sixteenth-notes [𝅘𝅥𝅯x16], etc.
3. The notations and/or performance of music in a key different from the one in which it was originally written. Thus, the composition, if literally transposed, is notated and heard with the same pitch sequence and harmony, rhythm, etc. albeit in a different key.
4. *See* Norman Carrell, Bach The Borrower 241 (1967).

action was filed in the United States) entitled *Antonio Lucio Vivaldi v. Johann Sebastian Bach* and, under the copyright laws of the United States, plaintiff Vivaldi would have been the prevailing party, while defendant Bach would have been the recipient of a judgment against him for intentional infringement. Vivaldi would have been awarded either damages or the profits realized by Bach from the sale of sheet music, recordings and perhaps mechanical synchronization licenses for the use of "his" A-minor concerto in motion pictures and television, as well as the attorneys' fees and court costs incurred by Vivaldi in prosecuting his action against a beloved but chastened Papa Bach. But this instance of "copying" occurred in the early eighteenth century, a time during which Bach not only "copied" from Vivaldi, but also from other Italian composers (Corelli, Albinoni, Benedetto Marcello, and Torelli, among others); from German composers (Telemann, Neumark, Rosenmüller, Buxtehude, Heinrich Isaak, and his own cousin, Johann Christoph Bach); from the French (Couperin, Louis Bourgeois, *et al.*); and even from a famous religious figure (Martin Luther). In the face of such overwhelming evidence, neither Vivaldi nor any of these other composers ever sued Bach or, to our knowledge, made a claim that he was a plagiarist. The reasons for this are at least twofold: (1) there was no concept of copyright protection in Germany and Italy (the obvious venues for legal action) nor were there any copyright laws in those "countries" in the eighteenth century; and (2) until the late eighteenth and nineteenth centuries in Italy and Germany, the concept that anyone could "own" literary, musical or other artistic creations was not contemplated. As a result, composers like Bach, and for that matter, others like Handel (who "copied" liberally from Telemann, Couperin, and Rameau) merely "used" materials developed in compositions by others, and gave these materials their own expression or, in modern parlance, "spin." It would not have occurred to Vivaldi or others to sue Bach, nor would Bach have had any thought, no matter how remote or fleeting, that he had done anything wrong. Such benign attitudes were not confined to composers—authors, playwrights, pictorial artists, and sculptors alike did not harbor the mental set that their creations constituted "property" which could be "stolen" by another creator. Had borrowing not been the norm, we may well speculate whether Shakespeare would have been discouraged from writing *Romeo and Juliet*. It is only long after the rise of copyright in the eighteenth century that the concept that artistic creations could be protected by the copyright laws emerged and grew to its zenith in the last half of the twentieth century.

II. The Rise of Copyright: A Brief Review

The first copyright statute—the Statute of Anne—was enacted by the British Parliament in 1710. It granted a limited monopoly to protect against the illegal

copying of writings for an initial term of fourteen years and a renewal term of the same length. It was not until the French Revolution with its emphasis on the rights of man (as distinguished from royal privilege) that the French National Assembly enacted the Law of January 13, 1791, and the Law of July 19, 1793. These laws were in contradistinction to today's statutes: each a model of brevity taking no more than two pages to open public theaters and grant authors rights akin to modern copyright: that is, dominion and control over copying, distribution, and sales of artistic works. Unlike the statute of Anne, the laws of 1791 and 1793 provided protection for the author's life and for a fixed term after his/her death. This system of protection (*i.e.*, life plus a specific term of years) became the norm on the European Continent, but was adopted by the United States only when the 1976 Copyright Law was enacted.

Prior to the enactment of these historically important statutes in England and France, the works of an author of a book or play were neither owned nor controlled by the creator, but rather by the Crown or the Church. Gutenberg's invention of the printing press not only revolutionized the means of reproducing the printed word, but by the eighteenth century had also provided the means for what may be termed the first information explosion. In prerevolutionary France, the monarchy exercised control by censorship of print media and by "licenses" controlling the spoken word in theaters. Thus, prerevolutionary France in effect granted a monopoly over specific works for a limited period of time. In England, the Crown granted similar monopolies to printers and booksellers in London. The British Monarchy gave the Stationers Company certain powers of the sovereign, including search and seizure, to protect works that had been licensed for limited periods by censors appointed by the Crown. In all instances of censorship, many bootleg copies in various European countries were distributed, even in countries that had enacted the early "copyright" laws. The idea that creative works constituted property achieved credibility only in the latter part of the eighteenth century.

In the course of its evolution copyright became viable in England and France, respectively, in the early and latter parts of the eighteenth century. In Germany, however, it was not until 1837 that a copyright statute was enacted in Prussia. It was only in 1865, after the *Risorgimento*, that Italy adopted its first copyright statute. Prior to the enactment of these statutes, neither of these nations, as we now know them, were unified, but rather had within their respective borders various principalities, duchies, kingdoms, and monarchies. It is equally important to note that the Statute of Anne and the French Acts of 1791 and 1793 protected only the printed word and theatrical performances of the spoken word. During this era, music did not fall under the protective cover of copyright. It was in this milieu that Bach and Vivaldi created their greatest (noncopyrightable) works. At that time the thought of

separating unprotectable ideas, building blocks of music, *scènes à faire*[5] or other unprotectables from protectable expression would not have occurred to Bach, Vivaldi, and their contemporaries. Today, however, in the United States and throughout much of the world, that search is carried on to separate the protectable from the unprotectable whether consciously by the musicologist or subliminally by the composer when he or she uses standard musical devices available to all composers and expresses them in an original way. It is that search which we will explore in this book.

5. *Scènes à faire* are unprotectable ideas, facts, devices and sequences, among other things, which necessarily follow from a common theme or premise. *See, e.g.,* See v. Durang, 711 F.2d 141, 143 (9th Cir. 1983); Jason v. Fonda, 698 F.2d 966 (9th Cir. 1982), *aff'g and incorp'g by reference*, 526 F. Supp. 774, 777 (C.D. Cal. 1981). As the late Judge Yankwich defined it in *Schwarz v. Universal Pictures Co*., 85 F. Supp. 270, 275 (S.D. Cal. 1945), "The French use a very expressive phrase in dramatic literature: '*scènes à faire*' that is, scenes which 'must' be done. For instance, the '*scène à faire*' in the present script is called for by the scene in which the girl burned her hand on a cigarette. Something had to be done with that burn, and the author uses it as a means of identification. In an old play in which Adolphe Menjou appeared, in the days before talking pictures, he came in, spilled some red ink; then took a handkerchief and wiped the ink off his hand with it. That was the beginning. Ultimately there had to be a scene explaining the red spot. [¶]So in all dramatic works we find that situations which are identical call for scenes which are similar."

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CHAPTER

1

The Copyright Law

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"Not all copying, however, is copyright infringement. To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."

Feist Publications, Inc. v. Rural Telephone Service Company, Inc.[1]

"The real task in a copyright infringement action, then, is to determine whether there has been copying of the expression of an idea rather than just the idea itself. . . . Only this expression may be protected and only it may be infringed."

Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corporation[2]

I. The Lawyer's Mission

Other than their obvious meaning, the words "Overview," "Basic Principles," and "An Introduction" are intended to convey a message to the practitioner that this chapter, like the copyright statutes, constitutes an invitation to look further and probe deeper into the facts and law when given the opportunity to represent a client in copyright infringement litigation. That approach is especially cogent at this time in history when copyright law is trying to keep apace with new and developing technology. Lawyers must creatively apply proper methodology to those tasks which, in essence, are governed by deductive logic. This methodology provides the structure for virtually all legal reasoning and is what the Supreme Court employed in the *Betamax* case when it applied the law to the facts in reaching its decision.[3] That is also what lawyers do in constructing their arguments: the logical handling of the law and facts, especially in close cases, is often the difference between prevailing and losing in a jury trial; or at the very least, the logical handling of the law may mitigate the consequences of an unfavorable set of facts. Those arguments, although presented in venues far removed from the concert hall, are analogous to the creation of a valid and effective musical work when, during and after hearing it, there is a sense of inevitability about it, leaving the listener instinctively knowing that in its final incarnation the composition could not have turned out any other way. So that another ingredient of successful advocacy is not lost in this discussion of logic, argument should always be driven by conveying

1. 499 U.S. 340, 361, 111 S. Ct. 1282, 1296, 113 L. Ed. 2d 358 (1991).
2. 562 F.2d 1157, 1163 (9th Cir. 1977).
3. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 456 104 S. Ct. 774, 796, 78 L. Ed. 2d 574 (1984). The actual statement of the Supreme Court regarding its use of deductive reasoning to reach a result is the following: "Applying the copyright statute, as it now reads, to the facts as they have been developed in this case, the judgment of the Court of Appeals must be reversed."

a sense of commitment to the client's cause delivered with eloquence, especially in oral argument.

II. Basic Principles: An Introduction

From the early days of its history, first in England, to the present day in the United States, copyright law has been succinctly codified in statutes, beginning in 1710 with the Statute of Anne and continuing through the twentieth century, with the 1909 Copyright Act, its revisions, and the current statute, the Copyright Act of 1976, which remains effective in the twenty-first century. In their successive and uninterrupted incarnations, these statutes have provided concise yet generic statements of the law, together with a framework of principles within which the law has been interpreted and developed by the courts. In its earliest incarnation—the Statute of Anne—music was not protected by copyright because it did not qualify as a "writing," a privilege accorded by the judges of the Court of Chancery and the King's Bench only to books, plays, and maps. This unjust denial of copyright protection for music was remedied in 1777, before the King's Bench, in a case filed by Johann Christian Bach, J. S. Bach's younger son, who lived and worked in England under the name of John Bach and who was granted the "privilege" (read "license") by the King to publish his own compositions. Although he was widely recognized as a composer and keyboardist, as a publisher he became a new and different champion for official recognition of musical works as copyrightable material: In 1777, he filed a case, *Bach v. Longman, Lukey & Co.*,[4] in which King's Bench led by Lord Mansfield conferred copyright protection upon music, as the following extract from the opinion reports:

> Lord Mansfield called on Mr. Wood to begin; and without hearing Mr. Robinson in answer, said, the case was so clear and the arguments such, that it was difficult to speak seriously upon it. The words of the Act of Parliament are very large: "books and other writings." It is not confined to language or letters. Music is a science; it may be written; and the mode of conveying the ideas, is by signs and marks. A person may use the copy by playing it; but he has no right to rob the author of the profit, by multiplying copies and disposing of them to his own use. If the narrow interpretation contended for in the argument were to hold, it would equally apply to algebra, mathematics, arithmetic, hieroglyphics. All these are conveyed by signs and figures. There is no colour for saying that music is not within the Act. Afterwards, on Monday, June 16th, the Court certified in these words, "Having heard counsel and considered this case, we are of opinion, that a musical

4. 2 Cowp. 623, 98 Eng. Rep. 1274 (K.B. 1777).

> composition is a writing within the Statute of the 8th of Queen Anne, intitled An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein Mentioned."

The clear vision of Lord Mansfield also foretold what we now label as the "idea/expression dichotomy." In the case of *Sayre v. Moore*[5] in 1785 he tried an action involving the extent of protection under a copyright statute covering maps and charts. He began his opinion in the *Sayre* case with this prescient statement of the two conflicting forces impacting copyright protection:

> [W]e must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.

This concise, brief and yet complete distillation of the aim of copyright in a free society has been echoed many times since, and it is good bet that none of the judges writing those opinions in the United States ever read Mansfield's prophetic observation in the Sayre case. One of the closest parallels in spirit and meaning (if not in the exact language) is enunciated in *Sid & Marty Krofft Television Productions v. McDonald's Corporation*,[6] a case which has generated much debate and comment. In discussing the "axiom of copyright law that the protection granted to a copyrighted work extends only to the particular expression of the idea and never to the idea itself," the judges in *Krofft* wrote that:

> This principle attempts to reconcile two competing social interests: rewarding an individual's creativity and effort while at the same time permitting the nation to enjoy the benefits and progress from use of the same subject matter. [¶] The real task in a copyright infringement action, then, is to determine whether there has been copying of the expression of an idea rather than just the idea itself.[7]

The tradition of lawmaking through the judicial process continues in England and the United States. In the United States, even though our statutory copyright regime is securely in place, it is essential for all practitioners, in other areas as well as copyright, to conduct in-depth research and analysis of the law. It is within the judicial arena in the United States Federal Courts that the struggle to distinguish protected expression from unprotectable elements in creative works has been, and continues to be, waged to the present day. This struggle found both its answer and at the same time created many questions

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5. 1 East 361 n., 102 Eng. Rep. 139 n. (K.B. 1785).
6. 562 F.2d 1157 (9th Cir. 1977).
7. *Id.* at 1163.

in the courts' confrontations with the *idea/expression dichotomy*. Those three words, so concise and simply stated, encompass a concept to which thousands of words and limitless thought have been devoted. It is logical and fitting that it is the first copyright theory for our discussion.

III. The Idea/Expression Dichotomy

The excerpts from two reported cases quoted at the beginning of this chapter—so directly and simply stated—belie the complexity and confusion spawned by the bench and bar to conceptualize and articulate clear and precise rules to determine which "constituent elements" of a copyrighted work are original and those which are not. The former are protected by copyright, while the latter are not and therefore are available for use by others who wish to create their own original works. These unprotectable elements include ideas, concepts, facts, matters in the public domain, methods of operation, principles, procedures, processes, principles, and *scènes à faire*. These two domains of the protected and unprotectable, in their short form, are commonly referred to as the "idea/expression dichotomy," or the "fact/expression dichotomy" (collectively the "idea/expression dichotomy") which have a constitutional dimension: The First Amendment guarantees that ideas are the stuff of free expression and cannot be monopolized by any one person, while still rewarding creators by granting them a limited monopoly over original expression to encourage creativity and authorship.

Because *the idea/expression dichotomy* and other legal principles for the resolution of copyright infringement disputes have been created in federal trial and appellate courtrooms, practitioners and judges must not only have knowledge of Title 17 of the United States Code, but must also turn to reported decisions to provide guidance and understanding in navigating the copyright law. That is not an easy task because judges sitting in different venues, hearing similar claims and applying the same legal concepts, often reach different conclusions. This is not an anomaly of copyright law, but occurs in virtually all areas of the law and in other fields where generally stated principles must be examined and interpreted by the courts. Thus, in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc*., the United States Supreme Court provided that in a copyright infringement action, "two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."[8] This statement and the long history of copyright opinions preceding it document the struggle to design tests for the application of the second element of a copyright claim as articulated in *Feist*. It is important to note that even though the Supreme Court has spoken, varying interpretive

8. 499 U.S. at 361, 111 S. Ct. at 1296.

approaches by the federal courts continue to be used when the issue of copying is addressed. It is at this point, when the *idea/expression dichotomy* asserts itself, that we are asked to determine whether the copying was of unprotectable ideas or protected expression. A review of selected reported authorities is not a mere historical exercise but, rather, a path to understanding this simply stated, often misunderstood, area of copyright law. We begin with *Arnstein v. Porter*,[9] followed by the efforts of the federal judiciary to understand and apply its formulation, and continuing with suggestions for the future of the test first announced in *Arnstein*, which is centered on one question: Should the *Arnstein* two-pronged, bifurcated approach of the second element of proving infringement be abandoned and replaced? However, that question will not be definitively answered unless and until the federal courts take that final step. In order to understand the reasons for a non-bifurcated approach to the second element of infringement, we must first explore the origins and lineage of the *Arnstein* test and understand how and why it has been reinterpreted and modified by the system.

A. *Arnstein v. Porter* and Its Legacy

Under both the 1909 and 1976 Copyright Acts, proof of copyright infringement has consisted of two elements: (1) ownership of a valid copyright, and (2) copying of protected expression. The first element in the overwhelming number of copyright actions has required little or no proof, nor is it often challenged. The second, however, has generated controversy and an ongoing search for a definitive formula and vocabulary to separate protected from unprotectable contributions to a creative work. Since the opinion by the Second Circuit in *Arnstein v. Porter* in 1946, the formula to determine whether protected expression has been copied consists of a two-pronged test: "(a) that defendant copied from plaintiff's copyrighted work and (b) that the copying (assuming it to be proved) went [so] far as to constitute improper appropriation."[10]

The court held that on the first prong, evidence of copying could consist of the defendant's admission that he or she copied, or "circumstantial evidence—usually evidence of access—from which the trier of the facts may reasonably infer copying."[11] The court goes on to state that only after copying is established "does there arise the second issue, that of illicit copying (unlawful appropriation). On that issue, . . . the test is a response of the ordinary lay

9. 154 F.2d 464 (2d Cir. 1946).

10. *Id.* at 468. One of the first statements dealing with the tests for actionable copying is found in *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 18 (9th Cir. 1933), where the court states that, "if there had been literary piracy of the story, [the ordinary person] should detect that fact without any aid or suggestion or critical analysis by others. The reaction of the public to the matter should be spontaneous and immediate."

11. 154 F.2d at 468.

hearer; accordingly, on that issue, 'dissection' and expert testimony are irrelevant."[12] This two-prong approach has remained a constant formula for determining permitted copying (of ideas, etc.) and/or access and actionable copying. Absent proof through this two-prong approach, the court also held that "[i]n some cases, the similarities between the plaintiff's and defendant's work are so extensive and striking as, without more, both to justify an inference of copying and to prove improper appropriation."[13]

We must, however, as a precursor to later decisions permitting expert testimony on the second prong of the *Arnstein* formula, pay close attention to the dissent of Judge Charles Clark, who not only castigated the majority opinion as "anti-intellectual," and "book-burning,"[14] but also cast doubt on the two-prong formula in the following language:

> I find nowhere any suggestion of two steps in adjudication of this issue, one of finding copying which may be approached with musical intelligence and assistance of experts, and another that of illicit copying which must be approached with complete ignorance; nor do I see how rationally there can be any such difference, even if a jury—the now chosen instrument of musical detection—could be expected to separate those issues and the evidence accordingly. If there is actual copying, it is actionable, and there are no degrees; what we are dealing with is the claim of similarities sufficient to justify the inference of copying. This is a single deduction to be made intelligently, not two with the dominating one to be made blindly.[15]

Less than a week later, the same court in *Heim v. Universal Pictures Co., Inc.*[16] held that the plaintiff must (1) prove that the infringer copied from plaintiff's work, and (2) in addressing the second prong, prove that the copying was so "material" (or "substantial") as to constitute actionable copying or infringement. The use of the word "substantial" evolved to the point where it was the adjective modifying similarity for both the first and second prongs or, in other words, *substantial* similarity to prove copying of *something*—whether of protected or unprotectable elements of the work—and *substantial* similarity of protectable expression to establish copyright infringement.[17]

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12. *Id.*
13. *Id.* at 468–69.
14. *Id.* at 478 (Clark, J., dissenting).
15. *Id.* at 476 n.1.
16. 154 F.2d 480, 487 (2d. Cir. 1946).
17. Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1164 (9th Cir. 1977); Ideal Toy Corp. v. Fab-Lu Ltd., 266 F. Supp. 755 (S.D.N.Y. 1965), *aff'd*, 360 F.2d 1021 (2d Cir. 1966); *see also* Novelty Textile Mills, Inc. v. Joan Fabrics Corp., 558 F.2d 1090, 1092 (2d Cir. 1977); Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir. 1975), *cert. denied*, 423 U.S. 863 (1975).

B. The Reinterpretation of *Arnstein v. Porter*

1. *Sid & Marty Krofft Television Productions Inc. v. McDonald's Corporation*

Plaintiff Sid & Marty Krofft Television Productions brought a copyright infringement action against McDonald's Corporation for infringement of Krofft's "H.R. Pufnstuf" television show by the "McDonaldland" television commercials. There was no dispute as to access. (Among other things, [1] defendants were engaged in negotiations with plaintiffs for licensing of the "H.R. Pufnstuf" characters while working on the infringing commercials and [2] representatives of the advertisers visited Krofft's offices to discuss engineering and design work.)[18] The jury awarded damages of $50,000 to plaintiff. Plaintiffs argued on appeal that the court erred in awarding the damages and should have ordered an accounting of profits by defendants or, alternatively, should have awarded statutory "in lieu" damages. Defendants cross-appealed contending that there was no infringement as a matter of law and that a finding of infringement abridges their First Amendment rights. The Ninth Circuit affirmed the judgment for infringement and rejected the First Amendment claim, but found that the district court erred in awarding damages, and remanded to the district court for further proceedings.

In reaching its decision, the Circuit Court reviewed the then-leading authorities on summary judgment of copyright claims. The court began by explaining that the elements of copyright infringement—ownership of copyright, access, and substantial similarity— require a limiting principle so that plaintiffs will not be able to claim infringement in cases that are beyond the scope of copyright protection.[19] The Ninth Circuit panel, in an opinion by Judge Carter, determined that the necessary limitation was provided "by the classic distinction between an 'idea' and the 'expression' of that idea."[20] Thus, in addition to ownership of copyright and access, there must be "substantial similarity not only of the general ideas but of the expression of those ideas as well."[21] The court reasoned that "two steps in the analytic process are implied by the requirement of substantial similarity."[22] The judges then chose a name for the first prong—the "extrinsic test"[23]—and explained it in the following language:

> It is extrinsic because it depends not on the response of the trier of fact, but on specific criteria which can be listed and analyzed. Such criteria include the type

18. *Krofft*, 562 F.2d at 1172.
19. *See id*. at 1162–63.
20. *Id*. at 1163.
21. *Id*. at 1164.
22. *Id*.
23. *Id*.

> of artwork involved, the materials used, the subject matter, and the setting for the subject. Since it is an extrinsic test, analytic dissection and expert testimony are appropriate. Moreover, this question may often be decided as a matter of law.[24]

The court next explained that, if the trier of fact finds that there is substantial similarity of ideas (*extrinsic test*), the next issue to resolve is whether there is substantial similarity in the expression of the ideas to constitute infringement. "The test to be applied in determining whether there is substantial similarity in expressions shall be labeled an intrinsic one depending on the response of the ordinary reasonable person. . . . It is intrinsic because it does not depend on the type of external criteria and analysis which marks the extrinsic test."[25] Furthermore, the court ruled that "[b]ecause this is an intrinsic test, analytic dissection and expert testimony are not appropriate."[26]

Noting that "[t]his same type of bifurcated test was announced in [*Arnstein v. Porter*]"[27] the court construed the "*Arnstein* doctrine"[28] and stated that "[w]e believe that the court in *Arnstein* was alluding to the idea-expression dichotomy which we make explicit today."[29] Because the defendants did not deny that they copied plaintiff's idea, but instead argued that the expressions of the idea are too dissimilar to constitute infringement based on dissection of relevant portions of the *H.R. Pufnstuf* series and the McDonald's commercials, the court found that defendants' approach "ignore[d] the idea-expression dichotomy alluded to in *Arnstein* and analyzed today."[30] It explained: "Defendants attempt to apply an extrinsic test by the listing of dissimilarities in determining whether the expression they used was substantially similar to the expression used by plaintiffs. That extrinsic test is inappropriate; an intrinsic test must here by used. . . . [¶] [A]nalytic dissection, as defendants have done, is therefore improper."[31]

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24. *Id.*
25. *Id.* (citations omitted).
26. *Id.*
27. *Id.* at 1164.
28. Specifically, the *Krofft* Court quoted as support for the distinction and for the different tests the following from *Arnstein*: "'[T]he trier of fact must determine whether the similarities are sufficient to prove copying. On this issue, analysis ('dissection') is relevant, and the testimony of experts may be received to aid the trier of facts. . . . If copying is established, then only does there arise the second issue, that of illicit copying (unlawful appropriation). On that issue . . . the test is the response of the ordinary lay hearer; accordingly, on that issue, 'dissection' and expert testimony are irrelevant.'" Krofft, 562 F.2d at 1164 (quoting Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946) (footnotes omitted)).
29. *Id.* at 1165.
30. *Id.*
31. *Id.*

Thus, under these tests, a literal reading of *Krofft* gives virtually all power in applying the *intrinsic* test to the jury, to the exclusion of the court; however, *Krofft*, in a throwaway line, states that the *extrinsic* test (confined to similarity of ideas and other unprotectables) may often be decided as a matter of law.

2. Fine Tuning *Krofft: Litchfield, Berkic, Aliotti and Olson*

Litchfield v. Spielberg[32] involved an action by the author of a musical play, *Lokey from Maldemar*, against the producers of the motion picture *E.T.—The Extra-Terrestrial* for copyright infringement and other claims for relief. The district court granted summary judgment for defendants on the grounds that *E.T.* was not substantially similar to *Lokey*'s ideas and protectable expression. The Ninth Circuit quoted *Krofft* that "[t]o prove infringement, a plaintiff must show that the works are substantially similar in both *ideas* and *expression*."[33] The court then went on to flesh out the extrinsic test when it stated that "[s]imilarity of ideas may be shown by an extrinsic test which focuses on alleged similarities in the objective details of the works. . . . The extrinsic test requires a comparison of plot, theme, dialogue, mood, setting, pace and sequence."[34] After *Krofft* articulated a test requiring comparison of ideas in the generic sense without objective criteria, this opinion worked an improvement, although the court maintained the compartmentalized functions of experts who were permitted to testify under a more objective extrinsic test, but were foreclosed from doing so on the intrinsic (reasonable person) side of the equation.

Berkic v. Crichton[35] continued to follow the two-prong test laid down by the *Krofft* Court as supplemented by the panel in *Litchfield*. In his complaint, *the Berkic* plaintiff filed copyright infringement and related claims against, among others, the writer of the novel *Coma* and the director and screenplay writer of the motion picture based on the novel. Specifically, plaintiff alleged that the novel and motion picture "were 'adapted, derived or copied' from his screen treatment *Reincarnation*."[36] This panel of the Ninth Circuit supplemented the holding and rationale in *Litchfield* that under the extrinsic test for substantial similarity of ideas, it is not merely the comparison of basic plot ideas, but rather "the actual *concrete* elements that make up the total sequence of events and the relationship between the major characters."[37] After an analysis of the plots, themes, dialogue, mood, settings, pace, and sequence of the two

32. 736 F.2d 1352 (9th Cir. 1984).
33. *Id.* at 1356 (quoting Krofft, 562 F.2d at 1164).
34. *Id.* (citing Jason v. Fonda, 698 F.2d 966 (9th Cir. 1982), *incorporating by reference*, 526 F. Supp. 774, 777 (C.D. Cal. 1981)).
35. 761 F.2d 1289 (9th Cir. 1985).
36. *Id.* at 1291.
37. *Id.* at 1293 (emphasis added).

works, the court concluded that there was no similarity of ideas and that no reasonable juror could find as a matter of law that defendant's work was substantially similar to plaintiff's treatment in protectable expression.

Aliotti v. R. Dakin & Co.[38] bears some resemblance to the fact pattern in *Krofft*, but with sufficient variation to warrant a different result on the appeal from a grant of summary judgment. In the 1970s, Favorite Things, Inc. was in the business of manufacturing cuddly stuffed toy dinosaurs with droopy eyes for the children's market. Beginning in November 1978 and continuing through March 1979, the president of Favorite Things and representatives of Dakin engaged in negotiations for Dakin to acquire Favorite Things. In April 1979, Dakin decided not to do so. Shelley Aliotti, the designer of Favorite Things' stuffed dinosaurs, was asked if she was interested in being considered for employment at Dakin, which she declined to remain at Favorite Things. In June 1980, Dakin began manufacturing its own designs of the same six dinosaur species used as a springboard for Aliotti's designs. When Favorite Things became bankrupt in 1982, Aliotti and her husband acquired the rights to the designs she had created. In the face of extensive and in-depth access by Dakin to the Aliotti stuffed dinosaurs, the court affirmed summary judgment for Dakin. In its analysis, this panel repeated the test articulated in *Litchfield*, but held that the test for similarity of expression "*is* modified by a line of cases recognized by *Krofft* but never satisfactorily integrated into the two-part *Krofft* framework"[39]: to wit, that it is appropriate "to perform analytic dissection of *similarities*"[40] based on the authorities holding that where idea and expression cannot be separated, there can be no infringement.[41] Although facially limited, this refinement of the *Krofft* two-part test is a significant step toward providing the jury with expert testimony and guidance in dealing with filtering unprotectable elements from protected expressions in applying the *intrinsic* test.

In *Olson v. National Broadcasting Company, Inc.*[42], Olson, the author of a treatment and screenplay entitled *Cargo* filed an action for copyright infringement against National Broadcasting Company, Inc. ("NBC") and others. In his treatment and screenplay, plaintiff Olson chronicled the exploits in an action-adventure genre story of three G.I.s in Viet Nam who become scam artists while in the service. When they return home they continue those illicit activities while working in an air cargo company owned by the father of a woman who was romantically involved with one of the three Viet Nam vets. In the defendant's series broadcast over the NBC television network, three characters—Peck, Baracas and Smith—while in Viet Nam are wrongfully accused of robbing

38. 831 F.2d 898 (9th Cir. 1987).
39. *Id.* at 901 (emphasis added).
40. *Id.* (emphasis in original).
41. *Id.*
42. 855 F.2d 1446 (9th Cir. 1988).

a bank in Hanoi, acting on secret instructions from a colonel who died and could not corroborate their defense. There is a love interest, Amy, of one of the three characters comprising *The A-Team*. Even though the jury found that the creator of the work, Steven Cannell, had not copied from plaintiff's work, they also inconsistently found that *The A-Team* was substantially similar to *Cargo*, and that NBC copied protected expression from plaintiff's work. The district court granted a judgment n.o.v., and in its memorandum decision, "found that Olson had failed to prove that the defendants who created the allegedly infringing work had access to his work."[43] The district court also found "that 'The A-Team' was not similar to the 'Cargo' works under either the extrinsic test or the intrinsic test" and "that no reasonable person could conclude that NBC copied the general ideas or protectable expression of 'Cargo.'"[44]

The appellate court observed that "there is little similarity between 'The A-Team' and the 'Cargo' works in terms of overall plot, sequence, dialogue or setting."[45] The similarities found by the Ninth Circuit were theme, mood, and pace, emphasizing action; however, the court went on to state that even though both had similar moods and were fast-paced, the similarities arose because both fell within the genre of action/adventure series in television and motion pictures. These similarities were from those "familiar scenes and themes [which] are among the very staples of modern American literature and film'" and "'stock' themes commonly linked to a particular genre."[46] The court concluded by holding in reliance on a combination of *Litchfield, Krofft,* and *Aliotti* that "[a]lthough . . . considerable deference is due to a jury's finding of substantial similarity under the intrinsic test . . . , 'no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas'. . . . [b]ecause those similarities that do exist arose from unprotectable scènes à faire, there exists no substantial similarity of protectable expression under the *intrinsic test*."[47]

3. *Shaw v. Lindheim*[48] *and Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*[49]

In *Shaw*, the Ninth Circuit panel, in considering the possible derivation of the television show *The Equalizer* from plaintiff's work with the same title (which title defendants admitted copying), concluded that the only issue before the

43. *Id.* at 1448.
44. *Id.*
45. *Id.* at 1450.
46. *Id.* at 1451 (quoting Berkic v. Crichton, 761 F.2d 1289, 1293–94 (9th Cir. 1985) & Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir.), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278 (1986)).
47. *Id.* at 1453 (citations omitted) (emphasis added).
48. 919 F.2d 1353 (9th Cir. 1990).
49. 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991).

district court "was whether defendants' version of the Equalizer is substantially similar to Shaw's original script."[50] The Circuit Court reversed the summary judgment, and in so doing failed to make good on its statement at the beginning of the opinion that "Shaw must show that he owns the copyright and that defendant copied protected elements of the work."[51] The holding is incorrect because the court in *Shaw* did not distinguish between similarity of original protected expression and substantial similarity of ideas under the *extrinsic* test. Absent settlement, this thus required that trial take place. (This case was thought at the time to sound the death knoll for summary judgment in copyright infringement cases in the Ninth Circuit.) At trial, the jury returned a verdict for the plaintiff. The trial judge, however, was not deterred by the Ninth Circuit holding and granted a j.n.o.v. in favor of defendants (the post-trial equivalent of a summary judgment) on the ground that the elements of his screenplay that plaintiff alleged were infringed were not protectable by copyright.

Feist was decided afterwards and *Shaw v. Lindheim* remains on the books in its current state. As Nimmer observes, however, "given *Shaw*'s reformulation of the extrinsic test, the decision is better viewed as standing for the unremarkable proposition that when objectively speaking a triable issue of expressive similarity exists, the case must be sent to the trier of fact; but when no such objective argument is possible, summary judgment will lie."[52]

The court in *Feist*, even though dealing with compilations in the white pages of a telephone book that undeniably were copied, did not limit its statement that "[n]ot all copying, however, is copyright infringement. To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are *original*"[53] Because there is no limiting language, in all probability, the Court, in announcing these two "constituent elements," intended that they apply to copyright

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50. *Id.* at 1356.

51. *Id.*

52. 3 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.03[E][3], at 13–78.20 (1991), *quoted in* Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1477 (9th Cir. 1991), *cert. denied*, 513 U.S. 1044, 115 S. Ct. 638 (1994) (where the court *affirmed* a summary judgment for the defendant, thus putting to rest the speculation (and even certainty) in some quarters that summary judgment was no longer viable in the Ninth Circuit).

53. 499 U.S. at 361, 111 S. Ct. at 1296 (emphasis added). Plaintiff's legal ownership of the copyright consists of several aspects, including (a) standing to sue for the exclusive copyright in and to the work at issue, *see* 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 12.02[B], at 12–56, *et seq.* (2007); 17 U.S.C. § 501(b), (b) the originality of plaintiff's work because only those aspects of the work that originated with plaintiff are protected by copyright, 17 U.S.C. § 102(a), and (c) the scope of the copyrightable (and hence protectable) aspects of the work, *e.g.*, facts, ideas, and *scènes à faire* are not protected, 17 U.S.C. § 102(b)); 1 Nimmer, §§ 2.01–2.19; Aliotti v. R. Dakin & Co., 831 F.2d 898, 901 (9th Cir. 1987).

infringement of works in all genres and all incarnations, whether literature, music, the fine arts, or computer programs and the like.

4. An Interim Stopgap: Latman's *Probative Similarity*

The two-prong test as it has evolved uses the word "substantial" in both prongs to modify "similarity," which has caused much confusion when the courts and juries have wrestled with the issue of copying involving access plus *substantial* similarity to prove copying or *substantial* similarity to prove access and *substantial* similarity of protected expression or, in the words of *Arnstein*, "actionable copying." Professor Alan Latman, in his illuminating article "'Probative Similarity' As Proof of Copying: Toward Dispelling Some Myths In Copyright Infringement,"[54] attributes the problem to the use of the words "substantial similarity" for both tests.[55] His solution is to describe the first prong of the test–that is, to prove copying from plaintiff's work (whether unprotectable or protected)—as *probative similarity*, and to name the second test *substantial* similarity of protected expression. The latter includes the requirements of materiality both as to quantity and quality of protected elements of a work.[56]

5. Expert Testimony and the Future of the Two-Prong Test

In reviewing these authorities, beginning with *Arnstein*, and culminating (at least for the time being) in *Feist*, we must view the two-prong test with a critical eye,[57] giving attention to the second prong (the reasonable person test or *the audience test* in music infringement actions), especially since it and the *extrinsic test* have become so intertwined with theories regarding the appropriate and inappropriate uses of expert testimony in copyright infringement litigation. The rationale for this query is based on the following: (1) the

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54. Alan Latman, *'Provative Similarity' As Proof of Copying: Toward Dispelling Some Myths In Copyright Infringement*, 90 Colum. L. Rev. 1187 (1990).
55. *Id.* at 1189–90.
56. *Id*. at 1204–06.
57. Even in the wake of *Feist*, however, the courts have continued to apply the *audience test* to determine whether the works are substantially similar in protectable expression. *See, e.g.,* Wildlife Express Corp. v. Carol Wright Sales, Inc., 18 F.3d 502, 508–09 & n.6 (7th Cir. 1994); *see also* Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp., 361 F.3d 312, 318 (6th Cir.), *cert. denied*, 543 U.S. 959, 125 S. Ct. 432, 160 L. Ed. 2d 323 (2004); Moore v. Columbia Pictures Indus., Inc., 972 F.2d 939, 945–46 (8th Cir. 1992); Banker's Promotional Mktg. Group, Inc. v. Orange, 926 F.2d 704, 705 (8th Cir. 1991); Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 732–33 (4th Cir.), *cert. denied*, 498 U.S. 981, 111 S. Ct. 511, 112 L. Ed. 2d 523 (1990); Hartman v. Hallmark Cards, Inc., 833 F.2d 117, 120 (8th Cir. 1987); Franklin Mint Corp. v. National Wildlife Art Exch., Inc., 575 F.2d 62, 65–66 (3d Cir.), *cert. denied*, 439 U.S. 880, 99 S. Ct. 217, 58 L. Ed. 2d 193 (1978); Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc., 479 F. Supp. 351, 356 (N.D. Ga. 1979).

Supreme Court has now made it clear, in *Feist* and in other opinions, that in order to satisfy the second element of a copyright infringement claim, copying must be "of constituent elements of the work that are *original*"; (2) the holdings in cases such as *Berkic* (similarity of *concrete* elements in applying the extrinsic test) and *Aliotti* (expert dissection and analysis may be admitted under the intrinsic test when two works are derived from a common idea); (3) adopting the logic of Judge Clark's dissent in *Arnstein* that the reaction of the reasonable person or listener must be an informed one when determining whether a defendant has engaged in actionable copying, because the reasonable person or listener—as represented by the jury as trier of fact—would be left without knowledge and guidance to determine whether the alleged copying is of protected expression or unprotected "constituent elements"; and (4) even Professor Latman's brilliant suggestion to change the adjective from "substantial" to "probative" similarity for the *extrinsic* test leaves the two prong test in place with its uneven history and potential for confusion.

The questions are: Is it now appropriate that serious consideration be given either to combine the two tests into one, or to abolish the so-called *intrinsic* test? Is it now appropriate to permit, without limitation or further justification, the admissibility of analytic dissection and testimony by experts for the *intrinsic* test? Or are there other workable alternatives? Before we consider these options, we turn to the subject of filtration.

IV. Filtration

A. The Use of Filtration to Separate Unprotectable Elements From Protected Expression: Two Early Formulations

Notwithstanding claims of originality by a plaintiff, certain materials are not granted a copyright monopoly for reasons of policy, as noted above. Every copyright infringement action requires the application of an important balancing process because copyright law rewards "an individual's creativity and effort while at the same time permitting the nation to enjoy the benefits and progress from use of the same subject matter."[58] For this reason, copyright protection is given only to the original expression of an idea, and never to the idea itself.[59] This concept applies as well in the context of music infringement litigation. As the court stated in *Granite Music Corporation v. United Artists Corporation*, "statutory copyright does not give a monopoly over . . . a musical phrase, but merely protects against the unlawful reproduction of an original work." [60]

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58. *Krofft*, 562 F.2d at 1163.
59. 17 U.S.C. § 102(b); *Krofft*, 562 F.2d at 1163, 1170.
60. 532 F.2d 718, 720 (9th Cir. 1976).

In conducting analyses of infringement claims, the United States federal courts and eminent scholars have attempted to articulate "tests" to apply to the task. All such approaches—no matter how well conceived or covered with legal jargon—share a common objective: to identify and separate unprotectable ideas, expression, and other such elements from protected expression, because not every element of work is protectable, though the work itself as a whole may be. Two such tests which have often been quoted as analytic tools to separate protected expression from unprotectable elements of a work are those articulated by Judge Learned Hand and Professor Zachariah Chafee. Judge Hand, in what has been labeled "the abstractions test," described the search to distinguish the unprotectable elements of a work from protected expression in the following language:

> Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist of only its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which, apart from their expression, his property is never extended.[61]

Professor Chafee, in his "patterns test," suggested the following approach:

> No doubt, the line does lie somewhere between the author's idea and the precise form in which he wrote it down. I like to say that the protection covers the "pattern" of the work . . . the sequence of events, and the development of the interplay of characters.[62]

Although it may be conceded that the intended result of each of these tests, after leaving out "more and more of the incident," was a focus on unprotectable generic elements of a creative work, these statements by two eminent copyright pioneers provide an earlier formulation of the "filtration" process, albeit with a one-sided emphasis.

B. Filtration: Contemporary Formulations

Regardless of the nomenclature used by judges, whether ruling on summary judgment motions, instructing a jury, or sitting as the trier of fact in a bench trial, one cogent factor becomes apparent: The courts have used analytic dissection to isolate alleged infringing elements in the works at issue to determine

61. Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930).
62. Zachariah Chafee, *Reflections on the Law of Copyright*, 45 Colum. L. Rev. 503, 513 (1945).

if they are protected expression or unprotectable ideas. In applying this analysis, the courts filter out those elements upon which the claim is based, and if they fall within the umbrella of unprotectables (i.e., ideas, facts, *scènes à faire*, etc.), the defendant should prevail, whether at trial or upon the granting of a summary judgment motion. This is exactly the approach followed by the judges in *Litchfield*, *Berkic* and *Aliotti* discussed in subsection III.B.2 of this Chapter. It is also the analysis the district court in *Olson* applied to an adverse decision against defendant National Broadcasting Company in granting a judgment n.o.v. in the following language, "no reasonable person could conclude that NBC copied the general ideas or protectable expression of 'Cargo.'"[63] In affirming, the appellate court stated that "'no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas.' . . . Because those similarities that do exist arose from unprotectable *scènes à faire*, there exists no substantial similarity of protectable expression under the *intrinsic test*."[64] A pre-echo of the *Olson* opinion is found in *Cooling Systems and Flexibles, Inc. v. Stuart Radiator, Inc*., where the court observed that "[w]hat is important is not whether there is substantial similarity in the total concept and feel of the works, . . . but whether the very small amount of protectible expression in Cooling Systems' catalog is substantially similar to the equivalent portions of Stuart's catalog."[65] The Ninth Circuit in *Aliotti* invoked this rationale in stating that "[a]lthough even unprotectable material should be considered when determining if there is substantial similarity of expression, . . . no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas."[66]

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63. *Olson*, 855 F.2d at 1448.
64. *Id.* at 1453 (citations omitted) (emphasis added).
65. 777 F.2d 485, 493 (9th Cir. 1985) (citation omitted), *overruled on other grounds by* Fogerty v. Fantasy, Inc., 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994).
66. *Aliotti v. R. Dakin & Co*., 831 F. 2d at 901 (citation omitted). *See also* Bateman v. Mnemonics, Inc., 79 F.3d 1532, 1545–46 (11th Cir. 1996) (where a jury instruction that limited filtration to *non-literal* copying (and did not apply it to the other challenges to originality such as *scènes à faire*, standard techniques and practices, etc.), constituted prejudicial error); Harbor Software, Inc. v. Applied Sys., Inc., 925 F. Supp. 1042, 1046 (S.D.N.Y. 1996) (where the court held that filtering unprotectable non-literal elements from protectable non-literal elements of a computer program is a determination of copyright scope to be made by a judge, not a jury (drawing an analogy to the patent case of Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed Cir. 1995), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (1996))).

V. Expert Testimony Under the Two Prong Test: Suggested Alternatives

A. Combine the Two Tests[67]

1. To Eliminate the Inherent Confusion Regarding Use of Expert Testimony

A review of reported authorities provides the most compelling argument that the two-prong test was ill-conceived from the beginning of its existence because it is counter-intuitive and artificial in that it has been, and arguably could still be, used to foreclose the admission of expert dissection and analysis for the second prong (the reasonable person/*audience* test). This has caused great confusion, as evidenced by the divergent views and formulae, together with modifications, permutations, etc. by the judiciary in the search to separate protected expression from unprotectable elements in a work.

The two-prong approach is also counter-factual because trial courts, in confronting motions for summary judgment in copyright infringement cases, more often than not filter unprotectable ideas, *scènes à faire*, etc., from protected expression and grant summary judgments, giving lip service to the so-called extrinsic test while going to the core issue in finding that no reasonable juror, properly instructed, could find as a matter of law that the defendant copied protected expression from plaintiff's work.

The judiciary and lawyers should face the reality that during trial when expert testimony is presented on the first prong of the *Arnstein* formulation, the jury does not erase that testimony from its collective memory when considering whether the elements plaintiff claims were copied are protected expression.[68] Rather than choosing a radical approach to eliminate the reasonable person/audience test, an option that should be given serious consideration is to combine the two tests and permit the admission of expert dissection and analysis, which together with the court's instructions, will provide guidance for the jury in answering the basic question: Assuming there is

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67. *See* Ideal Toy Corp. v. Fab-Lu, Ltd., 360 F.2d 1021, 1022–23 & n.2 (2d Cir. 1966) (where the court observed that the two prongs of *Arnstein* seem to have merged into a single lay observer test for substantial similarity). *See also* Ideal Toy Corp. v. Kenner Prods. Div. of Gen. Mills Fun Group, Inc., 443 F. Supp 291, 303 (S.D.N.Y. 1977).

68. Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc., 797 F.2d 1222, 1232–1233 (3d Cir. 1986) (where the court observed that "the distinction between the two parts of the *Arnstein* test may be of doubtful value when the finder of fact is the same person for each step: that person has been exposed to expert evidence in the first step, yet she or he is supposed to ignore or 'forget' that evidence in analyzing the problem under the second step. Especially in complex cases, we doubt that the 'forgetting' can be effective when the expert testimony is essential to even the most fundamental understanding of the objects in question.")

access and substantial similarity between elements in plaintiff's and defendant's works, giving rise to an inference of copying, did defendant copy protected expression or unprotectable ideas, *scènes à faire*, etc.?

2. The Necessity for Musicology Experts: Recognition of the Complexity of Musical Language and the Public's Unfamiliarity With That Language

The opinion in *Whelan Associates v. Jaslow Dental Laboratory Inc.*[69] is concerned not with copyright protection of the artist's expression, but rather with copyright protection of computer software. It does, however, offer a compelling analogy for the proposition that a one-prong, not two-prong, test be used in addressing the issues of admissibility of expert testimony to aid the trier of fact in determining whether protected expression or unprotectable ideas were copied by the defendant. The Court in *Jaslow* was concerned with the issue as to whether a computer program for dental laboratory record keeping was necessary to the idea of organizing a dental laboratory to operate efficiently. The Court held that the structure of a computer program is protected expression—not merely the bare idea of a program—and can therefore be protected by copyright. In reaching this conclusion, the Court considered the testimony of two expert witnesses, one testifying on behalf of each party. The Court rejected the two-prong test observing that "[t]he ordinary observer test, which was developed in cases involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value in cases involving computer programs on the account of the programs' complexity *and unfamiliarity to most members of the public*."[70] Although music and computers would appear to be at opposite ends of the creative spectrum, there can be little if any question that to the lay person (including the judge and the jury) the issues of protected expression *vis-à-vis* unprotectable building blocks of music are complex and unfamiliar to most members of the public.

B. Recognition of Current Practice

1. Burden of Proof: Components and Responsibilities

"Burden of proof" in civil cases is an inclusive term comprised of three components: (1) pleadings setting forth (a) the elements of the plaintiff's claims and (b) the defendant's denials and balances; (2) the burden of production or going forward; and (3) the burden of persuasion. In civil actions, including those for copyright infringement, the plaintiff has the burden to prove each

69. *Id.*
70. *Id.* at 1232 (emphasis added).

essential element of his or her claim by evidence that is more probably true than not.[71] If the defendant is also a counterclaimant, he or she is in the same position as the plaintiff, that is, to prove all essential elements of the counterclaim. If the defendant has asserted affirmative defenses, he or she bears the burden of proving the essential elements of those defenses. The burden of production is satisfied when the evidence, as viewed from the point of view of the party required to produce it, introduces evidence sufficient to avoid a ruling against him on the issue in question.[72] In such circumstances, where either party bears the burden, the opposing party has the right to refute the other party's proof by producing evidence "which denies, explains, qualifies, disproves, repels or otherwise sheds light on evidence offered by an opponent as to a fact of consequence in litigation including the credibility of witnesses."[73] Refutation evidence includes both documentary exhibits and testimony by witnesses. In the case of a defendant the refutation evidence is offered during the defendant's presentation of its denials and defenses. In the case of the plaintiff this presentation occurs during rebuttal after the defense has finished presenting its case.

2. Ritualized Procedures

These procedures are ritualized in the sense that they occur in virtually all civil cases, including those involving copyright infringement. For example, if plaintiff's work makes extensive use of a C Major triad (or a triad in a different key) and contends that defendant's use of the same triad constitutes actionable copying, defendant has the right to demonstrate that plaintiff's infringement claim is based on an unprotectable idea used by composers since natural creation of the modern Western scale of twelve notes, each an equal half-step apart. During the course of a trial the plaintiff will use an expert under virtually all circumstances to make his case to the jury. The defendant's response will be the presentation of expert testimony and exhibits to refute plaintiff's expert. Similarly, the plaintiff can present rebuttal evidence to (1) refute the testimony and exhibits presented by defendant's expert, and (2) explain that plaintiff used a musical idea free for use by all composers to create their own original expressions.

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71. Kevin F. O'Malley et al., Federal Jury Practice and Instructions § 104.01, at 135–42 (5th ed. 2000). *See* United States v. Montague, 40 F.3d 1251, 1254–55 (D.C. Cir. 1994) (where the court made the following observations: "Often, under a preponderance-of-the-evidence standard, it is assumed that the trier of fact piles up the evidence arguably on the defendant's side and determines which pile is greater. . . . In fact, a more accurate notion of the preponderance-of-the-evidence standard is 'evidence, which as a whole shows that the fact sought to be proved is more probable than not.'") (citations omitted); Black's Law Dictionary 1190 (6th ed. 1990). *See also* 3 Nimmer, *supra* note 53, § 12.11.

72. *See* Charles T. McCormick, Evidence §§ 336–38 (6th ed. 2006).

73. Michael H. Graham, Handbook of Federal Evidence § 611.13, at 545 (3d ed. 1991).

This brief and somewhat sketchy review of a small but important part of evidentiary rules is intended to highlight the thesis that the bifurcated approach to the admissibility of expert testimony on the second prong of the *Arnstein/Krofft* test is a fiction. In other words, since expert dissection and analysis is admitted in evidence through different avenues, there is a record for the jury or judge to consider in their search to determine whether the copying is of protected expression or unprotectable elements.

C. The Copyright Registration Certificate and the Rebuttable Presumption

The certificate issued pursuant to registration of copyright of a work within five years after first publication raises a rebuttable presumption that the work as a whole is original and, therefore, entitled to copyright protection.[74] It is also provided by statute and held in case authorities that not every element in a copyrighted work is protected by copyright: the presumption of originality is a rebuttable presumption and, therefore, defendants have the right to offer evidence to rebut that presumption.[75] Logically the guidance needed by a jury is expert dissection and analysis testimony directed toward proving the following: (1) from the plaintiff's viewpoint that the expression in his or her work is original and therefore protected; or (2) from the defendant's viewpoint that the elements that plaintiff claims were copied fall within that area of unprotectable raw materials and are therefore free for others to use in creating their works.

D. Music's Need for a Translator and Educator: Two Scenarios

The foregoing is not just a theoretical exercise but, in fact, is what juries do in copyright cases, and reflects the reality in the courtroom in the face of the artificial limitation imposed by the use of expert dissection and analysis in applying the reasonable person/audience *(intrinsic)* test. Although these comments apply both to music and to other works which are expressed in words, graphic images, and statuary, they have particular application to music infringement claims and the defenses of those claims. Although music should not be treated differently from other creative expressions, there are different approaches between these other genres and music as there are, for example, in the treatment or pictorial characters vis-à-vis literary characters (i.e., those described by the written word). This is because the former are graphically

74. *See* 17 U.S.C. § 410(c).
75. *See* Fed. R. Evid. 301.

portrayed for the human eye to perceive in all their detail (*Mickey Mouse*[76]) while the latter may only be conjured in the mind of readers, each of whom in all likelihood "see" the characters differently (*Sam Spade*[77]). It is also true that creative literary and audiovisual works that convey thoughts and expression in traditional spoken and written languages are understood without the help of an interpreter/expert, whereas judges and juries do require such guidance. For a more concrete understanding of this issue, let us consider two scenarios where two novelists write different fictional works about the Viet Nam war:

1. Scenario Number One

The story in novelist A's work concerns the experiences of a young Midwestern man who enlists in the army because he is unsure about his future and wants the time and experience to live dangerously to help clarify his thoughts. He does well in boot camp and becomes a ranger assigned to a special unit. Operating by night, he and his comrades become adept at killing the enemy silently with wires and ropes. On occasion, when necessary, they kill with knives. The novel also includes a description of Saigon, soldiers in the battlefield with the standard killing tools used in war—tanks, rifles, machine guns, bayonets, land mines, rockets and artillery—and the inevitable wounded and dead soldiers, the medics who attend them, and the officers who send them into battle from base camp. Our protagonist survives the war, returns home and finds his future as a highly paid hired assassin.

2. Scenario Number Two

In Novelist B's book, a young African-American man from Los Angeles is drafted into the army. After basic training, he is sent to Viet Nam as an infantry soldier. His unit becomes involved in some of the fiercest killing fields of the war, and on one such mission, he accidentally kills a young Vietnamese girl he mistakes for a guerrilla fighter. He is a highly religious man and is affected deeply by his mistake. The next day, his unit is ambushed and, in a passage that describes the battle, the novelist vividly describes tanks, machine guns, rockets, bayonets, the wounded and the dead, all with the drone of helicopters raining death on the enemy and in the rush and confusion of battle, even on fellow American soldiers. Most of the buddies of our soldier from Los Angeles are killed. He pretends to be dead as the Viet Cong run through the field chasing surviving G.I.s who are retreating to the safety of American lines where helicopters are waiting to take them back to camp. As he is lying under the body of one of his comrades, he prays to Jesus and makes a commitment that if God gets him out of the situation, which virtually promises death, he

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76. *See* Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978).
77. *See* Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc., 216 F.2d 945 (2d Cir. 1954).

will dedicate his life to public service. He survives and is evacuated to a relocation center outside of Saigon. He visits the city several times for R&R, but is never far from his thoughts about helping make the world a better place. Upon his return to Los Angeles, he enters college under the G.I. bill and eventually graduates from medical school, and after residency, specializes in pediatric surgery.

Novelist B's book reaches and remains on the *New York Times* bestseller list for seventeen weeks. When Novelist A reads B's book, he is certain that his work has been copied; the battle scenes, he thinks, are virtual re-enactments of those so carefully crafted in his novel. He sees that B has depicted soldiers being wounded and killed, medics assisting them, battles of incredible brutality, along with the weapons of death that accompany such battles: guns, rockets, bayonets, tanks, heavy artillery, and the latest incarnations of helicopters with guns blazing. And here we can see the basic difference between literary and representational works on the one hand and music on the other:

It is probable that even without expert testimony jury members having seen war films as moviegoers would, properly instructed, return a defense verdict because all of the battlefield elements in the works of each novelist are *scènes à faire* logically flowing from battle scenes. Not so with contending musical works. An intermediary is necessary to translate and interpret musical ideas and language so the jury will know the difference between unprotectable musical ideas available to all composers and original protected expression, and with that knowledge it can reach an informed decision and render the appropriate verdict. Without such information and acquired knowledge, the jury could not answer even the following basic question: Is the cadence (ending) of one song substantially similar to another in protected expression? Is the fact that one blues song whose composer uses accented notes to give a different feel to twelve-bar phrases sufficient for a viable infringement claim against another songwriter who wrote a blues song with twelve-bar phrases with accents on the same notes written by Blues Man Number One? Does a modulation going from the key of C to the key of G as found in two works expose the second creator using the same modulation to potential liability? The jury members, for the most part, have no idea how to answer these questions. They need a translator/interpreter to provide the knowledge and information enabling them to make an informed and, it is hoped, correct decision sought by both plaintiffs and defendants.

Comment

In reviewing the copyright law as it has evolved since *Arnstein* it is submitted that much of the confusion surrounding the two-prong test is centered on the admissibility or inadmissibility of expert testimony directed to the issue of copying. The reason for this confusion is the attitude set forth in the majority opinion in *Arnstein* (and by its judicial progeny) to hermetically seal expert advice within the domain of the so-called *extrinsic* test and totally foreclose its

admission when implementing the audience test. It should not be surprising that the courts could not live within this constraint because it is an unnatural and unworkable restriction. Thus, we have witnessed appellate courts bursting out of this archaic shackle to permit expert testimony to aid the trier of fact in working through the *instrinsic* side of the copying issue.[78] The conclusion—with particular reference to music infringement litigation—is that expert testimony should be freely used on issues of copying, whether of unprotectable elements or of protected expression, if for no other reasons than the following: (1) expert testimony is a *sine qua non* for defendants to rebut the presumption of originality created by registration of the work with the Copyright Office and the certificate of registration issued by it; (2) juries and the courts should, and perhaps must, be provided with guidance—especially in infringement cases involving music—to filter unprotectable ideas from protected expression; and (3) expert testimony having already been admitted under the *extrinsic* test to determine whether there exists similarity of ideas or between the works at issue, the logical consequence is that the trier of fact still applies the same "extrinsic testimony" to determine whether an infringement claim is based on copying of protected expression or unprotectable elements of the plaintiff's work. The bottom line is that it is almost irrelevant whether the test is bifurcated or combined. The artificiality of the attempted limitation on expert testimony to the first prong is an idea whose time has long passed. It might be argued that the two-prong test remains a valuable tool for judges to focus on idea/fact similarity in ruling on motions for summary judgment.[79] Even though this argument has some validity, in a music infringement case (as distinguished from disputes involving literary or pictorial works), an expert's guidance is essential for the court and the jury to understand what constitutes the ideas and language of music, and with that knowledge to separate ideas and commonplace building blocks of music from its protected expression.

VI. Legal and Equitable Defenses

A. Statute of Limitations

1. Accrual

Given that any statute of limitations constitutes a legal (as distinguished from equitable) defense which is quite specific as to (1) the type of claim or action

78. Please see discussion of *Aliotti* and *Olson*, *supra* at pp. 20–21.
79. This long-held belief is discussed in Chapter 10, *Music and Summary Judgment*.

involved, and (2) the time bar for these claims or actions (e.g., four years for breach of contract in California and six years in the State of New York; three years for copyright infringement), it would appear to be a relatively simple matter to apply the time bar to the age of the claims at issue and determine whether or not they are time barred. On their surface—i.e., considering only the bald, unadorned statement of a specific limitations period—potentially applicable statutes of limitations offer a shortcut to early termination of all or certain of the claims at issue. But to paraphrase the Supreme Court in *Kumho Tire Company, Ltd. v. Carmichael:* Life and the legal cases that it generates are too complex to permit such a simplistic approach to abruptly ending a plaintiff's pursuit of judicial relief.[80]

Three leading cases regarding the point in time where the statute begins to run are *Taylor v. Meirick*[81], *Roley v. New World Pictures, Ltd.*,[82] and *Polar Bear Productions, Inc. v Timex Corporation*.[83] Although it would appear, given the specific language of Section 507(b) of the Copyright Act[84] that there should be little or no dispute regarding the time the statutory period commences to run, the appellate courts in these three cases not only illustrate the great care which should be exercised in analyzing the particular facts of each case, but the different judicial philosophies at play when judges are confronted with potentially depriving litigants of their proverbial day in court through a coldly literal construction of a statute that figuratively slams the door in the plaintiff's face. The portion of the statute (17 U.S.C. § 507(b)) which has spawned these results is centered on the language requiring commencement of an action "within three years after the *claim accrued*."[85]

In *Taylor v. Meirick*, the plaintiff obtained a copyright in 1974 on maps for use by fishermen. Meirick, without a license or other authorization from Taylor, copied the maps in 1976 and 1977, after which Meirick sold the infringing maps to his dealers, who resold them to the fishermen. Meirick argued that he had stopped selling the maps before May 8, 1977, and had taken reasonable steps to recall the infringing maps from his dealers. Taylor did not discover that these sales were occurring until he purchased infringing maps from Meirick's company in 1979. The district court found that since

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80. The complete quotation is: "We do not believe that Rule 702 creates schematism that segregates expertise by type while mapping certain kinds of questions to certain kinds of experts. Life and legal cases that it generates are too complex to warrant so definitive a match." Kumho Tire Co., Ltd. v. Carmichael, 526 U.S. 137, 151, 119 S. Ct. 1167, 1176, 143 L. Ed. 2d 238 (1999).
81. 712 F.2d 1112 (7th Cir. 1983).
82. 19 F.3d 479 (9th Cir. 1994).
83. 384 F.3d 700 (9th Cir. 2004).
84. *See* 17 U.S.C. § 507(b) ("No civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued").
85. *Id.* (emphasis added).

the retailers were selling the maps for a period which continued to the start of the trial, Meirick had not carried his burden of proof that he had exercised reasonable efforts to recall the maps.[86] The Seventh Circuit affirmed the district court's findings on the theory that the series of infringing acts in selling the maps constituted a "continuing wrong."[87] The appellate court concluded that since the last act of infringement occurred within the three-year statutory period, those acts of infringement occurring more than three years prior to the filing of the action were not barred by § 507 of the Copyright Act. The Seventh Circuit analogized its opinion to other areas of the law, including personal injury and architectural malpractice, and stated that "[a]lthough we cannot find a copyright case on point, a similar principle may apply in such cases. . . . Probably it should be enough to toll the statute of limitations that a reasonable man would not have discovered the infringement; and there is no evidence that Taylor was unreasonable in failing to discover the infringing maps before 1979."[88] This, as the court dubbed it, is the "continuing wrong" theory to be applied to copyright infringement claims.[89]

Taking a different approach, the Ninth Circuit in *Roley v. New World Pictures, Ltd.*[90] gave its understanding of the "prevailing view" which mandates that "the statute bars recovery on any claim for damages that accrued more than three years before commencement of suit . . . [and concluded that] . . . [l]est there be any confusion regarding the law in this Circuit on this particular point, we adopt this view."[91] The dispute between the parties finds its roots in 1985 when the plaintiff Sutton Roley submitted a copy of his screenplay *Sleep Tight Little Sister* to Walter Coblenz, a friend and motion picture producer who Roley hoped would produce a picture from his screenplay. In 1987, Coblenz invited Roley to the screening of his film entitled *Sister Sister*; New World was the financier. After the screening, Roley claimed that *Sister, Sister* was actually a production of Roley's screenplay, or in other words, that Coblenz and New World Entertainment either copied the screenplay or used it without license or other authority. In February 1991 Roley filed a complaint against Coblenz and New World for copyright infringement. In June 1992 Coblenz and New World filed summary judgment motions which were granted by the district court upon the ground that Roley's infringement claims were barred by the three-year statute of limitations (17 U.S.C § 507(b)). Roley contended that "so long as any allegedly infringing conduct occurs within three years

86. 712 F.2d at 1117.
87. *Id.* at 1119.
88. *Id.* at 1117–18.
89. 712 F.2d at 1119. *Cf.* Stone v. Williams, 970 F.2d 1043, 1050 (2d Cir. 1992) (where the court observes that "[a]pplication of the continuous wrong doctrine generally has been rejected in the infringement context).
90. 19 F.3d 479 (9th Cir. 1994).
91. *Id.* at 481 (citations omitted).

preceding the filing of the action, the plaintiff may reach back and sue for damages or other relief for all allegedly infringing acts."[92] The Ninth Circuit affirmed and in so doing rejected the *Taylor v. Meirick* theory of a "continuing wrong," which the Ninth Circuit called the "'rolling statute of limitations' theory."[93]

In *Polar Bear Productions, Inc. v Timex Corporation*, the defendant requested the court "to rule that § 507(b) prohibits copyright plaintiffs from obtaining any damages resulting from infringement occurring more than three years before filing the copyright action, regardless of the date the plaintiff discovered the infringement."[94] The Ninth Circuit rejected Timex's argument and held that if plaintiff filed suit within three years of discovering the infringement, the plaintiff could reach back and claim damages for the acts and conduct of the defendant which occurred more than three years before the filing of plaintiff's complaint. The Ninth Circuit's opinion stated: "We conclude that § 507(b) permits damages occurring outside of the three-year window, so long as the copyright owner did not discover—and reasonably could not have discovered—the infringement before the commencement of the three-year limitation period."[95]

2. Tolling

Although the defense that plaintiff's claim of copyright infringement is barred by the three-year statute of limitations is legal in nature, plaintiff's rejoinder that the statute of limitations has been tolled is governed by equitable principles.[96] As equitable considerations are usually fact-driven, once a plaintiff claims that the operable facts demonstrate that the limitations period has been tolled, the following basic questions arise: Does plaintiff's ignorance of the acts of infringement of his copyrighted property toll the statute, or will the defendant's justifiable reliance on plaintiff's failure to file an action within the statutory period carry the day? To focus on two reported authorities—*Taylor v. Meirick* and *Prather v. Neva Paperbacks, Inc.*—will illustrate the balancing process raised by the degrees of plaintiff's ignorance and the defendant's reliance.

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92. *Id.*
93. *Id.*
94. 384 F.3d at 706.
95. *Id.*. *Cf.* Kling v. Hallmark Cards, Inc., 225 F.3d 1030, 1041 (9th Cir. 2000) (in reversing the district court's grant of summary judgment for defendants, the appellate court noted that defendants' §507(b) argument raised an unresolved issue, but one that the court did not have jurisdiction to consider on appeal since defendants' summary judgment motion succeeded below on a related but distinct laches argument).
96. *See* Prather v. Neva Paperbacks, Inc., 446 F.2d 338, 340 (5th Cir. 1971) (where the court states that "under general equitable doctrines, once defendant has shown that a claim is time barred by the applicable statute of limitations, it is incumbent upon the plaintiff, if he is to avoid the bar, to come forward and demonstrate that for some equitable reason the statute should be tolled in his case").

The plaintiff in *Prather* was a published author of a series of novels. In his complaint, Prather alleged that defendants had copied protected elements of several of his novels in creating and publishing their book entitled *Call Box*. The alleged infringement occurred in June 1964 but the suit was not filed until August 1969. In response to the defense that his claims were barred by the statute of limitations, plaintiff asserted that it was tolled because he was unable to procure a copy of the defendants' book.[97] The Fifth Circuit held that plaintiff's argument did not demonstrate that defendants fraudulently concealed the facts alleged by plaintiff in support of his infringement claim. In the opinion for the court Judge Goldberg wrote that "the mere fact that plaintiff was unable to procure a copy of the book is insufficient to show the successful concealment necessary to toll the statute of limitations. This was merely ignorance of evidence, not ignorance of a potential claim. The appellant knew of the alleged infringement, but did not have in his possession the precise minutiae of the plagiarism. The bells do not toll the limitations statute while one ferrets the facts."[98]

In *Taylor*, the facts of which are discussed above, Judge Posner in delivering the opinion for the Seventh Circuit took a more "equitable" stance toward plaintiffs when he wrote that "[a]lthough many cases state that mere ignorance of a cause of action does not toll the statute of limitations, in context the statements invariably mean only that the plaintiff has a duty of diligence: it is not enough that *he* did not discover he had a cause of action, if a reasonable man in his shoes would have."[99] *Taylor* deals with fraudulent concealment and may under those circumstances be distinguished from *Prather;* however, it is suggested that that does not militate against Judge Posner's reference to a reasonable man (person) vis-à-vis the more stringent standard enunciated in *Prather*.[100]

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97. *Id.*

98. *Id.* at 341.

99. 712 F.2d at 1118 (emphasis in original).

100. *See Taylor*, 712 F.2d at 1118. *See also* Stone v. Williams, 970 F.2d 1043 (2d Cir. 1992), *cert. denied*, 508 U.S. 906, 113 S. Ct. 2331, 124 L. Ed. 2d 243 (1993). In *Stone v. Williams*, the plaintiff, who claimed that she did not discover for many years that she was the illegitimate daughter of singer/song writer Hank Williams, Sr., filed a declaratory relief action in 1985 seeking a declaration that she was his child under relevant provisions of the 1909 Copyright Act, and therefore was a part-owner of renewal rights to Williams' copyrighted works. Even though she was placed on notice as early as October 19, 1979, that she may have been Hank Williams's daughter, she was unaware that she was suffering economic injury by being deprived of her property interest in the renewals. The court held that "Stone's suit is timely insofar as relief is sought for defendants' failure to remit to her a proportionate share of royalties received within three years of suit." *Id.*at 1051. The court also held the alternative claim for a position of a constructive trust on income derived from under the renewal term was also timely. *Id.*at 1051–52.

B. Laches and Estoppel

1. The Two Defenses Compared

In the experience of most practitioners, it is seldom that infringement or related actions are decided by these defenses. It is, however, essential for lawyers to recognize the elements and effects of these two defenses bequeathed to us by the court of equity. Whereas laches—comparable to an inexact statute of limitations—bars a tardy but otherwise viable claim, the effect of a successful estoppel defense is, in the words of Professor Paul Goldstein, to "completely excuse an infringer who can show that the copyright owner, knowing both of the infringement and of the infringer's reliance on the copyright owner's representations, misled the unwitting infringer into thinking that his conduct does not constitute infringement."[101] In observing that the defenses of laches and estoppel both present significant difficulties of proof, Professor Goldstein accurately points out why the requirements to prove the elements of estoppel are "more rigorous" when he states that "[t]he estoppel defense presupposes two facts that will only rarely coincide: a copyright owner who, knowing of the infringer's conduct, seeks to lull the infringer into complacency; and an infringer who, ignorant of the copyright owner's rights, falls into the trap and is injured."[102]

2. Laches

In the history of the laches defense, one of the most extreme for record delay is *Danjaq LLC v. Sony Corporation*[103] At issue in *Danjaq* were the rights to produce and exploit the James Bond character in motion pictures. The delay—extraordinarily lengthy by any measure—was from nineteen to thirty-six years by defendants and counterclaimants who had failed over the course of time to file their claims for copyright infringement against the producers and distributors of the James Bond motion pictures. Defendant and counterclaimant Kevin McClory, a screenwriter and associate of Ian Fleming, was involved in the production of *Thunderball*, an early James Bond film starring Sean Connery as *007*. McClory claimed that he, in his collaboration with a screenwriter, Jack Wittingham, and Ian Fleming, the creator of the Bond books, was the primary source in transforming the literary James Bond character into the "cinematic James Bond." In addition, he was involved in creating the sinister organization *Specter* and the villain Ernst Blofeld in the later film, *Goldfinger*, in which the theme of nuclear blackmail was introduced to the Bond canon.

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101. 2 Paul Goldstein, Goldstein On Copyright ("Goldstein") § 11.5, at 27 (3d ed. 2007).
102. *Id.* § 11.5.2, at 34.
103. 263 F.3d 942 (9th Cir. 2001).

As a result of these activities, McClory claimed that he was a part owner of these elements together with the James Bond character, although Ian Fleming was credited as the sole author of James Bond novels, including *Thunderball*. Although preceded by other litigation between the parties, in the litigation which is the subject of appeal the real contestants were Danjaq and McClory. In response to McClory's counterclaims for infringement of Bond films produced by the plaintiffs (including releases of those films on DVD), using McClory's Bond characters, Danjaq asserted that the counterclaims were barred by the defendants' laches.

The district court granted summary judgment on the counterclaims for good reasons: After having acquired rights directly from Ian Fleming, MGM/UA and its co-plaintiffs, for a period of thirty-six years of producing and exhibiting James Bond films, had spent millions developing what had become in the parlance of the motion picture industry a "franchise," and, at that, one of the most valuable in the history of that industry. As such, a delay of thirty-six years in asserting the rights which were the subject of the counterclaims was clearly unreasonable.[104] The opinion of the Ninth Circuit is instructive in that the court listed those elements necessary to establish the laches defense as follows:

(1) unreasonable delay; and
(2) prejudice to the defendant (or in the case of *Danjaq*, the counterclaim defendant) which has two subparts: (a) evidentiary prejudice, e.g., unavailable defendants due to death or other circumstances, lost or unavailable documentary evidence, etc.; and (b) "expectations-based" prejudice (e.g., defendant took actions or suffered consequences that it would not have if the plaintiff had filed his or her action promptly).[105]

In addressing the defendants' argument that the DVD release of the same Bond films in 1997 started a new period within which to file litigation and seek injunction relief, the court dismissed the argument, stating that, since the same filings were being released in DVD, "[i]t would be incongruous indeed to hold . . . that [the] claim for infringement on a re-release survives, despite the dismissal for laches of the same claim regarding the original work. This exception would effectively swallow the rule of laches, and render it a spineless defense."[106]

The court also observed that "laches typically does not bar prospective injunctive relief" and that "[t]his principle, although generally sound, does

104. *Id*. at 950.
105. *Id*. at 952–55.
106. *Id*. at 953.

not apply where, as here, the feared future infringements are subject to the same prejudice that bars retrospective relief."[107]

D.O. Haynes & Co. v. Druggists' Circular[108] presents an unusual factual setting in that the delay was not pre-litigation, but occurred during the time litigation was pending. In the initial proceedings, a special master granted an interlocutory decree directed to the defendant for an accounting after finding that the defendant had infringed plaintiff's directory for a list of chemicals and remedies. After the nine-year delay, a special master at the request of the plaintiff issued a subpoena to defendant to appear for the taking of further testimony. It then appealed from the "decree for infringement of copyright." The appellate court reversed the judgment for infringement and, in a capsulized review of the law as applied to the facts, stated that:

> At bar, no excuse is given for this long delay in proceeding with the hearing before the master. It is just such delays which have caused a just complaint against the administration of justice. It should not exist, particularly in equity cases. We hold that the appellee has been guilty of such laches in the prosecution of the proceedings before the master as to bar its right to a recovery of money damage. The costs and fee of the master will be imposed on appellee.[109]

Hoste v. Radio Corporation of America[110] presents a fact situation involving both the copyright statute of limitations and the defense of laches. The plaintiff alleged that "I'm Yours," a song in Elvis Presley's repertoire, infringed the copyright of her song "As Long as I Have You," which was registered and renewed as an unpublished composition. The district court held that plaintiff's claim for damages, which accrued more than two years preceding the filing of the complaint, was barred by 17 U.S.C. § 507(b).[111] That portion of the judgment was affirmed by the Sixth Circuit.[112] Turning to the defense of laches, the district court held that recovery of damages for the period subsequent to March 9, 1975, was barred by laches, and granted a defense summary judgment.[113] The Court of Appeals reversed, the defendants having filed no affidavits to support their motion for summary judgment based on the laches defense. The Court of Appeals in searching for a rationale for the grant of summary judgment, observed that the lower court had apparently determined that prejudice to the defendants could be presumed based solely on an

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107. *Id.* at 959.
108. 32 F.2d 215 (2d Cir. 1929).
109. *Id.* at 218.
110. 654 F.2d 11 (6th Cir. 1981).
111. *Id.* at 11.
112. *Id.*
113. *Id.* To put this holding in context, plaintiff's complaint was filed on March 9, 1978.

inordinate delay in bringing the action. In reversing the summary judgment, the court stated:

> The complaint raised material issues of fact as to whether the delay in bringing suit was unreasonable and whether the defendants were prejudiced by the delay. Any presumption of injury to the defendants would merely shift the burden to the plaintiff to show absence of prejudice; it would not be a proper basis for summary judgment.[114]

Laches, however, being an equitable doctrine, is highly dependent on specific facts that can tip the balance one way or another for the court in making its decision. For example, in *Lottie Joplin Thomas Trust v. Crown Publishers, Inc.*,[115] the district court awarded a successor-in-interest to Scott Joplin's widow the catalog of compositions.[116] The district court rejected defendant's laches defense that plaintiff's delay in filing the instant action should bar her from enforcing any of her copyright claims to the Joplin works. In denying the defense of laches, the court's reasons were (1) "mere passage of time is insufficient to establish laches as a bar to suit," absent prejudice to the defendants, and (2) the delay was not unreasonable because Scott Joplin's works, especially the opera *Treemonisha*, were virtually unknown until his piano rag "The Entertainer" was used in the Academy-Award-winning picture *The Sting* with Robert Redford and Paul Newman, which revived interest in his works.[117] The court injected the notion of economic determinism when weighing the timing and necessity for litigation when the judges, in bolstering their holding, observed that the lawyers for the Joplin Trust could have reasonably concluded that, prior to the revived interest in the Joplin works, "enforcement of the copyright was not worth the cost of litigation, especially because no infringing phonograph record was on the market."[118]

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114. *Id*. at 12.
115. 456 F. Supp. 531, 534 (S.D.N.Y. 1977), *aff'd*, 592 F.2d 651 (2d Cir. 1978).
116. *See* Chapter 6—*The Importance of the Expert: The Apportionment Expert*, in which the facts of this case are discussed.
117. 456 F. Supp. at 534.
118. *Id*. *See* Boothroyd Dewhurst, Inc. v. Poli, 783 F. Supp. 670 (D. Mass. 1991). In *Boothroyd*, the district court, in ruling on cross-motions for summary judgment, granted plaintiff's motion and rejected the defense's laches arguments. In so doing, the court gave the following rationale, based on economic considerations: "Defendant's alleged infringing activities were, from plaintiff's perspective, minimal if annoying, and plaintiff might reasonably have judged that it was not worth the cost of bringing suit. . . . Viewing the record in the light most favorable to plaintiff, defendant's infringing activities escalated, and for the first time presented a commercial threat, when he agreed to license his [engineering research] methodology to [a third party company]. In sum, on this record, the Court is not convinced that plaintiff's delay in bringing suit was unreasonable." *Id*. at 680–81 (citations omitted). *See also* Roulo v. Russ Berrie & Co., Inc., 886 F.2d 931, 942 (7th Cir. 1989) (where the court observed that "[a] two

3. Estoppel

Although pleading and proof to establish the equitable defenses of laches and estoppel share the common element of a lengthy lapse of time, the elements constituting each of these defenses are different. To successfully plead and prove laches a defendant in a copyright infringement must also show that (1) the copyright proprietor's delay in asserting its rights in a timely fashion was inexcusable and unreasonable and (2) the alleged infringer was materially prejudiced by the delay.[119] In asserting the defense of equitable estoppel, however, the court in *Hampton v. Paramount Pictures Corporation* set forth a restatement of the following four elements: "(1) The party to be estopped must know the facts; (2) he must intend that his conduct shall be acted on or must so act that the party asserting the estoppel has a right to believe it is so intended; (3) the latter must be ignorant of the true facts; and (4) he must rely on the former's conduct to his injury."[120]

The issues addressed by the court in the *Hampton* case involved the copyright to the silent motion picture *The Covered Wagon* (the "Film") of which Paramount was the successor copyright proprietor. Prior to Paramount's acquiring the copyright in and to the Film, its predecessor-in-interest entered into a written license agreement with Kodascope under the terms of which Kodascope was granted the rights to replicate 16mm prints of the Film for *non-theatrical* distribution.[121] In February 1938, Hampton purchased a 16mm print of the Film from Kodascope, and in 1942 built a building known as the Silent Movie Theatre for exhibiting 16mm silent pictures. The print he purchased bore the Paramount copyright notice on the runner or leader film preceding the start of the motion picture. Shortly after building the Silent Movie Theatre, Hampton began exhibiting the Film and other "silents." Between March 1942 and April 1955, the Film was exhibited nineteen times at the Silent Movie Theatre before paying audiences. After being told to cease and desist from further commercial showings of the film, Hampton exhibited the picture commercially for the remainder of the week in April 1955. Litigation followed, in which Paramount sought an injunction which was granted by the district court. In addition to his claim that the agreement between Paramount and Kodascope was not a license, but rather an assignment, Hampton claimed that Paramount was estopped by its conduct and Hampton's change of position to assert its claim against him because Paramount knew or should have known of the "open use and advertising" of the Film while it, itself, remained

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year delay in filing an action following knowledge of the infringement has rarely been sufficient to constitute laches"); Russell v. Price, 612 F.2d 1123, 1125–26 (9th Cir. 1979).

119. *See Boothroyd Dewhurst, Inc.*, 783 F. Supp at 680.

120. 279 F.2d 100, 104 (9th Cir. 1960).

121. The commercial distribution of films to colleges, private groups and others, as distinguished from distribution to "movie houses."

silent, and thereby "allowed" Hampton to change his position, including building the theatre in 1942 for the sole purpose of commercially exhibiting 16mm silent pictures.[122] The court restated the four elements for proof of estoppel, and in affirming the judgment, the court noted that, in view of the copyright notice that appeared on the screen every time the film was shown at the theater, Paramount had the right to assume that Hampton had notice of Paramount's rights under copyright. With this notice, the court reasoned that Hampton could have inquired of Paramount to ascertain any further facts. The court explained that the "doctrine of equitable estoppel does not erase the duty of care and is not available for the protection of one who has suffered loss solely by reason of his own failure to act or inquire."[123] There was "no holding out by Paramount on which Hampton was entitled to rely" that allowed him to continue showing The Film, because it was not any act or omission of Paramount upon which Hampton had relied, but, rather, it was his own "failure to use the means at hand to ascertain the extent of the [copyright] interest asserted."[124]

Encyclopaedia Britannica Educational Corporation v. Crooks.[125] presented a situation where a public agency and others devoted to the education and welfare of school children found themselves as defendants in a copyright infringement action filed by Encyclopaedia Britannica Educational Corporation and two other profit-making corporations in the business of licensing and selling educational films. The Board of Educational Services of Erie County, New York ("BOCES"), with full knowledge of copyright notices on the films produced by defendants, videotaped complete copies of 126 copyrighted works off the air for use in classrooms in the school district. BOCES's defenses were: (1) the videotaping was a fair use (pursuant to case authority under the 1909 Copyright Act for tapings before January 1, 1978, and under the four factors set forth in Section 107 of the Copyright Act of 1976 for those occurring after that date);[126] (2) that "the plaintiffs' laches in bringing this motion bars their claim for preliminary relief."[127] The court rejected this defense because even though the plaintiffs may have been aware of the practice by some educational institutions to videotape educational films, they had no knowledge of BOCES's actions until December 1976 and could not have sued BOCES until discovery of its practices at that time.[128] The court was equally dismissive of BOCES's argument that there was a custom and practice permitting the videotaping of these works. The court issued an injunction against future copying and, in a

122. *Hampton*, 279 F.2d at 104.
123. *Id.*
124. *Id.* at 105.
125. 447 F. Supp. 243 (W.D.N.Y. 1978).
126. *Id.* at 249–50.
127. *Id.* at 252.
128. *Id.*

Solomonic gesture, permitted the existing videotape library to be exhibited "if BOCES, in cooperation with the school districts, implements a plan to monitor the use of the tapes in the schools and to require their return and erasure within a specified time period."[129] Unlike the factual setting in *Encyclopaedia Britannica*, in which the court enjoined the defendants from future infringing acts, there are situations where the plaintiff's claim will be entirely barred for past and future acts.[130]

In addition to the very real difficulty in proving estoppel in copyright infringement litigation, there is another significant factor that makes the likelihood of success in establishing that defense even more remote: The presence of a copyright notice on motion pictures, in books, on television, on scores and sheet music, and on software, computer games, and other creative works. Even though it may be customary to include laches and estoppel as affirmative defenses, as is the custom in answers to infringement complaints, copyright practitioners should realize that when discovery is initiated, one of the interrogatories will include questions asking that facts supporting these defenses be specifically set forth; counsel should be prepared to respond with facts (if any) supporting these defenses. In reviewing reported authorities, however, it is apparent to the point of being obvious that there are few cases in which these defenses actually apply, and very few in which they prove to be successful.

C. Other Defenses

The defenses of abandonment, innocent intent, misuse of copyright and unclean hands, like seldom-used tools resting in a tool chest, are defenses the copyright practitioner should be aware of, not because circumstances requiring their use occur frequently, but because when the operative facts present the opportunity to mount a viable defense or to mitigate the financial impact of damages on a defendant, counsel will be aware of and implement these defenses for his or her client.

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129. *Id.* at 253. *See also* DeCarlo v. Archie Comic Publ'ns, Inc., 127 F. Supp. 2d 497 (S.D.N.Y. 2001); Archie Comic Publ'ns, Inc. v. DeCarlo, 258 F.Supp. 2d 315 (S.D.N.Y. 2003); Basic Books, Inc. v. Kinko's Graphics Corp., 758 F. Supp. 1522 (S.D.N.Y. 1991).

130. *See* Keane Dealer Servs., Inc. v. Harts, 968 F. Supp. 944 (S.D.N.Y. 1997). In *Keane,* the court, after first observing that estoppel is "a drastic remedy and must be utilized sparingly," *id.* at 948, granted defendants' summary judgment motion where plaintiff permitted defendants to use plaintiff's copyright software and "the evidence clearly supports defendants' reasonable assumption that they were entitled to use [the software] and that they relied on that assumption to their detriment," *id.* The court dismissed the complaint declaring defendants' use of the software non-infringing, thus barring plaintiff from relief on its claims both as to past and future conduct. *Id. See also* Nimmer, *supra* note 53, § 13.07, at 283–84.

1. Abandonment

The facts of the *Lottie Joplin Thomas Trust*[131] case, previously discussed in this chapter and discussed in more depth in a later chapter, tell a story of improper conduct by individuals including Wilbur Sweatman, the first trustee of the plaintiff trust, obviously calculated to strip composer Scott Joplin's widow Lottie Joplin Thomas of copyright ownership in and to the Scott Joplin catalog of works.[132] The trustee first transferred the copyrights to his own company, the Wilbur Sweatman Music Publishing Co. Upon his death, he willed the company to Robert Sweeney, who, in turn, assigned the renewal copyrights to himself and Joseph Abend, one of the defendants. Having failed to persuade the court that the Trust was barred from relief by estoppel and laches, the defendants were equally unsuccessful with the defense of abandonment. In his opinion, District Judge Cannella first provided a concise restatement of law that "[r]elated to the equitable doctrines of estoppel and laches is the claim that the Trust has abandoned any claim it or its successors may have in the copyright. In order to effect an abandonment, the copyright proprietor must manifest by some overt act his intention to surrender his right."[133] In applying the law to the facts at issue, the Court found that "[f]ar from indicating any intent on plaintiff's part to abandon the copyright, the evidence establishes that the Trust, from 1967 to date, asserted its proprietorship, albeit in the less than aggressive manner warranted by the lack of profitability of the protected works. Moreover, this is not a case wherein plaintiff permitted unauthorized and uncopyrighted copies to circulate for a significant period of time. . . . Although other recordings of the instant compositions were introduced into evidence at trial, it was established that neither plaintiff nor defendants knew of these recordings prior to the institution of this lawsuit."[134]

2. Innocent intent

The court in *New Line Cinema Corporation v. Russ Berrie & Company, Inc.*,[135] in addressing this defense, cogently stated that "[a]lthough innocent infringement

131. 456 F. Supp. 531 (S.D.N.Y. 1977). *See* Chapter 6, The Importance of the Expert: *The Apportionment Expert*.

132. As noted above, Scott Joplin's copyrights were to become popular and valuable when they became part of the score for the Academy-Award-winning motion picture *The Sting* in 1973.

133. 456 F. Supp. at 535.

134. *Id.* at 535 (citations omitted). The elements of the abandonment defense do not vary from case to case. For example, as the court observed in *Rohauer v. Killiam Shows, Inc.*, 379 F. Supp. 723, 730 (S.D.N.Y. 1974), *rev'd on other grounds*, 551 F.2d 484 (2d Cir. 1977), *cert. denied*, 431 U.S. 949, 97 S. Ct. 2666, 53 L. Ed. 2d 266 (1977), "[i]t is well recognized, however, that abandonment must be manifested by some overt act indicative of an intent to surrender rights in the copyrighted work and to allow the public to copy it. Mere inaction is not a sufficient manifestation of such intent."

135. 161 F. Supp. 2d 293 (S.D.N.Y. 2001).

does not constitute a defense to liability, it bears directly . . . on the issue of damages."[136] Thus, if a copyright lawyer is representing clients like George Harrison (as in the case discussed, *infra*) or Russ Berrie (the C.E.O. of the defendant corporation bearing his name), who are accused of copying from a copyrighted work either (1) without knowledge that the work is protected by copyright, or (2) that the elements he is using are in the public domain; or (3) who unintentionally copies by using elements buried in his subconscious from music copyrighted by another composer, or (4) who has relied on false and deceptive representations from someone from whom he has obtained the rights to the infringing materials, he or she at the very least, should become be acquainted with the defense of innocent intent.

In the *New Line Cinema/Russ Berrie* litigation, the defendant, a prominent toy distributor, acquired from a Taiwanese manufacturer the "Ghostly Gasher," a glove that appeared to be very similar to the "Freddy Glove," which is a toy replica of the glove with razor-sharp knives protruding from the fingers worn by the sinister protagonist Freddy Krueger of the *Nightmare on Elm Street* motion pictures and television series when he slashes his victims to death. New Line Cinema claimed that Berrie's "Ghostly Gasher" glove infringed its copyright in and to the "Freddy Glove." The defendants stipulated that the two gloves were substantially similar, but that the "Freddy Glove" was not protected by copyright. The court held the defendants liable for copyright infringement, but found that the defendants did not have "any awareness, belief or intention to infringe the New Line rights" and awarded the defendants' profits to New Line but declined to use its discretion to increase the damage award as requested by New Line.[137]

In the protracted history of the litigation involving George Harrison and his song "My Sweet Lord," much insight can be gained as to the hazards of composers who live in a world where music is literally in the air. Prior to composing "My Sweet Lord," George Harrison had heard "He's So Fine," a hit song composed by Ronald Mack and recorded by a popular singing group. "He's So Fine," in the words of Federal District Judge Owen, is a "catchy tune consisting essentially of four repetitions of a very short basic musical phrase" which was used with another short musical phrase to form a "highly unique pattern."[138] George Harrison, in composing "My Sweet Lord," used the same motifs and the same harmony as used by Mack in "He's So Fine." Harrison met with his group (not The Beatles) and by starting with basic chords and exchanging thoughts and advice with his collaborators, created the final version of "My Sweet Lord." The judge, a musician and composer, concluded that "the composer,

136. *Id.* at 302.

137. *Id.* at 302.

138. Bright Tunes Music Corp. v. Harrisongs Music, Ltd., 420 F. Supp. 177, 178 (S.D.N.Y. 1976), *aff'd sub nom.*, ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1983).

in seeking musical materials to clothe his thoughts, was working with various possibilities . . . and . . . [b]ecause his subconscious knew it already had worked in a song his conscious mind did not remember . . . [he], . . . [h]aving arrived at this pleasing combination of sounds, the recording was made . . . I do not believe he did so deliberately. Nevertheless, it is clear that *My Sweet Lord* is the very same song as *He's So Fine* with different words, and Harrison had access to *He's So Fine*."[139] The general rule prevailed that Harrison's innocent intent had no effect on liability, but would mitigate damages. However, after almost twenty years of litigation, George Harrison was relieved of the obligation to pay damages in their entirety, not because of his innocent intent, but rather because of the conduct of his former manager (who had acquired the original plaintiff corporation and pursued the claims against his former client, George Harrison), who had breached his fiduciary obligations owed to Harrison, and was thereby foreclosed from collecting any sums from him.[140]

Other situations where an infringer benefits from the defense of not being aware and having no reason to believe that any acts were infringement include the court's discretion to reduce statutory damages awards from $750 to $200 and the special treatment accorded nonprofit organizations and their employees, where the court must remit damages in their entirety if an employee "believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use under § 107 [of the Copyright Act]."[141]

3. Res judicata and Collateral Estoppel

a. The Two Doctrines: Differences and Effects

The doctrines of *res judicata* and collateral estoppel have an intertwined history in the law. The core principal embodied in the formulation of these two defenses is that what has been contested and decided through the judicial process should not be relitigated. These are doctrines of preclusion, the essence of which the United States Supreme Court nicely capsulized in *Cromwell v. Sac*:[142]

> [T]he judgment, if rendered upon the merits, constitutes an absolute bar to a subsequent action. It is a finality to the claim or demand in controversy, concluding parties and those in privity with them, not only as to every matter which

139. *Id.* at 180–81.

140. *See* Chapter 6, *The Importance of the Expert: The Apportionment Expert*, where the award of defendant's profits in this litigation are more fully explored in the Second Circuit case of ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F. 2d 988 (2d Cir. 1983).

141. 17 U.S.C. § 504(c)(2).

142. Cromwell v. County of Sac, 94 U.S. 351, 24 L. Ed. 195 (1876).

> was offered and received to sustain or defeat the claim or demand, but as to any other admissible matter which might have been offered for that purpose.[143]

Not surprisingly, the doctrines of *res judicata* and collateral estoppel apply to copyright actions with the same force and effect as in any other case. As a word of explanation, *res judicata* refers to the doctrine of claim preclusion in which a prior judgment acts as a bar to any further actions on the same claim.[144]

In addition to claim preclusion, the term *res judicata* also is often used to describe issue preclusion, which also is referred to as the doctrine of "collateral estoppel."[145] These doctrines—claim preclusion (or true *res judicata*) and issue preclusion (or collateral estoppel)—actually are quite different: the former prevents a party from suing on a prior claim that has been litigated to final judgment by that party (or parties in privity) and precludes those parties from asserting any theories, claims, causes of action or defenses that could have been asserted in the earlier litigation; and the latter prohibits the relitigation of issues that were actually litigated and necessary for the outcome of the prior litigation, even if the present litigation involves different claims.[146]

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143. *Id.* at 352.

144. *See* 18 James Wm. Moore et al., Moore's Federal Practice § 131.10[1][a] (3d ed. 2007) (explaining the concept of *res judicata* as claim preclusion).

145. *See id.; see also, e.g.*, Rohauer v. Killiam Shows, Inc., 379 F. Supp. 723, 735 (S.D.N.Y. 1974) (in making what it called a "*res judicata*" argument in defense of a copyright infringement claim, defendant failed to understand the distinction between *res judicata* and collateral estoppel), *rev'd on other grounds*, 551 F.2d 484 (2d Cir. 1977); Siegel v. National Periodical Publ'ns, Inc., 364 F. Supp. 1032, 1036–38 (S.D.N.Y. 1973), *aff'd*, 508 F.2d 909 (2d Cir. 1974) (in finding that plaintiffs were estopped from asserting certain rights to the character Superman that they created as the result of an earlier action in which rights to Superman were litigated and adjudged, the court refers several times to "*res judicata*" when discussing this preclusion from relitigating issues, when the court apparently was actually discussing the doctrine of collateral estoppel).

146. *See* Moore et al., *supra* note 144, § 131.10[1][a]; *see also* Lawlor v. National Screen Serv. Corp., 39 U.S 322, 326, 75 S. Ct. 865, 867, 99 L. Ed. 1122 (1954) ("Thus, under the doctrine of *res judicata*, a judgment 'on the merits' in a prior suit involving the same parties or their privies bars a second suit based on the same cause of action. Under the doctrine of collateral estoppel, on the other hand, such a judgment precludes relitigation of issues actually litigated and determined in the prior suit, regardless of whether it was based on the same cause of action as the second suit."); Kamakazi Corp. v. Robbins Music Corp., 534 F. Supp. 69, 80 (S.D.N.Y. 1982) ("The basic requirements for collateral estoppel are: (1) the party against whom collateral estoppel is asserted must have been a party, or in privity with a party, to the prior action; (2) the issues to be collaterally estopped must have been finally determined on the merits; (3) the estoppel issues must have been essential, necessary, and material to the prior action; (4) the estopped issues must have been actually litigated, and the party to be estopped must have had the opportunity to fully and fairly litigate the issues; and (5) the issues decided must be identical to the issues sought to be estopped.")

Obviously, given the right circumstances, a prior copyright action may be *res judicata* in, or have a collateral estoppel effect on, a later copyright action, but litigants have asserted—both successfully and unsuccessfully—the doctrines of *res judicata* and collateral estoppel where one of the cases was a copyright action and the other was one of a variety of different actions. Examples include, among others, a copyright case and a prior state court (noncopyright) action involving the scope of literary rights to a comic book character,[147] a copyright case and a prior arbitration involving contractual rights,[148] an earlier federal copyright action and later state contract action for false representation and breach of warranty,[149] music copyright infringement action and prior state court action for unfair competition,[150] a U.S. copyright infringement action and a prior English judgment for infringement,[151] and a federal action involving rights by a musician to receive royalties for songs he

147. *See* Siegel v. National Periodical Publ'ns, Inc., 364 F. Supp. 1032 (S.D.N.Y. 1973), *aff'd*, 508 F.2d 909 (2d Cir. 1974). In this case, involving the renewal rights under copyright law, the court found for defendants, because the parties were bound by the findings of a prior New York state (noncopyright) action in which rights to Superman, but not copyright renewal rights, were litigated and adjudged. The court held that plaintiffs, the creators of Superman, were precluded from relitigating certain issues underlying the determination of which parties owned the renewal rights. *See id*. at 1035–38. Note that this case was superseded by statute as to the issues regarding the work for hire doctrine.

148. *See* Kamakazi Corp. v. Robbins Music Corp., 534 F. Supp. 69 (S.D.N.Y. 1982). In this copyright infringement case, defendants were estopped from arguing that their acts were authorized by a contract where an arbitrator in a related arbitration had found the contractual rights of defendants had terminated. *See id*. at 80.

149. *See* Kirke La Shelle Co. v. Armstrong, 159 N.Y.S. 363, 173 A.D. 232 (1916) (district court judgment for the author of a story against a play production company that was producing an infringing play). In this state court action by a play production company against the claimed author of a play for, among other things, false representation and breach of warranty in contract, a prior copyright action acted as an estoppel against defendant's claims of authorship. *See* id. at 365–66, 174 A.D. at 234–35.

150. *See* Leo Feist, Inc. v. Song Parodies, Inc., 146 F.2d 400 (2d Cir. 1944) (action for infringement of plaintiff's copyright in certain songs). In a prior New York state unfair competition case brought by the same plaintiffs against the same defendants in connection with the sale of some of the same songs involved in the later copyright infringement action, the judgment resulted in a dismissal of the complaint on the merits. Defendant argued that the previous state court judgment was *res judicata*. *See id*. at 401. The court found *res judicata* was not applicable, because the plaintiffs "cannot be said to have elected to abandon the latter claim merely by bringing the State Court suit" and, in addition, the earlier judgment was based on a "fact unimportant in the copyright action" and there was no "finding on the facts essential to plaintiffs' success in the action here." *Id*.

151. *See* Leo Feist, Inc. v. Debmar Publ'g Co., 232 F. Supp. 623 (E.D. Pa. 1964) (English judgment of infringement was not *res judicata* in United States copyright infringement action, but collateral estoppel was applicable in connection with the finding of fact in the earlier judgment of no copying by defendant).

co-authored and an earlier bankruptcy action in which the same songs were assets of the estate.[152]

i. Prior State Judgments and Actions: Preclusive Effect in Federal Court

Many of the examples of cases that include a party asserting the application of *res judicata* and/or collateral estoppel involved a state court action raises interesting questions today. Indeed, in light of the 1976 Copyright Act's express preemption of state common law copyright claims, it is less likely that a state court judgment could be used to preclude a claim or issue in a copyright case under either of the doctrines of *res judicata* or collateral estoppel.[153] However, because contract enforcement and interpretation are governed by state law, state courts could still adjudicate breach-of-contract cases and other similar cases that involve agreements for copyright interests and rights and, in such cases, state judgments still could be used in later federal actions for preclusive purposes pursuant to the principles of *res judicata* and collateral estoppel.

ii. Res Judicata, Infringement Claims and Anti-Trust Proceedings

In many instances, a copyright dispute also may give rise to an antitrust suit by the alleged infringer. In such a case, to avoid conflicting results, the preclusive effect of the doctrine of collateral estoppel may be particularly important and will depend, in large part, upon whichever judgment(s) issue first from the respective courts. Thus, the court in the Southern District of Ohio, in which an antitrust action was pending while two related copyright actions between the same parties were pending in another jurisdiction, denied a motion to transfer the Ohio case to Minnesota, where the previously filed cases were pending, and held that, " because of the timing of the cases and the availability of collateral estoppel, conflicting results cannot occur" even though the actions were pending simultaneously in different courts.[154] However, *Nimmer On Copyright* weighed in on that court's assurances by noting that "[t]he better view is probably to the contrary."[155]

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152. *See* Cusano v. Klein, 264 F.3d 936 (9th Cir. 2001) (no *res judicata* effect from a bankruptcy court's refusal to re-open prior bankruptcy proceedings where songs and rights at issue in present action were assets in the prior bankruptcy estate).
153. *See* 17 U.S.C. § 301(a) ("all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright . . . are governed exclusively by this title. . . . [and] no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State").
154. Mead Data Ctr., Inc. v. West Publ'g Co., 679 F. Supp. 1455, 1464 (S.D. Ohio 1987).
155. 3 Nimmer, *supra* note 53, § 12.07, at 155–56.

Indeed, if, as the Ohio court proclaimed, the collateral estoppel preclusive effect would prevent conflicting results, then, arguably, the Ohio case should have been transferred to Minnesota pursuant to the motion under consideration. More particularly, if the Minnesota claims would have a collateral estoppel preclusive effect on the Ohio claims, and *vice versa*, as the Ohio court noted, then, under Federal Rule of Civil Procedure 13(a) and pursuant to at least one accepted analysis under that rule, the later-brought Ohio claims would be compulsory counterclaims to those previously brought in Minnesota and, as a result, should have been dismissed so that defendant could bring them as counterclaims in the Minnesota actions.[156] Query whether the fully litigated and determined issues in one of two pending cases between the same parties in different jurisdictions could be found to have a collateral estoppel preclusive effect on the other pending case in a situation where the court in one of the cases denied a motion to transfer (brought so that the actions could be tried together) and/or found that the claims of one were not compulsory counterclaims to the other. In short, the skepticism reflected by *Nimmer On Copyright* certainly is understandable, and the collateral estoppel preclusive effect of issues litigated in one court upon issues litigated in another court, where at least one of the actions is a copyright action, is far from clear-cut.

iii. Copyrighted Works and the Preclusive Effect of Bankruptcy Proceedings

Another area where the preclusive effect is not so clear-cut is where copyrighted works are involved in a bankruptcy proceeding. In such an instance, a debtor must be very cognizant of the effect of the ruling of a bankruptcy court on copyright issues that may be the subject of a later copyright infringement case. For example, in a case that involved royalty-related claims for songs a musician co-authored and performed for the band KISS, the Ninth Circuit found determinative as to the issue of plaintiff's standing the listing of assets by plaintiff on his personal property schedule in a prior bankruptcy proceeding, which included "songrights" to the songs at issue with a value of "unknown" and no claims for royalties listed.[157] The Ninth Circuit found that the listing of "songrights" with "unknown" value was sufficient so that claims for post-petition royalties reverted to plaintiff after plan confirmation, giving plaintiff standing to pursue these post-petition royalties.[158] Claims for royalties

156. *See* Fed. R. Civ. P. 13(a); *see also* Grumman Sys. Support Corp. v. Data Gen. Corp., 125 F.R.D. 160, 163–64 (N.D. Cal. 1988) (in granting copyright owner's motion to dismiss an antitrust action brought in California so that it could be brought as a compulsory counterclaim to a copyright infringement action brought in Massachusetts, the court discussed its disagreement with the analysis and result in Mead Data Central).

157. *See* Cusano v. Klein, 264 F.3d 936 (9th Cir. 2001).

158. *See id*. at 947.

owed prior to the filing of the bankruptcy petition, however, had to be separately scheduled such that plaintiff's failure to include these accrued causes of action in the bankruptcy schedule deprived plaintiff of standing to seek these pre-petition royalties owned.[159] In addition, the Circuit Court rejected any *res judicata* effect from the bankruptcy court's refusal to re-open its prior proceedings.[160]

iv. The Effect of Prior Judgments on a Non-Party

Another recurring issue in collateral estoppel/*res judicata* applications in copyright cases is the effect of a prior judgment on a nonparty. For example, if a copyright was declared invalid in a prior lawsuit, it appears that a different defendant in a later lawsuit with the same plaintiff could raise a collateral estoppel defense despite the fact that this defendant was not a party to the prior action.[161] However, where a copyright was *upheld* in an earlier action involving the same plaintiff, but a different defendant, neither *res judicata* nor collateral estoppel would bar the later defendant from arguing the invalidity of the copyright.[162]

v. Application of the Two Doctrines: Res judicata vs. Collateral Estoppel

It is interesting to note that the reported cases in the copyright arena appear to involve many more instances of collateral estoppel than of *res judicata*. One reason that there is a dearth of successful applications of the doctrine of *res judicata* in copyright cases may be that it is often particularly difficult to ascertain exactly what is the same claim in the two copyright cases at issue.

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159. *See id*.

160. *See id*. at 948. The bankruptcy court had refused to reopen the proceedings and ruled that "all claims based on facts predating Debtor's bankruptcy, including claims for unpaid royalties on pre-petition musical compositions remain assets of the estate, and the Estate is Closed." *Id*. at 944. The Ninth Circuit ruled that there was no *res judicata* effect of the bankruptcy court's decision not to re-open the bankruptcy proceedings: "The only *res judicata* effect of this denial is that the consequences of the prior closing will not be disturbed. Just as the mere reopening of a bankruptcy case is a ministerial act that 'lacks independent legal significance and determines nothing with respect to the merits of the case,' [citation omitted], the mere refusal to reopen a bankruptcy case similarly has no impact on the property of the debtor of the estate." *Id*. at 948.

161. *See, e.g.*, Blonder-Tongue Labs., Inc. v. University of Ill. Found., 402 U.S. 313, 91 S. Ct. 1434, 28 L. Ed. 2d 788 (1971) (in a patent case, court held patentee estopped to assert validity of patent that had been declared invalid in prior suit against different defendant unless patentee demonstrates that he/she/it did not have full and fair opportunity, procedurally, substantively, and evidentially, to litigate the validity of the patent in the prior suit).

162. *See* Bell v. Combined Registry Co., 397 F. Supp. 1241 (N.D. Ill. 1975), *aff'd*, 536 F.2d 164 (7th Cir. 1976), *cert. denied*, 429 U.S. 1001 (1976).

For example, in one case in which the defendant argued for the application of collateral estoppel, the same renewal copyright was alleged to be infringed in the prior action involving the same defendant, but the court ruled that *res judicata* was inapplicable.[163] In the earlier case, in Iowa federal court, the copyright proprietor of the Rudolph Valentino motion picture *The Son of the Sheik* had entered into an agreement with defendant's predecessors-in-interest for assignment of the copyright, but, because the copyright proprietor had died before the initial term of copyright had expired and her statutory heirs had assigned the rights to others, the defendant was later sued for offering for sale and selling prints of the motion picture. In the later case, in New York federal court, the defendant was alleged to have unlawfully authorized the broadcast of the motion picture for television in New York. The New York District Court ruled that, although in both cases "the same renewal copyright is alleged to be infringed," the "acts of infringement complained of are different" and "the Iowa and New York suits are not based on the 'same cause of action.'"[164] Notwithstanding the inapplicability of *res judicata*, the court explained that the doctrine of collateral estoppel would have been "fully applicable if [plaintiff] now sought to prosecute an action in this court based on the acts of infringement alleged in the Iowa action."[165]

Likewise, a federal district court ruled that a prior judgment of infringement in an English court was not *res judicata* in an infringement action brought in the United States, but it could have a collateral estoppel preclusive effect on the later U.S. action.[166] The court explained that the English judgment was not *res judicata*, because "this suit is brought under the United States statute for infringements which occurred in the United States, whereas the English suit was brought under the English statute for different infringements

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163. *See* Rohauer v. Killiam Shows, Inc., 379 F. Supp. 723 (S.D.N.Y. 1974), *rev'd on other grounds*, 551 F.2d 484 (2d Cir. 1977). Note that the Second Circuit case was overruled (on other grounds) by *Stewart v. Abend*, 495 U.S. 207, 110 S. Ct. 1750, 109 L. Ed. 2d 184 (1990), which held that authors of a derivative work that was subject to copyright protection separate from the underlying work could not lawfully continue to exploit the derivative work after the renewal rights for the underlying work have reverted to statutory heirs and been reassigned. The impact of *Stewart v. Abend*, on the other hand, was ultimately limited by statute. *See* 17 U.S.C. § 203(b)(1) ("A derivative work prepared under authority of the grant before its termination may continue to be utilized under the terms of the grant after its termination, but this privilege does not extend to the preparation after the termination of other derivative works covered by the terminated grant.").

164. *Rohauer*, 379 F. Supp. at 736.

165. *Id*. at 736 n.14. The court found that collateral estoppel was inapplicable because the dismissal in the previous action did not involve the actual determination of any issues on their merits: "[Collateral estoppel] precludes relitigation of issues actually litigated and determined in a previous action. In the Iowa action, however, nothing was litigated and hence nothing determined; the action was dismissed because of plaintiff's failure to comply with the court's discovery rulings. Such a dismissal can have no collateral estoppel effect." *Id*. at 736.

166. *See* Leo Feist, Inc. v. Debmar Publ'g Co., 232 F. Supp. 624 (E.D. Pa. 1964).

which occurred in England."[167] However, in ruling that there was no copyright infringement, the court found that collateral estoppel was applicable, because the finding of fact by the English court in the earlier case of no copying by defendant consisted of issues that were essentially the same in the United States federal case: "[T]he English court applied legal principles which, if different at all, are only very slightly different from those which would be applied in an American court."[168]

4. Unclean Hands and Misuse of Copyright

A copyright infringer may assert the defense of copyright misuse in situations in which the copyright owner has "violated a specific legal norm in obtaining, licensing or enforcing its copyright."[169] This defense is similar to, but not as well-established or developed, as the doctrine of patent misuse. Copyright misuse, like the doctrine of patent misuse, "originated in the equitable defense of unclean hands; indeed, courts occasionally use the two terms interchangeably. . . . [However,] the copyright misuse defense is still in its infancy."[170]

Taken together, the opinions *Lasercomb America, Inc. v. Reynolds*[171] and *qad. inc. v. ALN Associates, Inc.*[172] provide a veritable instruction manual for the practitioner in need of an introduction to the copyright misuse defense. With their discussions of patent law principles applicable to copyright law and observations that misuse of copyright is not confined to violations of the antitrust laws, these opinions throw much light on the issues raised by an allegation of misuse. For example, in *Lasercomb*, the plaintiff sued Reynolds for unauthorized copying and marketing of plaintiff's software. Even though there was no question that the defendants had engaged in unauthorized copying, the court affirmed in part and reversed in part the lower court's decision for plaintiff. The misuse alleged by defendants was an attempt by plaintiff in its licensing agreement to foreclose its licensees and the licensee's employees from developing software competitive to plaintiffs for a period of ninety-nine years. By attempting to reach beyond the scope of its protected expression, the effect was to create a monopoly over the idea upon which the software was based. The *Lasercomb* Court did state, however, that the bar to the plaintiff's infringement claim affected its right to sue for infringement only during the

167. *Id.* at 623.
168. *Id.* at 624.
169. 2 Goldstein, *supra* note 101, § 11.6, at 36–37.
170. *Id.* § 11.6, at 40–41.
171. 911 F.2d 970 (4th Cir. 1990).
172. 770 F. Supp. 1261 (N.D. Ill. 1991).

time of continued misuse. As the court observed, "once [plaintiff] has purged itself of the misuse," its right to sue for infringement would be reinstated.[173]

The court in *qad v. ALN Associates* relied heavily on the *Lasercomb* opinion, which remains an important restatement of the misuse defense. Qad alleged in one of its claims that its copyright had been infringed by defendant's copying protectable expression from the plaintiff's computer program. In applying for a preliminary injunction, with the aid of an expert who provided testimony, qad established that its program was protected by copyright and the defendant had copied protected expression. Based on this showing, the court granted a preliminary injunction. Defendant, however, charged the plaintiff with copying of elements from a program authored and copyrighted by Hewlett-Packard, which plaintiff incorporated in its software. When defendant uncovered this information, which was withheld by plaintiff from both it and the court, defendant moved for partial summary judgment which the court granted. In so doing, the court delivered a stinging rebuke to the plaintiff in the following language:

> qad began to misuse its copyright over MFG/PRO when it attempted to extend its rights over material over which it had no copyright: those portions of its software that it copied from HP250. Yet it did not reveal that fact to its adversary or to this Court. Using its weapon of falsehood, qad pursued ALN in this Court—something that it could not have done without the advantage of its copyright.
>
> That copyright misuse extended qad's copyright privilege beyond the scope of the grant and violated the very purpose of a copyright, which is to give incentive for authors to produce. After all, the creation of original writings is inhibited—not promoted—when a possessor of a copyright commits the kind of misuse evident here. This Court should not and will not offer its aid to a copyright holder whose actions run contrary to the purpose of the copyright itself.
>
> Furthermore, qad's present arguments reveal that its presentation at the Hearing was grounded in knowing falsehood. More than a century and a half ago *Pidding v. How*, 8 Simons 477, 480 (V.C.1837) stated:
>
> It is a clear rule, laid down by courts of equity, not to extend their protection to persons whose case is not founded in truth.
>
> And this Court will not extend its protection to qad here.[174]

---

173. *Lasercomb*, 911 F.2d at 979 n.22. *Accord* Practice Mgmt. Info. Corp. v. American Med. Ass'n, 121 F.3d 516 (9th Cir. 1997), *cert. denied*, 522 U.S. 933, 118 S. Ct. 339, 139 L. Ed. 2d 263 (1997).

174. *qad. inc*., 770 F. Supp. at 1270–71. In a footnote, the court also underscored its rationale for upholding the misuse defense when it stated that "[t]hat identical approach was taken in the copyright case of *Stone & McCarrick, Inc. v. Dugan Piano Co*., 220 F. 837, 841 (5th Cir.1915) and was there used to support a fraud-on-the-public theory. If such a generalized fraud were all that were involved here, it might not have served as a defense for ALN (*see* Mitchell Brothers

While copyright misuse is the real defense, many courts still discuss "unclean hands" as a separate and discrete defense. However, it generally has had a low success rate, whether the claim is legal (damages) or equitable (*e.g.* accounting for profits). When addressed as its own defense, courts have stated that, to establish unclean hands, two requisite elements of proof are that the defendant's wrongdoing must be (1) "of serious proportions"[175] and (2) directly relate to the "'merits of the controversy between the parties, but only where the wrongful acts' affect the equitable relations between the parties with respect to the controversy."[176] In order to be successful, the defense of unclean hands should not be immaterial or trivial in nature. It should also be noted that given the equitable nature of the defense of unclean hands, the court must balance equities as between the copyright proprietor and the infringer. In so doing, arguably, the courts will tip the balance against the infringer.

Since factual settings are helpful in understanding equitable defenses and when they may be used, a review of a few reported authorities discussing "unclean hands" as a separate and discrete defense is in order.

The Fourth Circuit in *Tempo Music, Inc. v. Myers*[177] wasted no time in telegraphing its intended holding when it announced at the beginning of its opinion, "[b]ecause the Showmen Four 'Combo' played four popular songs for the enjoyment of patrons of the Gold Leaf Supper Club, Proprietor James D. Myers, found himself mulcted in damages, $250 for the performance of each song, plus an award of $1,000 as counsel fees. To prevent what seems to us manifest injustice, we reverse and remand with instructions to dismiss the complaint."[178] Prior to the performances at the nightclub by The Showmen Four, Myers was solicited by an agent for ASCAP[179] to obtain a license from ASCAP to play musical compositions by its members. Myers asked for a list so that he could avoid infringing ASCAP songs by not playing them at his club,

---

Film Group v. Cinema Adult Theater, 604 F.2d 852, 864 n. 25 (5th Cir.1979)). But in this instance qad directly misused its copyright in the prosecution of *this* case, a misuse that violates the purpose of the copyright itself. That combination of factors fits the copyright misuse doctrine to a T (*id.*)." *Id.* at 1271 n.22. *See also* F.E.L. Publ'ns, Ltd. v. Catholic Bishop of Chicago, 214 U.S.P.Q. 409, 413 n.9 (7th Cir. 1982) (where the court held that "[i]t is copyright misuse to exact a fee for the use of a musical work which is already in the public domain").

175. Saxon v. Blann, 968 F.2d 676, 680 (8th Cir. 1992) (quoting 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 13.09[B], at 13-148–49 (1991)).

176. *Id.* (quoting Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852, 863 (5th Cir. 1979), *cert. denied*, 445 U.S. 917, 100 S. Ct. 1277, 63 L. Ed. 2d 601 (1980)).

177. 407 F.2d 503 (4th Cir. 1969).

178. *Id.* at 504–05.

179. The acronym for American Society of Composers, Authors and Publishers, a performing rights society, which under a federal consent decree monitors, collects and distributes royalties for uses of creative works authored by its members.

but ASCAP never furnished him such a list even though ASCAP, under an Amended Consent Judgment in the Federal District Court for the Southern District of New York, was required to make available its catalog of music for public inspection. Myers knew nothing of this requirement of the consent decree, nor is it likely that most people would. Thus, even though there was a finding of infringement, the Fourth Circuit held that the plaintiffs were estopped to assert their infringement claim and were also barred by "an application of the ancient equitable doctrine of 'unclean hands.'"[180] The members of ASCAP represented by the performing rights society were barred from relief by reason of the conduct of their agent.

The issue has also arisen as to whether obscene or pornographic content in a motion picture could be used as the basis for asserting an unclean hands defense. In *Mitchell Brothers Film Group v. Cinema Adult Theater,*[181] the film in question, the pornographic feature entitled *Behind the Green Door*, had been registered for copyright as a theatrical motion picture. The district court barred relief based upon the unclean hands defense, in that the judge considered the film obscene. The Fifth Circuit reversed, holding that the film was an "original work of authorship" under Section 102 of the Copyright Act[182] and that (1) the plaintiff's misconduct was not directly related to the merits of the controversy between the parties because "the doctrine of unclean hands 'does not purport to search out or deal with the general moral attributes or standing of a litigant,'"[183] and (2) "plaintiffs' alleged wrongful conduct has not changed the equitable relationship between plaintiffs and defendants and has not injured the defendants in any way."[184]

Those familiar with the life of Howard Hughes will not only be aware of his achievements in the disparate world of aviation and motion pictures, but also with his obsession to shield his private life from the public.[185] That obsession was the sole reason he caused litigation to be filed through a corporation formed for that purpose, which case was reviewed by the Second Circuit in *Rosemont Enterprises, Inc. v. Random House, Inc*.[186] Simply stated, in June 1965, when Hughes learned that Random House was about to publish his biography, based on research and some quotations in *Look* magazine articles, Gregson Bautzer, his California lawyer, advised Bennett Cerf, the C.E.O. of Random House, that Hughes opposed publication of the biography, and that if it decided to publish the book, Hughes with his great resources "would

180. 407 F.2d at 507.
181. 604 F.2d 852 (5th Cir. 1979).
182. *Id.* at 855–57.
183. *Id.* at 863 (quoting NLRB v. Fickett-Brown Mfg. Co., 140 F.2d 883, 884 (5th Cir. 1944)).
184. *Id.*
185. Knowledge of Howard Hughes's life may be garnered from newspapers, books, and the company he founded; or from the 2005 bio-pic, *The Aviator*, directed by Martin Scorsese.
186. 366 F.2d 303 (2d Cir. 1966).

cause endless trouble."[187] The following events occurred after that conversation: (1) on July 2, 1965, Hughes in a written agreement granted Rosemont the sole and exclusive right to publish his life story; (2) on September 16, 1965, Rosemont was incorporated, the sole shareholders being close business associates of Hughes and his New York lawyer; (3) on September 27, 1965, the agreement between Hughes and Rosemont dated July 2, 1965 (when Rosemont had not even been incorporated), was acknowledged; (4) on September 29, 1965, Hughes's New York lawyer, Chester Davis, advised Cerf of the Hughes-Rosemont agreement; (5) after Gardner Cowles, the publisher of *Look Magazine*, refused his request to sue Random House for copyright infringement, Cowles Publications granted Rosemont the rights to a series of articles about Hughes, which appeared in *Look Magazine* in 1964; and (6) on February 11, 1966, Rosemont commenced litigation and obtained a preliminary injunction against the publication of the Random House Hughes biography. The Second Circuit reversed, principally on fair use grounds and failure to apply equitable requirements in granting the injunctions. In so doing the court noted that "'[t]he interference of the court by injunction being founded on pure equitable principles, a man who comes to the court must be able to show that his own conduct in the transaction has been consistent with equity.'"[188] The court did not rule on this issue because it did not have sufficient facts at that stage of the proceedings to do so. The concurring opinion, in which two out of the three judges joined, however, was quite specific when they stated that "[t]he plaintiff's conduct in this transaction was not consistent with the equity it seeks; it came into court with unclean hands. This, of course, was sufficient reason why the district court should not have granted the preliminary injunction."[189]

In *Saxon v. Blann*,[190] the plaintiff, who was an author of books on survivalism and weaponry, sued a husband and wife (collectively "Blann") for infringing copyrights on paperback books because they printed copies in excess of the number he authorized them to publish and sell. One of his books, *The Poor Man's James Bond*, was published without a copyright notice under the 1909 Copyright Act, the effect of which was to dedicate it to the public domain. In order to destroy the commercial value of *The Poor Man's James Bond*, Saxon wrote and published the *New Improved Poor Man's James Bond*. Saxon's claims in substance were for copyright infringement by reproducing and distributing his books without authorization, including the *New Improved Poor Man's James Bond* and the Blanns' failure to include the copyright notice, for which

187. *Id.* at 312.
188. *Id.* at 305 (quoting T.B. Harms & Francis, Day & Hunter v. Stern, 231 F. 645, 649 (2d Cir. 1916)).
189. *Id.* at 313 (Lumbard, C.J., concurring).
190. 968 F.2d 676 (8th Cir. 1992).

he sought the Blanns' profits. The court ruled in Saxon's favor on his infringement claim based on the missing copyright notice, but found that Saxon could not enforce his copyright on the *New Improved Poor Man's James Bond* because of his unclean hands in publishing that work for the purpose of destroying the commercial value of the original *Poor Man's James Bond*.[191]

In the early to mid-twentieth century, Sigmund Romberg was a successful and beloved composer of operettas from which many of their individual songs achieved great popularity.[192] Romberg's romantic waltzes and ballads, which were easy to remember and hum when leaving the theater, were a bridge between Viennese operetta and the American musical. In his dealings with Stern & Co., however, Romberg revealed another persona: after entering into a written contract granting publishing rights to Stern & Co. to all his compositions for a period of five years in consideration of receiving royalties, Romberg repudiated the agreement and entered into a contract transferring the same publishing rights to the plaintiffs. In litigation in a New York state court, an action by Stern & Co. to enforce its contract with Romberg was dismissed, the court finding that the contract lacked mutuality and was inequitable. Based upon that ruling, the federal district court issued a preliminary injunction against Stern & Co. *et al*. Upon a rehearing, it was demonstrated that the record from the state proceedings was misrepresented to the federal court. As a result, the Second Circuit denied injunctive relief, holding that the plaintiffs' successors-in-interest to Romberg's purported interests were foreclosed from relief because "with his hands thus unclean he has no standing in a court of equity in asking an injunction to restrain these defendants from exercising a right which he bound himself to give exclusively to them. As the plaintiffs stand in his shoes we must decline to grant them what we could not grant to Romberg."[193]

In *Cherry River Music Company v. Simitar Entertainment, Inc.,*[194] the parties were both engaged in the business of manufacturing, distributing, and selling recorded music performances to the public. At issue were the rights to distribute compact discs featuring future "entrance themes," the copyrights to which were held by Titan Sports, Inc., the owner of the World Wrestling Foundation ("WWF"). WWF and Cherry River, a music publisher, released a CD entitled *WWF—The Music, Volume 3,* containing the entrance themes for famous wrestlers. Simitar, apparently on its maiden voyage in the CD recording

191. *Id*. at 680.

192. Among Romberg's operettas were *The Student Prince*, *Serenade*, *The Desert Song,* and *The New Moon*. Individual numbers from those shows which achieved popularity included *Deep in My Heart, Dear, Student's Marching Song, The Desert Song, One Alone,* and *When I Grow Too Old to Dream*. His life was the subject of a biopic chronicled in the 1942 motion picture *Deep in My Heart*.

193. T. B. Harms & Francis, Day & Hunter v. Stern, 231 F. 645, 649 (2d Cir. 1916).

194. 38 F. Supp. 2d 310 (S.D.N.Y. 1999).

and distribution business, released its CD called *Slammin' Wrestling Hits*, containing fifteen of the plaintiffs' copyrighted works for the obvious reason of capitalizing on the popularity of WWF wrestlers and the successful track record of plaintiff WWF's CDs. After receiving a cease and desist letter from plaintiffs, Simitar attempted to obtain a license from Cherry River, arguing that it was entitled to a compulsory license pursuant to Section 15 of the Copyright Act, even though it had not complied with the statutory requirements for such a license. Negotiations were interrupted by the illness of Michael Connelly, plaintiff's negotiator. Connelly did not further respond to Simitar's request for a license, nor did Simitar contact Connelly again. Simitar nevertheless continued shipping CDs and did not cease those activities in the face of further cease and desist letters. In further discussions between Leeanne Lawlor, a paralegal in charge of trademarks and copyrights at Titan, and representatives of Simitar, the rhetoric both in telephone conversations and in writings grew more confrontational and even hostile. In a telephone conversation with Anthony Darrow of Simitar, Lawlor informed him that no license would be granted to Simitar, called him "cocky" and advised him that "Titan would be watching and Simitar would be foreclosed from obtaining a compulsory license if it did not follow the law 'to a tee.'"[195] In a final sortie, Lawlor told Darrow that Titan "would own" Simitar "if it did not follow the law."[196] Based upon these comments and the delay by plaintiffs in responding to the request for a license, Simitar asserted that plaintiffs were foreclosed from relief by reason of its unclean hands.

Even after litigation had commenced seeking preliminary injunctive relief, both prohibitory (to enjoin further distribution of *Slammin' Wrestling Hits*) and mandatory (recall of all recordings previously delivered to distributors), in response to plaintiffs' application for preliminary injunction, defendants asserted the defense of estoppel and unclean hands. With respect to their defense of unclean hands, the defendants alleged that "Simitar relied on actions by plaintiffs that led it to believe that negotiated licenses would be forthcoming and therefore allowed the time within which it could have obtained compulsory licenses on at least eight of the Compositions to expire without taking the necessary steps."[197] The court in balancing the equities as between the parties rejected the unclean hands defense and issued both a prohibitory and mandatory preliminary injunction.

195. *Id.* at 315.
196. *Id.*
197. *Id.* at 317.

VII. Lack of Jurisdiction: Extraterritorial Acts

Extraterritorial acts of infringement do not violate the copyright laws of the United States simply because those laws do not prohibit extraterritorial infringements. In *Subafilms, Ltd., v. MGM-Pathe Communications Company*,[198] the court held that even if a defendant has authorized an extraterritorial infringement, he or she cannot be held liable as a contributory infringer for the extraterritorial acts.[199] In *Los Angeles News Service v. Reuters Television International, Ltd*,[200] the district court, relying on *Subafilms*, granted partial summary judgment for defendants on infringement claims based upon copying video footage of the Los Angeles riots (the Reginald Denny beating) and distributing it outside the United States (as distinguished from those claims arising from distribution within the United States). Specifically, the court held that "Defendants are not liable under the Copyright Act for damages arising extraterritorially."[201]

VIII. Conclusion: The Lawyer's Mission Redux

This brief overview of United States copyright law should provide a starting point for the practitioner who is called upon to represent either a plaintiff who believes that his or her protected expression has been copied or a defendant who contends that he has used those ideas, *scènes à faire,* and other unprotectables available to all creators and that to deprive him of that use would be violative of virtually sacred principles embodied in the U.S. Constitution. For the lawyer, it is rewarding work, not only for the financial benefits, but also for the exciting intellectual challenge it provides us.

198. 24 F.3d 1088 (9th Cir. 1994).
199. *Id.* at 1091.
200. 942 F. Supp. 1265 (C.D. Cal. 1996), *aff'd in part and rev'd in part*, 149 F.3d 987 (9th Cir. 1998), *cert. denied*, 525 U.S. 1141, 119 S. Ct. 1032, 143 L. Ed. 2d 41 (1999). *See also* Los Angeles News Serv. v. Reuters Television Int'l. Ltd., 340 F.3d 926 (9th Cir. 2003) regarding damages.
201. *Los Angeles News Serv*., 942 F. Supp. at 1269.

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Part One: Monetary Relief

A remedy is anything a court can do for a litigant who has been wronged or is about to be wronged. The two most common remedies are judgments that plaintiffs are entitled to collect sums of money from defendants and orders to defendants to refrain from their wrongful conduct or to undo its consequences. The court decides whether the litigant has been wronged under the substantive law; it conducts its inquiry in accordance with the procedural law. The law of remedies falls somewhere between substance and procedure, distinct from both but overlapping with both.

Douglas Laycock, *Modern American Remedies*[1]

I. Actual Damages and Profits

Among the objectives of the 1976 Copyright Act's providing for monetary relief were to (1) codify decisional precedents regarding damages and profits, and (2) clarify and eliminate conflicting opinions rendered by the federal courts regarding the interaction between awards where both damages and profits are at issue.[2] The first sentence of Section 504(b) of the Copyright Act, without further explanation, treats damages and profits as two different types of monetary recovery and then seemingly conflates profits with "damages" when it provides that the copyright owner is entitled to recover both damages and profits when *profits* attributable to the infringement are not taken into account in computing damages. When, however, profits represent the whole

1. Douglas Laycock, Modern American Remedies 1 (3d ed. 2002).
2. Section 504 of the Copyright Act, 17 U.S.C. § 504, is entitled, "Remedies for Infringement: Damages and Profits." The full text of 504(a) and (b) provides:
   (a) In General.—Except as otherwise provided by this title, an infringer of copyright is liable for either—
      (1) the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (b); or
      (2) statutory damages, as provided by subsection (c).
   (b) Actual Damages and Profits.—The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work.

of plaintiffs' damages, the plaintiff cannot recover both.[3] The legislative history provides a starting point in understanding how one category of profits becomes plaintiff's damages while another retains its status as "profits." The House of Representatives report rendered before passage of the 1976 Act provides the following commentary:

> Damages are awarded to compensate the copyright owner for losses from the infringement, and profits are awarded to prevent the infringer from unfairly benefiting from a wrongful act. Where the defendant's profits are nothing more than a measure of the damages suffered by the copyright owner, it would be inappropriate to award damages and profits cumulatively, since in effect they amount to the same thing. However, in cases where the copyright owner has suffered damages not reflected in the infringer's profits, or where there have been profits attributable to the copyrighted work but not used as a measure of damages, subsection (b) authorizes the award of both.[4]

What must be understood is that profits, no matter how they are categorized or treated, are still profits: (1) plaintiffs' lost profits have been designated as damages because he or she arguably would have realized such profits absent defendant's infringing conduct, (2) while those profits realized by the defendant are categorized and treated solely as profits. The former type of profits are, as the House Report advises us, to compensate the plaintiff for its loss (therefore damages), while the latter is to force the defendant to disgorge the gains realized by its infringing acts. This is a seemingly simple concept, but perhaps deceptively so, because the federal courts in published opinions have documented their struggles to apply the black letter law to various factual contexts in which damages and profits computations must be addressed. Under the 1909 Copyright Act, confusion arose because Section 101(b) of the 1909 Act clearly provided that actual damages as well as profits realized by the infringer could be recovered. The Committee Report preceding the passage of the 1909 Act in referring to monetary relief for the infringement of patents observed that "the courts have usually construed that to mean that the owner of the patent might have one or the other [referring to damages or profits] whichever was the greater."[5] As a result of this conflict between the statute and the Committee Report some courts awarded damages *or* profits, while others awarded both.[6]

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3. *See* 17 U.S.C. § 504(b).
4. H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 161 (1976).
5. 17 U.S.C. § 101(b) (1909).
6. *See* Sid & Marty Krofft Television Prods., Inc. v. McDonalds Corp., 562 F.2d 1157, 1175–79 (9th Cir. 1977) (where the court held that, if there is a rendering of defendants' profits, then plaintiffs may recover the greater of damages or profits (but not damages and profits), but, if either profits or actual damages or both are determinable, the trial court may, in its discretion, award

Fortunately, the current statute resolves this conflict, making it clear that, with only one exception, plaintiff is entitled to an award of both damages *and* profits. A brief review of these two monetary forms of relief is therefore necessary to understand the interrelationship between them. We turn first to damages.

A. Actual Damages

In seeking guidance to the full meaning behind the term "actual damages" we should remain mindful of legal scholar Benjamin Kaplan's observations on the drafting of the copyright statutes that "the statute, like its predecessors, leaves the development of fundamentals to the judges."[7] The language of Section 504(b) of the Act leaves it to the courts to provide a working definition of the term "actual damages" used in the statute. The term "actual," one might conclude, was employed to distinguish those damages from "statutory damages." The House, in its committee reports, provides additional information to define damages by describing their purpose and how they differ from profits when it states that "[d]amages are awarded to compensate the copyright owner for losses from the infringement, and profits are awarded to prevent the infringer from unfairly benefiting from a wrongful act."[8] The courts, however, have provided definitions when instructing juries and in rendering opinions by both trial and appellate courts as to the nature of damages, the theories upon which awards are based and how they are computed. The basis for an award of damages is injury to the value of the infringed work. Within that context, in establishing injury, there are two basic theories upon which an award may be based: (1) lost sales or revenues; and (2) an imputed license fee for the value of the work infringed.

The courts have clothed the definition of actual damages with varying terminology; the message, however, remains clear, as one court put it that, "[a]lthough the Act itself does not define what constitutes actual damages, the primary measure of recovery is the extent to which the market value of the copyrighted work at the time of the infringement has been injured or destroyed

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statutory "in lieu" damages; however, if neither profits nor actual damages is determinable, the award of "in lieu" damages is mandatory, but the amount is discretionary) (Sneed, J., concurring); Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354, 376–77 (9th Cir. 1947) (awarding damages, but not profits). *See also* Lottie Joplin Thomas Trust v. Crown Publishers, Inc., 592 F.2d 651, 656–57 (2d Cir. 1978) (affirming the award of both profits and damages); Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc., 772 F.2d 505 (9th Cir. 1985) (affirming district court's ruling that plaintiffs were entitled to damages or profits).

7. Benjamin Kaplan, An Unhurried View of Copyright 40 (1967). At the time Professor Kaplan wrote these words, he was referring to the 1909 Act and its predecessors.
8. H.R. Rep. No. 1476, 94th Congress, 2d Sess., at 161 (1976).

by the infringement."[9] It is the plaintiff's burden to establish the proximate cause between the infringement and lost revenue. The First Circuit in *Data General Corporation v. Grumman Systems Support Corporation* employed such "tort law damage" principles in defining the plaintiff's burden of proof when it observed that "it is useful to borrow familiar tort law principles of causation and damages . . . Thus, the plaintiff should first establish that the infringement was the cause-in-fact of its loss by showing with reasonable probability that, *but for* the defendant's infringement, the plaintiff would not have suffered the loss."[10] It is also to be noted that when the infringer has destroyed the total value of the work, the award of damages will be for the full value of the infringed work.[11]

1. Lost Sales

In those relatively rare circumstances where the infringer charges the same price that the copyright owner charges for sale of the same article it is relatively simple to calculate damages. As Professor Goldstein concludes, "[a]s long as the profits that the copyright owner would have made on these lost sales are identical to the profits that it has actually made on its own sales in this market, the copyright owner's historical profit figure need only be multiplied by the number of lost sales to arrive at its actual damages."[12] A more typical case is one in which the parties' costs of manufacture or sales are different, where each charges different prices for the goods in question, is catering to different segments of the public,[13] and operates at different levels of efficiency.

In *Bucklew v. Hawkins, Ash, Baptie & Co., LLP*,[14] plaintiff had created software specially tailored for local housing authorities applying for grants from the Department of Housing and Urban Development ("HUD"). In order to facilitate the process of completing the HUD forms, Bucklew developed and copyrighted software intended to be used in conjunction with standard

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9. Fitzgerald Publ'g Co., Inc. v. Baylor Publ'g Co., Inc., 807 F.2d 1110, 1118 (2d Cir. 1986). *Accord* In Design v. K-Mart Apparel Corp., 13 F.3d 559, 563 (2d Cir. 1994) (where the court defines actual damages as "typically the reduced market value of the copyrighted work").
10. 36 F.3d 1147, 1170–71 (1st Cir. 1994) (citations omitted) (emphasis added). *See also* Big Seven Music Corp. v. Lennon, 554 F.2d 504, 509 (2d Cir. 1977) ("[D]amages may be recovered only if there is a necessary, immediate and direct causal connection between the wrongdoing and the damages"); PAR Microsystems, Inc. v. Pinnacle Dev. Corp., 995 F. Supp. 658 (N.D. Tex. 1998).
11. *See* Golding v. RKO Pictures, Inc., 35 Cal. 2d 690, 221 P.2d 95 (1950) (following the general rule that when property is lost or destroyed the owner of the property is not limited to presenting expert testimony on these issues, but may also testify to the value of his or her copyrighted work). *See also* Runge v. Lee, 441 F.2d 579, 582–83 (9th Cir. 1971); Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354, 368 (9th Cir. 1947).
12. 2 Paul Goldstein, Goldstein On Copyright § 14.1.1, at 9 (3d ed. 2007).
13. *See id.*
14. 329 F.3d 923 (7th Cir. 2003).

spreadsheet applications such as Lotus 1-2-3 and Excel. The HUD forms required the following information: (1) "specific basic data such as salaries and other categories of proposed expenditure," and (2) "arithmetical transformations of the data," including "adding the numbers in particular cells in the table of basic data."[15] The defendants conceded that the evidence was sufficient to "compel" an inference that they had copied one of plaintiff's forms (No. 52566) to create their own form. In analyzing the plaintiff's and defendants' forms 52566, the court concluded Bucklew's form contained protectable features, including an arbitrary pattern of boldfacing cells; "an output range," which was an intermediate table the defendants would have had no reason to include (and yet did); headings identical to Bucklew's in the intermediate table; and a Swiss font that was not a feature defendants used to develop their software.[16] After the judge dismissed all but the copyright claim the jury returned a verdict for plaintiff for $660,000, which the judge cut down to $395,000. Both sides appealed with Bucklew contesting the dismissal of the non-copyright claims.

In the course of writing the opinion for the Seventh Circuit, Judge Posner observed that it was "irrelevant" that "Bucklew's formatting choices do not reflect a high degree of originality" because when the copyright "is based on work in the public domain, the only 'originality' required for the new work to be copyrightable . . . is enough expressive variation from public-domain or other existing works to enable the new work to be readily distinguished from its predecessors."[17] The opinion also made it clear that only "the first of the four allegedly infringing forms would survive the appeal. The court then discussed the concept of "one-stop shopping" and its importance when it observed that "the award consisted of four items: $100,000 for Bucklew's lost profits; $125,000 for HAB's [an acronym for both defendants] profits from the infringing forms; $70,000 for a savings and time that HAB obtained as a result of the infringement; and $100,000 for profits obtained by HAB on separate products by virtue of its being able to offer its customers 'one-stop shopping,' i.e., a complete line of HUD financial software, including the copied forms."[18] The appellate court affirmed the judgment of infringement as to Form 52566, reversed the jury verdict on the remaining three forms and remanded the case for redetermination of damages as follows: (1) one-stop shopping damages were too speculative because the plaintiff did not present any evidence from which the market value of "one-stop shopping" could be determined; (2) on remand the district court would be required to apportion not between public domain and original protected expression in the forms, but rather between infringing and noninfringing elements in defendants' Form 52566; (3) the

15. *Id*. at 925.
16. *See id*. at 926–27.
17. *Id*. at 929.
18. *Id*. at 931.

court held in substance that plaintiff should not have been able to recover both his lost profits (in effect his damages) and Bucklew's profits because "there is no basis in the law for requiring the infringer to give up more than his gain when it exceeds the copyright owners' loss. Such a requirement would add a punitive as distinct from a restitutionary element to copyright damages,. . . . [b]ut, astonishingly, HAB has failed to complain about double counting, and so it has booted away a winning issue."[19] The court concludes by observing that "[b]esides all these problems with the computation of damages, it will be necessary on remand to apportion damages between the infringing form and what we have determined to be the three noninfringing forms."[20]

In *Stevens Linen, Associates, Inc. v. Mastercraft Corporation*,[21] the plaintiff created and sold designed fabrics, one of which was given the product name "Chestertown." The plaintiff sued its competitor, Mastercraft, for infringing the Chestertown design with two infringing fabrics bearing the names Rio Grande and Grand Canyon. The District Court, after a bench trial, granted a permanent injunction but denied any monetary relief because the damages were too speculative for determination. In its efforts to prove damages, Stevens had presented evidence to support recovery under four different theories: (1) damages for lost profits on all sales of the Rio Grande and Grand Canyon fabrics; (2) evidence offered by Stevens that that (a) twenty-two existing customers of Chestertown had purchased Rio Grande and Grand Canyon; (b) Mastercraft made sales to purchasers to whom Stevens had provided samples; (c) Mastercraft made sales to customers of Stevens from whom Stevens had solicited orders to purchase Chestertown; (3) Stevens's original projection of the volume of its sales of Chestertown; and (4) a comparison of Chestertown sales with Stevens's total sales for the relevant time showing Chestertown's increases in sales compared to Stevens's overall sales during 1979 and the first six months of 1980. After discussing these options, the district court rejected the projection of sales because Stevens offered no proof of the basis for the projections.[22]

The Second Circuit reversed the lower court's denial of damages based on two alternative theories: (1) Stevens could recover lost profits on sales made by Mastercraft to Stevens's existing customers, recognizing in so doing that

19. *Id*. The court also observed in this regard that "[i]f the infringer is a more efficient producer, his gain may exceed the copyright owner's loss. If he is not more efficient, his gain is likely to be less than the copyright owner's loss because competition will tend to force price down to cost, minimizing the infringer's profits but depriving the copyright owner of the supracompetitive return that he enjoyed before he faced competition from the seller of an exact substitute for his product." *Id.*

20. *Id*. at 933.

21. 656 F.2d 11 (2d Cir. 1981).

22. *See id*. at 14. Although the district court did not elaborate on the reason why there was no basis for the projections, one potential answer is that the assumptions on which the projections were based were not valid, and as a result were without support.

each sale made by defendants would not necessarily have been one made by Stevens. In that circumstance the defendant would have the burden of proving that the purchasers of its two fabrics would not have purchased Chestertown from Stevens. (2) The second alternative by which damages could be measured was "that, at the least, Stevens should be able to recover lost profits based on the difference between its actual sales of Chestertown during the period in which it was forced to compete with the infringing fabrics and Stevens' average sales figures for its remaining fabric products."[23] The court concluded its analysis by stating, on remand to the district court, that "[u]nder the first of the two foregoing measures, damages would be awarded in the amount of Stevens's lost profits for additional sales of Chestertown to those of its customers who also purchased the infringing fabrics, less profits on sales which Mastercraft proves that Stevens would not have made. The measure under the alternative theory would be lost profits based upon the difference between Chestertown sales in the period in question and Stevens's average sales of its other fabric products. Having calculated damages according to these two alternative measures, the court should award to Stevens whatever sum proves to be greater."[24]

2. Value of Use of the Copyrighted Work (The Imputed License Fee). The *Deltak/Business Trends/Davis* Trilogy

a. *Deltak, Inc. v. Advanced Systems, Inc.*[25]

Deltak involves one of those fact patterns where the potential for the law school conundrum of "a right without a remedy" was presented to the district court and the Seventh Circuit Court of Appeals. It addresses this question: What can the courts do when (1) the infringer does not realize any profits, (2) the copyright proprietor suffers no damages or the damages are difficult to quantify, and (3) the copyright owner has failed to timely register his work with the copyright office, thereby foreclosing the availability of statutory damages as an *in lieu* remedy? One of the first attempts to answer this question was made in *Deltak* where this factual setting was presented.

Deltak and ASI were among the largest firms in the business of selling textbooks and audio and video tapes to teach data processing and other computer skills to the buyers of their products. Each of their materials were, according to the district court, "highly substitutable for those of the other."[26] Deltak's materials included a video tape, a book, a manual of forms and a

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23. *Id.* at 15.
24. *Id.*
25. 767 F.2d 357 (7th Cir. 1985).
26. *Id.* at 358.

"Task List." The Task List had two columns: one on the left side, which contained a list of data-processing tasks for teaching programmers, and, on the right hand side, a list of those teaching materials that Deltak sold for each such task. Defendant ASI hired consultants to create the infringing document which copied word-for-word the left-hand list of tasks while ASI substituted its own products cross-referenced to the tasks. ASI failed in its marketing campaign and earned no profits as a result of the infringement, and Deltak had not timely registered its material for copyright.

The district court granted an injunction against ASI's further distribution of its materials and later granted Deltak's motion for summary judgment against ASI on liability, which ASI did not contest. At trial, however, the court awarded no damages because Deltak had failed to prove its lost profits. Although the district court stated that it would have awarded statutory damages and attorneys' fees, neither was available because of Deltak's failure to timely register its copyright.[27] Given the circumstances, the Seventh Circuit, relying on a line of cases predating the 1976 Copyright Act, fashioned a "value of use" test because "[e]ach of the copies ASI distributed had a value of use to it equal to the acquisition cost saved by infringement instead of purchase, which ASI was then free to put to other uses."[28] Thus, even though ASI's sales to fifteen customers increased when the infringed materials were exploited, it would be speculative to attribute this to the presence of the Deltak material. Thus, the court reasoned that damages should probably be either $4,925 (representing the profit after deducting production costs of $75 for each kit) or $5,000, the list price for each sale but that the case had to be remanded so that the district court could determine the fair market value.[29] In other words, the appellate court, in referring to the "acquisition costs saved by infringement instead of purchase" was restating the measure of damages as that which a willing buyer would have paid a willing seller for the materials at issue.

b. *Business Trends Analysts, Inc. v. Freedonia Group, Inc.*[30]

Business Trends Analysts' ("BTA") predecessor in interest, Predicasts, Inc. ("Predicasts"), a pioneer in economic and marketing research reports, published a study of the robotics industry which was acquired by BTA. Predicasts also transferred its inventory and licensed the use of its name to BTA. Prior to this transaction, the former president of Predicasts Research Group left and formed Freedonia Group, Inc. which was joined later by three of Predicasts'

27. *See id*. at 359.
28. *Id.* at 361.
29. *See id*. at 363–64.
30. 887 F.2d 399 (2d Cir. 1989).

former employees, T. Kevin Swift, Robert Baumgartner, and Andrea Fetsko-Louie. BTA and Freedonia competed against one another in the same market. Ms. Fetsko-Louie copied a Predicasts study which was marketed at a price of $1,500 per study and later copied in detail from the BTA study which Freedonia sold for $150 for each copy during a two to three month period in order to boost its sales. BTA registered its copyright after Freedonia's study was published and was foreclosed from seeking statutory damages. As a result, BTA was limited to a recovery (if any) of actual damages or Freedonia's profits.

Judge Conboy, the district court judge, approached this issue creatively: He decided that the "drastic price-cutting" to gain market advantage could "inferentially be held to have made non-cash profit which, if quantifiable, can be awarded to the infringed competitor."[31] He held that "[Freedonia] had gained market advantage of 'value of use' . . . in the amount of $1,500, the full list price, less $150 for each copy sold."[32] He multiplied $1,350 ($1,500— $150) by the number of sales made by Freedonia (thirty-seven), thus quantifying damages at $49,950 in market advantage gained by Freedonia which he equated with value of use. To this figure, he added Freedonia's gross profits of $9,745 less Freedonia's expenses ($5,606.65) for a total damage award of $54,028.35.[33] The Second Circuit reversed stating, "[w]e decline to adopt *Deltak's* approach. . . . [Freedonia] no more priced the BTA study and then decided to copy than a purse-snatcher and then decided to forego friendly negotiations. . . . Moreover, the market value of the infringed study seems an anomalous measure of the value of use in the amount of the saved acquisition cost because that market value is in large part based on the good will attributed to the copyright plaintiff's trademark. In both *Deltak* and the instant case, the last thing the infringers wanted to buy and sell was the actual material produced by their competitors under their competitors' name. [¶] We see no room for such a speculative and artificial measure of damages under Section 504(b)."[34]

c. *On Davis v. The Gap, Inc.*:[35] The Second Circuit Has a Change of Heart

In *On Davis v. The Gap*, plaintiff On Davis ("Davis") was "the creator and designer of nonfunctional jewelry worn over the eyes in the manner of eyeglasses."[36] The Gap, Inc. is one of the largest retailers of clothing accessories with a youth-oriented customer base. The Gap, without permission, which it

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31. *Id.* at 402 (quoting Business Trends Analysts, Inc. v. Freedonia Group, Inc., 700 F. Supp. 1213, 1237 (S.D.N.Y. 1988) (internal quotations omitted)).
32. *Id.*
33. *Id.*
34. *Id.* at 405.
35. 246 F.3d 152 (2d Cir. 2001).
36. *Id.* at 156.

did not dispute, used a photograph of a model wearing Davis's copyrighted eyewear in its many stores operating under the "Gap" trademark. The advertising campaign with the model wearing Davis's eyewear was promoted throughout the United States. Davis filed an action for declaratory relief seeking a declaration that his eyewear had been infringed in asking for damages in the amounts of $2,500,000 for unpaid license fees, a percentage of Gap's profits, $10,000,000 in punitive damages and for attorneys' fees. Davis's plight—in common with that of plaintiffs in other authorities discussed in this chapter—was that he had failed to timely register his copyright and therefore was ineligible for awards of statutory damages and attorneys' fees.

The district court granted The Gap's motion for summary judgment on the grounds that (1) awards of statutory damages and attorneys' fees were not available to Davis because of his failure to timely register his copyright, (2) his claims for actual damages and profits were speculative, and (3) Davis was ineligible for punitive damages.[37] In so doing, the district court relied on *Business Trends*, holding that the Second Circuit's decision in that case precluded the award of actual damages to compensate a plaintiff for the defendant's failure to pay for the reasonable value of what the defendant took.[38] The Second Circuit reversed this portion of the district court's grant of summary judgment.[39]

In addressing the question as to whether Davis's evidence was too speculative with respect to a reasonable license fee, the court stated that "[w]hile there was no evidence to support Davis's wildly inflated claim of entitlement to $2.5 million, in our view his evidence did support a much more modest claim of a fair market value for a license to use his design in the ad."[40] In his testimony in opposition to the Gap's summary judgment motion, Davis pointed out that (1) in many instances rock music stars wore his line of eyewear in photographs featured in music publications and (2) that on one occasion he was paid a royalty of $50 for the publication by *Vibe* magazine of a photo of a deceased rock star wearing Davis's eyewear. Based in part on that testimony the court stated that "a jury could reasonably find that Davis established a fair

37. *See id*. at 158.

38. *See id*. at 159–61.

39. *See id*. at 172. The Second Circuit affirmed the grant of summary judgment on the plaintiff's claim for the Gap's profits and for punitive damages; however, the judgment of the district court was vacated and the case remanded for further proceedings on the declaratory relief and actual damages claims under 17 U.S.C. § 504(b). The court stated that *Business Trends* did not foreclose the use of the loss of a reasonable royalty as a measure of "actual damages" under § 504(a) & (b). The court explained that its comments about "actual damages" in *Business Trends* were dicta. Also, the court cautioned that, in that case, it had not laid down an absolute rule. Rather, it had rejected defendant's argument that a "value of use" standard is always impermissible, but found that the proof in that particular case was not adequate to support such an award. *See id*. at 163.

40. *Id*. at 161.

market value of at least $50 as a fee for the use of an image of his copyrighted design. . . . [I]f Davis could show at trial that the Gap used the image in a wider circulation than *Vibe*, that might justify a finding that the market value for the Gap's use of the eyewear was higher than $50. Therefore, to the extent the district court dismissed the case because Davis's evidence of the market value of a license fee was too speculative, we believe this was error."[41]

d. Value of Use or Imputed License Theory: Current Status

Thus, as matters presently stand, the *Deltak* approach to the reasonable or lost license fees theory is used in some circuits, including the Seventh Circuit.[42] Other federal courts, in facing the situation where there are no profits, damages are difficult to prove, and the plaintiff has failed to timely register his work for copyright, are in accord with the holding in *On Davis v. The Gap*.[43] Although the imputed license theory may be clothed in other verbiage, stated in common sense terminology, the basic hypothetical involving a willing buyer and willing seller both define this issue and provide its solution.[44]

B. Profits

Profits, as such, are not defined in Section 504(c)(1) of the Act, nor does the House Report provide any meaningful information, other than the rationale for its inclusion in the statute. The courts undoubtedly look to basic accounting principles for the answer: Since the term "profit" is not defined in the Copyright Act, the word has been assigned its usual meaning, such as excess of return over expenditures realized from the conduct of a business or the gain derived from an investment represented by the difference between its selling price above its cost.[45] Procedurally, Section 504(b) provides the order of proof: (1) To establish the infringer's profits the copyright holder need only

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41. *Id.*
42. *See, e.g.,* McRoberts Software, Inc. v. Media 100, Inc., 329 F.3d 557, 569 (7th Cir. 2003) (jury verdict of $1,200,000 affirmed; instruction to jury that determination to award to be guided by the standard of "the amount a willing buyer would have been reasonably required to pay a willing seller at the time of the infringement for the use of [the source code]").
43. *See On Davis*, 246 F.3d 152.
44. *Cf.* Mackie v. Rieser, 296 F.3d 909 (9th Cir. 2002), *cert. denied*, 537 U.S. 1189, 123 S. Ct. 1259, 154 L. Ed. 2d 1022 (2003) (the Ninth Circuit followed its own precedents in restating this approach). Value at the time of the infringement is to be determined by "what a willing buyer would have been reasonably required to pay to a willing seller for [the copyright owner's] work." Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1174 (9th Cir. 1977).
45. *See, e.g.*, In Design v. K-Mart Apparel Corp., 13 F.3d 559, 563 (2d Cir. 1994).

present proof of the infringer's gross revenues; (2) the burden of proof then shifts to the infringer to prove "his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work."[46] This unadorned language of Section 504(b) of the Act thus leaves it to the courts to provide working definitions of the terms "actual damages" and profits used in the statute. The term "actual," one may conclude, was employed to distinguish those damages from "statutory damages." The House, in its Committee Report, provides additional information for defining damages by describing their purpose and how they differ from profits.[47] The courts, however, have provided definitions as to the value of damages, the theory upon which awards are based and how they are computed.

1. Profits and Generally Accepted Accounting Principles

This definition of profits provided by the Second Circuit in *In Design v. K-Mart Apparel Corporation*.[48] is, in reality, a basic and very broad description based on Generally Accepted Accounting Principles ("GAAP"), which were issued by the Financial Accounting Standards Board under the title "Statement of Financial Accounting Concepts." GAAP standards provide guidance as to what may be included in revenues and expenses. These standards may vary to address the needs of the particular industry in question. Although it may appear obvious, it is essential that a certified public accountant be retained as an expert consultant and witness to address these issues.

2. *Sheldon v. Metro-Goldwyn Pictures Corporation*:[49] a Case Study

The plaintiff, the author of a historical novel, *Dishonored Lady*, sued the defendants for copyright infringement. The infringing motion picture, entitled *Letty Lynton*, featured the performances of popular screen stars and the creative talents of the screenwriter, director, set designer, and others. The case is instructive both for the court's analysis of accounting issues and the apportionment of the infringing from the noninfringing elements of the film. After gross receipts were established (including receipts from outside the United States), the issue of expenses was tried before a special master who made extensive findings. Both parties appealed to the Second Circuit from those findings. The circuit court (opinion by Learned Hand) ruled as follows:[50]

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46. 17 U.S.C. § 504(b).
47. *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 161 (1976).
48. 13 F.3d 559 (2d Cir. 1994).
49. 106 F.2d 45 (2d Cir. 1939), *aff'd*, 309 U.S. 390, 60 S. Ct. 681, 84 L. Ed. 825 (1940).
50. The following is a review and analysis of certain sections of the findings found on pages 51–55 of the opinion, 106 F.2d at 51–55.

a. Share of Profits Paid to Another Company

The master disallowed a credit for profits paid to the Louis B. Mayer Company and its principals—all of whom were powerful forces in the film industry. The appellate court reversed, finding this was a proper credit to the defendants, because the payments were never profits to the defendants, having been paid right away off the top.

b. Distribution Costs

The choice was whether to divide the total of the costs by the number of films distributed by defendants in 1932, or to divide these costs by the infringing film's proportional share of gross receipts. The master chose the former and the appellate court agreed stating that "we cannot see why on any theory the cost of distribution should vary with gross receipts."[51]

c. Inclusion of Profits Earned Outside United States

The issue as to whether profits earned from exhibition of *Letty Lynton* outside the United States were to be included for purpose of the infringement claim was resolved in favor of doing so. The court pointed out that the negatives were made in the United States, and the funds from foreign distribution were remitted to the defendants in the U.S. According to the court, the making of the negatives in this country was a violation of the Copyright Act.

d. Profits Earned By Subsidiaries of Defendants

The court also affirmed the master's finding that profits earned by subsidiaries of one of the defendants must be included in revenues for much the same reasons upon which foreign receipts were included.

e. Overhead: Allocation

The master's allocation of overhead based upon the production costs for *Letty Lynton* and other films of the defendants was upheld by the court. The court, however, disallowed an item of "overhead" which was carried on the books as a deduction for losses incurred before *Letty Lynton* was distributed.

f. Credit Deduction for Taxes

A credit for income taxes paid by defendants was proper.

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51. *Id.* at 52.

g. Deduction for "Idle Time"

A deduction for "idle time"—time by regularly employed personnel waiting for production of *Letty Lynton* to begin. This was the custom and practice of defendants, as it was more economical to employ these assistants by the year. The special master allowed a credit for the idle time of two employees which was affirmed. In effect, it was an item of overhead.

h. Deduction for Defendant's Payment to Trade Associations

Payment to producer and distributor trade associations was affirmed.

i. Deduction of Overhead Allocation

Over plaintiff's objections that no overhead deductions (proportionate or otherwise) should be allowed, the court upheld the master's finding, stating that "[i]n the case at bar the infringing picture was one of over forty made by the defendants, using the same staff and organization, which had to be maintained if the business was to go on at all. Without them no picture could have been produced; they were as much a condition upon the production of the infringing picture as the scenery, or the plaintiffs' play itself."[52]

j. Overhead: "Breakage"

The plaintiff's objection to an overhead allowance for continuities scrapped (*i.e.*, treatments) and completed pictures never exhibited, was rejected, the court commenting that "there is in most industries a certain inevitable wastage, resulting from imperfect industrial technique and the like; and this, being a condition upon all production, is a part of the cost of production. . . . Since therefore the plaintiffs profited by the fact that the defendants had developed this capacity, they must be content to take the breakage, so to say, which was its inevitable incident."[53]

k. Interest Calculation on Overhead Charges

The issue here was whether realty and personal property should both have been appraised to establish a "base" upon which overhead should be calculated. The realty was appraised but the personal property was not, but rather taken at cost less depreciation. Though the court observed that it was inconsistent

52. *Id.* at 54.
53. *Id.*

not to approve both, it also took a pragmatic approach because the amount involved was small. Interest was therefore calculated "by assuming that the infringing picture used that portion of the whole plant which its cost of production bore to the cost of production of all pictures made that year, than to attempt any allocation of buildings and other property according to their actual use for the picture."[54]

C. Indirect Profits

Indirect profits, as distinguished from direct profits which flow directly from the infringement, are those that require a causal link to the infringement before they can be recovered. The language of Section 504(b) provides that "[t]he copyright owner is entitled to recover . . . any profits of the infringer that are attributable to the infringement."[55] In using the words "any profits," Congress drew no distinction between direct and indirect profits. The courts, however, in applying tort principals of proximate cause, have provided a sufficient body of law to apply to this issue. To state the obvious, its application often depends on the business involved in the infringement and the factual situation, which in effect are built into the conduct of those businesses.

In *Frank Music Corporation. v. Metro-Goldwyn-Mayer, Inc.,*[56] involving a musical revue that used songs from plaintiffs' play, the City of Las Vegas, Nevada, was a serendipitously perfect setting provided by a city whose main industry is gambling, with the added inducements of headline entertainers and hit shows.[57] In that case, plaintiff music publisher claimed that MGM had infringed its copyrights to several songs from the Broadway musical *Kismet* by having them performed without authorization in *Hallelujah Hollywood*, a musical revue show presented at the MGM Grand Hotel in Las Vegas. In addition to direct profits, plaintiffs sought recovery of indirect profits from MGM's

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54. *Id.*

55. 17 U.S.C. § 504(b).

56. 772 F.2d 505 (9th Cir. 1985).

57. First, it must be understood that gambling is the chief magnet which attracts millions of people every year to Las Vegas. Many of the other attractions—fine restaurants, free drinks at the gambling areas in hotels, kid-friendly attractions, and posh hotels—are there to provide an ambience of comfort and luxury for gamblers. But star entertainers, hit shows, and championship boxing are there for the sole purpose of attracting additional gamblers to the tables. Acts and shows are booked with a very important objective in mind which requires an answer to the following question: are they the type of entertainer, show or boxing match which will bring the gamblers in? In addressing the issue generally, the court refers to MGM's Annual Report for 1976 which stated that "[t]he hotel and gaming operations of the MGM Grand-Las Vegas continue to be materially enhanced by the popularity of the hotel's entertainment." *Id.* at 517. The author bases these more pointed comments on personal experience and the information conveyed by individuals who represent artists and those who book the attractions in Las Vegas.

earnings from hotel and gaming operations in quantifying the amount of profits attributable to the infringement. The lower court declined to award actual damages, as it was not convinced that the value of plaintiffs' work was diminished as a result of defendants' infringement, and, instead, based its computation of the recovery solely on profits earned on the production of *Hallelujah Hollywood*.

In a case of first impression in the Ninth Circuit, the circuit court held that "under the 1909 Act [the predecessor to the 1976 Act] indirect profits may be recovered."[58] In rebuffing the defendants' claim that *Hallelujah Hollywood* was a profit center, just as their objective was to turn a profit from all their operations, the court stated, "that fact does not detract from the promotional purposes of the show—to draw people to the hotel and the gaming tables. MGM's 1976 annual report states that '[t]he hotel and gaming operations of the MGM Grand-Las Vegas continue to be materially enhanced by the popularity of the hotel's entertainment[, including] '*Hallelujah Hollywood,*' the spectacularly successful production review. . . . ' Given the promotional nature of *Hallelujah Hollywood*, we conclude indirect profits from the hotel and gaming operations, as well as direct profits from the show itself, are recoverable if ascertainable."[59] The court also cautioned that, "[a]t the same time, a court may deny recovery of a defendant's profits if they are only remotely or speculatively attributable to the infringement."[60]

The plaintiff in *Mackie v. Rieser*,[61] was not so fortunate, and for good reason. Mackie was a sculptor who created a popular artwork in Seattle known as "The Dance Steps," a series of foot shapes indicating dance steps to eight different dances, inlaid in the sidewalk in Seattle's Broadway district. An artist retained by the Seattle Symphony photographed The Dance Steps and then put them in a collage which appeared in a Symphony brochure for its series of Pops concerts. Since Mackie failed to timely register his copyright, he was relegated to the other monetary damage for infringement, damages, and profits. Mackie requested both direct profits generated by selling the "infringing collage" and "indirect profits." The indirect profits consisted of the "Pops series revenues generated through the inclusion of the collage in the direct-mail

58. 772 F.2d at 517.

59. *Id.*

60. *Id. See also* 4 Melville b. Nimmer & David Nimmer, Nimmer on Copyright § 14.03[B][2], at 14–45 (2006) ("When an infringer's profits are only remotely and speculatively attributable to the infringement, courts will deny recovery to the copyright owner."); *See also* Estate of Vane v. The Fair, Inc., 849 F.2d 186, 189–90 (5th Cir. 1988) (appellate court affirmed district court's refusal to award indirect profits damages that plaintiff claimed resulted from unauthorized use of advertising materials); MindGames, Inc. v. Western Publ'g Co., Inc., 218 F.3d 652, 658–59 (7th Cir. 2000) (evidence of lost profits was too speculative and properly disallowed by district court).

61. 296 F.3d 909 (9th Cir. 2002).

literature."[62] The district court granted summary judgment for the Seattle Symphony, rejecting Mackie's request for indirect profits. The Ninth Circuit affirmed, stating that these damages were "far too speculative" and that the plaintiff did not "articulate a non-speculative correlation" or causal link between the indirect profits and the infringement.[63]

Cases where the issue before the court involves a demand for indirect profits for unauthorized use through advertising require a recognition of the economics of the advertising business. Advertising agencies represent clients who pay them to create captivating copy for a targeted segment of the public. Advertising is ubiquitous in both broadcast and print media. The advertisements as such are not products that are sold and, as a result, do not generate any profit. The plaintiff in *Mackie* did not succeed because the damages he claimed were too attenuated and speculative. There was no proof of a link between the use of the infringing photographs in the promotional material for the Pops and the revenue generated by the Pops concerts.

In *Cream Records, Inc. v. Jos. Schlitz Brewing Company*,[64] the Ninth Circuit affirmed an award of profits from Schlitz's unauthorized use of the song "Shaft" in a television commercial. In *Cream Records*, the plaintiff also introduced evidence that another advertiser requesting a license for the theme from "Shaft" backed out when the Schlitz commercial aired on television. The jury returned a verdict of $12,000 that was reversed by the Ninth Circuit, which concluded that the award was insufficient. The court explained its remand to the district court as follows:

> The only evidence before the court was that unauthorized use of the Shaft theme music in Schlitz's commercial ended Cream's opportunity to license the music for this purpose. There was no evidence that Schlitz sought, or Cream was willing to grant, a license for use of less than the entire copyrighted work, that a license limited to the portion used in the commercial would have had less value, or that use limited to this portion would have had a less devastating effect upon Cream's opportunity to license to another. Since defendants' unauthorized use destroyed the value of the copyrighted work for this purpose, plaintiff was entitled to recover that value as damages.[65]

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62. *Id.* at 916.
63. *Id.* at 916. *See also* Associated Gen. Contractors of Cal., Inc. v. California State Council of Carpenters, 459 U.S. 519, 542–43, 103 S. Ct. 897, 911, 74 L. Ed. 2d 723 (1983) (the speculative nature of the damages was sufficient ground for affirming a dismissal of an anti-trust action); *Frank Music*, 772 F.2d at 517 (plaintiff's request for indirect profits will be denied "if they are only remotely or speculatively attributable to the infringement.").
64. 754 F.2d 826 (9th Cir. 1985).
65. *Id.* at 827–28.

D. Apportionment of Profits

See Chapter 6, "The Importance of the Expert: The Apportionment Expert."

E. The Prohibition Against Double-Counting: The Courts Speak

In analyzing the opinions of the federal judiciary, the treatment of plaintiffs' lost profits as damages is to prevent double-counting in the process of constructing an accurate and equitable award. Thus, to the extent that damages are comprised of plaintiffs' lost profits, they must be deducted from defendant's profits to avoid double counting, but, as one court has reasoned, "[i]f the infringer is a more efficient producer, his gain may exceed the copyright owner's loss."[66] In such circumstances where plaintiff's damages include or are equivalent to his lost profits, the plaintiff may still recover that amount of defendant's profits that exceeds plaintiff's lost profits.[67]

The factual contexts in which the courts have approached awards of profits and damages are thus essential to a basic understanding of this issue. Fortunately, there are a number of authorities whose facts are varied enough to provide a brief departure from the law-driven issue of infringement to one that is more driven by the operative facts of each case. *Abeshouse v. Ultragraphics, Inc.*[68] is one of those reported cases that, because of its factual setting, presented the appellate court with a platform to analyze many, if not all, of the issues raised by the bar against double-counting in awarding damages and/or profits. In September 1981, Tevin and Matthew Abeshouse secured a copyright on a large poster entitled *The Cube Solution*, which described in great detail the solution to the "Rubik's Cube" puzzle. The Abeshouses, as Amity Products, Ltd., entered into an agreement with defendant Ultragraphics for the latter to become its exclusive North American distributor of *The Cube Solution* poster. The contract, in pertinent part, was for Amity to supply Ultragraphics with the first 10,000 posters at $0.90 per poster and at $0.75 per poster in excess of 10,000. Ultragraphics, by its president, Richard Calio, did not believe Amity could deliver enough posters to meet customer demand. When Calio become concerned that Amity would not be able to fill orders for 20,000 posters, he contacted printer Davidson & McKirdy Co. ("D & M") to print 20,000 poster for Ultragraphics. D & M delivered 21,000 posters and also ordered two "separations" (negatives) for use in replicating the poster for domestic and foreign sales. The posters were slightly

66. Bucklew v. Hawkins, Ash, Baptie & Co., LLP, 329 F.3d 923, 931 (7th Cir. 2003).
67. *See* Montgomery v. Noga, 168 F.3d 1282, 1296 (11th Cir. 1999).
68. 754 F.2d 467 (2d Cir. 1985).

modified, but were substantially the same as the original graphic supplied by Amity. Ultragraphics sold the posters for a wholesale price of $2.00 per unit until its supply ran out. In expanding sales of these posters in the United Kingdom, D & M also provided the two separations, one each, to two English publishing companies in consideration of a $2,500 credit to its account. When the deal with Ultragraphics expired, the Abeshouses entered into an agreement with Ideal Toy Co. to produce and sell the posters.

In September 1982, the plaintiffs sued Ultragraphics, Calio, and D & M for copyright infringement, unfair competition, breach of contract, and unjust enrichment. The jury returned a verdict for plaintiffs awarding them the following: (1) against Ultragraphics and D & M jointly and severally for copyright infringement in the amounts of $55,368 and $2,441.53, respectively; and (2) against Ultragraphics for breach of contract in the amount of $22,513.18. The district court awarded attorneys' fees against only Ultragraphics. Plaintiffs and defendants both appealed.

The Second Circuit, per Chief Judge Feinberg, observed that in light of the current 1976 Copyright Act the court must ensure that (1) the award is not based on undue speculation and (2) "does not entail the double-counting of profits and damages" as prohibited by Section 504(b).[69] Ultragraphics argued, that "the jury engaged in both undue speculation and improper double-counting in finding it liable for $55,368."[70]

The court analyzed the damages/profits award as follows: Since D & M actually delivered 21,500 (rather than 20,000) posters to Ultragraphics, the jury's use of the higher figure was proper and, as a result, Ultragraphics sales at $2.00 per poster equaled $43,000 in gross revenues. Printing costs were $7,932 leaving profits on domestic sales of $35,068 plus a credit for the English separation/negative of $2,500, for a total of $37,268 for infringement of the copyright. The court assumed that the additional amount of $18,100 exceeding the award of profits of $37,268 represented the jury's assessment of the plaintiffs' actual damages. The plaintiffs argued that the higher jury award was for their actual damages of the profits they would have earned by selling 25,000 of their own posters directly to the public for $4.50–$5.50 per poster. The court dismissed this argument because the plaintiffs were bound by an agreement pursuant to which they granted exclusive sales rights for North America to Ultragraphics because this was the same arrangement they had with Ideal Toy after the term of the agreement with Ultragraphics had expired. They also offered no "evidence suggesting they might actually have done business in foreign markets."[71] The plaintiff/appellees did, however, offer evidence of sales they would have made to Ultragraphics if the latter had not

69. *Id.* at 470.
70. *Id.*
71. *Id.* at 471.

entered into its arrangement with D & M rather than purchasing the posters from plaintiffs. Since plaintiffs would have received $0.75 per poster and could print them for $0.22 their damages for lost profits would have been $11,395.[72]

Thus, leaving aside for the moment the issue of joint and several liability, the plaintiffs were entitled to an award of only $48,663 against Ultragraphics, which represented the total of Ultragraphics' profits of $37,268 and plaintiffs' damages of $11,395. The court suggested that a remittitur by the plaintiffs "would therefore seem appropriate. The precise amount of any remittitur, however, cannot be determined without an examination of the extent to which Ultragraphics shares joint liability with D & M."[73]

In addressing the issue of joint and several liability as between Ultragraphics and D & M, the court held that the verdict and judgment holding D & M jointly and severally liable not only for the $2,441.53 damages against it, but also for $55,368 for infringement of copyright was incorrect because holding D & M jointly and severally liable for Ultragraphics' profits was unwarranted in that D & M was an independent contractor and therefore not liable jointly and severally for the $37,268 representing Ultragraphics' profits. The court observed that D & M was not a joint venturer, partner, or in a similar enterprise and was therefore an innocent infringer.[74] After this in-depth exegesis of damages vis-a-vis profits, the court held that the damages awarded against Ultragraphics after remittitur would be plaintiffs' actual damages of $11,395, representing profits plaintiffs would have realized but for the infringement. Of this amount D & M would be jointly and severally liable with Ultragraphics. The court went on to explain that "[w]hile D & M is thus to be jointly liable for the actual damages of appellees, we do not believe that the purposes of the Copyright Act would be served if, in the event appellees seek to recover this entire amount from Ultragraphics, D & M were permitted to escape with no obligation to disgorge its illegal profits of $2,441.53. Consequently, we

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72. The court gave its rationale for legitimacy of this award as follows:

> In charging Ultragraphics with these damages, the jury would not have been engaging in the double-counting forbidden by § 504(b), even though the jury also awarded to appellees Ultragraphics' profits of $37,268. Double-counting may occur when an infringing seller has to disgorge profits on sales that a copyright holder might have made and for which he may therefore claim damages in the form of lost profits. But here, appellees could not have sold their posters domestically to anyone but their exclusive distributor, Ultragraphics, at $0.75 apiece. Appellees could not properly have made the latter sales and therefore cannot claim any lost profits on them. Thus, requiring Ultragraphics to disgorge to appellees its profits on those sales contains no element of double-counting, even though appellees are also recovering damages of $11,395.

Id.

73. *Id*.

74. *See id*. at 472.

hold that D & M must be solely liable for at least $2,441.53 of the $11,395 charged against it and Ultragraphics jointly. In essence, the portion of D & M's liability for which it is jointly liable with Ultragraphics is thus reduced to $8,953.47."[75]

F. Double-Counting and Statutory Damages

In *Sparaco v. Lawler, Matusky, Skelly Engineers LLP*,[76] the issue was whether a request for statutory damages could be granted when the plaintiff had already been compensated for his actual damages. Sparaco, a land surveyor, entered into an agreement with defendant Northern Metropolitan Foundation ("NMF") to prepare a site plan for an assisted-living facility. The agreement provided that Sparaco would retain all rights to the drawings, plans, or other documents ("Documents") prepared by him and, further, that his client's (NMF) use of the Documents was limited to "the purpose for which they [were] prepared unless the parties agree otherwise in a writing and signed instrument and with appropriate compensation to [Sparaco]."[77] Under the terms of the contract NMF also agreed that if it copied, reproduced or adapted the Documents, it would be deemed a material breach of the contract. During construction of the complex, the municipal authorities required NMF to submit an amended site plan. Plaintiff's written proposal to do this work, for a fee of $19,500, was rejected. NMF then hired Lawler, Matusky, Skelly ("LMS") to prepare an amended site plan. Rather than creating a new plan, however, LMS made a digital copy of plaintiff's copyrighted work, which they then revised. Sparaco sued for breach of contract and copyright infringement.

In a previous memorandum opinion, the district court judge had granted a partial summary judgment for Sparaco, establishing liability on the breach of contract claim against NMF with damages to be determined at trial. While NMF's appeal from the summary judgment was pending, Sparaco entered into a settlement agreement with NMF for a payment of $7,000 in consideration of his releasing all claims including those for breach of contract. In a wide-ranging discussion, the court observed that "[p]laintiff was damaged in an amount coextensive with the actual damages he could recover for the infringement of his copyright. Because Sparaco's actual copyright damages and his contract damages are coextensive, settling the one claim eliminated his ability to recover actual damages for the other."[78] The unusual issue in this

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75. *Id. See also* Taylor v. Meirick, 712 F.2d 1112, 1120 (7th Cir. 1983) (discussing damage awards and double counting); Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1172 (9th Cir. 1977).
76. 313 F. Supp. 2d 247 (S.D.N.Y. 2004).
77. *Id.* at 248–49.
78. *Id.* at 252.

litigation, however, was whether the plaintiff could claim statutory damages where plaintiff's actual damages for copyright infringement were co-extensive with damages under another theory of recovery, thereby avoiding the double recovery bar built into Section 504(b) of the Act. The court found that, since Sparaco had already settled his contract claim for his actual damages, he had received everything to which he was entitled under Section 504 of the Act.[79] The court also denied Sparaco's request for an award of attorney's fees.

In *McRoberts Software, Inc. v. Media 100, Inc.*,[80] McRoberts licensed to *Media 100* its *comment/CG* software, which provided character generation capability for users of the Apple Macintosh personal computer. Media 100 hired another company, Vanteon, to translate the *comment/CG* source code from Macintosh to Windows. McRoberts filed an action against Media 100 for copyright infringement (based on exceeding the terms of the license it granted to Media 100), breach of contract, and misappropriation under an Indiana state statute. The jury returned a verdict for McRoberts and awarded copyright infringement damages of $1.2 million for actual damages and $900,000 for lost profits; $300,000 for trade secret misappropriation; and $85,000 for breach of contract. The district court, in ruling on Media 100's motion in the alternative for judgment as a matter of law or a new trial, denied the relief requested with one exception: the court vacated the $300,000 damage award for trade misappropriation because it was, in part, duplicative of the infringement award of $1.2 million.

The Seventh Circuit reinstated the award for misappropriation of trade secrets, and rejected Media 100's contention that the $1.2 million award for actual damages was not supported by the evidence. The circuit court relied on the reinstated *Deltak* rule, observing that "[t]he Copyright Act permits a copyright owner to recover actual damages as a result of the infringing activity and any profits of the infringer resulting from the infringement that are not otherwise taken into account in calculating actual damages. 17 U.S.C. § 504(b). Actual damages are usually determined by the loss in the fair market value of the copyright, measured by the profits lost due to the infringement or by the value of the use of the copyrighted work of the infringer."[81] Adopting the *Deltak* holding, the Seventh Circuit held that the award for $900,000 in lost profits was not duplicative of the $1.2 million actual damages award in

79. Emphasizing her holding, Judge McMahon stated that "[h]e has been fully compensated for his *compensable* harm. In this circumstance, I am hard pressed to see why he should be able to get an additional award—even a *de minimis* award—as 'statutory damages.'" *Id*. at 254 (emphasis in original).

80. 329 F.3d 557 (7th Cir. 2003).

81. *Id*. at 566 (citing Deltak, Inc. v. Advanced Sys., Inc., 767 F.2d 357, 360 (7th Cir. 1985)). *See* Section II, *infra*.

that "[l]ost profit damages serve to make the copyright owner whole in cases where the infringer's gains exceed the owner's losses."[82]

II. Statutory Damages: An Overview

A. Theory and Practice: The Need For Statutory Damages

"Statutory damages," the current term used in Section 504(c), is perhaps better understood by the functional description, "in lieu" damages, the term used in Section 101(b) of the 1909 Act. The "in lieu" in that statute referred, and provided an alternative to, awards of actual damages and profits. The need for such "in lieu" damages arose in part because of the difficulty either in proving damages or in cases where the defendant did not realize any profits, or both. That was one rationale for "in lieu" damages; the other was to discourage potential infringers, who would be encouraged to copy protected works with impunity, especially in those situations where there was an infringement without injury or the infringer earned no profits. Even with these laudable objectives, Section 101(b) of the 1909 Act, with its dense language, proved more than difficult for judges and lawyers to apply.[83] In apparent frustration, one district court judge described Section 101(b) of the 1909 Act as "an ambiguous hodgepodge of improvisations,"[84] while another appellate court, ten years later, complained of the statute's "nearly impenetrable provisions for 'in lieu' damages."[85] For example, some courts held that statutory damages could not be awarded without proof of injury.[86] The Supreme Court, however, disagreed when it held that the "in lieu" damages section of the 1909 Act *must*

82. *Id*. at 568 (citing Taylor v. Meirick, 712 F.2d 1112, 1120 (7th Cir. 1983)).

83. In commenting on the 1976 Act, Professor Paul Goldstein provides an explanation of the public policy underlying statutory damages when he observes that "[t]he rationale commonly given for statutory damages is that, because actual damages are so often difficult to prove, only the promise of a statutory award will induce copyright owners to invest in and enforce their copyrights and only the threat of a statutory award will deter infringers by preventing their unjust enrichment. Under the 1909 Act, courts divided on the implications of this rationale for the relationship between statutory damages, actual damages, and profits." 2 Goldstein, *supra* note 12, § 14.2, at 41.

84. Davis v. E. I. DuPont de Nemours & Co., 249 F. Supp. 329, 331 (S.D.N.Y. 1966).

85. Robert Stigwood Group, Ltd. v. O'Reilly, 530 F.2d 1096, 1101 (2d Cir.) (quoting Benjamin Kaplan, An Unhurried View of Copyright 74 (1967)), *cert. denied,* 429 U.S. 848, 97 S. Ct. 135, 50 L. Ed. 2d 121 (1976).

86. *See, e.g*., Shapiro, Bernstein & Co. v. Bleeker, 224 F. Supp. 595, 596–97 (S.D. Cal. 1963); F. A. Mills, Inc. v. Standard Music Roll Co., 223 F. 849 (D.N.J. 1915), *aff'd*, 241 F. 363 (3d Cir. 1917).

be applied even where there is no proof of injury (i.e., actual damages).[87] Another court held that when the plaintiff proved damages and/or profits, "in lieu" damages could not be awarded,[88] while still another espoused the contrary view that the plaintiff could recover "in lieu" damages even when plaintiff had proved both damages and profits.[89] The statute was also unclear as to who could elect the remedy of statutory damages: Was it the copyright owner, the court, or was the remedy mandated by the law? For example, as late as 1985 (seven years after the effective date of the 1976 Act), the Ninth Circuit Court of Appeals (in applying Section 101(b) of the 1909 Act) stated that "[w]hen injury is proved but neither the infringer's profits nor the copyright holder's actual damages can be ascertained, an award of statutory 'in lieu' damages is *mandatory*. . . . But if either profits or actual damages or both can be ascertained, the trial court has discretion to award statutory damages. . . . Such an award must be in excess of the amount that would have been awarded as profits or actual damages."[90]

Thus, one of Congress's aims in enacting Section 504 was to clarify the confusion engendered by the lack of precision embodied in Section 101(b) of the 1909 Act.[91] Section 504(c) of the 1976 Act leaves no doubt that the plaintiff

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87. *See* Jewell-LaSalle Realty Co. v. Buck, 283 U.S. 202, 208, 51 S. Ct. 407, 409, 75 L. Ed. 978 (1931). *Accord* F. W. Woolworth Co. v. Contemporary Arts, Inc., 344 U.S. 228, 231–32, 73 S. Ct. 222, 276, 224–25, 97 L. Ed. 276 (1952). *See also Robert Stigwood Group, Ltd.,* 530 F.2d at 1101 n.11.

88. *See, e.g.*, F. W. Woolworth Co. v. Contemporary Arts, Inc., 193 F.2d 162, 168 (1st Cir. 1951), *aff'd*, 344 U.S. 228, 73 S. Ct. 222, 97 L. Ed. 276 (1952).

89. *See, e.g.*, Lottie Joplin Thomas Trust v. Crown Publishers, Inc., 592 F.2d 651, 657 (2d Cir. 1978).

90. Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc., 772 F.2d 505, 520 (9th Cir. 1985) (citations omitted) (emphasis added).

91. Section 101(b) is the predecessor to Section 504. The relevant provisions of the 1909 Act as originally enacted provided the following: "If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable:

* * *

(b) . . . To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement, and in proving profits the plaintiff shall be required to prove sales only, and the defendant shall be required to prove every element of cost which he claims, or in lieu of actual damages and profits, such damages as to the court shall appear to be just, and in assessing such damages the court may, in its discretion, allow the amounts as hereinafter stated . . . and in the case of the infringement of an undramatized or nondramatic work by means of motion pictures, where the infringer shall show that he was not aware that he was infringing, and that such infringement could not have been reasonably foreseen, such damages shall not exceed the sum of $100; and in the case of an infringement of a copyrighted dramatic or dramatico-musical work by a maker of motion pictures and his agencies for distribution thereof to exhibitors, where such infringer shows that he was not aware that he was infringing a copyrighted work, and that such infringements could not reasonably have been foreseen, the entire sum of such damages recoverable by the copyright proprietor from such

may, under the terms of the statute, elect statutory damages as the remedy "for all infringements involved in the action, with respect to any one *work*, for which *any one infringer* is liable individually, or for which any two or more infringers are liable jointly and severally."[92] In addition the election of statutory damages as the remedy is within the sole discretion of the copyright owner who may make his or her election "at any time before final judgment is rendered."[93] Because of the Supreme Court's decision in *Feltner v. Columbia Pictures Television, Inc.*,[94] however, the timing provided by Section 504(b)—i.e., "at any time before final judgment"—is from a pragmatic view, now in substantial doubt.[95]

B. Statutory Damages: Parsing the Statute

1. Section 504(c)(1)

In confronting the language chosen by Congress in implementing Section 504(c)(1) of the Act, the full meaning and import of its language may not be apparent to the reader encountering its provisions for the first time. Its language is direct and terse when it provides that:

> (c) Statutory Damages.—
>
> (1) Except as provided by clause (2) of this subsection, the copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any one infringer

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infringing maker and his agencies for the distribution to exhibitors of such infringing motion picture shall not exceed the sum of $5,000 nor be less than $250, and such damages shall in no other case exceed the sum of $5,000 nor be less than the sum of $250, and shall not be regarded as a penalty. But the foregoing exceptions shall not deprive the copyright proprietor of any other remedy given him under this law, nor shall the limitation as to the amount of recovery apply to infringements occurring after the actual notice to a defendant, either by service of process in a suit or other written notice served upon him." 17 U.S.C. § 101(b) (1909) (repealed).

92. 17 U.S.C. § 504(c)(1) (emphasis added).
93. *Id.*
94. 523 U.S. 340, 118 S. Ct. 1279, 140 L. Ed. 2d 438 (1998) (holding that the Seventh Amendment mandates a right to a jury trial on all issues relating to the award of statutory damages under § 504(1) of the Copyright Act).
95. The difficulty presented by *Feltner* is that, once the jury has returned its verdict, the jurors are excused, each to return to their daily lives. As a result, the jury is no longer available, should the plaintiff opt for statutory damages before the court enters judgment on the jury verdict The practical effect of *Feltner* is that the election should be made before the case is submitted to the jury to begin its deliberations, which would fall within the language "at any time before final judgment."

> is liable individually, or for which any two or more infringers are liable jointly and severally, in a sum of not less than $750 or more than $30,000 as the court considers just. For the purposes of this subsection, all the parts of a compilation or derivative work constitute one work.

It shares with other sections of both the 1909 and 1976 Acts the "maddeningly casual" language of the statute, leaving "the development of fundamentals to the judges."[96] This statute, however, is not one that is "imprecise" or "prolix," an observation also made by Professor Kaplan.[97] It is anything but prolix and, in fact, its maddening and casual feature is that it is condensed to the point of being terse. It is a subsection of a statute which, with its surface simplicity, appears to be providing answers, when in fact Congress is only providing a somewhat inexact formula for the courts and counsel to fill in the fundamentals based on each case in which the plaintiff seeks statutory damages.

Among the questions raised by Section 504(c)(2) are those relating to multiple infringements, multiple infringers, and the treatment of constituent parts of a "compilation." These questions are largely fact-driven. For example, if an infringer copies a portion of a copyrighted musical work and uses it in a recording of a CD which sold 150,000 copies, does that constitute 150,000 infringements, one infringement, or some number in between? In construing the last sentence of the statute regarding compilations, does the copyright for the compilation also include individual copyrights for the component parts of the compilation? If the compilation includes individual works created by the compiler, does copyright regulation protect the compilation only as a single work, or does it also protect each constituent part as an independent work separate and apart from the compilation? Does it make a difference if constituent parts of the compilation are works of a person or persons other than the compiler/anthologist?

These and other questions cannot be answered merely by consulting and construing the language of the statute alone. A lawyer or judge must also look to the legislative history (including comments by the House of Representatives) and, of primary importance, the opinions of both federal trial and appellate courts in the federal judiciary.

2. " . . . all infringements involved in the action, with respect to any *one work*."[98]

First, it is to be noted that the word "work" and the concept for which it stands is nowhere defined in the statute. Two definitions considered together provide

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96. Kaplan, *supra* note 7, at 40.
97. *See id*.
98. 17 U.S.C. § 504(c)(1) (emphasis added).

us with a working definition of that all-important word. The first is fanciful when it tells us what does not constitute a work by advising that "separate copyrights are not distinct 'works' unless they can 'live their own copyright life.'"[99] The other definition is commercial in nature, focusing on whether each copyrighted expression "has an independent economic value and is, in itself, viable."[100]

The reason for the emphasis on the word "work" (above) is that some courts, in applying the statute, have focused on the number of infringements of a single work rather than on the number of works that have been infringed. A finding based on the former will result in holding the defendant liable for too many infringements. For example, if the defendant sells 150,000 copies of a single work, under the statute, that will only constitute one infringement, rather than 150,000 infringements. This issue has arisen in a number of different factual contexts, including those involving the following: The number of copies of musical works embodied in sound recordings; the performances of the same theatrical work at different times and places before the same and different audiences; the repeated unauthorized broadcast over television of copyrighted productions of episodic series; the unauthorized publication of the same advertising illustrations by different advertisers in the same newspaper; and the copying by an internet company of copyrighted musical works.

3. " . . . for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally."[101]

A primary source which provides a key to the meaning of the phrase "for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally" is found in the notes of the committee on the judiciary which advises us that "[w]here the infringements of one work were committed by a single infringer acting individually, a single award of statutory damages would be made. Similarly, where the work was infringed by two or more joint tortfeasers, the bill would make them jointly and severally liable for an amount in the $250 to $10,000 range [the statutory range in § 504(c) as originally enacted]."[102] The House Committee rounds out this concept by dealing with that situation where separate infringements for two or

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99. Walt Disney Co. v. Powell, 897 F.2d 565, 569 (D.C. Cir. 1990) (quoting Robert Stigwood Group, Ltd. v. O'Reilly, 530 F.2d 1096, 1105 (2d Cir. 1976), *cert. denied*, 429 U.S. 848, 97 S. Ct. 135, 50 L. Ed. 2d 121 (1976)). *See also* Gamma Audio & Video, Inc. v. Ean-Chea, 11 F.3d 1106, 1116 (1st Cir. 1993).
100. MCA Television Ltd. v. Feltner, 89 F.3d 766 (citing *Gamma*, 11 F.3d at 1116; *Robert Stigwood Group*, 530 F.2d at 1105; *Powell*, 897 F.2d at 568).
101. 17 U.S.C. § 504(c)(1).
102. H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 162, note 4 (1976).

more defendants who are not jointly liable and are joined in the same action. In that set of circumstances "separate awards of statutory damages would be appropriate."[103]

III. Multiple Infringements and Statutory Damages: The Courts Construe the Statute

A. The Predecessor to Section 504(c): The Supreme Court and Section 101(b) of the 1909 Act

In the early Supreme Court case, *L.A. Westermann Company v. Dispatch Printing Company*[104]—decided long before the advent of MP3 recorders, other such devices, and the practice of file-sharing over the internet—the Court considered the issue of multiple infringements in litigation involving six separately copyrighted illustrations. All six were reproduced and published without authorization for advertisers by defendant in its daily newspaper. Each one was published "in a distinct issue [of the paper] and *in all copies*."[105] Five of the illustrations were published once, in separate issues of the paper, while the sixth was infringed on two occasions by different advertisers twenty-six days apart. The district court found that there were seven infringements, but was reversed by the circuit court, which held that there was only one infringement. The Supreme Court reinstated the district court's holding that there were seven infringements and, in so doing, applied what would later be termed the "time" test, and the "heterogeneity" test. The Court observed that, under the 1909 Act, "liability attaches in respect of each copyright that is infringed. Here six were infringed, each covering a different illustration."[106] With respect to the sixth illustration, the Court held that "[t]here was no connection between the two advertisements other than the inclusion of the same illustration in both. Each was by a different advertiser and was published at his instance and for his benefit. The advertisers were not joint, but independent, infringers."[107] Thus, from the standpoint of the time test, twenty-six days separating each publication was sufficient to treat each as a separate infringement. In addition, the two publications were not heterogeneous because the advertisers were different.

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103. *Id.*
104. 249 U.S. 100, 39 S. Ct. 194, 63 L. Ed. 499 (1919).
105. *Id.* at 103, 39 S. Ct. at 194 (emphasis added).
106. *Id.* at 105, 39 S. Ct. at 195.
107. *Id.*

Perhaps the clearest and most often-used definitions were provided later in Robert Stigwood Group Ltd. v. O'Reilly[108] and *Davis v. E. I. DuPont de Nemours & Co.*[109] *and restated in Iowa State University Research Foundation, Inc. v. American Broadcasting Companies, Inc.*:[110]

- The time test—which looks to the proximity and time of repeated infringements in deciding whether to treat them as multiple infringements or as one continuing infringement; and
- The heterogeneity test—which looks to differences between the advertisers, financial arrangements, locales, audiences and other significant variables in determining whether the circumstances surrounding successive infringements are so similar that those infringements should be treated as one continuing infringement or so different that they should be treated as multiple infringements.[111]

B. The *Feltner/Columbia* Trilogy

In a more contemporary setting, the activities of C. Elvin Feltner, Jr. and his corporation Krypton Broadcasting of Birmingham, Inc., are a dramatic true-life scenario of multiple infringements on a grand scale. Unlike the determination of infringement, the issues surrounding the determination of statutory damages are fact-driven. As a result, in order to attain a working understanding of what constitutes a "work," it is advisable for lawyers practicing in the copyright field to immerse themselves in the facts at issue when the court must rule on what constitutes a "work" to determine the number of "multiple" infringements, if any, involved in litigation at issue. While Feltner was also involved in copyright litigation against Columbia Pictures Television, his initial foray in the copyright wars was with MCA Television, Ltd., not Columbia.[112]

In that litigation, MCA sued C. Elvin Feltner and his stations for infringing its television series, including *Kojak* and the *A-Team*, claiming that Feltner had failed to pay license fees for these series. MCA elected statutory damages as its remedy. MCA claimed 900 separate acts of copyright infringement of its television series. The district court found for MCA, awarded $10,000 for each

108. 530 F.2d 1096, 1102–03 (2d Cir.), *cert. denied*, 429 U.S. 848, 97 S. Ct. 135, 50 L.Ed. 2d 121 (1976).
109. 249 F. Supp. 329, 333–34 (S.D.N.Y. 1966).
110. 475 F. Supp. 78, 81–82 (S.D.N.Y. 1979).
111. See *Iowa State Univ. Research Found.*, 475 F. Supp. at 81–82; *see also Robert Stigwood Group*, 530 F.2d at 1102–03; *Davis*, 249 F. Supp. at 333–34.
112. *See* MCA Television, Ltd. v. Feltner, 89 F.3d 766 (11th Cir. 1996), *cert. denied*, 520 U.S. 1117, 117 S. Ct. 1248, 137 L. Ed. 2d 330 (1997).

of the 900 programs which were aired without authorization and granted judgment of $9 million against Feltner. In the circuit court case, the court states that, in the *Gamma* litigation,[113] the First Circuit rejected the same argument asserted in this case by Feltner, i.e., that the entire television series was a single work no matter how many individual episodes it contained. Feltner's argument was based on the contention that an individual episode of a series does not have an independent value because it is not commercially viable and, therefore, is not a "work" under the tests adopted by the First, Second and D.C. Circuits.[114] The Eleventh Circuit, relying in part on *Gamma*, affirmed the award, holding that the series was not a single collective work (i.e., a "compilation" as defined in Section 504(c)(1)), but that each episode was a single work, each having an individual plot that was not linked together with other episodes into one cohesive story.[115]

1. *Columbia Pictures Television v. Krypton Broadcasting of Birmingham, Inc.*[116]

In this litigation, the plaintiff was a prominent producer and distributor of television series. Defendant C. Elvin Feltner was the owner of Krypton International Corporation, which owned three television stations in the southeast United States. Columbia licensed a number of television shows to these stations, including *Who's the Boss?*, *Silverspoons*, *Hart to Hart*, and *T. J. Hooker*. When the stations became delinquent in paying license fees, Columbia notified the defendants that the license was terminated. The stations

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113. *See id*. at 769 (citing and explaining Gamma Audio & Video, Inc. v. Ean-Chea 11 F.3d 1106 (1st Cir. 1993)).
114. In affirming the district court, the Eleventh Circuit also noted "[t]he circuits that have defined 'work' have held that separate copyrights are not distinct 'works' unless they can 'live their own copyright life' . . . [and] [t]his test focuses on whether each expression has an independent economic value and is, in itself, viable." 89 F.3d at 769 (citations omitted).
115. *See id*. at 769. The *Feltner* Court explained that, in *Gamma*, a video rental store reproduced and rented unauthorized videotape copy. The district court held that the rental store infringed the copyrights of four episodes of a Chinese language television series owned by the plaintiff. In calculating statutory damages, the district court gave Gamma a single award, concluding that the video store infringed the copyrights in four episodes of the series but that these episodes constituted only one work based in part on the fact that Gamma sells or rents only complete sets of the series to video stores. The First Circuit rejected this argument, observing that "'(1) viewers who rent the tapes from their local video stores may rent as few or as many tapes as they want, may view one, two, or twenty episodes in a single sitting, and may never watch or rent all of the episodes; and (2) each episode in the [ ] series was separately produced.'" *Feltner*, 89 F.3d at 769 (quoting *Gamma*, 11 F.3d 1106, 1117 (1st Cir. 1993)).
116. 106 F.3d 284 (9th Cir.), *cert granted*, 521 U.S. 1151, 118 S. Ct. 30, 138 L. Ed. 2d 1059 (1997), *rev'd*, 523 U.S. 340, 118 S. Ct. 1279, 140 L. Ed. 2d 438 (1998).

continued to broadcast the programs, and Columbia sued. Columbia subsequently dropped all causes of action against the stations, leaving the copyright claims against Feltner to be litigated. Following the district court judge's grant of Columbia's summary judgment motion on liability, he conducted a bench trial and awarded Columbia $8,800,000 in statutory damages, and over $750,000 in attorneys' fees and costs.

The district court judge found that *each episode* of the four television series constituted a single work. The judge further found that the infringements were willful in that Feltner, after notice from Columbia that the license between him and it was terminated, continued to broadcast episodes of these series. Even with the finding of willfulness, the district court had awarded statutory damages of $20,000 per infringement, the maximum within the then-current range of statutory damages in Section 504(c)(1), rather than implementing the provision for enhanced damages for willfulness found in Section 504(c)(2).[117] The circuit court affirmed.[118] *Certiorari* was granted by the United States Supreme Court upon Feltner's petition.[119]

2. *Feltner v. Columbia Pictures Television, Inc.*:[120] Feltner Seeks a Jury Trial

The sole issue presented by Feltner's appeal was whether he had a right to a jury trial for the determination of statutory damages requested by Columbia, the copyright owner. The Court, per Justice Thomas, first placed this issue in historical perspective by providing a brief review of the Statute of Anne (the first English copyright statute, 1710), the copyright laws passed by the Continental Congress before the founding of the United States, the legislative acts of twelve states that enacted copyright statutes and, lastly, the application of the Seventh Amendment, guaranteeing a jury trial on the issue of statutory damages, which, prior to *Feltner*, had been available only for the determination of actual damages and profits.[121] The Court, in conducting its history lesson, observed that Section 504 of the 1976 Copyright Act did not provide the right for a jury trial to determine statutory damages, and that the

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117. In 1997, statutory damages could be awarded "in a sum of not less than $500 or more than $20,000 as the court considers just." This range has now been increased to not less than $750 and not more than $30,000. Thus, the court did not apply the willfulness standard, per se, as set forth in 17 U.S.C.(c)(2) which at the time provided for enhanced damages of $100,000 for willful infringement. The statute has since been amended, increasing the maximum to $150,000.
118. 106 F.3d at 292–93.
119. *See* Feltner v. Columbia Pictures Television, Inc., 521 U.S. 1151, 118 S. Ct. 30, 138 L. Ed. 2d 1059 (1997).
120. 523 U.S. 340, 118 S. Ct. 1279, 140 L. Ed. 2d 438 (1998).
121. *See id.* at 348–53, 118 S. Ct. at 1285–87.

application of that statute was unconstitutional for that reason.[122] That, however, was not the end of the Court's opinion. In the majority opinion, in which eight judges joined, the Court held that, even though Section 504(c) makes no mention of a right to a jury trial, or to juries at all, providing instead that damages should "be assessed in an amount 'the court considers just,' . . . [and] in the event that 'the court finds' an infringement that is willful or innocent, 'the court in its discretion' may, within limits, increase or decrease the amount of statutory damages. . . . [¶] [T]he Act does not use the term 'court' in the subsection addressing awards of actual damages and profits . . . which generally are thought to constitute legal relief."[123] The Court, in addressing the constitutional question, in effect engrafted the right to a jury trial on Section 504 of the Act, because, as the Court found, the practice of awarding damages, no matter how denominated, was a legal, as distinguished from an equitable, remedy. Using few words, the Court succinctly held that "the Seventh Amendment provides a right to a jury trial on all issues pertinent to an award of statutory damages under § 504(c) of the Copyright Act, including the amount itself."[124] Justice Scalia concurred, but expressed "considerable doubt about the constitutionality of § 504(c) if it did not permit jury determination of the amount of statutory damages. Because an interpretation of § 504(c) that avoids the Seventh Amendment question is at least 'fairly possible,' I would adopt that interpretation, prevent the invalidation of this statute, and reserve the constitutional issue for another day."[125]

3. *Columbia Pictures Television, Inc. v. Krypton Broadcasting of Birmingham, Inc.*:[126] Feltner Gets His Jury Trial

Upon remand from the Court, the statutory damages phase of this litigation was tried before a jury, the facts upon which liability was based having already been established by the summary judgment in favor of Columbia.[127] Thus, the finding of 440 separate "works" was the law of the case. The one difference was that the jury returned a verdict of $31.68 million for Columbia, which was equivalent to an award of $72,000 for each of the 440 episodes infringed.

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122. *See id.* at 355, 118 S. Ct. at 1288.
123. 523 U.S. at 345–46, 118 S. Ct. at 1283–84.
124. 523 U.S. at 355, 118 S. Ct. at 1288.
125. 523 U.S. at 359, 118 S. Ct. at 1290 (Scalia, J., concurring).
126. 259 F.3d 1186 (9th Cir. 2001), *cert. denied*, 534 U.S. 1127, 122 S. Ct. 1063, 151 L. Ed. 2d 967 (2002).
127. Feltner appealed the jury verdict on several grounds. His arguments were summarily rejected by the Ninth Circuit, including one where he took the position, that since the Supreme Court had held that the statutory damages provision of the 1976 Copyright Act violated the Seventh Amendment, the Court "effectively found that the statutory damages provision of the Copyright Act is unconstitutional in its entirety." *Id.* at 1192.

In affirming, the Ninth Circuit held that, "[a]lthough the jury's $31.68 million verdict is substantial, it is equal to a per work infringed award that is well within the statutory range for willful infringement."[128]

4. Post-*Feltner* and Summary Judgments

In *BMG Music v. Gonzalez*,[129] plaintiffs sought only the minimum statutory damages of $750 for the thirty infringements arising from the unauthorized downloading of BMG's copyrighted songs. Plaintiff BMG made the decision to seek the minimum to eliminate any issue of fact. The district court granted BMG's motion for summary judgment. Gonzalez took the position that the Supreme Court's decision in *Feltner v. Columbia Pictures Television* mandated a jury trial whenever statutory damages are demanded.

The circuit court rebuffed her construction of *Feltner*, which had been based on one passage in the Supreme Court's opinion where it states that "'[t]he right to a jury trial includes the right to have a jury determine the *amount* of statutory damages, if any, awarded to the copyright owner.'"[130] The circuit court addressed her focus on the words *if any*, stating that: "Gonzalez maintains that by adding 'if any' the Court allowed a jury to send an author home empty handed, even if the statute makes $750 the minimum. In other words, she contends that *Feltner* creates a system of jury nullification unique to copyright litigation."[131] The court then discusses the role of summary judgment in the context of copyright litigation:

> We read *Feltner* as establishing no more (and no less) than that cases under § 504(c) are normal civil actions subject to the normal allocation of functions between judge and jury. When there is a material dispute of fact to be resolved or discretion to be exercised in selecting a financial award, then either side is entitled to a jury; if there is no material dispute and a rule of law eliminates discretion in selecting the remedy, then summary judgment is permissible.[132]

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128. *Id.* at 1195.
129. 430 F.3d 888 (7th Cir. 2005).
130. *Id.* at 892 (quoting Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340, 353, 118 S. Ct. 1279, 1287, 140 L. Ed. 2d 438 (1998) (emphasis in original)).
131. *Id.*
132. *Id.* at 892–93. *Accord* Segrets, Inc. v. Gillman Knitwear Co., Inc., 207 F.3d 56, 65 n.7 (1st Cir. 2000) (citing with approval the *BMG* Court's interpretation of *Feltner*).

C. Compilations[133] and their Constituent Elements

1. The Definition and Nature of Compilations

a. Section 504(c) and Related Sections of the Copyright Act

The last sentence of Section 504(c)(1) provides that, for the purpose of awarding and determining the amount of statutory damages, "all the parts of a compilation or derivative work constitute one work."[134] For a complete understanding of this portion of Section 504(c), there are two other sections of the Act which must be reviewed. The first is Section 101, which, in defining a "compilation," describes it as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as whole constitutes an original work of authorship. The term 'compilation' includes collective works."[135] The next is Section 102, which deals with the subject matter of copyright. Included among the works qualifying for copyright are "musical works, including any accompanying words."[136] An understanding of the treatment of compilations requires

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133. *See* 17 U.S.C. § 103(b) ("The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material").

134. 17 U.S.C. § 504(c)(1).

135. 17 U.S.C. § 101.

136. 17 U.S.C § 102(a)(2). The full text of Section 102 provides as follows:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
(1) literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

an understanding that Section 504(c)(1) provides that only a single award may be made for each infringed work. Thus, the copyright owner of a popular song would be entitled only to a single statutory damages award against an infringer who, for example, copied the copyrighted work and also made an arrangement of it for brass band. Let us further assume that the owner of the original song assigned it to a prominent music publisher. The result would be that the copyright owner and the publisher/assignee would both be owners of different rights in the same composition.[137]

The issue raised by Section 504(c)(1) by the phrase "all the parts of a . . . derivative work constitute one work" does not present so easy a solution. For example the hypothetical about the song and its arrangements raises the following question: Would the infringer who copied the arrangement for brass band be liable for one statutory damages award or two for both the original work and the arrangement?[138] The *Robert Stigwood Group* case discussed below addresses this issue, among others.

b. *Robert Stigwood Group Ltd. v. O'Reilly*[139]

Tim Rice, the lyricist for such hit musicals as *Joseph and the Amazing Technicolor Dreamcoat*; *Jesus Christ, Superstar;* and *Evita* made the offhand observation that "if it [*Jesus Christ, Superstar*] had not been successful, I would have almost certainly given up."[140] Rice, with Andrew Lloyd Webber, formed one of the most creative and successful lyricist/composer teams of the twentieth century. Their concept was brilliant, yet simple: create rock musicals to reflect the times in which that genre was born and embellish them with stories that tap into the contemporary psyche. They had already gone to the Bible in *Joseph*, so why not write a "rock opera" about the last seven days in the life of Jesus? And for good measure, they could tell the story through the eyes of Judas, because Rice "always wanted to write a piece about Judas."[141] To add to their creativity, the Webber/Rice combo decided to release a recorded show album before presenting the live stage version, a marketing strategy they had followed for *Joseph*. The U.S. copyrights protected the entire opera with all its constituent parts (music, libretto, and vocal score) and three songs which were each copyrighted separately. The show opened on Broadway on October 21, 1971, and ran for 720 performances, so compelling was its music and story. It has remained a classic, performed in many countries. Ben Vereen received an

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137. *See* Goldstein, *supra* note 12, § 14.2.2, at 52–62.
138. *See id*. § 14.2.2.1.b, at 60.1–60.2.
139. 530 F.2d 1096 (2d Cir.), *cert denied*, 429 U.S. 848, 97 S. Ct. 135, 50 L. Ed. 2d 121 (1976).
140. Al Kasha & Joel Hirschhorn, Notes On Broadway 231 (1985).
141. *Id*. at 233.

award for his portrayal of Judas. Webber and Rice were themselves superstars, going on to other successes, including *Evita*.

The message and music of *Jesus Christ, Superstar* were so powerful and accessible that a church decided to put on a series of performances to raise money for charitable purposes. In addition to local performances, the priests-turned-producers took the show on the road. These performances were quite successful. The performances by the religious group were without authorization and drew the attention of the copyright owners who filed an action for infringement of all four copyrights. The court's analysis and holding followed in *Robert Stigwood Group Ltd. v. O'Reilly.*

The issues: Since six elements of the opera were copied, were there six infringements, requiring that any award be multiplied by six? Given the fact that the church's production of *Jesus Christ, Superstar* was performed on tour forty-eight times in the United States at different times, on different days in different venues, did the "tour" constitute one infringement or was each performance a separate infringement, requiring forty-eight awards?

The court held that the musical play *Superstar* was a single work, even though it had several registrations, that the separately registered songs should be considered works separate from the musical play and that each performance was a separate infringement:

- First, the performances of *Superstar* as a complete integrated artistic entity constituted a single infringement because "infringement of performing rights of *overlapping* copyrights on substantial parts of the entire work should be considered as a single infringement;"[142] and
- Second, the court applies the time and heterogeneity tests: Since there were separate registrations of these songs, when the defendants gave dramatic performances of the songs, each performance constituted an infringement because "the copyrights on the songs can live their own copyright life."[143]

142. *Robert Stigwood Group*, 530 F.2d at 1104 (emphasis added).

143. *Id*. at 1104–05. "In this case, while injunctive relief was sought and granted, the infringers were nonetheless able to give forty-eight United States performances. These performances were not a single run at a particular theater. . . . Instead, they were a series of disconnected one-night or two-night stands in different cities. Each of the defendants' performances was given pursuant to a separately negotiated agreement made with a specific auditorium, and in conjunction with separately arranged advertising with local newspapers and radio stations. The financial arrangements which defendants made with numerous auditoriums varied in their terms. Thus, if we ask, in each instance, what the components of the several performances were, we find components which are quite heterogenous." *Id*. at 1103.

In remanding to the district court, the Second Circuit concluded by awarding $250 for each infringement or $48,000 as a minimum award (4 copyrights x $250 x 48 performances) or such greater amount as the court deems just.

D. Derivative Works

1. The Statutes: Sections 504(c)(1), 101, 102, and 103

The same analysis regarding the interrelationship between and among Sections 504(c)(1), 101, 102, and 103 applicable to compilations also applies to derivative works, except for their definitions. Section 101 defines a derivative work by describing it as follows: "A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a 'derivative work.'"[144]

2. A Case in Point: *Gamma Audio & Video, Inc. v. Ean-Chea* [145]

In addition to other issues, *Gamma Audio* involved the infringement of a derivative work, in this instance, a translation. Gamma (a collective designation for Gamma Audio & Video, Inc., and the individual plaintiffs), pursuant to four license agreements (recorded in the Copyright Office), obtained three exclusive rights to videotaped programs owned by Television Broadcasts Ltd. ("TVB"), a producer of Chinese language television programs. These rights were to: dub the programs into Cambodian; duplicate the dubbed versions; and distribute for rental the dubbed versions to thirty-seven states, including Massachusetts, where the case was litigated. The derivative Cambodian versions were never registered for copyright protection. Gamma then entered into an agreement with Tsing Tao and his partners granting them exclusive rights to distribute the Cambodian version in Massachusetts and five other states. Ean-Chea, who at the time was the authorized distributor of (apparently other) Cambodian versions of TVB's programs, commenced making unauthorized sales of the Cambodian versions licensed to Gamma. Gamma sued, alleging six claims for copyright infringement, Lanham Act violations, and state law claims. Gamma had failed to register for copyright the derivative works (i.e., the Cambodian translations). It therefore sought recovery of statutory

144. 17 U.S.C. § 101.
145. 11 F.3d 1106 (1st Cir. 1993).

damages for infringement of the underlying work (i.e., the original Chinese language versions). The district court entered judgment for Gamma, holding that the unauthorized distribution of four of these episodes constituted one infringement. The district court awarded attorneys' fees and costs to Gamma as the prevailing party. Both sides appealed. The district court agreed with Gamma, as did the First Circuit. The circuit court stated:

> Under the Copyright Act, the copyright owner of a derivative work "has a cause of action for infringement by reason of the substantial copying from the derivative work of material which originally appeared in the underlying work." . . . This means that, if the copyright owner in a derivative work is the exclusive licensee of certain rights in the underlying work, it becomes the copyright owner of the underlying work for the purpose of exercising those rights.[146]

The First Circuit affirmed the judgment with one exception: it reversed the district court and held that there were four separate infringements rather than just one, concluding that each episode could "live [its] own copyright life" because the expression in each "has an independent economic value and is, in itself, viable."[147]

IV. Statutory Damages: Willful and Innocent Infringement

A. Section 504(c)(2): Enhanced and Remitted Statutory Damages

In keeping with one of the objectives of awards of statutory damages, the courts are given a range of damages to provide each judge with the discretion to accomplish the following: (1) to make an award approximating actual damages and/or profits; or (2) where both are difficult to prove or profits are nonexistent, to make a reasonable award, given the facts of each case. In addition to the range permissible for ordinary infringements—$750 to $30,000—Section 504(c)(2) provides for enhanced damages to a maximum of $150,000 per work when the infringement is "willful." At the other end of the continuum are reduced or remitted damages of not less than $200 when the infringement is innocent.[148]

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146. *Id*. at 1112 (citation omitted).

147. *Id*. at 1116–17 (citing and quoting Walt Disney Co. v. Powell, 897 F.2d 565, 569 (D.C. Cir. 1990) (quoting Robert Stigwood Group, Ltd. v. O'Reilly, 530 F. 2d 1096, 1105 (2d Cir. 1976))).

148. *See* 17 U.S.C. § 504(c)(2).

B. A Sampling of Statutory and Case Authorities

1. Willfulness

a. *Lauratex Textile Corporation v. Allton Knitting Mills, Inc.*[149]

Plaintiff Lauratex was in the business of converting undyed goods into printed textiles for apparel. Through one of its stylists, the plaintiff purchased the design at issue from an English design studio in August 1979 and registered it for copyright. Defendant Martin Levine, the president and sole employee of defendant Allton Knitting Mills, testified that he first saw the design in a show in Italy in 1979, purchased a piece of the fabric containing the design, and began producing approximately 3,100 yards of the fabric in September 1980. The plaintiff sued for copyright infringement, seeking an injunction and statutory damages in the sum of $50,000 together with attorney's fees of $10,000. The issue regarding the amount of statutory damages to be awarded revolved around the question as to whether the defendants willfully copied plaintiff's copyrighted fabric design. The court found the infringements to be willful for the reasons, among others, that (1) the defendants did not mass-produce the fabric design and sell it until nine months after plaintiff had established a successful market and five months after plaintiff copyrighted the design; and (2) after defendants produced the copied design they tried to solicit one of plaintiff's best customers. In addition, defendant Levine had a history of six copyright infringement actions brought against him in the three years preceding the infringements of plaintiff's design.[150]

The court had the discretion to award $50,000 in statutory damages in a case of willful infringement. In the case at issue, the court awarded the plaintiff $40,000 in statutory damages and $2500 in attorney's fees, both of which were within the discretion of the court. As the judge observed, the awards "serv[e] the purpose of the Copyright Act to compensate plaintiff and deter such flagrant infringements as occurred here."[151]

b. *Harris v. Emus Records Corporation*[152]

In 1968, Emmy Lou Harris, a singer, entered into a written agreement with Jay-Gee, a record company, pursuant to which she recorded six songs later released on an album entitled *Gliding Bird*, which was also the name of one of the songs. Three companies—Hannah Brown Music (wholly owned by Harris),

149. 519 F. Supp. 730 (S.D.N.Y. 1981).
150. *See id.* at 733.
151. *Id.* at 734.
152. 734 F.2d 1329 (9th Cir. 1984).

Nanshel Music, and Jubilant Music—issued mechanical licenses to Jay-Gee Record Company to record the works, five of which were written by Harris, and one, "Gliding Bird," by Tommy Slocum. During the bankruptcy proceedings filed by Jay-Gee, defendants Emus, Suellen Productions, Inc. and Roulette Records, Inc., purchased the master recording of "Gliding Bird" and the remaining five songs composed by Harris. Emus re-released a duplicate of the *Gliding Bird* album with a new serial number and cover. Harris sued for copyright infringement and obtained summary judgment for the "Gliding Bird" song, and, after a bench trial, a judgment of copyright infringement on the remaining five songs. Harris elected to recover statutory damages under Section 501(c)(1) of the Copyright Act. The district court found that the defendants willfully infringed and awarded $10,000 for each infringement, the maximum allowed in 1984 under the 1976 Copyright Act. The Ninth Circuit held that the release of the new album constituted copyright infringement because the defendant did not obtain a new mechanical license. The Ninth Circuit then turned its attention to damages, which it affirmed, stating that "[t]he court has wide discretion in determining the amount of statutory damages to be awarded, constrained only by the specified maxima and minima."[153] The Ninth Circuit continued its explanation: "The award will be overturned only for abuse of discretion. . . . The district court awarded for each of the six infringed songs the maximum damages permissible, in the absence of a specific finding of wilfullness. The trial court is in a better position than are we to determine appropriate damages. We affirm that decision."[154]

The court also affirmed an award of $34,152.97 in attorney's fees, observing that "[t]he amount in this case represented approximately half of the amount plaintiff's attorneys claim to have earned in this rather extensive litigation."[155] The appellate court also retained jurisdiction for the purpose of awarding reasonable attorneys' fees to the plaintiff/appellee incurred for the appeal.[156]

c. *Boz Scaggs Music v. KND Corporation*[157]

In this case, the defendant owned a radio station in Windsor, Connecticut with the call letters WKND. Material facts were undisputed. Although initially licensed by ASCAP to broadcast music composed by its members, WKND did not pay license fees after it let its agreement with ASCAP expire. At the time these infringements occurred, the 1909 Copyright Act was in

153. *Id.* at 1335 (citations omitted). The minimum in 1984 was $250, while the maximum was $10,000, for each act of infringement. These have been increased by amendment to $750 and $30,000, respectively.

154. *Id.* (citations omitted).

155. *Id.*

156. *See id.* at 1336.

157. 491 F. Supp. 908 (D. Conn. 1980).

effect and provided for statutory damages in an amount not greater than $5,000 and not less than $250 for each infringement. Within these limits, the assessment of damages lay within the court's discretion and sense of justice. The district court provided a good capsulized statement of the factors to be applied in awarding statutory damages:

> Among the factors to be considered in arriving at a determination of damages are the expenses saved and profits reaped by the defendants in connection with the infringements, the revenues lost by the plaintiffs as a result of the defendants' conduct, and the infringers' state of mind whether wilful, knowing, or merely innocent.[158]

Because of the conduct of the defendant's station manager and part owner who ignored KND's obligations and those of other stations in which he had an interest, the district court found that "[t]he defendants' conduct cannot be termed innocent," but added that awards of statutory damages were in lieu of actual damages and profits and were "not an award premised on notions of penalty or punishment."[159] The district court awarded $23,000 ($1,000 for each of the twenty-three infringements involved) and also awarded attorneys' fees in an amount to be determined upon submission of an affidavit detailing counsel's time devoted and rate charged.

d. *Blendingwell Music, Inc. v. Moor-Law, Inc.*[160]

Defendant Robert C. Moor, Jr., the principal in Moor-Law, Inc., operated a club devoted to presenting live performances of country music performed by featured artists in that genre. Moor, who employed a manager at his club, called The Triple Nickel, also played an active role in supervising its operations. The plaintiffs were music publishers who were members of the American Society of Composers, Authors and Publishers ("ASCAP"). In order to establish that the defendants were performing the music of ASCAP members without a license to do so, ASCAP sent two "paid listeners" to monitor performances at The Triple Nickel in 1981 and 1982. The district court granted plaintiffs' motion for summary judgment, finding that the defendants knowingly and without authorization presented performances of ASCAP music, thereby infringing eighteen different country music works. Moor as an individual was held liable as a vicarious and contributory infringer, the court observing that "[t]he facts in this case will not admit to a finding other than that Moor was

158. *Id.* at 914.
159. *Id.* at 914–15.
160. 612 F. Supp. 474 (D. Del. 1985).

directly or contributorially liable for copyright infringement."[161] The court also noted that "defendants knowingly violated the copyright laws, (indeed, two of the infringing acts followed a defeat in another copyright infringement action against the defendants)."[162]

The court issued an injunction prohibiting further infringement of eighteen musical works that the defendants had infringed, and awarded $500 each for the eighteen infringing performances at The Triple Nickel.

> In determining statutory damages under 17 U.S.C. § 504(c)(1), courts have wide discretion to set damages within the statutory limits and awards of damages for more than the statutory minimum are frequent.[163]

The court also awarded attorneys' fees based on a so-called "lode-star" figure, computed by multiplying the number of hours reasonably spent, times the reasonable hourly rate. This "lode-star" figure is then subject to alteration by two other factors: "the contingent nature of success and the quality of the attorneys' work."[164] The court found that the hourly rate of the partner and junior associate were reasonable, but disallowed some of the hours spent by counsel on a brief. The award was provisional, to permit both defendants to object to the fee award, and plaintiffs to determine whether they wish to proceed on three remaining claims, and whether plaintiffs wished to bring the matter to trial for determination of the defendants' "wilfulness."[165]

e. *UMG Recordings, Inc. v. MP3.Com, Inc.*[166]

Defendant copied unlicensed music onto MP3 files for downloading by its subscribers over the internet. The court held that the defendant's copying was not a fair use.[167] Thereafter, in a Final Judgment and Order, the court found MP3.Com's conduct willful and awarded plaintiffs $25,000 per CD infringed, or $118,000,000 in statutory damages.[168]

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161. *Id*. at 482.
162. *Id*. at 486.
163. *Id.* at 485.
164. *Id*. at 486.
165. *Id*. at 488.
166. 92 F. Supp. 2d 349 (S.D.N.Y. 2000).
167. *See id*. at 352.
168. *See* UMG Recordings, Inc. v. MP3.Com, Inc., No. 00 CIV. 472 (JSR), 2000 U.S. Dist. LEXIS 13293, 2000 WL 1262568 (S.D.N.Y. Sept. 6, 2000). *See also* Teevee Toons, Inc. v. MP3.com, 134 F. Supp. 2d 546 (D.C.N.Y. 2001).

2. Innocence

a. The Statute: Section 504(c)(2)

In a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the award of statutory damages to a sum of not less than $200.[169] In its Notes of Committee on the Judiciary, the House provides its rationale for this provision as follows:

> The "innocent infringer" provision of section 504(c)(2) has been the subject of extensive discussion. The exception, which would allow reduction of minimum statutory damages to $100[170] where the infringer "was not aware and had no reason to believe that his or her acts constituted an infringement of copyright," is sufficient to protect against unwarranted liability in cases of occasional or isolated innocent infringement, and it offers adequate insulation to users, such as broadcasters and newspaper publishers, who are particularly vulnerable to this type of infringement suit. On the other hand, by establishing a realistic floor for liability, the provision preserves its intended deterrent effect; and it would not allow an infringer to escape simply because the plaintiff failed to disprove the defendant's claim of innocence.[171]

b. An Example of Innocent Infringement: *D.C. Comics Inc. v. Mini Gift Shop*[172]

Immediately prior to the release of the motion picture *Batman*, Warner Bros. (a co-plaintiff) discovered that two categories of two defendants—three retail stores and two flea markets—were selling *Batman* merchandise in violation of the plaintiff's copyrights. Warner Bros. commenced separate actions against the retail store and flea markets. Certain of the defendants defaulted, while others consented to "an injunction 'permanently prohibiting [them] from dealing in goods that display or depict the Batman symbol.'"[173] The district court explained to the defendants, who were Asian immigrants who spoke little or no English, the effect of the injunction and of the plaintiff's request for damages and attorneys' fees. The district court found the defendants to be innocent infringers in that they barely understood English, if at all, and did not have the sophistication to "'make [an] inquiry . . . for the purpose of

169. *See* 17 U.S.C. § 504(c)(2).
170. Since increased to $200.
171. H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 163 (1976).
172. 912 F.2d 29 (2d Cir. 1990).
173. *Id.* at 32.

determining whether [they are] or [are] not violating some copyright law.'"[174] The trial judge, therefore, found all of the infringements to be innocent and awarded $200 statutory damages against both the consenting and defaulted defendants. The appellate court reversed as to the defaulted defendants because, having defaulted, they did not meet their burden to prove that the infringements were innocent as required under Section 505(c)(2) of the Act. The court vacated the award of damages against the defaulted defendants, increasing the statutory damage award to $500, and affirmed the judgment as modified. The court did not award costs to any of the parties.[175]

c. The Teacher/Librarian/Archivist/Public Broadcaster Innocent Infringer

The statute also provides a safe harbor for particular classes of employees and entities who "believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use."[176] The classes of employees and entities include: employees or agents of nonprofit educational institutions, libraries and archives acting within the scope of employment and the institution itself; and broadcasting entities or individuals who infringe "by performing a published nondramatic literary work or by reproducing a transmission program embodying a performance of such a work,"[177] in which event statutory damages will be remitted in their entirety.

V. Coda to Statutory Damages: Five Scenarios

1. Scenario No. 1

Anthony Crater, a prominent songwriter, copies the "hook" from a song written by Manfred Tunesmith and incorporates that segment into his work *Caribbean Rock*. *Caribbean Rock* becomes famous during the time Crater performs it at a small club in New York. These performances lead to a publishing contract and a best-selling recording. Tunesmith sues Crater for copyright infringement and elects statutory damages for the copying and use of his "hook" on Crater's recording which sells 500,000 units. Tunesmith would be entitled to an award for a single infringement between the current minimum of $750 and a maximum of $30,000 absent other factors such as willfulness or

174. *Id.*
175. *See id.* at 36–37.
176. 17 U.S.C. § 504(c)(2).
177. *Id.*

innocence of the infringer. Since the infringer sold 500,000 copies, the court would be inclined to award an amount closer to the maximum.

2. Scenario No. 2

At a party, Tunesmith, in casual conversation with a friend who is also a songwriter, hears that he should join the record label as a codefendant to increase his award of statutory damages. Tunesmith checks with his lawyer and is advised the record label is liable jointly and severally with Crater for the single infringement, which will not increase Tunesmith's recovery.

3. Scenario No. 3

After the sales of his recording really establishes legitimacy of the work, *Caribbean Rock* is performed not only by Crater at his club but also at various venues by other performers, including a cabaret singer, a jazz pianist, a pop singer, and a rock group at three nightclubs in Manhattan and two in Queens. Tunesmith sues all these performers and the owners of the venues for four infringements, thus making seven awards of statutory damages a possibility.

4. Scenario No. 4

Crater becomes so popular that his manager arranges a tour of five major cities, each planned and produced by the leading promoter in each respective city. At each venue, he gives two performances with two or three travel days (depending upon distance and accumulated fatigue) between his appearances at each venue. In this scenario, the promoters are each jointly and severally liable with Crater for the following: one infringement at each venue presenting two performances; one infringement at each venue on two successive days, thereby constituting five separate infringements. The promoters, however, are only jointly and severally liable with Crater for one infringement each. They are not jointly and severally liable with one another because each set of two performances took place at separate unrelated venues.

5. Scenario No. 5

Crater, however, when recording *Caribbean Rock*, joked with members of the band that Tunesmith had a very limited talent for composing, who only came up with one original melody in his long career as a song writer. "I took the tune, altered it slightly, making one interval a fifth rather than a third. I really kicked ass with the way I used it. Just look at the royalties." In this scenario, Mr. Crater may be looking at $150,000 for each of the infringements in Scenarios 1–4, if the band members become witnesses for Manfred Tunesmith.

VI. Attorney's Fees

A. The Landscape Pre-*Fogerty v. Fantasy*[178]

1. The Conflict Among the Circuits

Section 505 of the Act provides that "[i]n any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party. . . . [T]he court may also award a reasonable attorney's fee to the prevailing party as part of the costs."[179] Its predecessor statute, Section 40 of the 1909 Act, similarly provided for discretionary awards of attorneys' fees in providing that "the court may award to the prevailing party a reasonable attorney's fee as part of the costs."[180] In construing the language of both statutes, their plain meaning would appear to be that (1) the court may award attorneys' fees to the prevailing party (i.e. as a part of costs) whether plaintiff or defendant, and (2) whether to make such an award and the amount thereof is "entrusted to the discretion of the district court."[181] Even with this simplicity of language as a guide to the federal judiciary, some courts adopted a "dual standard" under which the prevailing plaintiffs were awarded attorneys' fees as a matter of course while the prevailing defendants were required to establish that the plaintiffs' claim was frivolous or in bad faith.[182] Unlike the Ninth Circuit, the Eleventh Circuit does not require a showing of bad faith or frivolity, but only requires that the party receiving the fee be the "prevailing party" and that the fee be reasonable.[183] Still other courts have denied awards of attorneys' fees for reasons other than lack of bad faith or frivolity.[184]

In all this interpretational conflict the Third Circuit, in *Lieb. v. Topstone Industries, Inc.*[185] was a beacon for the "evenhanded" approach.

178. 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 445.
179. 17 U.S.C. § 505.
180. 17 U.S.C. § 40 (1909) (repealed).
181. Lieb v. Topstone Indus., Inc., 788 F.2d 151, 154 (3d. Cir. 1986).
182. *See, e.g.*, Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 493 (9th Cir. 1985).
183. *See, e.g.*, Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821, 832 (11th Cir. 1982).
184. *See, e.g.*, Smith v. Jackson, 84 F.3d 1213, 1221 (9th Cir. 1996) (plaintiffs did not prevail at trial but their claims had a "legal basis sufficient to survive a summary judgment and a factual basis supported by expert testimony").
185. 788 F.2d 151 (3d Cir. 1986).

2. A Sampling of Case Authorities on Opposite Sides of the "Dual" and "Evenhanded" Approaches

a. *Lieb v. Topstone Industries, Inc.*

Plaintiff created an audiocassette tape of familiar Halloween sounds, titled "Haunted Horror." After copyrighting his recording he entered into an agreement with Topstone, as his exclusive distributor of the recording. Topstone terminated that agreement with Lieb and began marketing its own Halloween cassette, titled "Horror Sounds of the Night." Codefendant D. Robbins & Co. obtained copies of plaintiff's copyrighted tape that it sold to retail customers along with Topstone's tape. Lieb sued for copyright infringement and pendant[186] state claims for breach of agreement and bad faith. The court granted summary judgment for defendants but denied their motion for attorneys' fees without discussion. Defendants appealed on the ground that the district court abused its discretion in failing to award attorneys fees. The circuit court held that the district court must articulate its reasons for denying or granting attorneys' fees to a prevailing party, and remanded with instructions to the district court to do so in conformity with its opinion.[187]

The court gives a concise overview of the split among the circuits, some requiring a finding of certain prerequisite behavior or mental state to justify an award, while others applied the "even-handed approach."[188] The result of the former was that, in most cases, defendants could never obtain an award of counsel fees. The latter, however, depended on the district court's discretion to determine what amount would be reasonable under the circumstances of each case. The factors the district court should consider in making a reasonable award "include frivolousness, motivation, objective unreasonableness (both in the factual and in the legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence."[189] In addition, in determining the amount to award, the district court should consider the following: (1) the complexity of the litigation; (2) the amount of the award, which must not exceed the amount of the fee charged, but may, in the court's discretion, be less than the amount charged; (3) the relative financial strength of the parties; and (4) the presence or absence of bad faith.[190]

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186. Now denominated "supplemental jurisdiction." *See* 28 U.S.C. § 1367.
187. *See* 788 F.2d at 154.
188. *See id*. at 154–56.
189. *Id*. at 156.
190. *See id*.

b. *Cooling Systems & Flexibles, Inc. v. Stuart Radiator, Inc.*[191]

Cooling Systems was in the business of selling replacement radiators for small and imported cars. In March 1981, it published a new edition of its illustrated catalog, which it distributed to warehouse part shops and radiator repair shops. Later in 1981, Stuart Radiator, which manufactured and sold radiator cores, published its first illustrated catalog. Cooling Systems filed an action in 1982, alleging that Stuart Radiator had infringed the new edition of its catalog. After Cooling Systems presented its case in a bench trial, the district court dismissed Cooling Systems' infringement claim.

Although the district court made no findings on bad faith and frivolity, the Ninth Circuit held that "[t]he record demonstrates, however, sufficient indicia of bad faith and frivolity to justify the district court's holding. For example, Cooling Systems, to bolster its substantial similarity claim, suggest that Stuart could have arranged its catalog in a wide variety of very impractical ways. These included such fanciful proposals as 'list[ing] the automobiles in its applications section alphabetically by models, instead of makes; . . . and, with respect to its OEM cross-references section, list[ing] OEM numbers by automobile model instead of by make.' . . . To have adopted such arrangements would have made the catalogues virtually useless. Cooling Systems' admission, in its own brief, that its former-and different- arrangement of the catalogs had been a commercial failure amply demonstrates this."[192]

c. *Fantasy, Inc. v. Fogerty*:[193] The Dual Standard's Last Gasp

John Fogerty was, during the 1960's, the lead singer and songwriter of "Creedence Clearwater Revival," a popular music group which was widely admired for its live performances and recordings. After composing the song "Run Through the Jungle," he sold the exclusive publishing rights to Cireco Music and Galaxy Records, and Fantasy, Inc., the assignee of Cireco and Galaxy, sued Fogerty for copyright infringement, alleging that the song he published and copyrighted in 1985, "The Old Man Down the Road," was merely "Run Through the Jungle" with new lyrics.

Fogerty filed four counterclaims seeking rescission and, if rescission was granted, other relief, including a claim for copyright infringement. The district court granted summary judgment in favor of Fantasy, dismissing Fogerty's counterclaim. Thereafter, in the latter part of 1988, a jury returned a verdict

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191. 777 F.2d 485 (9th Cir. 1985).

192. *Id.* at 493 (citations to parties' brief omitted).

193. 984 F.2d 1524 (9th Cir.), *cert. granted*, 509 U.S. 903, 113 S. Ct. 2992, 125 L. Ed. 2d 687 (1993), *rev'd*, 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994).

for Fogerty on plaintiff's copyright infringement claim. The district court denied Fogerty's motion for an award of attorneys' fees, citing the rule that "a prevailing defendant may not be awarded attorneys' fees under § 505 unless it can be demonstrated that the action was frivolous or was instituted and predicated in bad faith. The purpose of that rule is to avoid chilling a copyright holder's incentive to sue on colorable claims, and thereby to give full effect to the broad protection for copyright intended by the Copyright Act."[194]

Fogerty petitioned for *certiorari*, which was granted by the Supreme Court, thus setting the stage for the Supreme Court to bring uniformity to the rule which would guide the lower courts in awarding attorney's fees.

B. *Fogerty v. Fantasy, Inc.*:[195] The Evenhanded Rule Prevails

1. The Supreme Court Speaks

Because of a conflict in the circuits the Court granted *certiorari* "to resolve the conflict between the Ninth Circuit's 'dual' standard for awarding attorney's fees under § 505, and the so-called 'evenhanded' approach exemplified by the Third Circuit."[196] The Court reversed and remanded for further proceedings under the standards it mandated for the evenhanded approach. The Court, in an opinion by Chief Justice Rehnquist, begins by stating that "the statutory language—'the court may also award a reasonable attorney's fee to the prevailing party as part of the costs'—gives no hint that successful plaintiffs are to be treated differently from successful defendants."[197]

Fantasy argued that the dual standard should be maintained for three reasons, all of which the Court rejected: (1) the language of Section 505, in light of the Courts' opinions construing fee-shifting, supports the dual standard; (2) "treating prevailing plaintiffs and defendants differently comports with the 'objectives' and 'equitable considerations' underlying the Copyright Act as a whole;"[198] and (3) the legislative history of Section 505 demonstrates that Congress ratified the practice the trial courts followed in applying the dual standard under the 1909 Act.[199]

The Court also rejected Fogerty's argument that it adopt the British Rule—i.e., that the prevailing party be awarded attorneys' fees *as a matter of course*. The Court pointed out that this construction would not comport with the

194. *Id.* at 1532.
195. 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994).
196. *Id.* at 521, 114 S. Ct. at 1027.
197. *Id.* at 522, 114 S. Ct. at 1027.
198. *Id.*
199. *See id.*

statutory language of Section 505 that "the court *may* also award a reasonable attorney's fee to the prevailing party as part of the costs."[200] The Court observes that "[t]he word 'may' clearly connotes discretion. The automatic awarding of attorney's fees to the prevailing party would pretermit the exercise of that discretion."[201]

2. The Ninth Circuit Converts

a. *Jackson v. Axton*[202]

The song "Joy To The World" ("Joy") was composed by Hoyt Axton in 1970. Hoyt Axton recorded a demo tape of the song during that year, with David Jackson, Jr. playing the piano. The band Axton hired participated in the recording of four or five of his compositions. At the time of the recording, Axton had completed only fragments of "Joy." Before recording "Joy," Axton finished the lyrics; Jackson contended that he wrote much of the music. Axton registered the copyright for "Joy" in his name. Jackson filed an action for declaratory relief seeking a declaration that he was the co-author of Joy. The district court granted Axton's motion for summary judgment holding that, by Jackson's delay of twenty-three years before asserting his claim, Axton was presumptively prejudiced (a presumption Jackson failed to rebut), and Jackson's claim was barred by laches. In addition, the district court denied Axton's request for an award of attorneys' fees on pre-*Fogerty* grounds (i.e., that Jackson's claim was not frivolous, nor did he prosecute his claims in bad faith). The circuit court observed that "[w]hen the district court refused to grant attorney's fees, controlling authority in this circuit held that attorney's fees were unavailable to a defendant under § 505 unless the plaintiff's action was frivolous or in bad faith."[203] The Ninth Circuit reversed the district court, providing the following rationale:

> Since that time, *Cooling Systems* has been overruled. [citing the Supreme Court's decision in *Fogerty v. Fantasy, Inc.*]. . . . Under *Fogerty*, courts determining whether to grant attorney's fees are to exercise "equitable discretion . . . 'in light of the considerations [the Court has previously] identified.'" . . . Such considerations include, but might not be limited to, the degree of success obtained . . .; frivolousness; motivation; objective unreasonableness (both in the factual and legal arguments in the case); and the need in particular circumstances to advance considerations of compensation and deference. . . . Courts should keep

200. *Id.* at 533, 114 S. Ct. at 1033 (emphasis added).
201. *Id.*
202. 25 F.3d 884 (9th Cir. 1994).
203. *Id.* at 890 (citing Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 493 (9th Cir. 1985)).

> in mind the purposes of the Copyright Act (to promote creativity for the public good) and apply the factors in an evenhanded manner to prevailing plaintiffs and prevailing defendants alike.[204]

3. *Fantasy, Inc. v. Fogerty*[205]

This is the next-to-last installment in the contest between Fogerty and Fantasy over the former's entitlement to an award of attorneys' fees. On remand, District Judge Samuel Conti awarded Fogerty attorneys' fees of $1,347,519.15. Judge Conti, after reviewing extensive billing records, based his award of attorneys' fees on the following factors, as explained by the circuit court: "First, Fogerty's vindication of his copyright in 'The Old Man Down the Road' secured the public's access to an original work of authorship and paved the way for future original compositions—by Fogerty and others—in the same distinctive 'Swamp Rock' style and genre. Thus, the district court reasoned, Fogerty's defense was the type of defense that furthers the purposes underlying the Copyright Act and therefore should be encouraged through a fee award. Further, the district court found that a fee award was appropriate to help restore to Fogerty some of the lost value of the copyright he was forced to defend. In addition, Fogerty was a defendant author and prevailed on the merits rather than on a technical defense, such as the statute of limitations, laches, or the copyright registration requirements. Finally, the benefit conferred by Fogerty's successful defense was not slight or insubstantial relative to the costs of litigation, nor would the fee award have too great a chilling effect or impose an inequitable burden on Fantasy, which was not an impecunious plaintiff."[206]

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204. *Id*. at 890 (citations omitted). *Cf*. Smith v. Jackson, 84 F.3d 1213 (9th Cir. 1996). In *Smith*, the court in rendering its holding first reviewed the standards of review: (1) awards of attorneys' fees are reviewed for abuse of discretion; (2) "[r]eversal for abuse of discretion is not appropriate unless [the appellate court] has a definite and firm conviction that the court below committed a clear error of judgment" in the conclusion it reached upon a weighing of the relevant factors, *id*. at 1221; and (3) the district court's findings of fact in ruling on awards of attorneys' fees are reviewed for clear error. The circuit court, in affirming the district court, explained: "Although the district court did not explicitly mention the *Fogerty* factors, the court implicitly considered four of the five factors. First, the district court concluded that appellants had more success in pursuing their claims than is typical of copyright infringement actions, mainly due to their 'respectable evidence of access by defendants.' The district court also explicitly noted that it did not find frivolousness or that the suit was motivated by bad faith. Finally, the court noted that the claims had a legal basis sufficient to survive summary judgment and a factual basis supported by expert testimony." *Id*. The last sentence, although not necessary, provides a rationale for the finding of lack of frivolousness and bad faith.

205. 94 F.3d 553 (9th Cir. 1996).

206. *Id*. at 556.

The district court, however, declined Fogerty's request for interest on the amount of attorney's fees paid to his lawyers.[207]

The Ninth Circuit, now fully imbued with the Supreme Court's reasoning in *Fogerty v. Fantasy*, affirmed the award of attorney's fees, in the face of Fantasy's creative arguments, including its contention that the district court "had no discretion to award fees to Fogerty because Fantasy conducted a 'good faith' and 'faultless' lawsuit upon reasonable factual and legal grounds,"[208] arguing that it was "'blameless,'" because "evenhandedness cannot be achieved by rewarding each side for qualities that adhere only to that side."[209] This is, of course, contrary to the Supreme Court's holding and rationale in *Fantasy v. Fogerty*. This argument was rebuffed by the Ninth Circuit in that the focus should be, and is, on whether the district court exercised its discretion properly or abused it.

In addressing Fantasy's contention that a district court, in order to satisfy the evenhanded rule, "must be exactly capable" of applying the same factors to a prevailing plaintiff as those applied to a prevailing defendant to satisfy the evenhanded rule, the Ninth Circuit stated that "Fantasy's argument is just another way of making two points rejected by the Supreme Court—that for a prevailing defendant to qualify for fees the plaintiff must be blameworthy because whenever a plaintiff prevails the defendant, by definition, is blameworthy; and that to award fees when the plaintiff isn't blameworthy chills enforcement of the copyright laws."[210]

The court concluded by awarding Fogerty his attorneys' fees incurred for the appeal and remanded to the district court for calculation of the amount.

C. The "Prevailing Party"

1. Who Is the Prevailing Party?

The "prevailing party" in copyright litigation is not a monolithic being of fixed uniformity. An individual who "prevails" on some, but not all, of his or her claims may or may not be *the* prevailing party (*i.e.*, the actual "winner" of the litigation). It all depends on a number of factors, including the circuit in which the litigation is contested, whether one of the litigants prevails in a substantial portion of the litigation, or whether one "'succeeds on a significant issue in

207. The last official act of the district court was the amount of attorneys' fees incurred by Fogerty, if any, to be awarded pursuant to the Ninth Circuit's remand for that purpose.
208. 94 F.3d at 556.
209. *Id.* at 556–57.
210. *Id.* at 559.

the litigation.'"[211] These, and other permutations, are in vivid contrast to the case where a single claim of infringement is at issue. In that situation, a clear prevailing party will emerge: either the plaintiff or the defendant. Where that is not the case, the court will engage in a balancing process that will require careful analysis of both sides of the issue.

2. A Sampling of Judicially Created Guidelines

a. Party Prevailing On a "Substantial Portion" of the Litigation

In *Best Medium Publishing Company v. National Insider, Inc.*,[212] Best Medium, the publisher of *The National Enquirer*, sued *The National Insider*, a local Chicago weekly tabloid, for infringing six articles in the *Enquirer*. The *Insider*, in its counterclaim, alleged that Best Medium, in the *Enquirer*, infringed nine of its articles. At the time of trial, the *Enquirer* dismissed its claims regarding three additional articles, and trial proceeded on its remaining six claims, as well as on the *Insider's* counterclaims. At trial, the district court rejected the *Insider*'s contention that certain of the articles in the *Enquirer* were not protectable and that Best Medium's publishing rights to the articles had lapsed. The court ruled against the *Insider* on its counterclaims, found that it had infringed the copyrights on all six articles, and awarded statutory damages of $250 for each article, costs, and a permanent injunction. The *Insider* claimed that costs should be apportioned because it prevailed on the three claims dismissed by Best Medium. The court rejected this argument stating that "[t]he District Court concluded that 'the prevailing party' is the one who prevails as to the substantial part of the litigation, here the Enquirer. We will defer to the trial court in this respect"[213]

b. Party Prevailing on a "Significant Issue In the Litigation"

Gamma Audio & Video, Inc. v. Ean-Chea[214] involves a number of issues arising from the infringement of a translation as a derivative work, the issue of multiple or single infringement(s) of four copyrighted episodes from a foreign

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211. Gamma Audio & Video, Inc. v. Ean-Chea, 11 F.3d 1106, 1109 (1st Cir. 1993) (quoting Video Views, Inc. v. Studio 21, Ltd., 925 F.2d 1010, 1022 (7th Cir.) (citation omitted), *cert denied*, 502 U.S. 861, 112 S. Ct. 181, 116 L. Ed. 2d 143 (1991)).
212. 385 F.2d 384 (7th Cir. 1967), *cert denied*, 390 U.S. 955, 88 S. Ct. 1052, 19 L. Ed. 2d 1150 (1968).
213. *Id.* at 386–87.
214. 11 F.3d 1106 (1st Cir. 1993).

language television series, and an award of attorney's fees and costs to the "prevailing party."

The essential facts are the following:

Gamma (a collective designation for Gamma Audio and Video, Inc., and individual plaintiffs) obtained, pursuant to four license agreements (recorded in the Copyright Office), three exclusive rights to videotaped programs owned by Television Broadcasts Ltd. ("TVB"), a producer of Chinese language television programs. These rights were to: (1) dub the programs into Cambodian; (2) duplicate the dubbed versions; and (3) distribute for rental the dubbed versions to thirty-seven states, including Massachusetts, where the case was litigated. The derivative works (i.e., the Cambodian versions) were never registered for copyright protection. Gamma then entered into an agreement with Tsing Tao and his partners granting them exclusive rights to distribute the Cambodian version in Massachusetts and five other states. Ean-Chea was at the time the authorized distributor of (apparently other) Cambodian versions of TVB's Cambodian versions from Gamma's predecessor. Ean-Chea commenced making unauthorized sales of the Cambodian versions. Gamma sued, alleging six claims for copyright infringement, Lanham Act violations, and state law claims: unfair competition, conversion, tortious interference, and a constructive trust. The district court entered judgment for Gamma, holding that the unauthorized distribution of four of these episodes constituted one infringement. Gamma, however, dismissed five non-copyright claims before trial and was unsuccessful in proving other copyright claims. The court awarded attorneys' fees and costs to Gamma as the prevailing party. Both sides appealed.

The First Circuit reversed the district court, holding that there were four separate infringements rather than just one, the rationale being that each "can live its own copyright life" and that the expression in each "has an independent economic value and is, in itself, viable."[215]

Although Gamma requested an award of $80,198.62 for attorney's fees and $7,609.87 in costs, the district court awarded the costs requested, but cut the fees to $12,500 on the ground that Gamma had over-prosecuted their case, pursued infringement actions on works that were not registered, and achieved very limited success.[216]

Ean-Chea's argument that he, not Gamma, was the prevailing party was because of Gamma's voluntary dismissal of the noncopyright claims and its concession that twelve episodes of a series titled *Jade Box* had not been timely registered and its lack of success as to its infringement claims with respect to a series titled *Hunters Prey*. Even with these dismissals and failure to prove infringements, the First Circuit affirmed the district court's award to Gamma

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215. *Id.* at 1117 (citing Walt Disney Co. v. Powell, 897 F.2d 565, 569 (D.C. Cir. 1990)).
216. *See id.* at 1118.

as the prevailing party. The court's discussion is instructive: "Ean-Chea argues that Gamma did not 'prevail' because, prior to trial, it voluntarily dismissed the five non-copyright claims in the complaint, conceded that it was not entitled to statutory damages on twelve episodes of *Jade Fox* whose copyrights had not been registered prior to the commencement of this action, and failed to prove infringement with respect to the *Hunters Prey* videotapes. Although all of this is true, Gamma did succeed on its infringement claim with respect to episodes thirteen through sixteen of *Jade Fox*. While we recognize that Gamma downscaled its case as the litigation proceeded, in light of its victory vis-à-vis the four episodes of *Jade Fox*, we have little trouble in concluding that Gamma succeeded on a 'significant issue in the litigation'. . . . [The] significance must be viewed in light of 'the scope and tenor of the litigation as a whole.'"[217]

The court denied Gamma's request for attorneys' fees on appeal.

c. The Prevailing Party: The Statutory Offer

Rule 68 of the Federal Rules of Civil Procedure provides in substance that if the defending party, at any time more than ten days before trial, makes an offer, and the offer is not accepted, the party receiving the offer must pay *costs* to the other party, if the judgment the offeree obtains is not as favorable as the offer.[218]

In *Shapiro, Bernstein & Co. v. 4636 S. Vermont Ave., Inc.*,[219] the plaintiff, a significant music publisher, owned an extensive catalogue of copyrighted popular songs. The defendant, 4636 So. Vermont Ave., owned a small retail

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217. *Id.* at 1114 (citation omitted).

218. Rule 68. Offer of Judgment.

(a) Making an Offer. Judgment on an Accepted Offer. More than 10 days before the trial begins, a party defending against a claim may serve on an opposing party an offer to allow judgment on specified terms, with the costs then accrued. If, within 10 days after being served, the opposing party serves written notice accepting the offer, either party may then file the offer and notice of acceptance, plus proof of service. The clerk must then enter judgment.

(b) Unaccepted Offer. An unaccepted offer is considered withdrawn, but it does not preclude a later offer. Evidence of an unaccepted offer is not admissible except in a proceeding to determine costs.

(c) Offer After Liability Is Determined. When one party's liability to another has been determined but the extent of liability remains to be determined by further proceedings, the party held liable may make an offer of judgment. It must be served within a reasonable time—but at least 10 days—before a hearing to determine the extent of liability.

(d) Paying Costs After an Unaccepted Offer. If the judgment that the offeree finally obtains is not more favorable than the unaccepted offer, the offeree must pay the costs incurred after the offer was made.

Fed. R. Civ. P. 68.

219. 367 F.2d 236 (9th Cir. 1966).

music store whose sales were comprised overwhelmingly (98%) of pianos and organs. One and one-half percent of revenues was realized from sales of sheet music. Defendant purchased four copies of an unauthorized collection of plaintiff's copyrighted songs to sell retail to its customers. Although the court found that there was an infringement, it also found that it was *de minimus* and that the music store was the "prevailing party." The Ninth Circuit affirmed in an unusual factual setting: Because the defendant made an offer to settle for $50 and the plaintiff was awarded nothing, Shapiro, Bernstein was not the prevailing party based on the court's local rules.[220] The district court's award of attorneys' fees was reversed because the circuit court was "unable to agree that appellant brought this suit in bad faith knowing the cases were against it and without belief in the merits of the claim."[221] This holding by the appellate court was obviously made in the pre-*Fogerty* era, when bad faith and frivolity were required in order to award a plaintiff attorney's fees.

VII. Costs

The 1976 Copyright Act made a significant shift in the treatment of costs when it provided that the decision whether to award costs and to whom—the prevailing or losing party—is left to the discretion of the court.[222]

The approach to *allowing* costs to either party, somewhat unlike the standards for awards of attorneys' fees, seems to require that there must be proof of some element of bad faith against the party from whom the award of costs is requested, but whether or not to make the award is still left up to the court's sound discretion.[223] In exercising discretion, the court may also take into

220. At the time, Local Rule 15(c) of the Local Rules, United States District Court for the Southern District of California, provided the following, in relevant part: "If the defendant offers a judgment in a certain sum which is rejected by the plaintiff, and the case thereafter, goes to trial with the resulting recovery of only the amount previously offered by the defendant, or less, then the defendant is the prevailing party."

221. *Id.* at 243.

222. *See* 17 U.S.C. § 505. *See also* Diamond Star Bldg. Corp. v. Freed, 30 F.3d 503 (4th Cir. 1994) (reversing the lower court's denial of attorneys' fees and costs to prevailing defendant pursuant to abuse of discretion standard).

223. *See* Warner Bros., Inc. v. American Broad. Cos., Inc., 720 F.2d 231 (2d Cir. 1983). The district court granted summary judgment to the defendants in a copyright infringement and unfair competition case involving a famous comic book, movie and television character alleged to be infringed by a television show featuring a parody of that character. In granting the defendants' motion for summary judgment, the court awarded attorneys' fees and costs as provided in Rule 54(d) of the Federal Rules of Civil Procedure. The court, however, refused to award any additional costs under the Copyright or Lanham Acts. In affirming, the circuit court stated: "Though defendants were surely entitled to urge the District Judge that creativity and competition could be chilled by the prospect of defending litigation like this suit and

account equitable considerations, which, for example, is what happened when one court refused to award costs of almost $28,000 sought by a multimillion dollar corporation against an individual.[224]

Generally, those categories of costs which may be awarded, subject to the standards discussed above, include the following: Court costs, including filing and service fees;[225] reasonable photocopying charges;[226] transcripts of proceedings;[227] costs of investigation to establish that defendants had infringed the copyrighted work;[228] costs of licenses;[229] and secretarial costs, copying, telephone charges, and travel necessarily related to the litigation.[230]

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that defendants should therefore be awarded attorney's fees under the Copyright and Lanham Acts . . . for having to resists plaintiff's claims, [the district court judge's] decision not to award fees and added costs was not an abuse of discretion." *Id*. at 248.

224. *See* Sanford v. CBS Inc., 108 F.R.D. 42, 43 (N.D. Ill. 1985) (where the court, in providing the rationale for its ruling states that "§ 505 vests broad discretion in the courts regarding the assessment of costs in copyright actions—no presumptions in favor of the prevailing party are created. We believe the denial of all costs is a proper exercise of our discretion under the circumstances of this case. Taxation of the costs sought by CBS would impose a great hardship on Sanford and his wife, possibly driving them into bankruptcy. On the other hand, the amount of costs is immaterial to CBS, a multi-billion dollar corporation. Furthermore, Sanford's case was far from meritless. Although the trial took only about six days, the jury deliberated for approximately twenty-six hours. Given the close outcome of the case, it would be inequitable to force Sanford into financial ruin for bringing in good faith what appeared to be a legitimate copyright claim"). *See also* Warner Bros., Inc. v. Dae Rim Trading, Inc., 677 F. Supp. 740 (S.D.N.Y. 1988). In *Dae Rim Trading*, the plaintiff Warner prevailed and was granted an injunction against further infringements by the defendant, but the court found that the infringement itself was innocent and technical in nature, in addition to which the plaintiff and one of its lawyers were overly aggressive and abusive, not only to the defendant, but to the judicial system, as well. The district court awarded defendant its costs and also attorneys' fees. The award of costs to defendant was affirmed, but the award of attorneys' fees was reversed by the appellate court. *See* Warner Bros., Inc. v. Dae Rim Trading, Inc., 877 F.2d 1120 (2d Cir. 1989).

225. *See* Wow & Flutter Music v. Len's Tom Jones Tavern, Inc., 606 F. Supp. 554, 557 (W.D.N.Y. 1985).

226. *See* Blendingwell Music, Inc. v. Moor-Law, Inc., 612 F. Supp. 474, 487 (D. Del. 1985).

227. *See* NLFC, Inc. v. Devcom Mid-America, Inc., 916 F. Supp. 751, 763–64 (N.D. Ill. 1996). *See also* Data Gen. Corp. v. Grumman Sys. Support Corp., 825 F. Supp. 361, 366–67 (D. Mass. 1993) (where the court held that costs for obtaining daily transcripts of a trial were recoverable).

228. *See* Paramount Pictures Corp. v. Sullivan, 546 F. Supp. 397, 399 (D. Me. 1982). *Cf*. United Features Syndicate, Inc. v. Spree, Inc., 600 F. Supp. 1242, 1248 (E.D. Mich. 1984) (court denied costs for investigators' services that the court concluded were not appropriate costs of the litigation).

229. *See* Van Halen Music v. Palmer, 626 F. Supp. 1163, 1167 (W.D. Ark. 1986) (copyright proprietors attempted to secure a licensing agreement from the defendant who infringed their musical composition. In addition to awarding statutory damages, the court also approved an allowance of $610.87, representing the amount spent by ASCAP in an attempt to secure an agreement from the defendant granting him a license to use the plaintiff's music).

230. *See* Superior Form Builders v. Dan Chase Taxidermy Supply Co, Inc., 881 F. Supp. 1021, 1028–29 (E.D. Va. 1994), *aff'd*, 74 F.3d 488 (4th Cir.), *cert. denied*, 519 U.S. 809, 117 S. Ct. 53, 136 L. Ed. 2d 16 (1996).

Courts have denied awards of costs for the following: costs of registering a copyright;[231] defendant's costs after reversal of a plaintiff's judgment when plaintiff was not in bad faith and did not unnecessarily litigate a baseless claim.[232]

VIII. Arbitration

A. The Availability of Arbitration to Resolve Infringement Claims

The mating of a claim for copyright infringement with arbitration may, at first impression, appear incongruous. The construction and application of the Copyright Acts of 1909 and 1976 has always been the province of the federal judiciary, which furnishes the jurisdictional venue for the resolution of copyright infringement disputes. The issue of unlawful copying of protected works may, however, be determined by an arbitrator subject to the jurisdictional oversight and eventual confirmation or vacation of an award by the federal courts. With some exceptions, arbitration is consensual and therefore the parties must consent to arbitration either by a provision in a written agreement to arbitrate disputes that may arise within a particular venture (e.g., construction of a building, production of a motion picture, etc.), or by a written agreement submitting an existing dispute to arbitration (called a "submission agreement").

This issue was presented in 1981 in the Southern District of New York in the *Kamakazi Music/Robbins Music* litigation.

B. *Kamakazi Music Corporation v. Robbins Music Corporation*[233]

Kamakazi Music ("Kamakazi") was a corporation wholly owned by Barry Manilow, a best-selling songwriter and recording artist. Kamakazi owned the catalogue of Manilow's works and "so-called personality folios and other formats." Personality folios are "printed publications which feature musical compositions by a particular artist," which, in the instant case, was Manilow.[234]

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231. *See* Bly v. Banbury Books, Inc., 638 F. Supp. 983, 989 (E.D. Pa. 1986).
232. *See* TVT Records v. Island Def Jam Music Group, 446 F. Supp. 2d 235, 241–42 (S.D.N.Y. 2006).
233. 522 F. Supp. 125 (S.D.N.Y. 1981), *aff'd*, 684 F.2d 228 (2d Cir. 1982).
234. *Id.* at 127.

In November 1976, Kamakazi and Robbins entered into a written license agreement for the publication of a selection of Manilow songs by Robbins (the "License"). In addition, Robbins was granted the exclusive right to sell those compositions in various formats, including personality folios. Under the terms of the License, Robbins's rights lapsed on December 31, 1979, with the right upon notice by Robbins to sell off those folios on hand until July 31, 1980, when the sell-off right would also terminate. Robbins claimed that it had the right to print and manufacture the personality folios until December 31, 1980, and to sell off those folios in addition to those that were on hand on July 31, 1980, and it proceeded to do so. Manilow and Kamakazi filed a complaint in federal district court in New York, alleging copyright infringement based upon the unauthorized manufacture and sale of folios after the term of the License had lapsed. Kamakazi sought a preliminary injunction against Robbins's further manufacture and selling of personality folios, which was denied by the court. Robbins cross-moved for dismissal for lack of jurisdiction, or, in the alternative, for a stay of further proceedings pending arbitration pursuant to an arbitration clause in the License.[235] Robbins's defenses in the arbitration included its contention that the dispute involved only contract principles (as distinguished from copyright law) to determine damages under New York law. The court discussed what it described as "two overriding principles which are posed in this action [that] apparently conflict."[236] The first principle was the strong federal policy favoring arbitration to resolve private disputes. The second was the principle that "actions arising under certain federal statutes which provide for exclusive federal court jurisdiction, including antitrust, securities and patent" are of public concern and therefore a matter of public policy precluding state courts or arbitration of those disputes.[237]

The arbitrator found that Robbins infringed twenty-five separate Kamakazi copyrights, that the printing and sale of the folios constituted willful infringement, and awarded statutory $10,000 for all multiple infringements of each copyright, a total of $250,000. The arbitrator also awarded attorneys' fees of $50,127.72 to Kamakazi. The arbitrator, however, declined to rule on the validity of the copyrights, concluding that that was within the exclusive jurisdiction of the federal courts.

District Court Judge Sweet confirmed the award. With respect to the two principles that were in conflict (federal policy favoring arbitration and public policy requiring resolution of copyright disputes by the federal courts), he

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235. *See id.* The arbitration clause in the Agreement provided, in pertinent part, as follows: "[A]ny controversy or claim arising out of, or relating to this agreement or the subject matter thereof, or the breach hereof shall be settled by arbitration in the City of New York in accordance with the rules then obtaining of the American Arbitration Association, and judgment upon the award rendered may be entered in any Court having jurisdiction thereof." *Id.* at 127 n.2.

236. *Id.* at 130

237. *Id.*

held that the arbitrator had jurisdiction of the infringement claim as well as other noninfringement claims, but not of the defense raised by Robbins regarding the validity of Kamakazi's copyrights. The judge explained that "[w]hile an arbitrator . . . is commonly thought to lack jurisdiction to determine the validity of a copyright, . . . here the arbitrator did not make the determination of validity."[238] Judge Sweet held that that issue (the validity of Kamakazi's copyright) was within the exclusive jurisdiction of the federal court, which the court resolved in favor of Kamakazi.[239] Confirmation of the arbitrator's award of damages was based on Robbins's infringement of the Kamakazi copyright. The Second Circuit affirmed.[240]

C. *The Federal Court v. The Arbitration Tribunal:* Advantages and Disadvantages

It is unusual for a copyright infringement dispute to be arbitrated. Arbitration is touted by its supporters for its advantages: speedy resolution of disputes, informality, saving of attorneys' fees and costs, and a hearing before an expert in the field or business in which the dispute arose. In arbitration, however, there are disadvantages: no jury, no rigorous application of exclusionary evidentiary rules, no discovery and, for the losing party, no appeal. The nonprevailing party, of course, has the right to move that the award be vacated. In that regard, the Second Circuit, in *Kamakazi*, observed that "[e]ven if the arbitration clause did not encompass Kamakazi's claims, it is hornbook law that parties by their conduct may agree to send issues outside an arbitration clause to arbitration. . . . Robbins forced Kamakazi to submit its claim to arbitration and urged the arbitrator to consider all of the issues between the parties. Robbins by its conduct clearly agreed to submit all claims under the Copyright Act to the arbitrator, including, Kamakazi's claim—pressed from the start—for attorneys' fees."[241] The court went on to observe that "Robbins contends that 'public policy' prohibits submission of copyright claims to arbitration, but it cites no case for this proposition and we can find none. Public policy does prohibit submission of some securities, patent and antitrust claims

238. *Id.* at 131.

239. The court stated: "In this court's opinion of June 5, 1980, it was determined that this action arises under the copyright law, in that the complaint is directed against an offending use, and refers to the license agreement only by way of anticipatory replication. . . . Such a determination establishes the court's jurisdiction over the subject matter under 28 U.S.C. § 1338, as it did in this case, defeating Robbins' motion to dismiss, and also, traditionally, precludes arbitration of the dispute, since the subject matter of the dispute has been thus cast as belonging to the exclusive competence of the federal courts." 522 F. Supp. at 131 (citations omitted).

240. *See* Kamakazi Music Corp. v. Robbins Music Corp., 684 F.2d 228 (2d Cir. 1982).

241. *Id.* at 231 (citations omitted).

to arbitration. . . . The only 'public interest' in a copyright claim concerns the monopoly inherent in a valid copyright. The validity of copyrights here, and therefore the existence of the monopoly, was not determined by the arbitrator, but by the district court. Consequently, we see no public policy against arbitration of this claim for infringement of a valid copyright."[242] In other words, and from a procedural point of view, the issue that was first determined by the arbitrator was the infringement which resulted in the award in favor of Kamakazi. That award, however, did not become effective until the case returned to the federal court for determination of the copyrights' validity. That having been determined, the award was confirmed by the appellate court and became a judgment within the federal court system.

The tactical maneuver in *Kamakazi* was made by the defendants, who invoked the arbitration clause as a means to avoid a jury trial. Thus, Kamakazi and Manilow were dragged into the arbitration proceedings, having first counted on a trial in federal court, undoubtedly before a jury. It is obvious that Robbins's maneuver backfired; Robbins was shorn of the viable right of appeal it would have had if the trial had been conducted in federal district court. It is ironic to note that those advantages purportedly available in arbitration proceedings—speedy resolution and savings of attorney's fees and costs—were not the hallmark of this litigation. The arbitration consumed eight months before the American Arbitration Association, generating 2,000 pages of transcript and substantial attorneys' fees for both sides.

D. Practice Point: Whether To Choose Arbitration As a Remedy

The foregoing is not meant to discourage parties and their counsel from using arbitration to resolve copyright infringement disputes. Even though Kamakazi and Barry Manilow achieved a good result in arbitration after first filing their infringement claims in federal court, they were dragged into arbitration by the defendants based on an arbitration clause in an agreement documenting a business relationship between the parties. The lesson is not that the plaintiffs achieved a desirable result in arbitration, but that they were in arbitration at all.

After many years of experience in both copyright infringement disputes and arbitration proceedings, the author would advise plaintiffs to use the federal courts as the forum for resolving these disputes. It is not for the reason that federal judges have greater knowledge of the copyright law (practicing lawyers are often more familiar with its substance and nuances because the specialist can devote more of his or her time and energy to it), but rather

242. *Id.* (citations omitted).

because of the advantages the court system provides (e.g., discovery, appeal, etc.), without the necessity of negotiating an agreement to achieve them. If, however, a copyright dispute is an appropriate one for arbitration, there are a number of important considerations for the lawyer before agreeing to arbitrate an infringement claim. The first is whether to even permit arbitration as a dispute resolution mechanism.

a. Omnibus Arbitration Clauses and Submission Agreements[243]

This issue can be fairly easy to evaluate when negotiating a "Submission Agreement" submitting a specific *existing* dispute to arbitration. Evaluation becomes much more complex when drafting a so-called "omnibus arbitration clause" providing for arbitration of unknown future disputes related to a larger contract. In the latter case, the attorney and client must try to look into the future and anticipate the types of disputes that may arise under the particular facts and circumstances prevailing at the time the dispute surfaces.[244]

b. Evaluating the Desirability of Arbitration

In general, the decision to submit a present or future controversy to arbitration involves some tradeoffs when compared to resolving the controversy in court. The advantages of the courts are well known to attorneys. Our judicial system provides for extensive discovery, careful regulation of the admissibility of evidence, and safeguards designed to assure correct application of the law, including the right of appeal. In some cases it is also important that reported court cases establish legal precedents. In contrast, arbitration increases the likelihood of a comparatively speedy and inexpensive resolution of a controversy. If agreed on by the parties, arbitration also provides the opportunity for determination of the controversy by one or more arbitrators having expertise in the subject matter. This can be particularly important in cases involving scientific or engineering issues. Further, arbitration can provide secrecy.

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243. This section is adapted from an article by the author. *See* Ronald S. Rosen, *A Business Litigator's Advice to Attorneys Drafting Arbitration and Other ADR Agreements*, 8 CEB California Business Law Practitioner 230 (Fall 1993).

244. Statutes and court decisions now strongly favor the use of arbitration for an ever-expanding variety of disputes. Indeed, the United States Supreme Court has declared that implementation of the arbitral process is a national policy of the United States. *See* Shearson/American Express, Inc. v. McMahon, 482 U.S. 220, 226, 107 S. Ct. 2332, 2337, 96 L. Ed. 2d 185 (1987).

Although arbitration supposedly requires the consent of the parties with respect to procedures, the scope of disputes subject to arbitration, and the remedies available to the arbitrator, the law is quick to provide missing terms when the arbitration agreement is silent or ambiguous, often to the detriment of one of the parties.

The relevance of these considerations will vary with the facts, but in many business contexts, a quick, speedy resolution is imperative. For example, a manufacturer can rarely afford the production delays that may result from a dispute over the specifications of a part for which there is only one source of supply. In deciding whether to agree to arbitrate, the relevant issues include:

- Whether a speedy resolution will be necessary should a dispute arise;
- Whether it is important to have a subject matter expert as the trier of fact;
- Whether extensive discovery is needed for a fair determination of the issues;
- Whether there is a relevant difference in the remedies available from the arbitrator in contrast to those available from a court;
- Whether the right of appeal is important;
- Whether the party has the bargaining power necessary to negotiate custom terms for the arbitration agreement that are perceived as favorable (e.g., a clause permitting some limited discovery or a clause requiring arbitration only for certain types of disputes).

c. Significant Terms for an Arbitration Agreement

Agreement for the arbitration of future controversies should address a number of specific issues, including:

- The types of controversies that will be subject to the agreement;
- The remedies available to the arbitrators;
- The qualifications of the arbitrators and the manner of selection;
- The allocation of the costs of the arbitration;
- Rules of discovery;
- Procedural and evidentiary rules, including the procedures for initiating the proceeding;
- Choice of law;
- Right of appeal;
- If possible, mandatory mediation before arbitration.

To the extent that these issues may be addressed by silence, the effect is to adopt the statutory rules of either a state arbitration statute, or the rather sketchy provisions of the Federal Arbitration Act ("FAA").[245] (As a practical

245. *See* 9 U.S.C. §§ 1–16.

matter, the FAA simply provides for appointment of an arbitrator and then leaves most issues up to the arbitrator's broad discretion).[246]

The issues may also be addressed by adopting a specific set of rules by reference (e.g., one of the sets of rules of the American Arbitration Association).

Finally, these issues may be addressed by express custom contract provisions or a combination of such provisions and an incorporation by reference of a set of rules with respect to matters not expressly addressed. Regardless of the method of specifying the applicable rules, counsel must have read and considered them very carefully.

Part Two: Injunctive Relief and Impoundment

IX. Injunctive Relief

A. General Principles

Section 502(a) of the Copyright Act provides that "[a]ny court having jurisdiction of a civil action arising under this title may . . . grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright."[247] The injunctive relief available includes temporary restraining orders, preliminary injunctions, and permanent injunctions.[248] To obtain an injunction, the plaintiff also must file a complaint.[249]

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246. Regardless of which statutory scheme the parties use as a guideline for procedural rules to apply, a petition to confirm, correct or vacate an arbitration must be filed in a Federal District Court. *See* 9 U.S.C. §§ 9–11.

247. 17 U.S.C. § 502(a).

248. *See* 17 U.S.C. § 502(a); H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 160 (1976) (this section "reasserts the discretionary power of courts to grant injunctions and restraining orders, whether 'preliminary,' 'temporary,' 'interlocutory,' 'permanent,' or 'final,' to prevent or stop infringements of copyright").

249. Section 112 of the 1909 Copyright Act expressly provided that a complaint must be filed before an injunction could issue. While there is no similar express requirement in the current Act, section 502(a) requires that the court have "jurisdiction of a civil action," which has the same practical effect as the prior express provision necessitating a complaint. Note, however, that section 411(b) of the Act contains an unusual provision pursuant to which a preliminary injunction may be obtained before the work at issue has even been infringed, and even before it has been reduced to tangible form. *See* 17 U.S.C. § 411(b) ("In the case of a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission, the copyright owner may, either before or after such fixation takes place, institute an action for infringement. . . .").

The issuance of the injunction is discretionary with the court, except that no injunctions may issue against the United States.[250]

In light of the Act's proscription that preliminary and permanent injunctions issue "to prevent or restrain infringement of a copyright,"[251] the injunctive relief granted should be coextensive in range and scope with the infringement at issue. Indeed, "[i]njunctive relief should be narrowly tailored to fit specific legal violations. . . . Accordingly, an injunction should not impose unnecessary burdens on lawful activity. . . ."[252] Thus, ancillary benefits that may arise as a result of infringement should not be enjoined.[253]

As a general matter, the scope of an injunction should be no broader than the infringement at issue, and it should be carefully worded to define clearly the proscribed conduct.[254] For example, in one case, the district court had enjoined defendant in connection with the infringing product and its first unsuccessful attempt to redact the infringing product, but also as to "all future modifications and revisions." The circuit court rejected the last portion of the injunction, explaining that "the most that [the district court] could enjoin were future modifications and improvements . . . that are substantially similar to [the copyrighted work]."[255] Thus, with the narrowly tailored injunction, defendant could feel "free to continue its efforts to devise a non-infringing"[256] version of its product, even though its original product was a nearly identical copy of the copyrighted work and its first redacted version was likewise a "child of infringement."[257]

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250. Neither a permanent nor preliminary injunction may issue against the United States government, as is clear from the reference in section 502(a) to section 1498 of title 28. *See* 17 U.S.C. § 502(a) ("Any court having jurisdiction of a civil action arising under this title may, subject to the provisions of section 1498 of title 28, grant temporary and final injunctions. . . ."); 28 U.S.C. § 1498(b) ("the exclusive action [for copyright infringement by the United States] . . . shall be an action by the copyright owner against the United States in the Court of Federal Claims for the recovery of his reasonable and entire compensation as damages for such infringement, including the minimum statutory damages. . . ."). Courts, however, may enjoin states and their instrumentalities. *See* 17 U.S.C. § 511(b) ("remedies (including remedies both at law and in equity) are available for the violation [of copyright infringement against a state] to the same extent as such remedies are available for such a violation in a suit against any public or private entity other than a State. . . .").
251. 17 U.S.C. § 502(a).
252. Waldman Publ'g Corp. v. Landoll, Inc., 43 F.3d 775, 785 (2d Cir. 1994) (citations omitted) (vacating preliminary injunction based on Lanham Act claim regarding defendant's publishing of books that were substantially similar to plaintiff's books).
253. *See* Epic Metals Corp. v. Souliere, 181 F.3d 1280, 1284–85 (11th Cir. 1999) (after defendant was once again allowed to sell its product, the district court enjoined defendant from advertising that its product was certified with an Underwriter's Laboratory fire rating, since the rating stemmed from infringement in its catalog).
254. *See* Kepner-Tregoe, Inc. v. Leadership Software, Inc., 12 F.3d 527 (5th Cir. 1994).
255. *Id.* at 538.
256. *Id.*
257. *Id.* at 536.

Another caveat regarding the crafting of injunctions is that an injunction should not act to prevent the infringer from reproducing ideas, facts, methods, and related matters, since ideas, facts, methods, etc. are not copyrightable.[258] In *Lipton v. Nature Company*, for example, plaintiff, who had compiled collective terms for identifying certain animal groups in a book, sued another compiler of terms for copyright infringement. The circuit court affirmed the district court's granting summary judgment for plaintiff, finding that defendant had infringed plaintiff's protected compilation.[259] However, the circuit court ruled that the lower court's injunction, which prohibited defendant from copying, producing, or selling any infringing products or "any other products substantially similar to the said infringing products and/or incorporating, in whole or in part, plaintiff's copyrighted and inherently distinctive compilation," was excessively broad.[260] While copying plaintiff's entire compilation constituted infringement, the circuit court explained that defendant could properly manufacture a mug or a t-shirt with the single references to a "leap of leopards," a "sloth of bears," a "rafter of turkeys," a "dule of doves" or a "skulk of foxes" without infringing plaintiff's work.[261] This is because it was the "compilation—*i.e.*, the selection and arrangement—of the terms that is protectible, not the individual terms themselves."[262]

Likewise, a court fashioning injunctive relief must be careful to avoid violating a defendant's First Amendment rights. "While a specifically-tailored injunction in a copyright case does not offend the First Amendment, attempting to shut down a critic's speech activities, including those that do not implicate the copyright laws in the least, would constitute an unwarranted prior restraint on speech."[263]

In defining the scope of an injunction, a court also must be careful to consider what conduct may be prohibited or required as a practical matter. Thus, in *A&M Records, Inc. v. Napster, Inc.*, a case in which Napster, an Internet startup, allowed users to share and download MP3 music files with other users logged on to the site through its "peer-to-peer" file sharing software, the Ninth Circuit upheld the issuance of an injunction by the district court, but reversed

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258. *See, e.g.*, Lipton v. Nature Co., 71 F.3d 464 (2d Cir. 1995).
259. *See id.* at 469–72.
260. *Id.* at 474–75.
261. *See id.* at 475; *see also id.* at 472 n.5.
262. *Id.* at 475.
263. Religious Tech. Ctr. v. Netcom On-Line Communication Servs., Inc., 923 F. Supp. 1231, 1259 (N.D. Cal. 1995). In discussing these First Amendment concerns, the court noted that "the 1976 Act explicitly sanctions the use of preliminary injunctions in the case of copyright infringement," that the Supreme Court "recognized that the Copyright Act itself embodies a balance between the rights of copyright holders, guaranteed by the Constitution, U.S. Const. art. I, § 8, and the protections of the First Amendment," and that the "doctrine of fair use already considers First Amendment concerns." *Id.* at 1258.

on the grounds that the scope of the injunction was overly broad.[264] The appellate court explained:

> The preliminary injunction which we stayed is overbroad because it places on Napster the entire burden of ensuring that no "copying, downloading, uploading, transmitting, or distributing" of plaintiffs' works occur on the system. As stated, we place the burden on plaintiffs to provide notice to Napster of copyrighted works and files containing such works available on the Napster system before Napster has the duty to disable access to the offending content. Napster, however, also bears the burden of policing the system within the limits of the system. Here, we recognize that this is not an exact science in that the files are user named. In crafting the injunction on remand, the district court should recognize that Napster's system does not currently appear to allow Napster access to users' MP3 files.[265]

In a later appeal, the Ninth Circuit upheld the injunction issued by the district court that required plaintiffs to provide file names found on the Napster index corresponding to plaintiffs' copyrighted works before those works were entitled to protection, requiring Napster to block all files containing the identified works.[266] Plaintiffs challenged the requirement that they be obligated to supply the file names corresponding to their copyrighted works, but the appellate court found this requirement proper, because it placed on plaintiffs an appropriate "burden" in which "[b]oth parties are required to adopt reasonable measures to identify variations of the file name, or of the spelling of the titles or artists' names, of plaintiffs' identified protected works."[267]

Later, the district court ordered Napster to work on a "zero tolerance" policy regarding the works properly identified by plaintiffs in which Napster used a new filter that analyzed the contents of a file using "audio fingerprinting technology."[268] After several months of monitoring, the district court ruled that Napster still was not in compliance with the modified injunction, and, accordingly, it issued a shut-down order against Napster's site.[269] The Ninth Circuit affirmed the shut down order.[270]

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264. 239 F.3d 1004, 1027 (9th Cir. 2001). *See also* A&M Records, Inc. v. Napster, Inc., 114 F. Supp. 2d 896 (N.D. Cal. 2000).
265. 239 F.3d at 1027.
266. *See* A&M Records, Inc. v. Napster, Inc., 284 F.3d 1091, 1096–97 (9th Cir. 2002).
267. *Id.* at 1096.
268. *Id.* at 1097.
269. *See id.* at 1096.
270. *See id.* at 1097–99.

B. Temporary Restraining Orders

Where a copyright owner requires immediate relief and can make a showing that it will suffer irreparable harm from the delay necessitated by having to provide notice to the infringer, it may obtain the extraordinary relief of a temporary restraining order upon an *ex parte* application.[271] To obtain a temporary restraining order for copyright infringement, the plaintiff must abide the requirements necessary for any type of temporary restraining order as set forth in the Federal Rules of Civil Procedure.[272] More particularly, the moving party must present "specific facts in an affidavit or a verified complaint [that] clearly show that immediate and irreparable injury, loss, or damage will result to the movant before the adverse party can be heard in opposition."[273] Additionally, the "movant's attorney [must] certif[y] in writing any efforts made to give notice and the reasons why it should not be required."[274]

A restraining order may not issue unless the movant "gives security in an amount that the court considers proper to pay the costs and damages sustained by any party found to have been wrongfully enjoined or restrained."[275] The court fixes the time for the temporary restraining order to expire, but it shall not be more than ten days after its entry, unless the court, for good cause, extends it for a second period, not to exceed ten days, or unless the adverse party consents to a longer extension.[276]

Because the purpose of a temporary restraining order is to preserve the status quo until a preliminary injunction hearing can be held, cases indicate that the plaintiff must make a showing of at least the standards imposed for preliminary injunction.[277] Due to the extraordinary nature of the remedy, however, arguably, the standards for a temporary restraining order should be more rigorous than the irreparable harm standard for preliminary injunctions.

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271. Although section 502(a) discusses only a court's authority to grant "temporary and final injunctions," the House Report explains that this section "reasserts the discretionary power of courts to grant injunctions and restraining orders, whether 'preliminary,' 'temporary,' 'interlocutory,' 'permanent,' or 'final,' to prevent or stop infringements of copyright." H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 160 (1976); *see also* 17 U.S.C. § 502(a).
272. *See* Fed. R. Civ. P. 65(b). Note that Federal Rule of Civil Procedure 65 was amended effective December 1, 2007.
273. Fed. R. Civ. P. 65(b)(1)(A).
274. Fed. R. Civ. P. 65(b)(1)(B).
275. Fed. R. Civ. P. 65(c).
276. *See* Fed. R. Civ. P. 65(b)(2).
277. *See, e.g.*, Horn Abbot Ltd. v. Sarsaparilla Ltd., 601 F. Supp. 360, 364–65, 368 (N.D. Ill. 1984); O'Neill Devs., Inc. v. Galen Kilburn, Inc., 524 F. Supp. 710, 712, 715 (D. Ga. 1981). *See, infra*, section IX.C for a more detailed discussion on the substantive requirements for obtaining a preliminary injunction.

C. Preliminary Injunctions

1. General Considerations and Procedure

To obtain a temporary (preliminary) injunction, a copyright owner typically will file a complaint, a motion and memorandum of law, supporting affidavits, a proposed order, and the certificate of registration for the copyrighted work at issue.[278] The movant may want to accompany its motion with a request for expedited discovery to obtain the facts it needs for the hearing on the preliminary injunction. Indeed, the Federal Rules allow the court to "advance the trial on the merits and consolidate it with the hearing [for a preliminary injunction]."[279]

To obtain an injunction, the aggrieved party should be diligent and not wait too long to seek relief. Too much of a delay in plaintiff's attempt to obtain preliminary relief may defeat the injunction.[280] Likewise, if plaintiff appears to have acquiesced in defendant's infringing activities, that fact also may defeat the injunction.[281]

A preliminary injunction requires that the movant serve notice on the adverse party.[282] Additionally, as with a temporary restraining order, the party moving for a preliminary injunction must post "security in an amount that the court considers proper to pay the costs and damages sustained by any party found to have been wrongfully enjoined or restrained."[283] Although a court may determine that no bond is necessary to secure the preliminary injunction upon a finding that, under the circumstances, no security was required, it has been held to be error for a court not to make any finding in that regard when issuing the preliminary injunction.[284]

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278. *See* 11A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, Federal Practice and Procedure § 2949 (2d ed. 1995 & 2001 Supp.).
279. Fed. R. Civ. P. 65(a)(2).
280. *See, e.g.*, Gianni Cereda Fabrics, Inc. v. Bazaar Fabrics, Inc., 335 F. Supp. 278, 280 (S.D.N.Y. 1971) ("'[b]y sleeping on its rights a plaintiff demonstrates the lack of need for speedy action and cannot complain of the delay involved pending any final relief to which it may be entitled after a trial of all the issues'") (citation omitted); Klauber Bros., Inc. v. Lady Marlene Brassiere Corp., 285 F. Supp. 806, 808 (S.D.N.Y. 1968) (one year of inaction after discovery of infringement "disentitles [movant] from the drastic threshold remedy it seeks"). A delay will defeat a temporary restraining order, as well. *See, e.g.*, New Era Publ'ns, Int'l, ApS v. Henry Holt & Co., Inc., 684 F. Supp. 808, 811 (S.D.N.Y. 1988) (TRO denied because of plaintiff's delay (which amounted to laches)).
281. *See, e.g.,* American Metro. Enters. of N.Y., Inc. v. Warner Bros. Records, Inc., 389 F.2d 903 (2d Cir. 1968) (denial of preliminary injunction because plaintiff acquiesced in defendant's use of copyrighted work).
282. *See* Fed. R. Civ. P. 65(a)(1).
283. Fed. R. Civ. P. 65(c).
284. *See, e.g.*, Corning Inc. v. PicVue Elecs., Ltd., 365 F.3d 156, 158 (2d Cir. 2004) (per curiam) (district court violated Rule 65(c), because "[w]hile it might have been within the discretion

Courts have a great deal of discretion regarding how to tailor the substance of the preliminary injunction to maintain the status quo and keep the infringer in line. Thus, for example, one court issued the injunction to prevent further infringement and, additionally, ordered the defendant to use its best efforts to recall infringing goods from the marketplace.[285] Similarly, in another case, *Columbia Broadcasting System, Inc. v. American Society of Composers, Authors and Publishers (ASCAP)*, the court issued a mandatory injunction that required defendant to pay a reasonable license fee to the plaintiff pending trial.[286] The court explained:

> Where necessary to preserve the status quo, the court may, of course, issue a mandatory injunction, . . . it being the "general purpose of a preliminary injunction . . . to preserve the status quo . . . it follows that the court must have discretion to fashion such a preliminary injunction as may best approximate past positions in the light of the basic rights of the parties." [¶] Although courts are rarely called upon to issue mandatory injunctions calling for the payment of moneys pendente lite, they have done so when the equities and the circumstances of the case demonstrated the appropriateness of the remedy.[287]

A preliminary injunction that has been entered may be served on the infringer anywhere in the United States.[288] Additionally, violations of the injunction are punishable by "proceedings in contempt or otherwise."[289]

2. Elements for Obtaining Preliminary Injunction

The three main factors in determining whether a preliminary injunction is warranted are whether the moving party can demonstrate a likelihood of success on the merits of the copyright claim, irreparable injury, and a balance of hardships tipping in favor of the moving party. These three factors have been combined into the predominant standard that can be set forth as follows: To obtain a preliminary injunction, the moving party must show "either (1) a likelihood of success on the merits and the possibility of irreparable injury, or

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of the district court to decide that, under the circumstances, no security was required [citation omitted], the district court was required to make this determination before it entered the preliminary injunction").

285. *See* Hukafit Sportswear, Inc. v. Banff Ltd., Inc., 228 U.S.P.Q. 249, 255 (S.D.N.Y. 1985) (injunction ordered defendant to "recall immediately from all its direct customers all garments containing copies of plaintiffs' [infringed] design, and exercise its best efforts to cause them to be removed from public display").

286. *See* 320 F. Supp. 389, 392 (S.D.N.Y. 1970).

287. *Id.* (citations omitted).

288. *See* 17 U.S.C. 502(b).

289. *Id.*

(2) the existence of serious questions going to the merits and the balance of hardships tipping in its favor."[290] This rule is not two distinct tests, but "rather the opposite ends of a single 'continuum in which the required showing of harm varies inversely with the required showing of meritoriousness.'"[291] (Note that some circuits have added an additional element—whether the public interest will be promoted by granting the preliminary injunction[292]—but this additional element is generally not considered in the leading copyright circuits, the Second and Ninth Circuits.[293])

Moreover, a showing of a reasonable likelihood of success on the merits raises a presumption of irreparable harm in a copyright infringement case.[294] Thus, under this standard, if the moving party shows a likelihood of success on the merits, then no further showing would be necessary to obtain the

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290. Apple Computer, Inc. v. Formula Int'l Inc., 725 F.2d 521, 523 (9th Cir. 1984); *see also* Johnson Controls, Inc. v. Phoenix Control Sys., Inc., 886 F.2d 1173, 1174 (9th Cir. 1989); Hasbro Bradley, Inc. v. Sparkle Toys, Inc., 780 F.2d 189, 192 (2d Cir. 1985).

291. Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 1217 (9th Cir. 1987) (citation omitted) (trademark infringement case). *See also* Midway Mfg. Co. v. Bandai-Am., Inc., 546 F. Supp. 125, 142 (D.N.J. 1982) ("strength of a showing of irreparable injury required of a plaintiff varies inversely with the strength of his showing of a likelihood of success on the merits"); H.W. Wilson Co. v. National Library Serv. Co., 402 F. Supp. 456, 459 (S.D.N.Y. 1975) ("the weaker the case on the merits, the stronger the probability of injury must be in order for a preliminary injunction to be granted").

292. *See, e.g.*, Forry v. Neundorfer, Inc., 837 F.2d 259, 262 (6th Cir. 1988); West Publ'g Co. v. Mead Data Cent., Inc., 799 F.2d 1219, 1229 (8th cir. 1986), *cert. denied*, 479 U.S. 1070, 107 S. Ct. 962, 93 L. Ed. 2d 1010 (1987); Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1246 (3d Cir. 1983) (en banc), *cert. dismissed,* 464 U.S. 1033, 104 S. Ct. 690, 79 L. Ed. 2d 158 (1984); Atari, Inc. v. North Am. Phillips Consumer Elecs. Corp., 672 F.2d 607, 613 (7th Cir.), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982). Note, however, that the public interest factor rarely arises: "[I]t is virtually axiomatic that the public interest can only be served by upholding copyright protections and, correspondingly, preventing misappropriation of the skills, creative energies, and resources which are invested in the protected work." *Apple Computer v. Franklin Computer*, 714 F.2d at 1255. Notwithstanding that, the Fifth Circuit has emphasized that all four factors should be satisfied by the movant to obtain a preliminary injunction. *See* Plains Cotton Coop. Ass'n v. Goodpasture Computer Serv., Inc., 807 F.2d 1256, 1261 (5th Cir.), *reh'g denied*, 813 F.2d 407 (5th Cir.) (en banc), *cert. denied,* 484 U.S. 821, 108 S. Ct. 80, 98 L. Ed. 2d 42 (1987).

293. *But see* Miller v. California Pac. Med. Ctr., 19 F.3d 449, 456 (9th Cir. 1994) (en banc) (The test for preliminary injunctions is a consideration of: "(1) the likelihood of the moving party's success on the merits; (2) the possibility of irreparable injury to the moving party if relief is not granted; (3) the extent to which the balance of hardships favors the respective parties; and (4) in certain cases, whether the public interest will be advanced by granting the preliminary relief.")

294. *See* Johnson Controls, Inc. v. Phoenix Control Sys., Inc., 886 F.2d 1173, 1174 (9th Cir. 1989); West Publ'g Co. v. Mead Data Cent., Inc., 799 F.2d 1219, 1229 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070, 107 S. Ct. 962, 93 L. Ed. 2d 1010 (1987); Apple Computer, Inc. v. Formula Int'l Inc., 725 F.2d 521, 525 (9th Cir. 1984); Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1254 (3d Cir. 1983) (en banc), *cert. dismissed*, 464 U.S. 1033, 104 S. Ct. 690, 79 L. Ed. 2d 158 (1984).

preliminary injunction.[295] This does not mean that the presumption of irreparable harm is always warranted. Indeed, a court is more likely to apply the presumption in cases involving substantially original copyrighted works, rather than in cases involving works that have only limited original content.[296] Thus, for example, courts should not necessarily presume irreparable injury in cases involving compulsory licenses for reproducing nondramatic works, because having the compulsory licensing system means that the copyright owners can be fully compensated by a monetary award.[297] On the other hand, a movant's mere showing of irreparable injury without any showing of likelihood of success on the merits would likewise not be sufficient to obtain a preliminary injunction.[298]

Where the presumption of irreparable harm does not automatically arise, to determine whether there is irreparable harm, courts will consider, among other things, whether plaintiff's harm can be redressed by monetary relief and/or by the eventual grant of a permanent injunction.[299] If the work at issue has only a short-lived market, for example, a court is more likely to find

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295. *See, e.g.*, Joshua Meier Co. v. Albany Novelty Mfg. Co., 236 F.2d 144, 147 (2d Cir. 1956); Stern Elecs., Inc. v. Kaufman, 523 F. Supp. 635, 637 (E.D.N.Y. 1981); Miller Brewing Co. v. Carling O'Keefe Breweries of Canada, Ltd., 452 F. Supp. 429, 437 (W.D.N.Y. 1978).

296. *See, e.g.*, Rice v. American Program Bureau, 446 F.2d 685, 688 (2d Cir. 1971) (presumption of irreparable harm is especially applicable in case involving dramatic musical works); Marvin Worth Prods. v. Superior Films Corp., 319 F. Supp. 1269, 1276 (S.D.N.Y. 1970) (presumption "most clearly applicable to infringements of dramatic works"). *But see* West Publ'g Co. v. Mead Data Cent., Inc., 616 F. Supp 1571, 1581 (D. Minn. 1985) ("Although this Court has noted that the general rule is more commonly applied to copyrighted materials other than compilations, it nonetheless recognizes the presumption when the movant has a strong claim for copyright infringement."), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070, 107 S. Ct. 962, 93 L. Ed. 2d 1010 (1987); Northwestern Bell Tel. Co. v. Bedco of Minn., Inc., 501 F. Supp. 299, 303 (D. Minn. 1980) (although presumption is "more appropriately applied to copyrighted products of a more creative nature than compilations," plaintiff compiler was entitled to preliminary injunction because it had a strong case).

297. *See, e.g.*, American Metro. Enters. of New York, Inc. v. Warner Bros. Records, Inc., 389 F.2d 903, 905 (2d Cir. 1968).

298. *See, e.g.*, Uneeda Doll Co., Inc. v. P & M Doll Co., Inc., 241 F. Supp. 675, 677 (S.D.N.Y.) ("Plaintiff has made a showing of irreparable injury, but it has not made the prima facie showing of infringement necessary for the granting of a preliminary injunction," because what was copied may not be protectible by copyright), *aff'd*, 353 F.2d 788 (2d Cir. 1965).

299. *See, e.g.*, Albert E. Price, Inc. v. Metzner, 574 F. Supp. 281, 289 (E.D. Pa. 1983) (in finding irreparable harm, the court observed that "[t]he general rule in equity is that harm is 'irreparable' when it cannot be adequately compensated in damages because of the nature of the injury itself or because of the nature of the right or property that is injured or because there exists no certain pecuniary standard for measurement of damages. . . . Future injury of uncertain date and incalculable magnitude is 'irreparable harm' and protection from such an injury is a legitimate end of injunctive relief.") (citations omitted); Roy Export Co. Establishment v. Trustees of Columbia Univ., 344 F. Supp. 1350, 1353 (S.D.N.Y. 1972) (mere possibility of future, unlawful exhibitions of the infringed work too remote and speculative to be deemed a clear likelihood of immediate, irreparable harm).

irreparable harm, because withholding preliminary relief in such a situation could effectively prevent the copyright owner from obtaining any real relief at all.[300] Other factors that courts have considered in determining whether there is irreparable injury include, among others, the possible injury to the movant's competitive position, professional reputation and/or goodwill, and the movant's solvency.[301]

Of course, as already stated, a sufficient showing of likelihood of success on the merits is the critical element in obtaining a preliminary injunction. If the movant demonstrates a probability of success on the merits of its infringement claim, it usually will be able to obtain relief without a detailed factual showing of irreparable harm.[302] As for the showing required by the moving

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300. *See, e.g.*, Rushton v. Vitale, 218 F.2d 434, 436 (2d Cir. 1955) (toys at issue had seasonal market); Houghton Mifflin Co. v. Stackpole Sons, Inc., 104 F.2d 306, 307 (2d Cir.) ("In a case such as this, where two editions of a book of great popular interest are being actively promoted in competition with each other, it is obvious that much of the damage to a rightful owner of copyright, if any there be, will have been done by the time the action may be tried and final decree entered upon an accounting."), *cert. denied*, 308 U.S. 597, 60 S. Ct. 131, 84 L. Ed. 499 (1939); O'Neill Devs., Inc. v. Galen Kilburn, Inc., 524 F. Supp. 710, 715 (N.D. Ga. 1981) (finding that acts of infringement were likely to have ended by the time of trial); Stern Elecs., Inc. v. Kaufman, 523 F. Supp. 635, 638 (E.D.N.Y. 1981) ("Preliminary injunctive relief is the only effective means of protecting a copyright in a video game since the life span of a successful game is merely six months."), *aff'd*, 669 F.2d 852 (2d Cir. 1982).

301. *See, e.g.*, Rent-A-Center, Inc. v. Canyon Television and Appliance Rental, Inc., 944 F.2d 597, 603 (9th Cir. 1991) (for purposes of a preliminary injunction, intangible injuries, such as damage to advertising efforts and goodwill, can be irreparable harm); Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1254 (3d Cir. 1983) (en banc) (in reversing the denial of preliminary injunction, the circuit court explained that, "even without the presumption of irreparable harm generally applied in copyright infringement cases, the jeopardy to [plaintiff] Apple's investment and competitive advantage caused by [defendant] Franklin's wholesale copyright of many of its key operating programs would satisfy the requirement of irreparable harm needed to support a preliminary injunction"), *cert. dismissed,* 464 U.S. 1033, 104 S. Ct. 690, 79 L. Ed. 2d 158 (1984); Gilliam v. American Broad. Cos., Inc., 538 F.2d 14, 19 (2d Cir. 1976) (unauthorized nationwide broadcast of plaintiff's work would lead to a lead to an injury to plaintiffs' "theatrical reputation," and "[s]uch an injury to professional reputation cannot be measured in monetary terms or recompensed by . . . relief [other than preliminary injunction]"); RCA Records v. All-Fast Sys., Inc., 594 F. Supp. 335, 338 (S.D.N.Y. 1984) (finding irreparable harm, because, "by spreading inferior monaural copies of stereophonic tapes, defendant undermines plaintiffs' customers' good will," interferes with "plaintiffs' efforts to portray their artists' performances with maximum fidelity and the greatest aesthetic impact," and "disrupts the royalties-based contracts between artists and recording companies"); Videotronics, Inc. v. Bend Elecs., 586 F. Supp. 478, 487 (D. Nev. 1984) (court found it significant that plaintiff was "on the verge of bankruptcy," and, if a preliminary injunction were not entered, "customers [would] purchase the games from defendants rather than plaintiff, and plaintiff's business [would] be lost").

302. *See, e.g.*, Triad Sys. Corp. v. Southeastern Express Co., 64 F.3d 1330, 1335 (9th Cir. 1995) ("In a copyright infringement action, . . . the rules are somewhat different. A showing of a reasonable likelihood of success on the merits raises a *presumption* of irreparable harm.") (emphasis in original), *cert. denied*, 516 U.S. 1145, 116 S. Ct. 1015, 134 L. Ed. 2d 96 (1996);

party to demonstrate sufficiently a likelihood of success on the merits, the movant at least must show that it owns a valid copyright and that defendant has infringed the copyright, and, even if defendant claims a viable defense, the preliminary injunction still should issue.[303] The fact that the preliminary injunction issued does not prejudice the defendant's ability to prevail on the merits at trial when all evidence has been entered.[304]

In circuits that use the "public interest" element for preliminary injunctions,[305] the moving party also will have to make a showing that the balance of hardships tip in its favor. However, this element is not generally given a great deal of weight in copyright cases, because courts tend to link the balance of hardships to the showing of likelihood of success on the merits, usually tipping the balance of hardships in plaintiff's favor where it has made a sufficient showing of probability of success.[306] Likewise, the public interest factor does not appear to have much bearing on the court's decision. Indeed, "it is virtually

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Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1254 (3d Cir. 1983) (en banc) ("A copyright plaintiff who makes out a prima facie case of infringement is entitled to a preliminary injunction without a detailed showing of irreparable harm."), *cert. dismissed*, 464 U.S. 1033, 104 S. Ct. 690, 79 L. Ed. 2d 158 (1984).

303. *See* Midway Mfg. Co. v. Bandai-America, Inc., 546 F. Supp. 125, 141 (D.N.J. 1982) ("It should be noted that there is absolutely no impediment in a copyright infringement action to granting a plaintiff a preliminary injunction while simultaneously denying his motion for summary judgment. . . . Acknowledgement that disputed fact issues exist does not preclude a court from granting a plaintiff preliminary relief. . . .Similarly, the existence of a plausible defense in a copyright case is no barrier to the issuance of a preliminary injunction as long as the movant shows a substantial likelihood of success on the merits. . . .") (citations omitted), *aff'd sub nom*. Bandai-America, Inc. v. Bally Midway Mfg. Co., 775 F.2d 70 (3d Cir. 1985), *cert. denied*, 475 U.S. 1047, 106 S. Ct. 1265, 89 L. Ed. 2d 574 (1986); *see also* Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc., 600 F.2d 1184, 1188 (5th Cir. 1979); Princeton Univ. Press. v. Michigan Document Servs., Inc., 22 U.S.P.Q.2d 1863, 1864 (E.D. Mich. 1992).

304. *See, e.g.*, Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc., 600 F.2d 1184, 1188 n.1 (5th Cir. 1979) ("Our holding that the district court was correct in determining that the plaintiffs enjoyed a substantial likelihood of success on the merits in no way intimates any view concerning the correct outcome of this litigation when it is fully tried.").

305. *See supra* note 292 and accompanying text.

306. *See, e.g.,* Cadence Design Sys., Inc. v. Avant! Corp., 125 F.3d 824, 830 (9th Cir. 1997) (district court erred by weighing the balance of harms in defendant's favor, because one who knowingly infringes cannot be allowed to complain about the harm that will result when it is forced to cease the infringement); Worlds of Wonder, Inc. v. Veritel Learning Sys., Inc., 658 F. Supp. 351, 357 (N.D. Tex. 1986) (court held that, even if defendant could establish that it would be "put out of business" if the preliminary injunction issued, relief still should be granted to plaintiff, because knowing infringers act at their own peril and courts cannot allow them to complain in this way when they have chosen to construct their businesses around infringement). *Compare* Farmers Indep. Tel. Co. v. Thorman, 648 F. Supp. 457, 459 (W.D. Wis. 1986) (in finding that likelihood of success on the merits was not strong enough to overcome balance of harm in defendant's favor, the court explained, "it appears from the very wording of the balance of harms factor to be considered by this Court that, when

axiomatic that the public interest can only be served by upholding copyright protections and, correspondingly, preventing the misappropriation of the skills, creative energies, and resources which are invested in the protected work."[307] This is because, where the probability of success is high, preliminary relief is necessary to protect the integrity of the copyright law and the public's reliance on it.[308]

D. Permanent Injunctions

Pursuant to Section 502(a) of the Copyright Act, the prevailing plaintiff in a copyright infringement action may obtain "final injunctions" restraining further infringement.[309] Under Section 502(b), the injunction may be served and enforced throughout the United States.[310] While courts freely grant final injunctions upon a finding of copyright infringement, such relief may be denied where there is no probability or threat of continuing infringement.[311] On the other hand, even where there is not much evidence of continuing or additional infringement, a finding that defendant's infringement was deliberate and calculating may be sufficient to justify the issuance of a permanent injunction, because "the plaintiffs should not be required to assume the risk that [such deliberate infringers] will not repeat such infringement or engage in similar conduct in the future."[312] Notwithstanding that, a plaintiff need not

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assessing the harm to the defendant the Court should assume that the harm is that which flows from an erroneous grant of an injunction").

307. Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1255 (3d Cir. 1983) (en banc), *cert. dismissed*, 464 U.S. 1033, 104 S. Ct. 690, 79 L. Ed. 2d 158 (1984).
308. *See, e.g.*, Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 620 (7th Cir.) ("a preliminary injunction is necessary to preserve the integrity of the copyright laws which seek to encourage individual effort and creativity by granting valuable enforceable rights"), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982).
309. 17 U.S.C. § 502(a).
310. *See* 17 U.S.C. § 502(b).
311. *See, e.g.*, Harolds Stores, Inc. v. Dillard Dep't Stores, Inc., 82 F.3d 1533, 1555–56 (10th Cir.) ("[w]hen there is no probability or threat of continuing infringements, [permanent] injunctive relief is ordinarily inappropriate," and the district court did not abuse its discretion in denying the prevailing plaintiff's request for permanent injunctive relief), *cert. denied*, 519 U.S. 928, 117 S. Ct. 297, 136 L. Ed. 2d 216 (1996); Shapiro, Bernstein & Co. v. 4636 S. Vermont Ave., Inc., 367 F.2d 236, 242 (9th Cir. 1966) (district court did not err in denying permanent injunctive relief where it found that defendant was not likely to infringe again); Broadcast Music, Inc. v. Fox Amusement Co., Inc., 551 F. Supp. 104, 110 (N.D. Ill. 1982) (permanent injunction denied because defendant had paid license fees while lawsuit was pending such that copyright was no longer being infringed at time of trial).
312. Breffort v. I Had A Ball Co., 271 F. Supp. 623, 626 (S.D.N.Y. 1967), *disapproved on other grounds,* Fogerty v. Fantasy, Inc., 510 U.S. 517, 532 & n.18, 114 S. Ct. 1023, 1032 & n.18, 127 L. Ed. 2d 455 (1994).

show deliberate infringement to obtain permanent relief; courts will grant permanent injunction against innocent infringers, as well.[313]

Final injunctions in copyright cases must conform to the requirement as set forth in the Federal Rules of Civil Procedure that the order "state its terms specifically" and "describe in reasonable detail—and not by referring to the complaint or other document—the act or acts restrained or required."[314]

X. Impoundment

Section 503(a) of the Copyright Act provides that,

> [a]t any time while an action under [the Copyright Act] is pending, the court may order the impounding, on such terms as it may deem reasonable, of all copies or phonorecords claimed to have been made or used in violation of the copyright owner's exclusive rights, and of all plates, molds, matrices, masters, tapes, film negatives, or other articles by means of which such copies or phonorecords may be reproduced.[315]

According to the House Report, this section "permit[s] seizures of articles alleged to be infringing as soon as suit has been filed and without waiting for an injunction."[316] Thus, as a practical matter, an impoundment, which acts to seize infringing products and articles, would work well with a temporary restraining order or preliminary injunction, which would act to prohibit further infringement by the defendant pending trial.

A. Requirements and Court Discretion

The statute's language that a court "may" impound infringing materials makes it clear that the decision to issue an impounding order is within a court's discretion.[317] The current version of the Copyright Act, however, provides no

313. *See, e.g.*, Williams Elecs., Inc. v. Artic Int'l, Inc. 685 F.2d 870, 878 (3d Cir. 1982) ("A finding of willfulness was not necessary in order for the district court to enter the injunction in the present case. It is settled that innocent intent is generally not a defense to copyright infringement, . . . and injunctions may be issued without a showing of willful or deliberate infringement.") (citations omitted).

314. Fed. R. Civ. P. 65(d)(1). Note that, as indicated above, Federal Rule of Civil Procedure 65 was amended effective December 1, 2007.

315. 17 U.S.C. § 503(a).

316. H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 160 (1976).

317. 17 U.S.C. § 503(a).

explicit statutory standard for exercising the court's discretion.[318] Thus, when that discretion should be exercised to issue an impoundment order is not always so clear. Many courts have assumed that, to obtain impoundment, plaintiff was required to demonstrate likelihood of success on the merits, i.e., the same basic standard required for injunctions.[319]

Impoundment was previously governed, in part, by Section 101(c) of the 1909 Act, which is no longer in effect. That section provided, in relevant part:

> If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable: . . . (c) To deliver up on oath, to be impounded during the pendency of the action, upon such terms and conditions as the court may prescribe, all articles alleged to infringe a copyright.[320]

In addition, during the pendency of the 1909 Act, the procedures that governed impoundment orders were found in the Copyright Rules of Practice, promulgated by the United States Supreme Court in 1909.[321] Since the House Report for the 1976 Act concluded that there was "no need" for a provision on this matter in the current Act, the Supreme Court Rules adopted in 1909 as the Copyright Rules of Practice would appear still to be in effect.[322]

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318. *See* U2 Home Entm't, Inc. v. Chun Pook Tan, 209 F. Supp. 2d 299, 300 (S.D.N.Y. 2002) ("[t]he statute does not establish a standard governing applications for such [impoundment] orders"); WPOW, Inc. v. MRLJ Enters., 584 F. Supp. 132, 135 (D.D.C. 1984); Martin Luther King, Jr. Ctr. For Soc. Change, Inc. v. American Heritage Prods., Inc., 508 F. Supp. 854, 861 (N.D. Ga. 1981) (explaining that "[t]he decision to impound is discretionary with the court," but that "no standards are set out in the statute"), *rev'd on other grounds*, 694 F.2d 674 (11th Cir. 1983).
319. *See, e.g., U2 Home Entm't*, 209 F. Supp. 2d at 300 ("Plaintiff assumes that it is obliged to demonstrate a likelihood of success on the merits of its infringement claim in order to obtain and sustain the seizure order. The Court so assumes as well."); *Martin Luther King, Jr. Ctr. For Soc. Change, Inc*., 508 F. Supp. at 861 ("[a]s this court has held an evidentiary hearing and found that plaintiffs have shown a likelihood of success on the merits, we are inclined to order the impoundment of the infringing materials").
320. 17 U.S.C. § 101(c) (1909) (repealed 1948).
321. *See* 214 U.S. 533 (1909), *amended*, 307 U.S. 652 (1939), 383 U.S. 1031 (1966). According to the House Report on the 1976 Copyright Act, "the present Supreme Court rules with respect to seizure and impounding were issued even though there is no specific provision authorizing them in the copyright statute, and there appears no need for including a special provision on the point in the bill." H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 160 (1976).
322. *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 160 (1976); *see also* Warner Bros. Inc. v. Dae Rim Trading, Inc., 877 F.2d 1120, 1124 (2d Cir. 1989). In rejecting plaintiff's argument that the Copyright Rules of Practice had, in effect, been repealed, the *Warner Bros*. Court stated: "When section 25(e) of the 1909 Act was repealed in 1948 . . . the 1948 Act specifically provided that it did not repeal any rules of procedure theretofore prescribed by the Supreme Court. . . . This provision has been retained in 28 U.S.C. § 2072. The consensus of knowledgeable

The Supreme Court's Copyright Rules of Practice provide that, upon filing an action or after, but before the entry of final judgment, the plaintiff may file an affidavit with the clerk of the court identifying the number, value, and location of the alleged infringing copies or devices and materials used in making the infringing copies.[323] Along with the affidavit, the plaintiff must file a bond in a sum to be fixed by the court, but not less than twice the value of the materials to be impounded.[324] The bond must be "executed by at least two sureties and approved by the court or a commissioner thereof."[325] Upon the filing of the affidavit and the bond, and upon the court's approval of the bond, the clerk issues a writ pursuant to which the federal marshal can seize and hold the articles described in the affidavit.[326]

The defendant has three days from the time the articles are seized within which to file a notice objecting to the amount of the bond and the sufficiency of the sureties, and the plaintiff has ten days to respond to defendant's noticed objections.[327] Pursuant to Rule 9, after seizure has occurred, the defendant may make an application to the court for return of the impounded articles through an affidavit stating "all material facts and circumstances tending to show that the articles seized are not infringing copies, records, plates, molds, matrices, or means for making the copies alleged to infringe the copyright."[328] The court may, in its discretion and after "such hearings as it may direct," order the return of the seized articles, subject to the defendant's filing of a bond, as determined by the court.[329]

B. Constitutionality of the Impoundment Procedure

The impoundment procedure—apparently permitted when plaintiff has made the same showing required for preliminary injunction (i.e., that of likelihood of success on the merits)—has raised some constitutionality issues. Indeed, the Advisory Committee on the Federal Rules has expressed its doubts about the Copyright Rules of Practice, because of "their failure to require notice or a showing of irreparable injury to the same extent as is customarily required for threshold injunctive relief."[330] Also, in connection with this procedure, it is

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authorities is that the Supreme Court's Rules have not been repealed." *Warner Bros*., 877 F.2d at 1124 (citations omitted).

323. *See* Rule 3 of the Copyright Rules of Practice.
324. *See* Rules 3, 4 of the Copyright Rules of Practice.
325. Rule 3 of the Copyright Rules of Practice.
326. *See* Rule 4 of the Copyright Rules of Practice.
327. Rules 7, 8 of the Copyright Rules of Practice.
328. Rule 9 of the Copyright Rules of Practice.
329. Rule 10 of the Copyright Rules of Practice.
330. Notes of Advisory Comm. On Rules, Rule 4 (as set forth following 17 U.S.C. § 501 (1977)).

not clear whether there must be an adversary proceeding before an impoundment order may issue. Arguably, the Supreme Court's Copyright Rules of Practice appear to provide for summary seizure and impounding without the requirement of any notice or hearing.

Due process arguably requires minimally that courts impose upon *ex parte* impoundments the same strict standards imposed on applications for restraining orders and that the orders are no broader than required to ensure that infringing materials are not made publicly available.[331]

In *Paramount Pictures Corporation v. Doe*, the district court analyzed the constitutionality of the rules regarding impoundment.[332] The court found:

> The procedure for impoundment under the Copyright Rules, measured alongside the standard articulated in [*Mitchell v. W.T. Grant Company*],[333] is constitutionally infirm in multiple respects. . . . The applicability of the rules is not limited to situations where the defendant likely could conceal or destroy the infringing materials. The rules do not require the plaintiff to demonstrate the merits of the underlying infringement claim and likewise do not even require that the application be made by one with personal knowledge of the pertinent facts. . . . Under the rules, a clerk may issue the writ of seizure after the bond is approved by a court, . . ., and nowhere do the rules specify that a defendant has a right to a postseizure hearing to challenge the propriety of the seizure. . . . Furthermore, although the court does have a role in the impoundment procedure under the rules, that role is insignificant: the court's role can be characterized fairly only as ensuring formal compliance with the bond requirements since no showing of the merits of the underlying action is required. . . . [¶] Faced with the constitutionally deficient procedure established by the Copyright Rules, courts, exercising their discretion under section 503(a) [of the Copyright Act], have held copyright holders to the standards articulated in *Mitchell* and

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331. *See, e.g.*, First Tech. Safety Sys., Inc. v. Depinet, 11 F.3d 641 (6th Cir. 1993); Paramount Pictures Corp. v. Doe, 821 F. Supp. 82 (E.D.N.Y. 1993).

332. *See* 821 F. Supp. 82 (E.D.N.Y. 1993).

333. 416 U.S. 600, 94 S. Ct. 1895, 40 L. Ed. 2d 406 (1974). *Mitchell* was a case that articulated requirements consistent with constitutional due process for an ex parte prejudgment seizure of a defendant's property. The Supreme Court upheld a Louisiana sequestration statute that permitted ex parte prejudgment seizure, setting forth the minimum requirements of due process as follows: (1) the availability of *ex parte* prejudgment seizure must be limited to situations where plaintiff has established that the property to be seized is of a type that can be readily concealed, disposed of, or destroyed; (2) the plaintiff must allege specific facts based on actual knowledge supporting the underlying action and the right of plaintiff to seize the property; (3) the application for the order of seizure must be made to a judge rather than to a clerk; (4) the defendant has a right to a prompt postseizure hearing to challenge the seizure; and (5) the defendant must be able to recover damages from the plaintiff if the taking was wrongful and to regain possession of the seized items by filing a bond. *Mitchell*, 416 U.S. at 616–18, 94 S. Ct. at 1904–05.

> Rule 65 of the Federal Rules of Civil Procedure. That is, in addition to requiring plaintiffs to post bond, courts require a showing of the merits of plaintiffs' underlying infringement action and the particular circumstances justifying proceeding ex parte; and they fashion orders of seizure which require the plaintiff and defendant to appear at a postseizure hearing, thus providing the defendant a prompt opportunity to challenge the propriety of the seizure. . . . Recent decisions mark a trend of requiring a plaintiff applying for an ex parte order of impoundment to comply with the requirements of Rule 65 of the Federal Rules of Civil Procedure and the general principles governing preliminary injunctive relief. . . .[334]

An example of some of these principles being applied in practice is *First Technology Safety Systems, Inc. v. Depinet*, in which the circuit court held that the *ex parte* impoundment order was too broad.[335] "The district court's order permitted the plaintiff to seize not only computer software that allegedly infringed plaintiff's copyrights but also to copy defendants' business records, including '[a]ll invoices and purchase orders for parts, customer lists or other customer-information materials held by the defendants, and all correspondence between [any of the defendants and the plaintiff].'"[336] The circuit court explained that the business records were neither infringing copies, nor the means of producing infringing copies. Moreover, the main purpose of an impoundment is to "'maintain the feasibility of the eventual destruction of items found at trial to violate the copyright laws by safeguarding them during pendency of the action,'" and not to preserve evidence of defendants' wrongdoing; thus, because the business records did not fulfill that purpose, their permitted seizure was improper.[337] The circuit court concluded that the basic standards applicable to an impoundment are those applicable to a restraining order. The court also found that an *ex parte* seizure, without prior notice to the defendants, would be justified where notice to the adverse party is impossible (because, for example, that party is unknown or unable to be found) or where notice to defendant would "render fruitless further prosecution of the action," such as where plaintiff can show that defendant would have "disregarded a direct court order and disposed of the goods within the time it would take for a hearing."[338]

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334. 821 F. Supp. at 88–89 (citations omitted).
335. *See* 11 F.3d 641, 649 (6th Cir. 1993).
336. *Id.*
337. *Id.*
338. *Id.* at 650.

C. Practical Considerations of an Impoundment Order

For a plaintiff, whether to seek an impoundment order and the timing of such request is an important consideration. Where circumstances require preliminary injunctive relief, including a temporary restraining order, an impoundment order works in conjunction with such preliminary relief, because, as discussed above, an impoundment seizes the infringing articles and the temporary restraining order or preliminary injunction maintains the status quo by prohibiting further infringement pending trial. Indeed, the ultimate intent of an impoundment is to ensure the eventual destruction of the infringing articles when and if plaintiff prevails.[339]

Given the extraordinary relief involved and the constitutional implications if not done properly, plaintiff must be careful to follow all requirements to the letter. Thus, for example, plaintiff must wait for a public officer, such as the Federal Marshal, to seize and hold the articles identified in the affidavit, and not employ any self-help or enlist the services of any other individual.[340] Plaintiff also must be careful to draft with sufficient particularity the description of the articles to be seized so that the Marshal can easily identify what is to be seized without having to undertake any broad searches through defendants' possessions.[341] To the extent the infringing articles are likely to be in defendants' computer files—and where music copyrights are involved, that certainly is a safe bet—plaintiff should engage the services of a computer expert with forensic experience to accompany the Federal Marshal to help to locate the infringing computer files.[342]

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339. *See* Religious Tech. Ctr. v. Netcom On-Line Communication Servs., Inc., 923 F. Supp. 1231, 1263 (N.D. Cal. 1995) ("[T]he purpose of preliminary injunctive relief is to maintain the status quo[, and] [i]mpoundment is also meant to allow for a possible remedy of destruction of the infringing articles").

340. *See* Warner Bros. Inc. v. Dae Rim Trading, Inc., 877 F.2d 1120, 1125–26 (2d Cir. 1989) (seizure of allegedly infringing articles is properly conducted by a U.S. Marshal or other public law enforcement officer, and not by copyright owner's attorneys and their agents or by any other private person).

341. *See Religious Tech. Ctr.*, 923 F. Supp. at 1263–64 ("The criteria used to determine what items are to be seized must not be overly subjective, such that the decision of what to seize rests solely in the hands of plaintiffs' expert rather than the U.S. Marshal. . . . Here, there were no specific criteria given by which a marshal could identify which works were . . . protected by copyrights. In effect, this language gave plaintiffs' experts the authority to search through [defendant's] possessions and computer files using their discretion in deciding what to seize, unchecked by any law enforcement officials.") (citations omitted).

342. *See, e.g., id*. at 1264 ("The court finds that, in the context of identification of allegedly infringing copies of literary works, use of an expert to *aid* the marshal may be justified. In this case, the number of potentially infringed works was too great to permit the plaintiffs to bring originals to be used in verifying the source of copies. Accordingly, plaintiffs were justified in using an expert to identify the allegedly infringing works.") (emphasis in original).

For a defendant facing impoundment, an important consideration is the extent to which the impoundment order will reach into and affect defendant's ongoing business, including whether the defendant may have to surrender not only infringing articles in its possession, but also infringing articles that may already have entered the commerce stream, and/or "other articles by means of which such copies or phonorecords may be reproduced."[343]

For example, in a copyright infringement case involving stuffed toy animals, the court ordered defendants to deposit with the U.S. Marshal any and all accused toys, as well as any toys that it could recall from the marketplace through "reasonable efforts," "together with any and all molds or patterns which are used in manufacturing the whole or any part or parts [of the infringing toys]."[344] Likewise, in another case decided under the 1909 Copyright Act, the circuit court overturned a district court order returning to defendant, who allegedly made infringing cassette tape recordings of pirated music, impounded tape-recording equipment and machinery, blank tapes, cartridges, cassettes, labels, and unmarked or unprinted packaging materials.[345] The circuit court held that neither the Copyright Act nor the Supreme Court rules gives the district court any discretion to return "infringing copies or infringing means," including, in this case, "[m]achines, blank cassettes and cartridges, blank and printed labels, and other devices[, which are] 'other means' for making infringing copies."[346]

Regarding recalls of the infringing products that already are in the stream of commerce, one court declined to order the recall of infringing articles because of defendant's "slender resources" and "the damage to [defendant's] reputation which would occur if it were required to recall from its customers products presently in their stores, and because to require such recall would grant full relief to the plaintiff at a preliminary stage of the litigation."[347] In yet another case, the circuit court ruled that the lower court did not abuse its discretion in awarding damages computed over the course of years in lieu of ordering a recall of infringing products; the circuit court observed that "it is doubtful that recall would be an available remedy against defendant's customers who are innocent third-parties in this copyright infringement litigation."[348]

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343. 17 U.S.C. § 503(a).
344. Dollcraft Indus., Ltd. v. Well-Made Toy Mfg. Co., 479 F. Supp. 1105, 1118 (E.D.N.Y. 1978).
345. *See* Duchess Music Corp. v. Stern, 458 F.2d 1305, 1307 (9th Cir.), *cert. denied*, 409 U.S. 847, 93 S. Ct. 52, 34 L. Ed. 2d 88 (1972). The district court ordered that defendants had to surrender completed tapes and masters. *See id.*
346. *Id.* at 1308.
347. Jack Lenor Larsen, Inc. v. Dakotah, Inc., 452 F. Supp. 99, 100 (S.D.N.Y. 1978).
348. Applied Innovations, Inc. v. Regents of the Univ. of Minn., 876 F.2d 626, 637–38 (8th Cir. 1989).

On the other hand, even recognizing that a recall order would cause some "hardship to defendant," including that it would "cause [defendant] some loss of credibility in the marketplace" and would "cost money,"[349] another court nonetheless issued a recall order, because defendant "deliberately sailed in harm's way" and was to blame for the expense and other hardship it faced in light of a recall of infringing articles.[350]

In each of these cases regarding impoundments of the means of infringement and/or the recall of infringing products already in the commerce stream, the parties appear to be at the mercy of the district court. So long as it does not abuse its discretion, the court has a great deal of leeway to decide the extent of the scope of the impoundment order and, hence, to decide how disruptive to a defendant's business operations an impoundment will be.

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349. Cherry River Music Co. v. Simitar Entm't, Inc., 38 F. Supp. 2d 310, 323 (S.D.N.Y. 1999). The court recognized that, as the result of a recall order, the defendant "would have to refund the wholesale price of units returned . . . and pay shipping expenses and take a loss to the extent of the manufacturing and production costs," and it "might have to pay for any advertising arrangements already made that cannot now be cancelled without penalty." *Id.*

350. *Id.* The court noted that defendant continued to manufacture the infringing products after having received a cease and desist letter and even after plaintiff moved for preliminary injunction. *See id.* In ordering a product recall, the court rejected defendant's argument regarding hardship: "Hence, [defendant] made and shipped much of the unsold inventory now in the hands of distributors and retailers after it knew that it was proceeding without a valid license in the fact of plaintiffs' objections and with a court order possibly imminent. There is every reason to believe that it sought to get the product into the hands of distributors and retailers as quickly as possible to set up precisely the argument it now makes. In any case, the hardship of which it complains was significantly of its own making and could have been avoided or limited if it had stopped shipping when [defendant] received plaintiffs' first cease and desist letter." *Id.* at 323–24.

CHAPTER
3

The Basic Elements of Musical Language and Ideas

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Music is similar to language in that it is a temporal succession of articulated sounds that are more than just sound . . . [¶] It is not only as an organized coherence of sounds that music is analogous to speech, similar to language, but also in the manner of its concrete structure. The traditional doctrine of musical forms has its sentence, phrase, period, and punctuation. Questions, exclamations, subordinate clauses are everywhere, voices rise and fall, and, in all of this, the gesture of music is borrowed from the speaking voice.

Theodore Adorno[1]

To the gifted and experienced musician, music is a language—to be understood in sentences, paragraphs and chapters. The student who is still struggling with letters and words, so to speak, needs the guidance that will reveal to him the larger meanings of the musical language. . . . [T]his great language, . . . consists of more than one element; but there is hardly a doubt that the greatest of these organic elements is that of tonality with the inevitable relationship of tonal direction to the element of rhythm—for this is the space-time continuum in which music lives.

Leopold Mannes[2]

I. Music As Language

These quotations—one from Leopold Mannes, a member of an idealistic and influential musical family, the other from a composer, musical theorist, and legendary twentieth-century intellectual—come from different perspectives, but the backgrounds and objectives of these two visionaries may well account for the differences revealed in these brief quotations, each of which distills the essence of their views on the musical/linguistic analogy. Mannes, in his activities as teacher, director, and co-director of the Mannes School of Music, inherited his idealism from his father, David, a violinist who had been concertmaster of the New York Symphony Society Orchestra.[3] Theodore Adorno was a champion of the Second Viennese School, a composer of twelve-tone works, and a professor of philosophy at the University of Frankfurt, who counted among his friends and colleagues some of the great intellectual figures of the twentieth century.

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1. Theodore W. Adorno, Essays on Music 113 (Richard Leppert ed., Susan H. Gillespie trans., 2002).
2. Leopold Mannes, *Foreward* to Felix Salzer, Structural Hearing vii (1962).
3. After his marriage to Clara Damrosch, Leopold Mannes made it his life's work to bring musical education to young people and the underprivileged. The Mannes College of Music was preceded by the Third Street Music School Settlement (1894) and the Music School Settlement for Colored Children (1912).

In the analysis of music and copyright, and how each interacts with and influences the other, whether music is given full recognition as a "language" or is "similar to language" is irrelevant. Mannes and Adorno have provided us with the same starting point, albeit with different vocabulary: Music may, without any disclaimers or apologies, be analogized to written and spoken languages. This "language" offers an approach to the "expression" side of the idea/expression dichotomy. The "idea" component was best articulated by Aaron Copland, quoted in the Prelude to this book that, in substance, every composer begins his/her creative journey with a *musical* idea.[4]

In dissecting the various elements of literary works, the courts have fashioned tests to identify and separate protectable expression from unprotectable elements such as plot, theme, dialogue, stock characters, trite or commonplace phrases, and *scènes à faire*.[5] But what are the elements of "this great language"? The courts have been swimming in a sea of uncertainty in music infringement litigation. Most musicologists—with certain exceptions—begin their analyses outside the context of copyright protection of musical expression.

II. Copyright and the Components of Musical Language and Ideas

A. The Trinity: Melody, Harmony and Rhythm

For the most part, music in Western society is limited to twelve pitches, reduced to seven-note major and minor scales.[6] Just as in factual and dramatic works, where some expression is not entitled to copyright protection because only a limited manner of expression is available,[7] "[s]imilarity of tone

4. *See generally* Aaron Copland, What To Listen For In Music (1957).
5. *See*, *supra*, Prelude note 5 regarding *scènes à faire*.
6. The traditional Western scale contains the following intervallic relationship between pitches:

MAJOR SCALE								
Pitches:	1	2	3	4	5	6	7	8(1)
Intervals:	WHOLE	WHOLE	HALF	WHOLE	WHOLE	WHOLE	HALF	

NATURAL MINOR SCALE								
Pitches:	1	2	3	4	5	6	7	8(1)
Intervals:	WHOLE	HALF	WHOLE	WHOLE	HALF	WHOLE	WHOLE	

The minor mode has different permutations: harmonic minor (raised 7th); first melodic minor (raised 6th and 7th—ascending); second melodic minor (6th and 7th lowered upon descending); and Hungarian minor (raised 4th and 7th).

7. *See* Aliotti v. R. Dakin & Co., 831 F.2d 898, 901 (9th Cir. 1987).

succession" is "inevitable in all musical compositions."[8] Thus, pitch similarity standing alone cannot be used to establish copyright infringement.[9]

Although there is some difference of opinion regarding the elements of music, there appears to be consensus among a number of leading musicologists, composers, and pedagogues that the basic elements of music include melody, harmony, and rhythm. The judiciary, in its forays into copyright issues, has in many cases relied upon music experts regarding this trinity of basic elements of music[10] which we define as follows:

1. Melody:

The name given to the combination of linear successive musical notes (or pitches) and their corresponding durational values.

2. Harmony:

The simultaneous sounding of two or more different tones (or pitches) to produce "chords."[11] The structure of melody is essentially horizontal (*i.e.*, the name given to specific combinations of pitches) while the structure of harmony is vertical (chords). The temporal movement through the harmonies is the progression of "chords."

3. Rhythm:

The durational (or time) values of sound and silence (pitches and rests). Rhythm provides the feeling of movement in music and has been compared to breathing, pulse, and the ebb and flow of tides.

Although the presence of this trinity appears to be unanimous, there are those who supplement it with other components of musical ideas and language. Aaron Copland in his treatise on music for the common man—*What to Listen For in Music*—lists four basic elements of music: rhythm, melody, harmony, and tone color.[12] Ernst Toch, another composer and musical thinker,

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8. Hirsch v. Paramount Pictures, Inc., 17 F. Supp. 816, 817 (S.D. Cal. 1937).
9. The existence of a similar (or even identical) pitch progression in two works is of *no musical significance*. For example, "Rock of Ages" and "Rudolph, the Red-Nosed Reindeer," each of which contain the same seven-note progression C-D-C-A-F-D-C (1-2-1-6-4-2-1), would be found "substantially similar," even though the expression in each is substantially different.
10. *See, e.g.*, Northern Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 397 (S.D.N.Y. 1952) ("We examine now the rhythm, harmony and melody of both songs to determine whether similarity exists.").
11. *See* 5 The New Grove Dictionary of Music and Musicians ("Grove") 763 (Stanley Sadie ed., 2d ed. 2001). *See also, infra*, Sections III.A.&B. regarding chords, harmony, and equal temperament.
12. *See generally* Copland, *supra* note 4. These elements of music—according to Copland—are discussed in separate chapters of his book. Therefore, no page citations are listed.

in his book with the descriptive title *The Shaping Forces in Music*,[13] sees it somewhat differently: He apparently takes rhythm for granted (without mentioning it) and lists his four "shaping forces"—harmony, melody, counterpoint, and form.[14]

David Epstein in *Beyond Orpheus*[15] identifies three basic musical elements, or as he terms them "musical domains." He stresses that these domains must be analyzed in terms of multidimensional growth rather than limiting the focus to melodies and how they change (thematic development).

Epstein places these musical domains in the following categories:

1. Pitch, with reference to thematic shape, harmony (structure and progression in a local sense), tonal relations (harmonic progression and key schemes on larger structural levels).
2. Duration, with reference to tempo; rhythm and meter (in their small-scale roles as they bear upon thematic shape and in their larger ramifications).
3. Phrasing and nuance.
   The third group is a catchall group, inclusive of dynamics, timbre, register, styles of phrasing, and other aspects pertaining to the surface character of musical passages.[16]

Although these "domains" as envisioned by Epstein apply to the analysis of structural development, they are useful for an even broader approach to analyzing the basic elements of musical works.

B. Supplementing The Trinity

The late forensic musicologist Earl Spielman, in specifically tailoring the analysis of music to fit within controlling copyright principles, comes closer to the mark, suggesting that the following elements be considered together with rhythm, melody, and harmony as the framework within which to analyze musical works:

- *Pitch* (also called a "*note*" or "*tone*"), the specific location of notes in the tonal scale.[17]

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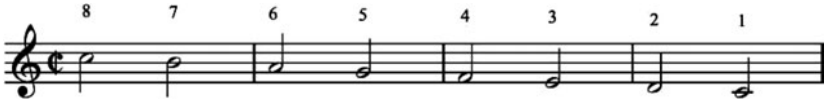
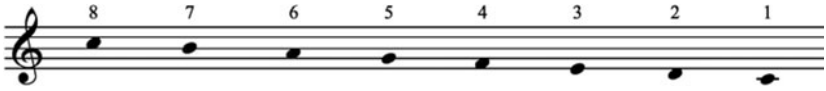
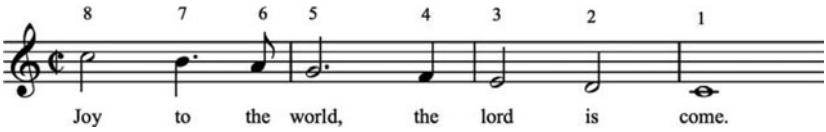
13. Ernst Toch, The Shaping Forces in Music (Dover Publications 1977) (1948).
14. *See generally id*. Toch divides his book into a discussion of these four "shaping forces" of music.
15. David Epstein, Beyond Orpheus (1979).
16. *Id*. at 28–29.
17. *See* Mozart example in Section III, *infra*. Dr. Spielman's suggestion regarding "pitch" is not intended by the author to be included as one of the musical elements, but rather used as an analytical tool to determine whether a plaintiff is basing his claim on similarity of tone or

- *Form* or *structure*, the way in which an entire work is organized in terms of section, (verses, choruses, etc.) and the way in which sections are organized in terms of phrases and/or subsections.

The suggestion to add pitch is a worthwhile contribution to the analysis of music/copyright disputes because, as briefly discussed above, pitch sequence alone is not protectable by copyright, as the court found in *Hirsch v. Paramount Pictures, Inc.*: "Similarity of tone succession . . . is, to a certain degree, inevitable in all musical compositions."[18] Thus, "pitches" or "notes" must at the very least be of different duration to constitute a melody. For example, a descending C major scale is merely a succession of notes without harmony or rhythm:

pitch succession (a *scène à faire*), or on defendant's actionable copying of plaintiff's original expression.

18. 17 F. Supp 816, 817 (S.D. Cal. 1937). Tone succession or pitch sequence constitutes a pure form of *scènes à faire*, because in the Western scale the key in which a composition is written is comparable to a force mandating that certain events occur. For example, it is virtually mandated that a composition logically end usually on a cadence of 5 to 1, with 5 designating the fifth note of the key in which the composition is written and 1 designating the first note (*i.e.* the root of the key [tonality] in which the work is written). If it is in the key of C major, the ending cadence would be 5 to 1, the dominant (5 or G) resolving to the tonic (1 or C). Pitch sequence, however, should be confined to its role as an analytical tool in copyright infringement litigation, since it is only raw material from which melody (one of the basic elements of music) is constructed. Similarly, concepts applicable to virtually all artistic creations may offer additional analytical tools in determining whether a commonplace musical device has been used in (1) a sufficiently unusual way so as to qualify for copyright protection, or (2) remains unprotectable under the copyright laws. Thus, when an academic or a reader, whether consciously or subconsciously, processes what he or she is reading, each must take into account the *context* in which language, descriptions or passages are placed in relation to what has gone before and what follows. Similarly, when analyzing a musical work, particularly in situations involving copyright protection, it is essential to consider the placement of motifs, phrases, melodies, rhythms, and harmonies. Add to these elements the *tenor* or *spirit* of the work—tragic, humorous, satiric, ironic, sardonic, etc. For example, characters in two works written by different authors may say "I'm going to kill 'em." In work number one, Tony Soprano from the hit cable television series, utters that familiar phrase. In the other, a novel about the life of a famous stand-up comedian, it is his ritual to repeat these words just before going onstage. If this phrase is merely stated by itself, its exact meaning is unclear. By placing it in the context in which the statement is made, no doubt remains as to the meaning each character intends to convey. By analogy, in music the same series of notes played fast and in a major key may, in the context of the particular passage, convey a different meaning than the same notes played slowly and in a minor key. That same passage played majestically (*maestoso*) by trumpets and french horns adds to the grandeur of the musical moment and, as a component of musical expression, differentiates it from the same passage played jocularly, or playfully by woodwinds (*giocoso*).

or, without rhythmic values:

but when durational values are added to the notes making some notes longer or shorter than their preceding or succeeding neighbors the C major scale becomes "Joy to the World" as follows:

When harmony is also added, "Joy to the World" and other musical works become complete in the sense that they are comprised of the basic trinity for musical compositions: melody, harmony, and rhythm. *Form/Structure* is the organizing element of musical composition and, as such, must join the trinity as one of the basic elements of music. Unlike "pitch," form/structure is an entirely different matter, in that it is more than an analytical tool. Thus, from the copyright perspective (and in the view of many musical professionals), when the trinity is supplemented and restated, the basic elements of music are: melody, harmony, rhythm, and form/structure.[19] They are comparable to the "plot, theme, dialogue, mood, setting, pace and sequence" found in literary and audiovisual works.[20] Theodore Adorno reminds us that "[t]he traditional doctrine of musical forms has its sentence, phrase, period, and punctuation."[21] Within each of these basic elements of a musical work are subsets of musical building blocks, free and available for all composers to use and develop. These are the ideas and raw materials which, standing alone, are not entitled to copyright protection. It is only when they are used and developed to create original expression that copyright protection is available for the composition (as distinguished from its constituent building blocks, which are not original

19. In *Tisi v. Patrick*, both experts were in agreement "that the elements to be considered on the question of similarity between [the two songs] were structure, melody, harmony and rhythm." 97 F. Supp. 2d 539, 543 (S.D.N.Y. 2000).
20. Litchfield v. Spielberg, 736 F.2d 1352, 1356 (9th Cir. 1984); *see also* Berkic v. Crichton, 761 F.2d 1289, 1293 (9th Cir.), *cert. denied*, 474 U.S. 826, 106 S. Ct. 85, 88 L. Ed. 2d 69 (1985).
21. Adorno, *supra* note 1, at 113.

and therefore not protected by copyright). We set them forth in the following brief glossary.

C. The Building Blocks of Music

1. The Phrase

The *phrase* is the smallest *structural* component of a musical composition. It has been described by Schoenberg as "a kind of musical molecule"[22] with a unity and completeness of its own. It has been likened to "natural 'breathing points'"[23] or, stated another way, the length of time at which one must take a breath when singing.[24] In literature, a phrase would be a breakpoint punctuated by a comma.[25] In music, it usually ends with a cadence.

2. Motive (Motif)

Motive is a terse musical idea, usually announced at the beginning of a musical work. It has been refined even more by Schoenberg, who called it the "'germ' of the idea."[26] It is a short, easily identifiable sequence of notes/pitches repeated throughout a work, and conveys a rhythmic, melodic or harmonic idea, or a combination containing two or all three of these elements. It is memorable and is repeated throughout a piece, usually varied or developed to

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22. Arnold Schoenberg, Fundamentals of Musical Composition 3 (Gerald Strang & Leonard Stein eds., 1980).
23. Cedric Thorpe Davie, Musical Structure and Design 18 (Dover Publications, Inc. 1966) (1953).
24. *See* Schoenberg, *supra* note 22, at 3.
25. *See id. See also* Willi Apel, Harvard Dictionary of Music 118 (2d ed. 1972) ("**Cadence** . . . . A melodic or harmonic formula that occurs at the end of a composition, a section, or a phrase, conveying the impression of a momentary or permanent conclusion. Each period of music history has a rather limited number of such formulas or, at least, a limited number of models of which all closing passages are but variations or modifications. . . . [¶] A cadence is called *perfect (final, full)* if it can be satisfactorily and normally used as the close of a composition.") (emphasis in original).

    The Oxford Companion to Music places the origin of cadences in linguistic terms: "**Cadence** or **Close**. The word 'cadence' comes from the Latin *cadere*, to fall (Shakespeare: 'That strain again; it had a dying fall.') In speaking, it is natural to drop the pitch of the voice on the last syllable of a sentence; the ancient plainsong melodies drop at their close to the chief note ('final') of the mode, from the note above, and if any book of folk-song melodies, hymn-tunes, and the like be examined it will be found that a considerable majority of them end by the corresponding downward step–from the 'ray' to the 'doh', the supertonic of the key to the tonic. There is, then, a general tendency to close by a fall, and this doubtless accounts for the word 'cadence.'" Percy A. Scholes, The Oxford Companion to Music 144 (John Owen Ward ed., 1984).
26. Schoenberg, *supra* note 22, at 8.

avoid monotony. As the germ of the idea it is a force driving forward movement in larger forms, including symphonies, concertos, overtures, and opera.[27] A motive usually carries within it a brief statement of three to eight notes with the potential for extensive and creative variation and development.[28]

3. Counterpoint

Counterpoint is one of the most important forces in musical composition. It is generally described as a combination of simultaneous but independent voices or parts created pursuant to a logical system of rules. Counterpoint is derived from the Latin *punctus contra punctum*, literally point against point, but in this context, note against note, or melody against melody (as defined above).[29]

4. Tempo and Expression Marks

These are terms and instructions regarding tempo (or speed) and matters of performance. The convention to use Italian terms has for the most part been maintained to the present day. Some examples are *largo* (broad), *lento* (slow), *adagio* (slow, but more leisurely than *lento*), *andante* (walking), *moderato* (moderate), *allegro* (fast), *allegretto* (*allegro*, but not quite as fast), *presto* (very fast), *prestissimo* (as fast as possible, but within the limits of human capacity). When a composer or arranger wishes to give instructions for gradual changes of speed, he uses such words as *retardando* (slowing up), *accelerando* (speeding up), and *rubato* (robbing durational value from one note for the benefit of the other, which gives a feeling of breathing while altering tempo).

5. Meter

Meter is the grouping of rhythms into units or patterns of duration and is designated and controlled by the time signatures that appear at the beginning of a musical work, but which may in the course of the composition be replaced by other time signatures. These time signatures are similar to fractions, for

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27. The Wagnerian *leitmotif* is used in his operas as a musical identification of persons (Siegfried, Brunhilde, Wotan, characters in *The ring of the Nibelungs*) or an object (*e.g.*—The sword Siegfried pulls from a rock or the birds and other animals in *Forest Murmurs*, a sequence from Act 2 of the opera, *Siegfried*).
28. *See* 17 Grove, *supra* note 11, at 227. *See also* Walter E. Nallin, The Musical Idea: A Consideration of Music and its Ways 27–28 (1968); Schoenberg, *supra* note 22, at 8–9.
29. *See* Harvard Dictionary of Music, *supra* note 25, at 208–11; 6 GROVE, *supra* note 11, at 551–52.

example: 4/4 meter represents four beats to a measure (or a bar)[30] with each quarter note receiving one beat.[31]

6. Two Basic Forms: Binary and Ternary Form

These are two of the most elemental forms, which consist of two and three main sections, respectively. Binary form is designated as AB with each section mutually dependent on the other with movement from one key to the other followed by a return to the tonic key. Ternary form follows an ABA scheme and "is perhaps the most fundamental of musical forms, based on natural principles of departure and return, and of thematic contrast then repetition."[32]

III. Musical Ideas and Expression: A Sampling

A. *Bach v. Mozart* and Chicago, Their Contemporary Colleagues: Using and Exploiting the Triad

To the extent that a sequence of notes has widely recurred, or was derived from a common source, it would constitute a building block, motif or musical idea that is not protectable.[33]

The confusion in distinguishing between idea and expression—or perhaps intentionally ignoring that distinction—has accounted for most of the copyright infringement opinions found in reported federal cases. This flawed approach to stating an infringement claim usually focuses on pitch similarity,[34] often by isolating a brief phrase or motif to the exclusion of other conventional

30. Bar lines mark off each measure.

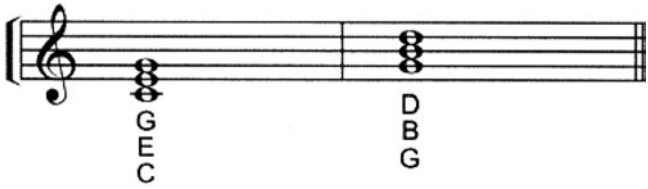
31. 3/4 meter (or ¾ time) means that each quarter note is equivalent to one beat, and there are three beats to the measure. Other meters include 6/8 time, 2/2 time, and any combination indicating the beats to the measure and the time value of certain notes, whether quarter note, eighth note, half note, whole note, etc.

32. 25 Grove, *supra* note 11, at 298; *see also* 3 *id*. at 576. Variants of these forms/structures will depend on situations encountered by the composer and his or her creativity. Two of the most commonplace are AA and AAB structure (binary) and ABABA structure (ternary). *See* discussion of Form and Structure, *infra*.

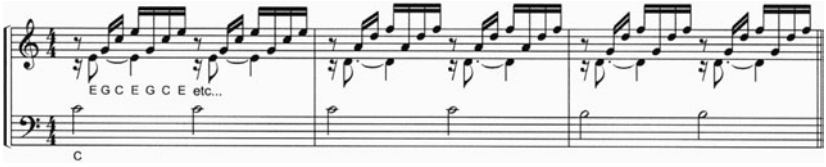
33. *See* Selle v. Gibb, 741 F.2d 896, 905 (7th Cir. 1984); Granite Music Corp. v. United Artists Corp., 532 F.2d 718, 721 (9th Cir. 1976).

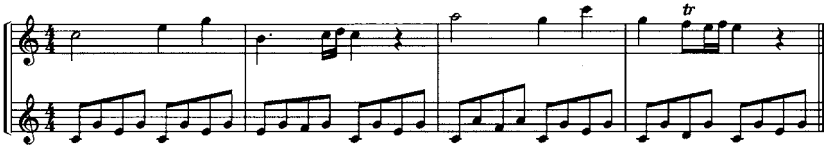
34. There is, however, the rare exception: In *Bright Tunes Music Corp. v. Harrisongs Music Ltd*., 420 F. Supp. 177 (S.D.N.Y. 1976), *aff'd sub nom*., ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1983), two motifs ("A" and "B") composed of commonplace pitch sequences were found to be protectable because the repetition of motif "A" four times followed by a repetition of motif "B" three times was so unusual as to constitute "original" expression. 420 F. Supp. at 180.

musical tools such as harmony, rhythm, melody, form/structure, and the context in which the idea is expressed, all of which must be creatively deployed to make the music original. For example, a triad is one of the most basic ideas in music. It is a chord composed of three notes including the root, a third, and a fifth[35] as follows:



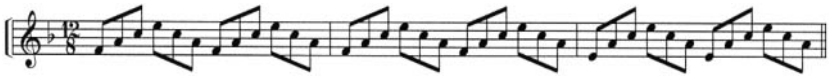
Separation of the pitches of a triad is equally commonplace and is unprotectable under the copyright laws.

Thus Bach used a series of broken or split triads beginning with a C major triad—a basic musical idea—when he created the C Major Prelude in the First Book of the *Well Tempered Klavier* as follows:

This pattern, modulating through a series of broken triads (C Major, D Minor, G Major, *etc.*), continues throughout the Prelude, which ends on a C Major chord.

Mozart, starting with the same C Major triad in his Sonata in C Major (K.545), with its split triads in the form of an *Alberti* bass—C-G-E-G-C-G-E-G (1-5-3-5-1-5-3-5)[36]—in eighth notes over which there is a ringingly clear C-E-G (1-3-5) in the first measure, creatively expressed this simple musical idea as follows:

35. *See* The Oxford Companion to Music, *supra* note 25, at 452.

36. "1" refers to the root (or first note) of the scale, "2" to the second, "3" to the third, etc.

The appearance of this figure in popular music reinforces the fact that it remains a musical idea available to all composers:

Chicago: "Color My World"

With this knowledge, let us turn to the use Bach and Mozart made of these triads and their variants. As we know from the Prelude to this book, copyright laws had been enacted in the early eighteenth century, and Vivaldi, in his infringement action against J.S. Bach would have been successful because Bach lifted virtually the entire contents of Vivaldi's Concerto For Four Violins—note for note, rhythmically and essentially, harmonically the same, and used it in his Concerto for Four Keyboards. Let us continue to assume that copyright law was in effect during the time Bach (1685–1750) and Mozart (1756–1799) were composing. During that period—from the late Baroque to the classical period—the western tonal system, consisting of twelve pitches or tones, provided the tonal framework for composers. As Bach died in 1750, it would have fallen to his heirs to determine whether to assert a claim against Mozart. If they had elected to do so, only defeat and disappointment would have been the result. Properly advised, they would have concluded that Mozart had used those raw materials and musical building blocks available to all composers, and would have made the wise decision not to sue. Each composer, however, in using these unprotectable equivalents of phrases and dynamics (the inflection of loud and soft) created original expression from unprotectable musical building blocks. Even though both are based on the practice of using broken triads, no one can successfully dispute that each of these two different expressions are original and bear the spark of genius. A fitting appraisal of the original expression applying to all original creative artists, Bach and Mozart included, is found in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corporation*:

> The complexity and artistry of the expression of an idea will separate it from even the most banal idea. Michaelangelo's David is, as an idea, no more than a statute [sic] of a nude male. But no one would question the proposition that if a copyrighted work it would deserve protection even against the poorest of imitations. This is because so much more was added in the expression over the idea.[37]

A useful perspective on the distinction between idea and expression concerns that situation when idea and expression coincide. Thus, as a prelude to

37. 562 F.2d 1157, 1168 (9th Cir. 1977).

its comparison of a male nude form with Michaelangelo's *David* the court observed that:

> Returning to our own example, the idea of a plaster statute [sic] of a nude will probably coincide with the expression of that idea when an inexpensive manufacturing process is used. There will be no separately distinguishable features in the statute's [sic] expression over the idea of a plaster nude statute [sic].[38]

In a footnote, the court expands on this approach in its observation that:

> A description of the "what" and the "how" of a work serves as a useful tool in determining whether the expression of an idea differs from the idea itself. If, in describing how a work is expressed, the description differs little from a simple description of what the work is, then idea and expression coincide.[39]

B. Equal Temperament and *Scènes à Faire*: The Harmonic Imperative

1. Equal Temperament

The controversies, debates, and struggles to find a tuning system that would liberate music from the strictures of untempered "scales" provide us with both history and saga. Prior to acceptance of equal temperament ("tonality") as we now know it, with twelve tones to the octave, each an equidistant one-half tone apart, the musical distance between notes was inconsistent. If we envision a piano keyboard, the unvarying pattern in every octave (using a C major scale as an example) consists of five black keys and seven white keys. The non-tempered scales were, until temperament first gained its primacy in Western civilization as the accepted system of tuning in the early eighteenth century, deemed inviolable by the church and others as having been created by God and, as such, could not be "tempered" (i.e., tampered with). The result was that composers could not write music permitting modulation from one "key" to another, because of the lack of consistency in musical distances between tones (or "notes"). The greater such distance, the more likely the sound would be harsh, ugly and, at the very least, unpleasant to the ear.

Equal temperament made possible what could not be achieved under non-tempered (or "natural") tuning. Among other advantages and achievements, modulation from one key to another could now be smoothly accomplished and the piano, with the new tuning system in place and the possibilities it created,

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38. *Id.*
39. *Id.* at n.10.

opened the way for the great works of the Classical and Romantic periods in the Western world. From the perspective of contemporary copyright theory, its application fits nicely within the doctrine of *scènes à faire*.

2. *Scènes à Faire*

Because of the nature of musical ideas and language, with particular reference to tone and chord progressions, the doctrine of *scènes à faire* should—or perhaps must—be a guiding analytic tool in any meaningful search to isolate and filter out unprotectable elements in a musical composition. The obviousness of this statement is that—focusing on Western music—there are laws and forces which dictate harmonic structures, progressions,[40] and cadences from which an internal logic has developed, just as universal concepts such as symmetry and dualism, and forces such as gravity assert themselves in the physical world.[41] In part, this occurs because (1) pitch selection is generally limited to the number of pitches in the major and minor scales; and (2) the equal tempered tonal system leads to and perhaps dictates (and conditions the listener to expect) that music logically move forward through development, modulation, transition, etc., to a conclusion which provides the listener with a final resolution of all that has gone before. By analogy, the logical result of throwing an object in the air is that it falls back to earth.[42]

As one respected publication puts it: "Here the premise is that one can abstract relations between harmonies from music and plot them as distances between points in two or more dimensions. This urge to spatialize musical phenomena has its immediate origins in registral intuitions of above and below: for Rameau, the dominant lies a perfect 5th above the tonic, the subdominant a perfect 5th below, and in this sense we can imagine the tonic as a centre, equidistant between the two dominants. In actual musical contexts, however, the tonic forms a conclusion, not a centre—it arrives at the ends of phrases, formal sections and entire pieces."[43] For example, when ending a hymn or other religious work with a musical amen (4 to 1) [sub-dominant

40. *See* § C.1, *infra*.

41. "Romain Rolland, in his *Musical Journey*, quotes the German theorist, Mattheson, in his *Vollkomenner Kappelmeister* (1739) as saying that in the 'new style' composers *hide* the fact that they write great music. 'A theme should have a certain something which the whole world already knows.'" Schoenberg, *supra* note 22, at 20.

42. As Stuart Isacoff, when referring to Isaac Newton's theory of gravity, aptly comments in his brilliant and entertaining book about the history and impact of equal temperament: "In the years following the publication of his idea, the theme of gravitation soared through European culture like a great mythical bird. . . . Composer Jean-Philippe Rameau explained the directional pull of tonal harmonies and was dubbed 'the Newton of music.'" Stuart Isacoff, Temperament 11 (2001).

43. 25 Grove, *supra* note 11, at 585.

to tonic][44] if a solo singer sings only "ah–," stops, and walks off the stage, the audience would experience a feeling of incompleteness, and perhaps would in its mind's ear supply the concluding "–men."[45]

C. Musical *Scènes à Faire:* Two Examples

1. Progressions

The Grove Dictionary of Music defines progression as "[a] succession of chords or chord-like constructions having coherence as an expression of harmony ('chord progression', 'harmonic progression'), especially one based on a familiar pattern such as the BLUES PROGRESSION."[46]

The judiciary in its forays into music infringement, in following the advice of forensic experts, has provided us with accessible analyses regarding copyright protection or lack thereof for progressions. In *Tisi v. Patrick*,[47] Judge Sweet weighs in on the "I-IV"[48] harmonic progression found in plaintiffs' and defendants' rock compositions. In granting summary judgment for the defendants, the court sets forth the following observations:

> Both songs are in the key of A major as are countless songs in all genres of music. In addition, although both songs feature in their respective introductions and verses a basic "I-IV" harmonic progression, which is built on the first and fourth steps of the scale (. . . from the A chord to the D chord), this harmonic progression can be found in songs of all genres and therefore its use in both [songs] does not constitute a significant similarity.[49]

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44. Called a *plagal cadence*.
45. There is a story—probably apochryphal—about a musician who was a guest at the residence of a music-lover, whose child was taking piano lessons. Upon going to bed for the night, he heard the child practicing at the piano. At the end of an easy sonatina the child approached the final perfect cadence (5 to 1) which traditionally ends works in the Western equal tempered scale. The young artist, however, abruptly stopped on the dominant (5) without ending the piece by resolving to the tonic (or the key in which the work was composed). The musician lay awake, unable to sleep until he put on his robe, went downstairs to the piano and played the tonic chord to provide the finale to the work. It was only then that he was able to sleep.
46. 20 Grove, *supra* note 11, at 402.
47. 97 F. Supp. 2d 539, 543 (S.D.N.Y. 2000).
48. The practice in musicology is to use Roman numerals. In the case of quotations and commentary on those quotations, that convention will be followed. In all other discussions of the intervallic relationships between pitches or notes in a scale, it is the author's experience, based on jury or bench (non-jury) trials, that it is preferable to use Arabic numerals.
49. *Tisi*, 97 F. Supp. 2d at 543.

Similarly, in *Johnson v. Gordon*,[50] the court affirmed the summary judgment in favor of defendants. The portion at issue was a III-II harmonic progression described as "a type of progression from a mediant chord to a supertonic chord, commonly inserted in popular and jazz music to 'create a sense of instability . . . with the hope of resolving at some point.'"[51] The court concludes that "this harmonic progression, which is a stereotypical building block of musical composition, lacks originality. Accordingly, it is unprotectable."[52]

In *Intersong–USA v. CBS, Inc.*,[53] the court dismissed the action and entered judgment for defendants. In its conclusions of law, the court found that "[o]ther similarities between the songs include their structure patterns, their use of a certain harmonic progression and a recurring eighth note rhythm. . . . [T]hese common elements are found in many other well-known songs. . . . . The elements and techniques used in the compositions . . . are unoriginal and constitute 'scenes a faire,' or ordinary, unprotectible expression."[54]

As the court in an earlier case held, harmony itself "is achieved according to rules which have been known for many years" and "[b]eing in the public domain for so long," it cannot by itself be copyrightable.[55] Another court has observed that even though harmony in and of itself is not accorded copyright protection because it is driven by the melody,[56] there are situations where even an otherwise unprotected element of music may by reason of its unusual use or expression raise a genuine issue of material fact, thereby foreclosing summary judgment.

In *Tempo Music, Inc. v. Famous Music Corporation*, for example, in which the estate of Billy Strayhorn claimed that his creative use of harmony in a version of the Duke Ellington classic song "Satin Doll" constituted a derivative work protected under the 1909 Copyright Act, the court's statement is instructive:

> Harmony is a derivative creation almost by definition. A composer generally creates a harmony to accompany a particular melody as opposed to developing harmony in the abstract. . . . [¶] While we agree that melody generally implies a limited range of chords which can accompany it, a composer may exercise creativity in selecting among these chords. As Strayhorn's expert notes, the choice of chords includes 'the mood, feel and sound of a piece.'[57]

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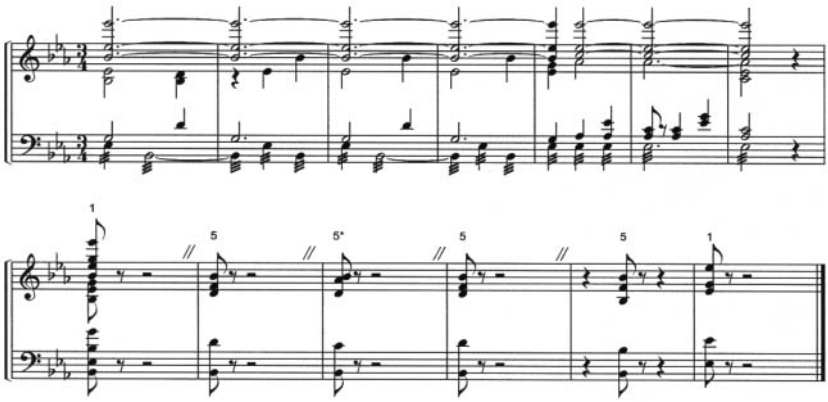
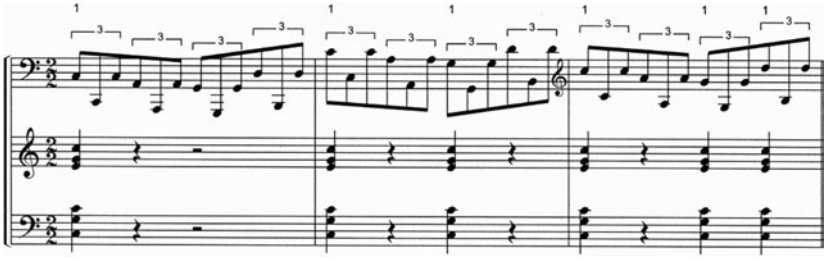
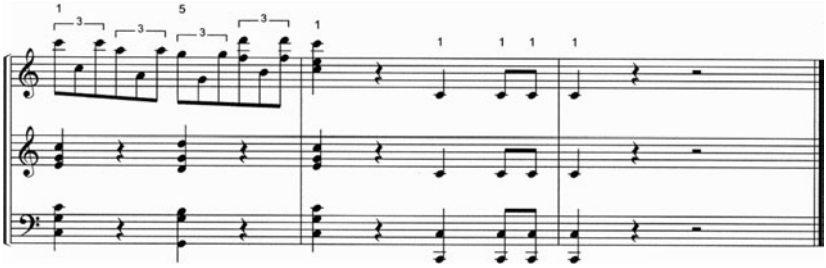
50. 409 F.3d 12 (1st Cir. 2005).
51. *Id.* at 23.
52. *Id.* For clarification, in a C Major scale, the mediant is the third step in the scale while the supertonic is the step (or note) immediately above the tonic. In other words, 3 is E, 2 is D and the tonic (1) is C.
53. 757 F. Supp. 274 (S.D.N.Y. 1991).
54. *Id.* at 282 (S.D.N.Y. 1991) (citation omitted).
55. Northern Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 400 (S.D.N.Y. 1952).
56. *See* Tempo Music, Inc. v. Famous Music Corp., 838 F. Supp. 162, 168 (S.D.N.Y. 1993).
57. *Id.* at 167–68.

2. Cadences: Two Examples

a. Sibelius

Similarly, a so-called *perfect* cadence (dominant to tonic, or 5-1) is one of the most commonly used endings in western music.[58] Standing alone it is unprotectable. At the conclusion of the Sibelius *Fifth Symphony*, however, the composer takes the basic idea or concept of a concluding cadence, and by placing the cadence in context and through harmony, rhythm, and structure makes the following *original* statement:

b. Rachmaninoff

Rachmaninoff was equally emphatic in ending his Piano Concerto No. 2 by taking a simple *perfect* cadence and turning it into this:

58. *See supra* note 18.

D. Comment: Harmony and *Scènes à Faire*

The choice to focus the discussion of *scènes à faire* on issues raised by the role of harmony in musical composition—in particular chord progressions—is that *scènes à faire*, in their original sense, focus on the events that logically follow from the theme or premise on which the work is based. As the court observed in *Schwarz v. Universal Pictures Company*,[59] "[t]he French use a very expressive phrase in dramatic literature: '*scenes a faire*' that is, scenes which 'must' be done. For instance, the '*scene a faire*' in the present script is called for by the scene in which the girl burned her hand on a cigarette. Something had to be done with that burn, and the author uses it as a means of identification." The same applies to music and in particular those issues involving what Felix Salzer has termed the "harmonic impulse" when he advises us of the following:

> All harmonic impulse is basically directed from the I to the V and on to the final I. Even though the III and the IV have a harmonic association with I, this association is superseded by the stronger over-all drive to the V, which causes each intermediary harmony such as the II, III, IV or VI, not to retard but to elaborate that motion to the V. This drive to V, however, would be impaired, if two intermediary harmonies such as II-IV, III-II or VI-II appeared between I and V. One of these intermediary harmonies would offset the impulse of the other in elaborating the drive to the V. . . . Once the V has been reached the final I is due; sometimes the V is prolonged to delay the appearance of the I which remains the ultimate goal of a complete harmonic progression.[60]

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59. 85 F. Supp. 270, 275 (S.D. Cal. 1945). *See, supra*, Prelude note 5 for a fuller explanation of the doctrine of *scènes à faire*.

60. Salzer *supra* note 2, at 96. *See* also Leonard B. Meyer, Music, The Arts and Ideas: Patterns and Predictions In Twentieth-Century Culture 7–8 (University of Chicago Press 1994) (1967) (emphasis added) (Meyer discusses style and information theory: "Style constitutes the universe of discourse within which musical meanings arise. There are many musical styles. They vary from culture to culture, from epoch to epoch within the same culture, and even within the same epoch and culture. This plurality of musical styles results because styles exist not as unchanging physical processes in the world of nature, but as psychological processes ingrained as habits in the perceptions, dispositions, and responses of

IV. Form/Structure and "Forms"

A. The Issue: A Question of Terminology and Context

There has long been much debate and confusion about the word "form" and what it describes in the lexicon of musical ideas and language. Perhaps the most instructive definition of form/structure for the purpose of music copyright analysis is found in *Fundamentals of Musical Composition*, in which Arnold Schoenberg informs us that "form means that a piece is *organized*; i.e. that it consists of elements functioning like those of a living *organism*. . . . [¶]The chief requirements for the creation of a comprehensible form are *logic* and *coherence*."[61] Thus, Schoenberg, like Earl Spielman after him, appears to use the term "form" as an element of music applying both to *form* as *structure* and the *forms* or *genres* discussed in the following paragraphs.

Others take a different approach. For example, in *The Grove Dictionary of Music*, the entry on "Form" begins by advising the reader of the following definition and distinction: "**Form**. The constructive or organizing element in music. This article is concerned with the concept of form itself, not with the historical evolution of particular forms or *genres* (for which see articles under appropriate titles). Form might be defined simply as what forms have in common, reflecting the fact that an organizing impulse is at the heart of any compositional enterprise, from the most modest to the most ambitious."[62] In *The Shaping Forces in Music*, Ernst Toch makes a similar distinction regarding the meaning of "form" when he advises us that "[w]hatever **FORM** may be, let us not confuse it with *forms*, namely the forms used in classical music."[63] What Toch is saying, in effect, is that **FORM** should not be used as a synonym for *structure*, and that the plural of "form" should be limited to designations for particular "forms" or genres such as sonata form, rondo, canon, fugue, variation form, and dance forms (e.g. gavotte, minuet, etc.). Toch's distinction regarding the use of the word "form" is not observed by a number of other composers and scholars.

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those who have learned through practice and experience to understand a particular style. What remains constant from style to style are not scales, modes, harmonies, or manners of performance, but the psychology of human mental processes—the ways in which the mind, operating within the context of culturally established norms, selects and organized the stimuli that are presented to it. . . . [¶]*Once a musical style has become part of the habit responses of composers, performers, and practiced listeners it may be regarded as a complex system of probabilities. That musical styles are internalized probability systems is demonstrated by the rules of musical grammar and syntax found in textbooks on harmony, counterpoint, and theory in general.*").

61. Schoenberg, *supra* note 22, at 1 (emphasis in original).
62. 9 Grove, *supra* note 11, at 92 (emphasis in original).
63. Toch, *supra* note 13, at 153 (emphasis in original); *see* discussion of binary and ternary form, *infra*.

For the purpose of copyright analysis, the distinction between **FORM** and *forms* will not be observed because to do so will only cause confusion among practitioners, the judiciary, and of equal importance, the men and women who sit on juries in copyright infringement trials. The reason for the use of the terms "structure" or "form/structure" is driven by the need (1) for terminology that fits within the categories of "procedures, processes and systems," set forth in the Copyright Act and (2) to define that element used by all composers to provide "logic and coherence" to their musical works.

B. § 102(b) of the Copyright Act: "Procedures, Processes, Systems"

Section 102 of the Copyright Act—Subject Matter of Copyright: In General—not only advises us of those "original works of authorship fixed in any tangible medium of expression that are protectable under copyright,"[64] but also those that cannot be granted copyright protection. With respect to the latter, Section 102(b) provides as follows:

> (b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.[65]

Many years prior to this terse statement of unprotectables in Section 102(b), the Supreme Court addressed the issue of copyright protection for a bookkeeping system in *Baker v. Selden*.[66] The facts in *Baker v. Selden* are brief and uncomplicated: Selden's deceased predecessor-in-interest wrote a 1879 copyrighted book entitled *Selden's Condensed Ledger, or Book-keeping Simplified* (which the Court described as a "peculiar system of book-keeping"),[67] and thereafter copyrighted additional books supplementing the first book in what became a series. These books included an explanation of the bookkeeping system and blank forms "consisting of ruled lines, and headings, illustrating the system and showing how it is to be used and carried out in practice."[68] Defendant Baker, in his book, used the same system as the one explained and illustrated in the Selden books. The Court held for Baker and stated that the

64. *See* 17 U.S.C. § 102(a), in which the Act sets forth eight general categories of "works of authorship" that are protectable under copyright.
65. *Id.* § 102(b).
66. 101 U.S. 99, 25 L. Ed. 841 (1879).
67. *Id.* at 100.
68. *Id.*

system explained in the book "cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public; not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application."[69] The Court continued by observing that "[t]he description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent."[70]

Feist Publications, Inc. v. Rural Telephone Service Company, Inc.[71] also bears on this issue. In *Feist*, the Supreme Court reversed a judgment against publishing company Feist, which had copied the alpha compilations of telephone subscribers in the white pages of the telephone company's telephone directories. In reversing the judgment, the Court made the following observations: "The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. . . . It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess a minimal creative spark required by the Copyright Act and the Constitution."[72] The Supreme Court in *Feist* is stating two propositions: (1) alphabetical listing is a virtual *scène à faire* because it is "inevitable" and (2) alphabetical listing is a universally understood method or system for directories, encyclopedias, and other publications using that methodology.

C. Musical Form/Structure and "Procedures, Processes, Systems"

Using the words *form* or *structure* as they have been defined above as the organizing element in music whose reach is extended not only to **FORM** (as Toch

69. *Id.* at 103.

70. *Id.* at 105. *See also* Crume v. Pacific Mut. Life Ins. Co., 140 F.2d 182, 184–85 (7th Cir.) (where the court simply stated "[t]o hold that an idea, plan, method or art described in a copyright is open to the public but that it can be used only by the employment of different words and phrases which mean the same thing, borders on the preposterous. It is to exult the accomplishment of a result by indirect means which could not be done directly. It places a premium upon evasion and makes this the test of infringement."), *cert. denied*, 322 U.S. 755, 64 S. Ct. 1265, 88 L. Ed. 1584 (1944).

71. 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991).

72. 499 U.S. at 363, 111 S. Ct. at 1297.

expressed in capital letters and bold type), but also to *forms* or *genres* such as sonata form, rondo, canon, variation form, and dance forms, etc., we can properly conclude that form/structure in virtually all its applications is a procedure, process, and/or application to, in Schoenberg's words "means that a piece is *organized*: i.e. that it consists of elements functioning like those of a living *organism*. . . . [¶] [T]he chief requirements for the creation of a comprehensible form are *logic* and *coherence*."[73] This organizing element to achieve "logic and coherence" applies whether the work uses sonata form in classical and romantic concert works; twelve-bar phrases for the blues, binary and ternary form; and a standard structure for rock music which includes "an introduction, verse, chorus, and bridge, with harmonic and rhythmic similarities common to many musical genres, including rock music."

There are, however, in vernacular, those exceptions that prove the rule: *Bright Tunes Music Shop v. Harrisongs Music, Ltd.*, in which George Harrison in composing "My Sweet Lord" unintentionally copied substantial portions of Ronald Mack's song "He's So Fine," a hit song which had been recorded by a popular singing group. Judge Richard Owen, an accomplished musician, observed that "He's So Fine" is a "catchy tune consisting essentially of four repetitions of a very short basic musical phrase" which was used with another short musical phrase to form a "highly unique pattern."[74] In effect, the court is stating that the structure, although using commonplace musical building blocks, was so unique that it was protectable. The judge attributed the copying to Harrison's subconscious knowledge of "He's So Fine" and stated that "I do not believe he did so deliberately. Nevertheless, it is clear that My Sweet Lord is the very same song as He's So Fine with different words, and Harrison had access to He's So Fine."[75]

D. Conclusion: Original Musical Works and The Vast Storehouse of Musical Ideas and Building Blocks

Although this book is not intended as a treatise on musicology or a substitute for a musicologicist or other qualified music professional, the application of copyright principles to the foregoing discussion and illustrations serves as a few exemplars of the following: (1) the multitude of unprotectable musical ideas which are the raw materials with which composers construct their works; and (2) the creative expressions which, as the court in *Krofft* observed,

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73. Schoenberg, *supra* note 22, at 1 (emphasis in original).

74. 420 F. Supp. at 178. *See also* note 34, *supra*, in which the musical repetition of a motif provided one rationale for copyright protection of an unusual pitch sequence. Judge Owens' language quoted above—"highly unique pattern"—provides another rationale for copyright protection regarding the structure of otherwise unprotectable fragments.

75. *Id.* at 180–81.

entitle the creators to copyright protection. All composers who express ideas in a personal way and meet those standards of originality with its element of creativity, as articulated in *Feist*, are entitled to protection under our copyright laws. It is only in the context of judicial proceedings that two works are compared/contrasted and a decision is rendered either by a judge or a jury separating unprotectable ideas from protected expression.

CHAPTER
4

Infringement and the Commencement of Litigation

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[A] copyright infringement action depends upon whether the defendant copied from the plaintiff, or whether he independently created his composition. Any evidence pertaining to the manner in which the defendant created his composition is logically relevant: his training, the subject matter of the art, his access to other works or to the plaintiff's composition.

—Granite Music Corporation v. United Artists Corporation[1]

In representing a client, a lawyer shall exercise independent professional judgment and render candid advice. In rendering advice, a lawyer may refer not only to law but to other considerations such as moral, economic, social and political factors that may be relevant to the client's situation.

—Rule 2.1 of the American Bar Association's Model Rules of Professional Conduct[2]

I. Pragmatism and Ethics: Initial Considerations

These quotations from the American Bar Association's Model Rules of Professional Conduct and from the *Granite Music* case may at first blush appear to be mismatched. One sets forth a specific and basic statement of the ultimate issue to be decided in a copyright infringement case, and the evidence necessary to address that issue, while the other deals with a general but high-minded pronouncement of the standards of conduct expected of lawyers. Taken together, however, the core principles embodied in these two statements provide a formulaic guide for the proper representation of clients involved in litigation, from a client's first contact with a lawyer, through the due diligence and evaluation of whether the plaintiff has a winnable case, or whether the defendant has viable defenses, continuing with the decision as to whether the plaintiff should file a complaint, and leading ultimately to the resolution of the dispute, either through settlement or trial. The lawyer must "exercise independent professional judgment" in marshaling and evaluating evidence and the applicable law, and "render candid advice" when advising the client of the merits or lack thereof in deciding whether to commence litigation, and when advising the defendant of the merits of his or her defenses. What follows in this chapter is a discussion of the steps to be taken by counsel on both sides, so that when analyses of the claims or defenses have been completed, the lawyer is fully prepared to advise his client of the risks and rewards

1. 532 F.2d 718, 720 (9th Cir. 1976).
2. Model Rules of Prof'l Conduct R. 21 (2002).

inherent in the contemplated litigation. In many respects, copyright litigation claims are no different from other claims, and require a combination of professionalism, knowledge of the copyright laws, wisdom, and good judgment. We commence at the point when the client has contacted a lawyer regarding an infringement claim and the process begins.

II. Pre-Meeting Tasks for the Parties

A. The Plaintiff[3]

When a plaintiff contacts a lawyer and says that a popular song she composed has been "ripped-off" by the composer of the score for a film that grossed in excess of $230 million at the box office and wants to file a lawsuit, an appointment is arranged and the client is requested to send the following items to the lawyer in advance of the office conference:

- Certificate of copyright documenting that the plaintiff's work has been registered in the United States Copyright Office;
- A sound recording of plaintiff's works as deposited with the Library of Congress (the "Deposit Copy");
- Commercial sound recordings of both the plaintiff's composition and the defendant's work;
- Score of the plaintiff's work;
- Copies of sheet music (if any) of the defendant's work; and
- A resume of the client's professional activities, titles of composition and membership in performing rights societies (ASCAP, BMI, SESAC, etc.), and other industry-based organizations (*e.g.* the Songwriters' Guild).

B. The Lawyer for the Plaintiff

Prior to meeting with the plaintiff the lawyer should get a feel for her case by doing the following:

- Listen to the sound recordings of both compositions and form a "non-expert" impression of the similarities and dissimilarities between the contending works: in other words, conduct a private "audience test" as the lay auditor;

3. For convenience the parties will be called "plaintiff" and "defendant," although in this scenario an action may not have been filed.

- Compare the sheet music of each work (if available) and, if counsel is unable to read music, at least determine whether the contours created by the notations in each work are similar; and
- Even though the lawyer may be familiar with the law, undertake a brief review regarding music infringement.

C. The Lawyer for the Defendant

Preparation for evaluation of the defendant's position is virtually the same as for the plaintiff's with the following exception:

- The lawyer should focus on viable defenses as well as liability and damages issues.

III. The Initial Office Conference

A. Clarifying the Plaintiff's Perspective

Even though the plaintiff may have supplied the information in writing, it is still necessary to conduct an in-depth inquiry into the plaintiff's background, including her musical training and professional experience, whether any of her works have been published, the name of her publisher, whether her works include scores for motion picture and television properties and whether she is also a performer.

Ask the plaintiff to describe in detail the creative process she followed in composing her work. Was she hired to write the work? Did she refer to any other preexisting compositions in doing so? Where did she do all or most of her work, *e.g.*, in a studio, at home, in an office? Were there deadlines for delivery of the work?

Discuss with the client whether she knows any specific instances when the defendant had access to her work, for example: Did her work receive substantial airplay? Has it been performed in concerts, and, if so, the venues for such concerts? Did she submit her composition to a publisher, studio, or television network? If so, was the defendant associated with the studio, network, etc., during the period plaintiff believes the defendant had access to her work?

Have the client explain in detail which portions of her work were unlawfully taken and used by the defendant, and in so doing point out similarities in melody (note or pitch progression), harmony, and rhythm.

Ask the client the exact nature and extent of the relief she is seeking. This presents an opportunity to evaluate whether the plaintiff is seeking relief that is reasonable or its exact opposite. For example, if a plaintiff is seeking damages

that would be comparable to what the composer of a motion picture score would have received for the single composition, that is very different from one who wants a percentage of the box office, a percentage of ancillary rights (*e.g.* merchandising), profit participation (if any) by the composer of the motion picture score, all of which may well end in disappointed expectations.

Use this meeting as an opportunity to evaluate the intelligence, personality, sincerity, and reasonableness of the plaintiff. The insights gathered from such a discussion are invaluable both to determine whether the lawyer wants to represent this client and to foresee problems in which case the lawyer may elect not to represent her.

B. Clarifying the Defendant's Perspective

With the exception of the explanation about which portion of plaintiff's work was unlawfully copied by defendant, all other points made in section A apply to the defendant.

IV. The Demand Letter and the Response

A. The Demand Letter

September 24, 2007

Malcolm P. Goniff
and Indie Publishing and Recording, Inc.

Re: *Vocale v. Malcolm Goniff and Indie Publishing and Recording, Inc.*

Ladies and Gentlemen:

This firm represents Richard Vocale, professionally known as Big Richard, who is the composer, prominent singer, entertainer and composer of popular works, including "Song of Love." We, on our client's behalf, have conducted a thorough musicological analysis and a review of applicable law. It is our opinion and conclusion that Malcolm Goniff, in creating the song "Stolen Words," has copied quantitatively and qualitatively important portions of "Song of Love," which are protected under the copyright laws of the United States of America. As a result of Malcolm Goniff's unlawful copying, and the performance, recording and other exploitation of "Stolen Words," both as a single and an album cut, Richard Vocale has suffered damages in an amount in excess of one million dollars.

You should therefore consider this letter as notice to each of you to cease and desist from further performances, distribution of recordings and other exploitation of "Stolen Words," and to immediately pay to our client, care of

this firm, the sum of one million dollars. If you fail to do so no later than October 1, 2007 we are authorized by our client to proceed against you with all available claims and remedies, including damages, accounting of profits or, alternatively, statutory damages and such interest as is allowable by law. In addition, our client has been required to retain counsel to enforce his rights under the copyright laws and will be entitled to an award of attorneys' fees which, as of this date, aggregate $37,330.

The foregoing is not intended by us, nor to be construed or interpreted by you or your clients, as a waiver or relinquishment of any other rights, claims, damages, remedies or privileges Richard Vocale may have with respect to this matter, or otherwise, and all such rights, claims, damages, remedies and privileges hereby are expressly and specifically reserved.

Yours very truly,

George P. Moneymaker

B. The Response

Re: *Vocale v. Malcolm Donoff and Indie Publishing and Recording, Inc.*

Dear Mr. Moneymaker:

Receipt is acknowledged of your letter of September 24, 2007 regarding the above-referenced matter.

Please be advised that we have now completed our analysis of the claims and contentions set forth in your letter. We have not only carefully analyzed the musicological elements of the two compositions, but have also conducted a thorough review of the law applicable to the claims you are asserting on behalf of Richard Vocale. We have concluded that, assuming for the sake of argument that there are similarities between "Song of Love" and "Stolen Words," those similarities relate only to commonplace building blocks of music, and musical *scènes à faire* and are not protectable under the copyright laws of the United States. We, on our clients' behalf, deny and reject the claims you have asserted on behalf of Mr. Vocale. If you have any additional information which you believe we, on behalf of our client, should review and analyze, or if you wish to speak further about this matter, please contact us at your convenience.

The foregoing is not intended by us, nor to be construed or interpreted by you or your client, as a waiver of any other rights, claims, defenses or privileges our clients may have with respect to this matter or otherwise, and all such rights, claims, defenses or privileges hereby are expressly and specifically reserved.

Yours very truly,

Franklin M. Earnest

Comment

The foregoing are very typical letters which are exchanged when a claim of copyright infringement is asserted and/or denied by lawyers on behalf of their respective clients. In particular, please note the response, which asks for more information, rather than aggressively denying the plaintiff's assertions and, in so doing, as is sometimes the case, denigrating the plaintiff and his lawyer. The request to give more information about the plaintiff's position may lead to the resolution of the dispute or disclosure of additional information, although in most instances the former would be very rare.

V. Pleading: The Complaint and Answer

A. Theory and Practice

At such time as the plaintiff and his lawyer have fully analyzed the merits of his case against the defendant and concluded that it is necessary to file a complaint for infringement, they should have a clear understanding of the pleading standards required under the Federal Rules of Civil Procedure, and, in particular, Rule 8. Unlike "code" or "fact" pleading mandated in many state jurisdictions, requiring that all elements of a "cause of action" be alleged or, stated another way, pleading specific elements necessary to prove a *prima facie* case against the defendant, Rule 8 requires only that the pleading contain a statement of the claim sufficient to show the pleader is entitled to relief.[4] As the Supreme Court in *Conley v. Gibson* held, "the Federal Rules of Civil Procedure do not require a claimant to set out in detail the facts upon which he bases his claim. To the contrary, all the Rules require is 'a short and plain statement of the claim' that will give the defendant fair notice of what the plaintiff's claim is and the grounds upon it rests. . . . Such simplified 'notice pleading' is made possible by the liberal opportunity for discovery and the other pre-trial procedures established by the Rules to disclose more precisely the basis of both claim and defense and to define more narrowly the disputed facts and issues."[5]

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4. *See* Fed. R. Civ. P. 8(a)(2).
5. 355 U.S. 41, 47–48, 78 S. Ct. 99, 103, 2 L. Ed. 2d 80 (1957), *abrogated on other grounds by* Bell Atl. Corp. v. Twombly, ___ U.S. ___, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007). (The *Bell Atlantic* Court rejected the literal interpretation of *Conley's* "no set of facts" language which provided that a complaint should not be dismissed for failure to state a claim unless it was beyond any doubt that the pleader could prove "no set of facts" in support of the pleaded claims that would entitle the pleader to relief. 127 S. Ct. at 1968–69 & n.8.) The *Conley* Court concludes its opinion with a diplomatic condemnation of the game theory of litigation when it states that "[t]he Federal Rules reject the approach that pleading is a game of skill in which one misstep by

Forty-five years later, in *Swierkiewicz v. Sorema N.A.*,[6] in an opinion involving age and national origin discrimination, the Court, per Justice Thomas, drives home this distinction between evidentiary standards and pleading requirements when it observes that "this Court has reiterated that the prima facie case relates to the employee's burden of presenting evidence that raises an inference of discrimination," but that "[t]his Court has never indicated that the requirements for establishing a prima facie case . . . also apply to the pleading standard that plaintiffs must satisfy in order to survive a motion to dismiss."[7]

Although Rule 8 of the Federal Rules of Civil Procedure only requires that a complaint include "a short and plain statement of the claim showing that the pleader is entitled to relief"[8] and need only "give the defendant fair notice of what the plaintiff's claim is and the grounds upon which it rests,"[9] there may be tactical reasons to include more than the "bare bones" pleading permitted by the Federal Rules. There are some practitioners who want to tell a complete story, including the standing and reputations of their clients, the success they have achieved, *etc*. These averments are apparently for the purpose of giving the court, upon a first reading of the complaint, a "feel" for the people involved and a more complete factual recitation of the facts and claims at issue. The author, however, prefers something closer to the minimum requirements of Rule 8, letting the discovery process flesh out the evidence to be marshaled for a potential summary judgment motion or for trial. In any event, there are few, if any, consequences for over-pleading.[10] The factual settings and objectives of the plaintiff and his counsel are too varied to be doctrinaire about the type of pleading that will best serve the client's interests. The decision as to which approach to take will be determined by the facts at issue, the parties involved, and the discretion and judgment of the plaintiff's lawyer.

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counsel may be decisive to the outcome and accept the principle that the purpose of pleading is to facilitate a proper decision on the merits." 355 U.S. at 48, 78 S. Ct. at 103.

6. 534 U.S. 506, 122 S. Ct. 992, 152 L. Ed. 2d 1 (2002).
7. *Id.* at 510–11, 122 S. Ct. at 997.
8. Fed. R. Civ. P. 8(a)(2); *see also Conley*, 355 U.S. at 47, 78 S. Ct. at 103.
9. 355 U.S. at 47, 78 S. Ct. at 103.
10. Courts seldom, if ever, dismiss a complaint containing irrelevant or repetitive matter. *See, e.g.*, United States *ex rel.* Garst v. Lockheed-Martin Corp., 328 F.3d 374, 378 (7th Cir.) ("Surplusage can and should be ignored. Instead of insisting that the parties perfect their pleadings, a judge should bypass the dross and get on with the case"), *cert. denied*, 540 U.S. 968, 124 S. Ct. 450, 157 L. Ed. 2d 313 (2003). If, however, the complaint is inordinately lengthy, it may be dismissed. *See, e.g.* Michaelis v. Nebraska State Bar Ass'n., 717 F.2d 437, 439 (8th Cir. 1983) (Complaint setting forth 144 numbered paragraphs in 98 pages was dismissed for not complying with Rule 8 of the Federal Rules when "[t]he style and prolixity of these pleadings would have made an orderly trial impossible").

B. Preparation of the Complaint

1. Appendix of Forms, Federal Rules of Civil Procedure

Form 19. Complaint for Copyright Infringement[11]

Form effective Until December 1, 2007, absent contrary Congressional action.

(Caption—See Form 1.)

1. (Statement of Jurisdiction—See Form 7.)
2. Before *date*, the plaintiff, a United States citizen, wrote a book entitled _____.
3. The book is an original work that may be copyrighted under United States law. A copy of the book is attached as Exhibit A.
4. Between *date* and *date*, the plaintiff applied to the copyright office and received a certificate of registration dated _____ and identified as *date, class, number*.
5. Since *date*, the plaintiff has either published or licensed for publication all copies of the book in compliance with the copyright laws and has remained the sole owner of the copyright.
6. After the copyright was issued, the defendant infringed the copyright by publishing and selling a book entitled _____, which was copied largely from the plaintiff's book. A copy of the defendant's book is attached as Exhibit B.
7. The plaintiff has notified the defendant in writing of the infringement.
8. The defendant continues to infringe the copyright by continuing to publish and sell the infringing book in violation of the copyright, and further has engaged in unfair trade practices and unfair competition in connection with its publication and sale of the infringing book, thus causing irreparable damage.

Therefore plaintiff demands:

(a) until this case is decided the defendant and the defendant's agents be enjoined from disposing of any copies of the defendant's book by sale or otherwise.
(b) the defendant account for and pay as damages to the plaintiff all profits and advantages gained from unfair trade practices and unfair competition in selling the defendant's book, and all profits and advantages gained

11. Although the subject matter of this form and the proposed form immediately following is for copyright infringement of a book, it can be adapted for other types of infringement, including those involving actionable copying from a musical work.

from infringing the plaintiff's copyright (but no less than the statutory minimum);

(c) the defendant deliver for impoundment all copies of the book in the defendant's possession or control and deliver for destruction all infringing copies and all plates, molds, and other materials for making infringing copies;

(d) the defendant pay the plaintiff interest, costs, and reasonable attorney's fees; and

(e) the plaintiff be awarded any other just relief.

(Date and sign—See Form 2.)

(Added Apr. 30, 2007, eff. Dec. 1, 2007.)

2. Complaint for Copyright Infringement (Basic Allegations in Compliance With Rule 8 of the Federal Rules of Civil Procedure)

Professional Corporation
Attorneys for Plaintiff

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Richard Vocale, professionally known as Big Richard,	) Case No.
	) COMPLAINT FOR COPYRIGHT
Plaintiff,	) INFRINGEMENT
v.	) JURY TRIAL DEMANDED
Malcolm Goniff and Indie Publishing and Recording, Inc, a corporation,	)
Defendants.	)

Plaintiff complains against defendants and alleges the following:

GENERAL ALLEGATIONS

1. This is a civil action, for which a jury trial is demanded, for damages for copyright infringement in connection with defendants' unauthorized copying and subsequent use, performance and exploitation of protected elements of plaintiff's copyright.

JURISDICTION AND VENUE

2. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1338(a). The alleged unlawful acts and violations described below were in part conceived, carried out and made effective within the Southern District of California. All of the defendants named herein transact or have transacted business within this District.

3. Venue is proper in this District pursuant to 28 U.S.C. § 1400(a), 28 U.S.C. §§ 1391(b)(2) & (3), and 28 U.S.C. § 1391(c).

THE PARTIES

4. Plaintiff Richard Vocale, professionally known as "Big Richard," is an individual residing in Los Angeles, California. Plaintiff Vocale is a singer, entertainer and composer of popular musical works, including "Song of Love."

5. Defendant Malcolm Goniff (aka "Big Mal") is an individual who, on information and belief, resides in Los Angeles and, at all relevant times herein, was doing business throughout the State of California. Defendant is a singer and composer of popular musical works and, on information and belief, is the composer of a popular musical work entitled "Stolen Words."

6. At all times relevant herein, defendant Indie Publishing and Recording, Inc. was, and still is, a California corporation with its principal place of business in Los Angeles, California and is in the business of publishing, recording and selling sheet music and recordings of popular music to the public.

7. Plaintiff is informed and believes, and thereon alleges, that each defendant named in this complaint is in some manner responsible for the wrongs and damages as alleged below, and in so acting was functioning, at least at times, as the agent, servant, partner, alter ego and/or employee of the other defendants, and in doing and/or not doing the actions mentioned below was acting within the course and scope of his or her or its authority as such agent, servant, partner, and/or employee with the permission and consent of the other defendants.

Further, all acts herein alleged were approved of and ratified by each of the defendants.

CLAIM FOR COPYRIGHT INFRINGEMENT
(Against All Defendants)

8. In or about January 2004, plaintiff authored the musical composition "Song of Love." The composition is original to plaintiff and is copyrightable subject matter under the Copyright Laws of the United States of America.

9. In 2004, the copyright in "Song of Love" was registered with the U.S. Copyright Office, registration number _____.

10. Plaintiff is the sole owner of all right, title and interest in and to the foregoing copyright. The composition has been published, performed and otherwise exploited by plaintiff, or by others under plaintiff's authority or license, in conformity with the Copyright Act.

11. At no time has plaintiff authorized defendants, or either of them, to republish, perform, create derivative works based on or otherwise exploit all or any portion of "Song of Love."

12. In or about April 2007, defendants, and each of them, infringed plaintiff's copyright in "Song of Love" by, *inter alia*, publishing and widely releasing a musical composition entitled "Stolen Words," as a single and as one of the tracks embodied on a CD album entitled *Scenes from the Street*. "Stolen Words" was copied in part from plaintiff's copyrighted composition "Song of Love."

13. As a result of Defendants' infringing conduct Plaintiff has been damaged in an amount in excess of $150,000. When the full nature and extent of said damages have been ascertained Plaintiff will amend this complaint accordingly.

14. Plaintiff cannot ascertain and calculate his damages herein, as provided for by law, unless and until he is provided with an accounting by Defendant as to their infringing activities and all gains, profits and advantages which they have earned as a result of such activities. Accordingly, Plaintiff is entitled to such an accounting from Defendants.

15. Plaintiff will continue to suffer damages as a result of Defendants' infringing conduct unless Defendants are restrained and enjoined during the pendency of this action and permanently, from infringing Vocale's copyright, as alleged herein or in any other manner. Defendants should therefore be so enjoined and restrained by this Court; recordings, masters other infringing items used by Defendants should be ordered impounded during the pendency of this action.

16. By reason of Defendants' infringing activities, it has been necessary for Plaintiff to retain counsel, and in connection therewith Plaintiff has incurred and will continue to incur attorneys' fees. Plaintiff is therefore entitled to an award of attorneys' fees, pursuant to 17 U.S.C. § 505.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays for judgment as follows:

1. For Plaintiff's damages and defendants' profits in an amount to be ascertained or, in the alternative, statutory damages against defendants and each of them in the amount of $150,000 for each infringement;

2. For an accounting by Defendants as to all gains and profits earned through their exploitation of "Stolen Words";

3. For a preliminary injunction and permanent injunction, restraining and enjoining Defendants and each of their agents and representatives from displaying, distributing, publishing, performing or in any other manner infringing "Song of Love";

4. For Plaintiff's reasonable attorneys' fees and costs of suit;

5. For interest at the legal rate on each monetary award; and

6. For all proper relief.

Dated: _____

By: _____

_____

Attorneys for Plaintiff

JURY DEMAND

Plaintiff hereby demands a jury trial as provided by Rule 38(a) of the Federal Rules of Civil Procedure.

Dated: _____

By: _____

_____

Attorneys for Plaintiff

3. Complaint for Infringement of Copyright and Unfair Competition (More Detailed Allegations)

Professional Corporation
Attorneys for Plaintiffs

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Plaintiff Richard Vocale, professionally known as Big Richard, an individual, and Elite Music, Inc, a corporation,	)	Case No.
Plaintiffs,	)	COMPLAINT FOR INFRINGEMENT OF COPYRIGHT AND UNFAIR COMPETITION;[12] DEMAND FOR JURY TRIAL
v.	)	
Malcolm Goniff, professionally known as Big Mal, an individual, and Indie Publishing and Recording, Inc.,	)	
Defendants.	)	

Plaintiffs Richard Vocale and Elite Music, Inc. complain against Defendants and allege the following:

GENERAL ALLEGATIONS
(Applicable To All Claims)

The Parties

1. Plaintiff Richard Vocale, professionally known as "Big Richard," is an individual residing in Los Angeles, California. Vocale is a singer, entertainer and

12. In preparing the Complaint, counsel should determine whether the facts will support a claim for unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). A claim for violation of § 1125(a) is distinctly different from one for copyright infringement and

composer of popular musical works. Beginning in 1988 and continuing to the present day Richard Vocale has been and remains, according to the reviews of his concerts and recordings, one of the most talented and successful singer/composers appearing on the world stage. His concert tours and recordings have generated income on the average of $20,000,000 per year over the last three years, during which he has been presented with awards from Billboard and MTV and his recordings have gone gold and platinum as best selling singles and CD albums.

2. Plaintiff Elite Music, Inc. ("Elite") is a corporation organized and existing under and by virtue of the laws of the State of Delaware and maintains its principal place of business in the Central District of California and is in the business of publishing, recording and selling sheet music and recordings of popular music to the public. Elite is among the most successful and prestigious music publishers and record labels in the music business, having been responsible for many number-one selling recordings and the making of performers who became world renowned stars in the world of hip-hop and pop music.

3. Defendant Malcolm Goniff (aka "Big Mal") is an individual who, on information and belief, resides in Los Angeles and, at all relevant times herein, was doing business throughout the State of California. Defendant is a singer and composer of popular musical works and, on information and belief, is the composer of a popular musical work entitled "Stolen Words."

4. At all times relevant herein, defendant Indie Publishing and Recording, Inc. was, and still is, a California corporation with its principal place of business in Los Angeles, California and is in the business of publishing, recording and selling sheet music and recordings of popular music to the public.

Jurisdiction and Venue

5. This action arises under the copyright laws of the United States (Title 17, United States Code), and the Lanham Act (Title 15, United States Code). Subject matter jurisdiction is conferred upon this Court by 28 U.S.C. §§ 1338(a) & 1338(b), and 15 U.S.C. § 1121. Venue lies in this District pursuant to 28 U.S.C. § 1400(a), 28 U.S.C. §§ 1391(b)(2) & (3), and 28 U.S.C. § 1391(c).

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should be carefully analyzed to make certain that such a claim is appropriate. In the Second Claim (below), the relief sought is based upon passing off and the likelihood of confusing the public as to the source of the recorded perf ormances. In other words, that the public would be induced to buy the defendants' recorded performances under the belief that they were purchasing those in which the plaintiffs were in some way involved.

Ownership of the Copyright

6. On or about _____ Vocale created and wrote a musical work, including music and lyrics, entitled "Song of Love" (hereinafter designated as "Song of Love").

7. "Song of Love" is comprised of copyrightable subject matter under the laws of the United States, and plaintiff has at all times and in all respects complied with all of the laws of the United States governing copyrights, including the statutory registration and deposit requirements. Plaintiff has thereby secured the exclusive rights and privileges in and to the copyright of "Song of Love," and has received a certificate of registration from the Register of Copyrights, dated and identified as follows: (DATE), Class l, No. _____. _____ is and at all times has been the sole and exclusive proprietor of all right, title and interest in and to said copyright.

8. Plaintiffs have expended millions of dollars in the promotion of "Song of Love" which has been performed throughout the United States, and in many countries throughout the world has received widespread popular and critical acclaim.

9. On or about _____ Plaintiff Vocale as featured soloist recorded "Song of Love" with an orchestra of first-rate studio musicians for Elite, which spent over five million dollars in recording, promoting and distributing the singles and CD album containing the "Song of Love" together with ten other works composed by Vocale.

FIRST CLAIM

(For Copyright Infringement
17 U.S.C. § 501)
(Against All Defendants)

10. During the past three years, Defendants have infringed Plaintiff Vocale's copyright in and to "Song of Love" by copying protected expression from "Song of Love" and incorporating as Defendants' composition entitled "Stolen Words" and thereafter performing, recording and distributing a single of "Stolen Words" and CD album using "Stolen Words" as the first or lead cut on the album.

11. As a result of Defendants' infringing conduct, Plaintiffs have lost and continue to be deprived of business opportunities and profits relating to "Song of Love" and will continue to suffer harm so long as Defendants continue to infringe Plaintiffs' copyright. Plaintiffs are therefore entitled to an award of

damages in excess of $250,000 to compensate them for those losses. Plaintiffs are further entitled to an award of profits made by Defendants resulting from their infringing conduct, by which they have been unjustly enriched. Plaintiffs do not now know the full nature or extent of the damages which they have suffered and will suffer in the future, and will, upon ascertaining the same, seek leave of the Court to amend this Complaint to fully allege such damages.

12. Plaintiffs cannot ascertain and calculate their damages herein, as provided for by law, unless and until they are provided with an accounting by Defendants as to their infringing activities and all gains, profits and advantages which they have earned in connection therewith. Accordingly, Plaintiffs are entitled to such an accounting from Defendants.

13. Plaintiffs will continue to suffer damages as a result of Defendants' infringing conduct unless Defendants are restrained and enjoined, during the pendency of this action and permanently, from infringing Vocale's copyright, as alleged herein or in any other manner. Defendants should therefore be so enjoined and restrained by this Court; recordings, masters and other infringing items used by Defendants should be ordered impounded during the pendency of this action.

14. In order to commence and maintain this litigation, it has been necessary for Plaintiffs to retain counsel, and in connection therewith, Plaintiffs have incurred and will continue to incur attorneys' fees. Plaintiffs are therefore entitled to an award of attorneys' fees pursuant to 17 U.S.C. §505.

SECOND CLAIM

(For Unfair Competition
15 U.S.C. § 1125)
(Against All Defendants)

15. Plaintiff incorporates by reference and realleges and repleads Paragraphs 1 through and including 10 of this Complaint with the same force and effect as though herein fully set forth.

16. Due to the widespread success and popularity of "Song of Love," Plaintiff Vocale's concert performances of "Song of Love," the Plaintiffs' recording and distribution of the single and CD album and promotion, and advertising and merchandising activities throughout the United States and other territories, "Song of Love" has become closely and widely associated with Plaintiffs Vocale and Elite.

17. Defendants engaged in the aforementioned conduct deliberately and wilfully, and for the purpose of creating confusion, deception and mistake in the

minds of the consuming public, and causing members of the consuming public to believe that "Song of Love" and the recording of it offered by Defendants originated with or were endorsed by Plaintiffs, or that, by copying and recording "Song of Love," Defendants were authorized by Plaintiffs to engage in said conduct. Said representations and conduct have, in fact, caused a likelihood of such confusion, deception and mistake on the part of said businesses and the public.

18. As a direct and proximate result of the conduct of Defendants, Plaintiffs have lost business opportunities and profits, suffered a loss of goodwill and been harmed by Defendants' acts and conduct. Plaintiffs are therefore entitled to an award of damages to compensate for those losses. Plaintiffs are also entitled to an award of damages equal to the profits made by Defendants by virtue of their conduct, and by which they have been unjustly enriched. Further, the circumstances of this case justify an award of treble damages. Plaintiffs do not now know the exact nature or extent of said damages and will seek leave of the Court to amend this Complaint to more fully allege its damages upon ascertainment thereof.

19. The total amount of damages to which Plaintiffs are entitled cannot be ascertained without an accounting from Defendants regarding their profits. Plaintiffs are therefore entitled to an order directing Defendants to provide such an accounting.

20. Defendants threaten, unless restrained by the Court, to continue to engage in the conduct described herein, causing Plaintiffs further serious harm and irreparable damage. The Court should therefore restrain and enjoin Defendants, during the pendency of this action and permanently, from making any or engaging in any conduct which causes confusion or deception as to the origin of Plaintiffs' Song and recording thereof or Plaintiffs' alleged association with Defendants.

WHEREFORE, Plaintiffs pray for judgment as follows:
Upon The First Claim:

1. For an award of compensatory damages, according to proof;

2. For an award of all gains and profits earned by Defendants through their exploitation of "Stolen Words";

3. For an accounting by Defendants as to all gains and profits earned through their exploitation of "Stolen Words";

4. For a preliminary injunction and permanent injunction, each restraining and enjoining Defendants and each of their agents and representatives from displaying, distributing, publishing, performing or in any other manner infringing "Song of Love";

5. For an award of attorneys' fees incurred by Plaintiffs in connection with this action;

6. For an order that all infringing items be impounded during the pendency of this action.

Upon The Second Claim:

7. For an award of a sum equal to three times the amount of actual damages, according to proof at trial;

8. For an accounting by Defendants as to all gains and profits earned by reason of their acts of unfair competition;

9. For an award equal to three times all gains and profits earned by Defendants as a result of their acts of unfair competition;

10. For a preliminary injunction and a permanent injunction, each restraining and enjoining Defendants and each of their agents and representatives from using in any manner any and all elements of "Song of Love," or otherwise engaging in any acts of unfair competition as against Plaintiffs;

11. For an award of attorneys' fees incurred by Plaintiffs in connection with this action.

Upon All Claims:

12. For costs of suit incurred herein;

13. For interest at the legal rate on each monetary award; and

14. For all proper relief.

Dated: _____

_____
_____
_____
_____

By: _____
_____
Attorneys for Plaintiff

JURY DEMAND

Plaintiffs hereby demand a jury trial as provided by Rule 38(a) of the Federal Rules of Civil Procedure.

Dated: _____

By: _____
_____
Attorneys for Plaintiffs

C. Preparation of the Answer

Professional Corporation
Attorneys for Plaintiffs

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Plaintiff Richard Vocale, professionally known as Big Richard, an individual, and Elite Music, Inc, a corporation,	) Case No. 95-1293 ER (Jgx)
Plaintiffs,	) ANSWER OF DEFENDANTS MALCOLM GONIFF AND INDIE PUBLISHING AND RECORDING, INC. TO COMPLAINT FOR COPYRIGHT INFRINGEMENT AND UNFAIR COMPETITION; DEMAND FOR JURY TRIAL
v.	
Malcolm Goniff, professionally known as Big Mal, an individual, and Indie Publishing and Recording, Inc.,	
Defendants.	

Defendants Malcom Goniff, and Indie Publishing and Recording, Inc., (collectively, "Defendants") answer Plaintiffs' Complaint ("Complaint") as follows:

ANSWER TO GENERAL ALLEGATIONS

1. Answering Paragraph 1, Defendants are without knowledge or information sufficient to form a belief as to the truth of the averments therein contained.

2. Answering Paragraph 2, Defendants are without knowledge or information sufficient to form a belief as to the truth of the averments therein contained.

3. Answering Paragraph 3, Defendants admit the averments therein contained.

4. Answering Paragraph 4, Defendants admit the averments therein contained.

5. Answering Paragraph 5, Defendants admit that this action purports to arise under the copyright laws of the United States and under the Lanham Act, 15 U.S.C. Section 1125(a), and that this Court has jurisdiction of the Claims for Relief pursuant to 28 U.S.C. §§ 1331 & 1338 and 15 U.S.C. § 1131. Defendants further admit that venue lies in this district.

6. Answering Paragraph 6, Defendants are without knowledge or information sufficient to form a belief as to the truth of the averments therein contained.

7. Answering Paragraph 7, Defendants deny the averments that "Song of Love" is comprised of copyrightable subject matter. Further Answering paragraph 7, Defendants are without knowledge or information sufficient to form a belief as to the truth of the remaining averments therein contained.

ANSWER TO FIRST CLAIM

(For Copyright Infringement)

[Further Admissions and Denials]

ANSWER TO SECOND CLAIM

(Unfair Competition and Violation of
the Lanham Act, 15 U.S.C. §1125(a))

[Further Admissions and Denials]

ANSWER TO THIRD CLAIM

(For State Unfair Competition
California Business and Professions Code § 17200)

[Further Admissions and Denials]

AFFIRMATIVE DEFENSES
FIRST DEFENSE

21. Each of the alleged Claims for Relief in the Complaint fails to state a claim upon which relief can be granted.

SECOND DEFENSE

22. None of the material in "Song of Love" alleged to have been copied is original.

THIRD DEFENSE

23. None of the material in "Song of Love" alleged to have been copied constitutes copyrightable material protected by the Copyright Laws of the United States.

FOURTH DEFENSE

24. If any use was made of any material alleged to have been copied by the Defendants, which they deny, such use constitutes fair use.

FIFTH DEFENSE

25. The relief sought by plaintiffs is barred by the First Amendment of the Constitution of the United States.

SIXTH DEFENSE

26. The relief sought by Plaintiffs is barred by laches.

SEVENTH DEFENSE

27. Plaintiffs are estopped from asserting the purported Claims for Relief set forth in the Complaint.

EIGHTH DEFENSE

28. Plaintiffs, in making the averments set forth in the Complaint, have filed unmeritorious and sham claims and, by reason thereof, Plaintiffs are guilty of unclean hands and abuse of copyright and are barred from the relief they seek herein.

NINTH DEFENSE

29. All or a part of the purported Claims for Relief are barred by 17 U.S.C. § 507 and all other applicable statutes of limitations.

TENTH DEFENSE

30. Plaintiffs lack standing to sue on the Claims for Relief set forth in the Complaint.

ELEVENTH DEFENSE

31. The Court lacks jurisdiction over the subject matter of the alleged claims set forth in the Second Claim for Relief.

WHEREFORE, Defendants pray for judgment as follows:

1. That Plaintiffs take nothing and be afforded no relief by way of their Complaint;

2. That Defendants recover their costs and expenses incurred herein;

3. That Defendants recover their attorneys' fees pursuant to 17 U.S.C. § 505, and all other applicable provisions of law; and

4. For all proper relief.

Dated: _____

By: _____
Attorneys for Defendants
_____, _____, and
_____

DEMAND FOR JURY TRIAL

Defendants Malcolm Goniff and Indie Publishing and Recording, Inc. hereby demand a trial by jury on all claims and issues upon which trial by jury is permitted.

Dated: _____

By: _____
Attorneys for Defendants
_____, _____, and
_____,

VI. The Litigation Plan

A. The Need for a Litigation Plan

As the description of activities and responsibilities listed above establishes, great care and thought is required of lawyers guiding their clients through the considerations to determine whether to commence litigation. Once the plaintiff has crossed that particular rubicon, counsel for both parties must, with care and foresight, implement their respective litigation plans outlining the actions necessary for preparation of pleadings, discovery, motions, and trial. The litigation plan should be thought of as an organic document, in the sense that, like a living organism, it will grow and change as circumstances dictate. The following outline is a suggested form for that document. In particular, please note the following: (1) on the last page, the last date the Litigation Plan has been updated must be set forth; and (2) in Section V, the theme or themes for the case are to be detailed. The latter is especially important when trying a case before a jury. Is the plaintiff a heroic David whose creative work was cynically copied by a corporate Goliath? Is the plaintiff a bitter and unsuccessful composer who is targeting a talented and successful film composer for an undeserved payoff? These are but two of the many themes which provide additional structure to the overall objective of both plaintiff's and defendant's planning.

The outline below is not written in stone, but is merely a suggested form which can be revised, supplemented, etc. to meet the needs of each case.

B. The Litigation Plan: A Suggested Format

The following document is a sample litigation plan:

LITIGATION PLAN

I. Parties (Identify the parties and their relationships and any additional parties that should be joined.)

II. Witnesses (Names, Addresses, and Telephone Numbers and E-Mail addresses)

III. Claims and Defenses (Describe the principal claims and defenses.)
A. Plaintiffs' Claims.
1. (*E.g.*, Copyright Infringement.)

2. (*E.g.*, Unfair Competition.)

3. (*E.g.*, Declaratory Relief.)

4. Remaining Claims (if any).

B. Defendants' Answer and Defenses.

C. Plaintiffs' Contentions re Defenses.

IV. Remedies (Describe the remedies including any provisional remedies.)

V. Theme (Describe the themes of your case [Plaintiffs' or Defendants'].)
A. Plaintiffs' themes:

B. Defendants' Themes:

VI. Discovery (Describe anticipated discovery and its objectives.)
A. Interrogatories, requests for admissions and requests for production of documents.

B. Depositions
   1. Depositions taken or to be taken by Plaintiffs:

   2. Depositions taken or to be taken by Defendants:

VII. Motions (Describe anticipated motions and their objectives.)
   A. Motions for summary judgment:
      1. Plaintiffs

      2. Defendants

   B. Trial motions and *Motions in Limine*

   C. Other Motions

VIII. Experts (Describe areas requiring expert testimony and the types of experts required.)

IX. Trial Game Plan (Describe the game plan for trying the case and identify the focus or "bullseye" of our [Plaintiffs' or Defendants'] trial strategy.)

VII. Final Thoughts

Although it may be self-evident, lawyers can never remind themselves often enough that preparation must start early and remain a continuing process throughout the representation of a client. Thus, in copyright infringement litigation, it is not premature to start exploring the grounds for moving for or potentially opposing a summary judgment, or to begin envisioning how the trial will proceed, at the earliest stages of representation. Most benefits are obvious. There is, however, one partially hidden benefit: When parties are fully knowledgeable regarding the strengths and weaknesses of those cases, settlements are more likely to occur.

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CHAPTER
5

The Importance of the Expert

The Musicological Expert

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In support of the plaintiffs' case, the affidavit of Mr. Rodwell, an experienced musician, was read. With reference to the 57th set of quadrilles published by the defendant, he deposed that the second quadrille was so completely similar to an air of the opera called "Gentille Muscovite," that it was nearly note for note the same, even to the accompaniments; that the melody of the fourth quadrille was like another air of the opera, with some variations in certain bars, which he specified; and that the melody of the fifth quadrille was contained in certain bars of the overture, which he specified. . . . He made similar statements with respect to the other quadrilles and the waltzes; observing, however, that in one of the waltzes there were sixteen bars which were not in the original air. He concluded his affidavit by saying, that although in several instances the music of the quadrilles in question was slightly varied from the airs of the opera, yet such variation was not more than is always found to be necessary when the music of an opera is arranged in the form of quadrilles.

—D'Almaine v. Boosey[1]

If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise.

—Rule 702, Federal Rules of Evidence[2]

I. Infringement of Musical Works: The Importance of Expert Opinion and Guidance

The forensic musicologist, in the person of a Mr. Rodwell, made his first appearance in England in 1835. The case was *D'Almaine v. Boosey*. In that case, Boosey, the publisher, was accused of copying sections of an opera, *Lestocq*, composed by Denis Ferdinand Esprit Auber, by publishing a set of quadrilles and waltzes arranged by Philippe Musard, a French composer and conductor, who also made dance arrangements from the works of other composers, including Beethoven. The Court of Chancery issued an injunction in favor of plaintiff D'Almaine, Auber's publisher, and ordered an accounting of proceeds from the sale of printed arrangements of the pirated music.[3]

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1. 1 Y. & C. Ex. 288, 289, 160 Eng. Rep. 117, 118 (1835).
2. Fed. R. Evid. 702.
3. It is also interesting to note that an English court in 1835 articulated many of the concepts that are now familiar in the modern era: substantial similarity ("[i]t must depend on whether the

Today, if Mr. Rodwell were to revisit the courts of England, the United States, and other nations, he would be confounded that his participation in *D'Almaine* had launched a profession called "forensic musicology." In the context of disputes that reach the courts, music, together with other disciplines requiring specialized knowledge beyond the experience of the average lay juror, experts having such knowledge are necessary—and perhaps mandatory[4]—participants as consultants and ultimately as witnesses in those cases that proceed to trial. Above all, the expert—whether musician or musicologist, composer or publisher—must be a teacher of and guide through the language, ideas, and commonplace building blocks of music available to composers for the creation of musical works. In music infringement litigation, it is the expert who is charged with the responsibility of assisting others, including lawyers, plaintiffs, and defendants, in evaluating and providing analyses upon which (1) a viable claim for copyright infringement may be based, or (2) that supportable defenses may be asserted on behalf of those accused of copying protectable expression from a copyrighted work. He or she is also the conduit through which knowledge and opinion are channeled to the court and the jury.

A. The Dilemma of Explanation

When one musical creator asserts that another has unlawfully copied the former's work, a two-pronged dilemma is presented to parties and their lawyers regarding the preparation of the case and its potential presentation to a judge and jury: How do we explain and thereby impart knowledge to the trier of fact of (1) the nature of musical ideas, language and expression, and (2) principles of the copyright law, with particular reference to the idea/expression dichotomy, as it applies to musical works? Stated another way: How do we simplify these two complex disciplines—musical analysis of the at-issue works and the application of copyright law to those works—so that the trier of fact can reach an informed and correct result? It is, of course, the

air taken is substantially the same with the original," 1 Y. & C. Ex. at 302, 160 Eng. Rep. at 123); and the audience test ("[n]ow the most unlettered in music can distinguish one song from another, and the mere adaptation of the air, either by changing it to a dance or by transferring it from one instrument to another, does not, even to common apprehensions, alter the original subject. *The ear tells you that it is the same*," *id*. (emphasis added)). As the Bible tells us in *Ecclesiastes*, "there is nothing new under the sun." *Ecclesiastes* 1:9 (The New Oxford Annotated Bible with the Apocrypha 805 (Herbert G. May & Bruce M. Metzger eds., 1977)).

4. Testa v. Janssen, 492 F. Supp. 198, 203 (W.D. Pa. 1980) ("[e]xpert testimony is not required to establish 'substantial similarity.' However, when a plaintiff seeks to dispense with direct proof of access and attempts to establish that two works are 'strikingly similar,' such testimony is required").

music expert who sheds light on the former, while it is the responsibility of the lawyer to provide scholarship and advocacy with respect to the latter. On the surface, the answer is straightforward: The plaintiff's expert testifies to the similarities between the contending works and, through the presentation of evidence in the form of visual and aural exhibits, demonstrates the similarities upon which that opinion is based. The defendant's expert explains in language understandable to lay jurors that both works are based upon or use the musical elements available to all composers and contain the same materials found in prior works. The expert also presents exhibits in the form of visual and aural materials to demonstrate the dissimilarities between the two works. Though simple in concept, the testimony of experts and the creation and presentation of such exhibits is manifold, depending upon the ability, dedication, and creativity of the musicological expert, the lawyer, and the artist or technician retained to advise and implement the needs of the expert and lawyer. The selection of the expert is without question a decision that must be made with the utmost care.

B. Functions and Tasks of the Musical Expert

The expert consultant and witness must provide the party and lawyer with the following advice and support:

> (1) Analysis and transcription from the sound sources of the works at issue; (2) Research and designation of prior art examples; (3) Rendering of a report or reports setting forth the expert's conclusions regarding substantial similarity or dissimilarity of protectable expression and providing examples of prior art, not only the names of the prior compositions but also comparative music notation of the works at issue showing the similarities or dissimilarities as to pitches, pitch duration, (e.g. eighth-note, quarter-note, half-note, etc.) melody, rhythm, and harmony; (4) numbering pitches (notes) so that individuals without musical training can understand the relationship between them; (5) providing opinion testimony via deposition; and (6) appearing in court as a witness fully prepared and in a position to provide the trier of fact with the expert's opinions grounded in sustainable and convincing bases for those opinions.

1. The *Daubert/Kumho Tire/Joiner* Trilogy and the "Gatekeeper" Function

Though experts have always been a necessary component in music infringement litigation, their use and usefulness—along with those of other disciplines—have been highlighted, among other things by (1) the expanded role of experts and their use in litigation generally; and (2) the United States Supreme Court's focus, in three important opinions, on the standards for admissibility of expert

testimony: *Daubert v. Merrill Dow Pharmaceuticals, Inc.*,[5] *General Electric Company v. Joiner*,[6] *Kumho Tire Company, Ltd. v. Carmichael*.[7]

In *Daubert*, which was concerned with scientific testimony, the Court enunciated standards based upon construction of Federal Rules of Evidence 702 and 104, the latter of which provides that preliminary questions concerning the qualifications of the person to be a witness "shall be determined by the court, subject to [considerations regarding the relevancy of the evidence at issue]."[8] The ultimate issue to be resolved under the *Daubert* decision is that "an expert's testimony must pertain to . . . [knowledge dealing with the subject matter of the litigation] . . . to establis[h] a standard of evidentiary reliability"[9] because "'[e]xpert testimony which does not relate to any issue in the case is not relevant and, ergo, non-helpful.'"[10] In order to determine whether the expert's testimony is admissible, the Court in *Daubert* suggests using four factors, among others: (1) testing of the knowledge presented; (2) peer review and publication of proffered information; (3) the rate of error relevant to the methodology used by the expert; and (4) the degree of acceptance of the proposed testimony in the relevant community.[11] It should be noted that, in *Daubert*, the Supreme Court pointedly avoided declaring these four as the only factors for evaluating reliability of expert opinion.

As the Court later emphasized in *Kumho Tire:* "We do not believe that Rule 702 creates a schematism that segregates expertise by type while mapping certain kinds of questions to certain kinds of experts. Life and the legal cases that it generates are too complex to warrant so definitive a match."[12] In *Joiner*, the Supreme Court, in effect, chided the Court of Appeals that it could not second-guess the rulings of the trial court in the latter's role as the "gatekeeper" for the admissibility of expert testimony.[13] The last case in this trilogy, *Kumho Tire*, laid down the rule that the holding in *Daubert*—outlining the gatekeeper function and the criteria to be utilized by the trial judge—were not confined to scientific issues, but apply in equal measure to expert testimony in other disciplines as well.[14]

Because of the "gatekeeper" function of the trial court and the application of a stringent abuse of discretion standard in reviewing the trial court's rulings

5. 509 U.S. 579, 113 S. Ct 2786, 125 L. Ed. 2d 469 (1993).
6. 522 U.S. 136, 118 S. Ct. 512, 139 L. Ed. 2d 508 (1997).
7. 526 U.S. 137, 119 S. Ct. 1167, 143 L. Ed. 2d 238 (1999).
8. Fed. R. Evid. 104 (a); *see also* Fed. R. Evid. 702 (regarding testimony by experts); Fed. R. Evid. 104(b) (regarding relevancy of evidence conditional on fact).
9. 509 U.S. at 590, 113 S. Ct. at 2795.
10. *Id.* (citations omitted).
11. *See* id. at 593–95, 113 S. Ct. at 2796–97.
12. 526 U.S. at 151, 119 S. Ct. at 1176.
13. *See* 522 U.S. at 143, 146–47, 118 S. Ct. at 517–18, 519.
14. *See* 526 U.S. at 141, 119 S. Ct. at 1171.

on the admissibility of expert opinion, it is vitally important to select experts whose opinions will meet the requirements of relevance and reliability enunciated by the court in *Daubert*.

As the Federal Rules of Evidence make clear, expert testimony should be offered for the purposes of providing information and expert opinions based upon the expert's specialized knowledge of the subject matter at issue and providing guidance for the trier-of-fact in reaching findings supported by "substantial evidence" based upon the law applicable to those facts. This is true whether the issue concerns the causes of physical disabilities in infants whose mothers ingested a prescription drug (*Daubert*); the causes contributing to a blow-out of a tire (*Kumho*); or whether the creator of musical work has infringed that of another by copying protectable expression from the latter's copyrighted creation. (e.g., *Selle v. Gibb* and *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corporation*).[15]

2. Initial Considerations Before Retaining An Expert

For both plaintiffs and defendants, the first question is what steps should be taken when presented with a potential claim for infringement in the case of either an individual who believes his/her work has been infringed, or one who has been the recipient of a demand letter or the service of a summons and complaint. From the prospective plaintiff's point of view, the ultimate issue is whether the alleged infringing musical work unlawfully appropriates portions of his/her work by copying protectable expression from the allegedly infringed work. In considering this issue, the prospective plaintiff should also determine whether the other creator had access to the allegedly infringed work and, if so, whether the similarities, substantial or not, involve unprotectable material or protectable expression. The defendants or prospective defendants must confront the same issues. The accused party will point to universally recognized unprotectables, such as musical ideas, musical elements in the public domain, *scènes à faire*, and other standard building blocks of music in his defense against a claim of infringement.

This question of how to proceed is answered by promptly consulting a music expert, preferably one with either a credential in musicology from a recognized university, conservatory, or music school or someone whose experience qualifies her or him as an expert, not necessarily by education but by the knowledge one absorbs through actually pursuing a career in music where that person is exposed to musical genres relevant to the matter at issue. The ultimate test is whether that individual can be charged with the responsibility of assisting others, including lawyers and parties, in evaluating and ultimately, if warranted, providing analyses (1) upon which a viable action for copyright

15. *See infra* notes 25–28 & 38–41 and accompanying text.

infringement may be based, or (2) upon which valid and supportable defenses can be asserted on behalf of those accused of copying protectable expression from a copyrighted work.

II. Music Infringement, The Courts and the Search for Answers

A. *Arnstein v. Porter* and Progeny

Even though aberrations can occur in appellate courts in copyright cases that do not involve music, in music infringement litigation, courts have struggled not only with subject matter but also with the use of experts and the specific issues to which their expertise and testimony should be directed. Perhaps the best start in the search for the right expert or experts involves the following issues: (1) who is the best person to provide an analysis of the similarities between works for the purpose of establishing through such similarities that the defendant had access to the plaintiff's work; (2) who has the education, ability, and personality to educate the trier of fact, by way of examples of prior art, which elements in musical language are unprotectable (e.g., musical ideas, *scènes à faire*, and other commonplace musical devices available to all composers); and (3) who, after due considerations, is best qualified to explain (a) that the passages of plaintiff's work at issue are commonplace building blocks, ideas, *scènes à faire*, etc. (for defendant's expert) or (b) that the passages of plaintiff's work are original, protectable expression (for plaintiff's expert)? Though these should be straightforward inquiries, the courts have, in precedent-setting cases, and always with good intentions, added confusion and chaos to the process of separating original expression from ideas and other unprotectable elements used in the creation of musical works.

Unfortunately, there are strains of recidivism among the courts in copyright cases—both in music and other creative fields—resulting in appellate authorities which reinstate flawed approaches to both musicological analysis and the copyright law itself. A brief review of five cases decided during the period 1946–2005 will show where the law has been and where it has temporarily arrived. These cases, which are from three different regions of the United States, provide dramatic examples of the critical role played by experts in copyright infringement actions and the struggle by the federal appellate courts to define that role. All of these opinions demonstrate the difficulties experienced by the courts to make some sense of the areas in which experts may or may not venture opinions. Unfortunately—especially in music infringement litigation—the search for a workable approach has often eluded the federal appellate courts. The failure of the courts to articulate workable standards for the role of musical experts has left a legacy of confusion and uncertainty, in no small part

attributable to the opinions in *Arnstein v. Porter*[16] and *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corporation.*[17] Recent developments, however, have provided an opportunity to minimize the uncertainty and its unfortunate byproducts: confused juries, the potential for unexpected and surprising results, and the attendant cost to the parties, both financial and emotional. Before analyzing the current role of experts and the areas of inquiry in which they may provide opinion testimony, it is appropriate to review history, which must begin with a discussion of the missteps of the courts in *Arnstein* and *Krofft*.

Though not the first case to contend with these issues, *Arnstein v. Porter*,[18] even though it has been distinguished, ignored and disapproved, still rises like a phoenix from the ashes to muddy the waters as a progenitor of flawed thinking. The defendant in *Arnstein* was Cole Porter, the celebrated composer/lyricist of classic American popular songs and Broadway musicals. Ira Arnstein, the plaintiff, was a moderately successful composer of pop songs and, within the federal judicial arena, a professional litigant who had filed a series of cases. He alleged that Porter had unlawfully appropriated one of his musical creations. In its opinion, the *Arnstein* Court held that summary judgment is a disfavored remedy in music infringement actions, basing its reasoning on the premise that the determination of unlawful appropriation from a musical work must depend on the reactions of the ordinary lay person (apparently the equivalent of the "reasonable person" in vastly different types of litigation).[19] This view of the "lay hearer" impacted the role of experts: Upon what issue would experts be permitted to provide opinion testimony and in which areas would such testimony be excluded? Before articulating the areas of inquiry in which an expert may testify, the *Arnstein* Court set forth three elements a plaintiff must establish to prove copyright infringement:

1. he or she owns a valid copyright;
2. the defendant copied from the plaintiff's work; and
3. defendant's copying constituted unlawful appropriation. [20]

With respect to the first issue, expert testimony is virtually never offered. It is within the latter two elements that the courts have attempted to allocate the areas of inquiry upon which experts would be permitted to provide musical analysis and those in which they would be foreclosed.

Deference to the average "lay hearer" (the juror) led the court in *Arnstein* to the following analysis of the role of the music expert regarding the issues of

16. 154 F.2d 464 (2d Cir. 1946).
17. 562 F.2d 1157 (9th Cir. 1977).
18. 154 F.2d 464.
19. *See* 154 F.2d at 473.
20. *See id*. at 468.

access, copying, and unlawful appropriation of protected expression. The court first distinguished between (a) copying (leaving aside for the moment the issue of whether what was copied is protectable by copyright) and (b) improper appropriation from a musical work (i.e. infringement). In dealing with the former, the *Arnstein* Court held that: (1) Copying may be proved by direct evidence (e.g., defendant's admission) or by direct or circumstantial evidence of access (e.g., wide dissemination of a composition through airplay and other means), combined with sufficient similarities between the works at issue; or (2) If there is no direct or circumstantial proof of access, a plaintiff may still prove access and copying by demonstrating that the works are "so striking as to preclude the possibility that the plaintiff and defendant independently arrived at the same result." [21]

On the issue of copying (regardless of whether it involves protectable expression), dissection and analysis by an expert witness is permitted. Once copying is established, however, the issue of illicit copying (unlawful appropriation) may be determined only by "the response of the ordinary lay hearer."[22] On this issue, dissection and analysis by the music expert is inadmissible. The court, however, incongruously stated that expert witnesses would be permitted "to assist in determining the reactions of lay auditors"[23] (the "audience test"), leaving the impression that jurors in any specific case do not decide whether there was illicit copying based upon their *own responses* (that is, that they are in effect the "lay hearer"), but rather on how the lay hearer (apparently a member of the hypothetical lay audience) would be likely to respond when hearing the accusing and accused works played in court. In other words, the expert, as envisioned by the *Arnstein* panel, would not be permitted to opine on the issue of illicit copying, but would be welcome to render an expert opinion on the reactions of the hypothetical (and perhaps mythical) lay hearer. These "tests," as articulated by the majority of the *Arnstein* court, have often been criticized. In his dissent, Judge Charles H. Clark, in an *ad hominum* and biting critique of the majority (although he refers to his colleagues as "my brothers"), questioned the wisdom of the two-step analysis of the issues of copying (of some musical device, whether protectable or not) and improper appropriation (or actionable copying, i.e., infringement of protectable musical expression). He stated that he could not apprehend why the former "'may be approached with musical intelligence and assistance of experts, and another that of illicit copying must be approached with complete ignorance.'"[24]

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21. *Id.* at 468.
22. *Id.*
23. *Id.* at 473.
24. *Id.* at 476 n.1 (Clark, J., dissenting) (citation omitted).

B. The Survival and Modification of the Two-Step Analysis

The two-step analysis has survived, however. Its application should not, however, be so rigidly doctrinaire as to foreclose testimony for use in determining whether the materials for which plaintiff seeks copyright protection are in fact protectable. *Krofft* is a leading example of a misconstruction of the *Arnstein* opinion as it relates to the delimitation of expert dissection and analysis. In *Krofft*,[25] (since refined and modified through a series of appellate decisions), which Professor Paul Goldstein has labeled a "consequential misstep,"[26] the Ninth Circuit mandated the application of a two-step analysis to decide the issue of substantial similarity. First, there must be substantial similarity as to the work's general ideas (the "extrinsic test"). Second, there must be substantial similarity as to the protectable expression (the "intrinsic" or "audience" test).[27] In *Krofft*, the Ninth Circuit extended *Arnstein's* preclusion of expert testimony by permitting analytic dissection by experts only for the purpose of determining copying; once copying is established, *Krofft* held that such expert testimony could not be considered by the trier of fact in determining whether the "lay ear" would conclude that there was illicit copying (or improper appropriation), since the issue of copying expression was placed exclusively in the hands (or ears) of the jury to determine the reactions of the reasonable person (in effect the "audience") to find actionable copying or the absence thereof.[28] Although this extension precluded the illogical use of expert testimony to

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25. 562 F.2d 1157 (9th Cir. 1977).

26. Paul Goldstein, Goldstein On Copyright § 9.3.2, at 39 (3d ed. 2007). The context in which Professor Goldstein used this apt description focused on both the use of the terms "extrinsic" and "intrinsic" and the functions the court assigned to each as follows:

> In developing this new taxonomy, *Krofft* made a consequential misstep by framing the inquiry under the extrinsic test as whether there is "substantial similarity of ideas" between plaintiff's and defendant's works. The error is that, while similarity in ideas—similarity in title, plot and setting, for example—may help to prove *copying*, it cannot prove that the defendant appropriated plaintiff's *protected expression*. Ideas embodied in copyrighted works are free for the taking. Even if the defendant copied ideas from the plaintiff's work, it cannot be liable for improper appropriation if it only took ideas, and not protected expression. [¶] This misstep in elaborating the extrinsic test led *Krofft* to mischaracterize the intrinsic, audience test as well, phrasing the test as whether the defendant's work captured the "total concept and feel" of the plaintiff's work. Traditionally conceived, the audience test never asks whether the works' audience will find substantial similarity in the two works overall—similarity in both their ideas and their expressions—but only whether the audience will detect substantial similarities in the works' expression. But, because *Krofft* nominally eliminated appropriation of protected expression as the gravamen of the extrinsic test, the court understandably excluded this measure from its formulation of the intrinsic test as well.

   Id. § 9.3.2, at 39–40 (emphasis in original).

27. *See* 562 F.2d at 1164.

28. *See id*.

opine on the reactions of a lay hearer in determining whether the contending works were substantially similar in protectable expression, where knowledge and guidance are most needed in separating protectable expression from unprotectable materials, the individual most qualified to provide such guidance is muzzled.

1. The Intrinsic Test and the Expanded Role of Expert Opinion

Over the years since *Krofft* was decided, the line between the extrinsic and intrinsic tests has eroded so that analytic dissection is now applied—as it should be—to the "intrinsic" or "audience" test. Thus, the court in *Litchfield v. Spielberg*[29] held that the extrinsic test requires more than an analysis of vague and abstract ideas, and the expert must analyze objective details and concrete elements, such as comparisons of plot, theme, dialogue, mood, setting, pace, and sequence, as embodied in the works at issue.[30] Building on *Litchfield*, in the *Berkic*,[31] *Aliotti*,[32] and *Olson*[33] cases, the Ninth Circuit modified the intrinsic test to permit analytic dissection by experts who may consider both protected and unprotectable material to determine substantial similarity of expression provided that "no substantial similarity *may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas*."[34]

In *Baxter v. MCA, Inc.*[35] the Ninth Circuit reversed the summary judgment that had been granted in favor of the defendants. In so doing, the Ninth Circuit announced a "no bright-line rule" between those elements of a plaintiff's composition which were commonplace building blocks of music, and therefore unprotectable, and those which were entitled to copyright protection.[36] In other words, the jury would be placed in the position under the *Krofft* test of sitting as the lay listener to determine (apparently without the guidance of any expert opinion) the ultimate issue of illicit copying.[37] One of the reasons the Ninth Circuit reached this result was because the judges, governed by a

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29. 736 F.2d 1352 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052, 105 S. Ct. 1753, 84 L. Ed. 2d 817 (1985).
30. *See id*. at 1356–57.
31. Berkic v. Crichton, 761 F.2d 1289 (9th Cir.), *cert. denied*, 474 U.S. 826, 106 S. Ct. 85, 88 L. Ed. 2d 69 (1985).
32. Aliotti v. R. Dakin & Co., 831 F.2d 898 (9th Cir. 1987).
33. Olson v. National Broad. Co., 855 F.2d 1446 (9th Cir. 1988).
34. *See Aliotti*, 831 F.2d at 901 (emphasis added). *See also Olson*, 855 F.2d at 1453; *Litchfield*, 761 F. 2d at 1293–94.
35. 812 F.2d 421 (9th Cir.), *cert denied*, 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987).
36. *See id*. at 425.
37. At the trial in *Baxter*, this did not prove to be the case since there was extensive testimony on both sides by musicologists and demonstrative evidence in the form of charts and recordings of prior art showing that the phrase allegedly copied was indeed commonplace and unprotected by copyright. Thus, as a matter of logic, expert testimony was admitted so that the jury

de novo standard, based their decision on synthesized versions of the two works containing only computer-generated individual notes without harmony, rhythm, or duration (time value) of the notes, whereas the original recordings of both works (as the real "audience" heard them—one on a vinyl record album, the other in a theater watching *E.T., The Extraterrestrial*) were seemingly deemed of lesser importance than the contemporary, computerized version that the real "audience" never heard. In addition, the appellate court cited disapproved language from *Arnstein v. Porter*, holding that summary judgment was a disfavored remedy. All these references to *Arnstein* were stricken by the court upon petition for rehearing, although the same rationale remains in the published opinion.

In *Selle v. Gibb*,[38] plaintiff, a composer, brought an infringement action against the Bee Gees, *et al.*, claiming that the song "How Deep Is Your Love" had infringed plaintiff's song "Let It End." In a bifurcated trial, the jury found for plaintiff on the issue of liability. The district court granted defendants' motion for judgment notwithstanding the verdict. The Seventh Circuit affirmed the grant of the motion. The district court's grant of judgment notwithstanding the verdict was based primarily on plaintiff's inability to show access, without which a copyright infringement claimant could not prevail, irrespective of how similar the two compositions were.[39] Also, plaintiff did not refute or contradict the testimony of defendants and their witnesses regarding the independent creation process of the allegedly infringing composition.[40] Finally, the district judge stated that "'the inferences on which plaintiff relies is not a logical, permissible deduction from proof of 'striking similarity' or substantial similarity; it is 'at war with the undisputed facts,' and it is inconsistent with the proof of nonaccess to plaintiff's song by the Bee Gees at the time in question.'"[41]

2. *Swirsky v. Carey*: Another Misstep?

In the last of these cases, *Swirsky v. Carey*[42], the Ninth Circuit reversed summary judgment that had been granted in favor of the defendants, and remanded the case for trial. In *Swirsky*, the court held that an allegedly accepted musicological analytical approach— known as "melodic reduction"—raised a genuine triable issue of fact for the jury in determining substantial similarity

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could determine whether the *motif*, which plaintiff claimed was protected by copyright, was in fact protectable. The jury found in a special verdict that it was not.

38. 741 F.2d 896 (7th Cir. 1984).
39. *See id*. at 899–900.
40. *See id*. at 900.
41. *Id.* (quoting Selle v. Gibb, 567 F. Supp. 1173, 1183 (N.D. Ill. 1983) (citations omitted)).
42. 376 F.3d 841 (9th Cir. 2004).

of ideas under the extrinsic test articulated in *Krofft*.[43] This methodology is one in which, rather than analyzing all of the notes in a motif, phrase or other form of musical expression, the musicologist based his analysis of similarities (to prove copying to satisfy the extrinsic test) on "stress" notes, which apparently are those that are more prominent or more important than other notes.[44] One reason the Ninth Circuit may have adopted this highly questionable test is that the defendants did not submit a declaration from a musicologist pointing out the defects in the plaintiff's expert's musicological report and declaration. It is to be noted that none of the recognized musical dictionaries (e.g., *Oxford, Harvard, Groves*) recognizes the concept. In fact, it is not unusual to find emphasis on a particular note or beat: for example, consider that three-quarter time is the meter used both for waltzes and mazurkas; three-quarter time is a standard building block available to all composers writing in these two dance forms. What distinguishes one from the other is that, in waltzes, the first beat is emphasized, while in mazurkas, it is usually the third beat or, occasionally, the second, that is emphasized or accented. This is a musical idea (the placement of emphasis on a beat) used by generations of composers, which, in these contexts, distinguishes these two musical forms. Though the emphasis on one beat rather than another may seem a trifle, in the case of these two dance forms, the differences are dramatic, not only to the listener, but also to the habitué of the dance floor. The same may be said for the emphasis on the downbeat in a popular song. The main problem with this attempt at forensic musicology, however, is that it fails to include (or give equal consideration) to all notes in the expression of a musical idea, no matter how brief or extended. In any event, the emphasis on the notes or beats in many contexts is a *scène à faire* growing logically from standard musical forms and structures which are not "owned" by any one composer.

"Melodic reduction" made its appearance in a prior reported case, *ZZ Top v. Chrysler Corporation*,[45] in 1999. In that case, the court rejected the testimony

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43. *See id.* at 846. As part of the expert testimony and expert report disclosures required under Rule 26(a)(2) of the Federal Rules of Civil Procedure, plaintiff's expert, in applying the "melodic reduction" method, identified "stressed" or "emphasized" notes, which, in his opinion, were more important than other notes, and he compared them with defendant's work to show that the same stressed notes appear at the same places in plaintiff's work as in defendants work. These important notes, in the expert's opinion, were those (1) that fall on a beat; (2) upon which "stress" is placed; (3) in the "hook" of the song; or, (4) that end a phrase. Plaintiff submitted testimony from this expert in moving for summary judgment *See id.* at 846–47.
44. This methodology is comparable to a literary analysis in which emphasis on certain words, and perhaps even letters, is given undue importance in analysis and dissection, rather than analyzing a full sentence or paragraph in the context in which alleged similarity of expression is found.
45. 54 F. Supp. 2d 983 (W.D. Wash. 1999).

of defendant's expert, who opined that one guitar "riff" had a similar pitch (note) and the same rhythm found in seven preexisting songs. The assumption was that, if this single note appeared in seven examples of prior art, defendant had not infringed plaintiff's work. The court granted plaintiff's summary judgment and made the following observations:

> While the reduced version of the riff may, as [the defendant's expert] maintains, be an appropriate representation of "how the music actually sounds" or is "perceived," it is not an accurate representation of the written notes that are subject to copyright protection. . . . Defendant has not, therefore, objectively analyzed the various riffs to show that the . . . objective characteristics of *La Grange's* guitar riff are not original. Rather, defendant has used seemingly objective criteria—music notes—to represent what is fundamentally [defendant's expert's] subjective perception of ZZ Top's expression of the riff.[46]

What should not go unnoticed is that, in *Swirsky*, the court, in accepting the plaintiff's melodic reduction theory, actually violated the essence of *Krofft's* version of the audience test: It permitted an expert to invade that area reserved to the trier of fact—the jury, in most infringement cases—by permitting the expert's *subjective* opinion as to the importance of one note over others to determine whether copying has occurred. Based in large part on the application of the "melodic reduction" theory, the Ninth Circuit held that plaintiff raised a genuine triable issue of fact and reversed the district court's grant of summary judgment.[47]

Caveat

In addition to the literal texts found in the Selle *and* Swirsky *opinions, there is an equally important subtext: Do not gamble by deciding—no matter how thorough the lawyer's analysis—to forego presenting the testimony of an expert. Without such testimony, the trier of fact (whether jury or judge) will not be afforded the opportunity to consider a complete analysis, pro and con, of the musicological merits trumpeted by each side.*[48]

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46. *Id.* at 986 (citations omitted).
47. *See Swirsky*, 376 F.3d at 849.
48. In the wake of *Krofft*, the thinking behind a defendant's election not to present an expert's analyses and opinion by declaration in support of motion for summary judgment in a music infringement action goes as follows:

> The presentation of expert testimony by declaration from the defendant's expert in support of the motion will be contested by a declaration from plaintiff's expert, thereby creating an issue of material fact—whether or not "genuine"—and, thus, foreclosing summary judgment. If the defendant, *arguendo*, concedes access, expert testimony under the *Krofft* extrinsic test to prove copying should be either eliminated or

III. Selecting the Expert

A. Preliminary Tactical Considerations

Initially, it is absolutely essential to become fully familiar with the federal rules applicable to experts. The lawyer should not only read, but also make each of these rules a part of his strategic thinking, whether selecting the expert or experts for the plaintiff or for the defendant. As Rules 104 and 702 of the Federal Rules of Evidence and the Supreme Court opinions have made clear, as long as the individual meets certain criteria, the lack of a Master's or Ph.D. degree in musicology does not disqualify a potential expert. The Federal Rules and the *Daubert* case (and its progeny) take an expansive view regarding the types of experts who may be used to testify at deposition and trial. Thus, in *Kumho Tire*, the expert possessed extensive practical experience in tire safety but did not have the educational background or degrees that may have sounded impressive; the lack of degrees was outweighed by the practical day-to-day knowledge one acquires from being on the job.

In the context of music infringement, an expert may be selected from individuals as diverse as professors in music departments at universities, forensic musicologists (usually with graduate degrees from a university or music school such as Juilliard or Curtis Institute), pop and contemporary composers and musicians, classical composers, and other music professionals who may not fit within a typical pigeonhole but, by practical experience, may bring an invaluable approach and dimension to the deposition and the courtroom. Such individuals bring into play skills that invite the trier of fact into the everyday business of music, usually explained in basic no-nonsense language that jurors can understand.

The last component of this trilogy of federal rules, Rule 26 of the Federal Rules of Civil Procedure, is on its face straightforward, but in fact presents a vitally important tactical consideration in selecting experts and, if more than one, the roles each is to fulfill. The mandates for exchange of information regarding the parties' expert witnesses give rise to implicit caveats and must be given the most careful consideration in choosing an expert. The first issue to be confronted is whether to separate the consulting function from that of the expert who will be a witness at deposition and trial. Rule 26 also provides

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disregarded so that the court can determine as a matter of law whether there is substantial similarity of *protectable* expression. Thus, under the intrinsic test, if the material plaintiff seeks to protect is unprotectable, the judge, in ruling on a summary judgment motion, or the jury, at trial, can find as a matter of law that no *protectable* expression in plaintiff's work has been copied. This approach should be discarded as a relic of the post-*Krofft* reaction to expert testimony now that expert opinion is permitted on the intrinsic side of the two prong approach. *See supra* Section II.B.1.

the procedural road map for: the selection of the testifying expert; the timing of the service of the request for exchange of information; the preparation of the lawyer's expert declaration providing the expert's resumé; the lawyer's statement under oath as to the expert's anticipated testimony; and the expert's fee for testifying.[49]

B. Initial Steps In Selecting The Expert: Due Diligence and Research

Given the importance of the role to be played by the expert in advising lawyers regarding the strengths and weaknesses of their clients' (whether plaintiffs or defendants) music infringement cases, a thorough investigation of the backgrounds and experiences of potential musicological experts must be undertaken by counsel once he or she has chosen to accept a client who may become involved in music infringement litigation. All sources of information should be pursued so that, in an imperfect world, the lawyer and his or her client will select an expert whose qualifications will meet the standards required by the federal rules as explicated in the *Daubert/Kumho Tire/Joiner* trilogy of cases. The sources for such background information include the names of experts to be found in opinions of United States Circuit Courts of

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49. Rule 26(b)(4) of the Federal Rules of Civil Procedure provides, in relevant part:

> (A) *Expert Who May Testify*. A party may depose any person who has been identified as an expert whose opinions may be presented at trial. If Rule 26(a)(2)(B) requires a report from the expert, the deposition may be conducted only after the report is provided. (B) *Expert Employed Only for Trial Preparation*. Ordinarily, a party may not, through interrogatories or deposition, discover facts known or opinions held by an expert who has been retained or specially employed by another party in anticipation of litigation or to prepare for trial and who is not expected to be called as a witness at trial. But a party may do so only: (i) as provided in Rule 35(b); or (ii) on showing exceptional circumstances under which it is impracticable for the party to obtain facts or opinions on the same subject by other means.

FED. R. CIV. P. 26(b)(4)(A)&(B).

> (e) *Supplementing Disclosures and Responses*. (1) *In General*. A party who has made a disclosure under Rule 26(a)—or who has responded to an interrogatory, request for production, or request for admission—must supplement or correct its disclosure or response: (A) in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing; or (B) as ordered by the court. (2) *Expert Witness*. For an expert whose report must be disclosed under Rule 26(a)(2)(B), the party's duty to supplement extends both to information included in the report and to information given during the expert's deposition. Any additions or changes to this information must be disclosed by the time the party's pretrial disclosures under Rule 26(a)(3) are due.

FED. R. CIV. P. 26(e).

Appeals and the United States Supreme Court; the names of lawyers set forth in published opinions of the United States Appellate and District Courts; lawyers who are known as practitioners in copyright infringement litigation; professors in schools of music at universities and colleges throughout the United States; composers of classical, pop, rock, rap, and other genres of music; articles in legal and music publications written by experts; and other sources, including music libraries and the Internet.

With this or a comparable list of sources in hand, the lawyer has the following options for research and study:

- Declarations of experts filed by parties in preexisting litigation in support and opposition to motions for summary judgment;
- Reports by experts provided to other lawyers who have handled copyright infringement actions (whether resolved by settlement or final judgment);
- Resumes of experts that were filed in federal courts during pre-trial proceedings;
- If available, depositions of expert testimony, which may be requested from lawyers who have worked with an expert in other music infringement cases; and
- Information from the potential expert.

C. The Initial Approach to the Expert

In the lawyer's first contact with the expert, the lawyer should not reveal the client he or she is representing either by name or by a plaintiff or defendant designation. In that way, the expert, if hired, is cloaked with seeming impartiality.

The lawyer should then forward to the expert a sound recording of the two compositions, requesting that the expert (1) prepare from the sound sources a transcription on the treble and bass staves, setting forth in written form all notes, meters and other notations for each of the works; (2) provide an initial analysis of prior antecedent works using the same musical motifs, phrases, progressions, or other standard building blocks of music alleged to be substantially similar; (3) provide an analysis of the similarities and differences as to melody, harmony, and rhythm as employed by the composer of each work; (4) prepare an analysis of the similarities and differences between those portions of the compositions that the plaintiff contends infringe his or her work; and (5) prepare an opinion as to whether the alleged infringing work is substantially similar or dissimilar to the allegedly infringed portions of plaintiff's composition.

The expert should be cautioned to communicate his initial findings by telephone to counsel for the party retaining his or her services. If the expert identifies any problems in either pursuing litigation or defending it, every effort

should be made to explore whether the issues raised by the initial oral report can be honestly addressed and resolved favorably to the client's claim.

Even if the problems are resolved, it nonetheless is advisable to hire another expert to support the corrected opinion of the first expert. The importance of this exercise cannot be over-emphasized: Once the musicologist is identified as a testifying expert, his deposition may be taken and his initial opinion must be disclosed, together with his conversations with the lawyer. The reason: such opinions and conversations are not protected by either the attorney work product doctrine or the lawyer/client privilege.

If the initial report of the expert does not raise issues as to the merits of the claim or defense, then the report should be reduced to writing and sent to counsel.

D. After the Expert Is Hired: The Next Steps

After the expert witness is hired, counsel should stay in contact. It may be advisable to ask this critically important witness to update his report for the following reasons, among others: (1) Rule 26 of the Federal Rules of Civil Procedure may require it; (2) there may be additional charts that the lawyer deems necessary to demonstrate graphically the similarities and/or dissimilarities between the two compositions; (3) further analysis may appear necessary as a result of new developments in the copyright law; (4) review and comment on the opposing expert's anticipated testimony may be necessary when his or her report is disclosed pursuant to Rule 26 of the Federal Rules of Civil Procedure; and (5) the preparation of the expert for deposition, the *Daubert* Hearing (if permitted by the Court), and/or trial.

IV. The Gatekeeper Role of the Court: The *Daubert* Hearing

A. Qualifications of Experts: Four Scenarios

After discovery has been completed, and the case set for trial, the court should, during pretrial proceedings, conduct, upon request of one or both parties, a hearing to determine which (if any) analyses and opinions of the musicological expert are admissible (the "*Daubert* Hearing"). For such a hearing, the lawyers on each side should be armed with reports, depositions, and Rule 26 statements (pursuant to Rule 26 of the Federal Rules of Civil Procedure) of the other party's expert. In sum, there should be no surprises regarding the anticipated testimony of each expert at trial.

If, after careful review, counsel concludes that the anticipated testimony of an adverse expert will not meet the standards mandated by *Daubert*, she should request that the court set a *Daubert* Hearing.[50] A likely scenario for obtaining a *Daubert* Hearing would include the following: In pretrial filings (including memoranda of points and authorities filed by each of the parties and the pretrial order of the court), it is advisable to set forth objections to the adverse expert's anticipated testimony and/or move *in limine* to exclude expert testimony and exhibits. In order to determine whether (1) all or less than all of the four *Daubert* factors apply to music infringement cases, and (2) whether music, because of its abstract nature, requires different or additional tests to either support or challenge admissibility of the proffered testimony, the four factors suggested in *Daubert* by the Supreme Court must be carefully considered in light of the subject matter of the litigation and the issues raised by the parties.[51]

Initially, it is apparent that the third factor in *Daubert* (the rate of error relevant to the methodology used by the expert) does not apply to musicology but, rather, to those disciplines lending themselves to measurable and quantifiable analyses such as science, medicine, and technology. In addition, forensic musicology has no recognized society responsible for certifying its members as qualified to provide expert testimony. As a result, experts must be evaluated on their musical knowledge and experience as measured by the *Daubert* standards and those music theories (1) accepted by academia, (2) taught at universities and music conservatories, and (3) found in books and treatises on musicology which have gained acceptance among scholars and musicians. This does not mean that an expert without a Ph.D. or Master's degree could not qualify as expert witness but, rather, that these same standards would apply to her or him.

In applying the three remaining factors suggested by the Supreme Court in *Daubert*, let us consider four scenarios:

Scenario 1: A Ph.D. and professor in musicology, who teaches at a university department of music, is called to testify regarding similarities between two bars of music found in a motion picture score and two similar bars in a popular song. His report is replete with examples of prior art using the same two-bar phrase. He has prepared exhibits documenting in musical and numerical notation the prior uses of the two-bar phrase. The plaintiff, however, regardless of the commonplace nature of this pitch progression phrase, contends that he has used them in a unique way. The plaintiff relies on nothing more than this argument and presents his demonstrative aural and notated evidence of substantial similarity to establish copying. This phrase, however,

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50. *See* Fed R. Evid. 26. As local practice in each federal district may have different procedural rules, those "local rules" must also be consulted.

51. *See supra* note 11 and accompanying text.

has been denuded of harmony and rhythm, both of which are elements found in the plaintiff's popular song as published and recorded. Our professor opines that, in this genre of music, *the expression* of the musical ideas in the phrase at issue is not complete without the three basic elements of music: melody (pitch sequence), harmony, and rhythm. He further testifies that two-bar phrases are a standard device in popular songs and function much the same as the sentence in language having a period at the end. He also testifies that the expression of this musical idea (the succession of notes) is a common building block of music found in countless examples of prior art, which he is prepared to demonstrate via recordings and visual exhibits (both on placards and through video presentation), which are notated with each pitch numbered so that a lay person may follow the intervalic[52] relationship between the notes or pitches.

This expert should survive all challenges to his qualifications to testify regarding his analysis and opinions for the following reasons, using the remaining three *Daubert* suggestions: (1) Upon re-examination and cross-examination (if the court permits testimony at the *Daubert* Hearing) or by declaration under penalty of perjury, the expert cites musicological authorities, his education, specialized areas of expertise and experience, all of which establish his extensive knowledge in the field; (2) the professor has published extensively, including a treatise on musical theory and one on composition, which have become standard texts at music schools, thus achieving a seal of approval for the proffered testimony, both by publication and by peer review; and (3) the substance of his anticipated testimony (as summarized above), clearly meets the remaining *Daubert* factor in that it would have a high degree of acceptance in the relevant community—i.e., musicology.

Scenario 2: Although the expert chosen is not a credentialed and respected professor at a recognized university department of music, he has an undergraduate degree in philosophy, is a trained musician, has been a member of a pop music band, and is an arranger and composer of popular songs that have achieved success with the public. He has also written scores for eleven motion pictures for which he conducted the orchestra heard on the soundtrack. From these experiences, he has become a knowledgeable professional musician fully

52. The term refers to the intervals of the Western Tempered scale consisting of twelve pitches (or notes). As defined in the *New Grove Dictionary of Music and Musicians*, an interval is "The distance between two pitches. The term 'harmonic interval' (as opposed to 'melodic interval') indicates that they are thought of as being heard simultaneously. Intervals are traditionally labelled according to the number of steps they embrace in a diatonic scale, counted inclusively: thus from C up to D or down to B is a 2nd, another step up to E or down to A makes a 3rd, etc." 12 The New Grove Dictionary Of Music And Musicians 500 (Stanley Sadie ed., 2d ed. 2001). *Author's note*: To place this in context, think of intervals as embodied physically on the keyboard of a piano. Thus, in the octave beginning with middle C, giving that note a numerical designation of 1, the interval between C and E (1 and 3) is a third, between C and F (1 and 4) is a fourth, etc. The black keys constitute half steps. For example, the interval between C and E-flat is a minor third, etc.

conversant with the elements making up a musical work. This expert reaches the same conclusions and forms the same opinions as the esteemed professor based upon virtually the same analysis. This witness will also survive a *Daubert* Hearing and should be permitted to testify at the trial.

Scenario 3: A professor at a university is a recognized expert in eighteenth-century music and is retained to opine on the alleged infringement of an acid rock song composed by members of a performing group using the professional name "Acid in Your Face." This is what may be called a non-starter. Although highly educated, he has no background or experience teaching any genre of popular music. He is able to point out similarities in the two works at issue but has no knowledge of the melody, harmony (or lack thereof), and rhythms that are the standard building blocks in the acid rock genre. This expert should not survive a *Daubert* hearing, but the question arises, "Is it possible he might?" Before answering this query, we must first consider one additional scenario.

Scenario 4: Plaintiff has filed an action claiming that a material portion of his disco composition has been copied by a composer and used in the theme for a popular television series. This theme is repeated at the beginning of, during, and at the end of each episode of the series. The phrase appearing in defendant's composition is similar to the note progression plaintiff uses, but the sequence of notes also has certain differences, as does defendant's use of harmony and rhythm in what appears to be a different expression of a musical idea. Plaintiff hires a professor at a prominent university who is a specialist in and teaches compositional techniques for aspiring popular song composers. Instead of analyzing the complete two-bar phrases which are the subject of the infringement claim, the professor creates a new theory in which the basis for the infringement claim is not one of substantial similarity of the phrase in question (including melody, harmony, and rhythm), but rather one that hangs its claim of similarity on specific notes and their occurrences at specific places in each composition. In weighing the professor's qualifications against the three *Daubert* factors applicable to music, the following conclusions seem appropriate: (1) although the professor has a Ph.D., teaches at a recognized university, and has extensive musicological knowledge, he fails the test of "knowledge" because his conclusions and opinions are based upon assumptions not supported by accepted musicological or copyright principles; (2) it would not be surprising that, even if the professor had published articles supporting his anticipated testimony, it would lack widespread approval in the field of musicology, and (3) dovetailing the above rationale, it is unlikely that there would be widespread acceptance of his testimony in musicological circles.

In a perfect world, this expert and the eighteenth-century specialist should not be permitted to testify. But would they be given the go-ahead by the court to do so? The likely answer is "yes." One of the principal reasons for this somewhat surprising answer is that the courts are often under the impression that music infringement claims should be held to a different standard, purportedly

because of the abstract nature of the ideas used by creative persons to compose musical works. Secondly, we can give some weight to traditional reluctance to foreclose a party from presenting a critical element of its case. Even though the analysis in the Supreme Court's *Daubert* opinion is intended to foreclose testimony based on what has often been called "junk science,"[53] that does not always advance the cause for disqualifying an expert who indulges in "junk musicology." "Junk science," as such, should be avoided because the proponent of such testimony runs the risk of having his or her expert opinions foreclosed by court order or given little or no weight by the judge and jury. That raises the question: What is junk musicology? Perhaps it is similar to pornography, in that you will know it when you see and hear it. The practical answer is that it is very difficult to convince a judge who believes that a party is entitled to present her case as she chooses, and does not want to be reversed on appeal, that the expert's opinion is truly "junk" or merely musicology which does not meet the *Daubert* standards.

Thus, even though the courts may conduct *Daubert* Hearings, many judges are more likely to permit such testimony and leave it to effective cross-examination, rebuttal, and impeachment for the jury to decide which of the dueling experts they wish to believe. Given this scenario of a court's likely ruling, what is the reason for even conducting a *Daubert* Hearing in a music infringement case? The answer: At a minimum, the judge will be educated regarding the flaws in the expert's opinion, which may impact the judge's rulings on jury instructions and, in the case of an adverse judgment, the court's ruling on a motion for judgment as a matter of law. It should also be remembered that the plaintiff has the burden of proof to establish infringement of copyright, and, if an expert's conclusions are based on assumptions that are insupportable,[54] it may furnish a ground for a directed verdict or a judgment as a matter of law in the event of an adverse verdict.

B. Determining What Will Be Played

Even if the *Daubert* Hearing does not prove fruitful in disqualifying the expert, lawyers and litigants should use such hearings as a springboard for the court to rule on the admissibility of aural and visual expert exhibits designed for the purpose of convincing a jury of the parties' respective claims and defenses. For example, if either the plaintiff or defendant proposes to play

53. *See Daubert*, 509 U.S. at 589–94, 113 S. Ct. at 2795–97 (discussing factors to ensure that scientific testimony admitted is reliable, relevant and based on "good science").

54. *See* Roddenberry v. Roddenberry, 44 Cal. App. 4th 634, 651–52, 51 Cal. Rptr. 2d 907, 916–17 (1996) (explaining that a judgment must be supported by substantial evidence, which focuses on the quality of the evidence at issue, and expert opinion testimony is substantial only if it is based on conclusions or assumptions supported by evidence in the record).

computer-generated sound recordings of the sequence of pitches at issue (purportedly to prove substantial similarity between the two works or the lack thereof) out of context and without harmony, rhythm, and meter, such exhibits should be inadmissible. The courts may be reluctant to exclude such testimony; however, if the party objecting to demonstrative evidence makes a sufficient showing, a carefully drafted instruction setting forth the essential components of musical expression may focus the jury's attention on the inadequacy of those exhibits and provide persuasive material for final argument.

V. The Musicological Expert: Translator and Teacher of Musical Language

Without the musicological expert—whether credentialed musicologist, academic, or other music professional—those involved in music infringement litigation would be deprived of the one participant who, at all stages from the filing of the complaint through trial and appeal, provides guidance in explaining the language and ideas of music for the parties, their lawyers, the court, and the jury. Of equal importance is the ability of this expert through analytic dissection to point out those constituent parts of a musical work that are potentially protected by copyright as original expression and those that are not. As this distinction between the protected and the unprotectable is one of the core issues in infringement actions, the care in selecting an expert can never be emphasized enough. He or she is the translator and teacher of this unique language and, as such, is a key player when parties face infringement or potential infringement issues.

VI. Rewriting to Avoid Claims

A. Preventive Law Explained

In our litigious society, creative individuals and their lawyers are often forced to deal with the unexpected and unwanted task of defending a copyright infringement action, especially when the client has authored a financially successful work. When that occurs, copyright lawyers are well equipped to mount well-conceived and often successful defenses to claims against their clients. Composers and their lawyers should, however, be aware that there are nonjudicial remedies to cure potential issues of infringement before the creative work is published, publicly performed or otherwise exploited. The approach that is more often than not overlooked within the world of copyright is one that involves "preventive law," a term intended to convey a message to lawyers

and their clients analogous to one familiar to physicians and the public as "preventive medicine." Thus, it is the goal of doctors to use current medical knowledge and technology to diagnose potential health problems the patient is likely to face, and to take steps to forestall or prevent serious illness or a premature death. In their search for better healthcare, doctors use state-of-the art devices that can ferret out coronary dangers that have not yet become symptomatic; perform surgery to prolong life through organ transplants; and, by prescribing medication, decrease the dangers posed by hypertension and restore balance and productivity to the lives of those plagued by severe clinical depression.

Preventive law has always been there for lawyers, who implement it each time they advise a client to take or not to take a particular course of action in a transaction, to chart a course of conduct for their client calculated to avoid potentially adverse consequences, or to settle rather than litigate a dispute. Advice such as this is in the best traditions of the legal profession and of obvious benefit to clients. Although the case of *See v. Durang* obviously arose after a complaint for copyright infringement had been filed, the opinion by the Ninth Circuit offers insight into the benefits of rewriting a work before the litigation gauntlet has been thrown down.

In *See*, the works at issue were two theatrical plays. During discovery, the plaintiff requested production of prior iterations of defendant's play to demonstrate that defendant copied from plaintiff's work, but revised his play to avoid detection and therefore liability. The court addressed plaintiff's argument as follows:

> The only discovery plaintiff suggests is the production of early drafts of defendant's play on the theory they might reflect copying from plaintiff's play that was disguised or deleted in later drafts. *Copying deleted or so disguised as to be unrecognizable is not copying.* [55]

In copyright the equivalent of these exercises in due diligence and preventive law is to spot problems and fashion a solution—with advice from a musicologist—by rewriting those portions of creative works presenting potential infringement issues before release of the work to the public. Such rewriting in the attempt to avoid a potential claim is, in essence, merely another application of the idea/expression dichotomy to a copyright issue. This type of "script doctoring" is nothing new in the worlds of publishing, motion pictures, and television industries. For example, in the entertainment industry the need to do so is driven in great part by the requirement that production companies, individual producers, and others involved in production must obtain entertainment errors and omissions insurance before their productions can be distributed, exhibited, or otherwise exploited for public consumption.

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55. See v. Durang, 711 F.2d 141, 142 (9th Cir. 1983) (emphasis added).

This type of errors and omissions insurance (1) covers claims for copyright infringement, defamation, invasion of privacy, false light privacy, and idea submissions; and (2) provides indemnification for damages and payment of defense costs for and on behalf of defendants insured under the terms of the insurance policy. The most effective approach to early detection of potential claims is to carefully analyze the properties (whether screenplays, novels, or other works) for problem areas. Examples of the situations giving rise to claims under such policies are numerous. The following scenarios illustrate typical issues which must be addressed before a work is released to the public:

The Romance and Marriage of Prince Charles and Lady Diana Spencer

Before the marriage of Charles and Diana, the author of this text was requested to review a screenplay for one of the productions chronicling their courtship and impending marriage. In the script, virtually every scene was footnoted by reference to a published source—such as the *London Times*, *Time Magazine*, the *New York Times*, etc.—to demonstrate that the scene was based on actual events. There was one scene, however, depicting a private picnic between Charles and a former girlfriend in which he proclaimed his love for her, and she insisted that, because she was a commoner, his family would never permit him to marry her, and that they should end their relationship. At an intense moment in their conversation a group of *paparazzi* virtually engulfs the couple causing them to flee. This scene was not footnoted with any references to establish its factual basis. The producers were advised either to rewrite the scene or to delete it from the overall scenario. They elected to cut the scene.

The reason the producers' representatives were advised to cut the scene was that the former girlfriend was a woman who had been linked with Prince Charles at a time when she became, by virtue of her relationship with him, a "vortex public figure."[56] Such individuals are those caught in the maelstrom of a public event and thrust into the limelight, but who, after a number of years, recede from public view and assume their private lives. When this occurs, writers do not have the same insulation from liability they have when writing about or depicting public figures. After the vortex subsides, a more stringent standard for defamation and invasion of privacy is imposed on those writing about or depicting an individual who has regained the right to assert his or her rights of privacy.

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56. *See generally* Gertz v. Robert Welch, Inc., 418 U.S. 323, 94 S. Ct. 2997, 41 L. Ed. 2d 789 (1974).

Famous Author Inadvertently Copies From a Pre-existing Work Protected by Copyright

A bestselling author (the "Novelist") is writing a novel about a notorious murderer who is brought to trial, convicted of first-degree murder, and sentenced to life imprisonment without the possibility of parole. During the course of the investigation of the murder and subsequent trial, the journalist (the "Journalist") writes a factually and psychologically in-depth retelling of the murderer's childhood, his alcoholic mother, physically abusive father, and pathological hatred of women. Like Truman Capote's *In Cold Blood*, a generation earlier, the Journalist's book becomes an instant bestseller and a classic, because of his meticulous research and brilliant writing. In preparing to write his novel, the Novelist engages in extensive research, which includes reading the Journalist's factual recounting of the killer's life and the heinous crime he committed. The Novelist makes extensive notes from the Journalist's written documentary, which, among the voluminous notes from other sources (e.g., newspapers, magazines, etc.), are used to create many of the passages in the Novelist's work in progress. When the novel is published, a demand letter is dispatched to the Novelist's publisher, claiming that he copied word for word two highly descriptive paragraphs from the Journalist's book. The inevitable lawsuit follows and is settled after two years of discovery, motions, and preparation for trial. All of this could have been avoided if the Novelist and his publisher had meticulously reviewed the novel to determine whether any licenses or other written consents were necessary for materials quoted by him, whether intentionally or inadvertently.

B. Musical Works and Preventive Law

The methodology for rewriting music is no different from that employed in attempting to avoid potential claims against writers, motion picture and television producers, and other creative individuals. What is different is the special knowledge required of musical ideas and expression in the vast literature of music, whether classical, pop, jazz, rock, or rap. The key player in rewriting is a musicologist with a broad knowledge of musical genres and access to a database housing an extensive library of prior musical art. In considering whether to rewrite a passage from a musical work, the legal protocol is to achieve and maintain the attorney-client privilege.

To place the process in a practical setting, let us assume the following: After a meeting with a composer/client who expresses some concern that one phrase in his score for a motion picture is similar to a passage in a popular song, his lawyer hires a musicologist as a consultant (not as a disclosed testifying expert) to input the musical notes in question to his computer to determine from stored thematic information the extent to which those notes have

been used in existing compositions. The results of his search reveal that these notes have appeared many times in the folk music of Anatolia (an area including Greece, Turkey, and other countries in the region) and among ethnic gypsies in Hungary and Romania. As the composer/client is writing a score that accompanies a sequence in the film depicting partisans from the Balkans in the Second World War, he decides to use music from two of the works the musicologist has found, both of which are in the public domain. He is cautioned by his lawyer, who has consulted with the musicologist, that he must prepare a different orchestration and alter two of the cadences from 5-1 to 3-1.[57] In composing the score, the composer first has the notes from the musicologist's database recorded by a gypsy violinist. He then places the recording on a temp track[58] to give the music he is writing (including the addition of rhythm and harmony) the ethnic/nationalistic feeling he is trying to achieve. In using this methodology, the following has been accomplished: the composer has used public-domain materials to write an ethnically flavored sequence for a motion picture depicting the actions and bravery of partisans during the Second World War in an area of Eastern Europe. The temp track will serve as evidence, should a claim be asserted, of the sources used by the composer to write his score. In this scenario, the composer used musical materials in the public domain available to all composers, altered the music sufficiently to make an "original" statement, and created the temp track to serve as evidence that he based his musical sequence on public-domain materials.

Another example: The producer of a motion picture seeks to obtain a license to use a brief section of an existing film score as a *leitmotif* parodying the onscreen action in a brief sequence in the film he is producing. The owners of the existing film refuse to grant the license. The producer's lawyer hires a musicologist to determine if anything similar to the sequence from the existing motion picture is in the public domain. The musicologist, after consulting his database, finds that the musical sequence in the existing film had been used in numerous works, including a German hunting song, a Danish folk song, and the Hungarian national anthem, as well as numerous folk songs from Northern Europe. He advises the composer's lawyer that the sequence found in the existing motion picture and those in his computer constitute a common bridge used in many compositions, and that it is available for use by the lawyer's client. He cautions, however, that it would be highly desirable to use a different orchestration than the one in the score for the existing film. The author of this text represented the client in this scenario. A claim was never

57. Choosing the key of C-Major as a representative example, 5 to 1 is G to C, while 3 to 1 is accomplished by playing E to C.

58. A "temp track" or "temp music track" is "[a] temporary sound track with music from various sources that is played during early previews or screenings of a film before its own music is composed and recorded." Ira Konigsberg, The Complete Film Dictionary 415 (2d ed. 1997).

asserted by the copyright proprietor of the existing music, perhaps because the composer of that score used the same source materials the musicologist accessed in his database.

A whimsical "confession" of this practice was provided by the famous film composer Dmitri Tiomkin, who, when accepting an Academy Award, announced that he wanted to thank those who collaborated with him in the creation of his award-winning score: Mr. Strauss, Mr. Beethoven, Mr. Wagner, *et al*. He elicited a knowing response from the audience—sprinkled with laughter.

CHAPTER
6

The Importance of the Expert

The Apportionment Expert

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In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work.

—Section 504(b) of the Copyright Act[1]

I. Historical Background and Rationale Underlying Apportionment

Creative works—whether drama, literature, music, or other forms of artistic expression—are, in their final forms, a combination of elements drawn from multiple sources. A motion picture is a prime example of a collective work, both in terms of the collaborative efforts of the people who provide its artistic/creative elements and those who manufacture it as a product to be consumed by the public.[2] Unlike dramatic works, such as motion pictures, television productions, live theater, and opera, literary and musical works, and other works in the fine arts (e.g., paintings and sculpture) are, with very few exceptions, the products of solitary creation by one person writing at a table, desk, or piano, or standing before an easel or a block of stone with brush or chisel in hand. In terms of ideas and inspiration, both types of creators—the collaborative and the solitary—draw on the vast resources of the past. As a result, virtually all creative works share with their predecessors those elements available to all those creators working within a particular genre. Under such circumstances, it should not be surprising that an author of a previous novel might allege that the second author copied an important or substantial portion from his novel, even though the portion "copied" may be either unprotected by copyright or a relatively small portion of the total work. Thus, when infringing and noninfringing elements are inextricably intertwined with protectable expression, the need arises for apportionment of defendant's profits. For example, when a composer, in creating a bestselling popular song, copies a motif from a copyrighted musical work, and as a result the plaintiff contends that the material copied from his work is the sole or most important reason for defendant's success, the defendant argues that his commercial success was due, not only to the original material he composed, but also to other elements present in the recording of his song, such as the arrangement,

1. 17 U.S.C. § 504(b).
2. As defined in the entertainment industry, the costs for the artistic/creative elements in a production are called "above-the-line costs" and the costs for those who provide technical support are "below-the-line costs."

orchestration, stature of the composer, and star power of the instrumental or vocal artist. The obvious question arises: How are defendant's profits to be apportioned between (a) the materials allegedly copied by defendant from plaintiff's composition; and (b) the defendant's original work and its constituent elements other than those for which plaintiff claims copyright protection?

A. *Sheldon v. Metro-Goldwyn Pictures Corporation*.[3] The Birth of Apportionment of Profits

The procedure for equitably apportioning the profits of copyright infringers, as now codified in Section 504(b) of the Copyright Act, achieved its initial incarnation only in 1940 when the Supreme Court in *Sheldon v. Metro-Goldwyn Pictures Corporation* "corrected" a misguided holding in the 1888 case of *Callaghan v. Myers*.[4] The word "equitable" highlights the compelling reasons for "correction" of the Supreme Court's holding in *Callaghan*, which, when viewed in context, was far from traditional concepts of equity and fairness. The Supreme Court's solution in *Callaghan* (a non-music infringement action) was to order defendant to pay *all* of its profits to plaintiff since (1) the task of separating infringing from noninfringing materials presented such difficulties that the infringing elements could not be separated with any reasonable degree of certainty from defendant's original (and, therefore, noninfringing) materials and (2) the difficulties inherent in filtering infringing from noninfringing materials were caused by defendant's decision to intermingle those elements with his original materials.[5]

The holding in *Callaghan* was eviscerated by an act of judicial legerdemain in *Sheldon v. Metro-Goldwyn Pictures Corporation*, first by the Second Circuit Court of Appeals (in an opinion by Learned Hand) and then by the Supreme Court (in affirming the Second Circuit's holding).[6] In so doing, the Court apparently "modified" or "corrected" *Callaghan* without reversing or disapproving the "nothing at all" approach to apportionment enunciated by the *Callaghan* Court.

In *Sheldon*, the Second Circuit held that 20 percent of defendant's profits were attributable to the materials copied from *Dishonored Lady* (the plaintiff's play) in the production of the motion picture *Letty Lynton*.[7] The Supreme Court affirmed the holding of the Second Circuit, recognizing that, in computing profits from the exploitation of a creative work, the courts must consider

3. 309 U.S. 390, 60 S. Ct. 681, 84 L. Ed. 825 (1940).
4. 128 U.S. 617, 9 S. Ct. 1777, 32 L. Ed. 547 (1888).
5. *See* 128 U.S. at 663–66, 9 S. Ct. at 190–91.
6. 106 F.2d 45 (2d Cir. 1939), *aff'd*, 309 U.S. 390, 60 S. Ct. 681, 84 L. Ed. 825 (1940).
7. *See* 106 F.2d at 51.

the contributions attributable to factors other than the allegedly infringed portions of the plaintiff's work. In the context of *Letty Lynton*, these included the popularity of the actors, the skill of the director, and the production values other professionals brought to the task.[8] In discussing methodology, the Court, echoing the opinion of Second Circuit Judge Learned Hand, held that, in allocating the contribution of copyrighted material copied by the defendant, "what is required is not mathematical exactness but only a reasonable approximation."[9] However, as Judge Hand observed in his Second Circuit opinion, "[w]e will not accept the experts' testimony at its face value; we must make an award which by no possibility shall be too small. It is not our best guess that must prevail, but a figure which will favor the plaintiffs in every reasonable chance of error. With this in mind we fix their share of the net profits at one fifth."[10]

To shed further light on the subject of apportionment, the Supreme Court held that, even though the defendant may be "found guilty of deliberate plagiarism," no penalty would be imposed because "we perceive no ground for saying that in awarding profits to the copyright proprietor as a means of compensation, the court may make an award of profits which have been shown not to be due to the infringement."[11]

In parsing the words of Learned Hand, quoted above, one should not fail to note the distinction he makes between "our best guess" (which he says should not be the standard for apportionment) and "a figure which will favor the plaintiffs in every reasonable *chance* of error."[12] In the Second Circuit and Supreme Court opinions, the courts are providing perhaps the only workable standard to balance fact-finding with the methodology influenced by a less than exact standard for allocations to noninfringing materials. This, obviously, leaves the evaluation and allocation of the amount and value of contributions to the creation and performance of a musical work to subjective evaluation by experts, counsel, and the courts. With such an elastic "standard," jury verdicts, bench findings, and judgments may yield "best guess" results less likely to constitute reversible error, except where a finding is clearly erroneous, as the reported authorities discussed below demonstrate. As a result, much care must be taken in vetting the stature and qualifications of apportionment experts and in presenting their testimony in court.

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8. 309 U.S. at 407, 60 S. Ct. at 687.
9. *Id.* at 408, 60 S. Ct. at 688.
10. 106 F.2d at 51.
11. 309 U.S. at 405, 60 S. Ct. at 686–87.
12. 106 F.2d at 51 (emphasis added).

B. The Progeny of *Sheldon:* A Brief History

• *Frank Music Corporation v. Metro-Goldwyn-Mayer Inc.*[13] In this case, the claim arose from the unauthorized use by MGM Grand Hotel of five songs from plaintiffs' musical play *Kismet* in a theatrical review entitled *Hallelujah Hollywood* that was staged by defendants at the MGM's Ziegfeld Theater in Las Vegas. The Ziegfeld Theater was a lavish showplace with special features including huge elevators used to raise and lower portions of the stage, ceiling lifts capable of lowering performers down into the audience during performances, and an array of impressive special effects. Act IV of *Hallelujah Hollywood* presented a tribute to *Kismet*, the MGM movie. It was comprised of four scenes of approximately eleven and one-half minutes in length. Six minutes of music used was taken directly from the plaintiffs' musical play. Total running time of *Hallelujah Hollywood* was approximately 100 minutes with the exception of Saturday night when two acts were deleted, thus shortening the show to seventy-five minutes. It was performed three times on Saturday evenings and twice on other evenings of the week. In all, the *Kismet* sequence was used for approximately 1,700 performances of *Hallelujah Hollywood*, which ran at the Ziegfeld Theater from April 26, 1974 through July 16, 1976, when new music was substituted for the *Kismet* music in Act IV.

Plaintiffs filed suit, alleging copyright infringement. The MGM Grand Hotel asserted in its defense that, pursuant to its ASCAP license, it had the right to perform publicly "non-dramatic renditions of the separate musical compositions" in the ASCAP catalogue of the works of its member composers.[14] The district court held that the use of the *Kismet* music exceeded the scope of the ASCAP license even though *Hallelujah Hollywood* is a nondramatic work, because it contained visual representations from plaintiffs' play.[15] The Ninth Circuit agreed with the result reached by the judge below but not with his approach and further stated that there was no reason to consider (as the district court did) whether Act IV was nondramatic. The district court found the following "visual representations" from *Hallelujah Hollywood* to be protected by copyright: plaintiffs' songs were performed in *Hallelujah Hollywood* by singers identified as characters from plaintiffs' *Kismet*; their costumes were designed to recreate *Kismet;* and the Ziegfeld Theater performances made use of locale, settings, scenery, props, and dance style music of the type used in plaintiffs' work.[16]

Upon appeal by defendants, the court, after dealing with other defenses advanced by defendants, turned its attention to determining the amounts

13. 772 F.2d 505 (9th Cir. 1985).
14. *Id.* at 511 & n.1.
15. *See id.* at 511.
16. *Id.* at 511–12.

recoverable for the infringement, including how profits should be apportioned. The court began by reviewing the applicable law:

The 1909 Act, which applied because the actions at issue all occurred prior to January 1, 1978, provided for copyright damages due to the infringement as well as *"all the profits which the infringer shall have made from such infringement*," and the court began at such damages.[17] The court defined actual damages as the extent to which market value of the copyrighted work has been diminished or destroyed by the infringement.[18] The test in the Ninth Circuit is "'what a willing buyer would have been reasonably required to pay to a willing seller for plaintiffs' work.'"[19] The district court would not award damages because it did not believe that the value of *Kismet* was diminished as the result of the defendants' infringement. This decision was sustained because it was not clearly erroneous, although the appellate court held that *Hallelujah Hollywood* had a promotional purpose that was to draw people to the hotel and the gaming tables.[20] The court therefore ruled that *Hallelujah Hollywood* had promotional value and, as a result, indirect profits from the hotel and gaming operations, as well as direct profits from the show itself, were recoverable if properly ascertainable.[21]

The court stated that it is defendant's burden to prove apportionment (i.e., "the contribution to profits of elements other than the infringed property").[22] The court further stated that it would not reverse the lower court's findings on apportionment unless clearly erroneous.[23] The court, in defining its task, stated that arriving at the proper method of apportionment is "largely a factual exercise."[24] It rejected defendants' contention that the lack of importance of the *Kismet* music was proven by its omission from *Hallelujah Hollywood* and its continued success, and it held that "[e]ach element contributed significantly to the show's success, but no one element was the sole or overriding reason for that success."[25]

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17. *Id.* at 512 (quoting 17 U.S.C. § 101(b)(1970) (emphasis added)). Please also note that, under the Copyright Act of 1976, a prevailing plaintiff is entitled to recover both actual damages and the infringers' profits. *See* 17 U.S.C. § 504 (1982).
18. *See id.* (citing 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 14.02, at 14–6 (1985)).
19. *Id.* (quoting Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1174 (9th Cir. 1977)).
20. *See id.* at 513–14.
21. *See id.* at 517–18.
22. *Id.* at 518 (citing Lottie Joplin Thomas Trust v. Crown Publishers, Inc., 592 F.2d 651, 657 (2d Cir. 1978)).
23. *See id.* (citing Shapiro, Bernstein and Co. v. 4636 S. Vermont Ave., Inc., 367 F.2d 236, 241–42 (9th Cir. 1966)).
24. *Id.*
25. *Id.*

Application of Apportionment Standards and Result:

The lower court found that a fair approximation of the profits of Act IV attributable to the infringement was $22,000. The Ninth Circuit reversed and remanded to the trial court with directions that this was not a "fair approximation," noting that the profit realized by defendants was approximately $2,500,000 and that the $22,000 award to plaintiff was "less than one percent of MGM Grand's profits from the show, or roughly $13 for each of the 1700 infringing performances."[26]

The court held that a portion of the infringer's overhead properly allocated would be deducted from gross revenues in computing profits; provided, however, that the infringement must not be willful, conscious or deliberate.[27]

The lower court allocated a portion of "general overhead" on a reasonable basis to the production of *Hallelujah Hollywood* based on defendant's method of allocation, which the Ninth Circuit called "reasonably acceptable." However, the Ninth Circuit disagreed with the district court to the extent it concluded that defendant adequately showed that its claimed overhead expenses actually contributed to the production of *Hallelujah Hollywood*. The Ninth Circuit found this clearly erroneous and reversed.[28]

Instructions On Remand to Lower Court:

The lower court should have considered MGM Grand's earnings from its hotel and gaming operation in arriving at the amount of profits attributable to the infringement. In other words, the lower court limited profits to revenues and profits earned only from the production of *Hallelujah Hollywood* (revenues $24,000,000; profits $2,500,000).[29] As a matter of first impression, this issue was resolved in favor of the plaintiffs, the court concluding that, under the 1909 Copyright Act, indirect profits may be recovered. On the other hand, the court stated that a court "may deny recovery of a defendant's profits if they are only remotely or speculatively attributable to the infringement."[30]

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26. *Id*.
27. *See id*. at 515 (citing Kamar Int'l, Inc. v. Russ Berrie & Co., 752 F.2d 1326, 1331 (9th Cir. 1984); Sammons v. Colonial Press, Inc., 126 F.2d 341, 351 (1st Cir. 1942); 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 14.03[B], at 14–16.1 (1985)).
28. *See id*. at 516.
29. *See id*. at 517–19.
30. *Id*. at 517 (citing 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 14.03[A], at 14–15 (1985); Roy Export Co. v. Columbia Broad. Sys., Inc., 503 F. Supp. 1137, 1156–57 (S.D.N.Y. 1980), *aff'd*, 672 F.2d 1095 (2d Cir. 1981)). *See also* Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 1983 Copyright L. Rep. (CCH) ¶ 25, 572 at 18,381 (C.D. Cal. 1983) (hereinafter, "*Krofft II*"); Cream Records Inc. v. Jos. Schlitz Brewing Co., 754 F.2d 826 (9th Cir. 1985). The Ninth Circuit remanded to the lower court to reconsider apportionment of profits with the instruction that if the court finds that a reasonable non-speculative formula cannot be derived or that the amount of profits is insufficient to serve the purposes underlying the statutes, the court should award statutory (or "in lieu") damages. *See Frank Music Corp*., 772 F.2d at 519.

Treatment of Joint Infringers:

The court observed that the award of $22,000 in profits jointly and severally was error and stated that "[w]hen a copyright is infringed, all infringers are jointly and severally liable for plaintiff's *actual damages*, but each defendant is severally liable for his or its own *illegal profit*; one defendant is not liable for the profit made by another."[31]

The Alternative of Statutory Damages:

In discussing statutory damages, the court, in remanding to the district court, held that, if the lower court could not find a satisfactory method for apportionment of profits, such damages may be a substitute for profits or actual damages. "When injury is proved but neither the infringer's profits nor the copyright holder's actual damages can be ascertained, an award of statutory 'in lieu' damages is mandatory."[32] "But if either profits or actual damages or both can be ascertained, the trial court has discretion to award statutory damages."[33]

• *Lottie Joplin Thomas Trust v. Crown Publishers, Inc*.[34] This case involved the infringement of two compositions contained in Scott Joplin's only opera, the copyrighted work *Treemonisha*: "Treemonisha (Prelude to Act III)" and "A Real Slow Drag." In addition to the copyright registration for the opera *Treemonisha*, Joplin registered for copyright the two individual works, and his widow (Lottie) renewed them all, after which ownership of the copyrights, through a series of bogus assignments, passed to the hands of trustees, executors, etc., who defrauded the estate of Scott Joplin and the estate of Lottie Joplin. These episodes of underhanded dealing were rectified in the district court, where the judge ruled that the assignments were invalid, and also observed that the mere filing and recording of an *assignment* in the Copyright Office was not *prima facie* evidence of the facts stated in the certificate documenting an invalid license.[35]

Defendants Crown Publishers, Inc., Olympic Records Corporation, and Joseph Abend produced an LP album entitled "Scott Joplin His Complete Works" that included the *Treemonisha* works at issue, and they continued selling these records, even after receiving written notice that they were infringing the copyrights of Mary L. Wormley, the final successor owner of Scott Joplin's works. Olympic Records Corporation (owned by Abend) sold 27,796 copies

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31. *Id*. at 519 (emphasis in original) (citing MCA, Inc. v. Wilson, 677 F.2d 180, 186 (2d Cir. 1981); 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 12.04[C][3], at 12–50 (1985); *Cream Records, Inc*., 754 F.2d at 829).
32. *Id*. at 520 (citing Russell v. Price, 612 F.2d 1123, 1131–32 (9th Cir. 1979); Pye v. Mitchell, 574 F.2d 476, 481 (9th Cir. 1978); *Krofft*, 562 F.2d at 1178–79).
33. *Id*. (citing *Krofft*, 562 F.2d at 1178).
34. 456 F. Supp. 531 (S.D.N.Y. 1977), *aff'd*, 592 F.2d 651 (2d Cir. 1978).
35. *See* 456 F. Supp. at 536.

of "Scott Joplin His Complete Works." The *Treemonisha* compositions filled only one side of a five-record set and, as a result, constituted only one-tenth of the entire set of records. Plaintiff, however, argued that the inclusion of *Treemonisha* made the recordings a complete set of Joplin works, and that, since it was the only one on the market, plaintiff was entitled to its entire profits. The court did not buy plaintiff's argument, and ruled that 50 percent of the profits from the album would be allocated to the *Treemonisha* works.[36]

• *MCA, Inc. v. Wilson*.[37] In that case, the Court of Appeals affirmed the finding of substantial similarity under the clearly erroneous standard of review. Between January 1974 and July 1976, the defendants were involved in the production of a revue entitled *Let My People Come*, which was performed at The Village Gate, a cabaret in Greenwich Village, NYC. After its run at The Village Gate, it had short runs in several other cabarets and legitimate theatres. In their reviews, the critics described the production variously as "'an erotic nude show'" with "'sex content raunchy enough to satisfy the most jaded porno palate,'" and a show whose "'main concern is not fornication, but fellatio and cunnilingus.'"[38] As one columnist observed, the show sounded "'like something we've heard before, but definitely not with these words.'"[39] The song which plaintiff claimed had been infringed is entitled "Boogie Woogie Bugle Boy of Company B," which the defendants, with new lyrics, called "The Cunnilingus Champion of Company C." Cast members in discussing that song (with new words) commented on its similarity to "Boogie Woogie Bugle Boy of Company B."[40]

In discussing damages and profits, the court refined the general statement that all defendants concerned in the infringement are jointly and severally liable by pointing out that this rule applies only to *liability for damages*, and not to profits. As far as illegal profits are concerned, liability is several in that one defendant is not liable for the profits made by another defendant.[41] A special master who was assigned to report to the court recommended an award of 5 percent of total receipts from *Let My People Come* attributable to "Cunnilingus Champion" as profits earned during the two and one-half year run of the *Let My People Come* at The Village Gate. In affirming the judgment, however, the court observed that "as triers of the fact, we might have been less generous."[42] The court reversed the award against defendant D'Lugoff, who was president of The Village Gate and whose $25,000 annual salary was not

36. *Id*. at 538. This case, including this allocation of profits was affirmed on appeal. *See* Lottie Joplin Thomas Trust v. Crown Publishers, Inc., 592 F.2d 651 (2d Cir. 1978).
37. 677 F.2d 180 (2d Cir. 1981).
38. *Id*. at 181.
39. *Id*. at 181–82.
40. *See id*.
41. *See id*. at 186. Please note, however, that defendants can be jointly and severally liable for profits if they are in a partnership or joint venture.
42. *Id.*

contingent upon or in any way related to the profits from *Let My People Come*.[43] The court also observed that, even though the term "profit" was not defined in the Copyright Act, it was to have its ordinary, usual meaning, as found in *Webster's Third New International Dictionary* and in *Black's Law Dictionary* as "'[g]ain realized from business or investment over and above expenditures'" and "'[i]n distinction from the wages of labor.'"[44]

• *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*[45] In the district court, the judge was Richard Owen, himself an accomplished musician and composer. The individual defendant was George Harrison, formerly one of the Beatles, who Judge Owen found "had subconsciously plagiarized" the song "He's So Fine" in composing the melody of his hit song "My Sweet Lord."[46] The district court also found that the revenues from "My Sweet Lord" were derived from four principal sources: "mechanical royalties, performance royalties, the sale of sheet music and folios, and the profits of Apple Records, Inc., the Harrison-owned manufacturer of the principal recordings of 'My Sweet Lord.'"[47]

Judge Owen observed that "[c]ommon sense dictates that a hit song contributes more to the sale of a record than does a less popular song. In such circumstance, mechanical royalties paid to a composer for a less-than-memorable song on the record are, in fact, earned by the memorable song which has caused the public to purchase the record. While not susceptible to quite the precision one might prefer, a reasonable determination of the total earnings applicable to 'My Sweet Lord' can be made here and is an appropriate item of damage for the court to award."[48]

The judge then proceeded to deal with earnings from the single of "My Sweet Lord" (the flip side being "Isn't It a Pity," a non-hit) and then considered the following types of revenues generated by "My Sweet Lord": gross earnings from mechanical royalties; performance royalties; and, the earnings of Apple Records (the label owned by Harrison).[49] The judge found that the total gross earnings from "My Sweet Lord" were $2,152,028.00, which, after deduction of expenses, reduced the total earnings to $2,133,316.00.[50]

The court then discussed its rationale for allocation of profits to (1) infringed music and (2) other factors that contributed to the success of the single and

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43. *See id.*
44. *Id.* (quoting unspecified pages *from* Webster's Third International Dictionary & Black's law dictionary (4th ed.)).
45. 722 F.2d 988 (2d Cir. 1983), *aff'g* 508 F. Supp. 798 (S.D.N.Y. 1981); *see also* Bright Tunes Music Corp. v. Harrisongs Music, Ltd., 420 F. Supp. 177 (S.D.N.Y. 1976), *aff'd sub nom.* ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1983). This litigation was commenced in early 1971 and continued in the courts until 1991.
46. 508 F. Supp. at 799 (citing *Bright Tunes Music Corp.*, 420 F. Supp. at 180–81).
47. *Id.* at 800.
48. *Id.* (citing *Lottie Joplin Thomas Trust*, 456 F. Supp. 531).
49. *See id.* at 801.
50. *See id.*

the album, including the contribution of the lyrics to "My Sweet Lord" and the selling power of Harrison's name and *persona*. The judge stated that "[a]lthough this is not an area susceptible to precise measurement, I conclude that three-fourths of 'My Sweet Lord's' success is due to plagiarized tune and one-fourth to other factors, such as the words and the popularity and stature of George Harrison in this particular field of music. I weigh the music heavily in this case because the music had already demonstrated its outstanding 'catchiness' in 1963 when it carried the rather unexceptional, romantic text of 'He's So Fine' to first place on the Billboard charts in the United States for five weeks."[51] The court ended this analysis by saying, "[g]iven all the foregoing, I conclude that $1,599,987.00 of 'My Sweet Lord's' earnings are reasonably attributable to the music of 'He's So Fine.'"[52]

• *Cream Records, Inc. v. Jos. Schlitz Brewing Company* (two cases).[53] In the district court, Judge William P. Gray, like Judge Owen who had presided over the *ABKCO Music* litigation, was also an accomplished musician. Judge Gray had presided over the *Granite Music* case and had performed relevant musical examples at the piano in the trial of the *Granite Music* case.[54] Though affirmed in *Granite Music*, Judge Gray was twice reversed and the case twice remanded in *Cream Records*.[55]

In the *Cream Records* cases, Cream Records, Inc., the copyright proprietor of "The Theme from *Shaft*" (the title song of a successful motion picture, with an Academy-award-winning score by Isaac Hayes) sued Jos. Schlitz Brewing

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51. *Id.* at 801–02.
52. *Id.* at 802. Allen B. Klein (the "ABK" in "ABKCO") was Harrison's overall business manager at the time when the claim for infringement first was asserted by Bright Tunes Music Corporation. After its managerial services were terminated and while Bright Tunes and Harrison were in the midst of settlement discussions, ABKCO made an offer to purchase Bright Tunes. Thereafter, ABKCO acquired Bright Tunes' copyright in and to "He's So Fine," as well as its rights in the litigation, thus becoming the plaintiff in the litigation. This all prompted Judge Owen to "conclude that ABKCO's intrusion into and interference with Harrison's 1975 and January 1976 settlement efforts were to the probable detriment of its former client." *Id.* at 803. The district court therefore concluded that ABKCO's and Klein's conduct (i.e., breach of fiduciary obligation) "irreparably destroyed the ability of Harrison to further negotiate a settlement in a range that Bright Tunes' lawyer had already determined to be 'good.'" *Id.* Judge Owen therefore held that ABKCO was not entitled to profit from its purchase of Bright Tunes' rights in "He's So Fine," which was essentially Bright Tunes' only asset. The judge therefore ordered that ABKCO pay to Harrison $587,000 (consisting of $422,500 paid by ABKCO to Bright Tunes and an additional $165,000 paid by ABKCO to the composer's heir) together with interest from the date of the acquisition. The court denied further relief. *See id.*
53. 754 F.2d 826 (9th Cir. 1983) and, following reversal and remand to the district court and another appeal, 864 F.2d 668 (9th Cir. 1989).
54. *See* Granite Music Corp. v. United Artists Corp., 532 F.2d 718 (9th Cir. 1976).
55. *See supra* note 53. The first reversal and remand in *Cream Records* is reported at 754 F.2d 826 (9th Cir. 1983); the second reversal (in which the profits were vacated) and the remand is reported at 864 F. 2d 668 (9th Cir. 1989).

Company and its advertising agency, Benton & Bowles, Inc. ("B&B") for infringement of "The Theme from *Shaft*" for using a ten-note *ostinato*[56] bass from the motion picture in its television commercial. B&B and Schlitz had attempted to obtain a license from Cream for the entire song. Cream quoted a license fee of $100,000, but no agreement was reached. At the trial, Cream conceded that the market value of the license for television commercials was $80,000.[57] The court ruled that the ten-note *ostinato* bass constituted 15 percent of the value of the license ($80,000), or $12,000, and awarded that amount against Schlitz. While there was testimony that use of a song in a commercial destroys its value to other advertisers for that purpose, there was no evidence that unauthorized use for the Schlitz commercials of just a portion of "The Theme from *Shaft*"—i.e., the ten-note *ostinato*—destroyed the value of the entire composition for other paid commercials.[58] The district court viewed it as its duty to apportion the profits. It concluded that the infringement was "minimal" and that "the infringing material did not add substantially to the value of the commercial."[59] Since Schlitz made a profit of $5,000,000, the court "interpolated," taking one-tenth of 1 percent of the profit, or $5,000, which, together with the 15 percent value of the license, or $12,000, came to a total award of $17,000.[60] The appellate court, while agreeing that it is the duty of the trial court to make an apportionment where an infringer's profits are not due entirely to the infringement, reversed and remanded.[61]

On remand, where the only remaining defendant was B&B, whose fee was $175,000 for producing the commercial, the district court ruled that the infringement was minimal. Thus, even though there was no evidentiary showing supporting apportionment, the trial court assumed that responsibility, and awarded 1 percent of B&B's profits to plaintiff on the ground that the amount contributed by the infringing work to the value of the commercial was *de minimis*.[62] Once again, with Circuit Judge Hall dissenting, the Ninth Circuit remanded, because, in its opinion, the use was not *de minimis* and, as a result, plaintiff was entitled to a greater portion of B&B's $175,000 producing fee.[63]

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56. An *ostinato* is a musical motif or phrase (or any clearly defined melodic or rhythmic pattern) that is repeated persistently throughout a composition or in a section. *See* Willi Apel, Harvard Dictionary of Music 634–35 (2d ed. 1972) (defining and explaining "ostinato").
57. *See* 754 F.2d at 827.
58. *See id*. at 827–28.
59. *Id*. at 828.
60. *See id*.
61. *See id*. at 828–29.
62. *See* 864 F.2d at 669.
63. *Id*. at 669–70.

• *Three Boys Music Corporation v. Bolton*.[64] This case, in which the jury found that Michael Bolton's 1991 song "Love Is a Wonderful Thing" infringed the Isley Brothers' 1964 song of the same name, is an anomaly because the court, while expressing reluctance and resignation, affirmed the jury verdict,[65] even though the panel believed it unlikely there was an infringement. The court stated that "we might not reach the same conclusion as the jury regarding access," but cautioned that "[o]ne must remember that the issue this Court must address is not whether Plaintiff has proven access by a preponderance of evidence, but whether *reasonable minds* could find that [to be the case]."[66] The court also affirmed the jury's award, finding that 28 percent of the album's profits were derived from original elements created by the defendants, Michael Bolton and his co-author, and that 66 percent of the profits were attributable to infringing elements.[67]

• *Gaste v. Kaiserman*.[68] Louis Gaste was the composer of an obscure French song, "Pour Toi," composed approximately seventeen years before Morris Kaiserman (known professionally as Morris Albert) composed and recorded the song "Feelings," which was a smash hit, winning gold record status in a number of countries. At the time of the litigation, the composition "Feelings" had grossed several hundred thousand dollars in the United States alone, while "Pour Toi" had grossed less than $15,000 in worldwide revenues. Gaste sued Kaiserman and Fermata International Melodies, Inc., Kaiserman's publisher, alleging that Kaiserman's song "Feelings" infringed "Pour Toi."[69]

At the trial, the district court instructed the jury that (1) in making an apportionment for the contribution of the lyrics to the success of *Feelings*, the deduction from profits would apply equally to Fermata and Kaiserman; and (2) only Fermata, as the publisher, was entitled to deduct its costs incurred for the commercial exploitation of *Feelings*.[70] The gross revenues were approximately $337,000 for Fermata and $265,000 for Kaiserman, respectively. Since the parties did not request a special verdict requiring the jury to specifically

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64. 212 F.3d 477 (9th Cir. 2000), *cert. denied*, 531 U.S. 1126, 121 S. Ct. 881, 148 L. Ed. 2d 790 (2001).
65. Please note that, although the determination of profits is, like its relative the accounting remedy, technically equitable in nature, one or the party may elect to have the matter determined by a jury. *See* Dairy Queen, Inc. v. Wood, 369 U.S. 469, 477–80, 82 S. Ct. 894, 899–901, 8 L. Ed. 2d 44 (1962) (a claim for money judgment by a trademark owner whether termed an "accounting" or an action for "debt" is not purely equitable, and the plaintiff was entitled to a jury trial on that issue); Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1174–75 (9th Cir. 1977) (plaintiffs, who asked for an accounting of profits, were entitled to a jury trial).
66. *Three Boys Music Corp*., 212 F.3d at 485 (emphasis in original).
67. *See id*. at 487.
68. 863 F.2d 1061 (2d Cir. 1988).
69. *See id*. at 1063.
70. *See id*. at 1069.

set forth its findings regarding the apportionment of profits, the Second Circuit panel, by quantifying the damage awards against each defendant in terms of percentages, concluded that the jury awarded Gaste approximately 80 percent of Fermata's profits and 88 percent of Kaiserman's.[71] In further extrapolating from these percentages the appellate court concluded that "it seems likely that the jury made a 12 percent reduction for both defendants to account for the lyrics and then made a further reduction of 8 percent for Fermata to account for its costs."[72] As a result the jury awarded plaintiff $268,000 and $233,000 as against Fermata and Kaiserman, respectively. In its judgment, the district court also (1) reduced the award against Kaiserman to $135,140 after excluding royalties earned from foreign performances; and (2) issued a permanent injunction against further infringement by defendants.[73] The judgment was affirmed on appeal.

II. The Apportionment Expert

Given the discretion available to apportionment experts, as reflected, in part, by the cases discussed above, the task of choosing the right expert is one of paramount importance for both parties. That is a choice to be made only after a meticulous selection process devoted to the qualifications of candidates, as discussed in the following paragraphs.

A. Selecting the Expert(s)

Locating and retaining the services of an apportionment expert is among the most important tasks for the lawyer in a copyright infringement case. The realization and exploitation of virtually all musical works requires collaboration among a number of talents (e.g., the composer, performing musicians, arrangers, recording technicians, etc.) to read and understand a page of printed symbols, notes or pitches and, through performance, make those notes come alive for the enjoyment of the public. The composer, unlike the literary writer or pictorial artist, must always trust recreative artists for his or her work to be fully perceived and absorbed by the lay listener, no matter what genre the music inhabits. As the philosopher Schopenhauer famously observed, music is the only art form that is the manifestation of the thing itself. An apportionment expert must, therefore, bring a combination of talents

71. *See id.*
72. *Id.*
73. *See id.* at 1063.

to the task in order to apportion those elements constituting a complete and performable collaborative work. In evaluating potential apportionment experts, it may be necessary, given the facts and circumstances of each case, to retain more than one expert. Among those possessing the necessary credentials, the following are often the subject of consideration in music infringement litigation:

1. The Industry Professional

This term does not include composers and performing musicians but, rather, those who are engaged on a day-to-day basis in the music business. They encompass all those from sales persons to the occupants of executive suites. Included are those who create marketing strategies for recorded product, and veterans who have their fingers on the pulse of the market and know what is hot and what is not and, more importantly, not only what recordings the public will buy *today*, but also, what the next wave will bring tomorrow—whether in the form of a hot bestselling single, or a rising superstar performer. These are the people, each in their own way, who help chart the future by promoting music that will drive sales in a very competitive marketplace.

2. The Pollster

These experts and the firms they work for conduct surveys to measure consumer confusion in trademark infringement and related types of litigation and public opinion and marketing surveys used in other litigation and non-litigation situations. Those involved in this field are credentialed from bachelor's degrees through doctorates, and many of them belong to the Council of American Survey Research Organization, which has a Survey Research Quality and Standards and Ethics Committee, as well as the American Association of Public Opinion Research and the Roper Center for Public Opinion Research, both of which also maintain professional standards for surveys.

An example of the activities the pollster might pursue to assist in apportioning damages might involve the following scenario: A songwriter files a copyright infringement action against a record company, the recording artist, and composer of a popular song that has been in the top five on the Billboard charts for six months. The plaintiff claims that all of the revenue realized from the infringing work resulted from the defendant's illicit copying and that that revenue includes not only gross income from the sales of singles and CDs, but also all revenues received by the artist, promoters, and venues at which the artist appeared over a period of eighteen months. The pollster is hired by the defendants and, after consultation with colleagues, determines that the correct approach is to conduct surveys at fifteen shopping malls in different cities

in the United States with two or three basic questions directed towards determining why consumers purchased the CD on which defendant's hit song was the first cut. Such questions logically ask the reasons the consumer purchased the CD. Depending upon the result, and assuming the questions will pass muster before the court, the survey provides a compelling result: 80 percent of those surveyed bought the record because of the artist's "star power" and for the song's "hook."[74]

3. The Disc Jockey ("DJ")

Disc jockeys work at the approximately 1,500 pop radio stations in the United States. In that capacity, DJs are provided with dozens, and even hundreds, of recordings every year that record labels desire to have played over the radio to promote new recordings and new artists as part of their marketing plans to create hit singles and CDs. As a result, disc jockeys listen, discuss, and become an integral part of the marketing plans strategically created by the record companies. They are in a unique position to gauge what makes a hit recording based on the requests and responses of the listening audiences.

4. The Consumer Psychologist

This discipline deals with marketing, consumer behavior, advertising, and the survey sciences. The consumer psychologist assists companies in gathering and interpreting marketing and consumer information relating to business decisions confronting those companies.

5. The Academic

These individuals teach many of those in the foregoing categories, with the probable exception of the DJs. They also may have been used as consultants to businesses and government. Depending upon the assignment, they may be particularly valuable as potential experts—among other things, they have the advantage of appearing impartial. However, they may not have the same knowledge of the market as industry professionals.

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74. The "hook" is what makes the song particularly appealing to the listener. It is usually a part of a song that is repeated, that contains memorable melody, rhythm or lyric, and that stays in the listener's mind. For those who listen to pop music, the refrain Stevie Wonder sings—"I just called to say I love you"—is the "hook" you cannot get out of your mind after hearing it. For the classical buff, the Schubert *Lied, Die Post*, with the constant reminder at the end of each verse "*mein herz, mein herz*" ("my heart, my heart"), may be the ultimate hook for the lovesick. But perhaps the most ubiquitous "hook" appears not in a song, but in Beethoven's Fifth Symphony: the famous three dots and a dash are repeated dozens of times.

In apportioning profits between an infringed work and original material created or added to the music by those accused of illegal copying—whether pop, rock, rap, jazz, rhythm-and-blues, or other pop genres—the party charged with copying will be best served by an expert who is an industry professional and makes decisions on a regular basis where millions of dollars and careers (perhaps even his own) might be in jeopardy if he makes the wrong decision. These are the industry professionals whose knowledge of the music business has been acquired in the trenches and refined in the executive suites of record companies, talent agencies, music lawyers, and personal management companies who either record and distribute recordings or act as representatives of performers, musicians, and composers. Although professors of marketing, consumer psychologists, market surveyors, and damages experts may be called to provide apportionment opinions, probably the best and most effective advice—and, if required, testimony—will be provided by those who truly know the market, how it works, who is hot, who is not and where public taste is currently focused and is headed. The foregoing conclusion is not intended to exclude the other categories of experts who play important roles as consultants and witnesses either to corroborate opinions of the industry professional or, given the circumstance of the matter at issue, to provide information that supplements the industry professional's findings and opinions.

B. Suggested Criteria For Apportionment of Profits[75]

1. The Value of the Infringed Work

Is the infringed work a "classic" such as "Michelle" and "In My Life" by Lennon and McCartney?

Is it an older "classic" or "standard," such as those by George Gershwin, Irving Berlin, and Cole Porter?

At the time of the infringement, was the infringed work a bestselling single and/or a "cut" on a CD album? If so, in the case of a bestselling CD album, what was its placement on the CD—first, last, or in some other position?

Was the infringed work a prominent part of the music score for a theatrical motion picture? If so, was it the title song played or sung over the opening credits? The end credits? Elsewhere during the motion picture? More than once during the motion picture?

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75. These criteria, although stated in terms applicable (in whole or in part) to pop music, apply to so-called "classical" music as well. For example, in contemporary classical (or "new") music, a composer such as John Adams, who has had entire festivals devoted to his music, might be entitled to higher commercial value than that of an equally accomplished creator whose music commands a smaller audience.

Did the work that was used in a motion picture or television show have a second life as a single or part of a bestselling album cut?

Is the infringed work a bestseller in a defined ethnic or urban market, such as, for example, the Latin or hip hop/rap cultures?

2. Persona and Star Power

This includes the following:

The contribution of the "look" to the artist's persona—whether sexy, crazy, elegant, beautiful, thuggish, etc.—which, if successful, sells recordings and generates sold out audiences at concerts;

The accomplishments of the recording artist(s), including, for example, the following: star status with devoted fan base; awards such as gold or platinum records signifying the sale of records in hundreds of thousands, one million, etc.; star appearances at first-class venues; successful tours; and personal appearances on television and in person to promote the artist, the latest single and CD;

Photo and video shoots for the single and album CD that create a new image; and

Airplay by disc jockeys that contributes to star image and is tied closely to the project or activity being "sold."

3. Customer Awareness

In raising the level of consumer awareness about a new song, a recording artist, or a superstar producer, for example, the music industry's list of activities can be as extensive as creative minds can make it. Among those promotional devices employed with frequency are the following:

Extensive play of a single on video channels, such as MTV, VH1, or BET, to generate buzz and drive the sale of the CD album, which will include the "hit single" and other "album cuts";

Handouts on the street, in malls, and other public locations, hyping the single and the CD album;

Doorhangers promoting the project;

Use of a *chyron*, which is a written graphic, appearing on the lower-left side of the music video containing information about the artist, the song, the label, the record producer, etc.;

Music videos that present a staged performance of a new song performed by the artist. Most music videos appearing on MTV, BET or VH1 are fanciful and sometimes bizarre; some, such as Michael Jackson's *Thriller*, directed by John Landis, have become classics;

The recording of the hit single is promoted so that airplay will be extensive (and sometimes seemingly endless), copies of which will be given to radio disc jockeys across the country, retail stores (e.g., a clothing store where the hit single is played in the background), press and media outlets, etc.;

Extensive television advertising;

A producer with star status, because, where the producer of the single or album also has star status (e.g., Dr. Dre), exploiting his participation to the fullest extent will help sell the recording and will contribute to the likelihood that the single will become a hit; some works have been more successful because they were associated with a producer who had status;

Print advertising;

Personal appearances, in which the artist performs album cuts, including the single, picked to drive sales of the album;

Advertising on the Internet; and

The "Streets." This term applies in particular to hip hop and rap music. In addition to traditional radio DJs, included in the creation of "buzz" are clubs, college radio mixes, urban mixes, cross-over mixes, and record pools.[76]

4. Awards and Award Shows

"Grammys," "People's Choice," "MTV," "Billboard" nominations and other televised award shows create invaluable publicity and impetus in increasing an artist's stature, which translates into dollars, pounds, marks, euros, and other currencies.

5. Value Attributed to Place or Position of Songs Appearing on CD Albums

If it is the first cut, does it set the tone for the entire album, and, as a result become the driving force in selling the album?

If it is the last cut, does that leave a lasting impression and, therefore, have substantial value in selling the album?

Other album cuts—what value do they have? What cuts are before or after the song at issue?

What is the value of a "hit sticker" on a CD jewel case showcasing the "hit" or lead single?

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76. "Mixes" were originated by club DJs in the 1970s. The term "mix" describes a technique for sequencing and mixing together recordings of different songs so that one runs and blends into another resulting in a constant stream of music. The popularity of mixes and the cult status and influence attained by some of the DJs who had created them lead the record labels to begin releasing mix album CDs in the 1990s. "Record pools" are associations formed by DJs whose members are provided with newly recorded pop music to play in clubs, over radio stations, and other outlets to create "buzz" (i.e., excitement, enthusiasm).

C. Working with the Expert

In working with the expert, essentially the same steps and cautions as those discussed in the preceding chapter on musicological experts (with some added thoughts) should be followed and observed. They bear repeating here, albeit in condensed form:[77]

1. Steps in Selecting the Expert

Check all sources for background information about the expert, so that he or she will meet the standards mandated in the *Daubert/Kumho/Joiner* trilogy of cases.[78]

Obtain all documents filed with the courts where the expert has been designated as a witness, together with biographical information from the expert and other sources.

Consider carefully whether the expert(s) should be chosen from the ranks of industry professionals, pollsters, disc jockeys, consumer psychologists, or academics.

2. Initial and Follow-Up Contacts with the Expert

In the lawyer's first contact with the expert, the lawyer should not reveal the client he or she is representing either by name or by a plaintiff or defendant designation. In that way, the expert, if hired, is cloaked with seeming impartiality.

Relevant materials should be sent to the expert for his review and comment.

As noted in Chapter 5, the expert should be cautioned to communicate his initial findings by telephone to counsel for the party retaining his or her services. If a problem is identified by the expert, the steps taken to solve it and the considerations regarding the hiring of another expert, both as outlined in Chapter 5, should be followed.

If the initial report of the expert does not raise issues as to the merits of the claim or defense, then the report should be reduced to writing and sent to counsel. The expert, if otherwise the right person for the assignment, may now be designated as an expert witness at such time as required by the court.

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77. *See*, *supra*, Chapter 5, Section III.

78. *See* Kumho Tire Company, Ltd. v. Carmichael, 526 U.S. 137, 119 S. Ct. 1167, 143 L. Ed. 2d 238 (1999); General Electric Company v. Joiner, 522 U.S. 136, 118 S. Ct. 512, 139 L. Ed. 2d 508 (1997); Daubert v. Merrill Dow Pharmaceuticals, Inc., 509 U.S. 579, 113 S. Ct. 2786, 125 L. Ed. 2d 469 (1993).

If more than one expert is designated as a witness, determine the areas for which each will be primarily responsible to maximize the strengths of each and to avoid presenting repetitious and cumulative testimony.

III. Final Thoughts: Apportionment and the Tolerance of Imperfection

A review of the reported authorities makes it clear that exactitude in apportioning profits, although desirable, is seldom achievable. For example, in *Sheldon v. Metro-Goldwyn Pictures Corporation* (discussed in Section I.A.), the *correct* result need not have been 20 percent of profits (as apportioned by the lower courts and affirmed by the Second Circuit and the Supreme Court), but, rather, one within a tolerable margin of subjective judgment, and as such, could have been 17 percent, 22 percent or 25 percent.[79] The most pointed guideline originated with Judge Hand when he gave plaintiffs a preferred status by cautioning that, in apportioning profits the courts and juries should make an award "which by no possibility shall be too small. . . . [and] which will favor the plaintiffs in every reasonable chance of error."[80] Thus, in the *Hallelujah Hollywood* case, the court held that the allocation of profits was so patently incorrect that it was not a "fair approximation." [81]

The message should be clear: In selecting an expert, counsel should choose one whose approach avoids extreme positions and whose testimony will create the perception of equity and fairness. Otherwise, the margin for error allotted for the exercise of judgment in making sustainable allocations may be exceeded, resulting in reversal on appeal.

79. *See Sheldon*, 309 U.S. 390, 398, 408–09, 60 S. Ct. 681, 683, 688; *Sheldon*, 106 F.2d 45, 51.
80. *Sheldon*, 106 F.2d at 51.
81. Frank Music Corp v. Metro-Goldwyn-Mayer, Inc., 772 F.2d 505, 518 (9th Cir. 1985).

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CHAPTER
7

Fair Use—Part One

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Although the courts have considered and ruled upon the fair use doctrine over and over again, no real definition of the concept has ever emerged. Indeed, since the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts.

. . .

The bill endorses the purpose and general scope of the judicial doctrine of fair use, but there is no disposition to freeze the doctrine in the statute, especially during a period of rapid technological change. Beyond a very broad statutory explanation of what fair use is and some of the criteria applicable to it, the courts must be free to adapt the doctrine to particular situations on a case-by-case basis.

House of Representatives Report on 1976 Copyright Act[1]

I. Fair Use: Background and Heritage

As we have learned, the birth of copyright in England gave rise to a struggle in the courts to balance (1) the goals of rewarding creators with a limited monopoly over their works and (2) the needs of society to have all ideas, concepts, and factual information available to the public and to future authors, visual artists, and composers. The tensions between these two competing ideals in eighteenth- and early nineteenth-century England foreshadow the methods and extent of copyright protection for the creative arts and define the issues that continue to evolve to the present time.

Before its codification, the doctrine of fair use was rooted in beliefs and principles to which the courts, in developing the law, provided a balance between copyright protection of original works embodying the creative efforts of authors, artists, and composers, on the one hand, and the rights of others to use portions of the copyrighted works without permission from, or compensation to, the copyright holder, on the other hand. Thus, like the *idea/expression dichotomy*, the doctrine of fair use also has a constitutional dimension: A reference to a copyrighted work is necessary and in fact dependent upon the growth and dissemination of knowledge. Such growth would be thwarted without the freedom to analyze, criticize, and comment upon the works of others whether from literature, music or the visual and audiovisual arts.

1. H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 65–66 (1976).

By focusing on the growth of copyright protection, we are also provided with a snapshot of the process by which, through analogy and expansion of existing legal principles, the law as an ever-changing organism responds to meet the challenges of new and different times. Just as musicians and early physicists experimented with the tempered scale of twelve pitches (or tones) in the space of an octave, the courts built a structure to address and resolve copyright issues raised by an art form that communicates the most abstract of ideas through the medium of a nonverbal language.

In rendering judgment for the plaintiff in 1835, the Court of Chancery in *D'Almaine v. Boosey*[2] issued an opinion that could have served as a guide to the doctrine of fair use for copyright lawyers and judges in the twentieth and twenty-first centuries. In *D'Almaine*, one of the defendants, Boosey, had published sets of quadrilles and waltzes in arrangements made of plaintiff/composer's opera by Phillipe Musard, a French composer and conductor who also made dance arrangements from the works of other composers, including Beethoven.[3] In their argument to the court, Messrs. Beames and Wood (attorneys for the defendant in a losing cause) sound like a prequel to the U.S. Supreme Court's opinion in the *2 Live Crew* case.[4] Defense counsel in *D'Almaine* argued that their client's dance arrangements of the plaintiff's original work did not constitute a violation of plaintiffs' rights because "the defendant's work does not pretend to compete with the elaborate work of the plaintiffs. Their publication is intended for the higher purposes of music, while that of the defendant is adapted entirely and exclusively for dancing."[5]

In other words, the barristers were contending that the metamorphosis of plaintiff's copyrighted work from opera to dance was what is now termed a fair use, because the dance arrangements were transformative and did not supersede the market for the plaintiff's opera.[6] The Court of Chancery did not buy it, and instead issued an injunction in favor of plaintiff and ordered an accounting of proceeds from the sale of the arrangements of the pirated music. This was obviously the correct result at the time and gratifying for the plaintiff. It is the court's written opinion, however, which with modernized language and the benefit of current copyright terminology, could have been written in the late twentieth century and the first years of the twenty-first. We find a combination of logic and invention in the court's formulation for testing the limits of copyright protection and the analytical tools and methods by

2. 1 Y. & C. Ex. 288; 160 Eng. Rep. 117 (1835).
3. In the early nineteenth century, it was a popular practice to arrange selections of larger works in the form of dances.
4. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).
5. *D'Almaine*, 1 Y. & C. Ex. at 296; 302 Eng. Rep. at 121.
6. *See, infra*, Chapter 8 *Fair Use and Musical Parody*.

which the boundaries are drawn between the protectable and the unprotectable.[7] That methodology remains a part of judicial process in the United States, having been nurtured by Supreme Court Justice Joseph Story, among others.

In America, Joseph Story was the first great expositor of copyright law, having studied and absorbed the work of Justices Mansfield and Eldon in the sparse collection of English reports available at that time in the United States. At the age of thirty-two he was appointed to the United States Supreme Court. Because of his outspoken views on constitutional law and his opposition to slavery, President Andrew Jackson referred to him as "the most dangerous man in America" and refused to appoint him as Chief Justice of the Court. Between 1839 and 1845 he ruled on copyright claims involving the same problems faced by the English jurists, reinterpreting and recasting those early rulings in the language and spirit of a modern society. His contributions to copyright law are found, not only in his published opinions, but also in his treatise *Commentaries on Equity Jurisprudence*. Although most of his writings involve non-music infringements, by analogy they apply equally to the musical art. In addition to his restatements of the copyright principles developed by the English courts, Story, as a progenitor of the doctrine of fair use, justified such takings of original works as privileged or as excused appropriation based upon the following factors:

In *Gray v. Russell*,[8] Circuit Justice Story explained that "if large extracts are made [from a copyrighted work] in a review, it might be a question, whether those extracts were designed bona fide for the mere purpose of criticism, or were designed to supersede the original work under the pretence of a review, by giving its substance in a fugitive form."[9]

In *Folsom v. Marsh*,[10] Justice Story, stating the elements and aims of fair use, advises us that "no one can doubt that a reviewer may fairly cite largely from the original work, if his design be . . . for the purposes of . . . criticism. On the other hand, it is as clear, that if he thus [quotes] the most important parts of the work, with a view, not to criticise [sic], but to supersede the use of

7. The official report of the decision in *D'Almaine* also gives us an early glimpse of what would later become a fixture in copyright disputes over musical composition: the forensic musicologist, who is described by the court as a "Mr. Rodwell, an experienced musician," whose affidavit was submitted to the court by plaintiff. *See D'Almaine*, 1 Y. & C. Ex. at 290; 302 Eng. Rep. at 118. Mr. Rodwell's opinions contain the raw material that lawyers and the courts in the United States later refined and incorporated into copyright law. When he opined that "the second quadrille was so completely similar to an air of the opera called 'Gentile Muscovite,' [and similar opinions regarding other themes from plaintiffs' opera]," *id*., he was looking toward a future that would hold liable literary and music pirates who copied and exploited the protected expression of others.
8. 10 F. Cas. 1035 (C.C. Mass. 1839) (No. 5728).
9. *Id*. at 1038.
10. 9 F. Cas. 342 (C.C. Mass. 1841) (No. 4901).

the original work, . . . such a use will be deemed in law a piracy."[11] He further expanded and clarified the doctrine of fair use by noting the importance of "the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work."[12]

If we assume for the moment that Justice Story's opinions in *Folsom v. Marsh* and *Gray v. Russell* were protected by copyright, by quoting them in these pages, we have demonstrated the need for this indisputable doctrine: We have quoted Story's words to the extent necessary to accomplish the following: (1) to further our knowledge of the copyright law with particular reference to fair use; while (2) transforming the quotation as one for educational purposes (as distinguished from its use in making a decision in writing an opinion); and (3) using only so much of Story's work so as not to supersede the market for the original.[13]

These concise statements by Justice Story look both backward in time to an argument made before the Court of Chancery by two English barristers in 1835[14] and forward to the 1976 Copyright Act which sets forth the following factors to determine whether alleged copying constitutes a fair use:

1. "[T]he purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit-educational purposes;"
2. "[T]he nature of the copyright work;"
3. "[T]he amount and substantiality of the portion used in relation to the copyrighted work as a whole; and"
4. "[T]he effect of the use upon the potential market for or value of the copyrighted work."[15]

Though now codified in Section 107 of the Copyright Act, fair use remains a creature of the common law and of common sense, fashioned by judges in England and the United States over a period of 268 years before the 1976 Act became effective on January 1, 1978.[16] That tradition of judge-made copyright law will continue, because, even though the incarnation of the law found in

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11. *Id.* at 344–45.
12. *Id.* at 348.
13. An ironic incident regarding Justice Story's restatement of fair use manifested itself within two years after his death in 1845. In a case brought by the executors of Justice Story's estate, Story v. Holcombe, 23 F. Cas. 171 (C.C. Ohio 1847) (No. 13497), Circuit Justice McLean held that an abridgment of Story's treatise *Commentaries on Equity Jurisprudence* was in substantial part a "fair use" and thus noninfringing. The late Justice Story probably would have joined in that holding without any reservations.
14. *See, supra*, notes 5–7 & accompanying text.
15. 17 U.S.C. § 107.
16. *See, supra*, Chapter 1, *Copyright Law: An Overview*.

the 1909 and 1976 Copyright Acts presents a statutory regime encompassing substantive and procedural law, it is stated in conclusory language leaving it to the federal courts to continue explication of copyright principles through the judicial process.[17] For example, Section 107 does not define "fair use" but simply states that it is not an infringement.[18]

After its codification in 1976, it is through this process that the doctrine of fair use began a twenty-year odyssey during which certain of its core principles were eroded, beginning with the *Betamax* case[19] continuing through *Harper & Row Publishers, Inc. v. Nation Enterprises*[20] in the Supreme Court and Federal Courts of Appeal for twenty years until the Supreme Court reinstated the law of fair use, giving due importance to each of the four factors earmarked in the statute. In the *2 Live Crew* case, the Supreme Court restored the original precepts of the fair use doctrine (1) to provide the author with the requisite protection for his work, while (2) leaving others free to quote from the author's words for the advancement of knowledge and the dissemination of ideas.[21]

II. *Sony Corporation of America v. Universal City Studios, Inc.*:[22] The Commercial Purpose Detour[23]

A. New Technology: The *Betamax* Recorder

The Supreme Court decision in *Sony* (often referred to as the "*Betamax* case") reflects another of those times in history when the courts must contend with the impact of new technology on the law—in this case copyright law in general,

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17. To put an exclamation point on its derivation, the reports on Section 107 of the House and the Senate cautioned that: "Section 107 is intended to restate the present *judicial doctrine* of fair use, not to change, narrow, or enlarge it in any way." H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 66 (1976); S. Rep. No. 94-473, at 62 (1975) (emphasis added).
18. *See* 17 U.S.C. § 107 ("[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . ., scholarship, or research, is not an infringement of copyright.").
19. *See* Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984).
20. *See* 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985).
21. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).
22. 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984).
23. In addition to a careful reading of the *Betamax* case and the other cases discussed in this chapter, the author recommends reading the Nimmer lecture given by the Honorable Pierre N. Leval, as adapted to essay form from the Melville B. Nimmer Memorial lecture delivered at U.C.L.A.'s law school on February 24, 1997, Pierre N. Leval, *Nimmer Lecture: Fair Use Rescued*,

and the doctrine of fair use in particular. The technology at the center of this litigation was the videotape recorder ("VTR"), the Betamax, manufactured by defendant Sony and commercially exploited by its co-defendants. It enabled the consumer to videotape copyrighted television product off the air for later private viewing (a practice referred to as "time-shifting") and potentially also for library purposes (i.e., to keep the tape copy for as long as the television viewer/recorder desired repeat viewings). In the *Betamax* case, plaintiff Universal sought to enjoin production of Sony's Betamax VTR, which consisted of three basic components: "(1) a tuner, which receives electromagnetic signals transmitted over the television band of the public airwaves and separates them into audio and visual signals; (2) a recorder, which records such signals on a magnetic tape; and (3) an adapter, which converts the audio and visual signals on the tape into a composite signal that can be received by a television set."[24]

The Betamax also provided the following advantages: (1) it was capable of permitting the viewer to watch one program live, while recording another being broadcast simultaneously on another channel for later viewing ("time-shifting"); (2) after having been recorded, tapes could be erased, either before or after viewing them; (3) tapes could be reused; (4) a timer could be used to activate and de-activate the equipment at predetermined times, enabling the Betamax user to record programs broadcast when he or she was not at home; and (5) the Betamax, since it was equipped with a pause button and fast-forward control, could be used to omit commercials from the recording, a feature that could be activated only when the viewer was present as the program was being recorded.[25]

B. The District Court's Findings

In the bench trial Judge Ferguson, in formal findings, denied all relief requested by plaintiffs and entered judgment for Sony and its codefendants.[26] The Ninth Circuit Court of Appeals reversed the district court's judgment, holding that the Sony defendants were liable for contributory infringement, and remanded to the district court to fashion appropriate relief.[27] The Supreme Court summed up the district court's conclusions that: (1) non-commercial recording for home viewing was a fair use, and therefore did not constitute copyright infringement; (2) the purpose of the use was "'consistent with the

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44 UCLA L. Rev. 1449 (1997). The author is indebted to Judge Leval for his illuminating analysis of insights to the doctrine of fair use.

24. 464 U.S. at 422, 104 S. Ct. at 778.
25. *See id*. at 422–23, 104 S. Ct. at 778–79.
26. *See* Universal Studios, Inc. v. Sony Corp. of Am., 480 F. Supp. 429 (C.D. Cal. 1979). Judge Ferguson was later elevated to the Ninth Circuit Court of Appeals.
27. *See* 464 U.S. at 427–28, 104 S. Ct. at 781–82.

First Amendment policy of providing the fullest possible access to information through the public airways'" . . . [and] "[e]ven when an entire copyrighted work was recorded, . . . [it was still a] fair use 'because there is no accompanying reduction in the market for 'plaintiff's original work.'"[28] The district court also held that, even though some of the uses of the Betamax VTR were capable of infringing uses, they were a "staple article of commerce" capable of noninfringing uses to record noncopyrighted material and material whose owners consented to copying of their works.[29] In particular, the Supreme Court also noted that many copyright proprietors (that is, those other than the plaintiffs) did not object to recording of their copyrighted materials and, further, that its use even expanded the potential audience for television viewing of other copyrighted works.[30]

C. Recording For Later Viewing: The Core Issues

1. Time-Shifting For Private Home Use

The Supreme Court framed the issue that had been before the district court when it succinctly stated that "[t]he lengthy trial of the case in the District Court concerned the private, home use of VTRs for recording programs broadcast on the public airwaves without charge to the viewer. No issue concerning the transfer of tapes to other persons, the use of home-recorded tapes for public performances, or the copying of programs transmitted on pay or cable television systems was raised."[31]

2. Contributory Infringement

The other core issue was whether VTRs manufactured by Sony Corporation, enabling consumers to videotape copyrighted television programs, subjected Sony, as manufacturer of the Betamax VTR and others involved in its commercial exploitation, to liability as contributory infringers. The Supreme Court held that Sony, *et al.*, as the manufacturer, and its distributors and sellers of the VTR, were not contributory infringers, a decision supported by (1) application of the fair use defense, and (2) the limitation of copyright owners' "exclusive domain" to use or authorize others to use his or her copyrighted work in the ways provided in Section 106 of the Copyright Act,[32] and

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28. 464 U.S. at 425–26, 104 S. Ct. at 780 (quoting Universal Studios, Inc. v. Sony Corp. of Am., 480 F. Supp. 429, 454 (C.D. Cal. 1979)).
29. 480 F. Supp. at 461.
30. *See, e.g.*, 464 U.S. at 445–46, 104 S. Ct. at 790–91.
31. 464 U.S. at 424, 104 S. Ct. at 780.
32. *See* 17 U.S.C. § 106.

(3) the limitations, self- or otherwise, imposed on courts to assume a legislative function expanding specific rights enumerated by Congress in a statute.

D. The Importance Of The Procedural Posture On Appeal

The procedural posture in this case is of more than casual importance because the parties' dispute was decided in a trial—and a lengthy one at that (five weeks)—in which many exhibits were admitted in evidence and a substantial number of witnesses (including experts) testified. This comment is not merely for the purpose of reciting procedural history, but also to make clear that, unlike motions to dismiss for failure to state a claim (pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure) or for summary judgment (pursuant to Rule 56 of the Federal Rules), where live witnesses are either not permitted (Rule 12(b)(6)) or are not the norm (Rule 56), witnesses were examined and cross-examined, objections to questions and to the admissibility of documents were ruled on, and the weight of that evidence and the credibility of witnesses were carefully evaluated by a well-qualified federal judge after a full hearing.

E. The Fair Use Factors

1. The First Factor: The Purpose and Character of the Use

Unfortunately, the Court, without precedent and without the need to do so in the controversy before it, emphasized the first fair use factor: "[i]f the Betamax were used to make copies for a commercial or profit-making purpose, *such use will presumptively be unfair*."[33] The Court went on to state that "[t]he contrary presumption is appropriate here, however, because the District Court's findings plainly establish that *time-shifting for private home use must be characterized as a noncommercial, nonprofit activity*."[34]

The Court also criticized the appellate court's methodology in its holding that the recording of a television program for a delayed single viewing by a private individual was not a private use, on the ground that the copying was not "productive" (or in an updated word "transformative") because the recording added nothing new to the time-shifted program. In reversing the Ninth Circuit, the Supreme Court observed that "[t]he Court of Appeals chose not to engage in any 'equitable rule of reason' analysis in this case. Instead, it assumed that the category of 'fair use' is rigidly circumscribed by a requirement that every such use must be 'productive.' It therefore concluded that

33. 464 U.S. at 449, 104 S. Ct. at 792 (emphasis added).
34. *Id.* (emphasis added).

copying a television program merely to enable the viewer to receive information or entertainment that he would otherwise miss because of a personal scheduling conflict could never be fair use. That understanding of 'fair use' was erroneous."[35]

2. The Second Factor: The Nature Of The Copyrighted Work

In its analysis of this factor, the Supreme Court gave it little weight on its own, but instead linked it with the third factor when Justice Stevens, writing for the Court, observed that "when one considers the nature of a televised, copyrighted, audiovisual work, see 17 U.S.C. § 107(2), and that timeshifting merely enables a viewer to see such a work which he had been invited to witness in its entirety free of charge, the fact that the entire work is reproduced, see *id*., at § 107(3), does not have its ordinary effect of militating against a finding of fair use."[36]

The Court was concerned with a *creative* (not a factual or nonfiction) work, which ordinarily would militate against a finding of fair use. The justices, however, all but ignored this factor by linking it with the third factor to edge it into the fair use camp, the effect of which was to make it virtually disappear. In effect, the "nature of the work" became a "nonfactor."

3. The Third Factor: The Amount and Substantiality of the Portion Used In Relation to the Copyrighted Work As a Whole

The Court advises us, as mentioned above, that, because time-shifting allows the viewer to see a work that the viewer had been invited to see in its entirety free of charge, "the fact that the entire work is reproduced . . . does not have its ordinary effect of militating against a finding of fair use."[37]

4. The Fourth Factor: The Effect of the Use Upon the Potential Market for or Value of the Copyrighted Work

As for the fourth factor of the fair-use analysis—the effect of the use upon a potential market for or a value of the copyrighted work—"a use that has no demonstrable effect upon the potential market for, or the value of, the copyrighted work need not be prohibited in order to protect the author's incentive to create."[38] The Court held that the plaintiffs failed to carry their burden of

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35. *Id*. at 455 n.40, 104 S. Ct. at 795 n.40.
36. *Id*. at 449–50, 104 S. Ct. at 792.
37. *Id*. (citation omitted).
38. *Id*. at 450, 104 S. Ct. at 793.

proof regarding the effect of home time-shifting.[39] The Court explained that "[a] challenge to a noncommercial use of a copyrighted work requires proof either that the particular use is harmful, or that it should become widespread, it would adversely affect the potential market for the copyrighted work. . . . If the intended use is for commercial gain, [the] likelihood [of future harm] may be presumed. But if it is for a noncommercial purpose, the likelihood must be demonstrated."[40]

In creating this commercial use presumption, the Court started the judiciary and copyright lawyers on a journey through this and another disruptive detour, that of engrafting the unpublished status of President Ford's memoirs as an ingredient of the second factor ("the nature of the copyrighted work").[41] These pronouncements from our highest source of judicial authority trickled down to, and were perpetuated by, the lower courts until the Supreme Court in *Campbell v. Acuff-Rose Music, Inc.*[42] restored core principles to the doctrine of fair use.

Before reaching that point of correction and restoration, a brief review of the frustrations experienced by President Ford and his publisher, Harper & Row, will enhance our understanding of fair use as now restored.

III. *Harper & Row Publishers, Inc. v. Nation Enterprises:*[43] The Unpublished Work Detour

Gerald R. Ford succeeded to the presidency at a time of political upheaval, which precipitated a Constitutional crisis in the United States of America. Unlike a situation when a President dies and is replaced by the Vice President, Ford's accession to the nation's highest office was a first in American history, as the only time the Speaker of the House of Representatives became President. Nixon's resignation in the wake of the Watergate scandal occurred less than a year after the elected Vice President, Spiro Agnew, had also been forced to resign in disgrace because of his participation in corrupt practices when he was Governor of Maryland.

When President Ford announced that "[o]ur long national nightmare is over,"[44] public sentiment was with him because he was, in the vernacular,

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39. *See id*. at 451, 104 S. Ct. at 793.
40. *Id*.
41. *See* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985).
42. 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).
43. 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985).
44. The Oxford Dictionary of Quotations 328 (Elizabeth Knowles ed., 6th ed. 2004) (quoting President Gerald R. Ford, Inaugural Address (August 9, 1974)). Upon being sworn in as

"a nice guy" and was not involved or otherwise associated with Watergate. But when he pardoned Nixon of any crimes he might have committed during his reign as President, Ford's image was tarnished, and public speculation began. Was there a "deal" between Nixon and Ford that Nixon would resign if Ford would pardon him after the latter became President? Were there other hidden agendas? Although some Nixon followers still believed in him, the prevailing public reaction was swift and highly critical of Ford. And in many circles, it is the pardon of Nixon that is the first comment made about Gerald Ford in discussion and will, in all probability, be the act for which he will be most remembered.

Although members of the public watched on TV and listened on radio as Ford announced the pardon and explained his reasons, when he wrote his memoirs, to be published by Harper & Row, the background and rationale for the Nixon pardon was one of the subjects most anticipated by readers. Pursuant to his contract with Harper & Row, Ford received a substantial advance and assigned the copyright to the publisher. Harper & Row then entered into an agreement with *Time Magazine* to publish excerpts of approximately 300 words from the Ford memoirs, including the eagerly awaited explanation of Ford's justifications for pardoning Nixon. This arrangement also provided Harper & Row with an advance payment for exclusive prepublication rights for excerpts from the memoirs. These arrangements and the expectation that the publication in *Time* would generate more interest in Ford's presidency were completely frustrated when *The Nation* obtained a bootleg copy of the memoirs and "scooped" *Time* by publishing excerpts prior to their scheduled publication in *Time*. As a result, *Time Magazine* cancelled the agreement with Harper & Row and terminated its obligation to make advance payments to the publisher. The inevitable lawsuit followed, *Time Magazine* claiming that *The Nation* infringed the copyright to the memoirs.

The district court found that *The Nation* published excerpts that were "essentially the heart of the book" and that the use was unfair.[45] The Second Circuit Court of Appeals reversed and affirmed, in part, finding the use fair.[46]

The Supreme Court reversed the Second Circuit, and, in an opinion for the Court written by Justice O'Connor, held that *The Nation* was liable for copyright infringement. *The Nation*, in its defense, argued that its publication was "newsworthy" and that the First Amendment required the scope of fair use to be "'wider when the information conveyed relates to matters of high

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the thirty-ninth President of the United States, President Ford stated: "Our long national nightmare is over. Our Constitution works; our great Republic is a Government of laws and not of men." *Id*.

45. Harper & Row Publishers, Inc. v. Nation Enters., 557 F. Supp. 1067, 1072 (S.D.N.Y. 1983).

46. *See* Harper & Row Publishers, Inc. v. Nation Enters., 723 F.2d 195 (2d Cir. 1983).

public concern.'"[47] The Court rejected this argument and observed that *The Nation* was, in effect, misusing widely accepted concepts of newsworthiness and public importance "as grounds for excusing a use that would ordinarily not pass muster as a fair use—the piracy of verbatim quotations for the purpose of 'scooping' the authorized first serialization."[48]

In its analysis, the Court observed that "'the fact that the plaintiff's work is unpublished . . . is a factor tending to negate the defense of fair use.'"[49] It also noted: "[T]he fact that the words the author has chosen to clothe his narrative may of themselves be 'newsworthy' is not an independent justification for unauthorized copying of the author's expression prior to publication."[50] To find otherwise would be to "expand fair use to effectively destroy any expectation of copyright protection in the work of a public figure."[51]

A. The Fair Use Factors:

1. The First Factor

As to the first factor, the purpose of the use, the Court agreed with the Second Circuit that "news reporting" was the "general purpose" of *The Nation*'s use of the work but found that "[t]he fact that an article arguably is 'news' . . . is simply one factor in a fair use analysis."[52] "In evaluating character and purpose we cannot ignore The Nation's stated purpose of scooping the forthcoming hardcover and [*Time* pre-publication] abstracts."[53] The "intended purpose" of the copying, the Court observed, was to supersede the copyright holder's commercially valuable first publication right.[54]

2. The Second Factor

In evaluating the second factor, the nature of the copyrighted work, the Court noted that "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy."[55] Nevertheless, the Court found that, by "focusing on the most expressive elements of the work," *The Nation*

47. 471 U.S. at 555–56, 105 S. Ct. at 2228 (citation omitted).
48. *Id.* at 556, 105 S. Ct. at 2228.
49. *Id.* at 551, 105 S. Ct. at 2226 (citation omitted).
50. *Id.* at 557, 105 S. Ct. at 2229
51. *Id.*
52. *Id.* at 561, 105 S. Ct. at 2231.
53. *Id.* at 562, 105 S. Ct. at 2231.
54. *See id.*
55. *Id.* at 563, 105 S. Ct. at 2232.

"exceed[ed] that necessary to disseminate the facts."[56] The Court found the fact that the work was unpublished to be a "critical element of its 'nature.'"[57] Observing that "[t]he right of first publication encompasses not only the choice whether to publish at all, but also the choices of when, where, and in what form first to publish a work," the Court concluded that "the scope of fair use is narrower with respect to unpublished works."[58]

3. The Third Factor

In evaluating the amount and substantiality of the portion used—the third factor—the Court examined the district court's analysis. While, "[i]n absolute terms, the words actually quoted were an insubstantial portion of [the copyrighted work,] . . . [t]he District Court . . . found that '[*The Nation*] took what was essentially the heart of the book'" and held that the use *The Nation* made of the memoirs was unfair.[59] The Second Circuit Court of Appeals reversed and affirmed in part, holding, based on its analysis of the fair use factors, that the use was fair.[60] The Supreme Court held that the Second Circuit erred in rejecting the district court's finding as to the third factor.[61] The Court acknowledged that "a taking may not be excused merely because it is insubstantial with respect to the *infringing* work."[62] Nevertheless, the fact that a "*substantial* portion of the infringing work [is] copied verbatim" is a relevant consideration in the analysis of the third factor because it "is evidence of the *qualitative* value of the copied material, both to the originator and to the plagiarist who seeks to profit from marketing someone else's copyrighted expression."[63]

4. The Fourth Factor

The Court considered the fourth factor, the effect on the market of the use, to be "undoubtedly the single most important element of fair use."[64] Noting that the trial court found "not merely a potential but an actual effect on the market," the Court observed that "[r]arely will a case of copyright infringement present such clear-cut evidence of actual damage."[65] "Placed in a broader perspective,"

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56. *Id*. at 564, 105 S. Ct. at 2232.
57. *Id*. (citations omitted).
58. *Id*.
59. *Id*. at 564–565, 105 S. Ct. at (quoting *Harper & Row Publishers, Inc*., 557 F. Supp. 1067, 1072 (S.D.N.Y. 1983)).
60. *See* Harper & Row Publishers, Inc. v. Nation Enters., 723 F.2d 195 (2d Cir. 1983).
61. *See id*. at 565, 105 S. Ct. at 2233.
62. *Id*. (emphasis in original).
63. *Id*. (emphasis added).
64. *Id*. at 566, 105 S. Ct. 2233.
65. *Id*. at 567, 105 S. Ct. at 2234.

the Court continued, "a fair use doctrine that permits extensive prepublication quotations from an unreleased manuscript without the copyright owner's consent poses substantial potential for damage to the marketability of first serialization rights in general."[66]

IV. Carrying The Torch; The Lower Courts Follow *Sony* and *Harper & Row*

A. *Salinger v. Random House, Inc.*[67]

During his productive years in the mid- to latter part of the twentieth century, J.D. Salinger, through his literary works, became one of the most read and respected writers of his time, an assessment which has not diminished. If he had written nothing else, *The Catcher in the Rye* would have been enough to secure his place as an original voice in American literature. There was, of course, much more, including *Nine Stories* and *Franny and Zooey*. But Salinger was also famous for his reclusiveness, taking extreme care to protect his privacy, while seldom venturing from his home in New Hampshire. He did, however, have close friends with whom he corresponded, and who donated his letters to the libraries of Harvard University, Princeton University, and the University of Texas, all with conditions restricting the use of the letters without permission from the libraries and Salinger.

Ian Hamilton, a writer and biographer, saw Salinger as a fascinating subject and embarked upon the task of exploring the life of Salinger and the source of his creative powers. Random House was to be the publisher of the planned book. Hamilton signed an agreement with the three university libraries to be bound by the conditions set forth in the grant. After reading the first set of galley proofs that had been provided to him, Salinger learned that the donated letters had been quoted verbatim, and he objected to their use. Hamilton and Random House then closely paraphrased the letters, but Salinger still refused to grant permission for their use and filed suit to enjoin publication for the biography. The district court denied relief, finding that the use of the letters was fair. When Salinger appealed, the Second Circuit Court of Appeals reversed and issued an injunction enjoining publication of the Salinger letters, stating that "[unpublished] works normally enjoy complete protection against copying any protected expression."[68]

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66. *Id*. at 569, 105 S. Ct. at 2235.
67. 811 F.2d 90 (2d Cir. 1987).
68. *Id*. at 97. *See also* New Era Publ'ns Int'l, ApS v. Henry Holt and Co., Inc., 873 F. 2d 576, 583 (2d Cir. 1989) (the Second Circuit, in the shorter version of its rationale in *Salinger*, stated that

B. *Acuff-Rose Music, Inc. v. Campbell*[69]

In *Acuff-Rose Music, Inc. v. Campbell*, the rap group 2 Live Crew parodied the romantic popular song, "Oh, Pretty Woman" (composed by Roy Orbison and William Dees) with its parody/adaptation, entitled "Pretty Woman." Acuff-Rose Music, Inc. ("Acuff-Rose") was, at the time of the litigation and to this day remains, a prominent publisher of popular music. In its efforts to protect its copyright against infringement, Acuff-Rose filed an action against 2 Live Crew, a rap group who performed and recorded their raunchy song "Pretty Woman." The district court saw "Pretty Woman" as a parody and found 2 Live Crew's parodied version of "Oh, Pretty Woman" to be a fair use. The Sixth Circuit Court of Appeals reversed, having received the clear message from the Supreme Court that commercial uses are "presumptively unfair"[70] and that potential harm in the market is "'the single most important'" factor of the four factors set forth in Section 107 to determine whether a use is fair or unfair.[71] Following the logic set up by these two "presumptions," the Sixth Circuit concluded that the use was unfair.

The Supreme Court's holding regarding the unpublished nature of copyrighted works was abrogated by statute in 1992 when the House of Representatives amended Section 107 to add the following:

> The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all of the above factors.[72]

The way was now clear for the Supreme Court to address the issues raised by the over-weighting of the commercial nature of the use in applying the first factor of the fair use test. That opportunity presented itself when the Court granted 2 Live Crew's Petition for a Writ of *Certiorari* to hear this appeal from the decision of the Sixth Circuit Court of Appeals.

"unpublished works normally enjoy complete protection"), *cert. denied*, 493 U.S. 1094, 110 S. Ct. 1168, 107 L. Ed. 2d 1071 (1990).

69. 972 F.2d 1429 (6th Cir. 1992).

70. 972 F.2d at 1436 (citing Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 449, 104 S. Ct. 774, 792, 78 L. Ed. 2d 574 (1984)).

71. *Id.* at 1438 (quoting Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 566, 105 S. Ct. 2218, 2233, 85 L. Ed. 2d 588 (1985)).

72. 17 U.S.C. § 107.

V. *Campbell v. Acuff-Rose Music, Inc.*:[73] The Restoration Of The Transformative/Superseding Analysis

In the *Sony* and *Harper & Row* opinions and the lock-step pattern followed by the lower courts in the wake of these Supreme Court precedents, the Supreme Court was the only judicial entity that could reinstate balance to the first factor of the fair use test, and it appropriately took the opportunity to do so in *Campbell v. Acuff-Rose Music, Inc*. As with other opinions that clarify our understanding of the law, Justice Souter, in his opinion, not only prescribed the cure for the misdirection that caused the commercial "presumption" in *Sony*, but also provided the judiciary and the copyright bar with what must be considered one of the finest copyright opinions in recent memory. Justice Souter, through patience and logic, drew the definitive road map to an understanding and application of the fair use doctrine.

In reversing the Sixth Circuit, the Supreme Court virtually gutted its holding in the *Betamax* case, when, in Justice Souter's masterful opinion, it held as follows.[74]

A. Fair Use Factors

1. First Factor

The Court found that the Sixth Circuit had erred by giving "virtually dispositive weight to the commercial nature of the parody."[75] While "the 'fact that a publication was commercial as opposed to nonprofit is a separate factor that

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73. 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).

74. In view of the extended discussion of the Court's opinion in *Campbell v. Acuff-Rose Music, Inc*. in the next chapter dealing with parody and fair use, the discussion of the case in this section will be confined to a brief review of the Court's holdings for the purpose of bringing an end to our initial review of the odyssey on which the Supreme Court embarked following the passage of the 1976 Copyright Act.

75. 510 U.S. at 584, 114 S. Ct. at 1174. The Circuit Court relied on language from *Sony Corporation of America*, as reaffirmed in *Harper & Row Publishers, Inc*., describing "commercial use" as "presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright." Acuff-Rose Music, Inc. v. Campbell, 972 F.2d 1429, 1437 (6th Cir. 1992) (quoting Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562, 105 S. Ct. 2218, 2231, 85 L. Ed. 2d 588 (1985) (quoting Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 451, 104 S. Ct. 774, 792, 78 L. Ed. 2d 574 (1984))). The Court in *Harper & Row* had previously qualified this language by observing: "The crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Harper & Row*, 471 U.S. at 562, 105 S. Ct. at 2231.

tends to weigh against a finding of fair use,'"[76] "the commercial or nonprofit educational purpose of a work is only one element of the first factor enquiry into its purpose and character."[77]

Another, perhaps more important, element in evaluating the purpose and character of use is whether it merely supersedes the original or is transformative.[78] "[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."[79] "[P]arody," the Court observed, "has an obvious claim to transformative value."[80] After discussing general definitions of parody, the Court explained that, "[f]or the purposes of copyright law, . . . and the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works."[81] While "[p]arody needs to mimic an original to make its point, and [thus] has some claim to use" the work of another, the Court rejected the proposition that "any parodic use is presumptively fair."[82] Instead, "parody, like any other use, has to work its way through the relevant factors."[83] As for the first factor, however, the important threshold question is whether "a parodic character may reasonably be perceived."[84]

2. Second Factor

The Court observed that an enquiry into the nature of the copyrighted work recognized that "some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish the former works are copied."[85] It observed that the original song in question fell close to the core of copyright's protective purpose.[86] "This fact,

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76. *Campbell*, 510 U.S. at 585, 114 S. Ct. at 1174 (quoting Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562, 105 S. Ct. 2218, 2231, 85 L. Ed. 2d 588 (1985) (explaining the proposition for which the *Sony* case stands)).
77. *Id*. at 584, 114 S. Ct. at 1174.
78. *See id*. at 579, 114 S. Ct. at 1171.
79. *Id*.
80. *Id*.
81. *Id*. at 580, 114 S. Ct. at 1172.
82. *Id*. at 580–81, 114 S. Ct. at 1172.
83. *Id*. at 581, 114 S. Ct. at 1172.
84. *Id*. at 582, 114 S. Ct. at 1173. The parodic nature of a work, of course, must still be balanced against whether and to what extent it is commercial. "The use, for example, of a copyrighted work to advertise a product, even in a parody, will be entitled to less indulgence under the first factor of the fair use enquiry than the sale of a parody for its own sake." *Id*. at 585, 114 S. Ct. at 1174.
85. *Id*. at 586, 114 S. Ct. at 1175.
86. *See id.*

however, is not . . . ever likely to help much in separating the fair use sheep from the infringing goats in a parody case, since parodies almost invariably copy publicly known, expressive works."[87]

3. Third Factor

The Sixth Circuit found that, while no more was taken from the copyrighted work than was necessary, the "'copying was qualitatively substantial.'"[88] "'[T]aking the heart of the original and making it the heart of a new work,'" the circuit court reasoned, "'was to purloin a substantial portion of the essence of the original work.'"[89] The Supreme Court rejected the premise that copying could be "excessive in relation to parodic purpose merely because the portion taken was the original's heart."[90] In fact, the Court reasoned, parody "necessarily springs from recognizable allusion to its object through distorted imitation . . . [¶] [T]he heart is . . . what most readily conjures up the song for parody, and it is the heart at which parody takes aim."[91] "[T]he question of fairness asks what else the parodist did besides go to the heart of the original."[92] In the instant case, the Court agreed with the district court that no more of the lyrics were taken than necessary, finding it "significant that 2 Live Crew not only copied the first line of the original, but thereafter departed markedly from the Orbison lyrics for its own ends."[93] It expressed no opinion as to whether the copying of the music was excessive.

4. Fourth Factor

The Court rejected the Sixth Circuit's presumption that, because 2 Live Crew's use was commercial, there was a likelihood of future harm to the copyright holder.[94] In discussing what harm the copying might cause, the Court distinguished between the effects of the song as a parody and the song as a rap derivative of the original. "[A]s to parody pure and simple, it is more likely that the new work will not affect the market for the original in a way *cognizable* under this factor, that is, by acting as a substitute for it."[95] Any harm to the market for the original that would likely be produced by a parody—harm

87. *Id.*
88. *Id.* at 587, 114 S. Ct. at 1175 (quoting Acuff-Rose Music, Inc. v. Campbell, 972 F.2d 1429, 1438 (6th Cir. 1992)).
89. *Id.* (quoting *Acuff-Rose Music, Inc.*, 972 F.2d at 1438).
90. *Id.* at 588, 114 S. Ct. at 1176.
91. *Id.*
92. *Id.* at 589, 114 S. Ct. at 1176.
93. *Id.*
94. *See id.* at 591–92, 114 S. Ct. at 1177–78.
95. *Id.* at 591, 114 S. Ct. at 1177.

the Court compared to "a scathing theater review"—is not "cognizable under the Copyright Act."[96] This distinction between "displacement" and "disparagement," the Court argued, "is reflected in the rule that there is no protectible derivative market for criticism."[97]

B. A Colleague's Comment On the Court's Holdings: Kennedy's Concurrence

Justice Kennedy wrote a concurring opinion to clarify that, in his view, the following constitutes the correct application of the fair use doctrine to parody issues:

> [P]arody may qualify as fair use regardless of whether it is published or performed for profit [and]. . . . parody may qualify as fair use only if it draws upon the original composition to make humorous or ironic commentary about that same composition. . . . It is not enough that the parody use the original in a humorous fashion . . . The parody must target the original.[98]

If the definition of parody is kept within these limits, Kennedy reasoned, "we have gone most of the way towards satisfying the four-factor fair use test in § 107."[99]

VI. Purpose and Character of the Use: Additional Thoughts on the Transformative/ Superseding Analysis and What Constitutes "Transformation"

A. Fair Use and Intrinsic Purpose of the Work Used by the Alleged Infringer

Prior to the listing of four non-exclusive factors for the determination of whether a use is fair, the introductory paragraph of Section 107 advises us that "the fair use of a copyrighted work . . . for purposes such as criticism, comment,

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96. *Id.* at 591–92, 114 S. Ct. at 1178.
97. *Id.* at 592, 114 S. Ct. at 1178.
98. *Id.* at 596–97, 114 S. Ct. at 1180 (Kennedy, J., concurring) (citations to majority opinion omitted).
99. *Id.* at 597–98, 114 S. Ct. at 1180 (Kennedy, J., concurring).

news reporting, teaching (including multiple copies for classroom use), scholarship, or research is not an infringement of copyright."[100] The Ninth Circuit in *Universal City Studios, Inc. v. Sony Corporation of America*[101] held that recording a television program for the purpose of time-shifting for private viewing was not a "productive" use because the television program was recorded without adding anything new to it.[102] Although the Supreme Court reversed the Ninth Circuit, the latter's holding focused the federal courts and counsel on what makes a use "productive" or, in the terminology used by the Supreme Court, "transformative." Specifically what constitutes something "new" added to the original? Does it mean that the work itself must be altered to transform it into something different? In reaching its holding, the Ninth Circuit relied heavily on the work of an eminent legal scholar who summed up the "transformative" issue in the following language:

> "The list, casual or studied as it may be, reflects what in fact the subject matter of fair use has in the history of its adjudication consisted in: *it has always had to do with the use by a second author of a first author's work.* Fair use has not heretofore had to do with the mere reproduction of a work in order to use it for its intrinsic purpose to make what might be called the 'ordinary' use of it. When copies are made for the work's 'ordinary' purposes, ordinary *infringement* has customarily been triggered, not notions of fair use."[103]

The Ninth Circuit then observes that "[t]he cases have, for the most part, adhered to this aspect of the fair use doctrine. If an alleged infringer has reproduced a copyrighted work to use it for its intrinsic purpose, fair use has not generally been applied."[104] Among the issues raised by the reference to the first work's "intrinsic purpose"—to make "ordinary use of it"—include the following: Does a transformative use require that the first work itself be edited, supplemented with new material or otherwise altered by distortion or otherwise to bring the second work within the protective ambit of fair use? Or, can the use of the copied work be legitimately considered for fair use treatment if the work itself is not altered but is placed in a different context without editing, supplementation or other alteration? In this era of Internet access to all manner of creative and often copyrighted works, it is not uncommon that an alleged infringer will raise the banner of fair use in seeking protection for his or her use of copyrighted works. In addition to the landmark rulings of the Supreme Court these issues revolving around transformative use, three

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100. 17 U.S.C. § 107.
101. 659 F.2d 963 (9th Cir. 1981), *rev'd*, 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984).
102. *Id.* at 970–71.
103. *Id.* at 970 (quoting Leon Seltzer, Exemptions And Fair Use In Copyright 24 (1978) (emphasis in original)).
104. *Id.*

appellate opinions and one district court opinion are representative of the issues lying behind the term "transformative use" and the use of a copied work for its "intrinsic purpose." The first such opinion deals with the use of images of the legendary music group the Grateful Dead.

B. The Grateful Dead and the Expanding Reach of Fair Use

1. *Bill Graham Archives v. Dorling Kindersley Ltd.*:[105] The Extended Limits of Fair Use

Bill Graham Archives ("BGA") was the copyright owner of graphic art images depicting events in the history of the one of the most famous and respected American music groups, the Grateful Dead. In October of 2003, Dorling Kindersley ("DK"), in collaboration with Grateful Dead Productions, published a 480-page "coffee table" book chronicling the history of the Grateful Dead with a running timeline highlighting dates of the Dead's career that was integrated with the text. The Second Circuit, in a concise description of the book in one sentence, advises us that "[a] typical page of the book features a collage of images, text, and graphic art designed to simultaneously capture the eye and inform the reader."[106]

Initially, DK attempted to negotiate a license fee to publish the images. These negotiations ended without an agreement for a license fee, but that did not deter DK from publishing *Grateful Dead: The Illustrated Trip* ("*Illustrated Trip*"), without permission from BGA. In *Illustrated Trip*, DK reproduced seven artistic images that were originally depicted on Grateful Dead event posters and tickets. The book featured these images in significantly reduced forms with captions describing the concerts for which they were used. Shortly after publication of *Illustrated Trip*, BGA filed an action for copyright infringement seeking an injunction against further publication of *Illustrated Trip*, the destruction of all unsold copies of the book and a demand for both actual and statutory damages. On cross-motions for summary judgment, the district court ruled in favor of defendant DK, holding that the reproduction of the seven images was a fair use. In affirming, the Second Circuit discussed each of the fair use factors, virtually echoing the analysis used by the district court.

a. First Factor: Purpose and Character of Use

This first prong of the fair use test requires an analysis of "the purpose and character of the use, including whether such use is of a commercial nature or

105. 448 F.3d 605 (2d Cir. 2006).
106. *Id.* at 607.

is for nonprofit educational purposes."[107] The appellate court agreed with the district court that the use by DK was "transformatively different [b]ecause the works are displayed to commemorate historic events, arranged in a creative fashion, and displayed in significantly reduced form."[108] The "creative fashion" to which the court was referring included the following elements: (1) the poster images were placed along a timeline; (2) each image was reduced to thumbnail size;[109] (3) the images were placed in a collage-like arrangement with other contemporary groups; (4) the use of the images enhanced the readers' understanding of the biographical text; (5) the images served as historical "artifacts" that highlighted Grateful Dead concert events; and (6) all the foregoing are given historical context by a running timeline in the book.[110]

b. The Second Fair Use Factor: Nature of the Copyrighted Work

The district court weighed the second factor against DK, stating that the images were "creative artworks, which are traditionally the core of intended copyright protection."[111] The appellate court agreed with the district court, but gave this factor little weight because the created artwork (the images) were used for a transformative purpose.[112]

c. The Third Fair Use Factor: Amount and Substantiality of the Portion Used

In weighing this factor, the appellate court examined both the qualitative and quantitative aspects of the copyrighted images. The court agreed with the

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107. *Id.* at 608 (quoting 17 U.S.C. § 107(1)).
108. *Id.* at 609.
109. *See id.* at 611 (citing Kelly v. Arriba Soft Corp., 336 F.3d 811, 818–20 (9th Cir. 2003) (finding use of thumbnail-sized images by online search engine to be highly transformative)).
110. The court summed up its overall approach when it stated that "First, DK significantly reduced the size of the reproductions. . . . While the small size is sufficient to permit readers to recognize the historical significance of the posters, it is inadequate to offer more than a glimpse of their expressive value. In short, DK used the minimal image size necessary to accomplish its transformative purpose. [¶] Second, DK minimized the expressive value of the reproduced images by combining them with a prominent timeline, textual material, and original graphical artwork, to create a collage of text and images on each page of the book. To further this collage effect, the images are displayed at angles and the original graphical artwork is designed to blend with the images and text. Overall, DK's layout ensures that the images at issue are employed only to enrich the presentation of the cultural history of the Grateful Dead, not to exploit copyrighted artwork for commercial gain." *Id.* at 611 (citations omitted). To underscore the secondary role of "commercial gain," the court observes that "[s]ignificantly, DK has not used any of BGA's images in its commercial advertising or in any other way to promote the sale of the book." *Id.* at 612.
111. *Id.* at 612.
112. *See id.*

district court relying upon the lower court's holding that the images were greatly reduced in size and intermingled with text and original graphic art provided by the publisher and concluded that "[a]s a consequence, even though the copyrighted images are copied in their entirety, the visual impact of their artistic expression is significantly limited because of their reduced size."[113]

d. The Fourth Fair Use Factor: Effect of the Use Upon the Market for the Value of the Original

Since the parties had agreed that the use of the image did not effect the "primary market" for sale of the images, the court's analysis focused on whether the unauthorized use superseded BGA's "potential to develop a derivative market" in which to promote and sell the images.[114] Once again, the court sided with the district court because "BGA's direct evidence of its license revenues involves a use that is markedly different from the use by DK. The licenses BGA sold to other publishers were for substantially less transformative uses of its posters: full-page, prominently displayed reproductions of BGA's images, with little discussion of the images or their historical context, much less any compilation of other related works into a coherent whole."[115]

2. *Blanch v. Koons*:[116] Satire Has Its Day in Court

Jeff Koons is a famous artist best known for works in which he comments on contemporary society by incorporating into his artwork certain images and objects from popular media or advertising, a practice often referred to as "neo-Pop art." He creates some of his neo-Pop art by copying copyrighted works of others and integrating them collage-like into his own works. At the time of the *Blanch* case, Koons was no stranger to the defense of fair use, which he already had invoked in three actions where the plaintiff alleged that he had copied and included their works in a series of sculptures for an exhibition entitled "The Banality Show." In all three he was found liable for infringement.[117]

In *Blanch*, Koons, without attempting to obtain consent from fashion photographer Andrea Blanch, used Blanch's photograph entitled "Silk Sandals by Gucci," which depicts the lower legs and feet of women with nail polish and

113. *Id.* at 613.
114. *Id.* at 614.
115. *Id.* at 615 n.6.
116. 467 F.3d 244 (2d Cir. 2006).
117. *See* Rogers v. Koons, 960 F.2d 301 (2d Cir.), *cert denied*, 506 U.S. 934, 113 S. Ct. 365, 121 L. Ed. 2d 278 (1992); Campbell v. Koons, No. 91 Civ. 6055, 1993 WL 97381, 1993 U.S. Dist. LEXIS 3957 (S.D.N.Y. Apr.1, 1993); United Feature Syndicate, Inc. v. Koons, 817 F. Supp. 370 (S.D.N.Y. 1993).

wearing Gucci sandals, resting on a man's lap, in a passenger airplane cabin, made for advertisements for metallic cosmetics, as published originally in *Allure* magazine. In creating his work, entitled "Niagara," he transformed the plaintiff's photograph by manipulating its content as follows: he inverted the legs from hanging downward to an upward angle and eliminated the background of the interior of an airplane cabin. Unlike his previous forays into fair use territory, he prevailed in his litigation against Blanch, perhaps having conceived of an approach that enabled him to select copyrighted works he could alter sufficiently for social commentary while fitting that use within the scope of fair use protection and still maintaining his artistic integrity. The result in *Blanch*, however, was more likely due to the more expansive view evidenced by the Second Circuit in *Bill Graham Archives v. Dorling Kindersley, Inc.*[118] The result in *Blanch* is also noteworthy because the court did not find Koons's use of "Silk Sandals" a parody, but, rather, a sufficiently transformative use to receive fair use protection as a satire. As the court states:

> The secondary work in *Campbell* was a parody, and some of the language in the opinion, and some of the cases following it . . . are specifically about parody. "Niagara," on the other hand, may be better characterized for these purposes as satire—its message appears to target the genre of which "Silk Sandals" is typical, rather than the individual photograph itself.[119]

In other words, the target of Koons's critical comments was not Blanch's photograph, but, rather, the *genre* of fashion advertisements (as the appellate court observed) or perhaps a critical look at the values and mores of society itself. As the court observed:

> In an affidavit submitted to the district court, Koons states that he was inspired to create "Niagara" by a billboard he saw in Rome, which depicted several sets of women's lower legs. By juxtaposing women's legs against a backdrop of food and landscape, he says, he intended to "comment on the ways in which some of our most basic appetites—for food, play, and sex—are mediated by popular images." . . . "By recontextualizing these fragments as I do, I try to compel the viewer to break out of the conventional way of experiencing a particular appetite as mediated by mass media."[120]

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118. *See* 448 F.3d 605 (2d Cir. 2006).
119. *Blanch*, 467 F.3d at 254 (citations omitted). The Second Circuit was also guided by the copyright policy that "[t]he ultimate test of fair use . . . is whether the copyright law's goal of 'promoting the progress of science and useful arts' U.S. Const., Art. I § 8, cl. 8, 'would better be served by allowing the use than by preventing.'" *Id*. at 251.
120. *Id*. at 247 (citations to record omitted).

The district court granted summary judgment, holding that the use of the images from "Silk Sandals" was a fair use.[121] In affirming, the Second Circuit found "Niagara" to be transformative and stated:

> "When a commercial use amounts to mere duplication of the entirety of an original, it clearly 'supersedes the objects' . . . of the original and serves as a market replacement for it, making it likely that cognizable actionable market harm to the original will occur. But when, on the contrary, the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred." . . .
>
> We do not mean to suggest that the commercialism of the use by the secondary user of the original is not relevant to the inquiry. But here, since the "new work" is "substantially transformative," . . . "the significance of the factors, [including] commercialism, are of [less significance]." We therefore 'discount[] the secondary commercial nature of the use.'[122]

Of particular note is that the court, in discussing the first fair use factor—"purpose and character of the use"—places emphasis on Koons's *purpose* in using "Silk Sandals" in "Niagara" when it states that:

> Koons is, by his own undisputed description, using Blanch's image as fodder for his commentary on the social and aesthetic consequences of mass media. His stated objective is thus not to repackage Blanch's "Silk Sandals," but to employ it "'in the creation of new information, new aesthetics, new insights and understandings.'"[123]

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121. At her deposition, Blanch testified that Koons's use of the photograph did not cause any harm to her career or upset any plans she had for "Silk Sandals" or any other photograph in which she has rights. She also testified that, in her view, the market value of "Silk Sandals" did not decrease as the result of Koons's alleged infringement. *See id.* at 249.
122. *Id.* at 254 (quoting Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 591, 579, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994)) (other citations omitted).
123. *Id.* at 253 (quoting Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc., 150 F.3d 132, 142 (2d Cir. 1998) (quoting Pierre N. Leval, *Toward A Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990))). In addition, the parties in their depositions each sharply drew the distinctions between the purposes of each: "But Koons asserts—and Blanch does not deny—that his purposes in using Blanch's image are sharply different from Blanch's goals in creating it. . . . ("I want the viewer to think about his/her personal experience with these objects, products, and images and at the same time gain new insight into how these affect our lives.") . . . ("I wanted to show some sort of erotic sense[;] . . . to get . . . more of a sexuality to the photographs.")." *Id.* at 252 (citations to record omitted).

3. *Clean Flicks of Colorado, LLC v. Soderbergh:*[124] *Bill Graham Archives Distinguished*

The Clean Flicks entities ("CleanFlicks") and the co-plaintiffs/counter-claim defendants founded their businesses for the primary purpose of making family films by editing motion pictures produced and distributed by major distinguished motion picture studios ("Studios") to delete from them "'sex, nudity, profanity and gory violence'" and making new edited VHS videocassettes.[125] Later, they added DVDs to their editing activities. As described by the district court, "[t]he deletions are from both audio and visual content of the movies. The editing techniques used included redaction of audio content, replacing the redaction with ambient noise, 'blending' of audio and visual content to provide transition of edited scenes, cropping, fogging or the use of a black bar to obscure visual content."[126] After editing the original content, CleanFlicks then made digital copies of the entire movie after circumventing protection systems in the acquired DVD designed to prevent copying. In order to demonstrate that the Studios had not lost sales, CleanFlicks and its co-plaintiffs purchased DVDs for each altered DVD to maintain a one-to-one ratio of altered disks to original disks. One of the co-plaintiffs used a slightly different method, but the result of a one-to-one ratio was maintained.

The Studios responded, not only by answering, but by also seeking an injunction "to stop the infringement because of its irreparable injury to the creative artistic expression in the copyrighted movies."[127] CleanFlicks and the other counter-claim defendants asserted that their alteration of the original videocassettes and DVDs were protected under the fair use doctrine and, hence, were not infringing. The district court rejected the fair use defense and analyzed the acts and conduct of the counter-claim defendants under each of the fair use factors, as follows:

a. First Factor: Purpose and Character of the Use

The court begins by a reference to the opinion in *Campbell v. Acuff-Rose Music, Inc*. when the district court judge observes that "the Supreme Court said that a use is transformative if it 'adds something new, with a further purpose or different character, altering the first with new expression, meaning or message. . . .' The counter-claim defendants added nothing new to these movies. They delete scenes and dialog from them."[128] The court further stated

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124. 433 F. Supp. 2d 1236 (D. Colo. 2006).
125. *Id*. at 1238.
126. *Id.*
127. *Id*. at 1243.
128. *Id*. at 1241 (quoting Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994)).

that the editing of the motion pictures was non-transformative, finding that the "first statutory factor in the fair use defense does not support the infringers."[129]

b. The Second Factor: The Nature of the Copyrighted Work

The court disposes of this defense in one sentence: "The non-transformative nature of the edited copies coupled with the creative expressions of the movies weighs heavily in favor of the Studios under the second factor, the nature of the copyrighted work."[130]

c. The Third Factor: The Amount and Substantiality of the Use

The court is equally brief after examining the quantitative and qualitative nature of the copyrighted material used by the counter-claim defendants. The court weighed this factor against fair use because the amount taken was substantial (*i.e.*, virtually the whole movie), and was non-transformative.[131]

d. The Fourth Factor: Effect on Potential Market for Value of the Copyrighted Work

The court also weighed this factor against the infringers in rejecting their contention that there was no adverse effect on the motion pictures or the value of these copyrighted works because they maintained a one-to-one ratio of the original to the edited versions of the Studios' films. The court, in rejecting this argument, stated that "[t]he argument has superficial appeal but it ignores the intrinsic value of the right to control the content of the copyrighted work which is the essence of the law of copyright."[132] The district court therefore granted summary judgment and issued an injunction against further infringing uses, including producing, manufacturing, creating, designing, selling, renting, etc. any of the motion pictures controlled by the Studios.

Of additional interest is the opinion of the District Court of Colorado in analyzing the *Bill Graham Archives* ("*BGA*") case.[133] The *Clean Flicks* court distinguished *Clean Flicks* from *BGA*:

> [In *BGA*, the court] held that the publisher of a "coffee table book," telling the story of the Grateful Dead, made fair use of that music group's artistic images on

129. *Id.*
130. *Id.*
131. *See id.*
132. *Id.* at 1242. The court also held that, since the infringing copies of the films were not transformative, they were not derivative works, and thus did not violate Section 106(2) of the Act. *See id.*
133. *See* Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605 (2d Cir. 2006).

> its event posters and tickets. In so doing, the opinion addressed all of the statutory factors and emphasized that these images were not exploitative and their appearance was only incidental to the commercial value of the historical/biographical book. Therefore, the use of the copyrighted images was "transformatively different from the images' original expressive purpose and [the publisher] does not seek to exploit the images' expressive value for commercial gain." . . . [¶] That is in sharp contrast to the counterclaim defendants' use of the copyrighted works in this case. It is undisputed that the edits [in the *Clean Flicks* case] are a small percentage of most of the films copied and the use is clearly for commercial gain. There is nothing transformative about the edited copies. Therefore, the first statutory factor in the fair use defense does not support the infringers.[134]

Comment

Although *Clean Flicks*, as a district court published opinion, only has whatever precedential value courts in other federal circuits may give it, the district judge's opinion provides a valuable reminder: no matter how esteemed the circuit in which a case was decided (in this instance, the Second Circuit deciding the *Dorling Kindersley* case) and which may have inordinately extended the reach of fair use, another court (a district court in Colorado, for example) in applying principles of fair use, may distinguish and limit the holding of the case—thus, in the *Clean Flicks* case, Judge Matsch of the District Court of Colorado distinguished the Second Circuit case of *Dorling Kindersley*, thereby limiting the application of *Dorling Kindersley*.

4. *Ty, Inc. v. Publications International Ltd.*[135]

The manufacturer of "Beanie Babies," Ty, Inc., sued Publications International Ltd. ("PIL") for copyright and trademark infringement based on PIL's publication of a series of "Beanie Babies" collectors' guides featuring color photographs of the copyrighted "Beanie Babies" dolls. PIL did not have a license from Ty to publish the photographs, nor did it seek such a license. While conceding that its photographs of the Beanie Babies were derivative works, PIL asserted that the copies were protected under the doctrine of fair use. The district court granted summary judgment for Ty and issued a permanent injunction enjoining PIL from selling any of its Beanie Babies books and awarded $1.36 million representing PIL's profits from the sale of the books.

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134. 433 F. Supp. 2d at 1241.

135. 292 F.3d 512 (7th Cir. 2002), *cert. denied*, 537 U.S. 1110, 123 S. Ct. 892, 154 L. Ed. 2d 783 (2003).

In discussing the essential role played by the defense of fair use in copyright law, Judge Posner of the Seventh Circuit Court of Appeals analogizes to book reviews, observing that without a license from the publisher of the book the reviewer would be foreclosed from using quotations from the book he was reviewing. In such a circumstance, reviews would not be a benefit to the public seeking advice on which books to buy. By being able to quote from a book, so the logic proceeds, the critic's review—or fair use—would increase the demand for copyrighted works. If, however, the reviewer quoted the entire book or too much of it, the review would become a substitute for the book, which would undermine the publisher's market. In the latter circumstance, a defense of fair use would be of no avail.[136]

Judge Posner then observes that "in economic terminology that has become orthodox in fair-use case law, we may say that copying that is complementary to the copyrighted work (in the sense that nails are complements of hammers) is a fair use, but copying that is a substitute for the copyrighted work (in the sense that nails are substitutes for pegs or screws), or for derivative works from the copyrighted work . . . is not a fair use."[137] Continuing his economic analysis, Judge Posner advises us that, "[i]f the price of nails fell, the demand for hammers would rise but the demand for pegs would fall. The hammer manufacturer *wants there to be an abundant supply of cheap nails, and likewise publishers want their books reviewed and wouldn't want reviews inhibited and degraded by a rule requiring the reviewer to obtain a copyright license from the publisher if he wanted to quote from the book. So, in the absence of a fair- use doctrine, most publishers would disclaim control over the contents of reviews. The doctrine makes such disclaimers unnecessary. It thus economizes on transaction costs*."[138]

The court thus provides new terminology with "complementary" and "substitutional" displacing "transformative" and "superseding" copying, respectively. In applying these terms to the facts, the Seventh Circuit focused on two of the Beanie Babies books published by PIL. One of them, targeting the childrens' market, *For the Love of Beanie Babies*, contained more than 150 color photographs of different Beanie Babies accompanied by a commentary "aimed exclusively at a child (or infantile adult) audience."[139] The other, PIL's *Beanie Babies Collector's Guide*, is described as a "small paperback book with small print, clearly oriented toward adult purchasers—indeed, as the title indicates, towards collectors."[140] In addition to photographs on each page depicting a Beanie Baby, the *Guide* provides additional information for a collector such as the release date of the picture, the date it ceased publication, the estimated value

136. *See id*. at 517. *See also* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562, 105 S. Ct. 2218, 2231, 85 L. Ed. 2d 588 (1985).
137. *Id*. (citations omitted).
138. *Id*. (emphasis added).
139. *Id*. at 519.
140. *Id*.

of the Beanie Baby depicted and arcane information in which only a devoted collector would be interested.[141] With respect to the childrens' book, which the court held, as essentially a picture book of the Beanie Babies, was a derivative work, the defense of fair use was not available. In dealing with the *Guide*, however, which was "no more a derivative work than a book review is,"[142] the *Guide* was clearly "complementary" (or "transformative") with the result that its publication was a protected fair use. The case was reversed and remanded.

VII. CONCLUSION

Even in the face of an expansive view of fair use as exemplified by *Bill Graham Archives v. Dorling Kindersley Ltd*., the current state of the doctrine of fair use as interpreted by the federal judiciary and the commentary of legal scholars is consistent with principles developed over the course of 270 years. The Supreme Court opinion in the *2 Live Crew* case has effectively restored the transformative/superseding analysis essential to an understanding of the law of fair use. In short graphic form, its history and the current status of law, may be illustrated as follows:

PURPOSE OF COPYRIGHT LAW
"[t]o promote the Progress of Science. . . ."
U.S. Const. art. 1, § 8, cl. 8

IDEA/EXPRESSION DICHOTOMY

Only Expression of Idea (not idea itself) is Protected

Areas of Non-Protectability

Ideas[143] **Facts**[143] **Fair Use**[144]

141. *Id.*
142. *Id.* at 520.
143. *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc., 490 U.S. 340, 350, 356, 111 S. Ct 1282, 1290, 1293, 113 L. Ed 358 (1991) (the Supreme Court referred to the area of the law as both the "idea/expression dichotomy" and "the fact//expression dichotomy"). *See also* 17 U.S.C. § 102 ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.").
144. 17 U.S.C. § 107.

OPERATIVE LANGUAGE IN STATUTE
("[t]he fair use of a copyrighted work . . . is not an infringement of copyright") 17 U.S.C. § 107

FAIR USE FACTORS

Focus on secondary creator	1. The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit-educational purposes;
Focus on incentives and entitlements of copyright proprietor	2. The nature of the copyrighted work; 3. The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and 4. The effect of the use upon the potential market for or value of the copyrighted work. (17 U.S.C. § 107)

THE MISSTEPS AND DETOURS

Sony Corp. vs. Universal City Studios (1984)

- Commercial Use = Presumption that such use is unfair (Corollary: Non-commercial private use by consumer = fair use)

Harper & Row vs. Nation Enterprises (1984)

- Unpublished nature of work and right of author to control first publication outweighs claim of fair use
- Effect of secondary use on value and/or potential market is single most important fair use factor

Lower Courts' Reliance on *Sony* and *Nation*

Salinger vs. Random House
(2d Cir. 1987)

New Era Productions vs. Henry Holt
(2d Cir. 1987)

(Second Circuit rejects trial court's finding of fair use and holds, in part, that "unpublished works normally enjoy complete protection.")

Acuff-Rose vs. Campbell
(6th Cir. 1992)

(Sixth Circuit reverses and remands; holds that rap parody (1) is an infringement per *Sony* in that commercial uses are presumptively unfair; and (2) effect on market is most important fair use factor).

CORRECTION AND CLARIFICATION

I. Congress: Amendment to §107 re unpublished nature of work (1992).

II. *Campbell vs. Acuff-Rose* ("Pretty Woman") (1994) (Supreme Court reverses Sixth Circuit and remands for further proceedings.)
   A. Character and Purpose of Use:
      1. Commercial use not presumptively unfair; only a factor to be considered with others.
      2. Is it transformative or non-transformative?
   B. Market harm does not give rise to presumption of unfair use.
      1. If market is harmed by non-transformative use, this factor weighed in favor of unfair use.
      2. The more transformative the use, the less likely use is unfair.
   C. Restoration of the Transformative/Superseding Analysis.

We now turn to specific applications of fair use in Chapter 8.

CHAPTER

8

Fair Use—Part Two

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Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.

. . .

It is this joinder of reference [to the original] and ridicule [of the original] that marks off the author's choice of parody from the other types of comment and criticism that traditionally have had a claim to fair use protection as transformative works.

Justice David H. Souter
in *Campbell v. Acuff-Rose Music, Inc.*[1]

I. The Origins and Uses of Parody and Satire

Basic to an understanding of parody and satire is that each grew from the human need to express opinions freely about (1) serious subjects in an imitative and humorous manner in order to comment on individuals, genres, literature, music, and the pictorial arts; and (2) society's vices, inadequacies, and foibles.[2] Thus, both are best understood, especially in the context of copyright protection, as vehicles for criticism and comment. Before their collision with copyright laws, satire and parody both enjoyed vigorous lives as accepted literary forms initially free from the constraints imposed by those laws. Because parody has experienced inconsistent treatment and been the victim of erroneous decisions by the courts, it has generated the most comment both in court decisions and legal analyses.

A. Parody: Traditional Languages and Music

Parody in spoken and written languages offers only one initial challenge: to understand parody, it is necessary either to have or to acquire knowledge of the work being targeted or used for comment by reading, attending a theater performance, or viewing the work in question. With musical parody two obstacles are raised: having or acquiring knowledge and understanding of (1) musical language and ideas through which the parody is conveyed to

1. 510 U.S. 569, 580–81, 583, 114 S. Ct. 1164, 1172, 1173, 127 L. Ed. 2d 500 (1994).
2. Some of the greatest literary and theatrical works fall under the rubric of one or the other: *The Frogs* and *Lysistrata* (both by Aristophanes), *Gulliver's Travels* (Swift), *Candide* (Voltaire), portions of *Ulysses* (Joyce), *You Are Old, Father William* (Lewis Carroll), *Don Quixote* (Cervantes), *A Christmas Garland* (Beerbohm), *Brave New World* (Huxley), and *Animal Farm* (Orwell).

the listener; and of (2) the parodied motif, phrase, or other element of the composition. Two possible approaches to overcoming these obstacles are to attend lectures given by academics (if such lectures are even offered) and/or to purchase a scholarly guidebook (if one is even in print) to accompany the listener's journey through a musical work, every note and harmony of which can be heard and ingested by the listener, who nevertheless cannot always understand the meaning of the work. In literature, one is reminded of Stuart Gilbert and his insights into the meanings behind the text of James Joyce's *Ulysses*.[3] Each of these approaches is aided by attaining an understanding of parody in written, spoken, and visual expressions and then, with that background, establishing a methodology to seek musical equivalents of these non-musical send-ups.

B. Parody and Satire Defined

These two distinct methods of commentary have been defined in dictionaries, academic essays, and the courts as evidenced by the extract from Justice Souter's opinion in *Campbell v. Acuff-Rose Music, Inc.*[4] In the case of parody, definitions found in most dictionaries and learned texts are of limited utility. The reason: Those who attempt to define a word must of necessity condense the definition to its core essence, thus bearing the risk that too much has been left out and/or that what has been included may be misleading. This is especially true when the issues of copyright infringement and fair use are raised in the courts. Satire suffers less from this definitional dysfunction because the satirist is not attempting to target a specific original work.

A reading of the following dictionary and treatise definitions does, however, offer a starting point for understanding the distinctions between the parodist's and the satirist's objectives:

1. Parody

a. "[L]iterary or musical composition imitating the characteristic style of some other work or of a writer or composer, but treating a serious subject in a nonsensical manner, as in ridicule."[5]
b. "(Gk 'beside, subsidiary or mock song') The imitative use of the words, style, attitude, tone and ideas of an author in such a way as to make them ridiculous. This is usually achieved by exaggerating certain traits, using

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3. *See generally* Stuart Gilbert, James Joyce's Ulysses: A Study (Random House 1955) (1930).
4. 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).
5. Webster's new world dictionary of the american language 1034 (2d ed. 1976).

more or less the same technique as the cartoon caricaturist. In fact, a kind of satirical mimicry. As a branch of satire . . . its purpose may be corrective as well as derisive."[6]

2. Satire

a. "[A] literary work in which vices, follies, stupidities, abuses, etc. are held up to ridicule and contempt[;] . . . such literary works collectively, or the art of writing them[;] . . . the use of ridicule, sarcasm, irony, etc. to expose, attack, or deride vices, follies, etc."[7]
b. "The satirist is thus a kind of self-appointed guardian of standards, ideals and truth; of moral as well as aesthetic values. He is a man (women satirists are *very* rare) who takes it upon himself to correct, censure and ridicule the follies and vices of society and thus to bring contempt and derision upon aberrations from a desirable and civilized norm. Thus satire is a kind of protest, a sublimation and refinement of anger and indignation."[8]

C. Parody[9] and Satire: Fair Use under Copyright Law

1. Definition: A Point of Departure

Another reason such definitions are only a point of departure is that, although litigants and the courts have used them in parody and satire cases, they do not deal with fair use criteria first established by the courts through many years of precedential rulings and later codified in Section 107 of the Copyright Act of 1976 (the "Copyright Act") in the following language:

a. "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;"
b. "the nature of the copyrighted work;"

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6. J.A. Cuddon, the penguin dictionary of literary terms and literary theory 640 (4th ed. 1999).
7. Webster's new world dictionary of the american language, *supra* note 4, at 1265.
8. J.A. Cuddon, *supra* note 6, at 780 (emphasis in original).
9. Parody should not be confused with burlesque. The Seventh Circuit has noted the following distinction: "A parody, which is a form of criticism (good-natured or otherwise), is not intended as a substitute for the work parodied. But it must quote enough of that work to make the parody recognizable as such, and that amount of quotation is deemed fair use. . . . A burlesque, however, is often just a humorous substitute for the original and so cuts into the demand for it: one might choose to see *Abbott and Costello Meet Frankenstein* or *Young Frankenstein* rather than *Frankenstein*, or *Love at First Bite* rather than *Dracula*, or even *Clueless* rather than *Emma*. Burlesques of that character, catering to the humor-loving segment of the original's market, are not fair use." Ty, Inc. v. Publ'ns Int'l Ltd., 292 F.3d 512, 518 (7th Cir. 2002) (citations omitted).

c. "the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and"
d. "the effect of the use upon the potential market for or value of the copyrighted work."[10]

2. Parody and Satire in Practice: The Struggles and Missteps

If the parodist, in order to comment on the original work, stops within the boundaries established by courts and Congress, he or she is entitled to conjure up the original by reference to portions of the targeted work, and, if these references are properly executed, will escape liability for copyright infringement as a fair use. But the use of too much of another's work for the purpose of commenting on society, mores, conventions, foibles, etc., which does not target the original for comment, crosses the line to satire and may not fall within the protecting veil of fair use. The subjective question is how much is too much. For example, if an author were to parody Hemingway's style (which has often been a ripe target), he/she (in parodying Hemingway's exaggerated macho style) might write, "He pointed the camera directly at the rhino. The shot was perfect. The camera's shutter made a hard click, a good sound, a man's sound. He treasured the picture and it was good." This would be a fair use and falls within copyright protection because it is totally transformative (that is, it has been transformed to a different and separate work) and would not supersede the market for the original.

But satire is another matter under the law. If the satirist uses an existing work to make a comment on society's customs and mores and does not target the original work for comment, that use may not qualify as a fair use. Thus, a *satirist* may not be accorded the same treatment if he/she were to satirize the overindulgent era ending in the dot.com disaster and to use Hemingway's short story "A Clean, Well-Lighted Place" as a vehicle to show the greed and moral bankruptcy of that segment of society by conjuring up the short story through a new title, "A Dark, Dirty Place," using the guts of the Hemingway story with limited changes of proper names and places, but repeating key phrases created by the author such as: "nada y pues nada y nada y pues nada. Our nada who art in nada, nada be thy name thy kingdom nada thy will be nada in nada as it is in nada"[11]

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10. 17 U.S.C. § 107.

11. Ernest Hemingway, *A Clean, Well-Lighted Place*, *in* The Short Stories Of Ernest Hemingway 477, 481 (1938). In using Hemingway's story and language to comment on society (rather than targeting the original), the second author may be hard-pressed to escape liability even with an attribution to Hemingway. *See, e.g.*, Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir.), *cert.dismissed*, 521 U.S. 1146, 118 S. Ct. 27, 138 L. Ed. 2d 1057 (1997). In the *Dr. Seuss* case, the Ninth Circuit affirmed the issuance of a preliminary injunction enjoining the distribution and sale of a book entitled *The Cat NOT in*

Courts have struggled to define adequately how this ancient Greek vehicle for comment and criticism can be reconciled with using the content and expression of another creator's copyrighted work to make the point espoused by the parodist. For most of its history under copyright law, the art of the parodist has often been the victim of faulty analyses by the courts ending either in erroneous decisions or correct ones based on the wrong reasons. Two cases from the mid-twentieth century provide insight into and a measure of understanding the struggle in which the judiciary was engaged in trying to make coherent sense out of the amorphous tests for determining whether a use by one author of another's protected material was fair or unfair. The battleground was often focused on parody. The federal district court judge who authored the opinion in both of these two cases was James M. Carter, who, later as a member of the Ninth Circuit, wrote the opinion which has bedeviled the copyright bench and bar since its publication in 1977: *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corporation.*[12]

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the Hat! A Parody by Dr. Juice, which was either a parody of the Dr. Seuss classic *The Cat in the Hat* or a commentary on the judicial system (a satire), or both. *The Cat in the Hat* was created by the late Theodore S. Geisel under the pseudonym "Dr. Seuss." In his sixty-year career Geisel authored (both text and illustrations) at least forty-seven books with approximately 35 million copies sold worldwide as of 1997. The main character in *The Cat in the Hat* is a whimsical feline creature who wears a red and white striped stovepipe hat. *The Cat NOT in the Hat! A Parody by Dr. Juice*, claiming even in its title to be a "parody" by its creators, was a whimsical and often discomfiting critique of the criminal justice system and law enforcement agencies, particularly the Los Angeles Police Department. Specifically, it was written as a send-up of the O.J. Simpson criminal trial and it was purportedly authored by "Dr. Juice" (where "Juice" has been a nickname for O.J. Simpson). The targeted markets for the two works were quite different: *The Cat in the Hat* was written for children, while *The Cat NOT in the Hat!* was targeted for adult readership. Plaintiffs in the *Dr. Seuss* alleged, among other things, that, in creating *The Cat NOT in the Hat!*, defendants had infringed Dr. Seuss' *The Cat in the Hat*, as well as the Dr. Seuss works *Horton Hatches the Egg* and *One Fish Two Fish Red Fish Blue Fish*. After analyzing the two works, the Ninth Circuit agreed with the district court, which found that "Seuss had demonstrated: (1) a strong likelihood that [defendants] Katz and Wrinn had taken substantial protected expression from *The Cat in the Hat*, but not from *Horton* or *One Fish Two Fish;* (2) a strong likelihood of success on the copyright claim raising a presumption of irreparable harm; (3)a strong likelihood of success on the parody as fair use issue; (4) serious questions for litigation and a balance of hardships favoring Seuss on the trademark violations; and (5) a minimal likelihood of success on the federal dilution claim." *Id*. at 1397. The court of appeals, in affirming the lower court's grant of the preliminary injunction on the copyright claims, adopted Justice Kennedy's lone concurring opinion in *Acuff-Rose Music* (rather than the majority opinion) by supporting its holding that, even though a parody may under appropriate circumstances constitute a fair use, in not targeting the original work, defendants were unlikely to prevail on that defense because it did not meet the standards mandated by 17 U.S.C. § 107. *See id*. at 1401. *But see* Blanch v. Koons, 467 F.3d 244 (2d Cir. 2006) (the Court of Appeals for the Second Circuit held that the alteration of a photograph first published in a fashion magazine and then used in a satirical painting was sufficiently transformative to qualify as a fair use).

12. 562 F.2d 1157 (9th Cir. 1977).

In *Loew's, Inc. v. Columbia Broadcasting System,* Judge Carter authored the district court opinion that was affirmed by the Ninth Circuit under the name of *Benny v. Loews, Inc.*[13] *("Benny/CBS")*, the first of these two parody/fair use opinions that demonstrate the struggle of the judiciary in attempting to understand and apply the fair use doctrine. In *Benny/CBS*, Jack Benny, the famous comedian, and his writers created a parody of the film *Gaslight*, which, as *Autolight*, was broadcast over the CBS Television Network. The district court judge and the Ninth Circuit Court of Appeals both held that, since *Autolight* was substantially similar to *Gaslight*, the former infringed the latter, thereby foreclosing any consideration of fair use. Therefore, parody was not available as a defense to infringement.[14] *Benny* was the first parody case to be heard by the United States Supreme Court, which was precluded from rendering a precedential opinion because the vote was four to reverse and four to affirm with one judge abstaining, thus preventing a majority decision.[15]

Later in 1955, Judge Carter reached a very different result in *Columbia Pictures Corporation v. National Broadcasting Company, Inc.*[16] Apparently, he had second thoughts about his refusal to apply the fair use defense in *Benny/CBS*, and, in *Columbia Pictures v. NBC*, ruled that Sid Caesar's parody of the motion picture (and novel) *From Here to Eternity*, entitled *From Here to Obscurity*, which was broadcast over the NBC Television Network, was a fair use. Seemingly discovering that defense for the first time, he decided that *Obscurity* was a parody of *Eternity*. He explained that *Obscurity* was a "burlesque" in which "the intentional use of the motion picture by the writers of the burlesque [was done] in order to accomplish the purposes of a burlesque" and the use in *Obscurity* of material from the motion picture "was of only sufficient [amount] to cause the viewer of the burlesque to recall and conjure up the motion picture, or the novel 'From Here To Eternity' upon which said motion picture was based, and thus provide the necessary element of burlesque" and, therefore, a fair use.[17] Unfortunately, *Columbia Pictures v. NBC* was never appealed, thus depriving the Supreme Court of a potential opportunity with a full complement of justices to address the parody/fair use issue in the context of the familiar and then recent stalemate in *Benny/CBS*.

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13. Loew's, Inc. v. Columbia Broad. Sys., Inc., 131 F. Supp. 165 (S.D. Cal. 1955), *aff'd sub nom.* Benny v. Loew's, Inc., 239 F.2d 532 (9th Cir. 1956), *aff'd sub. nom.* Columbia Broad. Sys., Inc. v. Loew's, Inc., 356, U.S. 43, 78 S. Ct. 667, 2 L. Ed. 2d 583 (1958).
14. *See* Benny v. Loew's, Inc., 239 F.2d at 536–37, *aff'g* Loew's, Inc. v. Columbia Broad. Sys., Inc., 131 F. Supp. 165 (S.D. Cal. 1955).
15. *See* Columbia Broad. Sys., Inc. v. Loew's, Inc., 356 U.S. 43, 78 S. Ct. 667, 2 L. Ed. 2d 583 (1958).
16. 137 F. Supp. 348 (S.D. Cal. 1955).
17. *Id.* at 352. From what Judge Carter says about *Obscurity*, he seems to have equated a "parody" with "burlesque," which is something that some courts have cautioned against. *See, supra*, note 9.

In the late 1970s, the Ninth Circuit in *Walt Disney Productions v. The Air Pirates*,[18] furnished another example of the effort and thought still being devoted by the judiciary almost a quarter of a century later to understanding and applying the doctrine of fair use. *Air Pirates* was on appeal from a summary judgment granted to the plaintiff, Walt Disney Productions. The defendants were publishers of "counterculture" comic books, *Air Pirates* and *Hell Comics.* In two of the editions of *Air Pirates* comics, the defendants used some of Disney's most famous cartoon characters including Mickey Mouse, Minnie Mouse, Donald Duck and Goofy. The cartoon characters were made a direct target of parody of the prototypical Disney characters' "image of innocent delightfulness" by "convey[ing] an allegorical message of significance" that "centered around 'a rather bawdy depiction of the Disney characters as active members of a free thinking, promiscuous, drug ingesting counterculture.'"[19] The court pointed out that the characters in defendants' magazines bore "a marked similarity to those of plaintiff" and "[t]he names given to defendants' characters are the same names used in plaintiff's copyrighted work"[20] The defense of fair use was therefore rejected by the district court "because defendants had copied the substance of the Disney products."[21] The appellate court affirmed the summary judgment for plaintiff as to the copyright infringement, while reversing as to the remainder of the claims, including those for infringement of Disney's trademarks, disparagement, and unfair competition. In order to build further support for its decision, the Ninth Circuit Court of Appeals relied upon the distinction between literary characters (those described in words) and cartoon characters (those that are graphic) which have "physical as well as conceptual qualities . . . [and are] more likely to contain some unique elements of expression," while "many literary characters may embody little more than an unprotected idea."[22]

We must remember that, at the time of the *Air Pirates* decision, the search by the federal courts for the "right answers" to copyright issues was ongoing, as it always has been. We must also remember that the guidelines for applying fair use standards did not enjoy the benefit of Judge Souter's scholarly and lucid traversal of the history and purpose of the fair use doctrine in *Acuff-Rose Music, Inc.*, including the restoration of the transformative/superseding analysis that benefited the defendants in three "Barbie Doll" federal copyright cases in the early 2000s.[23] Please note that the courts found that the famous girl's doll does not suffer infringement at the hands of "Foodchain Barbie" and

18. 581 F.2d 751 (9th Cir. 1978).
19. *Id.* at 753 (citations omitted).
20. *Id.*
21. *Id.*
22. *Id.* at 755.
23. *See* Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003); Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171, 123 S. Ct. 993,

"Dungeon Barbie." One can only wonder what the result would have been if *Air Pirates*' less than subtle parody of famous Disney cartoon characters depicted in a counterculture of "free thinking, promiscuous, drug ingesting" members would have prevailed, even with the Ninth Circuit's obsession with the extent of copying involved.

D. Parody and Its Targets

Another reason for these missteps is that neither legal nor dictionary definitions adequately distinguish different targets selected by the parodist. All targeted works are not subject to the same treatment: they may be as different as are the weapons the parodist employs. Parody should therefore be broken down as follows:

1. Parody which targets a specific work for comment or criticism;
2. Parody which humorously targets the style of an author or a group of authors;
3. Parody which targets a genre;
4. Parody which targets the mannerisms and style of not one but many works;
5. Parody of a work in the public domain;
6. A parody which uses another work for social, political or literary criticism *and at the same time* targets the parodied work for comment.

Of the above six categories, numbers three, four and five are what may be labeled "safe parodies." These not only could pass the test for fair use, but also—as a threshold issue—could not infringe anyone's copyright because, by their very nature, they are unprotectable under law. Those in the "unsafe" or "chancy" range are found in numbers one, two and six in that (a) one and two may cause the parodist to stray beyond the fail-safe point by taking too much of the parodied work; and (b) number six combines parody and satire, thus leaving a blurred line between them.

II. Common Sense and Clarification: *Campbell v. Acuff-Rose Music, Inc.*

Perhaps we have now come closer to sorting out these issues: Enter the United States Supreme Court in *Campbell v. Acuff-Rose Music, Inc. (*the *2 Live*

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154 L. Ed. 2d 912 (2003); Mattel, Inc. v. Pitt, 229 F. Supp. 2d 315 (S.D.N.Y. 2002); *see also*, *infra*, notes 42–44 and 49–54 & accompanying text.

Crew case).[24] The Campbell in *Campbell v. Acuff-Rose Music* is Luther Campbell who, along with Christopher Wongwon, Mark Ross, and David Hobbs, formed the rap group 2 Live Crew. Acuff-Rose Music is the company that published the popular Roy Orbison song "Oh, Pretty Woman." 2 Live Crew recorded a song entitled "Pretty Woman," intended as a parody of the Orbison song from which 2 Live Crew copied a bass riff and used specific words. Acuff-Rose filed litigation for infringement of the "Oh, Pretty Woman" copyright. The district court granted summary judgment for 2 Live Crew; the court of appeals reversed the summary judgment and held that the defense of a fair use was barred by the commercial character and excessive borrowing by 2 Live Crew from the Orbison song. Justice Souter wrote this landmark copyright opinion clarifying the law of fair use, which, as legal scholarship, is an example of "high art." Justice Souter's opinion grew out of a controversy requiring a careful and scholarly analysis of "low art" featuring lyrics such as:

> Big hairy woman you need to shave that stuff
> Big hairy woman you know I bet it's tough
> Big hairy woman all that hair it ain't legit
> 'Cause you look like 'Cousin It'[25]

to determine whether 2 Live Crew parodied the lyrics of the song written by Roy Orbison and William Dees, which, among other things, was used as the title song for the movie *Pretty Woman* starring Julia Roberts and Richard Gere:

> Pretty Woman, walking down the street,
> Pretty Woman, the kind I like to meet,
> Pretty Woman, I don't believe you, you're not the truth,
> No one could look as good as you[26]

A reading of the Orbison/Dees lyrics and the less-than-subtle parody by 2 Live Crew will, even for those with a modest degree of sensitivity, demonstrate why Acuff-Rose was incensed and launched the litigation war that followed.[27]

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24. 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).
25. *Id.* App. B, at 595–96, 114 S. Ct. App. B, at 1179.
26. *Id.* App. A, at 594, 114 S. Ct. App. A, at 1179.
27. The complete lyrics from both songs, as quoted by the Supreme Court in *Acuff-Rose*, are reproduced for the full flavor of the parody:

> "Oh, Pretty Woman" by Roy Orbison and William Dees
>
> Pretty Woman, walking down the street,
> Pretty Woman, the kind I like to meet,
> Pretty Woman, I don't believe you, you're not the truth,
> No one could look as good as you
> Mercy

Neither 2 Live Crew nor its publisher, Luke Records (then doing business as Skyywalker Records), contested that the 2 Live Crew song would be an infringement of "Oh, Pretty Woman" under the 1976 Copyright Act unless the court were to find that "Pretty Woman" was a parody and therefore a fair use.

Pretty Woman, won't you pardon me,
Pretty Woman, I couldn't help but see,
Pretty Woman, that you look lovely as can be
Are you lonely just like me?
Pretty Woman, stop a while,
Pretty Woman, talk a while,
Pretty Woman give your smile to me
Pretty Woman, yeah, yeah, yeah
Pretty Woman, look my way,
Pretty Woman, say you'll stay with me
'Cause I need you, I'll treat you right
Come to me baby, Be mine tonight
Pretty Woman, don't walk on by,
Pretty Woman, don't make me cry,
Pretty Woman, don't walk away,
Hey, O.K.
If that's the way it must be, O.K.
I guess I'll go on home, it's late
There'll be tomorrow night, but wait!
What do I see
Is she walking back to me?
Yeah, she's walking back to me!
Oh, Pretty Woman.

"Pretty Woman" as Recorded by 2 Live Crew

Pretty woman walkin' down the street
Pretty woman girl you look so sweet
Pretty woman you bring me down to that knee
Pretty woman you make me wanna beg please
Oh, pretty woman
Big hairy woman you need to shave that stuff
Big hairy woman you know I bet it's tough
Big hairy woman all that hair it ain't legit
'Cause you look like 'Cousin It'
Big hairy woman
Bald headed woman girl your hair won't grow
Bald headed woman you got a teeny weeny afro
Bald headed woman you know your hair could look nice
Bald headed woman first you got to roll it with rice
Bald headed woman here, let me get this hunk of biz for ya
Ya know what I'm saying you look better than rice a roni
Oh bald headed woman
Big hairy woman come on in
And don't forget your bald headed friend
Hey pretty woman let the boys

In the mid-nineteenth century, Justice Story laid the groundwork for a methodology to determine whether a use was fair when he stated that, to determine whether there has been a "justifiable use of the original materials," one must "look to the nature and objects of the selection made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work."[28]

Justice Souter began his analysis of the four factors mandated by Section 107 of the Copyright Act to determine whether 2 Live Crew's song was a parody of "Oh, Pretty Woman" or an infringement of the original. The Court weighed the first factor—purpose and character of the work—in favor of 2 Live Crew, with the following comments containing a tongue-in-cheek artistic judgment:

> While we might not assign a high rank to the parodic element here, we think it fair to say that 2 Live Crew's song reasonably could be perceived as commenting on the original or criticizing it, to some degree. 2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility. The later words can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies.[29]

The Court found that the second factor—the nature of the copyrighted work—was of little help "since parodies almost invariably copy publicly known, expressive works."[30]

> Jump in
> Two timin' woman girl you know you ain't right
> Two timin' woman you's out with my boy last night
> Two timin' woman that takes a load off my mind
> Two timin' woman now I know the baby ain't mine
> Oh, two timin' woman
> Oh pretty woman.

Id. Apps. A & B, at 594–96, 114 S. Ct. Apps. A & B, at 1179–80.

28. Folsom v. Marsh, 9 F. Cas. 342, 348 (C.C. Mass. 1841) (No. 4901). *See, also, supra*, Chapter 7, notes 10–13 & accompanying text.

29. *Acuff-Rose*, 510 U.S. at 583, 114 S. Ct. at 1173. Implicit in these observations by Justice Souter is that the ranking of parodic elements could not descend much lower, but of course one should never say never: The parody of "Boogie Woogie Bugle Boy of Company B" found its way into an off-Broadway show, *Let My People Come—A Sexual Musical* with a new verse, chorus and title: "The Cunnilingus Champion of Company C." *See* MCA, Inc. v. Wilson, 677 F.2d 180 (2d Cir. 1981), *aff'g* 425 F. Supp. 443 (S.D.N.Y. 1976).

30. *Acuff-Rose*, 510 U.S. at 586, 114 S. Ct. at 1175.

The third factor—the amount and substantiality of the portion used in relation to the copyrighted work as a whole—was also weighed in favor of 2 Live Crew. The Court entwined this factor with a fourth factor, when it stated that "[t]he facts bearing on this factor will also tend to address the fourth, by revealing the degree to which the parody may serve as a market substitute for the original or potentially licensed derivatives [of the original]."[31]

In dealing with the fourth factor—the effect upon the potential market and value of the copyrighted work—the Court clearly weighed this factor heavily in favor of the 2 Live Crew parody. The court held that the trial court erred. The Justices also harked back to the rationale for parody and why it should not be necessary to ask the composer of the original for permission or license when they stated that "the unlikelihood that creators of imaginative works will license critical reviews or lampoons of their own productions removes such uses from the very notion of a potential licensing market."[32] The Court quotes Somerset Maugham from his novel *Of Human Bondage*, where the author, an always curious observer of the human condition, advises us that "[p]eople ask . . . for criticism, but they only want praise."[33]

The Court also held that the Sixth Circuit Court of Appeals erred in presuming that the commercial use was presumptively harmful to the market for the original.[34]

The end-result of *Campbell v. Acuff-Rose Music, Inc.*, after applying these four factors, is that the Court cleared away much debris and restored the original test for determination of fair use: (1) whether the accused work was transformed into a separate creation, though quoting from and targeting the original; and (2) whether the second work superseded the market demand for the original.[35] It is also to be noted that the transformative/superseding test applies to fair uses other than parody. Justice Souter underscores this when he advises us that other types of comments and quotations from preexisting works also fall under the umbrella of fair use, and states that: "It is this joinder of reference [to the original work] and ridicule [of the original] that marks off the author's choice of parody from the *other types of comment and criticism that traditionally have had a claim to fair use for protection as transformative works*."[36]

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31. *Id.*
32. *Id.* at 592, 114 S. Ct. at 1178.
33. *Id.* (quoting Somerset Maugham, Of Human Bondage 241 (Penguin ed. 1992)).
34. *See id.* at 590–91, 114 S. Ct. at 1177–78.
35. 2 Live Crew is to be commended for clarifying the law. But he or she who lives by the parody can also be parodied by the parody, as 2 Live Crew became aware after the fifteen minutes of fame achieved by the comedy singing group *2 Live Jews*.
36. 510 U.S. at 583, 114 S. Ct. at 1173 (emphasis added).

One reason Justice Souter has come closer to the mark is because his references to the "original" throughout the opinion are pointedly addressing the target of the parody, regardless of whether that "original" is attributed to a particular author, a group of works (unnamed) constituting a genre, or one in the public domain. The use of the word "original" is especially helpful because Justice Souter does not use the limiting terms "writer" or "composer," as did the compilers of the dictionaries. What is implicit and left open by the word "original" is that it encompasses different types of parody falling within the construction of that broad and inclusive word.

III. Parody in Literature, Motion Pictures and the Visual Arts

Many representative examples of parody are found in literature, theater, motion pictures, photography, and the fine arts. In its earliest incarnations, however, parody was used to comment only upon literary and dramatic works (as distinguished from the works of visual and musical creators), and the styles of the authors of parodied works. The earliest examples, created by the Greeks living in the city-state of Athens 500 years before the birth of Christ, are still read, analyzed and enjoyed today.

Among those early practitioners of the art of parody, perhaps Aristophanes is the greatest of the poets and playwrights. Although his ideas may be considered conservative viewed from today's climate (he believed Athenian democracy was responsible for Athens's defeat in the Peloponnesian war and was also opposed to many of the then-current ideas in the fields of religion, education, and literature), his parodic scalpel usually hit its mark with a combination of wit and sarcasm.

One of Aristophanes' earliest parodies—*The Frogs*—was written in 405 B.C.E. Although a comedy on the surface, *The Frogs* was produced in Athens within the year before that city-state was defeated by the Spartans in the Peloponnesian Wars and conveys messages relating to the impending conflict and the corruption in Athenian society and government. The scenario: Dionysus, the patron god of drama, resolves to journey to the Underworld to find Euripides, the deceased poet he most admired and whom he pledges to bring back to Athens. Prior to Euripides' death and arrival in Hades, the playwright Aeschylus, as was the custom in Hades, had been designated as the greatest master of tragedy and had held that distinction for fifty years before Euripides arrived there. Upon his entry into the world of the dead, Euripides had immediately challenged Aeschylus by claiming that he (Euripides) was a greater tragedian and entitled to the Chair of Honor currently occupied by Aeschylus. At that moment, Dionysus reaches the Underworld and is appointed to judge which master is the greater of the two. The playwrights

debate savagely, giving Aristophanes the opportunity to parody both—with an undisguised bias in favor of Aeschylus. Although Dionysus started his journey with the intention of bringing Euripides back to Athens, he chooses Aeschylus to return with him, based upon Aeschylus's greater wisdom and insight into public policy for the governance of the city-state.

In his traversal of this story, Aristophanes not only parodies the styles of both playwrights but also skewers the corrupt elements of Athens (with whom Aristophanes identifies Euripides) by pointing out that Aeschylus' works improved the morals and patriotism of those who attended his plays, unlike the works of Euripides, which were both immoral and lacking in patriotism. Euripides was left in Hell without even the Chair of Honor because Aeschylus' request was granted that in his absence Sophocles be given the honor and that Euripides be excluded from the Chair forever. And the unkindest cut administered by Aristophanes was that it was unfair to hold the contest in Hades because as Aeschylus complains: "For my dramas live on earth above, but his died with him and here are the witnesses."

What has Aristophanes accomplished in his drama? He parodies the works of both creators, pointing out the stylistic faults of each. But there is a much deeper politically-motivated message: The corruption in Athens, as depicted through satire and allegory, mirrored the situation in the play in Hades, thus sending a thinly disguised message to the Athenians that they should rise up and reinstate those moral citizens who had been exiled or stripped of all power, even the right to vote.

In a modern example, *The Wind Done Gone (TWDG)*, a novel published in 2001, though a bit lacking in literary merit, is instructive as to how much may be borrowed from a targeted work—in this case *Gone With The Wind* (*GWTW*)—and still enjoy the safe harbor provided by fair use standards.[37] Alice Randall, the author of *TWDG*, claimed that her novel, through its parody of *GWTW*, constituted a critique of the Civil War, the Antebellum South, and the institution of slavery. *TWDG* is essentially a retelling of the story in *GWTW* through the eyes of a slave named Cynara. Rather than merely conjuring up *GWTW*, Alice Randall references and borrows many elements and characters central to those in *GWTW*. For example, she copies and summarizes major scenes and elements of the plot of *GWTW*; explicitly refers to *GWTW* in the foreword to her novel; copies dialog and descriptions from the earlier work; and pushes the envelope to its extreme by using fifteen core characters with thinly disguised names—Scarlett O'Hara is "Other" and Rhett Butler is "R." *TWDG* is also sprinkled with descriptions of local settings and themes easily recognizable as those written by Margaret Mitchell. Suntrust Bank, the trustee of the Mitchell Trust and copyright proprietor of *GWTW*, sued the publisher of *TWDG* for copyright infringement. Although the trial court granted a preliminary

37. *See* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001).

injunction prohibiting publication, the United States Court of Appeals for the Eleventh Circuit reversed. Considering the four fair use tests, the circuit court specifically found that Randall took no more than was necessary for her parody and held that the second work was clearly transformative and would not harm the market demand for *GWTW*.[38]

Over the years, there have been many examples of motion picture parodies. For example, the motion picture *The Princess Bride* follows a rich history in its parody—not of a single work—but of an entire genre: the highly romanticized age of chivalry with its excess of courtliness, sorcery, sword play and untouchable feminine purity. Similarly, *The Crimson Pirate* was a hilarious motion picture parody of swashbuckling high seas adventures during the Elizabethan era. The Danny Kaye picture *The Court Jester* parodied the time of Robin Hood with its allusions to evil forces trying to steal the throne while plotting the death of the heir apparent, only to be thwarted by the minions of good, thus clearing the way for an infant (hidden in a basket) to be crowned King of England because he bears the royal birth mark—a purple pimpernel on his backside.

In the history of motion pictures, perhaps some of the most on-target parodies have been those involving the Western. *Blazing Saddles*—now a bona fide classic—parodies the clichés and conventions of that most American of genre movies, with its square-jawed hero; villains out for an avaricious land grab; the obligatory cattle-drive with cowboys sitting around the campfire; stereotypes of American Indians—war paint, feathers, and ungrammatical speech (in this instance not fractured English but perfect Yiddish); girl singer (itself a parody of Marlene Dietrich); and the over-the-hill gunslinger seeking redemption. Think *Shane*, *The Lone Ranger*, *Gunfight at the O.K. Corral*, and the Clint Eastwood character in the series of Spaghetti Westerns in which he starred toward the beginning of his motion picture career. *Blazing Saddles,* however, is a parody that aims beyond the obvious.[39] Mel Brooks and his co-writers (including Richard Pryor) direct many of their barbed comments at racism in America: the sheriff who rides into town on a horse equipped with a saddle designed by Gucci is not a super WASP who clears out the villains and then, refusing to accept thanks, rides into the dusk galloping on to the next town in need of redemption. No, the hero is a black sheriff (Cleavon Little) being used by the forces of evil, who expect his quick demise at the hands of white racist citizens. The high point of the parody? Did you ever wonder how cowboys in virtually every Western ever made could eat pork

38. *See id*. at 1270–71, 1275–76. It is interesting to note that, after the Randall novel was released, there was a brief spike in sales of *GWTW*—undoubtedly due to the publicity from the lawsuit—only to drop dramatically after *TWDG* was reviewed by the critics.

39. Could *Blazing Saddles* filmmaker Mel Brooks have intended an implicit and perhaps subliminal subtext—i.e. "BS"?

and beans around the campfire and immediately go to sleep under the stars without so much as a single gastro-intestinal response? Brooks answers this query with a campfire pervaded by an orchestra of flatulent noise and sounds ranging from soprano to bass.[40]

But non-musical parody is not limited to the written or spoken word. When the photograph of a very pregnant Demi Moore, shown nude and in profile with her right hand covering her breasts and her left hand under her distended belly, appeared on the cover of *Vanity Fair*, the reaction of its readers—as undoubtedly calculated by the editors of the magazine—was an avalanche of letters from those who believed the photograph was refreshing for its candor in depicting one stage on the journey to motherhood, and those who viewed it as disgusting or at the very least in bad taste. The sale of this *Vanity Fair* issue and the buzz it generated were, one would guess, even greater than the editors had hoped for. But, could Annie Leibovitz, the celebrated photographer and favorite of *Vanity Fair* readers who took the Moore photos, have predicted that there would be a different response to the photograph in the form of a hilarious and wonderfully silly parody to advertise the latest sequel in the *Police Squad* series of comedies for the silver screen? The answers to that question were (1) "no"; and (2) the filing of a lawsuit for copyright infringement in the federal district court in New York. The parody photo: A headshot of Leslie Nielsen as detective Frank Drebbin, the bumbling hero in the *Police Squad* motion picture franchise (there are now three sequels) superimposed on the body of a model in the same state of undress and pregnancy as the actress. The appellate court affirmed the summary judgment for the producers, holding that the *Police Squad* photo was a true parody being both transformative and a work that would not supersede the market for the original photographs.[41]

If the Demi Moore/*Police Squad* parody pushes the outer limits, three commercially motivated Barbie Doll parodies go well beyond those borders. In this trilogy of cases, Barbie, in the name of parody, was depicted as an S&M dominatrix ("Dungeon Barbie"),[42] a "blond bimbo girl" ("Barbie Girl")[43] and in various nude photographs in absurd and sexualized positions ("Food Chain Barbie").[44] In all three cases, the courts found that each was a legitimate parody, transformative and unlikely to displace the real Barbie in the market place. This was especially true of "Dungeon Barbie" because it was highly unlikely that Mattel would expand its market by transforming the

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40. As a matter of fact, in Symphony No. 93 Franz Joseph Haydn uses a bassoon for the same effect.
41. *See* Leibovitz v. Paramount Pictures Corp., 137 F.3d 109 (2d Cir. 1998).
42. Mattel, Inc. v. Pitt, 229 F. Supp. 2d 315 (S.D.N.Y. 2002).
43. Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171, 123 S. Ct. 993, 154 L. Ed. 2d 912 (2003).
44. Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003).

real Barbie (given her well-scrubbed image) into a dominatrix toy for the "adult" market.

The Princess Bride and *Blazing Saddles* take-offs are both "safe" parodies because the parodists are not targeting any specific work but, rather, each parodies a particular genre. Thus, since no author can complain that too much was taken from his or her work for the parody, the genre parody will usually avoid the threat of litigation. But parodies like the Demi Moore/Barbie Doll parodies will often invite (intentionally or unintentionally) a claim from the party wounded by the lampoon. Had authors been as litigious in Aristophanes' day as they are today, they would have acquired extensive experience testifying as defendants both at depositions and in court.

IV. Musical Parody

The questions raised with respect to musical parody have different answers depending on whether the targeted composition combines music and words or conveys its comments solely through the language of music. In the former, the words are the anchor providing the listener a key to grasp the message delivered by the parody. There have been numerous examples. Let us consider a few.

A. Music and Lyrics

Does anyone remember these famous songs?:

"Louella Schwartz Describes Her Malady"; "The Last Time I Saw Maris"; "When Sonny Sniffs Glue"; "I Love Sodom"; "I Love You For Seventy Mental Reasons"; "Borscht Riders In The Sky"; "Duvid Crockett, King Of Delancy Street"; "Schleppin' My Baby Back Home"?

If you repeat each title—and assuming you know the original song—you may in your mind's ear begin to hear the melody with the result that the original title and lyrics emerge. The first four songs were the targets of copyright infringement claims. The first two, based on "A Pretty Girl is Like a Melody" and "The Last Time I Saw Paris"[45] were parodied in a special edition of *Mad Magazine* called *More Trash From Mad—A Sickening Collection of Humor and Satire from Past Issues*. Each was accompanied by an instruction that they were to be "sung to" or "sung to the tune of" a well-known popular song. In order

45. The names of the other originals are: *When Sunny Feels Blue; I Love Paris; I Love you for Sentimental Reasons; Ghost Riders in the Sky; Davey Crockett, King of the Wild Frontier;* and *Walkin' My Baby Back Home.*

to facilitate this instruction, these parodies were written in the same meter as the original lyrics. The composers of these two popular American classics and their colleagues were not amused and sued for copyright infringement and other violations of their rights.[46]

Though the music was not copied in the *Mad Magazine* special edition, the plaintiffs alleged that the parody lyrics infringed the compositions as a whole. As Circuit Judge Kaufman summed up the plaintiffs' theory, "[p]ointing to the use of titles, the meter, and an occasional phrase from the original lyrics in an occasional song, the plaintiffs insist that their copyrighted efforts were improperly appropriated by the defendants for their own financial gain."[47] In other words, Irving Berlin and his fellow songwriters seem to be saying that (1) the words and music are inseparable and therefore the infringement of one is an infringement of the other; and (2) when reading the parody text, the reader would subliminally "hear" the music to the song. In analyzing the parodic lyrics and the targeted works, Judge Kaufman observes that the *Mad Magazine* lyrics for these two pop evergreens follow the grand tradition of parody in that each comments on the original. The court affirmed the judgment for *Mad Magazine*. In so doing, Judge Kaufman seems to conflate parody with satire, as far as their use under copyright is concerned when he wrote, "as a general proposition, we believe that parody and satire *are* deserving of substantial freedom—both as entertainment and as a form of social and literary criticism."[48] This statement foreshadows Justice Souter's language in *Campbell v. Acuff-Rose Music, Inc.* quoted at the beginning of this chapter in that there is no bright line separating when and under what circumstances satire will be denied the safe harbor accorded parody, when the four tests discussed above are analyzed.

Musical parody was the subject of one of the trilogy of Barbie cases, *Mattel, Inc. v. MCA Records, Inc.*[49] In the court's recounting of Barbie's history, we are told that she was born in Germany in the 1950s as "an adult collector's item" and that, after her initial start in life, "Mattel transformed her from a doll that resembled a 'German street walker,' as she originally appeared, into a glamorous, long-legged blonde."[50] She has been described as the ideal American woman and as a bimbo. A Danish band, Aqua, recorded the song "Barbie Girl," in which a band member impersonating Barbie sang in a doll-like voice, while another band member, playing her boyfriend, Ken, entices Barbie to "go party."[51] The single of "Barbie Girl" sold well enough to make it into the Top 40

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46. *See* Berlin v. E. C. Publ'ns, Inc., 329 F.2d 541 (2d Cir.), *cert. denied*, 379 U.S. 822, 85 S. Ct. 46, 13 L. Ed. 2d 33 (1964).
47. *Id.* at 543.
48. *Id.* at 545 (emphasis added).
49. 296 F.3d 894 (9th Cir. 2002), *cert denied*, 537 U.S. 1171, 123 S. Ct. 993, 154 L. Ed. 2d 912 (2003).
50. *Id.* at 898.
51. *Id.* at 899.

on the pop music charts. Once again, the lower court held that "Barbie Girl" was a parody of Barbie and a nominative fair use.[52] On the recording of the song Barbie tells Ken, "Life in plastic, it's fantastic / You can brush my hair, undress me everywhere / Imagination, life is your creation / . . . I'm a blonde bimbo girl, in a fantasy world / Dress me up, make it tight, I'm your dolly."[53] The appellate court affirmed, holding that there was no infringement or dilution[54] of the "Barbie Doll" trademark, one of the most famous trademarks in the world.

These parodies of music and lyrics—with the lyrics seemingly controlling the parodic expression of the original lyrics and "conjured" music—clearly fall within the "unsafe" or "chancy" parodies which, unlike the genre parody, leave no doubt as to the identities of the targeted work and its composer.

B. Music Only

Now for the more difficult challenge presented by the *music-only* parody. A good starting point is that intense nationalistic rivalry between the Germans and the French, and, in particular, the Gallic reaction to the music of Richard Wagner, or as some preferred to call it, "Wagnerism." As we understand French culture as viewed by the French, its music, art, and literature were and still are the standard to be emulated by the rest of the world. The German-speaking world, however, did produce, among others, Haydn, Mozart, Bach, Beethoven, Brahms, Schubert, Schumann, Goethe, Heine, Rilke, Thomas Mann, and Heinrich Böll, as well as some of the greatest stage and motion picture directors, including Max Reinhardt, Fritz Lange, Billy Wilder, Ernst Lubitsch, and, more recently, Rainer Werner Fassbinder—giving Germany world acclaim as a leading incubator of genius in the creation of artistic works.

When Wagnerism invaded France, the French were divided *pro* and *contra* Wagner. Add to all this the confrontations (military, political, and economic) between these nations, and you have a witches' brew for fomenting cultural wars. The *contra* contingent (including Fauré and Chabrier) created a number of Wagner parodies in the form of frivolous dances holding Wagner's music up to more than a little scorn. But it was for Claude Debussy to compose a biting send-up of *Tristan und Isolde* and the "*Tristan* Chord"—a revolutionary harmonic reinvention by Wagner, which has been labeled by one commentator as

52. Nominative fair use is one in which, in order to identify the object of the parody, that object must be named.

53. 296 F.3d App., at 909.

54. *See id*. at 903 (citing 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 24.67, at 24–120; § 24.70, at 24–122 (2001) ("'Dilution' refers to the 'whittling away of the value of a trademark,' when it's used to identify different products.'))

"the most famous single chord in the history of music."[55] The *Tristan* Chord started Western music on the road to atonality, culminating in the twelve-tone serial music of Arnold Schoenberg.

During the controversy in France, Debussy was an early convert to Wagnerism. But Debussy was also unsettled by Wagner's influence on French music. Initially captivated and seduced by the German composer's music dramas (traces of which are found in early works of Debussy—*The Blessed Demoiselle* and *Five Poems of Baudelaire*), Debussy became disenchanted with Wagner—so disenchanted that he wrote an article, "The Futility of Wagnerism," which he never published. He also composed the "Golliwogg's Cakewalk," a ragtime romp in a suite of piano pieces entitled *The Children's Corner*. In this work, Debussy mercilessly lampooned the *Weltschmertz* blood-and-guts experience of German Romanticism by a parodic dismissal of Wagnerian excesses.

This Gallic target practice found the ideal foil in *Tristan und Isolde*, an opera whose story and plot combine to create a masterpiece of excess emotion with some of the greatest music to match. Although usually associated with late romanticism in Germany, the scenario for *Tristan und Isolde* is based on Celtic legend. Following the playing of the *leitmotifs* for Tristan (cadencing on the *Tristan* Chord), for Isolde, and the Love Potion as announced in the orchestral Prelude, the opera opens aboard a vessel on which Tristan is taking Isolde to Cornwall to marry his uncle, King Marke. We soon learn that Isolde and Tristan have a shared past: Tristan killed Isolde's betrothed in combat when he traveled to Ireland to collect taxes for King Marke; Tristan was wounded in this confrontation; Isolde, with her knowledge of herbs and potions, nurses Tristan back to health when she realizes that he is her lover's slayer; she wishes to kill him, but, when Tristan looks into her eyes, she cannot. En route to her forced marriage, Isolde determines to end her life and Tristan's. After her marriage to King Marke, Isolde invites Tristan to drink to their reconciliation from a cup that contains poison. But her servant, Brangäne, without Isolde's knowledge, substitutes a love potion for the deadly brew. Tristan and Isolde drink and are overwhelmed by their passion and a love so intense and complete that they do not understand what has happened to them. Isolde and Tristan are discovered by her husband while making love.[56] Tristan is critically wounded by one of the king's knights and is exiled to Brittany, where

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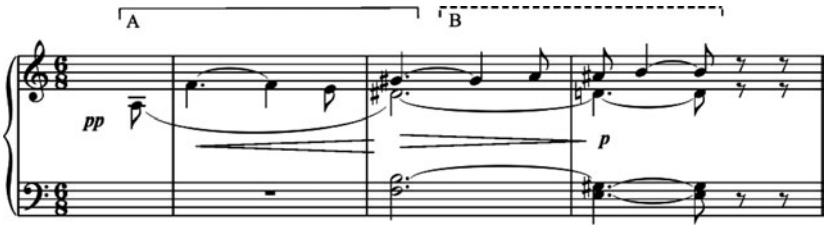
55. Bryan Magee, The Tristan Chord 208 (2000). It is a harmonic watershed which contains two dissonances, one result being that when it resolves to another harmony it requires and perhaps begs for further resolution, perhaps providing a musical exploration of infinite possibility (though not probability). *See generally id.*

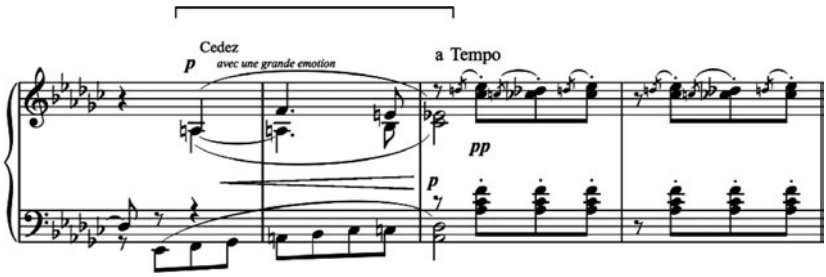
56. The *coitus* is literally *interruptus*, but, for the protection of audience's sensibilities, is not explicit.

he waits for Isolde to arrive by ship. When she does, Tristan rips off his bandages, and runs toward Isolde. King Marke also arrives on another ship having resolved to forgive them and give his consent to their marriage, after learning that Brangäne had replaced the poisoned cup with the love potion. But it is too late: Before Isolde can reach Tristan, he dies; Isolde sings the *Liebestod* ("Love Death") beginning with the words "*Mild und Leise*" ("gently and softly") and sinks across Tristan's body, their souls now transfigured and united for eternity.

It was with innate artistic instinct that Wagner begins *Tristan und Isolde* with the *Tristan leitmotif*, with its feeling of instability and longing, an important literary theme in the opera (see A below):[57]



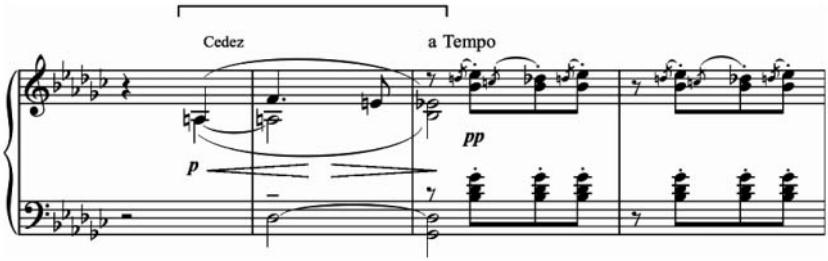
Debussy mocks *Tristan und Isolde* and German Weltschmerz in The *Golliwogs Cakewalk* as follows:



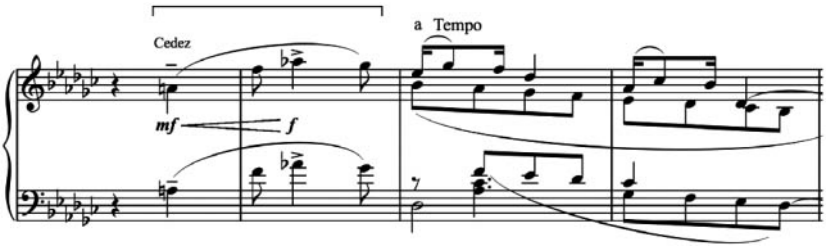
Note the sarcasm with which Debussy writes above the first statement of the *Tristan leitmotif "avec une grande émotion"* ("with great emotion")—after which he thumbs his nose using capricious little figures in eighth notes as if

57. The portion of the *Tristan leitmotif* that is parodied is identified by the A bracket above the staff. Its parodied counterparts are also so identified. The broken-line bracket ("B") is that part of the *leitmotif* that is not parodied.

saying "plink plank plunk," "plink plank plunk," and repeats the phrase with slight variation:



He then makes the grand gesture in the first two measures below (with the bracket above the treble staff) with the notes A, F, A flat, and G in octaves followed by a syncopated and jazzy transition leading back to the parodied *Tristan leitmotif* and the *Tristan* Chord.



Camille Saint-Saens (1835–1921) was yet another Frenchman with an eye (and ear) for mocking sacred cows. He fills the fourteen sections of *The Carnival of the Animals* with quotations from many works and parodies others. Among others, Saint-Saens parodies Hector Berlioz, that most turbulent of Romantics, and pokes fun at the pianists as two "animals," and at his own compositions. He was also a *contra*-Wagnerian, defending French works for their own worth and resisting any encroachment of the Wagnerian invasion on French music.

The Carnival of the Animals—a "Grand Zoological Fantasy"—was written by Saint-Saens in 1886 as an inside joke. With the exception of "The Swan," a musical evergreen adapted as a ballet solo—the "Dying Swan"—by the great ballerina, Pavlova, *Carnival* was never performed in public during Saint-Saens's lifetime, at the explicit instruction of the composer, who felt that this *Carnival* would detract from his reputation as a serious composer. The ban, however, was lifted within a year after his death, and *Carnival* has since become his most popular work. Saint-Saens's highly fanciful and loving portraits of the animals are interrupted by sly but benign parodies. For example, "The Dance of the Sylphs" (variously defined as a slender, graceful woman or

girl and/or any group of elemental beings who inhabit the ether), from *The Damnation of Faust* by Hector Berlioz, played in the uppermost register of the violins (the sylphs floating in the air), turns up in *The Carnival of the Animals* as a group of slow, lumbering elephants played by the double basses. Tortoises, who are equally renowned for their lack of speed, are pictured in sound moving to the ordinarily quick-stepping, high-kicking can-can from Offenbach's *Orpheus in the Underworld*—but with one catch: The can-can becomes a painfully slow dirge. Saint-Saens saves his only barbed parody for the pianists, peculiar animals practicing exercises of C major scales for all four hands: The pianists play octaves in unison with a number of dropped and sour notes along the way. In fact, the duo-pianists are given the liberty of delivering clinkers of their choosing during performances. Lastly, Saint-Saens gives us a huge send-up of his serious tone poem, *Danse Macabre*, by giving the xylophone star status to imitate the rattling, clanking bones of fossils.

Saint-Saens combines both the "safe" and "chancy" parodies in his zoological fantasy. The plodding elephants and painfully slow tortoises clearly target the Berlioz and Offenbach compositions. Had claims been asserted by those two French composers under the current copyright laws (assuming an anachronistic stance for the moment), each use would clearly be transformative and be found not to displace the originals in the marketplace. The "safe" parody is the one targeting the anonymous duo-pianists and their exercises. The pianists represent a type of musician who mindlessly plays generic exercises—maybe those by Czerny, perhaps Hanon, who knows? Such exercises are used to develop finger dexterity and have virtually no musical value. Of course, parodying his own work (*Dance Macabre*) is about as risk-free as it gets.

V. Satire In Literature and the Theatre

A. The Satirist's Targets

For early examples of satire, we must return to the ancient Greeks and to Aristophanes. A few examples—each of which is a comment on society—demonstrate the scope and depth of this insightful writer and of those who followed him.

The satirist's targets are obviously circumscribed both by definition and legal precedent. The objects of satirical comment range from philosophical systems to social evils to individuals. There are those who claim that the purpose of satire is to bring about improvements in society by exposing its vices, follies, and abuses. With that ambitious agenda, it has been observed that satire can be successful as literature only because the satirist invariably fails to reform society. Molière's *Tartuffe* did not end religious hypocrisy. As a result, it is still a living work of art because religious hypocrisy has never come close

to being eliminated. In Aristophanes' *Lysistrata*, the women of Greece unite to deny their husbands sex until they end the war. This may be the precursor to the 60s' slogan "Make love, not war." Unfortunately, all the love over the centuries has not eliminated war. In *The Clouds*, Aristophanes skewers Socrates and lampoons the educational reforms led by the Sophists. At the time Aristophanes wrote, the Athenians, like present-day Americans, filed lawsuits over the most minor incidents. In one scene from *The Wasps*, Labes, a dog, is faced with the death penalty, and, to generate sympathy, brings his offspring to the trial, who then whine and moan during the proceedings. The plague of lawyers is still with us.

B. Satire: A Form of Criticism

Satire as a form of criticism, sometimes blatant and sometimes thinly disguised, has been with us in every century since it was invented in Greece. It flourishes in democratic societies in often disguised and allegorical forms and even under the heel of oppressive regimes, that Jean Paul Sartre accomplished in *Les Mouches* (*The Flies*), in which, through a disguised retelling of the *Electra* tragedy, he adroitly commented on the oppressive Nazi occupation of France. In 1726, Dr. Lemuel Gulliver, a ship's surgeon and later a captain, allegedly wrote *Gulliver's Travels*, one of the greatest satires in English literature and a favorite children's book. In fact, it was written by Jonathan Swift, Dean of St. Patrick's Cathedral in Dublin. In the book, Dr. Gulliver (Swift) describes his adventures in the nation of Lilliput where the citizens are only six inches high. In spite of being vertically challenged (to be politically correct), the Lilliputians take themselves very, very seriously. Swift makes fun of his own land through the Lilliputian emperor's description of his country and of all those who take themselves so seriously. After many adventures, Gulliver leaves Lilliput and, on his second voyage, travels to Brobdingnag where the people are giants. Gulliver becomes a pet of a nine-year-old girl who is less than forty feet tall because she is small for her age. He has harrowing experiences in Brobdingnag and eventually escapes to the flying island of Laputa in the country of the Houyhnhnms, who are talking horses with great wisdom. What Swift has accomplished is to lampoon those who are self-important (especially those in high office in England) and to skewer those who are bullies; he finally achieves a counterbalance when he reaches the country of wisdom and tolerance, inhabited not by humans but by talking horses.

Voltaire's *Candide* takes aim at a different target when he satirizes the optimism of the 1700s engendered by followers of the philosopher Leibnitz. Candide is a child of wealth who grows up in a castle. Dr. Pangloss, his tutor, preaches to him that "all is for the best in this best of all possible worlds." When Cunègonda, his great love, becomes separated from him, he searches for her throughout the world. A Dutch Anabaptist takes Pangloss and Candide

into his service. They travel to Lisbon where they witness an earthquake and are condemned to death by the Inquisition. Candide is rescued by Cunègonda, who just happens to be in Lisbon at the same time. Unfortunately, Dr. Pangloss is hanged. Candide mistakenly kills Cunègonda's brother. The two frustrated lovers are separated. When Candide finally finds Cunègonda, she is an ugly and repulsive old woman. He is also reunited with Pangloss, who slipped out of the noose, and with Cunègonda's brother, whom he had merely wounded but did not kill. The three settle down on a farm. Pangloss is still the optimist and, after trying to prove that all events, no matter how ugly and tragic, are linked to the best of all possible worlds, Candide gives this bit of advice: "'Tis well said but we must cultivate our garden." *Candide* is a funny and caustic satire delivering a knock-out punch to the blissful and unrealistic optimism of Leibnitz and his followers. It was adapted by Leonard Bernstein and mounted on Broadway, but audiences and critics could not determine whether it was a musical, an opera, or something else. It has been revived many times. Bernstein did so during the McCarthy era when there was every reason to be fearful and to view the world without much optimism.

George Orwell's novel *Animal Farm* is a political satire that throws its darts at socialism and communism. The story is a simple one: animals live on a farm and are supposedly all equal in status, comforts, and all that goes with them. But we are reminded constantly that some animals are more equal than others. The reference was directed at the communist leadership in Russia. After the fall of the Berlin Wall, which occurred much later, Orwell's vision could still be timely enough to expose the hypocrisy of the communist ruling class in East Germany with its hidden mansions and extravagant lifestyles.

VI. Satire In Music: *Don Quixote,* Richard Strauss and Mozart

Then there is Miguel de Cervantes' *Don Quixote*, a satire criticizing both the exaggerated heroicism of chivalric heroes and the literature that deifies them. It has been the subject of many musical works, the most famous of which are a Richard Strauss tone poem (where Don Quixote is represented by a cello and Sancho Panza by a viola), Ravel's *Don Quichotte et Dulcinée*, and the Broadway musical *Man of La Mancha*. There is, however, far more to a musical satire than merely setting a satiric literary work to music in the form of a symphonic poem, a song-cycle, and a Broadway show. Beethoven wrote a droll satire entitled *Rage Over a Lost Penny*, and in the early Baroque Marin Marais composed his take on a gall-bladder operation. Perhaps the greatest of these musical satires is *A Musical Joke* (*Ein Musikalischer Spass*), subtitled *Dorfmusikanten—Sextet (Village Music Sextet),* written by Mozart. It is a deliberate satire of the mediocre state of popular music at the time, while also

parodying the works of third-rate composers replete with their incorrect modulations, wrong notes, ignorance of form, and repetition of the most trivial of banalities. In the *Joke*, there is a musical depiction of an inept composer who cannot make proper transitions so that his flow of ideas dries up. There are disjointed melodic ideas, disconnected melodic fragments, irrelevant *pizzicatti*[58] and an ear-shattering dissonance that concludes this *Musical Joke*. As Mozart biographer Hermann Abert has characterized it, seldom in the sphere of music has so much intelligence been employed to give the impression of stupidity. It is rarely performed in concert but has been recorded many times.

VII. The Convergence of Parody and Satire

Although parody, according to definition, usually employs humor to make its point, it can also be the vehicle for serious social comment. The question arises, however, as to whether social commentary should be placed in the column marked "Parody" or the one labeled "Satire." Or is there room to use a "quotation" from a musical work, just as phrases and other excerpts may be quoted from a literary work singled out for criticism?

The following scenario was played out publicly in the most tragic days of the Second World War and its aftermath, when Eastern Europe was forcibly subjected to Soviet occupation. Bela Bartok fled his native Hungary in advance of Russian troops, first for France, and eventually to the United States, where he settled until his death. When he wrote the Concerto for Orchestra, he was suffering the onset of leukemia and was in strapped financial circumstances. He was viewed as a radical European modernist at a time when an American folk-based sound, as represented by the works of Aaron Copland and Roy Harris, had captured the attention of the public. The Concerto was commissioned by the Koussevitsky Foundation and was performed by the Boston Symphony Orchestra in 1944 under the direction of Serge Koussevitzky to great popular and critical acclaim. When he composed Concerto for Orchestra, Bartok was far from accepted beyond a core of devotees who understood his Hungarian folk-based musical language. At the time of his death in 1945, scarcely a year after the hugely successful premiere performance of the Concerto, Bartok had received many lucrative projects on which to begin work, thanks to the Concerto's success, which underscored the acceptance of Bartok as a modern composer one could "listen to" and understand.

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58. *Pizzicatti* is the plural form of the word *pizzicato*, which is the plucking of the strings on an instrument where the strings are usually played with a bow. *See* Willi Apel, Harvard Dictionary of Music 680 (2d ed. 1972).

At the same time, Shostakovich had achieved wide acclaim, not only in Russia, but also in the West. In 1941, Shostakovich wrote his Seventh Symphony, to honor the memory of those who had defended Leningrad from the invading Nazis. The middle section of the first movement is occupied with a march repeated incessantly in various instrumental garb—from a solo clarinet that announces this (perhaps agonizing) melody and continues through each section of the orchestra until every reasonable combination of instruments is exploited. This symphony, composed when the Soviets were our courageous comrades and allies, was viewed with such importance to the war effort that the score was microfilmed and flown secretly to the United States to be performed on a national radio broadcast by Arturo Toscanini (an avowed anti-fascist) and the NBC Symphony Orchestra.

When Bartok, already perplexed by the acceptance and popularity of Shostakovich, heard a later broadcast of this march repeated in bolero-like fashion, he was both annoyed and irritated. The result: A mocking send-up of this infuriating march in the movement of the Concerto entitled "Interrupted Intermezzo," followed by snarly bursts in the winds and lower brass, in effect laughing at the march as it completes its downward progression. This Bartokian poison dart clearly hits its target by, in the vernacular, "flipping off" the simplistic descending pattern with which Shostakovich was apparently obsessed, in Bartok's estimation. Taken on its own, it is everything parody should be. It quotes just enough of the march to conjure up the original, it hits the target so that the audience gets the joke, it is transformative, and certainly does not supersede the market for the original.

Unfortunately, Bartok missed the point of Shostakovich's target as reflected in the music: Shostakovich is actually skewering the pomp and arrogance of the Nazi troops by quoting the melody of the aria "O Vaterland" from *The Merry Widow* by Franz Lehar. "O Vaterland" in the Lehar work is really a take-off on government bureaucracy when Danilo (the male lead) complains about his dreary job while planning an escape to his favorite watering hole, Maxim's. But wait a minute: Is this an instance of a parody (Bartok of Shostakovich) of a parody (Shostakovich of Lehar)? Shostakovich certainly quoted a recognizable section of the "Maxim's" tune from *The Merry Widow*, not because he is targeting the original for parodic comment, but rather by using it as a symbol of Nazism ("O Vaterland"), whose army must bear the brunt of Shostakovich's and Leningrad's attacks and counterattacks. In other words, it may not be a parody, but a satire, striking directly at the evils of totalitarian dictatorship. But would Shostakovich's use still be a fair use, even though he is not targeting specifically the Lehar work or its composer for comment, but rather using a quotation from that work to comment on the evils of Nazism and the tragedies of war?

As we have discovered, the answer is "yes."

This convergence also occurs in *The Carnival of the Animals* and "Golliwogg's Cakewalk." In *Carnival*, the duo-pianists are parodied directly, while their

profession is satirized for, among other things, the mindless playing of scales in order to develop technique. Debussy, in his "Golliwog's Cakewalk," while parodying Wagner as his obvious target, is also satirizing the German sensibilities for overwrought displays of tragic emotion.

VIII. The Quotation

After this exploration of the world of parody and satire, a brief note on the use of "quotations" from existing musical material is in order.

A. Critics and Quotations

In literary criticism, critics often quote from the work being reviewed without concern that the use of the quoted passage will invite a claim of copyright infringement, even when the critics' opinions are negative to the point of substantially destroying public interest in the work in question. Music critics write reviews of concerts, but, unlike critics dealing with the written and spoken word, seldom if ever quote from the score of a composition to substantiate their comments, whether laudatory or critical. If, however, a music critic were to quote from a score, he or she would be entitled to the same protections provided by the defense of fair use as those extended to literary critics. The tradition of using quotation from preexisting works is an old one not limited to critical or academic writings.

B. Quotations from Musical Works

There is no mystery surrounding the use of quoted material in musical works. As in literature, the composer incorporates a relatively brief passage from existing music into his/her composition, and, akin to their function in literature, quotations fulfill the same purpose in music: to engender recognition of the quoted passage that will be meaningful for the listener. The range of meanings and associations aroused by musical quotation are as diverse and unlimited as those triggered in the minds of each listener: allusions to places, historical periods and events; references to a genre of musical works, to a composer or to the entire work from which a quotation is abstracted. Examples are numerous: Tchaikovsky in the 1812 Overture quotes from battle songs to represent the clash of the French and Russian armies in the War of 1812. During the course of its twenty-plus minutes, Tchaikovsky quotes portions of the "Marseillaise," before that stirring anthem symbolizing the French army and nation is overwhelmed by the Russian victory over Napoleon, as the

Overture concludes with the "Czar's Anthem."[59] In the Reformation Symphony, Mendelssohn quotes portions of "Ein' Feste Burg" ("A Mighty Fortress Is Our God"), written by Martin Luther, to conjure up the time of the Reformation. Mendelssohn, in his Reformation Symphony, and Wagner, in his opera *Parsifal* (a religious Christian work), both quote the "Dresden Amen" used in Protestant churches after the Reformation. We have already experienced the parodic/satirical intent in "Golliwogg's Cakewalk," in which Debussy targeted Wagner and the Germans for comment. Mendelssohn's "Wedding March," from *A Midsummer Night's Dream* furnished material for two prominent late nineteenth- early twentieth-century songwriters: George M. Cohan in the "Story of the Wedding March" (1901) and "That Mesmerizing Mendelssohn Tune" (1909) by Irving Berlin. Singer and songwriter Barry Manilow quoted extracts from Chopin's C Minor Prelude to great effect in his song "Could It Be Magic." Charles Ives (whom Leonard Bernstein has dubbed our first really great composer, our "Washington, Lincoln and Jefferson of music") sprinkled his works with quotations from well known works. In his Second Symphony, in which he fondly gazed back on the nineteenth century while looking ahead to the twentieth, we hear reminiscences of Brahms's First Symphony, "Columbia, The Gem of The Ocean," "America the Beautiful," "Camptown Races," and five hymn tunes, including "Bringing in the Sheaves" and "When I Survey the Wondrous Cross." The Symphony concludes with "Reveille," ending on an earsplitting discordant note—perhaps Ives' goodbye to the past as he seeks a new musical language.

C. The Conflict: Quotations from Copyrighted Musical Works

When the inevitable collision between the use of quotations from copyrighted music and the law occurs, the courts have seldom if ever considered the history and established practice of musical quotation. Instead the judiciary relies on the legal concept of *de minimis non curat lex* (literally translated "[t]he law does not concern itself with trifles").[60] As previously discussed, in order for a composer to infringe the copyright of another, there must be substantial similarity of protectable expression between the plaintiff's and defendant's works. As such, the *de minimis* standard is a component of the substantial similarity test, or stated in another way, the "pilfered" notes (or "tones") are not *substantially* similar in protectable expression to the plaintiff's composition.

When the dispute involves the unauthorized use of a *digital sample* from an existing sound recording, the *de minimis* standard has been replaced by a

59. During the Soviet era in Russia the "Czar's Hymn" vanished and was replaced by the "Internationale," the Communist anthem.

60. Black's Law Dictionary 464 (8th ed. 2004).

strict liability standard that courts have construed to be mandated by statute. The judicial clarification of this musical quotation issue comes from an unlikely source: the practice of sampling existing works, which often occurs in the rap/hip hop genre of music. In *Newton v. Diamond*,[61] the rap group Beastie Boys sampled a three-note segment (C, D-flat, C) from the recording of jazz flutist James Newton's composition "Choir," for inclusion in the recording of their song "Pass the Mic." As the court framed the issue, Beastie Boys, who had a license from Newton to use the master sound recording (but not one for the music itself) in their recording of "Pass the Mic," looped[62] this three-note fragment and repeated it at regular intervals forty times. The district court granted a summary judgment for Beastie Boys on two grounds: (1) the segment sampled was not of sufficient originality to merit copyright protection; and (2) even if the sampled portion was copyrightable, The Beastie Boys' use was *de minimis* and therefore not actionable.[63]

In *Bridgeport Music, Inc. v. Dimension Films, No Limit Films,*[64] the plaintiffs sued defendants for the unauthorized use of a sample in the soundtrack of a motion picture, *I Got The Hookup*, from a composition and sound recording of a song by George Clinton and the Funkadelics entitled "Get Off Your Ass And Jam" ("Get Off"). Plaintiff's claims were solely for infringement of the sound recording of "Get Off." No Limit Films, LLC ("No Limit") did not deny that it sampled, but rather asserted that the copying was *de minimis*. The district court concluded that, whether the copying was analyzed under a qualitative/quantitative *de minimis*[65] analysis or the "'fragmented literal similarity' test," the sample (a two-second fragment from a guitar solo that was lowered

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61. 388 F.2d 1189 (9th Cir. 2004), *cert. denied*, 545 U.S. 1114, 125 S. Ct. 2905, 162 L. Ed. 2d 294 (2005).
62. A loop is a section within a sample that through digital technology may be played repeatedly as many times as the composer requires.
63. *Id*. at 1192. The Ninth Circuit Court of Appeals affirmed on the second ground with the following observations: "[N]o reasonable juror could find the sampled portion of the composition to be a quantitatively or qualitatively significant portion of the composition as a whole. Quantitatively, the three-note sequence appears only once in Newton's composition. It is difficult to measure the precise relationship between this segment and the composition as a whole, because the score calls for between 180 and 270 seconds of improvisation. When played, however, the segment lasts six seconds and is roughly two percent of the four-and-a-half minute 'Choir' sound recording licensed by Beastie Boys. Qualitatively, this section of the composition is no more significant than any other section. Indeed, with the exception of two notes, the entirety of the scored portions of 'Choir' consist of notes separated by whole and half-steps from their neighbors." *Id*. at 1195–96.
64. 410 F.3d 792 (6th Cir. 2005).
65. In short, the issues are: (1) is the copied portion a quantitatively sufficient taking to constitute actionable copying and/or (2) is it qualitatively important enough to prove actionable copying? For example, the copied notes may not be quantitatively sufficient, but the quality of the quotation may be so memorable that, like the "hook" in a popular song, it is what listeners remember and associate with the work as a whole. As a result, even though the portion borrowed

in pitch and extended to sixteen beats with each looped segment lasting approximately seven seconds), was not a "'legally cognizable appropriation,'" and granted summary judgment for defendant No Limit on the claims of plaintiffs Westbound and Bridgeport on the grounds that the alleged infringement was *de minimis* and therefore not actionable.[66]

The Sixth Circuit Court of Appeals reversed, basing its decision on a strict "bright line" interpretation of Sections 106[67] and 114(a)[68] of the Copyright Act. The court stated that "the exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106, and do not include any right of performance under section 106(4)."[69]

Sections 106 and 114(b) of the Copyright Act, in substance, grant specifically delineated exclusive rights to the copyright proprietor (pursuant to

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may be *de minimis* quantitatively, liability may nevertheless attach because of the unusual or memorable quality of plaintiff's work.

66. *Id.* at 797 (quoting Bridgeport Music, Inc. v. Dimension Films, 230 F. Supp. 2d 830, 841 (M.D. Tenn. 2002)). Westbound appealed from the district court's grant of summary judgment. Bridgeport did not appeal the summary judgment against it, but based its appeal on the denial of its "motion to amend the complaint to assert new claims of infringement based on a different song included in the sound track of *Hookup*." *Id*. at 795.

67. Section 106 provides that a copyright holder has the "exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission." 17 U.S.C. § 106.

68. Section 114(b) provides as follows: "(b) The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording. The exclusive rights of the owner of copyright in a sound recording under clauses (1), (2), and (3) of section 106 do not apply to sound recordings included in educational television and radio programs (as defined in section 397 of title 47) distributed or transmitted by or through public broadcasting entities (as defined by section 118(g)): *Provided*, That copies or phonorecords of said programs are not commercially distributed by or through public broadcasting entities to the general public." 17 U.S.C. § 114(b) (italics in original).

69. 410 F.3d at 799.

Section 106(1), (2), (3), and (6)), while attaching limits to those exclusive rights with particular reference to "[t]he exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. *The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in a copyrighted sound recording*."[70] Construing this limiting language, the court concluded that other creators could emulate or simulate portions of a recorded work so long as the sound recording itself is not copied, but added that, since one could not "pirate" a complete sound recording, he or she could not sample portions of it. Using this rationale, the court held that, since No Limit "lifted" or "sampled" notes (or "tones") protected by copyright, that alone was sufficient to constitute infringement, thus rendering the question of substantial similarity of expression (including the question of *de minimis* copying) inapplicable. In a terse word of advice, the court coined this aphorism of caution: "it would appear to be cheaper to license than to litigate."[71] In reversing and remanding, the Sixth Circuit Court of Appeals thought it unnecessary to deal with No Limit's fair use defense "[s]ince the district judge found no infringement," and left that issue for the trial judge to consider on remand.[72]

Even though both *Newton* and *Bridgeport Music* involved digital sampling from existing recordings, the ultimate issues were different: In *Newton*, the plaintiff claimed that the copyright for his music (as distinguished from the sound recording embodying the music) had been infringed,[73] while the court in *Bridgeport Music* was concerned with a claim for copyright infringement of the sound recording. Although one might argue that no conflict exists between the Ninth and Sixth Circuits regarding application of the qualitative/quantitative *de minimis* standard because the issues before the two courts were different, one of the questions that remains is whether a so-called "bright-line" standard should apply, or whether a qualitative/quantitative *de minimis* test could or should be implemented as the test for infringement of sound recordings.

It is to be noted, however, that the district court in *Bridgeport Music* found that "a jury could reasonably conclude that the way the arpeggiated chord is used and memorialized in the 'Get Off' sound recording is original and creative

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70. 17 U.S.C. § 114(b) (emphasis added); *see also* 17 U.S.C. § 106.
71. 410 F.3d at 802.
72. *Id*. at 805.
73. The defendants had obtained a license to use the sound recording, but not for the underlying composition.

and therefore entitled to copyright protection."[74] If defendant No Limits, instead of digitally sampling from the recording, had interpolated "Get Off," it is probable that the decision of the Sixth Circuit in *Bridgeport Music* would have been comparable to the Ninth Circuit's affirmance in *Newton*, since the district court in *Bridgeport Music* found that the digital sample of "Get Off" "was *de minimis* and therefore not actionable."[75] For the reasons articulated by the Sixth Circuit, the conservative (and therefore cautious) view at this time in history is that because a strict "bright line" construction of Sections 106(1), (2), (3) and (6), and 114(b) of the Copyright Act was based on a logical interpretation of the applicable statute, sampling from a copyrighted sound recording is likely to expose the sampling defendant to strict liability for copyright infringement.

Thus, those who wish to use the actual sounds embodied in a sound recording are best advised to pay for and obtain a license. This still leaves open the potential for interpolation of the sounds from a copyrighted recording. Interpolation involves the recreation or approximation of recorded sounds. By interpolating the notes, the copied portion of plaintiff's work would not be subject to the statutory construction of strict liability (*Bridgeport Music*), but should be analyzed under the qualitative/quantitative *de minimis* (*Newton*) test for infringement.[76] Thus, it is suggested that, if interpolation is adroitly implemented by mimicry and *de minimis* copying, the use may be considered transformative and in all likelihood will not supersede the market for the original. Although this may not provide a panacea in every instance, the approach will, at the very least, bring interpolation of sound recording extracts within the tests for fair use.[77]

IX. Soundalikes: Their Uses and Abuses

A. Impressions/Imitations

The art of convincingly imitating (or creating and performing an impression of) a well-known person has been a staple of entertainment and comedy,

74. Bridgeport Music, Inc. v. Dimension Films, 230 F. Supp. 2d 830, 839 (M.D. Tenn. 2002), *aff'd*, 410 F.3d 792 (6th Cir. 2005).

75. 410 F.3d at 795.

76. A *de minimis* finding folds nicely within the substantial similarity of protectable expression analysis in that, if it is *de minimis*, it is not substantial, although it may be similar or even identical to the copied fragment.

77. *See, supra*, Section II of this chapter for a discussion and analysis of the Supreme Court's reformulation of the fair use standards, as set forth in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 114 S. Ct 1164, 127 L. Ed. 2d 500 (1994).

going back for many generations—so far distant that it would be difficult, if not impossible, to point to the exact circumstances of the first imitation of an individual whose characteristics were so well-known to an audience that recognition would be instantaneous. Such impressions are a very pure form of parody because, if done well, there is no doubt as to the identity of the person at whom criticism or other comments are aimed, whether politician, socialite, famous billionaire, or another in the public eye. Although this exercise in parodic comedy often includes imitations of facial expressions and body language, it is the vocal component that is at the heart of this artform. While the parodist of creative and copyright-protected works must fit his creative efforts within the fair use factors, the copyright and related issues that arise in the soundalike context require analysis and application of legal principles centered primarily on Sections 301 (Preemption With Respect To Other Laws) and 114 (Scope Of Exclusive Rights In Sound Recordings) of the Copyright Act and the reported authorities construing those provisions, as well as state statutes for the protection of rights of publicity and privacy.

B. The Violation of Rights of Publicity

When used to describe violations of the rights of publicity,[78] the term "soundalike" is most commonly understood to refer to the imitation of a famous person's voice by another performer who is specifically hired to simulate the artist's voice on a recording for commercial purposes, often for advertising and selling a product or service. Depending on the factual context, a claim that a soundalike recording violates the rights of publicity under the laws of various states may or may not be preempted by copyright laws and, in some instances, may leave the artist who is not the copyright proprietor of the recording without a remedy for the use of his or her voice or simulated voice.[79]

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78. *See, infra*, Section C.3.b. and discussion of *Midler v. Ford Motor Company*, 849 F.2d 460 (9th Cir. 1988).

79. Preemption aside, federal law provides relief under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), for those claiming that a false endorsement has been created by imitating elements of an artist's well-known persona (including voice) for commercial purposes. The pertinent language in Section 43(a) provides as follows: (1) "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

C. State versus Federal Law: A Sampling from the Judiciary

The artists whose voices are the subject of soundalikes have, for the most part, based their claims for relief on state statutes for the protection of rights of publicity. Many of these claims (both soundalikes and other creative efforts imitative of the characteristics of well-known persons) have prevailed in those factual settings where the voice—a part of their persona—has been hijacked to sell a product. When, however, the artist wishes to assert a claim based on the use of a "sample" from a copyrighted sound recording featuring his or her voice, a serious question is raised: Given the primacy of federal copyright law in those areas in which it has exclusive jurisdiction, and where state claims are "equivalent," is the state claim preempted by the copyright law of the United States? The answer to that question is in the affirmative. But, for a basic understanding of how these situations occur, and why they may result in a decision leaving the artist whose voice is "aped" in a quandary as to whether or not he has a remedy, a review of the applicable statutes and some of the leading cases will be helpful.

1. The Federal Statutes: Applicable Provisions

a. Section 301 of the Copyright Act: Preemption With Respect To Other Laws

i. Section 301(a):

On and after January 1, 1978, all legal and equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.[80]

ii. Section 301(b):

Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to . . . subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression.[81]

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shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act." 15 U.S.C. § 1125(a).

80. 17 U.S.C. § 301(a).

81. *Id.* § 301(b)(1).

b. Section 114 of the Copyright Act: Exclusive Rights in Sound Recordings

i. Subsection 114(a): Exclusive Rights

(a) The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106, and do not include any right of performance under section 106(4).[82]

ii. Subsection 114(b): Limitations On Copyright Ownership of Sound Recordings

(b) The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. *The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.*[83]

2. The State Statute[s]: California Civil Code Section 3344[84]

Section 3344 of the California Civil Code provides, in pertinent part, as follows:

> (a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.[85]

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82. *Id.* § 114(a).
83. *Id.* § 114(b)(emphasis added).
84. This statute is used as an example (a) because of its application in oft-cited opinions discussed in this section and (b) because it provides protection for rights of publicity similar to those provisions found in the laws of other states. *See, e.g.*, N.Y. Civ. Rights Law § 51 (McKinney 1995); Tenn. Code Ann. §§ 47-25-1102-1108 (1984).
85. Cal. Civ. Code § 3344(a).

(g) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.[86]

3. Reported Authorities

a. *Sinatra v. Goodyear Tire & Rubber Company*[87]

After embarking on her career as a professional entertainer, Nancy Sinatra made a recording of the song "These Boots Are Made For Walkin'," which, with its beat and catchy melody, became a hit. Sinatra's recording made both her (who already possessed some family fame) and the song famous and became her signature song. Criterion Music was the copyright proprietor for the music, lyrics, and arrangement of "Boots." At a time when "Boots" was still stamped in the public consciousness, Goodyear Tire & Rubber Company and its advertising agent, Young & Rubicam, Inc. ("Y&R"), obtained a license for the copyrighted music, and mounted a campaign using the term "Wide Boots" to publicize the tires they were advertising. Goodyear and Y&R produced six radio and television commercials, using music and revised lyrics from "Boots," which was sung by a female singer whose voice and style, according to plaintiff, were "deliberately intended to imitate the voice and style of" plaintiff Nancy Sinatra, so that there was no mystery about whose persona was being exploited.[88] Although the defendants did not attempt to use a "lookalike" for Nancy Sinatra, plaintiff contended that the young women who appeared on screen in the television commercials exhibited "mannerisms and dress" associated with her.[89] Sinatra filed an action for unfair competition under the then-applicable California statute in federal court based on diversity of citizenship, claiming that "Boots," by association with her, had acquired a secondary meaning and the song was therefore associated with her.

That statute defined unfair competition to "mean and to include 'unlawful, unfair or fraudulent business practice and unfair, untrue and misleading advertising.'"[90] In applying this statute to the facts, the court stated that Sinatra and Goodyear were in different businesses and, therefore, were not in competition with one another and that there was no passing-off of Sinatra's "products" (her voice) as Goodyear's. The lower court granted summary judgment

86. Cal. Civ. Code § 3344(g).
87. 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906, 91 S. Ct. 1376, 28 L. Ed. 2d 646 (1971).
88. *Id.* at 712.
89. *Id.*
90. *Id.* at 714 (quoting Cal. Civ. Code § 3369 (West 1970)).

for the defendants, which was affirmed by the Ninth Circuit. In so doing, the appellate court made the following observations:

> In this case appellant's complaint is not that her sound is uniquely personal; it is that the sound in connection with the music, lyrics and arrangement, which made her the subject of popular identification, ought to be protected. But as to these latter copyrightable items she had no rights. Presumably, she was required to obtain permission of the copyright owner to sing "Boots", and to make an arrangement of the song to suit her own tastes and talents. Had she desired to exclude all others from use of the song so that her "secondary meaning" with the song could not be imitated she could have purchased those rights from the copyright proprietor. One wonders whether her voice, and theatrical style, would have been identifiable if another song had been presented, and not "her song," which unfortunately for her was owned by others and licensed to the defendants. But that case is not before us now.[91]

The court also held that the then-effective Copyright Act by implication preempted Sinatra's state law claim for unfair competition under California law because, as the Ninth Circuit later observed in *Midler v. Ford Motor Company*, "[t]o give Sinatra damages for [defendants'] use of the song would clash with federal copyright law."[92]

b. *Midler v. Ford Motor Co.*[93]

In 1973, Bette Midler recorded the song "Do You Want To Dance?" which was a cut in her 1973 album, *The Divine Miss M*. In 1985, her agent was approached by advertising agency Young & Rubicam to record the song for a Ford Lincoln Mercury advertising initiative that was called "The Yuppie Campaign" because it appealed to those people who had grown up in the 1970s and would likely feel nostalgic for songs of that decade. The request was refused by Midler's representative, leaving the advertising agency to find other means to use "Do You Want To Dance?" as the key song for the advertising campaign.

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91. *Id.* at 716. In a footnote in this section, the court explained: "The tapes and the movies introduced as exhibits were viewed and heard by this court. To the untrained ear the sound of the voice carried no recognition, and no confusion of source. It was of professional quality but there was no readily identifiable accent (Maurice Chevalier), range, quality, (Lahr or Andy Devine), or pitch which would distinguish it to the ordinary listener from many others or identify it with any particular person. Although the actresses who appeared fleetingly and did not sing, wore boots, such props for this particular song carried no more originality than a snow scene for a rendition of White Christmas." *Id.* at 716 n.2.
92. Midler v. Ford Motor Co., 849 F.2d 460, 462 (9th Cir. 1988). The exact wording of the *Sinatra* court is "[t]he resulting clash with federal law seems inevitable if damages or injunctive remedies are available under state laws" *Sinatra*, 435 F.2d at 717.
93. 849 F.2d 460 (9th Cir. 1988).

The answer presented itself when the advertising agency contacted Ula Hedwig, one of the "Harlettes" (Midler's back-up singers) to record a soundalike of Bette Midler.

Hedwig made a demo tape and got the job. In preparing for the Midler soundalike, the drill included the following: Hedwig listened to the Midler recording and was told to "'sound as much as possible like the Bette Midler record'" of "Do You Want to Dance?".[94] The desired result was achieved. Many friends of Hedwig and Midler thought that Midler had recorded the commercial. Midler, an award-winning singer and actress, filed an action for the unauthorized use of her voice to sell Ford products on television and radio as a feature of "the Yuppie Campaign."

The district court granted summary judgment for the defendants. The Ninth Circuit Court of Appeals reversed. In its analysis, the appellate court first gives a brief review of First Amendment considerations where copyright and rights of publicity collide, and advises us that First Amendment protection of the media includes the right to reproduction of likenesses and sounds and that "[a] primary value is freedom of speech and press."[95] The court also observes that federal copyright preempts much of the area and then quotes the House committee report that "'[m]ere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible.'"[96] In articulating its rationale for reversing the defense summary judgment, the court goes through a step-by-step process by first distinguishing *Midler* from *Sinatra* before announcing its holding:

> If Midler were claiming a secondary meaning to "Do You Want To Dance" or seeking to prevent the defendants from using that song, she would fail like Sinatra. But that is not this case. Midler does not seek damages for Ford's use of "Do You Want To Dance" and thus her claim is not preempted by federal copyright law. Copyright protects "original works of authorship fixed in any tangible medium of expression." . . . A voice is not copyrightable. The sounds are not "fixed." What is put forward as protectible here is more personal than any work of authorship.[97]

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94. *Id.* at 461.
95. *Id.* at 462. The court goes on to provide guidance by distinguishing the purposes of the media's use of an individual's persona: "The purpose of the media's use of a person's identity is central. If the purpose is 'informative or cultural' the use is immune; 'if it serves no function but merely exploits the individual portrayed, immunity will not be granted.' . . . Moreover, federal copyright law preempts much of the area." *Id.* (citations omitted).
96. *Id.* at 462 (citation omitted).
97. *Id.* (citation omitted).

The court then distinguishes the Midler voice appropriation claim from those cognizable under Section 3344 of the California Civil Code:

> California Civil Code section 3344 is also of no aid to Midler. The statute affords damages to a person injured by another who uses the person's "name, voice, signature, photograph or likeness, in any manner." The defendants did not use Midler's name or anything else whose use is prohibited by the statute. The voice they used was Hedwig's, not hers. The term "likeness" refers to a visual image not a vocal imitation. *The statute, however, does not preclude Midler from pursuing any cause of action she may have at common law; the statute itself implies that such common law causes of action do exist because it says its remedies are merely "cumulative."*[98]

The court then analogizes these "common law causes of action" to what it terms a "companion statute protecting the use of a deceased person's name, voice, signature, photograph or likeness," stating that appropriation of these common law rights, which are "property rights," constitutes a tort.[99] The court fits the Midler claim within that tort, holding that her voice had been wrongfully appropriated with the following cogent statement:

> A voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested . . . A fortiori, these observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity.[100]

c. Comment

In comparing the *Sinatra* and *Midler* cases, consideration must be focused on the statutory schemes in place when each was litigated. At the time Nancy Sinatra filed her complaint, neither California Civil Code Section 990(b) (protection of deceased person's persona) nor Section 3344 (protection of elements of an individual's persona) had been enacted. Placing *Sinatra* within the same time frame as *Midler* and assuming Sinatra's lawyers sought the same relief as Midler (i.e., a common law tort involving voice appropriation), it is likely that Frank Sinatra's daughter would have prevailed, as did Bette Midler, whose complaint was based on the soundalike imitation of her distinctive voice, and not one for unfair competition based on an attenuated theory of secondary meaning attaching to the performance of a copyrighted song in which Nancy Sinatra had no ownership interest.

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98. *Id.* at 463 (citations omitted) (emphasis added).
99. *Id.* (citing Cal. Civ. Code § 990(b)).
100. *Id.*

d. *Waits v. Frito-Lay, Inc.*[101]

Tom Waits is and has been a truly unusual artist, as a singer, songwriter, and actor. The defendants, Frito-Lay, which manufactures and sells snack foods, and its advertising agency, Tracy-Locke, decided that the Waits song "Step Right Up" offered the right tone and approach in their advertising campaign to market a new Frito-Lay product, SalsaRio Doritos. "Step Right Up" reflects Waits' attitude toward commercials, his stated policy having been expressed in virtually all media that, not only would he not do commercials, but also that other musical artists should not do them because it compromises their artistic integrity. Defendants, in the face of Waits' philosophy about commercials, decided nevertheless that they would still use the song "Step Right Up," and also hire a singer to impersonate Tom Waits' voice to capture the feeling of the song. This presented one of those instances where red flags should have gone up for the defendants. Waits had received prestigious awards for his songs and performances, had performed on marquis late-night television shows, and had openly expressed his policy against doing commercials. Then, of course, there was the unmistakable uniqueness of his voice, as described by a fan and restated at the beginning of the appellate opinion as, "'like how you'd sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades. . . . Late at night. After not sleeping for three days.'"[102]

Waits sued for voice appropriation and false endorsement. The jury awarded Waits damages, of which $375,000 were compensatory damages and $2,000,000 were punitive damages for voice appropriation; in addition, Waits was awarded $100,000 damages and attorneys' fees for Lanham Act violations.[103] The defendants appealed. The Ninth Circuit Court of Appeals affirmed the awards for voice misappropriation, citing *Midler*, holding that the voice was distinctive and well-known. In addition, in affirming damages for mental distress, the judge observed that "[a]lthough the injury stemming from violation of the right of publicity 'may be largely, or even wholly, of an economic or material nature,' we have recognized that 'it is quite possible that the appropriation of the identity of a celebrity may induce humiliation, embarrassment, and mental distress'"[104]

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101. 978 F.2d 1093 (9th Cir. 1992).
102. *Id.* at 1097.
103. The Ninth Circuit vacated the award under the Lanham Act, 15 U.S.C. § 1125(a), as duplicative, but stated that Waits had standing to sue for false endorsement under that statute. *See id.* at 1110–11.
104. *Id.* at 1103 (quoting Motschenbacher v. R. J. Reynolds Tobacco Co., 498 F.2d 821, 824 & n.11 (9th Cir. 1974)).

e. *Laws v. Sony Music Entertainment, Inc.*[105]

In 1979, Debra Laws and Spirit Productions entered into a recording agreement with Elektra/Asylum Records to produce master recordings of Laws's vocal performances for the Elektra label. Under the terms of the agreement, Elektra retained copyright ownership of the master recordings and had all rights to exploit them, including the right to "'lease, license, convey or otherwise use or dispose of such master recordings.'"[106] Elektra also had the "right to use and to permit others to use your name, the Artist's name . . . likeness, other identification, and biographical material concerning the Artist . . . in connection with such master recordings."[107]

Laws recorded the song "Very Special" in 1981. In November 2002, Elektra licensed a sample from "Very Special" to defendant Sony for incorporation in the recording of the song, "All I Have," performed by Jennifer Lopez and L.L. Cool J, which was a "cut" in the Jennifer Lopez CD album entitled *This Is Me . . . Then*. The song was number one on the pop charts and, together with the CD album, netted $40 million in sales. Laws filed her complaint in California Superior Court, which included claims for (1) common-law invasion of privacy for the misappropriation of her name and voice; and (2) misappropriation of her name and voice for commercial purposes, a violation of California Civil Code Section 3344. Sony removed the case to federal court and moved for summary judgment on the ground that the claims (bundled together under the rubric of "right of publicity") had been preempted. The district court granted summary judgment, ruling that the claims had, in fact, been preempted by the Copyright Act. In its opinion, the appellate court engaged in an exegesis of *Sinatra, Midler, Waits*, and *Toney v. L'Oreal USA., Inc.*[108] In affirming the defense summary judgment, the court also relied heavily

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105. 448 F.3d 1134 (9th Cir. 2006), *cert. denied*, 127 S. Ct. 1371, 167 L. Ed. 2d 159 (2007).
106. *Id.* at 1136.
107. *Id.*
108. For additional background, a reading of copyright/preemption cases dealing with subject matter other than soundalikes is instructive. *See, e.g.*, Toney v. L'Oreal USA, Inc., 406 F.3d 905 (7th Cir. 2005). In *Toney*, June Toney, a model who had posed for photographs to promote hair care products, sued the defendants, who continued to use her photographs beyond the period for which rights were granted, as a result of which Toney sued for violation of her right of publicity under Illinois law. In holding for Toney, the Seventh Circuit Court of Appeals emphasized that her persona was not fixed in tangible form. It explained:

> Toney's identity is not fixed in a tangible medium of expression. There is no "work of authorship" at issue in Toney's right of publicity claim. A person's likeness—her persona—is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this. . . . [¶] The defendants did not have her consent to continue to use the photograph, and therefore, they stripped Toney of her right to control the commercial value of her identity.

on controlling provisions of the agreement between Laws/Spirit Productions and Sony when it reinforced its affirmance in the following language:

> The essence of Laws's claims is, simply, that she objects to having a sample of "Very Special" used in the Jennifer Lopez-L.L. Cool J recording. But Laws gave up the right to reproduce her voice—at least insofar as it is incorporated in a recording of "Very Special"—when she contracted with Elektra in 1981 and acknowledged that Elektra held the "sole and exclusive right to copyright such master recordings," including the right "to lease, license, convey or otherwise use or dispose of such master recordings." At that point, Laws could have either retained the copyright, or reserved contractual rights in Elektra's use of the recording. Indeed, Laws claims that the latter is precisely what she did. But if Elektra licensed "Very Special" to Sony in violation of its contract with Laws, her remedy sounds in contract against Elektra, not in tort against Sony.[109]

D. Analysis and Conclusions:

Stated simply and directly, in order to successfully invoke federal preemption of a copyright claim under Section 301(a) of the Copyright Act, a two-stage test must be satisfied:

1. The state right must be "equivalent" to the exclusive rights staked out by Congress in the Copyright Act of 1976; and
2. The state right must fall "within the subject matter of copyright," as provided in the Copyright Act.[110]

Thus, if the state right is either not equivalent to an exclusive federal right granted by the Copyright Act, or the subject matter is different from that covered by the Act, such a claim based on the state right will not be preempted.

Id. at 910. *See also* Michaels v. Internet Entm't Group, Inc., 5 F. Supp. 2d 823 (C.D. Cal. 1998). In *Michaels*, the plaintiffs Brett Michaels and Pamela Anderson sought an injunction against the unauthorized release of a "home porno" tape. They claimed that their right of publicity had been violated because their names were used to promote the unauthorized distribution and sale of the film. The court ruled in their favor and stated that "the plaintiffs have alleged that the defendants have used their names, likenesses and identities on radio, television and the Internet to advertise the imminent distribution of the Tape. . . . This conduct is unrelated to the elements of copyright infringement, which are concerned only with the distribution of the Tape itself." *Id*. at 837.

109. 448 F.3d at 1144.

110. *See* 17 U.S.C. § 301(a); *see also* 17 U.S.C. §§ 102, 103, 106.

One of the better definitions of equivalency is found in the Second Circuit opinion in *Harper & Row Publishers, Inc. v. Nation Enterprises*, in which the court stated that:

> When a right defined by state law [within the subject matter of copyright] may be abridged by an act which, in and of itself, would infringe one of the exclusive rights, the state law in question must be deemed preempted. . . . Conversely, when a state law violation is predicated upon an act incorporating elements beyond mere reproduction or the like, the rights involved are not equivalent and preemption will not occur.[111]

E. Coda: An Alternative Approach

The author has on occasion advised clients regarding the risks of hiring a vocalist to imitate a well-known artist for a radio or television commercial. One such instance involved the following advertising campaign: the advertiser/sponsor, a manufacturer and distributor of food products and its advertising agency, wanted to appeal to the audience that came of age during the 1970s. They were particularly interested in targeting African-Americans within that age demographic while still appealing to white consumers. The agency conceived of the idea of hiring a famous group of male singers who had achieved great popularity during the 1970s and who were associated with a bestselling song that became their "signature song." The advertising agency contacted the group, which was still performing in small clubs in the United States; the group's agent demanded an exorbitant fee for their services. The company and its ad agency, with the advice of counsel, made the following decision: since the song would still resonate with the target audience, the company would use the song performed by a female vocalist, who could give the song a "70s feeling," singing the revised lyrics advertising the product. It should also be emphasized that a most important objective had to be accomplished before the project could proceed: obtaining a license for the music (as distinguished from the performance by the 1970s group) from the copyright proprietor (which was an entity other than the group). The commercial aired on television in two versions—one thirty seconds and one fifteen seconds—and featured a husband and wife dancing on screen to the music while the female vocalist "pitched" the product off camera. The commercial in this incarnation proved to be so successful that it ran for an extra cycle on television. No claims were asserted on behalf of the 1970s male group.

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111. 723 F.2d 195, 200 (2d Cir. 1983), *rev'd on other grounds*, 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985).

It must be pointed out that the original singers who made the song a hit in the 1970s were a logical choice for the commercial and it may have been pure chance that the commercial featuring the female vocalist was an anomaly in proving so successful. It should be remembered, however, that the first choice of the male group, if implemented without their authorization, may have ended unhappily in litigation.

X. The Indirect Suppression of Parody, Satire and Quotation

Although the law of fair use has been codified by Congress, clarified by legal scholars, and its transformative/superseding test restored by the Supreme Court in *2 Live Crew*, uncertainty still remains because the tests to determine whether the contemplated use is fair or an infringement requires careful consideration of the facts and the context in which the use occurred: Must the composer target the original? How much use of the original work is too much? Is the parody transformative? Will a particular parody supersede the market for the original? Will a satire be able to overcome the extra scrutiny leveled at it as distinguished from parody? Will a quotation from a famous work be actionable? The answer to these questions will be varied, depending upon how the parody or satire is constituted and the context in which the original work is used. This uncertainty is compounded because the question still remains as to how an individual federal trial judge might rule—correctly or erroneously—based upon the facts in front of him or her. The most practical solution is to secure a license from the copyright proprietor. Even this approach may not provide any comfort for two reasons: (1) Owners of the parodied works, especially those controlling immensely valuable catalogues, feel the need to protect their compositions; and (2) the same owners often demand substantial fees, which the parodist/satirist cannot justify paying. These roadblocks are proof enough of the chilling effect posed by the threat of lawsuits against those who would properly use existing copyrighted material, even though their planned parodies (and perhaps satires) would probably qualify as fair uses.

A. P.D.Q. Bach and "Safe Parody"

Perhaps the most popular musical satirist/parodist currently composing is Peter Schickele, who is also the host/moderator of a weekly radio show on Public Radio International. A musician well-schooled at Aspen School of Music and Juilliard by Roy Harris, Darius Milhaud, William Bergsma, and Vincent Persichetti, Schickele has written music for the stage, for symphony orchestras, chamber ensembles, and solo instruments, many of which have

been performed by major orchestras, leading vocalists, and instrumentalists. He has achieved greater recognition however, under the name P.D.Q. Bach. Under that *nom de plume*, his imagination carries his listeners through pastiches of familiar works and his own original parodies and satires of individual compositions, genres and styles of composers, all while adroitly modifying these works to give a different spin on the originals. The titles chosen for P.D.Q.'s compositions tell us much of what we wish to know about them: *The Stoned Guest; Hansel & Gretel & Ted & Alice; The Abduction of Figaro; Iphigenia in Brooklyn; Blaues Gras* (Blue Grass Cantata); *Wachet Arf!* (a canine cantata poking fun at the Bach sacred contata *Wachet Auf, Ruft Uns Die Stimme* [*Awake! A Voice Calls to Thee*]); *Pervertimento and Variations On An Unusually Simpleminded Theme For Piano And Orchestra*.[112]

P.D.Q. Bach has taken the safe route by parodying dead European composers, using preexisting musical materials left by that defunct population while including his original work for these hilarious send-ups. PDQ's example provides a safe and prudent course of action—the only road to travel in our overly litigious society.

B. Indirect Suppression of Comment: A Case in Point

In a conversation with the author, a much-honored composer—recipient of the Pulitzer Prize and MacArthur award—related his frustration at having to abandon a long-gestating composition because of his inability to obtain the license to quote a few bars from a famous song. His objective: to either parody the song or conjure up a historical period through the nostalgia the song would create in the listener's mind. The complete work as originally conceived features selected but brief quotations from four classic American popular songs to comment on the songs themselves and on the times in the United States with which each was associated. My friend succeeded in securing licenses for three of the songs; the fourth, protected securely by copyright, was owned by a trust holding a catalogue of works written by one of this country's legendary popular composers. The trustees did not outright refuse the license needed for the fourth song. Instead, they requested fees so exorbitant and unreasonable that the composer scrapped the project, insisting (probably

112. These titles are also parodies: *Hansel & Gretel & Ted & Alice* refers not only to the classic children's opera, but also to *Bob & Carol & Ted & Alice*, the 1969 motion picture satire about encounter groups and the free love culture in 1960s California; *The Abduction of Figaro* turns the tables on the operatic barber of Seville, the original Mozart opera, and refers to the abduction from the Seraglio about an abduction from a Turkish harem; *Iphigenia in Brooklyn* is a takeoff on the mythological Greek story of *Iphigenia in Aulide*, an opera by Gluck; and *Pervertimento* is obviously a perverted *Divertimento*, a serenade-like composition mostly used to accompany other activities especially in the time of Mozart and Haydn.

correctly in his artistic judgment) that it was this song and not another that could convey the commentary he wished to evoke in one section of his musical tableau.

As we have already learned, J.S. Bach would not have experienced the same frustrations, nor would he or any of his contemporaries have given a single moment's pause to using another composer's work for any purpose—including parody, satire, or merely to satisfy a particular need or purpose. As we have also discovered, the composer may well have quoted the passage from that fourth composition if he had targeted it for criticism or other comment, thereby making it the object of a parody or using only so much to qualify as a *de minimis* quotation. The risk, however, was too great and the ultimate reward too small.

XI. Non-Musical and Musical Equivalents—A Brief Cadenza

To summarize, the following observations are instructive:

- Mozart's *Musical Joke* as a genre parody is a soul mate of the motion pictures *Blazing Saddles*, *The Princess Bride*, and *The Crimson Pirate*. Whereas Mozart pillories the genre of the inept composer, these three motion pictures parody the Western, the age of chivalry and the swashbuckling high-seas adventures of the Elizabethan era. Add to these the motion picture *The Court Jester* which pokes fun at the life and times of Robin Hood, his merry men and the villains they always defeat.
- Though separated by more than 2,400 years, Aristophanes and Debussy both accomplished hitting their targets—Aristophanes in his parody of Euripides's style and, somewhat more gently, that of his friend Aeschylus, while Debussy, centuries later, indulged in the same exercise in "Golliwogg's Cakewalk."
- "Boogie Woogie Bugle Boy" in its transformed identity, "Cunnilingus Champion of Company C," is certainly the equivalent of two Barbie Doll parodies—"Food Chain Barbie" and "Dungeon Barbie."
- "Louella Schwartz Describes Her Malady," "The Last Time I Saw Maris," and 2 Live Crew's version of "Oh, Pretty Woman" all find their counterparts in the nude and pregnant Demi Moore and Jack Benny's *Autolight* parody of *Gaslight*.
- In addition to his parody in *Musical Joke*, Mozart uses satire to lampoon the tastes and styles of the Rococco period and provides a musical equivalent of *Don Quixote*, in which Cervantes parodies the chivalric genre of literature while also satirizing the society in which the Don and his sidekick, Sancho Panza, lived.

- Saint-Saens in *The Carnival of the Animals* indulged in unsafe parodies of the "Dance of the Sylphs" and the can-can from *Orpheus in the Underworld*, which qualifies him as a spiritual successor to Aristophanes.
- Once again, Mozart's *Musical Joke* is akin to Molière's *Tartuffe* and Aristophanes's *The Clouds* and *The Wasps* with their lampoons of the Sophists and the absurdities of Athenian society. And we must not forget *Candide*, which satirically explodes all the myths of a society floating on contrived bliss.
- Bartok, in his Concerto for Orchestra, not only parodies Shostakovich but also misses the point of Shostakovich's satirizing the Nazis through a quotation from "O Vaterland." Thus, Shostakovich is a soul-mate not only of Aristophanes in his comments about the corrupt Athenian society, but also of Jonathan Swift in his lampoon of men of self-importance.

XII. Coda: The Obscenity/Pornography Syndrome

In the judicial system's treatment of parodists and satirists, judges have exhibited a misplaced tendency to become self-appointed censors based on their distaste for the sexual or off-color nature of the parody or satire. Such considerations are irrelevant to the fair use issues presented by the parodists'/satirists' comments or criticism. We have already seen how Mickey Mouse's and his friends' virginal public images were rescued by one court in *Walt Disney Productions v. The Air Pirates*.[113] There is, of course, more:

Disney, ever-active in protecting its library of copyrighted works, had earlier brought an action for infringement of the "Mickey Mouse March"[114] by the defendants in their movie *The Life and Times of the Happy Hooker* and/or *The Life and Times of Xaviera*.[115] The "Mickey Mouse March" was the theme song for the Mickey Mouse Club series, which introduced Annette Funicello to a national television audience of children and young people. The series was innocent and upbeat without any hint of sex. The defendants' motion picture featured three male actors (portraying teenaged boys) "'whose father had arranged for [the "Hooker"] to be present as a birthday surprise [for] them.'"[116] The Hooker engages in an orgy with the actors, who are totally nude except that each of the "boys" is wearing a "mouseketeer" hat on his head. The defendants

113. 581 F.2d 751 (9th Cir. 1978).
114. *See* Walt Disney Prods. v. Mature Pictures Corp., 389 F. Supp. 1397 (S.D.N.Y. 1975).
115. "Xaviera" is Xaviera Hollander who was, according to her book of the same name, "The Happy Hooker."
116. 389 F. Supp at 1398.

argued that the march was played as a "'humorous takeoff' on the music" to comically reenact "the transition . . . from childhood to manhood."[117] The judge ruled for Disney and, while he gave lip service to fair use principles (e.g., parody can only be permitted where the parodist targets the original), he emphasizes two reasons for his decision: (1) the March, lasting only two minutes, was played over and over again—far more time than required to conjure up the original; and (2) the defendants depicted what the court termed "bestiality" in the work, but it was not to parody the March, but, rather, "to improperly use the copyrighted material."[118] As to the first reason, if the work is transformative and did not supersede the market for the original, the *Hooker* film may well have qualified as a parody. As to the second reason, we are witnessing what may be labeled the "obscenity/pornography syndrome," which has absolutely no place in any fair use analysis.

Similar thinking pervaded the decision in *MCA, Inc. v. Wilson*.[119] In that litigation, the defendants in an off-Broadway show parodied the song "The Boogie Woogie Bugle Boy of Company B," initially made famous by the Andrew Sisters in the 1940s and later by Bette Midler. The defendants performed a number entitled "The Cunnilingus Champion of Company C" in their play *Let My People Come—A Sexual Musical*. Once again, a court in a flawed fair use analysis let slip in its lengthy opinion that:

> We are not prepared to hold that a commercial composer can plagiarize a competitor's copyrighted song, *substitute dirty lyrics of his own*, perform it for commercial gain, and then escape liability by calling the end result a parody or a satire on the mores of society. Such a holding would be an open-ended invitation to musical plagiarism. We conclude that the defendants did not make fair use of plaintiff's song.[120]

This is another example of the pornography/obscenity syndrome asserting itself. One judge dissented after a brief but persuasive analysis and stated that defendants' "Champion" was a parody and, even though offensive to some, courts should not indulge in moral judgments such as those exhibited in the majority opinion.[121] Perhaps in the wake of Justice Souter's opinion in *2 Live Crew*, this syndrome will be laid to rest. Don't bet on it.

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117. *Id.*
118. *Id.*
119. 677 F.2d 180 (2d Cir. 1981).
120. *Id.* at 185 (emphasis added).
121. *See id.* at 191 (Mansfield, J., dissenting).

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CHAPTER
9

Discovery

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The various instruments of discovery now serve (1) as a device, along with the pre-trial hearing under Rule 16, to narrow and clarify the basic issues between the parties, and (2) as a device for ascertaining the facts, or information as to the existence or whereabouts of facts, relative to those issues. Thus civil trials in the federal courts no longer need be carried on in the dark. The way is now clear, consistent with recognized privileges, for the parties to obtain the fullest possible knowledge of the issues and facts before trial.

Hickman v. Taylor[1]

Modern instruments of discovery serve a useful purpose, as we noted in [Hickman v. Taylor]. . . . They together with pretrial procedures make a trial less a game of blind man's bluff and more a fair contest with the basic issues and facts disclosed to the fullest practicable extent.

United States v. Procter & Gamble Company[2]

I. Discovery Tools and Their Uses

Discovery has been so ingrained and taken for granted in the American judicial system that there is often a tendency to pull out all the stops without considering the extent to which the four most employed discovery tools available to the parties—written interrogatories, requests for admission, requests for production of documents, and depositions upon oral examination[3]—should be used. Each has its proper role, which will vary depending upon the facts of each case and the law applicable to those facts. Moreover, the courts in response to abuses of written discovery and marathon depositions, have limited the number of interrogatories and requests for admission, and by federal rule, now allow, without stipulation or court order, only seven hours per deposition.[4]

Of paramount importance in analyzing the extent to which each discovery tool should be used, and the specific questions to be propounded, is the issue of interrogatories *versus* depositions. The rationale is that the other discovery tools are different: (1) requests for production of documents are not "question" discovery, but seek access to information embodied in physical form for examination and copying; while (2) requests for admission likewise do not ask for "answers" to questions, but request that the opposing party admit facts

1. 329 U.S. 495, 501, 67 S. Ct. 385, 388–89, 91 L. Ed. 451 (1947).
2. 356 U.S. 677, 682, 78 S. Ct. 983, 986–87, 2 L. Ed. 2d 1077 (1958) (citations omitted).
3. *See* Fed. R. Civ. P. 30–34.
4. *See* Fed. R. Civ. P. 30(d)(1).

the propounding party either views as undisputed or is trying, by obtaining admissions through discovery, to dispute.

The overriding principle in constructing a discovery plan is to use each discovery tool to elicit information for which it is best suited and, when integrated with its fellow discovery tools, is best calculated to achieve maximum benefit from the discovery process. The principal areas of inquiry in copyright infringement litigation are the following: (1) the creative process followed by each party in composing his or her work; (2) defendant's access to the plaintiff's work; (3) musicological questions calculated to test the opposing party's knowledge regarding the basic elements of music (e.g., melody, harmony, and rhythm); (4) knowledge of preexisting works using the same motif, phrase or other commonplace building block of music; (5) the plaintiff's/defendant's collaborators in creating the compositions at issue; (6) the persons with whom each of the parties discussed their respective works; (7) each party's use of public-domain materials; (8) a listing of all drafts and working notes of the works at issue; and (9) plaintiff's listing of similarities between his and defendant's work.

II. The Discovery Plan: Ultimate Facts and Controlling Authorities

In constructing a discovery plan, it is essential that all legal theories supporting the plaintiff's claims and the defendant's defenses be understood and integrated as a driving force in shaping lines of inquiry and the search for documentary evidence to prove those claims and defenses. Although this is true to a greater or lesser degree of other substantive areas of law, it is especially applicable in copyright litigation, because, when a charge of infringement is leveled at a defendant, the basic facts—other than those to prove access—are not at issue: The works involved exist unchanged in fixed and immutable form when the alleged illicit copying occurred and the claim of infringement is asserted. Under such circumstances, even if the defendant had access to plaintiff's composition, the issue is one of law: Although defendant may have had access to plaintiff's work, does the alleged infringement involve the "taking" of an unprotectable idea or of protectable expression based on that idea? If the former, plaintiff cannot prevail; if the latter, absent viable defenses (e.g., lack of access, independent creation based on unprotectable building blocks of music, or exceptions carved out in the copyright law (e.g., fair use)), the claims will raise triable issues of fact and must be placed in the hands of the trier of fact for determination. Thus, if both works incorporate the splitting of a C major triad (C-E-G played together) where the composer provides that each note of the triad be played separately and repeated consecutively, that is a musical idea—a commonplace building block

of music—and, as a matter of copyright law, is not protectable. By analogy to literature, Author A writes a novel about the Second World War that achieves the number one spot on the New York Times bestseller list. The novel is set in an unnamed battlefield and tells a story filled with guns, artillery, tanks, soldiers being wounded and killed, and heroic medics risking their lives to administer to the wounded and dying as armies clash on the battlefield. A few years later, Author B creates a novel with equally vivid scenes of a battle and carnage, depicting soldiers being wounded and killed, courageous medics, etc. These specific elements of both works are unprotectable ideas—*scènes à faire*[5]—which flow naturally from a basic premise—owned by no one author and open for all to use in expressing the horrors of war.

In each of these scenarios—one involving music, the other literature—even if the respective defendants had ample opportunity for access to plaintiffs' works, neither plaintiff could assert a viable infringement claim. The lesson should be clear when the guiding force of the idea/expression dichotomy is applied to these two factual situations: The universal *idea* that war is hell establishes a premise for the work from which events logically follow. These are *scènes à faire* that will provide the key to a series of questions to be directed to the opposing party and his experts in the question and answer give-and-take of a deposition. Similarly, questions about the basic idea of harmony being embodied in a C major triad that is then split into individual notes cannot be protected, *per se*, under the established principles of copyright: The idea/expression dichotomy mandates that ideas remain free for all to use, while only *original* expression may be protected.

Though the areas of inquiry as between depositions and interrogatories may overlap, the law-driven lines of questions, as related above, will prove more effective in a deposition when the logical progression from one question to the next may lead to proof of the ultimate fact: (1) from defendant's point of view that the materials plaintiff seeks to protect are unprotectable and (2) from the plaintiff's position that substantial similarities of expression exist between the subject works tending to prove that the defendant has engaged in illicit copying of plaintiff's composition.

III. A Hypothetical Case Study: *Tunesmith v. Crater*

It is a prerequisite in conducting discovery that meticulous care be taken in marshalling and understanding all facts relevant to the subject matter of the action and those facts that may lead to the discovery of admissible evidence,

5. *See, supra,* Prelude, note 5.

to paraphrase Rule 26 of the Federal Rules of Civil Procedure.[6] This opens up broad-ranging areas to gather the following facts: the activities of the parties as writers, composers, musicians, or academics; the process followed by them in creating the musical works at issue; the musical knowledge of each party to the litigation; the parties' knowledge regarding previous works employing the same phrases,[7] motifs[8] or other musical devices found in each of the contending works. In order to analyze the place each discovery tool occupies, a brief review of facts in the hypothetical lawsuit between Manfred Tunesmith, professionally known as Mick Ringo, and Anthony Crater, professionally known as Master A.C., should prove helpful:

In 1999, the well-known rock legend, Mick Ringo, composed an homage to 1960s rock and roll for a reunion tour with his band, "The Rolling Bones." The song he composed, "Tropical Rock," virtually monopolized the number one spot on the Billboard hit list during the cross-country tour of *The Rolling Bones*, and, in virtually every city in which they performed—whether Fargo, North Dakota, or Yankee Stadium in New York—"Tropical Rock" had to be repeated, on average, at least three times at every venue. The single of "Tropical Rock" and the CD, which also included other classic songs from the early days of the Rolling Bones, each went platinum.[9] In 2002, Ultimate Studio Productions entered into a production/financing/distribution agreement with Dynamite Productions, a large, independent production company, to produce

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6. *See* Fed. R. Civ. P. 26(b)(1) ("Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense. . . . For good cause, the court may order discovery of any matter relevant to the subject matter involved in the action . . . [and discovery is proper if it] appears reasonably calculated to lead to the discovery of admissible evidence.").
7. "The smallest structural unit is the *phrase*, a kind of musical molecule consisting of a number of integrated musical events, possessing a certain completeness, and well adapted to combination with other similar units. [¶] The term *phrase* means, structurally, a unit approximating to what one could sing in a single breath. . . . Its ending suggests a form of punctuation such as a comma. Often some features appear more than once within the phrase." Arnold Schoenberg, Fundamentals of Musical Composition 3 (Gerald Strang ed., 1980).
8. "Even the writing of simple phrases involves the invention and use of motives, though perhaps unconsciously. Consciously used, the motive should produce unity, relationship, coherence, logic, comprehensibility and fluency. [¶] The *motive* [or motif] generally appears in a characteristic and impressive manner at the beginning of a piece. The features of a motive are intervals and rhythms, combined to produce a memorable shape or contour which usually implies an inherent harmony. Inasmuch as almost every figure within a piece reveals some relationship to it, the basic motive is often considered the 'germ' of the idea. Since it includes elements, at least, of every subsequent musical figure, one could consider it the 'smallest common multiple.' And since it is included in every subsequent figure, it could be considered the 'greatest common factor.'" *Id.* at 8.
9. The Recording Industry Association of America ("RIAA") certifies that a musical work (usually a popular song) or an album has achieved certain levels of sale. For example, for albums (the average content of a CD), a 500,000-unit sale would be certified as a gold album and a 1,000,000-unit sale as a platinum album. *See* Sidney Shemel & M. William Krasilovsky, This Business of Music 316 (1990).

the motion picture, *South Atlantic*, based on the best-selling novel about the rap culture in Atlantic City, New Jersey. The producers chose not to hire any of the famous motion picture composers to create the score for the film, but instead selected the famous rap artist Anthony Crater, under his rap moniker, "Master A.C.," who worked his way up the ladder from a D.J. to a star in the hip hop/rap genre of the music business. "Master A.C.," after screening a rough cut of the film, composes a rap song with a furious beat as the title song for *South Atlantic*. The song: "Caribbean Rock." A.C. spent many hours at his computer listening to and sampling other compositions to get the right feel for the ambience created in the Atlantic City rock culture. "Caribbean Rock" became such an integral part of the motion picture *South Atlantic* that, whenever it was played on the radio, many listeners automatically associated it with the film. One such listener, who was a friend of Mick Ringo, heard "Caribbean Rock" on a radio station specializing in hip hop music, and immediately recognized a strong similarity in the unique beat underpinning each composition. The beat was "unique" in that, between the second and third beats in each measure, there was a slight but noticeable pause before the third beat was played. This affected the rhythm of the entire song and the lyric, which was controlled by the beat.

Mick telephoned his personal manager, the personal manager called Mick's lawyer, and, after a demand letter was sent to Master A.C., Ultimate Studios, and Dynamite Pictures, all of whom denied that Master A.C. had infringed the copyright owned by Mick Ringo, litigation was commenced in the Federal District Court for the Central District of California. After Master A.C. was served with the summons and complaint and their counsel had to make their required initial disclosures pursuant to the Federal Rules of Civil Procedure, the primary focus of both parties was the implementation of their discovery plans.[10] Their strategy would be shaped by the considerations set forth in this text and by the written and deposition discovery that follows.

IV. Interrogatories

A. The Use and Abuse of Interrogatories

Perhaps the best way to start a discussion about the use and abuse of interrogatories is to consider not only what should go into a set of interrogatories but also what should be omitted. In resolving that issue, the guiding rule should be not to ask a question in interrogatories that will prove more effective

10. *See* Fed. R. Civ. P. 26.

when put to a witness in the format of a deposition. The reasons for this approach may vary, but among the most important are the following: (1) the opposing lawyer and his client will have at least thirty days to review each *written* interrogatory and provide responses carefully crafted to avoid providing information damaging to their case; (2) many questions are best addressed to the opposing party (and other witnesses) for the first time in a deposition where questions must be answered in real time and are thus likely to elicit an accurate and telling answer, without hedging or qualification; and (3) making certain areas of inquiry part of the interrogatories may reveal more about the propounding party's case than he or she intends.

B. Objectives and Types of Interrogatories

- Interrogatories should be developed that compel the plaintiff and defendant to list all facts supporting their respective claims and defenses. Other general areas of inquiry of the plaintiff would include the identities of persons with whom plaintiff discussed his composition during its creation; the publishing history, if any, of plaintiff's work; a specific descriptive listing of plaintiff's prior iterations of the musical work that he claims defendants have infringed; and plaintiff's knowledge of defendants' work. Plaintiff should explore the same generic areas as the defendant in crafting his or her interrogatories. There is, of course, greater breadth in constructing a complete set of interrogatories designed for each copyright infringement action. In addition, the use of different types or categories of interrogatories should be implemented for effective discovery.
- The types or categories of interrogatories most, if not all of which, will be used to propound a probing set of questions to the opposing party are: (1) allegation interrogatories; (2) contention interrogatories; (3) access interrogatories; (4) substantial similarity interrogatories; and (5) interrogatories regarding public domain material, common building blocks of music (i.e., standard musical devices available to all composers), other protectables, and prior art.

C. Types of Interrogatories: Examples

1. Allegation Interrogatories: Plaintiff

Set forth in detail all the facts that support YOUR allegations contained in the Third Defense of the ANSWER TO COMPLAINT that "all portions of plaintiff's composition which plaintiff claims are protected by copyright are in fact common building blocks of music available to all composers."

2. Allegation Interrogatories: Defendant

Set forth in detail all facts that support YOUR allegations contained in paragraph___in the COMPLAINT that [**TITLE OF PLAINTIFF'S COMPOSITION**] "contains a large amount of wholly original material and constitutes copyrightable subject matter under the laws of the United States . . . "

3. Contention Interrogatories: Plaintiff

Do YOU contend that plaintiff's composition, or any part thereof, is not protected under the copyright laws of the United States?

If YOUR answer to the foregoing interrogatory is anything other than an unequivocal "No," set forth in detail all facts that support YOUR contention.

4. Contention Interrogatories: Defendant

Do YOU contend that the intervals (using "1" for the root of the scale)[11] 1-5-4-3-2-3-1 without harmony, rhythm, and different duration, are protectable under the copyright laws of the United States?

If YOUR answer to the foregoing interrogatory is anything other than an unequivocal "No," set forth in detail all facts that support YOUR contention.

5. Access Interrogatories: Plaintiff

Did YOU hear plaintiff's composition at any time prior to the commencement of this litigation?

If YOUR answer to the foregoing interrogatory is anything other than an unequivocal "No," set forth in detail the dates when and places where YOU heard plaintiff's composition.

6. Access Interrogatories: Defendant

Set forth in detail all facts establishing defendant's access to plaintiff's composition.

7. Interrogatories Regarding Commonplace Building Blocks of Music (or standard Musical Devices available to all Composers), Public Domain Material, Prior Art and Other Unprotectables: Defendant

Do YOU agree that the intervals on the scale 1-5-4-3-2-3-1 have been used by composers other than plaintiff and defendant for over 200 years?

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11. "1" refers to the root (or first note) of the scale, "2" to the second, "3" to the third, etc. For example, in the scale of C. Major, "1" refers to "C," "2" to "D," "3" to "E," etc.

If YOUR answer to the foregoing interrogatory is anything other than an unqualified "No," set forth in detail all facts that support YOUR answer.

8. Substantial Similarity Interrogatories: Defendant

Set forth in detail all similarities between **[PLAINTIFF'S WORK]** and **[DEFENDANT'S WORK]** on which YOU rely to support YOUR allegation of copyright infringement.

D. Interrogatories

1. Plaintiff's Interrogatories

[ATTORNEY NAMES]
[LAW FIRM]

Attorneys for Plaintiff
Manfred Tunesmith, professionally
known as Mick Ringo

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MANFRED TUNESMITH, professionally known as Mick Ringo, Plaintiff, v. ANTHONY CRATER, professionally known as Master A.C., Defendant.	Case No. FIRST SET OF INTERROGATORIES PROPOUNDED BY PLAINTIFF MANFRED TUNESMITH (PROFESSIONALLY KNOWN AS MICK RINGO) TO DEFENDANT ANTHONY CRATER (PROFESSIONALLY KNOWN AS MASTER A.C.)

PROPOUNDING PARTY:	Manfred Tunesmith, professionally known as Mick Ringo
RESPONDING PARTY:	Anthony Crater, professionally known as Master A.C.
SET NO.:	One

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Local Rule 8.2.1 of the Local Rules of Practice for the United States District Court, Central District of California, Plaintiff Manfred Tunesmith, hereby requests that Defendant Anthony Crater, professionally known as Master A.C., answer the following interrogatories in writing and under oath, within thirty (30) days after service of these interrogatories.

PRELIMINARY STATEMENT

In answering the following interrogatories, you are required to furnish all information that is available to you, including, without limitation, information in the possession, custody or control of your officers, directors, employees, agents, accountants, attorneys, investigators for your attorneys or accountants, experts, representatives or any other person acting on your behalf.

If you are unable to answer any of these interrogatories in full after exercising due diligence to secure the requested information, you should so state in your answer, specifying your inability to answer and stating what information and knowledge you have concerning the unanswered portion.

As set forth in Rule 26(e) of the Federal Rules of Civil Procedure, you are required to supplement your answers hereto where appropriate.

GENERAL DEFINITIONS & INSTRUCTIONS

The following general definitions apply to each interrogatory herein:

A. As used in these interrogatories, the terms YOU, YOUR, and DEFENDANT mean, refer to, and include, individually and collectively, DEFENDANT Anthony Crater, professionally known as Master A.C., and any of his employees, agents, representatives, accountants, attorneys, investigators for his attorneys or accountants, experts, or any other person acting on his behalf.

B. As used in this request, the term PLAINTIFF means, refers to, and includes plaintiff Manfred Tunesmith, professionally known as Mick Ringo.

C. As used in these interrogatories, the term COMPLAINT means, refers to, and includes the COMPLAINT filed by plaintiff in this action.

D. The term ANSWER TO COMPLAINT means and refers to the Answer filed by DEFENDANT in this action.

E. As used in these interrogatories, the terms DOCUMENT and DOCUMENTS mean, refer to, and include the original, or, if not available, one identical copy of the original, and all non-identical copies (whether different from the original by reason of notations or otherwise) of all "documents" as that term is defined in

Rule 34(a) of the Federal Rules of Civil Procedure and all "writings" as that term is defined in Rule 1001(1) of the Federal Rules of Evidence. Every work paper, draft, preliminary version or non-identical copy of a document is a separate document and must be produced in response to this request.

F. As used in these interrogatories, the phrases SOUND RECORDING and SOUND RECORDINGS mean, refer to, and include sound recordings as defined in Title 17 USC § 101, including but not limited to all master recordings, demonstration tapes, and outtakes.

G. As used in these interrogatories, the term TROPICAL ROCK means, refers to, and includes the musical composition that was created and written by plaintiff, and any sound recordings thereof.

H. As used in these interrogatories, the phrase CARIBBEAN ROCK means, refers to, and includes the musical composition that was allegedly created and written by Anthony Crater, and any sound recordings thereof.

I. As used in these interrogatories, the terms "and," "or," "any," and "all" shall be construed either conjunctively or disjunctively as may be necessary to make the question inclusive rather than exclusive.

J. Whenever the context so requires in these interrogatories, the singular shall refer to and include the plural, and the plural shall refer to and include the singular.

K. As used in these interrogatories, the phrase RELATE TO, RELATED TO or RELATING TO means and includes any and all information (including, but not limited to, DOCUMENTS) constituting, evidencing, supporting, referring to or otherwise relating to requested information.

L. The term PERSON shall mean, in the plural as well as in the singular, any natural person, any group of natural persons acting as individuals, any group of natural persons acting in a collegial capacity (*e.g.*, as a committee, board of directors, etc.), any partnership, joint venture, incorporated or unincorporated business, association, enterprise, firm, trust, city, county, governmental agency or body, or any other kind of organization or entity.

M. When used herein with respect to a PERSON, the term IDENTIFY shall mean to state with respect to each such PERSON, the following information: (i) his or her full name; (ii) his or her present or last known business address and business telephone number; and (iii) his or her last known residence address and residence telephone number.

N. When used herein with respect to a corporation, partnership, sole proprietorship or other business entity, the term IDENTIFY shall mean to state with respect to each such corporation, partnership, sole proprietorship or other business entity, the following information: (i) the full name of the business entity; (ii) the present or last known business addresses and business telephone numbers of the business entity; (iii) the business or businesses in which the entity is engaged; and (iv) the names of the officers, directors, partners, and/or principal owners, operators or managers of the corporation, partnership, sole proprietorship or other business entity.

O. When used herein with respect to a DOCUMENT, the term IDENTIFY shall mean to state with respect to each such DOCUMENT, the following information: (i) the nature and substance of the DOCUMENT, including a detailed description of the contents of the DOCUMENT; (ii) the number of pages therein; (iii) the date, if any, of the DOCUMENT; (iv) the identity of each PERSON who signed the DOCUMENT, authored the DOCUMENT, or received or is shown to have received the original or a copy of the DOCUMENT; and (v) the present location of the DOCUMENT, if known, or if unknown, the present location of any reproductions thereof.

P. The terms STATE or STATE THE BASIS, when used with respect to a fact, event, allegation or contention, mean to provide the complete and full details known to YOU that are in any way RELATE TO that fact, event, allegation or contention and all facts that YOU contend support or establish that fact, event, allegation or contention, including, without limitation, the identity of any PERSON, DOCUMENT, oral statements or occurrences that YOU contend support or RELATE TO in any way that fact, event, allegation or contention.

Q. When asked to DESCRIBE an event, fact, situation, contention or basis of allegation, please: (i) describe in detail every act, event, fact or occurrence of any kind whatsoever that supports or RELATES TO the information requested; (ii) identify the maker of each and every oral statement that supports or RELATES TO the information requested, the contents of such statement, the date, time and place such statement was made; and (iii) identify each and every DOCUMENT that supports or RELATES TO the information requested.

INTERROGATORIES

INTERROGATORY NO. 1:

IDENTIFY all educational institutions (whether for the study of music or other subjects) YOU have attended.

INTERROGATORY NO. 2:

Set forth each and every degree YOU have received from the educational institutions YOU have attended.

INTERROGATORY NO. 3:

List all subjects YOU studied at each educational institution YOU have attended.

INTERROGATORY NO. 4:

Have YOU ever heard PLAINTIFF's composition TROPICAL ROCK?

INTERROGATORY NO. 5:

If YOUR answer to the foregoing interrogatory is anything other than an unequivocal "No," set forth the number of times, places and PERSONS present when YOU heard TROPICAL ROCK.

INTERROGATORY NO. 6:

Set forth the period in terms of weeks, months and years during which YOU composed CARIBBEAN ROCK.

INTERROGATORY NO. 7:

IDENTIFY all PERSONS (if any) with whom YOU collaborated in the composition of CARIBBEAN ROCK.

INTERROGATORY NO. 8:

IDENTIFY all PERSONS who participated in the recording of CARIBBEAN ROCK.

INTERROGATORY NO. 9:

Set forth the name of each and every PERSON who participated in the recording of the soundtrack for the motion picture "South Atlantic."

INTERROGATORY NO. 10:

Did YOU use a "temp track"[12] in viewing the motion picture "South Atlantic," in the course of composing the score for "South Atlantic"?

INTERROGATORY NO. 11:

If YOUR answer to the foregoing interrogatory is anything other than an unequivocal "No," set forth each and every musical work included on the temp track.

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12. "**temp track, temp music track** A temporary sound track with music from various sources that is played during early previews or screenings of a film before its own music is composed and recorded." Ira Konigsberg, The Complete Film Dictionary 415 (2d ed. 1997).

INTERROGATORY NO. 12:

Did YOU use material from any preexisting musical works in composing CARIBBEAN ROCK?

INTERROGATORY NO. 13:

If YOUR answer to the foregoing interrogatory is anything other than unequivocal "No," list each and every musical work from which YOU used materials in composing CARIBBEAN ROCK.

INTERROGATORY NO. 14:

[To be used if the plaintiff is a performer] Have YOU ever been at a performance where PLAINTIFF [played the piano, violin, guitar, etc./conducted/sang]?

INTERROGATORY NO. 15:

If YOUR answer to the preceding interrogatory is anything other than an unequivocal "No," list each and every musical work that PLAINTIFF performed on each such occasion.

INTERROGATORY NO. 16:

List each and every DOCUMENT prepared by YOU in the course of composing CARIBBEAN ROCK.

INTERROGATORY NO. 17:

IDENTIFY each PERSON with whom YOU discussed CARIBBEAN ROCK.

INTERROGATORY NO. 18:

IDENTIFY all PERSONS who participated in the creation of CARIBBEAN ROCK.

INTERROGATORY NO. 19:

For each PERSON identified in response to the foregoing interrogatory, DESCRIBE in detail his or her involvement in the creation of CARIBBEAN ROCK.

INTERROGATORY NO. 20:

IDENTIFY all PERSONS who have knowledge RELATING TO the creation of CARIBBEAN ROCK.

INTERROGATORY NO. 21:

For each PERSON identified in response to Interrogatory No. 20, DESCRIBE in detail his or her knowledge RELATING TO the creation of CARIBBEAN ROCK.

INTERROGATORY NO. 22:

IDENTIFY all PERSONS who were involved in the creation of any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK, including but not limited to anyone involved in engineering, programming, arranging, mixing and/or producing.

INTERROGATORY NO. 23:

For each PERSON identified in response to Interrogatory No. 22, DESCRIBE in detail his or her involvement in the creation of the SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK.

INTERROGATORY NO. 24:

IDENTIFY all PERSONS who have knowledge RELATING TO the creation of any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK.

INTERROGATORY NO. 25:

For each PERSON identified in response to Interrogatory No. 24, DESCRIBE in detail the basis of his or her knowledge relating to the creation of the SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK.

INTERROGATORY NO. 26:

IDENTIFY all studios where any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK was recorded.

INTERROGATORY NO. 27:

DESCRIBE in detail all sampling equipment used in the creation of any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK.

INTERROGATORY NO. 28:

List by title and author all sampled material embodied in any SOUND RECORDING of the musical composition entitled CARIBBEAN ROCK.

INTERROGATORY NO. 29:

Set forth the number of sound recordings manufactured, distributed, and/or sold containing any performance of CARIBBEAN ROCK.

INTERROGATORY NO. 30:

Set forth the amount of monies received and costs expended by YOU relating to the manufacture, distribution and/or sale of SOUND RECORDINGS containing any performance of CARIBBEAN ROCK.

INTERROGATORY NO. 31:

STATE THE BASIS for DEFENDANT'S Third Defense of the ANSWER TO COMPLAINT that "[e]ach of the alleged Claims for Relief in the Complaint fails to state a claim upon which relief can be granted."

INTERROGATORY NO. 32:

STATE THE BASIS for DEFENDANT'S Fourth Defense alleged in the ANSWER TO COMPLAINT that "[n]one of the material in CARIBBEAN ROCK alleged to have been copied is original."

INTERROGATORY NO. 33:

STATE THE BASIS for DEFENDANT'S Fifth Defense alleged in the ANSWER TO COMPLAINT that "[n]one of the material in CARIBBEAN ROCK alleged to have been copied constitutes copyrightable material protected by the Copyright Laws of the United States."

INTERROGATORY NO. 34:

STATE THE BASIS for DEFENDANT'S Sixth Defense alleged in the ANSWER TO COMPLAINT that "[i]f any use was made of any material alleged to have been copied by Defendant, which he denies, such use constitutes fair use."

INTERROGATORY NO. 35:

STATE THE BASIS for DEFENDANT'S Seventh Defense alleged in the ANSWER TO COMPLAINT that "[t]he relief sought by Plaintiff is barred by the First Amendment of the Constitution of the United States."

INTERROGATORY NO. 36:

STATE THE BASIS for DEFENDANT'S Eighth Defense alleged in the ANSWER TO COMPLAINT that "[t]he relief sought by Plaintiff is barred by laches."

INTERROGATORY NO. 37:

STATE THE BASIS for DEFENDANT'S Ninth Defense alleged in the ANSWER TO COMPLAINT that "Plaintiff is estopped to assert the purported Claims for Relief set forth in the Complaint."

INTERROGATORY NO. 38:

STATE THE BASIS for DEFENDANT'S Tenth Defense alleged in the ANSWER TO COMPLAINT that "Plaintiff, in making the allegations set forth in the Complaint, has filed unmeritorious and sham claims and by reason thereof Plaintiff is guilty of unclean hands and abuse of copyright and is barred from the relief he seeks herein."

INTERROGATORY NO. 39:

STATE THE BASIS for DEFENDANT'S Eleventh Defense alleged in the ANSWER TO COMPLAINT that "[a]ll or a part of the purported Claims for Relief are barred by 17 U.S.C. § 507 and all other applicable statutes of limitations."

INTERROGATORY NO. 40:

STATE THE BASIS for DEFENDANT'S Twelfth Defense alleged in the ANSWER TO COMPLAINT that "Plaintiff lacks standing to sue on the Claims for Relief set forth in the Complaint."

By:_____
Attorneys for Plaintiff

2. Defendant's Interrogatories

[ATTORNEY NAMES]
[LAW FIRM]

Attorneys for Defendants Anthony Crater, professionally known as Master A.C.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MANFRED TUNESMITH, professionally known as Mick Ringo,	)	Case No. 95-1293 ER (Jgx)
Plaintiff,	)	FIRST SET OF INTERROGATORIES PROPOUNDED BY DEFENDANT ANTHONY CRATER TO PLAINTIFF MANFRED TUNESMITH
v.	)	
ANTHONY CRATER, professionally known as Master A.C.,	)	
Defendant.	)	

PROPOUNDING PARTY:	Anthony Crater, professionally known as Master A.C.
RESPONDING PARTY:	Manfred Tunesmith, professionally known as Mick Ringo
SET NO.:	One

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Local Rule 8.2.1 of the Local Rules of Practice for the United States District Court, Central District of California, Defendant hereby requests that Plaintiff Manfred Tunesmith answer the following interrogatories in writing and under oath, within thirty (30) days after service of these interrogatories.

PRELIMINARY STATEMENT

Adapt from Plaintiff's Preliminary Statement

GENERAL DEFINITIONS

Adapt from Plaintiff's General Definitions

INTERROGATORIES

INTERROGATORY NO. 1:

DESCRIBE each portion of TROPICAL ROCK that YOU claim has been infringed by CARIBBEAN ROCK by setting forth the tones of the musical scale that constitute each such portion of TROPICAL ROCK.

INTERROGATORY NO. 2:

DESCRIBE each portion of CARIBBEAN ROCK that YOU claim infringes TROPICAL ROCK by setting forth the tones of the musical scale that constitute each such portion of CARIBBEAN ROCK.

INTERROGATORY NO. 3:

DESCRIBE each and every musical work composed by YOU setting forth the name of such composition, the dates it was composed, the dates it was published and the publisher thereof, the dates it was recorded, and the recording company or companies who recorded and distributed each such composition.

INTERROGATORY NO. 4:

IDENTIFY all PERSONS who were involved in the creation of TROPICAL ROCK, and, for each such PERSON, describe his/her/its involvement in the creation of TROPICAL ROCK.

INTERROGATORY NO. 5:

IDENTIFY all PERSONS who were involved in the creation of any sound recording embodying TROPICAL ROCK, including, but not limited to, anyone involved in engineering, programming, arranging, mixing and/or producing such sound recordings, and, for each such PERSON, describe in detail his/her/its involvement in the creation of any sound recording embodying TROPICAL ROCK.

INTERROGATORY NO. 6:

DESCRIBE in detail all sampling equipment used in the creation of any sound recording embodying TROPICAL ROCK.

INTERROGATORY NO. 7:

DESCRIBE in detail all sampling equipment used in the creation of TROPICAL ROCK.

INTERROGATORY NO. 8:

List by title and author all sampled materials embodied in TROPICAL ROCK or any SOUND RECORDINGS thereof.

INTERROGATORY NO. 9:

STATE THE BASIS for YOUR contention that DEFENDANT had access to TROPICAL ROCK prior to the creation of CARIBBEAN ROCK.

INTERROGATORY NO. 10:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT that YOU "created and wrote a musical composition entitled TROPICAL ROCK."

INTERROGATORY NO. 11:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT that TROPICAL ROCK "contains a large amount of wholly original material and constitutes copyrightable subject matter under the laws of the United States."

INTERROGATORY NO. 12:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT that "the songwriters and Plaintiff have duly complied with all pertinent provisions of the Copyright Act and all of the laws governing copyright with respect to the musical composition entitled TROPICAL ROCK."

INTERROGATORY NO. 13:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT that "[c]ommencing in or about 1992, and continuing to date, Defendant infringed Plaintiff's copyright in the musical composition entitled 'TROPICAL ROCK' by, among other things, substantially copying, publicly performing, making and distributing, authorizing the making and distributing of, phonorecords, participating in and furthering such infringing acts, and/or sharing in the proceeds therefrom, all through substantial use of the musical composition entitled TROPICAL ROCK in and as part of a song entitled CARIBBEAN ROCK recorded by Defendant."

INTERROGATORY NO. 14:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT regarding the purported infringing acts of DEFENDANT.

INTERROGATORY NO. 15:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT that "Defendant has full knowledge that his acts are wrongful and unlawful and have continued to infringe said copyright."

INTERROGATORY NO. 16:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT that "Defendant's infringing acts were and continue to be committed willfully."

INTERROGATORY NO. 17:

IDENTIFY and set forth in detail each and every element of damages, including the amount thereof that support YOUR allegations contained in Paragraph___of the

COMPLAINT that "Plaintiff has sustained damages in excess of $1,000,000 and is entitled to exemplary and punitive damages in an amount to be proven at trial."

INTERROGATORY NO. 18:

STATE THE BASIS for YOUR allegations contained in Paragraph___of the COMPLAINT that "Defendant has infringed Plaintiff's international copyrights."

INTERROGATORY NO. 19:

STATE THE BASIS for YOUR allegation contained in Paragraph___of the COMPLAINT that "the public performance royalties collected by BMI[13] should be paid to Plaintiff."

INTERROGATORY NO. 20:

Set forth the number of SOUND RECORDINGS manufactured, distributed, and/or sold containing any performance of TROPICAL ROCK.

INTERROGATORY NO. 21:

Set forth the amount of monies received and costs expended by YOU relating to the manufacture, distribution and/or sale of SOUND RECORDINGS containing any performance of TROPICAL ROCK.

Dated:_____ By:_____
Attorneys for Defendants_____

E. Requests for Production of Documents and Things[14]

1. Defendant's Requests

[ATTORNEY NAMES]
[LAW FIRM]

Attorneys for Defendants Anthony Crater,
professionally known as Master A.C.

13. BMI is, along with ASCAP, SESAC, and others, a performing rights society, which by formulae based on credits earned by composers, authors, and publishers, distributes performance royalties on a proportionate basis to its members.
14. *See* Fed. R. Civ. P. 34.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MANFRED TUNESMITH, professionally known as Mick Ringo,	)	Case No. 95-1293 ER (Jgx)
Plaintiff,	)	DEFENDANT'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS PROPOUNDED TO PLAINTIFFS
v.	)	
ANTHONY CRATER, professionally known as Master A.C.,	)	
Defendant.	)	

PROPOUNDING PARTY: Anthony Crater, professionally known as Master A.C.
RESPONDING PARTY: Manfred Tunesmith, professionally known as Mick Ringo
SET NO.: One

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, Defendant Anthony Crater hereby requests that Plaintiff produce for inspection and photocopying the documents and writings described below, which are in the possession, custody, or control of plaintiff (including his officers, agents, employees and attorneys). The documents and writings shall be produced on _____, at 10 A.M. at the law offices of _____, located at _____.

PRELIMINARY STATEMENT

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, a written response to this request is required of plaintiff within thirty (30) days after service hereof. If you fail to respond and/or do not permit the inspection and copying of documents as requested, Defendant is entitled to move for an order compelling a response and/or inspection and for reimbursement of the expenses in making such motion. If you object to producing any requested document, category of documents or part of any category of documents, the document, the category or the part thereof must be specified.

If any document is withheld on the grounds of privilege or other immunity from discovery, set forth, with respect to each such document, its date, author,

addressee, title, the identity of those who received or saw (or heard) the original or copies of such document, the location of the document, and a brief description of the document that you would consider adequate to support your contention that it is privileged or otherwise immune, as well as each fact upon which you based your claim of privilege or other immunity.

In responding to this request, you are required to produce all requested documents, whether prepared by or for you, or by or for any other person or entity, that are in your possession or custody, or under your control, or that are in the possession or custody, or under the control, of your agents, employees, representatives, attorneys, investigators for your attorneys, consultants, anyone acting on your behalf, or anyone over whom you exercise control with respect to documents in that person's possession, regardless of where the documents may be located.

You are required to produce the documents as they are kept in the usual course of business, or you may organize and label them to correspond to the categories in this request.

You are hereby notified that, at trial or any other proceeding before the Court, Defendant will apply to the Court for an order precluding you from introducing any documents or evidence that are responsive to and/or are related to the subject of this request but which were not produced or disclosed by your responses.

GENERAL DEFINITIONS

The following general definitions apply to each request for documents contained herein:

A. As used in this request, the terms YOU, YOUR, and PLAINTIFF mean, refer to, and include plaintiff Manfred Tunesmith, professionally known as Mick Ringo, and any of his employees, agents, representatives, accountants, attorneys, investigators for their attorneys or accountants, experts, or any other person acting on his behalf.

B. As used in this request, the term DEFENDANT means, refers to, and includes Defendant Anthony Crater p/k/a "Master A.C."

C. As used in this request, the term COMPLAINT means, refers to, and includes the Complaint for Copyright Infringement of plaintiff on file in this action.

D. The term ANSWER TO COMPLAINT means and refers to the Answer filed by DEFENDANT in this action.

E. As used in this request, the term TROPICAL ROCK means and refers to the musical composition that was allegedly created and written by PLAINTIFF, and any sound recordings thereof.

F. As used in this request, the words CARIBBEAN ROCK means and refers to the musical composition that was created and written by DEFENDANT, and any sound recordings thereof.

G. As used in this request, the phrases SOUND RECORDING and SOUND RECORDINGS mean, refer to, and include sound recordings as defined in Title 17 USC § 101, including but not limited to all master recordings, demonstration tapes, and outtakes.

H. As used in this request, the terms EVIDENCE(S), EVIDENCING, RELATING TO, and/or RELATE OR REFER TO mean and include any and all documents constituting, evidencing, supporting, referring to or otherwise relating to a requested category or subject matter of documents, irrespective of whether or not such relationship is shown on the face of the document.

I. As used in this request, the terms DOCUMENT and DOCUMENTS mean, refer to, and include the original, or, if not available, one identical copy of the original, and all non-identical copies (whether different from the original by reason of notations or otherwise) of all "documents" as that term is defined in Rule 34(a) of the Federal Rules of Civil Procedure and all "writings" as that term is defined in Rule 1001(1) of the Federal Rules of Evidence. Every work paper, draft, preliminary version or non-identical copy of a document is a separate document and must be produced in response to this request.

J. As used in this request, the terms "and," and "or" shall be construed either conjunctively or disjunctively as may be necessary to make the request inclusive rather than exclusive. The word "ALL" shall mean "any and all" so as to bring within the scope of this Request all DOCUMENTS that otherwise might be construed to be outside its scope.

K. Whenever the context so requires in this request, the singular shall refer to and include the plural, and the plural shall refer to and include the singular.

DOCUMENTS REQUESTED

REQUEST NO. 1:

ALL SOUND RECORDINGS embodying any version of TROPICAL ROCK, including but not limited to master recordings, demonstration tapes and/or outtakes.

REQUEST NO. 2:

ALL SOUND RECORDINGS made in connection with the creation of TROPICAL ROCK, including but not limited to master recordings, demonstration

tapes and/or outtakes embodying previous versions of said composition, whether entitled "TROPICAL ROCK" or something else.

REQUEST NO. 3:

ALL SOUND RECORDINGS relating to the creation of TROPICAL ROCK, including but not limited to ALL master recordings, demonstration tapes and/or outtakes embodying previous versions of the composition TROPICAL ROCK, whether entitled "TROPICAL ROCK" or something else.

REQUEST NO. 4:

ALL SOUND RECORDINGS embodying any musical composition or part of any composition on which TROPICAL ROCK was based in whole or in part.

REQUEST NO. 5:

ALL DOCUMENTS that REFER or RELATE TO the creation of TROPICAL ROCK, including but not limited to ALL notes and/or sheet music.

REQUEST NO. 6:

ALL DOCUMENTS that REFER or RELATE TO the creation of any SOUND RECORDINGS of TROPICAL ROCK.

REQUEST NO. 7:

ALL SOUND RECORDINGS embodying in whole or in part TROPICAL ROCK, including but not limited to ALL master recordings, demonstration tapes and outtakes.

REQUEST NO. 8:

ALL SOUND RECORDINGS made in connection with the performance by any artist of TROPICAL ROCK.

REQUEST NO. 9:

Any sampling device (including but not limited to a keyboard with sampling capabilities) containing in its memory any portion of TROPICAL ROCK.

REQUEST NO. 10:

Any sampling device (including but not limited to a keyboard with sampling capabilities) used to create TROPICAL ROCK or any SOUND RECORDING embodying TROPICAL ROCK.

REQUEST NO. 11:

ALL computer discs or similar devices used to store information embodying all or any portion of TROPICAL ROCK.

REQUEST NO. 12:

ALL computer discs or similar devices used to store information embodying all or any portion of any SOUND RECORDING of TROPICAL ROCK.

REQUEST NO. 13:

ALL DOCUMENTS that RELATE or REFER TO ALL individuals or entities involved in the creation of TROPICAL ROCK.

REQUEST NO. 14:

ALL DOCUMENTS that RELATE or REFER TO ALL individuals or entities involved in the creation of any SOUND RECORDING embodying TROPICAL ROCK.

REQUEST NO. 15:

ALL DOCUMENTS that RELATE or REFER TO ALL individuals or entities involved in the recording of TROPICAL ROCK.

REQUEST NO. 16:

ALL DOCUMENTS that RELATE or REFER TO ALL recording studios or other places where TROPICAL ROCK was created and/or recorded.

REQUEST NO. 17:

ALL DOCUMENTS that RELATE OR REFER TO ALL individuals or entities involved in or present at the creation of any SOUND RECORDING of TROPICAL ROCK.

REQUEST NO. 18:

ALL applications for copyright registration filed with the United States Copyright Office that RELATE or REFER TO TROPICAL ROCK.

REQUEST NO. 19:

ALL applications for copyright registration filed with the United States Copyright Office that relate or refer to any SOUND RECORDING of all or any part of TROPICAL ROCK.

REQUEST NO. 20:

ALL DOCUMENTS deposited with the United States Copyright Office embodying and/or relating to TROPICAL ROCK.

REQUEST NO. 21:

ALL certificates of copyright issued by the United States Copyright Office that RELATE or REFER TO either TROPICAL ROCK and/or any SOUND RECORDING embodying TROPICAL ROCK.

REQUEST NO. 22:

ALL DOCUMENTS, including, but not limited to, correspondence, between YOU, on the one hand, and the United States Copyright Office, on the other hand, that RELATE or REFER TO either TROPICAL ROCK or any SOUND RECORDING embodying TROPICAL ROCK.

REQUEST NO. 23:

ALL DOCUMENTS, including, but not limited to, correspondence, that RELATE or REFER TO the creation of TROPICAL ROCK or any SOUND RECORDING embodying TROPICAL ROCK, including, but not limited to, ALL correspondence between YOU, on the one hand, and anyone involved in engineering, programming, arranging, mixing or producing any SOUND RECORDINGS embodying TROPICAL ROCK, on the other hand.

REQUEST NO. 24:

ALL DOCUMENTS that RELATE or REFER TO ALL oral communications pertaining to TROPICAL ROCK between YOU, on the one hand, and anyone else, including, but not limited to, anyone involved in engineering, programming, arranging, mixing or producing any SOUND RECORDINGS embodying TROPICAL ROCK, on the other hand.

REQUEST NO. 25:

ALL DOCUMENTS, including, but not limited to, correspondence, that RELATE or REFER TO any written and/or oral communications between YOU, on the one hand, and DEFENDANT, on the other hand, regarding any SOUND RECORDING embodying TROPICAL ROCK.

REQUEST NO. 26:

ALL DOCUMENTS, including, but not limited to, correspondence, between YOU and DEFENDANT.

REQUEST NO. 27:

ALL DOCUMENTS, including, but not limited to, correspondence, between YOU, on the one hand, and DEFENDANT, on the other hand, that RELATE or REFER TO the musical compositions TROPICAL ROCK and/or CARIBBEAN ROCK, or any SOUND RECORDINGS of TROPICAL ROCK and/or CARIBBEAN ROCK.

REQUEST NO. 28:

ALL DOCUMENTS, including, but not limited to, correspondence, between YOU, on the one hand, and any other individual or entity, on the other hand, that RELATE or REFER TO TROPICAL ROCK or any SOUND RECORDING of TROPICAL ROCK.

REQUEST NO. 29:

ALL DOCUMENTS, including, but not limited to, reports and correspondence, prepared by any musicologist or anyone else YOU intend to call as an expert witness at trial comparing the musical compositions CARIBBEAN ROCK and TROPICAL ROCK.

REQUEST NO. 30:

ALL DOCUMENTS, including, but not limited to, agreements (including amendments, attachments or addendums thereto), between YOU, on the one hand, and DEFENDANT, on the other hand, that RELATE or REFER TO TROPICAL ROCK or any SOUND RECORDINGS thereof.

REQUEST NO. 31:

ALL DOCUMENTS, including, but not limited to, agreements (including amendments, attachments or addendums thereto), that RELATE or REFER TO TROPICAL ROCK or any SOUND RECORDINGS embodying TROPICAL ROCK.

REQUEST NO. 32:

ALL DOCUMENTS, including, but not limited to, licensing agreements (including amendments, attachments or addendums thereto), that RELATE OR REFER TO TROPICAL ROCK or any SOUND RECORDINGS embodying TROPICAL ROCK.

REQUEST NO. 33:

ALL DOCUMENTS, including, but not limited to, agreements (including amendments, attachments or addendums thereto), that RELATE or REFER TO any album, record, compact disc, tape, cassette or any other material or thing, whether analog or digital, containing any SOUND RECORDING of TROPICAL ROCK.

REQUEST NO. 34:

ALL DOCUMENTS that RELATE or REFER TO the registration of TROPICAL ROCK with any performing rights society.

REQUEST NO. 35:

ALL DOCUMENTS that RELATE or REFER TO the payment of any royalties or other monies by any performing rights society to YOU for TROPICAL ROCK, including, but not limited to ALL royalty statements.

REQUEST NO. 36:

ALL DOCUMENTS that RELATE or REFER TO the number of SOUND RECORDINGS manufactured, distributed and/or sold containing any performance of TROPICAL ROCK.

REQUEST NO. 37:

ALL DOCUMENTS that RELATE or REFER TO the receipt of any monies by YOU from the exploitation of TROPICAL ROCK and any SOUND RECORDINGS thereof.

REQUEST NO. 38:

ALL DOCUMENTS that RELATE or REFER TO any profits made by YOU from the exploitation of TROPICAL ROCK and ANY SOUND RECORDINGS thereof.

REQUEST NO. 39:

ALL DOCUMENTS that RELATE or REFER TO the gross receipts collected by YOU from any licensee from the exploitation of TROPICAL ROCK or any SOUND RECORDINGS thereof.

REQUEST NO. 40:

ALL DOCUMENTS that RELATE or REFER TO any claim for copyright infringement made by YOU during the last ten years.

REQUEST NO. 41:

ALL DOCUMENTS that RELATE or REFER TO any lawsuit for copyright infringement filed by YOU during the last ten years.

REQUEST NO. 42:

ALL DOCUMENTS, including, but not limited to, correspondence, that RELATE or REFER TO DEFENDANT's access to TROPICAL ROCK.

REQUEST NO. 43:

ALL DOCUMENTS that RELATE or REFER TO TROPICAL ROCK and/or any SOUND RECORDING embodying TROPICAL ROCK.

REQUEST NO. 44:

ALL DOCUMENTS that RELATE or REFER TO any sampled material embodied in any SOUND RECORDINGS of TROPICAL ROCK.

REQUEST NO. 45:

ALL DOCUMENTS, including, but not limited to, agreements (including amendments, attachments or addendums thereto), that RELATE or REFER TO the granting of permission to use the sampled material embodied in any SOUND RECORDINGS of TROPICAL ROCK.

REQUEST NO. 46:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that YOU created and wrote TROPICAL ROCK.

REQUEST NO. 47:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that TROPICAL ROCK "contains a large amount of wholly original material and constitutes copyrightable subject matter under the laws of the United States."

REQUEST NO. 48:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT, that "[a]t all times relevant hereto, the songwriters and Plaintiff have duly complied with all pertinent provisions of the Copyright Act and all of the laws governing copyright with respect to the musical composition entitled TROPICAL ROCK."

REQUEST NO. 49:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations of Paragraph___of the COMPLAINT regarding DEFENDANT's alleged infringement of YOUR copyright in TROPICAL ROCK.

REQUEST NO. 50:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations set forth in Paragraph—of the COMPLAINT.

REQUEST NO. 51:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that "Defendant's infringing acts were and continue to be committed willfully."

REQUEST NO. 52:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that "Plaintiff has sustained damages in excess of $1,000,000 and is entitled to exemplary and punitive damages in an amount to be proven at trial."

REQUEST NO. 53:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that DEFENDANT has violated PLAINTIFF's "international copyrights" by publicly performing CARIBBEAN ROCK.

REQUEST NO. 54:

ALL DOCUMENTS that RELATE or REFER TO any international copyrights in TROPICAL ROCK.

REQUEST NO. 55:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that PLAINTIFF's international copyrights have been violated by the sale of phonorecords mechanically reproducing CARIBBEAN ROCK in various territories of the world outside of the United States.

REQUEST NO. 56:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations of Paragraph___of the COMPLAINT that "Defendant has infringed Plaintiff's international copyrights."

REQUEST NO. 57:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that "[s]uch failure to attribute the authorship and copyright ownership of the musical composition is done with full knowledge of the falsity of such representation and designation of origin."

REQUEST NO. 58:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the allegations in Paragraph___of the COMPLAINT that "Defendant's acts as foresaid have been undertaken willfully and maliciously."

REQUEST NO. 59:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO YOUR contention in Paragraph___of the COMPLAINT that "the public performance royalties collected by Broadcast Music, Inc. ("BMI")[15] should be paid to Plaintiff."

Dated: _____

By: _____
Attorneys for Defendants_____

2. Plaintiff's Requests

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, Plaintiff Manfred Tunesmith hereby requests that Defendant Anthony Crater produce for inspection and photocopying the documents and writings described below that are in the possession, custody, or control of Defendant (including his officers, agents, employees and attorneys). The requested documents and writings shall be produced on_____, at 10 A.M. at the law offices of_____, located at_____.

PRELIMINARY STATEMENT

Adapt from Defendant's Preliminary Statement.

GENERAL DEFINITIONS

Adapt from Defendant's General Definitions.

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15. S*ee, supra*, note 13.

DOCUMENTS REQUESTED

REQUEST NO. 1:

ALL SOUND RECORDINGS embodying any version of the musical composition entitled CARIBBEAN ROCK including but not limited to master recordings, demonstration tapes and/or outtakes.

REQUEST NO. 2:

ALL SOUND RECORDINGS made in connection with the creation of the musical composition entitled CARIBBEAN ROCK including but not limited to master recordings, demonstration tapes and/or outtakes embodying previous versions of CARIBBEAN ROCK, whether entitled CARIBBEAN ROCK or something else.

REQUEST NO. 3:

ALL SOUND RECORDINGS that EVIDENCE, REFER TO or RELATE to the creation of the musical composition entitled CARIBBEAN ROCK including but not limited to all master recordings, demonstration tapes and/or outtakes embodying previous versions of CARIBBEAN ROCK, whether entitled CARIBBEAN ROCK or something else.

REQUEST NO. 4:

ALL SOUND RECORDINGS embodying any musical composition or part of a composition on which CARIBBEAN ROCK was based in whole or in part.

REQUEST NO. 5:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the creation of the musical composition entitled CARIBBEAN ROCK including but not limited to all notes and/or sheet music.

REQUEST NO. 6:

ALL demonstration tapes or outtakes made in connection with the creation of the SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK contained on the CD entitled "Master A.C.'s Greatest Hits," and the maxi single entitled "Master A.C.'s CARIBBEAN ROCK."

REQUEST NO. 7:

ALL SOUND RECORDINGS embodying in whole or in part the musical composition entitled CARIBBEAN ROCK including but not limited to all master recordings, demonstration tapes and outtakes.

REQUEST NO. 8:

ALL SOUND RECORDINGS made in connection with the performance by DEFENDAN as Master A.C. or otherwise of the musical composition entitled CARIBBEAN ROCK embodied on the CD entitled "Master A.C.'s Greatest Hits," and the maxi single entitled "Master A.C.'s CARIBBEAN ROCK."

REQUEST NO. 9:

ALL SOUND RECORDINGS embodying any prior version of the musical composition entitled CARIBBEAN ROCK that is embodied on the CD entitled "Master A.C.'s Greatest Hits," or the maxi single entitled "Master A.C.'s CARIBBEAN ROCK."

REQUEST NO. 10:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the creation of any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK including but not limited to all notes or sheet music.

REQUEST NO. 11:

Any sampling device (including but not limited to a keyboard with sampling capabilities) containing in its memory any portion of the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 12:

Any sampling device (including but not limited to a keyboard with sampling capabilities) used to create the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK.

REQUEST NO. 13:

ALL computer discs or similar devices used to store information embodying all or a portion of the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 14:

ALL computer discs or similar devices used to store information embodying all or a portion of the SOUND RECORDING entitled CARIBBEAN ROCK.

REQUEST NO. 15:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the names of any individuals or entities involved in the creation of the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 16:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the names of any individuals or entities involved in the creation of any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 17:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the names of any individuals or entities involved in the recording of the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 18:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO any recording studio or other place where the musical composition entitled CARIBBEAN ROCK was created.

REQUEST NO. 19:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO any recording studio or other place where any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK was created.

REQUEST NO. 20:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the recording studio or other place where the musical composition entitled CARIBBEAN ROCK was recorded.

REQUEST NO. 21:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the recording session(s) where any SOUND RECORDING entitled CARIBBEAN ROCK was recorded.

REQUEST NO. 22:

ALL applications for copyright registration filed with the United States Copyright Office that RELATE or REFER TO the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 23:

ALL applications for copyright registration filed with the United States Copyright Office that RELATE or REFER TO any SOUND RECORDING entitled CARIBBEAN ROCK.

REQUEST NO. 24:

ALL deposits made with the United States Copyright Office embodying the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 25:

ALL certificates of copyright issued by the United States Copyright Office that RELATE or REFER TO either the musical composition entitled CARIBBEAN ROCK and/or any SOUND RECORDING embodying CARIBBEAN ROCK.

REQUEST NO. 26:

ALL correspondence between DEFENDANT or anyone else on DEFENDANT'S behalf, on the one hand, and the United States Copyright Office, on the other hand, RELATING or REFERRING TO either the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK.

REQUEST NO. 27:

ALL correspondence that RELATES or REFERS TO the creation of the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK, including but not limited to all correspondence between DEFENDANT. or anyone else on DEFENDANT'S behalf, on the one hand, and anyone involved in engineering, programming, arranging, mixing or

producing of any SOUND RECORDINGS embodying the musical composition entitled CARIBBEAN ROCK, on the other hand.

REQUEST NO. 28:

ALL correspondence that EVIDENCES, RELATES or REFERS TO the creation of either the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK.

REQUEST NO. 29:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO any oral communications pertaining to CARIBBEAN ROCK between DEFENDANT, on the one hand, and anyone else, including but not limited to anyone involved in engineering, programming, arranging, mixing or producing any SOUND RECORDINGS embodying the musical composition CARIBBEAN ROCK, on the other hand.

REQUEST NO. 30:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO any oral communications between DEFENDANT, on the one hand, and Ultimate Studios and Dynamite Pictures, or either of them, on the other hand, RELATING or REFERRING TO the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 31:

ALL correspondence between DEFENDANT, on the one hand, and Ultimate Studios and Dynamite Pictures, or either of them, on the other hand, that RELATES or REFERS TO either the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK.[16]

REQUEST NO. 32:

ALL SOUND RECORDINGS embodying the musical composition entitled TROPICAL ROCK.

REQUEST NO. 33:

ALL correspondence between DEFENDANT, on the one hand, and anyone else, on the other hand, that RELATES or REFERS TO the musical composition entitled TROPICAL ROCK.

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16. If more than one defendant, any of these requests can be adapted. For example, this one may be: ALL correspondence between any two or more DEFENDANTS that RELATES or REFERS TO either the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK. However, note that, if additional defendants are named *(e.g.*, the music publisher, the production company, etc.), requests relating to matters over which those defendants have knowledge should be put in set(s) of Requests for Production of Documents that are propounded directly to each of the additional defendants. The same applies to Interrogatories and Requests for Admission.

REQUEST NO. 34:

ALL correspondence between DEFENDANT, on the one hand, and Ultimate Studios or Dynamite Picture, or either of them, on the other hand, that RELATES or REFERS TO the musical composition entitled TROPICAL ROCK.

REQUEST NO. 35:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the musical composition entitled TROPICAL ROCK.

REQUEST NO. 36:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO any communications (face-to-face, telephonic or otherwise) between DEFENDANT (as Master A.C. or otherwise), on the one hand, and PLAINTIFF (as Mick Ringo or otherwise), on the other hand.

REQUEST NO. 37:

ALL correspondence between anyone involved in the creation of the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK, on the one hand, and PLAINTIFF (as Mick Ringo or otherwise), on the other hand.

REQUEST NO. 38:

ALL reports prepared by a musicologist or anyone else that compare the musical compositions entitled CARIBBEAN ROCK and TROPICAL ROCK.

REQUEST NO. 39:

ALL agreements (including amendments, attachments and addendums thereto) between or among any two or more of the DEFENDANTS. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 40:

ALL agreements (including amendments, attachments and addendums thereto) between or among any two or more of the DEFENDANTS that RELATE or REFER to the musical composition entitled CARIBBEAN ROCK. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 41:

ALL agreements (including amendments, attachments and addendums thereto) between or among any two or more of the DEFENDANTS that RELATE or REFER TO any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 42:

ALL agreements (including amendments, attachments and addendums thereto) that RELATE or REFER to the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK.

REQUEST NO. 43:

ALL licensing agreements that RELATE or REFER TO the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 44:

ALL licensing agreements that RELATE or REFER TO any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 45:

ALL agreements (including amendments, attachments and addendums thereto) that RELATE or REFER TO either the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK.

REQUEST NO. 46:

ALL agreements (including amendments, attachments and addendums thereto) that RELATE or REFER TO the album entitled "Master A.C.'s Greatest Hits."

REQUEST NO. 47:

ALL agreements (including amendments, attachments and addendums thereto) that RELATE or REFER TO the maxi single entitled "Master A.C.'s CARIBBEAN ROCK."

REQUEST NO. 48:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO any agreement between or among any of the DEFENDANTS RELATING or REFERRING TO the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 49:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the registration of the musical composition entitled CARIBBEAN ROCK with any performing rights society, including but not limited to Broadcast Music, Inc. ("BMI").

REQUEST NO. 50:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the payment of any royalties or other monies by BMI or any other performing rights society to any one or more of the DEFENDANTS for the musical composition entitled CARIBBEAN ROCK including but not limited to all royalty statements. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 51:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the number of SOUND RECORDINGS manufactured, distributed and/or sold containing the performance of the composition entitled CARIBBEAN ROCK including but not limited to the CD entitled "Master A.C.'s Greatest Hits," and the maxi single entitled "CARIBBEAN ROCK."

REQUEST NO. 52:

ALL royalty statements sent to or from any one or more of the DEFENDANTS that EVIDENCE, RELATE or REFER TO the exploitation of the musical composition or SOUND RECORDING entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROCK. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 53:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the receipt of any monies by any one or more of the DEFENDANTS from the exploitation of the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDING embodying CARIBBEAN ROC, including but not limited to cancelled checks. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 54:

ALL royalty statements that EVIDENCE, RELATE or REFER TO the musical composition entitled CARIBBEAN ROCK or any SOUND RECORDINGS embodying CARIBBEAN ROCK.

REQUEST NO. 55:

ALL Soundscan reports that EVIDENCE, RELATE or REFER TO the sale of the album entitled "Master A.C.'s Greatest Hits," and the maxi single entitled "Master A.C.'s CARIBBEAN ROCK."

REQUEST NO. 56:

ALL DOCUMENTS that EVIDENCE, RELATE, or REFER TO the gross receipts collected by DEFENDANT from the exploitation of any of the following SOUND RECORDINGS: Album entitled "Master A.C.'s Greatest Hits;" and Maxi single entitled "Master A.C.'s CARIBBEAN ROCK."

REQUEST NO. 57:

ALL DOCUMENTS that EVIDENCE, RELATE TO or REFER TO the expenses incurred by any of the DEFENDANTS in connection with the exploitation of any of the following SOUND RECORDINGS: Album entitled "Master A.C.'s Greatest Hits;" and Maxi single entitled "Master A.C.'s CARIBBEAN ROCK." [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 58:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the profits made by DEFENDANT from the exploitation of any of the following SOUND RECORDINGS: (a) Album entitled "Master A.C.'s Greatest Hits;" (b) Maxi single entitled "Master A.C.'s CARIBBEAN ROCK."

REQUEST NO. 59:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the gross receipts collected by DEFENDANT from the exploitation of the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 60:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the expenses incurred by DEFENDANT in connection with the exploitation of the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 61:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the profits made by DEFENDANT from the exploitation of the musical composition entitled CARIBBEAN ROCK

REQUEST NO. 62:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO the indemnification of any one or more of the DEFENDANTS by any one or more of the other DEFENDANTS for any legal fees or damages incurred in connection with this action. [IF MORE THAN ONE DEFENDANT]

REQUEST NO. 63:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO any claim for copyright infringement made against DEFENDANT during the last 10 years.

REQUEST NO. 64:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO any lawsuit for copyright infringement filed against DEFENDANT during the last 10 years.

REQUEST NO. 65:

ALL DOCUMENTS that EVIDENCE, RELATE or REFER TO DEFENDANT'S access to the musical composition entitled TROPICAL ROCK.

REQUEST NO. 66:

ALL DOCUMENTS that RELATE or REFER TO the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 67:

ALL DOCUMENTS that RELATE or REFER TO any SOUND RECORDING embodying the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 68:

ALL DOCUMENTS that EVIDENCE, REFER or RELATE TO any sampled material embodied in any of the SOUND RECORDINGS embodying the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 69:

ALL agreements (including amendments, attachments and addendums thereto) that RELATE or REFER TO the grant of permission to use the sampled material embodied in any of the SOUND RECORDINGS embodying the musical composition entitled CARIBBEAN ROCK.

REQUEST NO. 70:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[e]ach of the alleged Claims for Relief in the Complaint fails to state a claim upon which relief can be granted."

REQUEST NO. 71:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[n]one of the material in CARIBBEAN ROCK alleged to have been copied is original."

REQUEST NO. 72:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[n]one of the material in CARIBBEAN ROCK alleged to have been copied constitutes copyrightable material protected by the Copyright Laws of the United States."

REQUEST NO. 73:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[i]f any use was made of any material alleged to have been copied by Defendant, which he denies, such use constitutes fair use."

REQUEST NO. 74:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[t]he relief sought by Plaintiff is barred by the First Amendment of the Constitution of the United States."

REQUEST NO. 75:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[t]he relief sought by Plaintiff is barred by laches."

REQUEST NO. 76:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "Plaintiff is estopped to assert the purported Claims for Relief set forth in the Complaint."

REQUEST NO. 77:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "Plaintiff, in making the allegations set forth in the Complaint, has filed unmeritorious and sham claims and, by reason thereof, plaintiff is guilty of unclean hands and abuse of copyright and is barred from the relief he seeks herein."

REQUEST NO. 78:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[a]ll or a part of the purported Claims for Relief are barred by 17 U.S.C. § 507 and all other applicable statutes of limitations."

REQUEST NO. 79:

ALL DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that that "Plaintiff lacks standing to sue on the Claims for Relief set forth in the Complaint."

REQUEST NO. 80:

All DOCUMENTS that support, EVIDENCE or RELATE TO the___th Defense alleged in the ANSWER TO COMPLAINT that "[t]he Court lacks jurisdiction over the subject matter of the alleged claims set forth in the Second, Third, and Fourth Claims for Relief."

By:_____
Attorneys for Plaintiffs_____

V. Requests for Admission[17]

A. Practice Point

Pragmatically and simply stated, requests for admission are of limited utility except in instances where the fact, event, or conduct to be admitted is virtually beyond dispute. For example, it is a waste of time to request that the defendant admit that he copied protectable expression from plaintiff's work in composing his own. Yet, such requests do turn up in the course of copyright infringement litigation. Requests for admission have value only when tailored properly to place facts, events, or conduct beyond dispute: for example, a request that the defendant admit that he heard plaintiff's work before composing his own or was at a location during a time when plaintiff's work received widespread air play over the radio. Similarly, a defendant may wish to ask for admissions to prove that the musical figure plaintiff alleges was copied is unprotectable under the copyright laws. It should also be noted that, if the responding party does not admit that which is or should be undisputed, a motion may be made for sanctions against a recalcitrant or evasive party.

17. *See* Fed R. Civ. P. 36.

B. Defendant's Requests for Admission

REQUEST FOR ADMISSION NO. 1:

Admit that the intervals 1-5-4-3-2-3-1 have been used in compositions by Franz Schubert, Alexander Borodin, Johann Sebastian Bach, Darius Milhaud, Georges Bizet, Neil Diamond and Felix Mendelssohn.

REQUEST FOR ADMISSION NO. 2:

Admit that the intervals 1-5-4-3-2-3-1 is a commonplace musical sequence used in compositions predating both TROPICAL ROCK and CARIBBEAN ROCK.

REQUEST FOR ADMISSION NO. 3:

Admit that the interval 5-1 is a cadence commonly used in Western music to conclude phrases in, and endings of, musical works.

C. Plaintiff's Requests for Admission

REQUEST FOR ADMISSION NO. 1:

Admit that YOU were in Detroit, Michigan performing at the Orpheum Theatre from March 12 to March 26, 2002.

REQUEST FOR ADMISSION NO. 2:

Admit that while YOU were in Detroit, Michigan from March 12 to March 26, 2002, YOU heard TROPICAL ROCK.

VI. The Taking of Depositions

After receipt of interrogatory responses and documents, depositions should be noticed for the opposing party and other individuals identified in his interrogatory answers or whose identities were discovered when the lawyers were marshalling the facts before (plaintiff) and after (defendant) plaintiff's claim of infringement was asserted. Preparation for the depositions of plaintiff, defendant, and third parties having meaningful involvement with each of them and their compositions often varies according to a number of factors, including the following: The personal styles of the lawyer who will examine the deponents; whether questions should be approached on a strict chronological basis; what each lawyer deems important; asking questions based on law applicable to each given set of facts (e.g., whether plaintiff's claim arguably focuses on commonplace and, therefore, unprotectable building blocks of music); how the deposition examination should be structured (e.g., whether by chronology or subject matter); the demeanor of the lawyer toward each particular deponent

(e.g., formal, seemingly casual, stern versus soft spoken, etc.); the size of the deponent's ego and whether the examiner should play to that ego to elicit ostentatious displays of knowledge, which may prove damaging to the egotistical plaintiff or defendant; the use of at least three different types of questions—"direct," "open" and "oblique," and their particular functions at a deposition. Proper attention to and consideration of these factors can often lead to the revelation of veritable nuggets to be used against your opponent, either in support of a motion for summary judgment or during trial. But how are deposition questions defined or described and how are they used?

A. Direct Questions

Direct questions are those designed to elicit a response to establish a narrow range of facts:

Q. When did you first have the idea to compose "Tropical Rock"?
A. In 1996, when I was on vacation in Jamaica.
Q. Was there something or someone in Jamaica that inspired you to write "Tropical Rock"?
A. Well, I'm always inspired.
Q. Please answer the question. Ms. Reporter, please read the question back for the witness.
[Question read]
A. I was listening to a Jamaican steel band outside my hotel, and they used a certain beat that was new to me.
Q. What was there about the beat that was new to you?
A. There was a pause between the second and third beats, so that, even though each note was supposed to have equal duration on each of those beats, the third beat has lesser time value than it ordinarily would have. Do you get what I'm saying?
Q. I think so. You mean that, because of the delay in playing the third beat, it was kind of robbed of its full duration. Is that it?
A. Yeah, that's it.

Comment

This series of questions provides guidance for the examiner in three respects:

(1) Although the direct question may provide an answer that is complete in and of itself, it also often contains within its seemingly limited response the germ for further inquiry;

(2) Do not be wedded to a "script" but, rather, be prepared to follow up and improvise on the job until the examiner has exhausted the possibilities of the answer to the first direct question; and
(3) Know when to quit and move on, having achieved the maximum out of a basic set of questions, all triggered by the first direct question.

What has been accomplished with these questions?

The answer to the first question gave birth to four additional questions, which establish that, when the plaintiff wrote "Tropical Rock," he used a standard and therefore unprotectable musical device, *rubato*[18] —literally meaning "robbed" in Italian—where one note is robbed of a portion of its durational value and added to a succeeding note (thus "stolen time") which provides flexibility for the performer and slightly alters rhythm.

B. Open Questions

Open questions are designed to elicit a response that is not intended to be limited but, rather, to induce the opposing party (or third party witnesses having relevant information about his composition) to open up and speak at length.

Q. Please tell us as precisely as you can each thing you did in composing "Caribbean Rock," starting from the beginning.
A. Are you kidding? Everything?
Q. Yes. Please answer.
A. I was first contacted by Barry Weinberg of Dynamite Productions. He told me they didn't want to hire a John Williams type of composer. You know, one of the few big ones, but wanted a rap score for his motion picture, *South Atlantic* to give it a feeling of the 'hood, you know, where I grew up, and the action takes place in the film.
Q. For clarity of the record, when you said 'hood, you meant neighborhood, isn't that right?
Q. Yeah. Shall I say neighborhood if the subject comes up again?
A. No. 'hood is fine. I knew what you meant, but someone else may be reading the transcript, or it may be read to a jury, and I just wanted the record to be clear. Please continue.

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18. *See* 21 The New Grove Dictionary of Music and Musicians 832 (Stanley Sadie ed., 2001) ("**Rubato** [tempo rubato] (It: 'robbed or stolen time'). The expressive alteration of rhythm or tempo. In an earlier type the melody is altered while the accompaniment maintains strict time. A later type involves rhythmic flexibility of the entire musical substance. Both originated as a part of unnotated performing practice, but were later sometimes indicated in scores. Some modern writers refer to the earlier and later types as melodic and structural, borrowed and stolen, contrametric and agogic, or bound and free.").

A. Well, I told Barry, sure I was interested. Who wouldn't be? He wanted to know more about me. Was I ever in a gang? How did I get started in rap? So I told him, no, I wasn't in a gang. I was really a computer nerd. I just loved computers and rap. So, I went out and started doing DJ gigs with stuff I sampled on the street, as well as commercially recorded stuff. You know, Dr. J, Eminem, Flashmaster J, 50 Cent—most everyone who released a rap disk.

Q. Do you mean everyone, or did you limit it to the top forty, fifty on the charts?

A. Only the top forty.

Q. What did you do next after Barry said he wanted someone like you to do the score for *South Atlantic?*

A. Well, he gave me a script for the film and asked me to read it, which I did. I told him this one was perfect for me. I lived in the 'hood, actually in Atlantic City. I know these people. I know how they talk. I know what they listen to, whose music they like. It was made to order for me. I told Barry all this, and he asked me to come up with some ideas, so I did some sampling with scratches, did some of my original stuff.

Q. Like what?

A. Well, I thought in certain bars,19 I would kinda shortchange one note so it would be shorter than its real time value, and would break up the rhythm and make the rap a lot angrier. I remembered hearing something like that on the streets. I just don't remember when.

Q. Was it within the last year?

A. No, I don't think so.

Q. How about the last two years?

A. That seems about right.

Q. Before you continue, you mentioned hearing the irregular beat on the streets. What do you do to keep up with what's going on in hip hop/rap?

A. I listen to everything. DJs on the street, at parties, radio DJs, concerts—the whole nine yards.

Q. Thank you. Please continue.

A. Well, I kept coming up with ideas, kept doing my research on the streets, listening to DJs on the radio, and doing everything I could just to get the feel for what he wanted, and finally they screened the film for me. I got a tape of an almost final cut and took it home with me. I looked at it over and over again and finally came up with the idea I mentioned a little bit before about shortchanging one note for another to vary the beat.

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19. *See* 2 Grove, *supra* note 16, at 681 ("**Bar**. In Western notation a vertical line drawn through the staff to mark off metrical units. Hence also the metrical unit thus indicated, which in American usage is called 'measure.' English usage often relies on context alone to make the distinction clear (e.g. 'up to the double bar,' 'the end of the bar'), but 'bar-line' is also common.").

Q. Did you ever use a temp track while screening the film, either in the studio or at home?
A. I didn't need a temp track. I would always sample everything I needed. . . .
Q. I want to add one question. When did you first start listening to rap?
A. Well, it was when I was a little boy. It's been around at least 25 years, and I just fell in love with it. I just didn't want to hear anything else.
Q. How old were you then when you first started listening to it?
A. I was about eight or nine years old.
Q. How old are you now?
A. I'm 33.
Q. During those 24 or 25 years, can you list all the rap composers and artists you have heard?
A. Do we have an extra day in this deposition?
Q. Do you mean there are so many of them?
A. Yes, that's exactly what I mean.
Q. Well, do your best.
A. [The witness starts with Tupac Shakur and continues for approximately fifteen minutes, displaying his knowledge, during which time he names the composer of Tropical Rock. After those fifteen to twenty minutes have elapsed, the examining lawyer thanks him and asks him to resume his answer to the initial question.]

Comment

This open question and the questions interjected during deponent's interrupted monologue have accomplished the following:

(1) By having the examiner appeal to the deponent's ego, the deponent did not hesitate to display his extensive knowledge of hip hop/rap music and, in so doing—even if he had not mentioned the opposing party's name—his in-depth knowledge left little doubt that he was familiar with that composer and his works;
(2) The examiner, in preparation for the deposition, had one of many salient facts in the forefront of his mind: That is, "Tropical Rock," which employed *rubato*, was in the Top 40 charts, which the defendant testified he listened to;
(3) The deponent did not need a temp track because he had already sampled everything he needed; and
(4) The deponent remembered hearing something on the streets or over the radio, which he played within the last two years.

C. Oblique Questions

Oblique questions are comprised of a series of questions that do not directly address an ultimate fact to be proved, but, rather, are constructed in such

manner as to prove through the opposing party's own words a controlling legal principle, the application of which will be damaging to your opponent's claim. For purposes of illustration, let us assume that the composition at issue is not a rap or hip hop work, but rather a motion picture score in the romantic nineteenth-century tradition of many such scores. One approach is to ask the following series of questions:

Q. From your music studies and your experience, what do you consider to be the basic elements of a musical composition?
A: What do you mean by basic elements?
Q: Let's break it down. For the record, please tell us what you believe to be the essential ingredients in a musical composition?
A: If you are talking about things such as melody, then I understand your question. Are you talking about melody as an ingredient or element of the musical composition?
Q: Yes.
A: Then I can answer. In Western music, what makes a complete composition are melody, rhythm, and harmony. Does that answer your question?
Q: Yes. When is the first time you learned that those were the essential elements of music?
A: I learned that when I took piano lessons, when my teacher told me that.
Q: How old were you when you first learned about these three elements of music?
A: It wasn't when I first started piano lessons. It was probably about four years after that, so I was about eleven or twelve.
Q: How would you describe melody?
A: Melody is comprised of a series of pitches or tones strung together to make a tune recognizable as such to a person hearing it.
Q: Would you agree that, when each song note is played, as when you're hearing a key played on the piano, it has two basic qualities, pitch and duration?
A: Yes, that sounds right.
Q: Would you agree that, when you have a succession of pitches with duration values, you then have what are called melodies?
A: Yes, I think that is correct.
Q: What is the difference between melody and rhythm?
A: I don't think you can put it that way.
Q: Why not?
A: Because melody and rhythm cannot be separated or be mutually exclusive phenomena. They go together.
Q: Then how does melody figure into all of this?
A: I think you're getting at something, and let me try and explain it to you because I don't think you really understand music.
Q: Please go ahead.
A: Let me see if I can explain this. If you look at the distinction between pitch quality—for example, high and low—and time quality—long and short—then,

the proper terminology of these are motion and rhythm. As a result, melody consists of motion plus rhythm.

Q: From a lay person's point of view—and I am a lay person—is it accurate to say that music must consist of melody, harmony, and rhythm?

A: Yes, I think that's a fair statement if you're just being very basic about it.

Q: Is there anything else? For example, form comes to mind?

A: Yes, but form is really very much like a formula that all of us composers use to give the composition a feel of coherence so that the music has a logic like architecture or some other coherent structure about it. Holds it together.

Following is essentially the same approach but the witness unwittingly gave the examiner what he was seeking much earlier than the preceding deponent:

Q: Why did you add harmony to the first phrase that you just described to us?

A: I'm sure you realize that it's general practice to add harmony as well as orchestration to a piece if it's going to be recorded.

Q: Are there any reasons than just recording it to add harmony?

A: It's general practice. There must be a reason.

Q: What is the reason?

A: I don't know why people have added harmony for all these years, but it would seem incomplete, I think, without harmony?

Q: Is that the reason you added harmony?

A: No, it's a habit with me.

Q: Other than habit, is there a reason?

A: I can't think of one.

Q: It's to add something to the nature of the music, isn't it?

A: Yes.

Q: And what does it add?

A: People generally speak of melody, harmony, and rhythm. They are incomplete without each other. I think that's rather basic. You don't go with the melody alone.

Q: Any other reasons?

A: No.

Q: And, has it always been your practice to add the three of those ingredients together in a composition?

A: If it requires all three. If it's a piece that doesn't require rhythm, I don't use rhythm.

Q: What compositions would not require rhythm?

A: There are two meanings for rhythm. I'm thinking of rhythmic accompaniment. There is basic rhythm in the writing of the melody. Indigenous to the notes, but I was thinking of rhythm in terms of a beat or tempo.

Q: But all compositions have some rhythm if they are to . . .

A: Not all. No.

Q: Give me an example of a composition that doesn't have any rhythm.

A: A melody that would be *rubato*.
Q: Meaning what?
A: Meaning without rhythm.
Q: That's what *rubato* means?
A: No, not exactly.
Q: What does *rubato* mean? You've used the term,
A: Out of tempo.

Comment

The rationale for these questions—put to the plaintiff—is found in a basic premise in copyright law as it applies to music infringement litigation: the similarity of a sequence of pitches ("tones" or "notes") alone (without harmony and rhythm) cannot establish copyright infringement because "[s]imilarity of tone succession" is, "to a certain degree, inevitable in all musical compositions."[20] In addition, copyright protection for music usually involves at least melody, rhythm, and harmony.[21]

In the case in which this deposition was taken, the plaintiff/deponent's claim was based entirely on the similarity of pitch sequences, without harmony, rhythm, or duration of the pitches at issue. The first series of questions and answers is a reconstruction of the examiner/author's strategy to induce an admission of the ultimate fact: i.e., what plaintiff was trying to protect under copyright—a bare succession of pitches or notes—was unprotectable. In the first series of oblique questions, note how hard the examiner has to work to finally get the desired unintended admission. The second series of questions and answers is from the actual deposition of the plaintiff in *Baxter v. MCA, Inc*.[22] By their testimony, the plaintiffs in both scenarios damaged their claims, not knowing that they were doing so at the time they gave these answers.

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20. Hirsch v. Paramount Pictures, Inc., 17 F. Supp. 816, 817 (S.D. Cal. 1937). *See also* Granite Music Corp. v. United Artists Corp., 532 F.2d 718, 721 (9th Cir. 1976) ("The copyrightability of [the song] 'Bubbles' is not the four-note sequence, but the fitting together of this sequence with other melodious phrases into a unique composition.").
21. *See, e.g.*, Northern Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 397 (S.D.N.Y. 1952) ("We examine now the rhythm, harmony and melody of both songs to determine whether similarity exists."). *Cf.* Swirsky v. Carey, 376 F. 3d 841, 848 n.13 (9th Cir. 2004) ("concentration solely on pitch sequence may break music down beyond recognition"). While the *Swirsky* Court's observation was apt, unfortunately, the court in that case applied the unsupportable theory of "melodic reduction" and included irrelevant and unprotectable musical elements such as "key" and "tempo" to reach its incorrect holding reversing the summary judgment that had been granted in favor of defendants. *See, supra*, Chapter 5, "The Importance of the Expert: The Musicological Expert."
22. 812 F 2d 421 (9th Cir. 1987) (reversing the district court's summary judgment in favor of defendants). At the trial of this action, the jury found in its special verdict that the musical phrase that plaintiff Baxter alleged had been copied was unprotectable under the copyright law.

D. Protecting the Witness—An Imperative for Both Plaintiffs and Defendants

Needless to say, during the taking of depositions, it is essential that all witnesses, but especially the party witness, be protected. The plaintiff's lawyer should always watch for the dangerous questions that may be found in direct, open, or oblique questions: e.g., defendant's counsel asking plaintiff when he first conceived of the "idea" for his property; a question eliciting a description of the "ideas" set forth in plaintiff's property. Plaintiff's counsel should have reviewed beforehand the possibility of such questions and instructed the client as to the appropriate way to handle them. Likewise, the defendant has his own vulnerabilities and should guard against exposing them, without careful preparation, to a full and searching deposition examination by counsel for the opposing party.

CHAPTER
10

Music and Summary Judgment

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APPENDIX 10-A. "Slip Opinion" and Official Published Opinion 466

The judgment sought should be rendered if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. . . . [¶] An interlocutory summary judgment may be rendered on liability alone, even if there is a genuine issue on the amount of damages.

Rule 56 of the Federal Rules of Civil Procedure[1]

Courts have an important responsibility in copyright cases to monitor the outer limits within which juries may determine reasonably disputed issues of fact. If a case lies beyond those limits, the contrary view of a properly drawn sample of the population, or even a particular jury, cannot be permitted to enlarge (or diminish) the scope of statutory protection enjoyed by a copyright proprietor.

Warner Bros. v. American Broadcasting Companies, Inc.[2]

I. Early History and the Anti-Summary Judgment Bias

The history of summary judgment and copyright infringement litigation has been one of initial disfavor[3] followed by inconsistency in its application by the federal trial and appellate courts[4] and finally achieving clarity and renewed impetus from the Supreme Court in the *Celotex*, *Anderson*, and *Matsushita* cases.[5] Though the road map charted by the Supreme Court for summary judgment under Rule 56 of the Rules of Civil Procedure would appear to be

1. Fed. R. Civ. P. 56(c) & (d)(2).
2. 720 F.2d 231, 245 (1983).
3. *See* Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946).
4. *See* Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 977 (2d Cir.), *cert. denied*, 449 U.S. 841, 101 S. Ct. 121, 66 L. Ed. 2d 49 (1980) (court observed that "[b]ecause substantial similarity is customarily an extremely close question of fact, . . . summary judgment has traditionally been frowned upon in copyright litigation"); *see also* Baxter v. MCA, Inc., 812 F.2d 421, 435 (9th Cir. 1987) (the Ninth Circuit reversed a summary judgment in favor of defendants holding that "no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity" and "[e]ven if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity").
5. *See* Celotex Corp. v. Catrett, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986); Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986); Matsushita Elec. Indus. Co., Ltd v. Zenith Radio Corp. 475 U.S. 574, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986).

the proverbial "last word" for the application of summary judgment standards, when faced with ruling on motions for summary judgment in copyright infringement case, the federal courts have followed different paths in granting or denying them. The principal reasons for the divergent views among the trial and appellate courts in the fourteen federal circuits are the following: (1) differences of opinion as to what constitutes a genuine issue of material fact; (2) extraordinary respect for and therefore deference to the jury, as the representative of the reasonable lay listener, charged with the responsibility of determining whether one work infringes the other; and (3) the misunderstandings of some members of the judiciary in presiding over copyright infringement claims and the application of the law to copyright issues, which misunderstandings are intensified in confronting the allegedly unique issues raised in music infringement litigation (as distinguished from those involving written, dramatic, audiovisual, and sculptural works).

Although this text makes no pretense at being a historical treatise on the evolution of copyright law, a brief review of significant milestones is in order, charting the federal courts' rulings on summary judgment motions when musical ideas and language are the subject of the motions. At the very least, lawyers moving for, or opposing, summary judgment motions will, by studying the past, be alerted to arguments advanced by their predecessors and incorporated in published opinions. As a famous philosopher once observed, "[t]hose who cannot remember the past are condemned to repeat it."[6] Perhaps the most monumental gaffe was made by the federal judge who later became the most creative and insightful interpreter of copyright law: Judge Learned Hand.

In *Hein v. Harris*,[7] the Second Circuit Court of Appeals affirmed Judge Hand's ruling that the defendant's composition "I Think I Hear a Woodpecker Knocking at My Family Tree" infringed plaintiff's "Arab Love Song," even though defendant had never heard or even known of the plaintiff's work and obviously had not copied it. At this juncture, in 1910, Learned Hand was wrestling with the issue of whether copyright was to be governed by principles of patent law or copyright law. He opted to apply patent law. Examined at a distance of ninety-eight years, Judge Hand's rationale that lack of copying by the defendant was immaterial because defendant's song was not only composed later than plaintiff's but was also substantially similar to portions of plaintiff's song was, in the vernacular, "off the track" and also ignored the existence of prior works from which plaintiff may have either copied, adapted, or derived in composing "Arab Love Song."

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6. 1 George Santayana, The Life of Reason (1905), *quoted in* Oxford Dictionary of Quotations 666 (Elizabeth Knowles ed., 6th ed. 2004). George Santayana was a Spanish born philosopher and critic.
7. 183 F. 107 (2d Cir. 1910).

In *Haas v. Leo Feist, Inc.*,[8] Judge Hand showed little or no regard for prior art or common sources from which plaintiff and defendant may have—and probably did—derive ideas for their respective compositions. As he observed in that case:

> For example, nearly the whole of the leading theme of the plaintiff's song is repeated literally from a chorus of Pinafore, though there is not the slightest reason to suppose that the plaintiff ever heard the opera. Nevertheless, between the two choruses in question there is a parallelism which seems to my ear to pass the bounds of mere accident.[9]

He goes on to state that, "[i]f the choruses be transposed into the same key and played in the same time, their similarities become at once apparent. In certain of the bars, only a trained ear can distinguish them, and their form and rhythm is quite the same. . . . The case is not of the mere suggestion of a bar common to each, but of a continuously suggestive melodic parallelism, except at the end. Identity was not to be expected, but derivation seems to me proved."[10] Judge Hand seems to place his emphasis in finding infringement on pitch sequence (i.e., parallelism of pitches while ignoring harmony, context, rhythm, and prior common sources, perhaps even public domain materials.) Luckily for the defendants, plaintiff had registered for copyright in a fictitious name, which invalidated the copyright, leaving the defendants as the prevailing parties.

In *Fred Fisher, Inc. v. Dillingham*,[11] Judge Hand was faced with the plaintiff's claim that, in composing "Kalua," Jerome Kern infringed an *ostinato* bass[12] in the plaintiff's "Dardanella." Kern did not remember copying, and, in his defense, argued that the figures in both compositions were used in an adaptation of "Mermaid's Song" by Carl Maria von Weber, the composer of *Oberon* and *Der Freischutz*.[13] Nevertheless, relying once again on the similarity of the *ostinato* accompaniment and ignoring the apparent commonplace nature of the sequence of pitches and prior art, Judge Hand found for the plaintiff and awarded damages in the amount of $250. Plaintiff was awarded

8. 234 F. 105 (S.D.N.Y. 1916).
9. *Id.* at 107.
10. *Id.*
11. 298 F. 145 (S.D.N.Y. 1924).
12. "Ostinato" is a clearly defined phrase—most often used in the bass—that repeats itself in immediate and persistent succession; hence, the phrase is *ostinato* or obstinate. Its uses are not confined to any genre or musical structure. Examples may be found in the Baroque, Classical, and Romantic periods. Without a strong *ostinato* bass, rap and hip hop would be deprived of their beat and driving force. *See* Willi Apel, Harvard Dictionary of Music 634-35 (2d ed. 1982).
13. *See* 298 F. at 148-49.

costs but no attorneys' fees. As Hand whimsically observed "[s]uch victories I may properly enough make a luxury to the winner."[14]

It was not until 1936 that Judge Hand, in *Arnstein v. Edward B. Marks Music Corporation,*[15] finally overruled his holding in *Hein v. Harris* when, in finding for the defendant, he stated:

> Our reasoning in Hein v. Harris . . . cannot therefore be confined to musical copyrights, for the same language covers all copyrighted productions; it can be defended only in case copyrights, like patents, are monopolies of the contents of the work, as well as of the right to manifold the work itself. That is contrary to the very foundation of copyright law, and was plainly an inadvertence which we now take this occasion to correct.[16]

He then dismisses the "similarities" between the songs when he observes:

> True, it is the themes which catch the popular fancy, but their invention is not where musical genius lies, as is apparent in the work of all the great masters. Success in such music as this is by no means a test of rarity or merit; it is a commonplace that the most experienced are usually unable to tell in advance what will hit the public fancy and what will not. Were it otherwise much waste could be avoided. These songs were both written in the key of B-flat; the seven notes available do not admit of so many agreeable permutations that we need be amazed at the re-appearance of old themes, even though the identity extend through a sequence of twelve notes. The rest of the chorus follows a very simple and well-known pattern, and is derived for the most part from the two phrases we have just discussed, which account for the first four measures.[17]

Fortunately, Judge Hand recovered from his early missteps, going on to write opinions of priceless value, but not before joining in the majority opinion in *Arnstein v. Porter*.[18] In *Arnstein*, the panel was wrestling with (1) establishing summary judgment standards in a music infringement case; and (2) setting boundaries by defining and delimiting the issues on which experts could opine and testify. With respect to the standards for summary judgment, the court (opinion by Judge Frank), in one sentence, borrowing in part from earlier opinions, announced the "slightest doubt rule" when it wrote that "[t]he principal question on this appeal is whether the lower court, under Rule 56, properly *deprived* plaintiff of a trial of his copyright infringement action.

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14. *Id*. at 152.
15. 82 F.2d 275 (2d Cir. 1936).
16. *Id*. at 275.
17. *Id*. at 277.
18. 154 F.2d 464 (2d Cir. 1946). For the facts and further analysis of this case, *see, supra*, Chapter 5, *The Importance of the Expert: The Musicological Expert*.

The answer depends on whether 'there is the slightest doubt as to the facts.'"[19] The court, without considering whether the plaintiff's position presented a *genuine* triable issue of fact, shored up its "slightest doubt" rule by stating that "[b]ut where, as here, credibility, including that of the defendant, is crucial, summary judgment becomes improper and a trial indispensable. It will not do, in such case, to say that, since the plaintiff, in the matter presented by his affidavits, has offered nothing which discredits the honesty of the defendant, the latter deposition must be accepted as true. We think that Rule 56 was not designed thus to foreclose plaintiff's privilege of examining defendant at a trial, especially as to matters peculiarly within a defendant's knowledge."[20] This begs the question as to whether the alleged copying by the defendant was of protectable expression or of unprotected ideas, *scènes à faire,* and other commonplace building blocks of music. This, of course, was at an early stage in the judiciary's approaches to music infringement when the "topography of copyright"[21] was still being charted.[22]

II. *Celotex, Anderson, and Matsushita:* Clearing the Air

The importance of this triumvirate cannot be emphasized enough. In these three opinions, the Supreme Court scrubbed from the law of summary judgment the decades-long accumulation of misunderstanding, misapplication and "slightest doubt" thinking originated and perpetuated by the federal courts.

In *Celotex v. Catrett,*[23] the Court ruled that Rule 56(c) of the Federal Rules of Civil Procedure requires the entry of summary judgment:

> against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be "no genuine issue as to any material fact," since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial.

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19. 154 F.2d at 468 (citations omitted) (emphasis added).
20. *Id.* at 471.
21. The author has borrowed this phrase from Professor Paul Goldstein because the word "topography" aptly alludes to the natural features of and relationships between copyright concepts and principles. *See generally* 1 Paul Goldstein, Goldstein On Copyright Ch. 1 (3d ed. 2007) (the title of Chapter One is "The Topography of Copyright").
22. The "slightest doubt" rule in *Arnstein*, however, endured for many years, and, even after its holding was questioned, diminished and disapproved, the courts continued to cite it for a proposition which, in retrospect, was incompatible with the aims of summary judgment.
23. 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).

> The moving party is "entitled to a judgment as a matter of law" because the nonmoving party has failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof.[24]

In *Matsushita Electric Industrial Company, Ltd. v. Zenith Radio Corporation*[25] and *Anderson v. Liberty Lobby, Inc.*,[26] the Court, likewise, considered the standards for granting summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure and further corrected the prior misunderstandings and missteps of the federal courts.

III. Specific Grounds for Summary Judgment in Copyright Litigation

A. Ownership and Access

1. Lack of Ownership

Although it is often conceded *arguendo* by the defendant for the purpose of a summary judgment motion that the plaintiff is the owner and holder of a copyright,[27] one should not assume that ownership and a viable copyright are foregone conclusions. For example, in *Silverman v. CBS, Inc.*,[28] a stage writer, in creating a musical, was free to use *Amos 'n' Andy* scripts broadcast between 1928 and 1948 which were in the public domain, but not those of post-1948 shows, which had been unpublished works protected by common law copyright before 1978 and registered by CBS in 1985 pursuant to the 1976 Act. The copyrights to the post-1948 shows were thus owned by CBS.[29]

2. Lack of Access

As to access, there must be a "reasonable opportunity" to copy, and, as used by the courts, that does not include any "bare possibility" in the sense that

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24. *Id.* at 322-23, 106 S. Ct. at 2552.
25. 475 U.S. 574, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986).
26. 477 U.S. 242, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).
27. *See, e.g.,* Davis v. United Artists, Inc., 547 F. Supp. 722, 723 (S.D.N.Y. 1982) ("[f]or purposes of this motion only, defendants concede the issues of access and plaintiff's ownership of the registered copyright in the novel [at issue]"); *see also* Walker v. Time Life Films, Inc., 784 F.2d 44, 48 (2d Cir. 1986) ("[i]t is undisputed that appellant Walker has a valid copyright in his book").
28. 632 F. Supp. 1344 (S.D.N.Y. 1986), *aff'd in part* and *rev'd on other gounds* 870 F.2d 40, 43, *cert. denied* 497 U.S. 907 (1989).
29. *See id.* at 1351. The Second Circuit reversed the trademark judgments and, in affirming, limited copyright protection to those increments of protectable expression added in CBS' radio and television programs of *Amos 'n' Andy. id.*

anything is possible. Access may not be inferred through mere speculation or conjecture.

For example, in *Jason v. Fonda*,[30] the plaintiff claimed that defendants, the producers and broadcasters of the motion picture *Coming Home*, had access to plaintiff's book *Concomitant Soldier* because between 200 and 700 copies of her book were available in Southern California bookstores. The court found that this created only a "bare possibility" that defendants had access and, by itself, was not sufficient to create a factual issue as to copying.[31]

In *Meta-Film Associates, Inc. v. MCA, Inc.*,[32] plaintiff, assignee of the rights in an unpublished screenplay entitled *Frat Rats*, brought a copyright infringement action against the writers and producers of the film *Animal House* and the television series sequel to the film *Delta House*. Granting defendants' motion for summary judgment, the court held that submission of plaintiff's screenplay to a director who was under contract to the company that filmed *Animal House* and who had an office on the company's lot, but whose only relationship with the alleged copiers was that they shared a common employer, was insufficient as a matter of law to establish access.[33]

In *Towler v. Sayles*,[34] the owner of a copyrighted script entitled *Crossed Wires or Bobbie and Wendy were Neighbors* sued John Sayles for infringement because of his *Passion Fish* movie. The court held that there was not sufficient evidence that Sayles had access, in spite of plaintiff's assertion that a third party that received the script promised to send it to Sayles; however, there was no evidence that the third party ever did send it to Sayles. Citing *Meta-Film*, the court acknowledged that, although access through a third party intermediary who has a close relationship with defendant may be enough, the proffered evidence fell short because there was (a) no evidence that the third parties had a relationship with Sayles *during the relevant time period* and (b) a lack of evidence that the persons involved were *third party intermediaries*.[35] In any event, in applying the extrinsic/intrinsic analysis, the plaintiff's expert,

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30. 526 F. Supp. 774 (C.D. Cal. 1981), *aff'd*, 698 F.2d 966 (9th Cir. 1982).
31. *See id*. at 776-77. The court granted defendants' motion for summary judgment, and the judgment was affirmed by the Ninth Circuit. (*Caveat*: In light of *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990), in which the court explained that the standard of proof necessary to show substantial similarity decreases as the degree of access increases, this holding may be limited in application to its finding of lack of access. However, the viability of *Shaw* is seriously in question in light of the holdings in *Brown Bag Software v. Symantec Corporation*, 960 F.2d 1465 (9th Cir. 1992) and *Feist v. Rural Telephone Service Company*, 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991).
32. 586 F. Supp. 1346 (C.D. Cal. 1984).
33. *See id*. at 1355; *see also* Ferguson v. National Broad. Co., Inc., 584 F.2d 111, 113 (5th Cir. 1978) (adduced proof of access constituted only a "bare possibility" of access and was insufficient as being based on "speculation or conjecture").
34. 76 F.3d 579 (4th Cir. 1996).
35. *See id*. at 583.

with his chart of alleged similarities (including fragments. of dialogue), did not demonstrate substantial similarity because a "list comparing 'random similarities scattered throughout the works' is 'inherently subjective and unreliable."[36] The court rejected plaintiff's "striking similarity" argument because the evidence of similarities "does not even approach this exacting standard."[37]

The court in *Silverman v. CBS, Inc*.,[38] found there to be no question as to the alleged infringer's access to the original work where he acknowledged owning a videotaped documentary containing *Amos 'n' Andy* film clips and having viewed an entire program at the Museum of Broadcasting.[39]

In *Cameron Industries, Inc. v. Albert Nipon Co., Inc*.,[40] a claim for copyright infringement failed because, despite substantial similarity of fabric designs, the defendant neither had access to nor had copied the original. Defendant ordered the fabric from another source six weeks before it appeared in *Women's Wear Daily*. The court credited defendant's assertions that there had been no meeting with plaintiff at which plaintiff had shown the design, as alleged by plaintiff.[41]

B. Lack of Substantial Similarity of Protectable Expression

The Second Circuit Court of Appeals in *Warner Bros., Inc. v. American Broadcasting Companies, Inc*.,[42] stressed the important responsibility of courts to grant summary judgment in cases where no reasonable jury could find that the two works at issue are substantially similarly as a matter of law.[43] *Warner Bros.* involved copyright, unfair competition, and trademark claims against the producers of the television series *The Greatest American Hero* by the copyright owners of the character "Superman," hero of comic books, television, and films. The court struggled with the problem of infringement of a character, rather than of a story.[44] The court ultimately ruled that a reasonable jury could not conclude that the main character in *Hero* and Superman were substantially similar as to the protectable features of the respective characters, and the court affirmed the granting of defendants' summary judgment motion.[45]

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36. *Id*. at 584 (citation omitted).
37. *Id*. at 585.
38. 623 F. Supp. 1344 (S.D.N.Y. 1986).
39. *See id*. at 1351.
40. 630 F. Supp. 1293 (S.D.N.Y. 1986).
41. *See id*. at 1295-96.
42. 720 F.2d 231 (2d Cir. 1983).
43. *See id*. at 245.
44. *See id*. at 240 ("[w]hen, as in this case, the claim concerns infringement of a character, rather than a story, the idea-expression distinction has proved to be especially elusive").
45. *See id*. at 243. The *Warner Bros*. case has been cited in a number of decisions granting summary judgment on this ground. *See, e.g.,* Arthur v. American Broad. Cos., Inc., 633 F. Supp.

The types of works put before the court on a motion for summary judgment—whether literary, motion pictures, television productions, magazines, books, etc., or three-dimensional works such as dolls, pictorial cartoon characters, jewelry, etc.—do not seem to affect the legal analysis. For example, in *Durham Industries, Inc. v. Tomy Corporation*,[46] the case involved dolls, but the rule is the same as in any other copyright case: A "'court may compare the two works and render a judgment for the defendant on the ground that as a matter of law a trier of fact would not be permitted to find substantial similarity.'"[47]

A case that shows how the principle is applied to copyright infringement claims involving artistic works is *Steinberg v. Columbia Pictures Industries, Inc*.[48] Plaintiff was the artist Saul Steinberg, known for his illustrations in *The New Yorker* magazine. Steinberg sued Columbia claiming that a promotional poster done for Columbia's picture *Moscow on the Hudson* infringed his copyright to an illustration he had done for *The New Yorker* in 1976, one in which a map of the United States is shown from a humorously myopic perspective of a New Yorker in which the entire United States west of the Hudson River is reduced to less that 10% of the surface area and a few blocks of Manhattan comprise the major portion of the illustration. The poster for *Moscow on the Hudson*, which defendant claimed was a parody of the Steinberg poster, also gave a bird's eye view of New York continuing eastward across Manhattan and the Atlantic Ocean where the background showed Russian-style buildings. On cross-motions for summary judgment, the court compared the two posters (accepting the obvious fact that defendant had access to Steinberg's poster) and granted summary judgment to plaintiff, holding that there was a "striking stylistic relationship" between the posters and that style was an ingredient

146, 148 (S.D.N.Y. 1985) (citing *Warner Bros*. for proposition that, to prevail, plaintiff must show "substantial similarity" between protectable features of the copyrighted work and the infringing work in a case where the court found that differing versions of an unprotectable idea (i.e., the superimposition of the small-case letters "abc" upon the Olympic logo) were not restrainable by the copyright holder. *See also* Walker v. Time Life Films, Inc., 784 F.2d 44, 48 (2d Cir. 1986) (citing *Warner Bros*. for proposition that noninfringement may be found by a court as a matter of law on summary judgment "either when the similarity concerns only noncopyrightable elements of plaintiff['s] work, or when no reasonable trier of fact could find the works substantially similar");.Zambito v. Paramount Pictures Corp., 613 F. Supp. 1107, 1110 (E.D.N.Y. 1985) (defendants granted summary judgment, because their screenplay and movie *Raiders of the Lost Ark* were not substantially similar as to the protectable elements of plaintiff's screenplay *Black Rainbow*); Smith v. Weinstein, 578 F. Supp. 1297, 1302 (S.D.N.Y. 1984) (summary judgment for defendants granted where there was no substantial similarity between the motion picture *Stir Crazy* and plaintiff's screenplay).

46. 630 F.2d 905 (2d Cir. 1980).

47. *Id*. at 918 (quoting 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 12.10, at 12–69 (1980)).

48. 663 F. Supp. 706 (S.D.N.Y. 1987).

of expression.[49] The court also rejected defendant's "fair-use" defense in undertaking the analysis required by Section 107 of the Copyright Act.[50]

Cases involving literary works are common. For example, in *Burroughs v. Metro-Goldwyn-Mayer, Inc.*,[51] the case involved an infringement claim where the plaintiff's work was the adventure novel *Tarzan of the Apes* and defendant's work was the motion picture *Tarzan the Ape Man*. The district court dismissed plaintiff's claim on summary judgment, and the Second Circuit Court of Appeals upheld the dismissal. While the plaintiff, the author of the novel, had granted to MGM a copyright license allowing it to make certain films, plaintiff contended that, in 1977, the license to the character Tarzan and/or the book was effectively terminated by the author's heirs pursuant to Section 304(c) of the Copyright Act. The circuit court agreed with the district court that the license to the character Tarzan was not effectively terminated. As to the claimed infringement of the book, the circuit court stated: "Based on our comparison, and discounting permitted similarities in characterization [pursuant to the license agreement], we conclude as a matter of law that the 1932 film was not based on the Book, for no reasonable jury could find the two works substantially similar beyond the level of generalized ideas or themes."[52] In comparing the works at issue, the court appeared to undertake on an ordinary person or observer analysis.[53]

This ordinary observer test is, however, with increasing frequency, rejected where the works at issue are not easily accessible material, such as novels, plays and paintings, but are more complex. For example, in *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*[54] which involved a computer program, the court rejected the bifurcated test stating that "[t]he ordinary observer test, which was developed in cases involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value in cases involving computer programs on account of the programs' complexity *and unfamiliarity to most members of the public*."[55]

1. Shaw v. Lindheim: A Perplexing Detour

A development that temporarily cast doubt on the availability of summary judgment in the Ninth Circuit is found in *Shaw v. Lindheim*.[56] The *Shaw* court, in effect, virtually foreclosed summary judgment based upon lack of

49. *Id.* at 712.
50. *See id.* at 714-15.
51. 683 F.2d 610 (2d Cir. 1982).
52. *Id.* at 624.
53. *See id.* at 624-28.
54. 797 F.2d 1222 (3d Cir. 1986).
55. *Id.* at 1232 (emphasis added). *See also, supra*, Chapter 1, *The Copyright Law: An Overview*.
56. 919 F.2d 1353 (9th Cir. 1990) (en banc).

substantial similarity. In substance, the court apparently focused on the derivation of an alleged infringing work from an idea embodied in an allegedly infringed work, rather than on the question as to whether the alleged infringement involves a taking of protectable expression.[57] In other words, no matter how dissimilar is the expression between two "literary" works (i.e., books, motion pictures, music and other nonrepresentational works), and regardless of whether similarity results from the use of unprotectable material, any determinations under the intrinsic test would be reserved for the trier of fact.

The continued availability of summary judgment in copyright cases involving representational works was underscored in *Pasillas v. McDonald's Corp*oration.[58] In *Pasillas*, the defendant conceded for the purposes of the summary judgment motion that its "man in the moon" mask shared the same idea as plaintiff's Halloween mask, thus foreclosing the necessity of the court to focus on the extrinsic test, and requiring only an analysis of the intrinsic test. In affirming the district court's grant of summary judgment for the defendant, the court distinguished *Shaw v. Lindheim* on two grounds: (1) *Shaw* applied only to literary works, and (2) unlike the works involved in *Shaw*, the defendant's "man in the moon" mask and the plaintiff's Halloween mask involved works where the idea and expression were inseparable.[59]

2. *Brown Bag Software v. Symantec Corporation:* The Retreat From *Shaw v. Lindheim*

In *Brown Bag Software v. Symantec Corporation*,[60] the plaintiff claimed that the copyright to its computer program had been infringed by the defendants. In considering the defense motion for summary judgment, the district court dissected and analyzed various features that the plaintiff relied upon in asserting its claim for copyright infringement. The court's purpose in so doing was to determine not only if there had been copying, but also whether the plaintiff was endeavoring to protect elements that were in and of themselves unprotectable. In affirming the summary judgment, the Ninth Circuit Court of Appeals, relying upon prior authorities in the Ninth Circuit (which *Shaw v. Lindheim* had apparently disapproved), enunciated two important principles

57. *See id.* at 1359. The court explained: "[W]e hold that it is improper for a court to find, as the district court did, that there is no substantial similarity as a matter of law after a writer has satisfied the extrinsic test. To conclude otherwise would allow a court to base a grant of summary judgment on a purely subjective determination of similarity. . . . [¶] The rule we announce today . . . [is] that satisfaction of the extrinsic test creates a triable issue of fact in a copyright action involving a literary work. . . . [so that a grant of summary judgment could] res[t] on application of the intrinsic test alone." *Id.*

58. 927 F.2d 440 (9th Cir. 1991).

59. *See id.* at 442-43.

60. 960 F.2d 1465 (9th Cir. 1992).

regarding summary judgment and copyright infringement claims: (1) the extrinsic test is to be utilized for more than determining similarity of ideas—i.e., the court may compare expression to determine whether what the plaintiff seeks to protect is in fact protectable; and (2) in the court's words: "[i]f the rule in *Shaw* was applied without recognizing that the extrinsic test now includes some analysis of expression, *Shaw* would ring 'the death-knell in the Ninth Circuit for defense summary judgments based on purported absence of substantial similarity.'"[61] The court put the *Shaw* holding in perspective in quoting the following observation from *Nimmer On Copyright*: "'given *Shaw*'s reformulation of the extrinsic test, the decision is better viewed as standing for the unremarkable proposition that when objectively speaking a triable case of expressive similarity exists, the case will be sent to the trier of fact; but when no such objective argument is possible, summary judgment will lie.'"[62]

IV. A Sampling of Unprotected Elements: Non-Musical Analogies

A. Ideas and Standard Literary Devices

As we have learned, it is an axiom of copyright law that the protection granted a copyrighted work extends only to the author's original expression, never to the underlying ideas.[63]

The principle has been incorporated into the revision of the Copyright Act, which provides:

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated or embodied in such work.[64]

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61. *Id.* at 1476 (citation omitted).
62. *Id.* (quoting 3 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 13.03[E][3], at 13-78.20 (1991)). As of this writing, one can properly conclude that *Baxter v. MCA, Inc.*, 812 F.2d 421 (9th Cir. 1987), and *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990), have limited application and viability.
63. Mazer v. Stein, 347 U.S. 201, 217, 74 S. Ct. 460, 470, 98 L. Ed. 630 (1954) (unlike with a patent, " a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself"); Baker v. Selden, 101 U.S. (11 Otto) 99, 102-03, 25 L. Ed. 841 (1879); *see also* Whelan Assoc. v. Jaslow Dental Lab., Inc., 797 F.2d 1222, 1234-1240 (3d Cir. 1986) (discussion about how to distinguish between an idea and its expression).
64. 17 U.S.C. § 102(b).

In *Fuld v. National Broadcasting Company, Inc.*,[65] the court held:

> [A] copyright does not protect its owner from the use by others of the ideas, themes, local or characters in his copyrighted work. . . . It is only the means of expression of those ideas and themes—or manner of use and development of those characters—that is protected.[66]

B. Common Antecedent Sources and the Public Domain

The courts long ago recognized—and the cases continue consistently to follow—the rule that:

> "[O]ne work does not violate the copyright in another simply because there is a similarity between the two, if the similarity results from the fact that both works deal with the same subject, or have made use of common sources."[67]

Works within a genre or dealing with the same subject matter necessarily will exhibit some similarity, which does not, as a matter of law, measure up to copyright infringement. For example, in *Warner Bros., Inc. v. American Broadcasting Companies, Inc.*,[68] the court compared Ralph Hinkley, the central character of the television show *Greatest American Hero*, to Superman, and found that they both possessed traits "widely shared within the superhero genre."[69] "Stirring one's memory of a copyrighted character is not the same as appearing to be substantially similar to that character, and only the latter is infringement."[70]

In *Alexander v. Haley*,[71] plaintiff claimed that Alex Haley, in creating his historical novel *Roots*, copied protectable expression from *Jubilee*, plaintiff's novel about slavery in America. The court granted summary judgment for defendants, noting that the allegedly similar elements in the two works could be found in antecedent sources, such as the cultural history of African-Americans.[72]

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65. 390 F. Supp. 877 (S.D.N.Y. 1975).
66. *Id.* at 881 (citations omitted).
67. Harold Lloyd Corp. v. Witwer, 65 F.2d 1, 17 (9th Cir. 1933) (quoting 13 C.J.S. § 278, at 1114 (19__)).
68. 720 F.2d 231 (2d Cir. 1983).
69. *Id.* at 243.
70. *Id.* at 242.
71. 460 F. Supp. 40 (S.D.N.Y. 1978).
72. *See id.* at 44-45.

C. Logic and the Doctrine of *Scènes à Faire*

Elements in competing works that flow inevitably from the treatment of a given topic, *scènes à faire*, are not protected by copyright. A copyright claimant cannot acquire a monopoly on a genre. Sometimes similarities are unprotectable because they are *scènes à faire*—"incidents, characters, or settings that naturally flow from or are standard to the treatment of certain ideas and themes."[73] For example in *Walker v. Time Life Films, Inc.*,[74] the Second Circuit Court of Appeals discussed the numerous similarities between plaintiff's book, entitled *Fort Apache*, and the film, *Fort Apache: The Bronx*, including that both the book and the film open with the murder of a policeman with a handgun used by a gunman at close range. The killing of the police officer was a historical fact that had been reported in the media, placing it in the public domain and beyond the scope of copyright protection.[75]

In *Williams v. Crichton*,[76] an author of children's books about dinosaurs sued the author of the novel (and screenplay for) *Jurassic Park* and the producers of the motion picture based on the novel. In affirming summary judgment for defendants, the Court of Appeals for the Second Circuit reaffirmed those principles supporting grants of summary judgments (i.e., nonprotectable ideas, standard literary devices, etc.) and in particular based their affirmance on the ground, among others, that *scènes à faire* are not protectable.[77] In so doing, the court reiterated the responsibility of the courts to monitor copyright infringement claims to make certain that the similarity forming the basis of the plaintiff's complaint is not based on *scènes à faire* and other unprotectable materials.[78]

In *Zambito v. Paramount Pictures Corporation*,[79] defendant was granted summary judgment partially on the ground that the actual similarities between plaintiff's screenplay *Black Rainbow* and defendants' movie *Raiders of the Lost Ark* were *scènes à faire*. Both works were about archaeologists searching for artifacts and, therefore, certain elements would necessarily be present in both works. The court cited examples of treasure being hidden in a cave inhabited by snakes, using fire to repel snakes, birds frightening an

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73. Anderson v. Paramount Pictures Corp., 617 F. Supp. 1, 2 (C.D. Cal 1985); *see also* Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc. 797 F.2d 1222, 1236 (3d Cir. 1986) ("*scenes a faire* are 'incidents, characters or settings which are as a practical matter indispensable . . . in the treatment of a given topic. . . .[¶] *Scenes a faire* are afforded no [copyright] protection because the subject matter represented can be expressed in no other way than through the particular *scene a faire*.") (citations omitted).
74. 784 F.2d 44 (2d Cir. 1986).
75. *See id*. at 50.
76. 84 F.3d 581 (2d Cir. 1996).
77. *See id*. at 588-89.
78. *See id*. at 590-91.
79. 613 F. Supp. 1107 (E.D.N.Y. 1985).

intruder in the jungle, etc., as "indispensable elements to the treatment of 'Raiders' theme, and are, as a matter of law, simply too general to be protectible."[80]

Again, in *Walker v. Time Life Films, Inc.*,[81] a book and film about police work and life in a dangerous and violent South Bronx neighborhood shared the following elements: both depicted cockfights, drunks, stripped cars, prostitutes, and rats; both featured, as central characters, third- and fourth-generation Irish policemen who lived in Queens and who frequently drank; and both showed disgruntled, demoralized police officers and unsuccessful foot chases of escaping criminals. The appellate court agreed with the lower court that these similarities related to "uncopyrightable material," and were unprotectable as *scènes à faire* because they would appear in any realistic portrayal of police work in the South Bronx.[82]

D. Facts and Products of Research

Facts, including news, historical events, and the lives of persons involved in such events, are not protected by copyright and may be used in other works even if the same have been incorporated into prior works.[83] As Judge Learned Hand explained: "There cannot be any such thing as copyright in the order of presentation of the facts, nor, indeed, in their selection, although into that selection may go the highest genius of authorship, for indeed, history depends wholly upon a selection from the undifferentiated mass of recorded facts."[84]

One type of case that involves the generic category of "unprotectables" deals with the attempt by an author to secure a monopoly in his research. Although, for the purpose of placing the claim within the ambit of respectable theory, the claim is sometimes made in a way that seeks protection for the arrangement of facts, the sequence of their expression or the expenditure of time and effort in the gathering of facts, the end result, if the claim were accepted, would be to equate facts (historical or otherwise) with the expression of the same and thereby grant an author a copyright monopoly in the

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80. *Id*. at 1112. *See also* Reyher v. Children's Television Workshop, 533 F.2d 87 (2d Cir. 1976) (no substantial similarity between the two works as to copyrightable matter, because similarities are as to *scènes à faire* and other unprotectable matter).
81. 784 F.2d 44 (2d Cir.), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278, 90 L. Ed. 2d 721 (1986).
82. *See id*. at 50. *See also* Novak v. National Broad. Co., Inc., 716 F. Supp. 745 (S.D.N.Y. 1989) (similarities between scripts of various video shorts involved only nonprotectable matters, such as ideas and *scènes à faire*).
83. *See* Greenbie v. Noble, 151 F. Supp. 45 (S.D.N.Y. 1957) (facts about life of historical figures are not protectable by copyright and publishers of historical novel based on historical figure's life did not infringe author's copyrighted biography).
84. Myers v. Mail & Express Co. (S.D.N.Y. Sept. 23, 1919) *in* 36 Copyright Decisions, 1967-1968 at 478, 479 (Benjamin W. Rudd ed., 1970). In this case, Judge Hand's statement of the case may be so basic and well accepted as to be considered axiomatic.

facts themselves. Thus, in *Houts v. Universal City Studios, Inc.*,[85] the author of the book *Where Death Delights* was estopped from claiming that his book was fictional, because he held it out to the public as factual and nonfiction. Because it was a factual work, the court rejected plaintiff's claims that the television program "Quincy" infringed his copyright and granted defendants' motion for summary judgment.

In response to the creative and ingenious theories of those endeavoring to assert exclusive dominion over facts, courts have held the following biographical and historical facts freely available for use by second and subsequent authors: The plot to assassinate President Lincoln (even though sixty-six parallels were found between the two works);[86] the life and times of the most secretive of millionaires, Howard Hughes;[87] the romanticized adventures of Wyatt Earp, frontier marshal;[88] the sensational story and ordeal of a young woman who was kidnapped and buried alive in a coffin-like box for 83 hours;[89] and the tragedy of the Hindenburg, including the possible motives of an obscure "rigger" on the airship named Eric Spehl who plaintiff first theorized could have caused the tragedy.[90]

V. The Merger of Idea and Expression

When an idea and the expression of the idea are inseparable, no copyright protection will be afforded. The courts have recognized that in some instances the expression of an idea is limited by the idea itself. When the expression provides little that is new or additional to the idea, the idea and expression are said to "merge." When this occurs, copyright protection extends only to identical copying of the plaintiff's work.[91] In *Herbert Rosenthal Jewelry Corporation v. Honora Jewelry Company, Inc.*,[92] the question was whether the design of a gold, jeweled turtle-shaped pin infringed the copyright of a similarly-shaped pin. The court found no infringement and stated:

> Since all turtles are created more or less along the same lines, appellant cannot, by obtaining copyright upon one design of a turtle pin, exclude all others from

85. 603 F. Supp. 26 (C.D. Cal. 1984).
86. *See* Eisenschiml v. Fawcett Publ'ns, Inc., 246 F.2d 598 (7th Cir.), *cert denied*, 355 U.S. 907, 78 S. Ct. 334, 2 L. Ed. 2d 262 (1957).
87. *See* Rosemont Enters, Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966).
88. *See* Lake v. Columbia Broad. Sys., Inc., 140 F. Supp. 707 (S.D. Cal. 1956).
89. *See* Miller v. Universal City Studios, Inc., 650 F.2d 1365 (5th Cir. 1981).
90. *See* Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841, 101 S. Ct. 121, 66 L. Ed. 2d 49 (1980).
91. *See* Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1168 (9th Cir. 1977) (explaining when the idea and the expression coincide).
92. 509 F.2d 64 (2d Cir. 1974).

> manufacturing gold turtle pins on the ground that they are substantially similar in appearance. Clearly, a copyright does not offer protection of such breadth. "Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself."[93]

The absence of protection in this context also encompasses those situations involving the compilation and arrangement of data and facts. As noted by the Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*,[94] alphabetical telephone lists lacked sufficient creativity to accord copyright protection where the claimed infringement involved the alleged copying from the directory's white pages. In such situations, where compilations of data and other facts are only capable of being expressed in a limited number of ways and, as a consequence, the idea and its expression "merge" thereby precluding copyright protection, summary judgment should be granted. In *Feist*, the Supreme Court explained that facts are not copyrightable and that the "most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates.'"[95] Additionally, "'[n]o one may claim originality as to facts.' . . . The first person to find and report a particular fact has not created the fact."[96] Finally, "copyright is not a tool by which a compilation author may keep others from using the facts or data he or she has collected. . . . Rather, the facts contained in existing works may be freely copied."[97]

VI. A Sampling of Unprotected Musical Elements

A basic understanding of musical ideas and expression is of vital importance in assuming the responsibility of representing a client in music infringement disputes. This sampling is a step in the learning process to acquire that "basic understanding." It should enable the lawyer, whether representing a plaintiff or defendant, to better understand and make use of his or her musicological experts and thereby be in a better position to examine and cross-examine

93. *Id.* at 65 (citation omitted).
94. 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991).
95. *Id.* at 344-45, 111 S. Ct. at 1287.
96. *Id.* at 347, 111 S. Ct. at 1288 (citations omitted).
97. *Id.* at 359, 111 S. Ct. at 1295. *Accord* Cooling Sys. and Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 492 (9th Cir. 1985) (no copyright infringement where range of possible expression is extremely narrow and where what has been taken from the previous work is nothing more than what "'must unavoidably be produced by anyone who wishes to use and restate' the facts") (citation omitted); *see also* Kregos v. Associated Press, 3 F.3d 656 (2d Cir. 1993); Arica Inst., Inc. v. Palmer, 970 F.2d 1067 (2d Cir. 1992).

witnesses and communicate with judges and jurors. This sampling of unprotected musical elements, placed in the context of general copyright principles, is designed to accomplish that goal. (*See* Chapter 1, Sections II–V.)

VII. Music, the Judiciary and Summary Judgment: An Evolving Body of Authorities

A. *Baxter v. MCA, Inc.*: The "No-Bright-Line" Rule

In *Baxter v. MCA, Inc.*[98] a music infringement case, defendants obtained summary judgment upon the ground that, as a matter of law, there was no substantial similarity of expression as between the two works. On appeal, the Ninth Circuit Court of Appeals issued an initial opinion in which it restates the discredited theory that summary judgment is a disfavored remedy and also uses language that conjures up the *Arnstein* "slightest doubt" rule.[99] by explaining that the case is not one in which the absence of similarities is so patent as to warrant summary judgment. (It is to be noted that the Supreme Court had issued its opinion in *Celotex Corporation v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986), which reexamined and clarified the standards for granting summary judgment, prior to the Ninth Circuit's initial opinion in *Baxter*.) The Court of Appeals, after the filing of a motion for reconsideration, then filed an amended opinion in which it struck all references to the "slightest doubt" rule and all language citing the discredited rule that summary judgment is disfavored, but left in intact its holdings, which were based upon those portions of its initial opinion that had been excised. (See Appendix "A" to this chapter for a comparison between the original "slip opinion" and the amended opinion published in the official reports.) The court retained its "no-bright-line" rule as set forth in its initial opinion, thereby virtually foreclosing summary judgment when a court is requested to find that musical works are not substantially similar as a matter of law.[100]

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98. 812 F.2d 421 (9th Cir.), *cert. denied*, 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987).
99. *See* Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946). *See also, supra*, note 10 and accompanying text.
100. *See Baxter*, 812 F.2d at 425 (in holding that the district court's grant of summary judgment was improper, the appellate court explained that "reasonable minds" could differ as to whether the two works were substantially similar because "no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity").

B. *Smith v. Jackson*[101]

In *Smith v. Jackson*, the court affirmed the grant of a summary judgment for defendants on the ground that the similarity of the songs at issue related to a musical *scène à faire* and, in so doing, stated that the defendant was not required to prove that it relied on a prior iteration of that *scène à faire*, but only that it *existed* in musical literature prior to defendant's creation of his work.[102]

C. *Newton v. Diamond*[103]

Newton v. Diamond involved a somewhat anomalous set of facts where the plaintiff sued the defendants for digitally sampling a three-note segment (C, D flat, C) from the recording of plaintiff Newton's composition *Choir*, even though defendants Beastie Boys had a license from Newton to use the master sound recording (but not one for the music itself) in Beastie Boys' recording of "Pass the Mic." By looping[104] the sample of this three-note fragment, defendants repeated it at regular intervals forty times throughout their song. The district court granted a summary judgment for Beastie Boys on two grounds: (1) the segment sampled was not of sufficient originality to merit copyright protection; and (2) even if the sampled portion was copyrightable, Beastie Boys' use was *de minimis* and therefore not actionable.[105]

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101. 84 F.3d 1213 (9th Cir. 1996).
102. *See id*. at 1219. Unfortunately, the remainder of the opinion in *Smith v. Jackson* only demonstrates the continued confusion about the inverse ratio rule, in which a lower standard of proof is needed to show substantial similarity as a higher degree of access is shown, and its appropriate application.
103. 388 F.3d 1189 (9th Cir. 2004), *cert. denied,* 545 U.S. 1114, 125 S. Ct. 2905, 162 L. Ed. 2d 294 (2005).
104. A loop is a section within a sample that, through digital technology, may be played repeatedly as many times as the composer requires.
105. *See* 388 F.3d at 1192. The Ninth Circuit Court of Appeals affirmed on the second ground with the following observations: "[N]o reasonable juror could find the sampled portion of the composition to be a quantitatively or qualitatively significant portion of the composition as a whole. Quantitatively, the three-note sequence appears only once in Newton's composition. It is difficult to measure the precise relationship between this segment and the composition as a whole, because the score calls for between 180 and 270 seconds of improvisation. When played, however, the segment lasts six seconds and is roughly two percent of the four-and-a-half minute "Choir" sound recording licensed by Beastie Boys. Qualitatively, this section of the composition is no more significant than any other section. Indeed, with the exception of two notes, the entirety of the scored portions of "Choir" consist of notes separated by whole and half-steps from their neighbors." *Id*. at 1195-96.

D. *Bridgeport Music, Inc. v. Dimension Films*[106]

Unlike *Newton v. Diamond*, where the plaintiff claimed that the defendants had infringed the *music copyright* (as distinguished from the copyright for the sound recording), in *Bridgeport Music Inc. v. Dimension Films,* the plaintiffs claimed that, in using the sample at issue, the defendants had infringed the copyright in the sound recording. The district court, in granting defendants' summary judgment motion, found that a digital sample of a two-second guitar riff was *de minimis* and therefore not actionable. In reversing the summary judgment, the Sixth Circuit Court of Appeals held that defendants' sampling from the copyrighted sound recording violated an exclusive right granted to plaintiff under the 1976 Copyright Act and was therefore a *per se* infringement of plaintiff's sound recording.[107] This strict "bright line" construction of the Copyright Act by the Sixth Circuit is discussed in greater detail in Chapter 8.[108]

E. *Swirsky v. Carey*[109]

In *Swirsky v. Carey*, the Ninth Circuit Court of Appeals reversed summary judgment in favor of the defendants, and remanded the case for trial. In this case, the court accepted a creative musicological approach called "melodic reduction," which in its opinion raised a genuine issue of fact for the jury to determine whether ideas embodied within the two works were substantially similar under the extrinsic test articulated in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corporation*.[110] This methodology is one which, rather than considering the function and importance of all the notes in a motif, phrase, or other form of musical expression, focuses on so-called "stress" notes, which apparently are those that are allegedly more prominent or more important than the other notes.[111]

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106. 410 F.3d 792 (6th Cir. 2005).
107. *See id*. at 800-01.
108. *See, supra*, Chapter 8, *Fair Use—Part Two: Borrowing, The Art of Parody and Other Exercises In Fair Use*, §§VIII.B & C.
109. 376 F.3d 841 (9th Cir. 2004).
110. *See id*. at 846. As part of the expert testimony and expert report disclosures required under Rule 26(a)(2) of the Federal Rules of Civil Procedure, plaintiff's expert, in applying the "melodic reduction" method, identified "stressed" or "emphasized" notes, which, in his opinion, were more important than other notes, and he compared them with defendant's work to show that the same stressed notes appear at the same places in plaintiff's work as in defendants work. These important notes, in the expert's opinion, were those (1) that fall on a beat; (2) upon which "stress" is placed; (3) in the "hook" of the song; or, (4) that end a phrase. Plaintiff submitted testimony from this expert in moving for summary judgment *See id*. at 846–47.
111. This methodology is comparable to a literary analysis in which emphasis on certain words, and perhaps even letters, is given undue importance in analysis and dissection, rather than

The appellate court's adoption of this approach may have occurred because the defendants did not submit a declaration from a musicologist pointing out the defects in the plaintiff's expert's musicological report and declaration. It is to be noted that none of the leading musical dictionaries (*e.g. Oxford*, *Harvard, Grove*) recognizes this theory. In fact, it is not unusual to find emphasis on a particular note or beat: for example, consider that three-quarter time is the meter used both for waltzes and mazurkas; three-quarter time is a standard building block available to all composers writing in these two dance forms. What distinguishes one from the other is that, in waltzes, the first beat is emphasized, while in mazurkas, it is usually the third beat or, occasionally, the second, that is emphasized or accented. Putting emphasis or "stress" on certain notes is a musical idea used by generations of composers, which, in these contexts, distinguishes these two musical forms. Though the emphasis on one beat rather than another may seem a trifle, in the case of these two dance forms, the differences are dramatic, not only to the listener, but also to the habitué of the dance floor. The same may be said for the emphasis on the downbeat in a popular song. The main vice of this attempt at forensic musicology, however, is that it fails to include (or give equal consideration to) all notes in the expression of a musical idea, no matter how brief or extended. In any event, the emphasis on the notes or beats in many contexts is a *scène à faire* growing logically from standard musical forms and structures that are not "owned" by any one composer.

F. *Tisi v. Patrick*[112]

Michael Tisi, a composer, wrote a rock composition in 1994 entitled "Sell Your Soul" ("SYS"). During the same year, Arthur Joseph Productions Company, in which his father was a partner, submitted a demo tape of SYS to executives of various record companies for the purpose of procuring a recording contract for Tisi and interesting them in licensing and distributing commercial recordings of SYS. All submissions were rejected, and, in early 1996, all efforts to promote the demo tape ceased. In early 1999, the plaintiff heard the rock song "Take A Picture" ("TAP"), written by Richard Patrick and recorded by Patrick's rock band, Filter, which was included in the band's CD album *Short Bus*.

Richard Patrick, unlike Tisi, from an early age experienced substantial success and recognition composing and performing music he had written, beginning in 1984. He composed TAP at various times in 1996 and 1997. When released in 1999, it became a hit single, and reached number one on the

analyzing a full sentence or paragraph in the context in which alleged similarity of expression is found.

112. 97 F. Supp. 2d 539 (S.D.N.Y. 2000).

Billboard "Dance" charts. The plaintiff named as defendants not only Patrick and Filter but also the record and publishing companies to which SYS had been submitted. Plaintiff moved for a preliminary injunction and summary judgment, and defendants filed a cross-motion for summary judgment. Judge Sweet denied plaintiff's motion and granted defendant's summary judgment because plaintiff failed to prove the elements of striking similarity to establish copying or even access. Judge Sweet's published opinion analyzes both similarities and differences between the compositions in a sophisticated exercise of separating unprotected ideas from protected expression without the need to implement a two-prong test or to label those tests extrinsic and intrinsic. He merely states:

> This action requires an analysis of the common and unique aspects of the two rock music compositions at issue, as well as resolution of the issue of Patrick's access to Tisi's composition. Thanks to the skill of counsel and the clarity of the Defendants' expert witness, the unfamiliarity of the court with the genre has been overcome. A combination of common sense and a hastily trained ear dictate the forthcoming result.[113]

Then, prior to analyzing the two compositions, he states:

> For the uninitiated, much of rock music sounds the same, and a hasty comparison of SYS and TAP could result in a finding of superficial similarity, as both songs employ a standard usage in rock music: an introduction, verse, chorus, and bridge, with harmonic and rhythmic similarities common to many musical genres, including pop rock. A closer review of the two compositions reveals, however, that they are significantly different. Even to one unversed in the genre, the two songs can be heard to be quite dissimilar.[114]

The court then explains that each side had one expert who agreed that, on the question of similarity between the songs, the elements to be considered are "structure, melody, harmony, and rhythm."[115] The court continues its analysis of these four elements and finds both unprotected similarities and differences as follows:

1. Structure

Due to the fact that both songs use a structure that is standard in popular rock music—introduction, verse, chorus, and bridge sections—such similarities

113. *Id.* at 541.
114. *Id.* at 543.
115. *Id.*

are insignificant (and from that we can conclude "unprotectable," although the court did not use that terminology). Judge Sweet also finds significant structural differences, including a "lengthy distorted rock guitar intro not found in SYS," a different construction of the verse in both songs, and a closing section found in TAP but not in SYS.[116]

2. Harmony

Although harmonic analysis shows that here the songs are the closest, they result from "chords with common characteristics."[117] The judge, however, finds that there are also "notable differences" in the harmonies and, even though both songs are in the key of A major, that is true of "countless songs in all genres of music."[118] The fact that, although both the compositions in their introductions and verses use a "I-IV" harmonic progression (*i.e.* built on the first and fourth steps of the scale, or an A chord to a D chord), this progression can be found in all genres of music. But there are also differences in the way the progressions are used in TAP, which the judge describes as "more complex, nuanced, and dissonant than the harmony of SYS and produces a different musical sound."[119]

3. Melody

The court held that "the melody in TAP does not share any notable similarities with the melody in SYS."[120]

4. The Court's Holding

The court held that, even though a lay person may hear certain similarities between the songs that result because both are based on four basic accents per measure, that alone is not significant because the use of four accents is "extremely common in the pop rock genre, and is also featured in Eastern European folk music and is not original to either SYS or TAP."[121]

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116. *Id.*
117. *Id.*
118. *Id.*
119. *Id.* at 544.
120. *Id.*
121. *Id.* The judge is obviously stating that there are antecedent sources in the public domain from which one or both parties drew or that may be musical expression resulting from the tonic-driven tempered Western scale.

G. *Johnson v. Gordon*[122]

In *Johnson v. Gordon*, the plaintiff, through his expert, attempted to demonstrate similarity of expression by altering the plaintiff's work, "You're The Only One (For Me)" through the use of two compositional devices—inversion and retrograde[123] to vary plaintiff's melody and thereby show that the melody lines in defendant's composition are merely variants of elements found in plaintiff's work. In commenting upon this methodology, the court observed that "[a] look at the techniques employed by [plaintiff's expert] Mr. John in his Herculean effort to assimilate the two melodies makes manifest the absence of any meaningful degree of similarity. The witness first transposed bars 16 and 17 of the plaintiff's composition into D flat (the key of the defendants' song). He then altered the melody by raising it a perfect fifth (moving each note seven half-steps up the musical scale). At that point, he applied the known formula for inversion, but altered the rhythm to match that of the defendants' song. And, finally, he added an A flat note to the altered, inverted version of the plaintiff's bars 16 and 17. . . . [¶] He also conceded that the melodic contour employed by the defendants—the descending scale of 5, 4, 3, 2, 1—was a 'very common' melodic pattern that appears in such hoary songs as 'Row Row Row Your Boat' (specifically, the melody that accompanies the lyric 'life is but a dream')."[124]

The court also makes it clear that harmonic progressions (*i.e.*, a progression of chords) are, as a general proposition, not protectable by copyright. In *Johnson v. Gordon*, the progression was a III, II harmonic progression described as "a type of progression from a mediant chord to a supertonic chord, commonly inserted in popular and jazz music to 'create a sense of instability . . . with the hope of resolving at some point.'"[125] The court concludes that "this harmonic progression, which is a stereotypical building block of musical composition, lacks originality. Accordingly, it is unprotectable."[126]

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122. 409 F.3d 12 (1st Cir. 2005).
123. For clarification, the court noted: "[R]elying on a standard musicological dictionary, [plaintiff's expert] Mr. John defines melodic inversion as 'a procedure in which each ascending interval of an entire melody is changed into its opposite descending interval and vice versa.' He defines retrograde as 'a term indicating reverse or backward motion, e.g., beginning with the last note of the melody and ending with the first.'" *Id*. at 21 n.4 (citation omitted in original).
124. *Id*. at 21-22.
125. *Id*. at 23. For clarification, in a C Major scale the mediant is a third step in the scale while the supertonic is the second step immediately above the tonic, or in other words 3=E, 2=D.
126. *Id*. *See also* Intersong-USA v. CBS, Inc., 757 F. Supp 274, 282 (S.D.N.Y. 1991) (certain harmonic progressions are unprotectable because they appear in many songs); Northern Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 400 (S.D.N.Y. 1952) (where the court states that harmony "is achieved according to rules which have been known for many years" and that "[b]eing in the public domain for so long" it cannot itself be the subject of copyright").

H. *Tempo Music Inc. v. Famous Music Corporation*[127]

The Duke Ellington jazz standard "Satin Doll" became a battleground to determine the ownership interests in certain versions of this bona fide jazz classic. The claims of composers Duke Ellington and Billy Strayhorn were represented by their estates, since each had died a number of years previously. Specifically, the dispute was between third party plaintiffs Famous Music Corporation and Mercer Ellington (the "Ellington Estate"), as plaintiffs, and defendant Gregory A. Morris, executor of the Billy Strayhorn estate. Although the parties had settled a number of the disputes, one remaining issue, as the court framed it, "is whether Billy Strayhorn's estate has an interest in the harmony and revised melody of Satin Doll when used or performed *without* the lyrics."[128]

The parties filed cross-motions for summary judgment. The Strayhorn estate moved for a partial summary judgment, declaring that Strayhorn's heirs were entitled to one-third of all royalties and other compensation earned from his contribution to the harmony and revised melody of the "Satin Doll" version without lyrics. The Ellington estate, in its cross-motion, sought a declaration that the Strayhorn estate had no interest in the versions of "Satin Doll" without the lyrics. The court described the first issue as one of first impression, that is, "whether a harmony added to an earlier work can, as a matter of law, be the subject of copyright."[129] There were a number of factual disputes, including differing attributions on the copyright registration certificates as to who were composers of the music for "Satin Doll."

The court held that "[t]hese inconsistencies create a genuine issue of material fact and preclude summary judgment on this ground."[130] Of greater significance, however, is the court's holding that, even though harmony in and of itself is not accorded copyright protection and is "a derivative creation almost by definition," and that although derivative works can be copyrightable under the 1909 Copyright Act, there are two limitations standing in the way of protectability for Strayhorn's contributions to the "Satin Doll" versions without lyrics: (1) in order to be entitled to copyright protection, the contributions must be non-trivial and original elements must be added by the second composer (in this case, Strayhorn); and (2) these contributions cannot affect the scope of copyright protection in the original preexisting composition.[131] The court observes, however, that:

> While we agree that melody generally implies a limited range of chords which can accompany it, a composer may exercise creativity in selecting among these chords.

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127. 838 F. Supp. 162 (S.D.N.Y. 1994).
128. *Id.* at 164 (emphasis in original).
129. *Id.* at 165.
130. *Id.* at 166.
131. *Id.* at 167-68.

> As Strayhorn's expert notes, the choice of chords influences "the mood, feel and sound of a piece."[132]

I. *Intersong-USA v. CBS, Inc.*[133]

This case involved two Latin songs, one, a song entitled "Es" composed by Enrique Chia, and the other, a song entitled "Hey" recorded by the popular Latin singer Julio Iglesias. In addition to lack of access and independent creation, plaintiff failed to show that there was substantial similarity of protected expression. With respect to the second ground for granting a defense summary judgment, the court provided its rationale in the following language:

> As was ably demonstrated by [defendants' expert] Mr. Ricigliano, "Es" and "Hey" do contain common elements. Both use a descending scale step motive in the verse. . . . This descending scale step motive, however, is a commonly used compositional device. Not only is this device found in "Twinkle, Twinkle Little Star," but the identical note progressions found in "Es" and "Hey" also are found in compositions entitled "Amore un Altra" and "Without You." . . . In addition, Iglesias has incorporated this device in many of his recordings. . . .
>
> Other similarities between the songs include their structure patterns, their use of a certain harmonic progression and a recurring eighth note rhythm. As indicated in the Court's Findings of Fact, . . . however, these common elements are found in many other well-known songs.[134]

VIII. Preparing a Summary Judgment Motion: An Overview

A. Initial Planning

1. The Question

When should a lawyer representing the party to a copyright infringement action begin considering whether to move for or potentially whether and how to defend against a summary judgment?

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132. *Id.* at 168. *See also* ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1991) (where the court held that, even though a sequence in plaintiff's composition was comprised of unprotectable musical building blocks, they were used in such a creative and unique way that the musical expression was protectable).

133. 757 F. Supp. 274 (S.D.N.Y. 1991).

134. *Id.* at 282 (citations to record omitted).

2. The Answer

a. For the Plaintiff

Before litigation is commenced and after plaintiff has consulted with a musicologist or other music expert to determine whether the claim will survive a defense summary judgment.

b. For the Defendant

After doing the following: reviewing the plaintiff's complaint; obtaining a copy of the deposit[135] audio tape or CD of plaintiff's composition and submitting the same to and consulting with the musicological expert regarding his or her opinion as to whether defendant copied protectable expression from plaintiff's work.

For the plaintiff's lawyer, focus should be on whether the client's claim has sufficient merit to withstand a motion for summary judgment. For the defendant's counsel, it is the proverbial other side of the coin: Are there supportable grounds for a defense summary judgment: (1) As a matter of law that no reasonable juror properly instructed could find the two works substantially similar in protectable expression; (2) the materials plaintiff is seeking to protect by copyright are in fact commonplace musical fragments, phrases, *scènes à faire*, or other unprotectables; (3) any copying of protectable expression by defendant is *de minimis*; and/or (4) the copying by defendant constituted a fair use.

B. To File or Not To File: The Fixed Form of the Works at Issue

The steps taken by lawyers representing parties to copyright infringement litigation, as discussed in Chapter 4—whether plaintiff or defendant—bear repeating when considering, filing, or potentially defending a motion for summary judgment. In most cases, a successful summary judgment motion is usually the goal of defendants, while the likelihood of defending a summary judgment should be confronted by plaintiff's counsel before filing the complaint. The same careful and probing interview with the client must be conducted by counsel regarding the following: access by defendant to plaintiff's work—the only purely fact-driven issue in infringement litigation—must be fully explored to prove copying whether by direct proof or by inference from similarities between the contending works; all facts relating to the creation of plaintiff's work; opinions and advice from an expert regarding the originality

135. An audio recording of the musical being registered for copyright must be deposited with the Copyright Office of the United States concurrently with the application for registration.

of the musical material that plaintiff claims was copied by defendant; and legal analysis by counsel for each party regarding the copyright protection—or lack thereof—upon which the plaintiff's claims and defendant's defenses will be based.

Lawyers and their clients may question the advisability of moving for summary judgment, with its history of misunderstanding and inconsistency of application. Will it end in denial of the motion and its consequent waste of resources? Given varying results when similar issues have been decided by the courts, what is the likelihood of a successful result? Could the resources be better directed toward settlement or the ultimate trial of the action? Will denial of the motion provide a psychological lift to the opposition? Are there any genuine issues of material fact regarding similarity of protectable expression? At the risk of overstatement—leaving aside the issue of access and focusing on actionable copying of protectable expression—unlike the majority of claims regarding disputed facts underlying the litigation, in copyright infringement cases, the works are complete and fixed in some tangible form of expression at the time of the alleged infringement. As such, litigation involving copyrighted works is "law-driven," as distinguished from those disputes that are "fact-driven."[136] In the fact-driven disputes, because of self-interest, the selectivity of memory, and the differences in the way humans perceive events and their interaction with others, facts and circumstances giving rise to litigation are passionately disputed and, as such, raise questions as to the credibility of witnesses who are involved in or witness the same events: Who is telling the truth? Is a witness's memory faulty? Are the witness's perceptions of the event flawed or the result of reconstruction of the events whether due to faulty recollection or blatant self-interest? The stark differences between fact-driven and law-driven disputes are placed in sharp relief by the following scenarios:

1. Scenario 1—The Law Driven Case: Copyright Infringement

In 2000, the famous rap composer and performer, Rapper D-Strukt, created a rap song/declamation. Having studied at Juilliard in New York City in the mid-1990s on a scholarship in composition (when his name was still Patrick Rooney), he abandoned his plan to compose symphonic works. His imagination had been captured by rap music and the possibilities of using the elements of concert music in rap to open up a whole new approach to rap that would expand its range of expression. He chose to use the revolutionary musical elements utilized by Igor Stravinsky in *Rite of Spring*: disjointed rhythms

136. An exception to this statement is those infringement actions in which the fair use defense is asserted. Because of the many factual and contextual permutations that may be involved in determining whether a use is fair or constitutes an infringement, a careful analysis of the operative facts is essential.

achieved by changing meter and tempo throughout his new work, polytonality, and a symphony-sized orchestra with sixty violins, plus the usual winds, brass, and percussion. His composition, "Symphony Rap," was an instant sensation. It was number one on the charts for seventeen weeks and started a rush by other rappers to create equally revolutionary works. One of these was Flashman Igor (*né* Igor Ratoff), a Russian émigré who also studied composition at Juilliard on a scholarship. Igor decided he would use Dmitri Shostakovich and Bela Bartok as his models. The orchestra was also symphonic in size and instrumentation and his song, "Igor's Hip-Hop," first climbed the charts in Russia, eventually making its way to the United States, where "Igor's Hip-Hop" was at first a novelty, then caught on and became a hit because of its unusual use of polytonality and idiosyncratic disjointed rhythms, also achieved by changing meter and tempo throughout his work. Both works were registered for copyright, and an audio CD of each song was deposited with the Copyright Office of the United States.

2. Scenario 2—The Fact-Driven Case: Sexual Harassment

These disputes are often reduced to the catch phrase: "He said; She said." In this instance, He was the manager at a restaurant where She was a server. She says that, on the second day of Her employment, prior to opening for dinner, He asked Her to get three extra tablecloths in a room at the back of the premises. She immediately walked to the room where tablecloths and other linens were kept in and started picking out the tablecloths when He walked in the door, closed it, and pinned Her against the wall. He started groping Her. She pushed Him off, picked up the tablecloths and hurried out the door to a dining area where She set the tables. At the end of Her shift before going home, She told Him that She would not report Him but cautioned that He should never grope or harass Her again. He promised not to do so. Two weeks pass. He asks Her to go out on a date with him. She refuses. Finally, He fires Her, claiming that She failed to follow orders and that Her performance did not meet the standards set by the company. She files a sexual harassment action against Him, the company, and His superiors. He denies that He ever groped or harassed Her sexually or otherwise and that She was fired because of unsatisfactory performance of Her job. She, in painstaking detail, gives Her side of the story: His groping Her, harassing Her, and retaliating because She refused to give in to His advances. In other words, this is a hotly-contested dispute, leaving the jury to evaluate the credibility of each to reach a decision.

3. Copyrighted Works in Final Form: A Conglomeration of Stipulated Facts

The stark difference between the fact-driven incident and a copyright law-driven controversy could not be more dramatic: In our sexual harassment

wrongful termination scenario, the testimony of the plaintiff and the defendants' restaurant manager are at total variance with one another because one of them is not telling the truth. The jury must weigh the credibility of each witness, the circumstances surrounding the incident, and the motives of each to determine what the facts are. After so doing, the facts found by the jury may or may not be those that actually occurred. Copyright infringement litigation, however, involves two creative works—whether motion pictures, pictorial or sculpted works, or musical compositions—which, at the time of infringement, are in their fixed and final form documented by their creators. [137] As such, each creative work can be viewed as a conglomerate of stipulated facts, immutable at the moment of the alleged infringement and thereby free from dispute regarding its respective contents. In that factual setting, a judge ruling on a summary judgment motion should, as a matter of law—with the aid of expert testimony (where necessary)—be able to rule on whether there is no substantial similarity of protectable expression as between the works at issue, or whether there are genuine issues of material facts foreclosing summary judgment. This is also true of the reverse where the plaintiff moves for summary judgment on the ground that the defendant has copied protectable expression.

IX. Strategy and Tactics: The Use of Expert Testimony in Support of a Motion for Summary Judgment

A. Two Schools of Thought

In approaching summary judgment, there are two schools of thought on whether to submit declarations from experts opining on similarities or the lack thereof between the works at issue. Those opposed to using expert testimony point out that doing so invites a responsive expert declaration listing similarities between the works—whether protectable or not—thereby giving rise to an issue of fact (which may or may not be genuine or material) ending in denial of the motion. The other school of thought is that, since the law has advanced to the stage where expert testimony is not confined to proof of

137. For example, in *Walt Disney Productions v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978), the trial judge,in his opinion noted that the basic facts were undisputed and found as follows: "The works protected by the copyrights comprise a series of cartoon drawings ranging from a single page to 'book length.' The cartoons depict the antics of characters created by plaintiff, with 'balloons' over each of the characters' heads containing dialog. Cartoons are drawn to form a narrative." *Id*. at 753. "According to plaintiff, defendants infringed Disney copyrights by copying the graphic depiction of over 17 characters. Two of the characters are represented as insects, and the others as animals endowed with human qualities. *Each character has a recognizable image." Id*. (emphasis added).

access, but can also be offered to demonstrate that what plaintiff is trying to protect by copyright is in fact unprotectable, the expert may opine that the portion of the work plaintiff claims has been infringed is a motif, phrase, *scène à faire* or other commonplace building block of music.

Although each of these approaches regarding the use of expert testimony in support of summary judgment motions has merit, given the law as it has evolved, the better approach in music infringement litigation is to submit a declaration setting forth the analysis and opinion of a qualified expert.[138] The legal guidelines for proceeding in this manner are found in the following sources: Rule 56 of the Federal Rules of Civil Procedure; Rule 702 of the Federal Rules of Evidence; and the Supreme Court opinion in *Daubert v. Merrell Dow Pharmaceuticals Inc.*,[139]as well as the Supreme Court opinions in *Kumho Tire Company, Ltd. v. Carmichael*[140] and *General Electric Company v. Joiner,*[141] both of which clarified and expanded the holdings in *Daubert* by, among other things applying its holdings to different factual circumstances and eliminating any lingering doubt that *Daubert* applies to disciplines outside science and medicine.[142]

B. The Mandates of Rule 56

Our initial focus will be on the following requirements for summary judgment motions found in Rule 56 of the Federal Rules of Civil Procedure:

1. Genuineness and Materiality

The language of this Rule mandates that a moving party is entitled to judgment as a matter of law "if the pleadings, the discovery and disclosure materials on

138. There are exceptions depending upon the circumstances. For example, in a non-music infringement case, if the plaintiff's claim is based upon *scènes à faire* in two scenarios dealing with battles in World War II and the Korean War, each of which is expressed differently, counsel should consider whether an expert's dissection and analysis are necessary or even harmful in that an issue of material fact (whether or not "genuine") may be created by the response from an opposing expert where the subject matter at issue is so commonplace that expert opinion may well be unnecessary.

139. 509 U.S. 579, 113 S. Ct. 2786, 125 L. Ed. 2d 469 (1993).

140. 526 U.S. 137, 119 S. Ct. 1167, 143 L. Ed. 2d 238 (1999).

141. 522 U.S. 136, 118 S. Ct. 512, 139 L. Ed. 2d 508 (1997).

142. *See, e.g.*, *Kumho Tire*, in which the Court advises us that "This language [in Rule 702 of the Federal Rules of Evidence] makes no relevant distinction between 'scientific' knowledge and 'technical' or 'other specialized' knowledge. It makes clear that any such knowledge might become the subject of expert testimony. In *Daubert*, the Court specified that it is the Rule's word 'knowledge,' not the words (like "scientific') that modify that word, that 'establishes a standard of evidentiary reliability.' . . . Hence, as a matter of language, the Rule applies its reliability standard to all 'scientific,' 'technical,' or 'other specialized' matters within its scope." *Kumho Tire*, 526 U.S. at 147, 119 S. Ct. at 1174.

file, and any affidavits show that there is no genuine issue as to any material fact." In *Anderson v. Liberty Lobby, Inc.*,[143] the Court defined a "material fact" as one that affects the determination of a litigation. Materiality is determined by the pleadings that raise the issue(s) to be resolved by the substantive law applicable to the claim or claims that are the target of the summary judgment. A "genuine issue of any material fact" is one on which the non-moving party would or can prevail at trial.

2. Burden

Prior to 1986 when the Supreme Court decided *Celotex Corporation v. Catrett* and *Anderson v. Liberty Lobby, Inc.* on the same day, summary judgment was a disfavored remedy[144] with the moving party saddled with a virtually impossible burden of producing evidence in support of the motion. Since 1986, however, the non-moving party in opposing a summary judgment motion bears the same burden of production and proof he or she would bear at trial.[145] Under these standards, the moving party (most often the defendant) in showing that there is no genuine issue of material fact, must reference "pleadings, the discovery and disclosure materials on file [such as depositions, answers to interrogatory and admissions] and any affidavits" to support his or her motion. Once having done so, the same burden that the plaintiff or defendant would have at trial shifts to him or her to produce admissible evidence supporting the opposition.

C. Rule 702 and the *Daubert* Trilogy: The Basic Qualifications for Experts

In *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, the Court listed four factors to be considered by trial courts in ruling on the admissibility of expert testimony: (1) testing of the knowledge being presented; (2) peer review and publication of proffered information; (3) the rate of error relevant to the methodology used by the expert; and (4) the degree of acceptance of the proposed testimony in the relevant community.[146] The Court was quick to point

143. 477 U.S. 242, 248, 106 S. Ct. 2505, 2510, 91 L. Ed. 2d 202 (1986).

144. In fact, it was disfavored by the majority in the *Celotex* circuit court opinion. *See* Catrett v. Johns-Manville Sales Corp., 756 F.2d 181 (D.C. Cir. 1985), *rev'd sub nom.* Celotex Corp. v. Catrett, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). The dissenting opinion by Judge Robert Bork favoring the remedy of summary judgment is echoed by the Supreme Court.

145. This statement is made in the context of a defense motion for summary judgment and should not lead to the conclusion that plaintiffs may not also file such motions, as will also be discussed in this Chapter, *infra*.

146. *See Daubert*, 509 U.S. at 593-94, 113 S. Ct. at 2797.

out, however, that the inquiry into the qualifications of experts was not limited to these four factors.[147] This *caveat* by the Court was fleshed out in *Kumho Tire Company, Ltd. v. Carmichael*.[148] An additional factor that merits special attention is whether a theory upon which the expert relies has been created specially for the dispute for which he or she has been retained to analyze the issues and render an opinion.

For example, in our hypotheticals set during the Second World War and the Korean War, let us assume that a professor of cinema in his or her declaration in opposition to a summary judgment motion attempts to raise a genuine issue of material fact by opining that the defendant had placed particular emphasis on Sherman armored tanks (as distinguished from other field artillery) by photographing close-ups of these armored vehicles in battle scenes, as had the plaintiff in battle scenes in its picture about the Korean War. Our expert further testifies by written declaration that this is a highly creative approach calculated to emphasize the role of the tank corps in war. This expert testimony is therefore inadmissible, lacks foundation, and is irrelevant for the reasons that: (1) it is not genuine, because it is not an issue upon which the plaintiff would be able to prevail at trial because merely placing emphasis on a piece of war machinery, or any other object for that matter, is a cinematic method or technique which is not protectable under the copyright law; and (2) it is not a "material fact" because it is not one that would affect the outcome of the litigation in that a close-up shot of a piece of machinery is not actionable copying of expression. In addition, in applying the four *Daubert* factors, it would not meet at least three of the four: It is unlikely that peer review would sanction this opinion based on placing emphasis on a single piece of machinery; there would be no information about the rate of error relevant to this methodology, the nature of which is highly suspect; and it is unlikely that there is any degree of acceptance within the academic community involved with cinema studies.

D. Expert Testimony: Weighing the Balance in Music Infringement Litigation

1. The Benefits of Using Expert Witnesses

Based upon a strict and fair application of the Federal Rules of Civil Procedure and Federal Rules of Evidence, in deciding whether to submit declarations of experts in support of motions for summary judgment, the balance in most music infringement cases weighs heavily in favor of doing so. The point has

147. *See id.* at 594-95, 113 S. Ct. at 2797.
148. 526 U.S. 137, 119 S. Ct. 1167, 143 L. Ed. 2d 238 (1999).

been made that, unlike with literary works, the visual arts, motion pictures, television, and other audiovisual works, music, with its ideas and medium of expression, requires translation and explanation for the trier of fact in infringement litigation. This is especially true when the plaintiff's case (as many of them are) is based on musical ideas, building blocks of music, and *scènes à faire*. To put this on a very practical footing, even with those judges disinclined to grant summary judgments, the only way of attacking a theory based upon "infringement" of unprotectable elements of musical work is to bring to the court's attention, sooner rather than later, the reasons copyright protection cannot be extended to the work or parts thereof that are at issue. If, after the hearing, the judge is still disinclined to grant the motion, at least the educational process has begun.

It should not pass without comment that the opinion in each of the cases discussed in Section VII, above, turned on the court's acceptance of opinions by one expert over another.

For example, in *Johnson v. Gordon*,[149] plaintiff alleged that defendants, in creating their song, "You're the One," copied protected expression from his work "You're the One (For Me)." Plaintiff's claim rested almost solely on the deposition testimony of his expert, Kenrick John. There were two versions of plaintiffs' song—a short version and a long version—only the former being protected by copyright. The similarities between plaintiff's and defendants' compositions were created by Mr. John, who altered the notes in plaintiff's work so that defendants' song would appear to be substantially similar to plaintiff's *protectable* expression. To his credit, plaintiff's expert, in his deposition, (1) agreed that progressions common to both works can be found in thousands of songs;[150] (2) acknowledged that, even with his "manipulation"[151] of portions of the songs, they were still different; and (3) agreed that certain of the copied notes were in the public domain. The court observed:

> A nisi prius court need not give weight to opinion evidence that is unsupported by an adequate foundation. . . . Given the porous nature of the foundation that undergirded Mr. John's casual references to sampling, the district court's refusal to credit those references was amply justified. To hold otherwise would be tantamount to requiring trial courts to indulge in speculation and surmise.[152]

In effect, the First Circuit Court of Appeals is stating that the testimony of the plaintiff's expert was unworthy of consideration or belief because it did not meet—nor was there any attempt to satisfy—the suggested (but nonexclusive) requirements in *Daubert* to lay the following minimal foundation

149. 409 F.3d 12 (1st Cir. 2005).
150. *See id.* at 23.
151. *Id.*
152. *Id.* at 25-26 (citations omitted).

for his testimony: (1) testing of the knowledge being presented; (2) peer review and publication of proffered information; (3) the rate of error relevant to the methodology used by the expert; and (4) the degree of acceptance of the proposed testimony in the relevant community.

Pivotal to supporting the grant of summary judgment by the district court in *Newton v. Diamond* and its affirmance is the opinion of Dr. Lawrence Ferrara, the defendants' expert, as noted by the Ninth Circuit Court of Appeals in the following language:

> The [defendants] Beastie Boys' expert, Dr. Lawrence Ferrara, concludes that the compositional elements of the sampled section do not represent the heart or the hook of the "Choir" composition, but rather are "simple, minimal and insignificant." The sampled section may be representative of the scored portions of the composition as [plaintiff] Newton's experts contend. Newton has failed to offer any evidence, however, to rebut Dr. Ferrara's testimony and to create a triable issue of fact on the key question, which is whether the sampled section is a qualitatively significant portion of the "Choir" composition as a whole.[153]

The district court's opinion in *Tisi v. Patrick* underscores the importance of expert testimony when moving for summary judgment in music infringement cases. Judge Sweet, for all his judicial talents, would not have been able to articulate his musicological rationale without education and analysis from an expert who conveyed knowledge to the court ranging from the musical elements of structure, harmony, and rhythms to "accents" common in the pop rock genre and Eastern European folk music.[154]

2. The Decision Not to Present Expert Testimony: The Downside

In two of the reported authorities—*Baxter v. MCA, Inc.* and *Swirsky v. Carey*—the defendants, for tactical reasons, chose not to submit expert declarations in support of their summary judgment motions, resulting in a denial of summary relief. Their rationale was that, if they submitted expert declarations in support of their motions, the plaintiffs, by submitting their experts' opposition declarations, would create an issue—genuine or not—of material fact, thus leaving the judge no alternative other than to deny the motion. When the plaintiffs in those cases submitted expert declarations, they still raised or created the issues of material fact the defendants sought to avoid by not filing expert declarations.[155]

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153. Newton v. Diamond, 388 F.3d 1189, 1196 (9th Cir. 2004).

154. *See* Tisi v. Patrick, 97 F. Supp. 2d 539 (S.D.N.Y. 2000).

155. *See* Swirsky v. Carey, 376 F.3d 841 (9th Cir. 2004); Baxter v. MCA, Inc., 812 F.2d 421 (9th Cir.), *cert. denied*, 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987).

This same line of reasoning—which was not without some merit—led defendants' trial counsel in *Selle v. Gibb*[156] to try a music infringement case before a jury without presenting expert testimony. The jury returned a verdict for plaintiff. The district court granted judgment *n.o.v.*, which was affirmed by the Seventh Circuit Court of Appeals, holding that plaintiff failed to sustain his burden of proving access based on striking similarity.

E. Two Scenarios

1. Scenario Number One

Let us assume that the plaintiff's musicologist, in opposition to the motion targeting a musical sequence for an onscreen ballroom sequence in Vienna, concludes that the defendant copied from plaintiff's work under the following circumstances: In the musical score accompanying an actor and actress dancing to a Viennese waltz, the defendant placed particular emphasis on the first beat of each measure followed by the playing of the second beat earlier than notated. The plaintiff's musicologist opines that a waltz scene, as depicted in plaintiff's motion picture, was accompanied by the allegedly infringed music whose elements include emphasis on particular notes and slight pauses between notes and that this raises a genuine issue of material fact because the defendant has placed emphasis on the same notes and has the same *rubato*[157]—like treatment that occurs in plaintiff's score. This position, as advanced by the plaintiff and his musicologist, is neither a genuine issue, nor is the fact at issue material for the following reasons:

a. Applying the Law of Evidence

This expert testimony is inadmissible for the reasons that: (1) it is not a genuine issue, as it is not an issue upon which the plaintiff would be able to prevail at trial because merely placing emphasis on the first beat and slightly advancing the playing of the second beat of a Viennese waltz is part of a musical genre that is not protectable under the copyright law; and (2) it is not a "material fact" because it is not one that would affect the outcome of the litigation

156. 741 F. 2d 896 (7th Cir. 1984).

157. *See* 21 The New Grove Dictionary of Music and Musicians 832 (Stanley Sadie ed., 2001) ("**Rubato** [tempo rubato] (It: 'robbed or stolen time'). The expressive alteration of rhythm or tempo. In an earlier type the melody is altered while the accompaniment maintains strict time. A later type involves rhythmic flexibility of the entire musical substance. Both originated as a part of unnotated performing practice, but were later sometimes indicated in scores. Some modern writers refer to the earlier and later types as melodic and structural, borrowed and stolen, contrametric and agogic, or bound and free.").

in that the composer's use of building blocks commonplace to a musical genre is not actionable copying of expression.

b. Applying the *Daubert* Factors

- If the knowledge of this expert were tested, either in a *Daubert* hearing before trial, or on *voir dire* before testifying at trial, his opinion would have been excluded because such accents are common in music. It is a technique for emphasizing certain notes and is a common building block in waltzes, where the accent occurs on the first beat of each measure, and in the Viennese waltz, whose hallmark is a slight anticipation advancing the playing of the second beat together with a slight *rubato;*
- There was no peer review and, if it had been requested, would not have been supportive of plaintiff's expert;
- There could be no analysis of a rate of error relevant to the methodology used by the expert since it was not subjected to peer review, nor was there any attempt to test the "theory" against applicable musicological rules and principles; and
- It has not and would not be accepted by the relevant community of musicologists.

In the moving party's reply brief, an expert would undoubtedly point out these flaws to the court. The question then arises as to whether this conflict raises a genuine issue of material fact. The answer is that the moving party in its reply papers should focus, not only on the qualifications of the opposing expert and the issues raised by the motion, but also on the fact that the expert has failed to satisfy (1) the four conditions set forth in *Daubert*, and (2) the explicit requirements set forth in Rule 56 of the Federal Rules of Civil Procedure. In other words, the mere filing of an expert declaration in which he or she attempts to raise issues as to facts that are neither genuine nor material should never defeat a motion for summary judgment.

2. Scenario Number Two

Plaintiff, Anton Urtext, a contemporary composer of concert music, has filed an action against Dennis Hollywood, a film composer, his publisher and a recording company alleging that Hollywood, in composing a motion pictures score, unlawfully copied elements from his concert work entitled "Unter den Linden," including its time signature (6/8), key (E minor) and, of pivotal importance, a progression (1, 4, 5, 1)[158] that logically leads to the conclusion

158. Although the convention in musicology is to use Roman numerals, the more familiar Arabic numbers will, for the most part, be used in this text. When quotations include Roman numerals,

of plaintiff's composition. Urtext's expert provides a written report in which he states that the combination of time signature, the key, and the progression constitute original protected expression. This analysis is a slight improvement over the expert opinion in Scenario 1. It will not, however, carry the day: Meters and selection of key are part of the raw materials used by all composers. Although plaintiff's expert may argue that joining these two musical elements with a 1, 4, 5, 1 progression demonstrates that plaintiff is relying on more than pitch sequence alone, that does not rise to the level required for copyright protection because that progression, together with the meter and key, have been used in countless works whether classical, pop, or other musical genres.

X. Forms

A. Plaintiff's Motion

Relatively speaking, far fewer motions are made by plaintiffs than by defendants in copyright infringement cases and, of those, far fewer are reported than those in favor of defendants. The principal reason is that, as at trial, a plaintiff in making a summary judgment motion must prove his or her case by a preponderance of admissible evidence. Except in those circumstances where a defendant's copying is virtually identical, the plaintiff will have great difficulty sustaining that burden on a summary judgment motion in the face of a defendant's opposition.[159]

B. Defendants' Motion

Given plaintiff's burden of proof, the defendant's goal is easier to attain. Pursuant to Rule 56 of the Federal Rules of Civil Procedure and its two most-cited expository opinions—*Celotex Corporation v. Catrett*[160] and *Anderson v. Liberty Lobby, Inc.*[161]—if the plaintiff's claim is based on infringement of unprotectable elements of his musical work, all the defendant must do is to identify these elements by reference to pleadings, discovery responses, other matters of record and perhaps an expert's declaration testimony. This leaves plaintiff with the burden of raising a genuine issue of material fact by proving by a preponderance of evidence that an element of his claim at issue is protected by copyright.

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however, the same numbering system will be employed when commenting on such quoted materials.

159. Examples of such cases are found in *Walt Disney Productions v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978), and *Bridgeport Music, Inc. v. Dimension Films,* 410 F.3d 792 (6th Cir. 2005). With the advent of file sharing and digital sampling the number of plaintiffs' successful judgments has increased significantly. *See, infra*, Chapter 12, § III.

160. 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).

161. 477 U.S. 242, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

C. Comment on Forms

- The information set forth in the preceding sub-paragraphs A and B is provided so that counsel for either a plaintiff or defendant can place in context the tasks confronting each of them in moving for summary judgment.
- These forms are based on the two-prong test (intrinsic and extrinsic) in view of the fact that that test is still followed by a majority of federal courts.
- The author has underscored the names of cases in the text of these forms and used other rules for citation and formatting as set forth in *The Bluebook*.[162] Counsel should consult Circuit Court Rules and District Court Rules for any citation and formatting rules for motions that may be preferred by each particular jurisdiction and venue.

D. Form: Plaintiff's Motion

[ATTORNEY NAMES]
[LAW FIRM]

Attorneys for Plaintiff Manfred Tunesmith,
professionally known as Mick Ringo

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MANFRED TUNESMITH, professionally known as Mick Ringo, Plaintiff, v. ANTHONY CRATER, professionally known as Master A.C., Defendant.	CASE NO. NOTICE OF MOTION AND MOTION OF PLAINTIFF FOR SUMMARY JUDGMENT; MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT THEREOF (Fed. R. Civ. P. 56) DATE: TIME: CTRM:

162. *See generally* The Bluebook: A Uniform System of Citation (Columbia Law Review Ass'n et al. eds., 18th ed. 2005).

TO DEFENDANT AND TO HIS COUNSEL OF RECORD:

PLEASE TAKE NOTICE that on _____, at _____, or as soon thereafter as the matter can be heard, in the courtroom of United States District Judge _____, located at 312 North Spring Street, Los Angeles, California, Plaintiff Manfred Tunesmith, professionally known as Mick Ringo, will move the Court for summary judgment in his favor, pursuant to Rule 56 of the Federal Rules of Civil Procedure.

This Motion will be made on the following grounds: (1) The sample taken by Defendant from Plaintiffs' composition, "Tropical Rock," which is used fifty-one (51) times in Defendant's composition "Caribbean Rock," is protected under Sections 106 and 114(a) of the Copyright Act, 17 U.S.C. §§ 106 & 114(a); (2) the "sampling" or "lifting" of a portion from the sound recording of "Tropical Rock" constitutes copyright infringement as a matter of law; (3) Plaintiff has the exclusive right as copyright proprietor to prepare derivative works from "Tropical Rock" as a result of which Defendant's "sampling" or "lifting" of portions of a copyrighted sound recording constitutes copyright infringement; and (4) pursuant to Sections 106 and 114(a) of the Copyright Act, 17 U.S.C. §§ 106 & 114(a), and related authorities, the grant of summary judgment in favor of Plaintiff is mandated as a matter of law. Plaintiff also moves for an award of attorneys' fees and costs pursuant to Section 505 of the Copyright Act, 17 U.S.C. § 505, and the holding in *Fogerty v. Fantasy, Inc.,* 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994).

This Motion will be based on this Notice, the pleadings, records and files in this action, the attached Memorandum of Points and Authorities, and the Declarations of [computer expert/recording engineer] and [counsel for Plaintiff], together with the exhibits referenced in the declarations, which are filed concurrently herewith, and upon such oral argument as the Court may permit.

Dated:_____

Respectfully submitted,

_____

By: _____

_____

Attorneys for Plaintiff Manfred Tunesmith

I. Introduction

Defendant Anthony Crater apparently wants this Court to ignore the laws that promote and protect creative artistic works and, instead, to award theft. To prevent such a result, summary judgment should be granted to Plaintiff on his claims of copyright infringement asserted against Defendant.

At the heart of this action is the immensely popular rock composition entitled "Tropical Rock." Plaintiff Manfred Tunesmith, professionally known as Mick Ringo, is the composer and lyricist of "Tropical Rock," which was one of the most financially successful compositions ever in its genre. For example, (1) Mick Ringo's tours featuring "Tropical Rock" were consistently sold out in the United States and Europe, and (2) the single record and CD album maintained its position as number one on the Billboard and other recognized charts for a period of more than eighteen weeks, a length of time virtually unheard of in the popular music field. On recordings alone, he achieved platinum record status (over one million singles sold) and gold record status on both the single and album (over 500,000 albums sold). Defendant Anthony Crater, professionally known as Master A.C., "sampled" or "lifted" a significant portion of "Tropical Rock" and used it fifty-one times in his composition "Caribbean Rock." The reason the portion lifted is a significant portion is because that segment is the very "hook" of "Tropical Rock," which Defendant chose to use, because, in the music industry, a "hook" is essentially defined as that refrain in a composition that the listener always remembers and associates with the song itself. Although Mr. Crater, in his deposition, claimed that he sampled the "hook" from "Tropical Rock" simply because of artistic considerations, in reality he wanted a piece of music an audience would immediately recognize and relate to. That is the purpose of the "hook." "Tropical Rock" was composed by the Plaintiff, and, in sampling the "hook" from "Tropical Rock," the Defendant not only exploited that protectable segment of music composed by the Plaintiff, but also all of the work and production values added by the band of musicians, the sound engineers, the computer experts, and all of the talents of the recording technicians who generated the unusual electronic sounds found in the "hook" to "Tropical Rock," the expense for which, including overhead, exceeded $500,000.

An electronic sample from an existing recording is clearly in violation of the Copyright Act of the United States with particular reference to Sections 106 and 114(a), 17 U.S.C. §§ 106 & 114(a). Defendant's use of the sample constitutes the "bright line" standard amounting to strict liability. It is as if someone decided to reproduce without permission, faithfully and with exactitude, the Darth Vader character in *Star Wars* or to copy without permission the Disney

characters such as Mickey Mouse and Donald Duck and to use them to illustrate a work totally unrelated to the Disney productions featuring those original fictional characters that are indelibly fixed in the minds of the public.

In his attempt to defend the indefensible, Defendant uses the usual affirmative defenses, as will be discussed more fully in this Memorandum of Points and Authorities: The portion of the song used by Defendant was *de minimus* and therefore not actionable; Defendant's sampling from "Tropical Rock" is a fair use; etc., etc., etc. As a matter of law, however, neither of these clichéd defenses has any merit whatsoever.

Moreover, in making this Motion, Plaintiff is cognizant of the requirements set forth in the Supreme Court decisions of *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986), and *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986), i.e., that each of the parties bear the same burden of proof it would have at trial. Plaintiff acknowledges that he bears that burden: Proof by a preponderance of evidence. That burden is more than met, however, by the admission into evidence of: (1) the certificate of registration for the sound recording of "Tropical Rock"; (2) a clip of the "hook" of "Tropical Rock"; (3) a clip of the "sampled" hook from "Tropical Rock" as used fifty-one times in Defendant's "Caribbean Rock"; and (4) the Declaration of George R. Bolt, a recording engineer and computer expert, testifying that the "hook" used by Defendant was electronically sampled by Defendant from "Tropical Rock" fifty-one times. Defendant, however, because of the nature of his conduct in the sampling of an important piece of the infringed material—the "hook"—from a copyrighted sound recording, cannot sustain his burden of proof by submitting relevant admissible evidence on an issue of which Defendant has the burden of proof. For that reason a summary judgment must be granted in favor of Plaintiff, Manfred Tunesmith.

II. STATEMENT OF FACTS

[HERE, PLAINTIFF SHOULD SET FORTH A SHORT STATEMENT OF FACTS THAT TELLS A STORY AND THAT CONTAINS FACTS THAT ESTABLISH EACH ELEMENT OF HIS CLAIM FOR INFRINGMENT, ALONG WITH CITATIONS TO THE DECLARATIONS, EXHIBITS, DEPOSITION TESTIMONY, ETC. THAT REFLECT THOSE FACTS.]

III. PLAINTIFF SHOULD BE GRANTED SUMMARY JUDGMENT BECAUSE HIS BURDEN OF PROOF IS SATISFIED BY PROVING THAT DEFENDANT DIGITALLY SAMPLED A SEGMENT FROM PLAINTIFF'S SOUND RECORDING AND USED THE SAMPLE FOR DEFENDANT'S RECORDING

A. The Statutory Mandate

Rule 56 of the Federal Rules of Civil Procedure mandates that a summary judgment motion be granted:

> [i]f the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.

Fed. R. Civ. P. 56(c).

B. Judicial Construction and Clarification: *Celotex* and *Anderson*

The United States Supreme Court has ruled that Rule 56(c) requires the entry of summary judgment

> against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be "no genuine issue as to any material fact," since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial. The moving party is "entitled to a judgment as a matter of law" because the nonmoving party has failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof.

Celotex Corp. v. Catrett, 477 U.S. 317, 322-23, 106 S. Ct. 2548, 2552, 91 L. Ed. 2d 265 (1986); *see also Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 249-50, 106 S. Ct. 2505, 2511, 91 L. Ed. 2d 202 (1986) (holding that "there is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. . . . If the evidence is merely colorable . . . or is not significantly probative . . ., summary judgment may be granted.") (citations omitted).

As discussed herein, Plaintiff has sustained his burden of proof, while Defendant cannot produce any evidence to raise a genuine issue of material fact. Accordingly, summary judgment is appropriate and should be granted.

IV. SUMMARY JUDGMENT SHOULD BE GRANTED, BECAUSE, PLAINTIFF, WHO IS THE COPYRIGHT PROPRIETOR OF A SOUND RECORDING, HAS THE EXCLUSIVE RIGHT TO PREPARE DERIVATIVE WORKS THEREFROM AND DEFENDANT'S DIGITAL SAMPLING DIRECTLY FROM THE SOUND RECORDING IS AN INFRINGEMENT OF COPYRIGHT

To prevail on a claim for copyright infringement, a plaintiff must provide proof of two elements: "(1) ownership of a valid copyright; and (2) copying of constituent elements of the work that are original." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.,* 499 U.S. 340, 361, 111 S. Ct. 1282, 1296, 113 L. Ed. 2d 358 (1991). Here, Plaintiff has adduced evidence to demonstrate each of those elements. Plaintiff's certificate of registration from the United States Register of Copyrights, (Ex. A to the Declaration of [ATTORNEY]), constitutes *prima facie* evidence of the valid ownership of a copyright. *See* 17 U.S.C. § 410(c). Additionally, Plaintiff has offered the copyrighted sound recording of "Tropical Rock," as well as a sound recording of "Caribbean Rock." (Exs. A & B to the Declaration of George R. Bolt ("Bolt Decl.").) A comparison of the two sound recordings establishes that the "hook" from Plaintiff's "Tropical Rock" is used by Defendant in his recording of "Caribbean Rock." In fact, "Caribbean Rock" uses electronic samples lifted directly and unchanged from the sound recording of "Tropical Rock." (See Bolt Decl. ¶¶ _____ & Exs. A & B.) Plaintiff therefore has established that Defendant's actions constitute copyright infringement.

While it is clear that Defendant's unauthorized copying of "Tropical Rock" is infringement, Defendant has argued that the copying was somehow *de minimus*—and therefore not actionable. This argument must fail. In *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005), for example, the defendants unsuccessfully attempted the same argument. In that case, the plaintiffs sued defendants for the unauthorized use of a sample from a composition and sound recording of a rap song entitled "Get Off Your Ass and Jam" ("Get Off") played in the soundtrack of a motion picture, *I Got The Hookup*. Plaintiff Westbound Record's claims were solely for infringement of the sound recording of "Get Off." Defendant No Limit Films, LLC ("No Limit") did not deny that it sampled, but, rather, asserted (as has the defendant in this case) that the copying was *de minimis* and, accordingly, not actionable.

The district court concluded that, whether the copying was analyzed under a qualitative/quantitative *de minimis* analysis or the "fragmented literal similarity test," the sample (a two-second fragment from a guitar solo that was lowered in pitch and extended to sixteen beats with each looped segment lasting approximately seven seconds) was not a "legally cognizable appropriation," *id*. at 797 (quoting *Bridgeport Music, Inc. v. Dimension Films*, 230 F. Supp. 2d 830, 841 (M.D. Tenn. 2002)), and granted summary judgment for defendant No Limit against plaintiff Westbound "on the grounds that the alleged infringement was *de minimis* and therefore not actionable," *id*. at 795.

The Sixth Circuit reversed, basing its decision on a strict "bright line" interpretation of Sections 106 and 114(a) of the Copyright Act. The court quoted from Section 114 of the Act, which provides, in relevant part, that "'[t]he exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106 [of the Copyright Act].'" *Id*. at 799 (quoting 17 U.S.C. § 114(a)). Sections 106 and 114 of the Copyright Act, in substance, grant specifically delineated exclusive rights to the copyright proprietor (as set forth in Section 106 (1), (2), (3), and (6)), while attaching limits to those exclusive rights with particular reference to "[t]he exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 . . . to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. *The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such other sounds imitate or simulate those in the copyrighted sound recording*." *Id*. at 799-800 (quoting 17 U.S.C. § 114(b) (emphasis added)). Construing this limiting language, the court concluded that other creators could emulate or simulate portions of a recorded work so long as the sound recording itself is not copied, but added that since one could not "pirate" a complete sound recording, he or she could not sample portions of it. The court further explained that "[f]or the sound recording copyright holder, it is not the 'song' but the sounds that are fixed in the medium of his choice. . . . [and] [w]hen those sounds are sampled they are taken directly from that fixed medium. . . . [such that sampling] is a physical taking" in violation of the copyright proprietor's rights in Section 106 of the Act. *Id*. at 802. Using this rationale, the court held that, since No Limit "lifted" or "sampled" notes (or "tones") protected by copyright, that alone was sufficient to constitute infringement, thus rendering the question of substantial similarity of expression (including the question of *de minimis* copying) inapplicable.

As in *Bridgeport Music*, any attempt by Defendant to argue that his copying was not actionable because it was *de minimus* must be rejected. His unauthorized use of "Tropical Rock" is a clear infringement of the Copyright Act, and, for that reason, summary judgment should be granted for Plaintiff.

Likewise, any argument that the copying was a "fair use" also must fail. For example, in *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978), summary judgment was granted in favor of plaintiff, and defendant's "fair use" defense was rejected. *Air Pirates* was on appeal from a summary judgment granted to the plaintiff Walt Disney Productions. The defendants were publishers of "counterculture" comic books, *Air Pirates* and *Hell Comics*. In two of the editions of *Air Pirates* comics, the defendants used some of Disney's most famous cartoon characters, including Mickey Mouse, Minnie Mouse, Donald Duck and Goofy. The cartoon characters were made a direct target of parody of the prototypical Disney characters' "image of innocent delightfulness" by "convey[ing] an allegorical message of significance" that was "centered around 'a rather bawdy depiction of the Disney characters as active members of a free thinking, promiscuous, drug ingesting counter-culture.'" *Id*. at 753 (citations omitted). The court pointed out that "substantial copies of the work of plaintiff." and the characters as copied by defendants bore "a marked similarity to those of plaintiff" and "[t]he names given to defendants' characters are the same names used in plaintiff's copyrighted work." *Id*. The defense of fair use was therefore rejected by the district court "because defendants had copied the substance of the Disney products." *Id*.

The Ninth Circuit affirmed the summary judgment for copyright infringement. While defendants argued that they could avoid liability for infringement by relying on a fair use defense, the court found that the fair use defense was not available, because defendants had copied the Disney characters in their entireties, thereby "[taking] more than as necessary to place firmly in the reader's mind the parodied work and those specific attributes that are to be satirized." *Id*. at 758. "Because the amount of defendant's copying exceeded permissible levels, summary judgment [for plaintiff] was proper." *Id*.

Here, as in *Air Pirates*, Defendant unlawfully took the entirety of a piece of copyrighted work. By sampling a portion of "Tropical Rock," Defendant has used the entirety of that portion of a copyrighted sound recording, as explained in *Bridgeport Music*. Thus, the defense of "fair use" is unavailable to him, and summary judgment should be granted in favor of Plaintiff.

V. DEFENDANT CANNOT DEFEAT THIS MOTION, BECAUSE HE CANNOT PRESENT SUFFICIENT EVIDENCE TO DEMONSTRATE A GENUINE ISSUE OF MATERIAL FACT ON EACH ELEMENT OF HIS DEFENSE

This Motion should be granted, because Plaintiff has met his burden pursuant to Rule 56 of the Federal Rules of Civil Procedure, and Defendant cannot

meet his burden of proof to defeat the Motion. More particularly, pursuant to Rule 56(c) of the Federal Rules of Civil Procedure, the motion must be granted if the moving party shows "that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c).

Moreover, as already noted, the United States Supreme Court has ruled that Rule 56(c) requires the entry of summary judgment "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." *Celotex Corp.,* 477 U.S. at 322, 106 S.Ct. at 2552; *see also Anderson v. Liberty Lobby,* 477 U.S. at 249-50, 106 S.Ct. at 2511.

The Supreme Court further explained:

> Rule 56 must be construed with due regard not only for the rights of persons asserting claims and defenses that are adequately based in fact to have those claims and defenses tried to a jury, but also for the rights of persons opposing such claims and defenses to demonstrate in the manner provided by the Rule, prior to trial, that the claims and defenses have no factual basis.

Celotex Corp., 477 U.S. at 327, 106 S. Ct. at 2555. "By its very terms, this standard provides that the mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact." *Anderson v. Liberty Lobby,* 477 U.S. at 247-48, 106 S. Ct. at 2510 (emphasis in original).

Thus, it is not enough for the nonmoving party simply to allege that material issues of fact exist, because, on a motion for summary judgment, such a party must come forward with evidentiary facts that demonstrate a triable issue of fact regarding each element of its claim. Here, Defendant can adduce no evidentiary facts that demonstrate a triable issue of fact regarding each element of the claim. He sampled Plaintiff's copyrighted work, and, by doing so, he infringed Plaintiff's copyright. There is no dispute, nor is there an applicable defense. Accordingly, summary judgment should be granted for Plaintiff.

VI. CONCLUSION

Summary judgment should be granted to Plaintiff. While Plaintiff acknowledges that, in the context of a motion for summary judgment, a plaintiff must prove essential elements of his claim by a preponderance of evidence (or, in other words, plaintiff must sustain the same burden he would have at trial), Plaintiff undoubtedly has done so by offering the following admissible

evidence: Plaintiff's copyright registration certificate; the copyrighted sound recording of "Tropical Rock"; the sound recording of "Caribbean Rock" containing the electronic sample of the "hook" from the "Tropical Rock" sound recording; and, the Declaration of George R. Bolt, a recording engineer and computer expert who confirms that the "hook" from "Tropical Rock" used by Defendant in his recording of "Caribbean Rock" is, in fact an electronic sample lifted directly from the sound recording of "Tropical Rock." Given the clear mandate of Sections 106 and 114 of the Copyright Act, (1) Plaintiff is entitled to summary judgment as a matter of law and (2) in any event, Defendant cannot by relevant evidence sustain the burden of proof on his defenses of fair use and *de minimis* use to raise any genuine issue of material fact. Therefore, for all the foregoing reasons, Plaintiff respectfully requests that judgment be entered in his favor.

Dated:_____

Respectfully submitted,

_____

By: _____
Attorneys for Plaintiff
Manfred Tunesmith

[ATTORNEY NAMES]
[LAW FIRM]

Attorneys for Plaintiff Manfred Tunesmith,
professionally known as Mick Ringo

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MANFRED TUNESMITH, professionally known as Mick Ringo,	)	Case No.
	)	
	)	PLAINTIFF'S STATEMENT OF
Plaintiffs,	)	UNCONTROVERTED FACTS
	)	AND CONCLUSIONS OF LAW
	)	IN SUPPORT OF MOTION FOR
v.	)	SUMMARY JUDGMENT
	)	(Fed. R. Civ. P. 56; Local Rule
ANTHONY CRATER, professionally known as Master A.C.,	)	_____)
	)	
	)	Date:
Defendant.	)	Time:
_____	)	Dept:

STATEMENT OF UNCONTROVERTED FACTS

Pursuant to Rule 56 of Federal Rules of Civil Procedure, Plaintiff Manfred Tunesmith submits this Statement of Uncontroverted Facts and Conclusions of Law in support of his Motion for Summary Judgment (the "Motion").

As used within this Statement: (a) "Bolt Decl." means the concurrently submitted Declaration of George R. Bolt, a recording engineer, computer programmer and expert witness; (b) "_____ Decl." means the concurrently submitted Declaration of [PLAINTIFF'S COUNSEL].

UNDISPUTED MATERIAL FACT	EVIDENTIARY BASIS
1. Plaintiff Manfred Tunesmith (professionally known as Mick Ringo) is an individual who resides in the State of California and is the composer of the musical work TROPICAL ROCK.	1. Bolt Decl. ¶ ¶ 2, 8-11; Interrog. Answers 11, 13, 17 & 18; Def.'s Dep. 11:8-13:7; 24:11-27:8; 61:15-70:18.[163]
2. Defendant Anthony Crater (professionally known as Master A.C.), is an individual who resides in the State of Oregon and is the composer of the musical work CARIBBEAN ROCK.	2.
3. Plaintiff created and authored the musical composition entitled TROPICAL ROCK.	3.
4. Plaintiff also authored and recorded a sound recording embodying his performance of TROPICAL ROCK.	4.
5. Plaintiff registered claims to the composition and the sound recording of TROPICAL ROCK in the United States Copyright Office, at which time an audio compact disk recording of TROPICAL ROCK was deposited with the United States Copyright Office.	5.
6. In 2003, TROPICAL ROCK was re-released as TROPICAL ROCK on Bongo Records.	6.
7. In or about 2005, Defendant Crater created, authored and recorded the musical composition entitled CARIBBEAN ROCK.	7.

163 The references to depositions (*e.g.*, 11:8-13:7) refer to page and line numbers. The references are also fictitious and included by way of example only.

UNDISPUTED MATERIAL FACT	EVIDENTIARY BASIS
8. Both the musical composition and sound recording of CARIBBEAN ROCK were duly registered in the Copyright Office of the United States, at which time an audio compact disk was deposited with the United States Copyright Office.	8.
9. The audio CD of TROPICAL ROCK deposited in the United States Copyright Office contains a musical figure that constitutes the "hook" of TROPICAL ROCK, the hook being that part of the composition which listeners most remember and which becomes closely associated by the public with the song, in this case TROPICAL ROCK.	9.
10. TROPICAL ROCK is one of the most popular and financially successful rock songs of the last 25 years having been awarded a platinum record (1,000,000 single records sold) and gold record (500,000 albums sold).	10.
11. Defendant "sampled" or "lifted" the "hook" from the original sound recording of TROPICAL ROCK and used it 51 times in the creation and writing of CARIBBEAN ROCK.	11.

CONCLUSIONS OF LAW

1. This Court has jurisdiction of the claim in the Complaint under 17 U.S.C. §§ 101, et seq., and 28 U.S.C. §§ 1331 & 1388.

2. The entry of summary judgment is required "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." *Celotex Corp. v. Catrett,* 477 U.S. 317, 322, 106 S. Ct. 2548, 2552, 91 L. Ed. 2d 265 (1986).

3. "[T]here is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. . . . If the evidence is merely colorable . . . or is not significantly probative, . . . , summary judgment may be granted." *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 249-50, 106 S. Ct. 2505, 2511, 91 L. Ed. 2d 202 (1986). Moreover, "the mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact." *Id*. at 247-48 (emphasis in the original).

4. To prevail on a claim for copyright infringement, a plaintiff must provide proof of two elements: "(1) ownership of a valid copyright; and (2) copying of constituent elements of the work that are original." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.,* 499 U.S. 340, 361, 111 S. Ct. 1282, 1296, 113 L. Ed. 2d 358 (1991).

5. A certificate of registration from the United States Register of Copyrights constitutes *prima facie* evidence of the valid ownership of a copyright. *See* 17 U.S.C. § 410(c).

6. Section 114 of the Copyright Act provides that the exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of Section 106 of the Copyright Act. *See* 17 U.S.C. §§ 106 & 114. These two sections of the Copyright Act, in substance, grant specifically delineated exclusive rights to the copyright proprietor (Section 106 (1), (2), (3) and (6)) while attaching limits to those exclusive rights with particular reference to "[t]he exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 . . . to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. *The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such other sounds imitate or simulate those in a copyrighted sound recording*." 17 U.S.C. § 114(b) (emphasis added).

7. The "sampling" or "lifting" of notes by a defendant from a copyrighted sound recording constitutes an infringement of copyright. *See* 17 U.S.C. §§ 106(1), (2), (3) & (6); 17 U.S.C. § 114(a); *see also Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005).

8. Defendant Crater infringed Plaintiff's copyright in and to "Tropical Rock" by "sampling" the "hook" in "Tropical Rock" and using it fifty-one (51) times in Defendant's work, "Caribbean Rock."

9. Plaintiff is entitled to a judgment of copyright infringement against Defendant Anthony Crater for the sampling of the "hook" from "Tropical Rock."

10. Plaintiff is entitled to an award of damages against Defendant according to proof.

11. As a matter of law, there are no genuine issues as to any material fact, as a result of which plaintiff is entitled to summary judgment.

12. Plaintiff is entitled to all attorneys' fees and costs he has incurred and expended in this action. *See* 17 U.S.C. § 505; *Fogerty v. Fantasy, Inc.,* 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994).

_____

United States District Judge

Respectfully submitted by:

_____

[LAW FIRM]

By:_____

Attorneys for Plaintiff

Manfred Tunesmith

E. Form: Defendant's Motion

[ATTORNEY NAMES]
[LAW FIRM]

Attorneys for Defendant Anthony Crater,
professionally known as Master A.C.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MANFRED TUNESMITH, professionally known as Mick Ringo,	CASE NO.
Plaintiff,	NOTICE OF MOTION AND MOTION OF DEFENDANT FOR SUMMARY JUDGMENT; MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT THEREOF
v.	
ANTHONY CRATER, professionally known as Master A.C.,	(Fed. R. Civ. P. 56)
Defendant.	DATE: TIME: CTRM:

TO PLAINTIFF AND TO HIS COUNSEL OF RECORD:

PLEASE TAKE NOTICE that on _____, at _____, or as soon thereafter as the matter can be heard, in the courtroom of United States District Judge _____, located at 312 North Spring Street, Los Angeles, California, Defendant Anthony Crater, professionally known as Master A.C., will move the Court for summary judgment in his favor pursuant to Rule 56 of the Federal Rules of Civil Procedure.

This Motion will be made on the following grounds: (1) The musical element in Plaintiff's composition, "Tropical Rock," which Plaintiff alleges has been infringed by Defendant's composition "Caribbean Rock" is not protectable under the copyright laws of the United States in that it is a commonplace progression and, as such, is a musical idea and/or commonplace building block of music; (2) the form/structure used in the relevant section of "Caribbean Rock"—introduction, verse, chorus and bridge—is a standard structure found in rock

music; and (3) as a matter of law, there is no substantial similarity of protectable expression as between the relevant sections of "Caribbean Rock" and the copyrighted version of "Tropical Rock." Each of the foregoing grounds requires dismissal of Plaintiff's claim for copyright infringement, as well as his claims under the Lanham Act and for declaratory relief, which necessarily and in fact are based on the claim of copyright infringement. Defendant also moves for an award of attorneys' fees and costs pursuant to Section 505 of the Copyright Act, 17 U.S.C. § 505, and the holding in *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994).

This Motion will be based on this Notice, the pleadings, records and files in this action, the attached Memorandum of Points and Authorities, and the Declarations of Carl Y. Copeland, a forensic musicologist, and _____, counsel for Defendant, together with the exhibits referenced in those declarations, which are filed concurrently herewith, and upon such oral argument as the Court may permit.

Dated: _____

Respectfully submitted,

_____

By: _____

_____

Attorneys for Defendant Anthony Crater

I. INTRODUCTION

A. General Overview

By his Complaint, Plaintiff Manfred Tunesmith, professionally known as Mick Ringo, seeks to enlist the aid of the judicial system in an attempt to hold the Defendant Anthony Crater liable for copyright infringement based on Defendant's use of (1) a harmonic chord progression (1, 4, 5, 1) and (2) a structure commonly found in the Western popular music generally available to all composers for use in their musical creations—just as individual letters, words and structures are free for all authors to use in their novels, screenplays, essays and other literary works. In addition, as documented by the examples of prior art analyzed by Carl Y. Copeland, a Ph.D. musicologist, in his Declaration filed concurrently herewith ("Copeland Decl."), the progression upon which Plaintiff apparently bases his complaint is a musical idea and/or musical *scène à faire*[164] so commonplace that it can be found in learned texts, a Russian folk song, various classical compositions, and pop and rock songs. (Copeland Decl. ¶¶ ___ & Charts _____ attached thereto (Exs. ___).) To use a literary analogy: If one author begins a sentence with "Once upon a time . . . ," it would be a peculiar world if another author who previously used that phrase could successfully prevail in an infringement action against the second author based upon his use of the same commonplace preliminary introduction to a sentence.

This observation becomes even more pointed in the case of music, which, as far as pitches are concerned, is limited to eight notes (comprised of six whole steps and two half steps) in each octave scale bearing a key signature, and only twelve notes if all half steps in the span of an octave are counted. (Copeland Decl. ¶ ___.) The unprotectable nature of what Plaintiff claims was copied is further supported by a consideration of the durational values of notes, which determine a composition's rhythm: there are whole notes, half-notes, quarter-notes, eighth-notes, sixteenth-notes and seldom used thirty-second notes. A composition's tempo, i.e., how fast or how slow it is played or how many notes per minute it contains, may of course vary, but the durational values of the notes within a composition necessarily are notated within a limited range. In those forms of music—especially pop, rock, and rap—where bass accompaniments setting forth the "beat" are limited in range of expression, such patterns would necessarily be repeated because the musical idea, i.e., the beat, and the expression of that idea are substantially the same. (Copeland Decl. ¶¶ ___.)

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164. *Scènes à faire* are scenes or sequences that necessarily follow from a common theme or premise. *See, e.g.*, *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983); *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982), *aff'g and incorporating by reference Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981).

In short, by his music infringement claim, the Plaintiff is attempting to protect that which is unprotectable: a commonplace musical progression whose pitches and structure are musical building blocks available to all composers. Stated another way, composers do not invent these musical fragments, motifs and progressions, they merely find them. This litigation should therefore be disposed of by summary judgment. Though Plaintiff has attempted to set forth additional claims for violations of the Lanham Act, 15 U.S.C. § 1125(a), in essence all such claims are based upon the alleged infringement of his composition, "Tropical Rock," by Defendant through the creation and distribution of the composition "Caribbean Rock."

The grounds that mandate summary judgment and dismissal are the following: (1) the musical fragment used in "Tropical Rock" that Plaintiff alleges has been infringed by Defendants' composition "Caribbean Rock" is not protectable under the copyright laws of the United States because it is a common building block of music; (2) the form/structure used in the relevant portions of "Caribbean Rock"—introduction, verse, chorus, and bridge—is a standard structure used in rock music; and (3) as a matter of law, there is no substantial similarity of *protectable expression* as between the relevant sections of "Tropical Rock" and "Caribbean Rock."

In applying controlling authorities, both statutory and decisional, summary judgment is not merely an appropriate remedy to dispose of Plaintiff's meritless claims, but it has also been specifically held to be the duty of the courts to grant summary judgment in monitoring litigation of the type involved in this action. *See Warner Bros., Inc. v. American Broad. Cos., Inc.,* 720 F.2d 231, 240, 245 (2d Cir. 1983) (explaining that "a court may determine non-infringement as a matter of law on a motion for summary judgment . . . because the similarity between two works concerns only '*non*-copyrightable elements of the plaintiff's work'" and discussing the "important responsibility" of the courts "to monitor the outer limits within which juries may determine reasonably disputed issues of fact") (emphasis in original). The lack of merit in Plaintiff's infringement claims is obvious when analyzing the issues at bar in light of the governing law: (1) the holding in *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc*., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), that creativity is an essential element to satisfy the originality requirement of the copyright laws; and (2) the standards mandated by the United States Supreme Court for the granting of summary judgments in *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986), and *Anderson v. Liberty Lobby, Inc*., 477 U.S. 242, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

An insightful observation as to the importance of Feist has been set forth by Professor Paul Goldstein of the Stanford Law School in the *Journal of the Copyright Society of the USA* in the following language:

> What is most striking about Justice O'Connor's opinion for herself and seven other members of the Court is its reliance on two bold and largely unprecedented

> premises. First—a point made no fewer than sixteen times in the opinion—is that creativity is part of copyright law's originality requirement. This came as a surprise to those of us who had thought that, outside the narrow field of photographs and art reproductions, originality meant only that the copyright claimant had not copied from another source. Second—a point made no fewer than thirteen times—is the Court's premise that copyright's originality standard has a constitutional dimension. Again, apart from some scattered dicta, this is pretty much new law.

Paul Goldstein, Copyright, 38 J. Copyright Soc'y 109, 118-19 (1991).

Feist and the other authorities cited throughout this brief provide that more than the mere arrangement or rearrangement of ideas, commonplace literary and musical devices and phrases, data, listings, and other elements in the public domain—whether telephone listings (as was the case in *Feist*) or common musical notations or harmonic progressions (as was the case in *Granite Music Corp. v. United Artists Corp*., 532 F.2d 718 (9th Cir. 1976))—is required to merit protection under the copyright laws of this country.
Here, the portions of "Tropical Rock" at issue are not protectable by copyright, because they are comprised of merely commonplace musical devices and common musical building blocks.

Moreover, pursuant to the standards for granting summary judgment as set forth in *Celotex Corp.* and *Anderson*, unless a plaintiff can sustain its burden of proof on an element upon which it has the burden of proof at trial, the summary judgment must be granted. Here, Plaintiff cannot meet that burden.

It is because of the reach and depth of these and other controlling authorities and the policy underlying the copyright laws of the United States that Plaintiff's claims must fail, and judgment must be granted for Defendant.

B. Plaintiff's Claims

Briefly stated, Plaintiff alleges in his Complaint that he is the composer of "Tropical Rock," an original musical work created by him in 2003. Plaintiff further alleges that he secured a copyright for "Tropical Rock" on or about December 17, 2003, and that the creation, publication, recording, and distribution of "Caribbean Rock" infringed that copyright. Complaint, ¶ 23. Though one wishes to be kind, such a claim by the Plaintiff approaches the same absurdity as if, in a literary sense, an author of a war novel had objected that another author of a war novel had also (1) included passages depicting the horrors of battle with descriptions of wounded and dying soldiers, the ubiquity of tanks and helicopters raining destruction and death on the enemy, etc.; and (2) used the form or structure of a novel to tell his story. The copyright laws were never designed to protect such public domain materials and should not be so used in this litigation.

Thus, summary judgment should be granted to Defendant in light of (1) the standards for the granting of summary judgment pursuant to the governing law; (2) the nonprotectability under the copyright laws of the musical ideas that Mr. Tunesmith seeks to protect; and (3) as a matter of law, the lack of substantial similarity of *protectable expression* between the works at issue.

II. STATEMENT OF FACTS

[HERE, DEFENDANT SHOULD HAVE A SHORT STATEMENT OF FACTS THAT TELLS A STORY AND THAT CONTAINS FACTS THAT ESTABLISH EACH OF HIS DEFENSES UPON WHICH HE RELIES FOR THIS MOTION, ALONG WITH CITATIONS TO THE DECLARATIONS, EXHIBITS, DEPOSITION TESTIMONY, ETC. THAT REFLECT THOSE FACTS.]

III. DEFENDANT IS ENTITLED TO JUDGMENT AS A MATTER OF LAW, AND PLAINTIFF CANNOT DEFEAT THIS MOTION, BECAUSE HE CANNOT PRESENT SUFFICIENT EVIDENCE TO DEMONSTRATE A GENUINE ISSUE OF MATERIAL FACT ON EACH ELEMENT OF HIS CLAIMS

A. The Statutory Mandate

Rule 56 of the Federal Rules of Civil Procedure mandates that a summary judgment motion be granted

> [i]f the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.

Fed. R. Civ. P. 56(c).

B. Judicial Construction and Clarification: *Celotex* and *Anderson*

The United States Supreme Court has ruled that Rule 56(c) requires the entry of summary judgment

> against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be "no genuine issue as to any material fact," since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial. The moving party is "entitled to a judgment as a matter of law" because the nonmoving party has failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof.

Celotex Corp. v. Catrett, 477 U.S. 317, 322-23, 106 S. Ct. 2548, 2552, 91 L. Ed. 2d 265 (1986); *see also Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 249-50, 106 S. Ct. 2505, 2511, 91 L. Ed. 2d 202 (1986) (holding that "there is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. . . . If the evidence is merely colorable . . . or is not significantly probative . . ., summary judgment may be granted.") (citations omitted).

The Supreme Court further stated:

> Rule 56 must be construed with due regard not only for the rights of persons asserting claims and defenses that are adequately based in fact to have those claims and defenses tried to a jury, but also for the rights of persons opposing such claims and defenses to demonstrate in the manner provided by the Rule, prior to trial, that the claims and defenses have no factual basis.

Celotex Corp., 477 U.S. at 327, 106 S. Ct. at 2555.

The Court also stresses:

> By its very terms, this standard provides that the mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact.

Anderson, 477 U.S. at 247-48, 106 S. Ct. at 2510 (emphasis in original).

Thus, it is not enough for a plaintiff simply to allege that material issues of fact exist, because, on a motion for summary judgment, such a plaintiff must come forward with evidentiary facts that demonstrate a genuine issue of material fact regarding each element of his claim. Here, Plaintiff cannot do so. Therefore, summary judgment for Defendant is warranted.

IV. SUMMARY JUDGMENT IS PROPER BECAUSE, BY THIS ACTION, PLAINTIFF ATTEMPTS TO PROTECT UNPROTECTABLE IDEAS AND, ADDITIONALLY, PLAINTIFF CANNOT SHOW PROBATIVE SIMILARITY OF THE MUSICAL IDEAS AT ISSUE

A. Policy Considerations

Every copyright infringement action requires the application of an important balancing process: copyright law must reward the plaintiff just enough to encourage authorship and creation without granting the plaintiff such a monopoly in a subject matter as to deter future writers, composers, and other creative artists. *See Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp*., 562 F.2d 1157, 1163 (9th Cir. 1977). Courts employ the *idea/expression dichotomy* to verbalize this balancing process whereby copyright protection is given only to the original expression of an idea, and never to the idea itself. *See Mazer v. Stein*, 347 U.S. 201, 217, 74 S. Ct. 460, 470, 98 L. Ed. 630 (1954); *Krofft*, 562 F.2d at 1163-70. As such, the *idea/expression dichotomy* is required by copyright policy and First Amendment considerations.

In the context of copyright protection for musical works, the Ninth Circuit has expressed this dichotomy as follows:

> We recognize that a statutory copyright does not give a monopoly over an idea or a musical phrase, but merely protects against the unlawful reproduction of an original work.

Granite Music Corp. v. United Artists Corp., 532 F.2d 718, 720 (9th Cir. 1976).

The task of distilling the unprotected idea from the protected expression ultimately involves policy considerations—"drawing the line" to preserve "the balance between competition and protection." *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).

> [T]he fewer the methods of expressing an idea, the more the allegedly infringing work must resemble the copyrighted work in order to establish substantial similarity.

Cooling Sys. and Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 491 (9th Cir. 1985) (referencing *Landsberg v. Scrabble Crossword Game Players, Inc*., 736 F.2d 485, 488-89 (9th Cir. 1984)).

B. Ownership and Protectability

The above principles underlie all discussions of copyright infringement. With these principles as background, to prove his claim for copyright infringement, Plaintiff must establish each of the following elements:

(a) Plaintiff owns the copyright in "Tropical Rock";
(b) Probative similarity exists between Defendant's and Plaintiff's works; and
(c) Defendant has copied substantial portions of constituent elements from Plaintiff's work that are original.

See Johnson v. Gordon, 409 F.3d 12, 17-18 (1st Cir. 2005); *see also Krofft*, 562 F.2d at 1162-69.

In *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L.Ed.2d 358 (1991), the Supreme Court stated that:

> [t]he *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author. . . . Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.

Id. at 345, 111 S. Ct. at 1287 (citations omitted). The Court further held that "[o]riginality is a constitutional requirement." *Id.* at 346, 111 S. Ct. at 1288.

Under the copyright laws, ownership consists of several aspects, including (a) standing (plaintiff's legal ownership of the exclusive right sued upon, *see* 3 Melville B. Nimmer & David Nimmer, *Nimmer On Copyright* § 12.02, at 12-55, *et seq.* (2005); 17 U.S.C. § 501(a)); (b) the originality of plaintiff's work (only those aspects of the work that originated with plaintiff are protected by copyright, *see* 17 U.S.C. § 102(a)); and (c) the scope of the copyrightable (and hence protectable) aspects of the work (e.g., facts, ideas, and *scènes à faire* are not protected, *see* 17 U.S.C. § 102(b)), *see Aliotti v. R. Dakin & Co.,* 831 F.2d 898, 901 (9th Cir. 1987). Based on the foregoing, to the extent that "Tropical Rock" is not original, it is not copyrightable. *See Feist,* 499 U.S. at 345, 111 S. Ct. at 1287; *see also, e.g., Hirsch v. Paramount Pictures, Inc.*, 17 F. Supp. 816, 817 (S.D. Cal. 1937). In *Hirsch*, an early music infringement case, the court stresses originality as a precondition to copyright protection:

> In determining whether there has been an infringement of the copyright of a work, certain fundamental principles have been evolved, which the trial of almost every suit for infringement always brings into play. [¶] Every such suit turns upon two fundamental problems—the existence of a copyright protecting

> an original work and the infringement of the right, through copying. [¶] Ultimately, the determination of these two problems turns on the issues of originality, access and similarity. [¶] . . .In determining the originality of a popular song, we are confronted with the fact that it is built upon a rather simple, accepted pattern. It has, as a rule, three parts in the chorus: The opening strain, which usually runs for eight bars and is repeated for another eight bars, a middle tune of eight bars, and a concluding eight bars, which repeat the first strain. . . . Similarity of tone succession, which is, to a certain degree, inevitable in all musical compositions, because of the limits of the chromatic scale, is more likely to appear within this narrow pattern.

Hirsch, 17 F. Supp. at 817 (citations omitted).

Notwithstanding claims of originality by a Plaintiff, certain materials are not granted a copyright monopoly for reasons of policy as noted above in Section IV.A. These policy reasons apply to music infringement litigation as they do to literary, audiovisual and non-musical works whose creators find themselves embroiled in litigation. As explained in *Granite Music*, "statutory copyright does not give a monopoly over . . . a musical phrase, but merely protects against the unlawful reproduction of an original work." *Granite Music,* 532 F.2d at 720.

Because it is only expression that is protected, copyright plaintiffs often seek a broad interpretation of the definition of "expression" and, consequently, the scope of their copyright protection. Such an interpretation, however, would defeat the purposes of the Copyright Act, not only by encumbering future composers, but also by ignoring the debt all composers owe to the past. Indeed, it has often been acknowledged that "there is only rarely anything new under the sun" and that all creators draw upon the ideas of their predecessors. *Berkic v. Crichton,* 761 F.2d 1289, 1294 (9th Cir. 1985). All authors may thus freely draw upon the ideas of their predecessors. *See, e.g., id*. Moreover, where ideas or facts are only capable of expression within a narrow range, such expression is not protected. *See Aliotti,* 831 F.2d at 901.

C. Under Applicable Copyright Principles Defendant's Summary Judgment Motion Should Be Granted

As demonstrated in the Copeland Declaration, the two works at issue here—"Tropical Rock" and "Caribbean Rock"—share at most a commonplace similarity of chord progressions and structure employed in innumerable musical works from classical to rock. (Copeland Decl. ¶ __.) However, a chord progression standing alone is irrelevant because such progressions are "musical ideas" not protected by copyright. All music in Western society is limited to twelve pitches, reduced to seven-note major or minor scales. (Copeland Decl. ¶ __.)

Just as in factual and dramatic works, where some expression is not entitled to copyright protection because only a limited manner of expression is available, *see Aliotti*, 831 F.2d at 901, similarity of chord progressions is inevitable and, as such, are *scènes à faire*, *see, e.g., Johnson v. Gordon,* 409 F.3d 12, 22 (1st Cir. 2005). In addition, a plaintiff must base his claim on more than a single element of musical composition in that copyright protection for music usually involves at least pitch, rhythm, and harmony. *See, e.g., Northern Music Corp. v. King Record Distrib. Co.*, 105 F. Supp. 393, 397 (S.D.N.Y. 1952) ("We examine now the rhythm, harmony and melody of both songs to determine whether similarity exists.").

For a copyright plaintiff to meet its burden, copying is generally shown by evidence of defendant's access to plaintiff's copyrighted work and substantial similarity between the plaintiff's and defendant's works. *See Krofft,* 562 F.2d at 1162. The requirement of substantial similarity, in turn, is met when a two-part test set forth by the Ninth Circuit in *Krofft* is satisfied: first, there must be a probative similarity as to the general ideas of plaintiff's and defendant's works; second, there must be substantial similarity as to the protectable expression of those ideas in both works. *See id.* at 1164. As noted above, because ideas are not protectable under copyright law, the existence of probative similarity of "general ideas" (under the first part of the *Krofft* test) is simply a preliminary requirement and cannot by itself constitute copyright infringement. *Both* parts of the *Krofft* test must be met in order to find substantial similarity between the works in question.

Here, Plaintiff cannot satisfy either the preliminary requirement (probative similarity) or the more specific requirement of substantial similarity of protectable expression as between "Tropical Rock" and "Caribbean Rock." Determination of the latter issue is a matter of law for this Court to decide. Once this Court determines this issue in favor of Defendant, there can be no copyright infringement, and Defendant's Motion must be granted.

V. THE MUSICAL FRAGMENT THAT PLAINTIFF ALLEGES HAS BEEN INFRINGED IS NOT PROTECTABLE UNDER THE COPYRIGHT LAWS

For Plaintiff to succeed on his claims, he must prove substantial similarity between "Tropical Rock" and "Caribbean Rock" as to the elements of protectable expression in the former. *See Granite Music*, 532 F.2d at 720 ("statutory copyright does not give a monopoly over an idea or a musical phrase"). Plaintiff cannot make such a showing, because the portions of "Tropical Rock" at issue are not protectable by copyright.

A. Probative Similarity of General Ideas (The Extrinsic Test)

Since ideas themselves are not protected by copyright, substantial similarity of "general ideas" (under *Krofft's* "extrinsic" test) is or has evolved to become simply a preliminary review of the objective aspects of the work. *See, e.g., Berkic*, 761 F.2d at 1293.

Analysis of the "general ideas" of works such as novels, films, and screenplays requires a comparison of the extrinsic or objective characteristics of the work, including its plot, dialogue, setting, sequence of events, and characters. *See, e.g., Litchfield v. Spielberg*, 736 F.2d 1352, 1356-57 (9th Cir. 1984). In Berkic, the Ninth Circuit, carrying forward its refinement in *Litchfield* of the extrinsic test, states:

> The test for "substantial similarity of ideas" compares, not the basic plot ideas for stories, but the actual concrete elements that make up the total sequence of events and the relationships between the major characters. The extrinsic test for similarity of ideas looks beyond the vague, abstracted idea of a general plot and instead "focuses on . . . the objective details of the works. . . . The extrinsic test requires a comparison of plot, theme, dialogue, mood, setting, pace, and sequence."

Berkic, 761 F.2d at 1293 (citations omitted).

Clearly, the extrinsic test as applied since *Krofft* focuses primarily on the "objective" aspects of a work, allowing a court to rule as a matter of law that the similarities either do not relate to copyrightable expression or are *de minimis*. *See id.; Worth v. Selchow & Righter Co*., 827 F.2d 569, 572-73 (9th Cir. 1987). Here, the brief fragmentary musical passages contained in "Tropical Rock" and "Caribbean Rock" that Plaintiff contends are infringed and infringing, respectively, merely constitute a musical idea because the pitches are commonly used in musical works (Copeland Decl. at ¶ __) and, in the works at issue, they are in fact used differently (Copeland Decl. at ¶ __). To the extent that such a sequence of notes has widely recurred or is likely to recur in musical works, it is nothing more than a "building block" or "motif" or "musical idea" that does not represent protectable expression. *See Granite Music*, 532 F.2d at 721.

B. Substantial Similarity of Protectable Expression (The Intrinsic Test)

In many of the federal circuits, including this one, substantial similarity of protectable expression is dependent upon an "intrinsic" test to determine the response of the ordinary reasonable listener to the works. *See Krofft*, 562 F.2d

at 1164. Under the intrinsic test, "[s]imilarity of expression exists only when 'the total concept and feel of the works' is substantially similar." *Aliotti*, 831 F.2d at 901 (citing *Litchfield v. Spielberg*, 736 F.2d at 1357; *Krofft*, 562 F.2d at 1164). It has also been made abundantly clear in those cases refining and modifying the *Krofft* intrinsic test that, even if there are similarities in the allegedly infringing work, but such similarities merely result from the use of unprotectable elements contained in the allegedly infringed work, there can be no infringement.

> The inquiry into similarity of expression is modified by a line of cases recognized by *Krofft* but never satisfactorily integrated into the two-part *Krofft* framework. . . . No substantial similarity of expression will be found when "the idea and its expression are . . . inseparable," given that "protecting the expression in such circumstances would confer a monopoly of the idea upon the copyright owner." . . . [¶] Because these cases involve elements of expression, they properly may be assimilated within the analytical framework of the intrinsic test. To the extent that it is necessary to determine whether similarities result from unprotectable expression, it is appropriate under *Krofft*'s intrinsic test to perform analytic dissection of *similarities*. Although even unprotectable material should be considered when determining if there is substantial similarity of expression, . . . *no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas.*

Aliotti, 831 F.2d at 901 (emphasis both in original and added) (citations omitted). *Accord Olson v. National Broad. Co., Inc.*, 855 F.2d 1446 (9th Cir. 1988).

Materiality of the taking is also implicit in determining "substantial similarity." As Judge Nelson observed in *Worth v. Selchow & Righter Co.*:

> Worth's calculations demonstrate the number of times the authors of the game's questions and answers allegedly used his books as a factual source. However, to the extent that Worth intends to indicate the quantitative relation of similar material in the works, the relevant inquiry is whether a substantial portion of the protectible material in the *plaintiff's* work was appropriated–not whether a substantial portion of *defendant's* work was derived from plaintiff's work. . . . In any event, assuming that particular material is copyrightable, a determination of the qualitative importance of the material to the plaintiff's work is more significant than a quantitative calculation of the portion allegedly appropriated by the defendant.

Worth, 827 F.2d at 570 n.1 (emphasis in original) (citations omitted).

C. The Declaration of Defendant's Expert Establishes That The Harmonic Progression Plaintiff Claims Is Protected Expression Is, In Fact, Unprotectable Under The Copyright Laws

1. Expert Testimony is Admissible on the Issues Raised in Both the Extrinsic and Intrinsic Tests

The admissibility and application of expert opinion to both the extrinsic and intrinsic tests is now clearly recognized and permitted by the federal appellate courts. The controlling opinions do not limit, but rather have extended the admissibility of such evidence to summary judgment motions. For example in *Aliotti v. R. Dakin & Co.,* 831 F.2d 898 (9th Cir. 1987), the defendant, Dakin, began manufacturing its own designs of stuffed animals with the same six dinosaur species as Aliotti's stuffed animal designs. In the face of extensive and in-depth access by Dakin to the Aliotti stuffed dinosaurs, the court affirmed summary judgment for Dakin. In its analysis, this panel repeated the test articulated in *Litchfield*, but held that the tests for similarity of expression "*is* modified by a line of cases . . . [that had not been] satisfactorily integrated into the two-part *Krofft* framework," *id*. at 901 (emphasis added), to wit, that "it is appropriate to perform analytic dissection of *similarities*" based on the authorities' holding that where idea and expression cannot be separated, there can be no infringement, *id*. (emphasis in original).

In *Olson v. National Broad. Co., Inc.*, 855 F.2d 1446 (9th Cir. 1988), the author of a treatment and screenplay entitled *Cargo* filed an action for copyright infringement against National Broadcasting Company, Inc. ("NBC") and others. Plaintiff, in his treatment and screenplay, chronicled the exploits in an action/adventure genre story of three G.I.s in Viet Nam who became scam artists while in the service. Although the jury found that the creator of the allegedly infringing work, Steven Cannell, had not copied from plaintiff's work, they also inconsistently found that NBC's and Cannell's television show *The A-Team* was substantially similar to *Cargo*, and that *NBC* had copied protected expression from plaintiff's work. The district court granted a judgment *n.o.v*., and in its memorandum decision, "found that Olson had failed to prove that the defendants who created the allegedly infringing work had access to [plaintiff Olson's] work." *Id*. at 1447. The district court also found that *The A-Team* "was not substantially similar to the 'Cargo' works under either the extrinsic test or the intrinsic test . . . [and] . . . that no reasonable person could conclude that NBC had copied the general ideas or protectable expression of 'Cargo.'" Id. The appellate court observed that "there is little similarity between 'The A-Team' and the 'Cargo' works in terms of overall plot, sequence, dialogue or setting." *Id*. at 1450. The similarities found by the Ninth Circuit were theme, mood, and pace, emphasizing action, the lack of identifiable themes;

however, the court went on to state that, even though both had similar moods and were fast-paced, the similarities arose because both fell within the genre of action/adventure series in television and motion pictures. These similarities were "'from familiar scenes and themes [which] are among the very staples of modern American literature and film' . . . [and] . . . 'stock' themes commonly linked to a particular genre.'" Id. at 1451 (citations omitted). The court concluded by discussing the use of analytic dissection in connection with the intrinsic test, in reliance on a combination of *Litchfield, Krofft*, and *Aliotti*: "Although . . . considerable deference is due to a jury's finding of substantial similarity under the intrinsic test, . . . 'no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas' . . . [b]ecause those similarities that do exist arose from unprotectable scenes a faire, there exists no substantial similarity of protectable expression under the *intrinsic test*." *Id.* at 1453 (emphasis added) (citations omitted).

2. Expert Testimony is Especially Applicable in Music Infringement Litigation Because the Language of Music is Complex and the Public is Unfamiliar with that Language

The opinion in *Whelan Assoc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222 (3d Cir. 1986), although concerned, not with copyright protection of the artist's expression, but rather with copyright protection of computer software, is instructive. It offers a compelling analogy for the proposition that a one—not two—prong test be used in addressing the issues of admissibility of expert testimony to aid the trier of fact in determining whether protected expression or unprotectable ideas were copied by the defendant. The court in *Jaslow* considered the issue as to whether a computer program for dental laboratory record keeping was necessary to the idea of organizing a dental laboratory to operate efficiently. The court held that the structure of a computer program is protected expression—not merely the bare idea of a program—and can therefore be protected by copyright. In reaching this conclusion, the court considered the testimony of two expert witnesses, one testifying on behalf of each party. The court rejected the two-prong test observing that "[t]he ordinary observer test, which was developed in cases involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value in cases involving computer programs on account of the programs' complexity *and unfamiliarity to most members of the public*." *Id.* at 1232 (emphasis added). Although music and computers would appear to be at opposite ends of the creative spectrum, there can be little, if any, question that, to the lay person (including the judge and the jury), the issues of protected expression vis-a-vis

unprotectable building blocks of music are complex and unfamiliar to most members of the public.

Here, when the unprotected idea is filtered from the protected expression, it is clear that the musical fragment that Plaintiff alleges has been infringed is not protectable under the copyright laws of the United States, because that musical fragment represents nothing more than a commonplace event in music. (*See* Copeland Decl. at ¶ __); *Granite Music*, 532 F.2d at 720; *see also Brown Bag Software v. Symantec Corp*., 960 F.2d 1465, 1473 (9th Cir. 1992) (noting with approval the district court's finding that "'[p]laintiffs may not claim copyright protection of an . . . expression that is, if not standard, then commonplace in the computer software industry'") (citation omitted). Thus, even assuming *arguendo* that the musical fragment from "Tropical Rock" is substantially similar to the purportedly infringing musical fragment in "Caribbean Rock" (which it is not), there can be no copyright infringement because the musical fragment is unprotectable.

Dr. Copeland clearly delineates for this Court various antecedent musical compositions that predate both "Tropical Rock" and "Caribbean Rock" and that contain similar musical fragments. (Copeland Decl. ¶ __ & Charts _____ (Exs. A, B & C).) Since the fragment that Plaintiff seeks to protect clearly is one commonly found in other musical works, it is unprotectable under the copyright laws. In reviewing those prior art examples, it is worthy of note that (1) the fragment in question is likely to occur in pedagogical texts, folk songs, and pop compositions; and (2) more importantly, in the pop and rock field the beat and/or fragments found in all versions of "Tropical Rock" occur over and over in similar contexts, patterns and rhythms while using the same pitches (i.e., the pop compositions "Complications," "Shake, Shake, Shake," and "It's More Fun To Compute"). (Copeland Decl. ¶¶ ____ & Charts _____ (Exs. D & E).)

In *Granite Music*, the Ninth Circuit held that the district court's admission into evidence of prior works containing a certain four-note sequence was proper. The court further stated that "[t]he copyrightability of [plaintiff's song] 'Bubbles' is not the four-note sequence, but the fitting together of this sequence with other melodious phrases into a unique composition." *Granite Music*, 532 F.2d at 721. Likewise, here, the copyrightability of "Tropical Rock" is not the harmonic chord progression at issue, but the fitting together of that chord progression with other musical phrases. Yet, it is only that chord progression that Plaintiff claims was copied, and that chord progression, as in *Granite Music,* is contained in numerous prior works such that we must conclude that it is a non-unique and unprotectable element of Plaintiff' song.

VI. LACK OF SUBSTANTIAL SIMILARITY OF PROTECTABLE EXPRESSION MAY BE DECIDED ON SUMMARY JUDGMENT

Courts have increasingly disposed of groundless copyright infringement claims by summary judgment where, as a matter of law, there is no substantial similarity of protectable expression. *See, e.g., Litchfield v. Spielberg*, 736 F.2d 1352; *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982), aff'g and incorp'g by reference 526 F. Supp. 774 (C.D. Cal. 1981); *Hoehling v. Universal City Studios, Inc.,* 618 F.2d 972 (2d Cir. 1980); *Giangrasso v. CBS, Inc.,* 534 F. Supp. 472 (E.D.N.Y. 1982); Warner Bros., Inc., 720 F.2d at 240 (holding that courts may determine non-infringement as a matter of law by summary judgment, either (1) because the similarity between the works concerns only non-copyrightable elements of the plaintiff's work; or (2) because no reasonable jury, properly instructed, could find the two works are substantially similar in protectable expressions).

> [I]t was entirely proper for [the district court] to hold that [the copyright owner] is not entitled to go to trial on the issue of infringement. For where both the plaintiff's and defendant's works are before the court, "the court may compare the two works and render a judgment for the defendant on the ground that as a matter of law a trier of fact would not be permitted to find substantial similarity."

Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 918 (2d Cir. 1980) (citation omitted).

Indeed, a defendant is entitled to summary judgment even if he or she had access to the plaintiff's copyrighted work. *Krofft*, 562 F.2d at 1172 (no amount of proof of access will suffice to show copying if there are no similarities); *Jason v. Fonda,* 526 F. Supp. at 777 (summary judgment granted "[e]ven assuming defendants had access to plaintiffs' work"), *aff'd,* 698 F.2d 966 (9th Cir. 1982); *Gethers v. Blatty*, 283 F. Supp. 303, 307 (C.D. Cal. 1968) (summary judgment granted for lack of substantial similarity even though defendant's work was begun as an adaptation of plaintiff's). Furthermore, this Court may grant Defendants' Motion solely on the basis of its comparison of the two works in question. It is a well-established principle of copyright law that "only substantial similarity will support a determination of infringement." *Durham Indus., Inc. v. Tomy Corp.,* 630 F.2d at 913. Thus, a "general impression of similarity is not sufficient to make out a case of infringement." *Id.* at 912.

Courts in copyright infringement actions have stated the test for substantial similarity between two musical compositions as follows:

> "Infringement . . . must be founded upon more than the adoption of a few measures here and there. The theme and general melody or composition must be

> substantially lifted. . . . There must be in the last analysis such a substantial appropriation that the general public will detect the same air in the new arrangement. . . . A mere similarity is not the sole criterion of whether there is infringement."

Gingg v. Twentieth Century-Fox Film Corp., 56 F. Supp. 701, 709-10 (S.D. Cal. 1944) (quoting *Arnstein v. Broad. Music, Inc.,* 46 F. Supp. 379, 381 (S.D.N.Y. 1942), *aff'd,* 137 F.2d 410 (2d Cir. 1943) (citations omitted)). Another court expressed its finding of a lack of substantial similarity as follows:

> [W]hile there are similarities between the two compositions, there are a great many differences. I have heard the compositions played, and to my ear there is a similarity, but not such a similarity as would impress one. In other words, I would not take the one for the other.

Allen v. Walt Disney Prods., Ltd., 41 F. Supp. 134, 140 (S.D.N.Y. 1941).

In discussing the music copyright claim before it, still another court stated that it is not enough that there is some sort of similarity in a phrase or in the progression of a few bars, specifically stating that

> the claimed similarity appears to be lacking to the layman's ear. The slight resemblance in the progression of a few bars in both compositions is something which occurs frequently but which is not enough to make out a case of piracy.

Davilla v. Harms, Inc., 36 F. Supp. 843, 844 (S.D.N.Y. 1940). *See also Arnstein v. Broad. Music, Inc.,* 46 F. Supp. 379, 381 (S.D.N.Y. 1942) (no infringement in "adoption of a few measures here and there"), aff'd, 137 F.2d 410 (2d Cir. 1943); *Gingg v. Twentieth Century-Fox Film Corp.,* 56 F. Supp. at 709 (no infringement because no recognizable resemblance except in opening phrase of each chorus).

Other courts have recognized that, within the narrow dictates of popular music, there are limitations in the number of pleasing combinations of notes within the chromatic scale. *See Darrell v. Joe Morris Music Co.,* 113 F.2d 80, 80 (2d Cir. 1940) (per curiam) ("while there are an enormous number of possible permutations of the musical notes of the scale, only a few are pleasing; and much fewer still suit the infantile demands of the popular ear"); *Arnstein v. Edward B. Marks Music Corp.,* 82 F.2d 275, 277 (2d Cir. 1936) ("True, it is the themes which catch the popular fancy, but their invention is not where musical genius lies, as is apparent in the work of all the great masters. Success in such music as this is by no means a test of rarity or merit"); *Carew v. R.K.O. Radio Pictures, Inc.,* 43 F. Supp. 199, 202 (S.D. Cal. 1942). Thus, "[s]imilarity of tone succession" is "inevitable in all music compositions." *Hirsch,*17 F. Supp. at 817. Likewise, "simple, trite themes . . . are likely to recur spontaneously,"

so that "[r]ecurrence is not therefore an inevitable badge of plagiarism." *Darrell v. Joe Morris Music Co.,* 113 F.2d at 80.

Thus, for the Plaintiff in this case to establish substantial similarity between any version of "Tropical Rock" and "Caribbean Rock," he must show that the average listener would hear substantially the same musical figure in the Defendant's work as in his own, and that such similarity between the works goes far beyond limited phrases which are commonplace in music or generally similar tone progressions, both of which are necessarily unprotectable. Plaintiff cannot demonstrate that such similarity exists in the present case. In listening to the two works in this action, the Court will be able to determine, as a matter of law, that no reasonable jury could find substantial similarity of protectable expressions between them for the following principal reasons:

(1) The chord progression that plaintiff seeks to protect is a commonplace musical idea that is not entitled to protection under the copyright laws of the United States, even if one were to assume for the sake of argument that the fragments in "Tropical Rock" and "Caribbean Rock" are similar. (Copeland Decl. ¶ __.);
(2) The "Caribbean Rock" accompaniment and the "Tropical Rock" fragment would both logically occur independently of one another because of the nature and contents of the compositions at issue, both of which rely on limited musical ideas (especially with respect to the "beat" accompaniment), and the limited range of expression available in pop and rock music rhythms. (See Copeland Decl. ¶ __); *Hirsch*, 17 F. Supp. at 817; *Tisi v. Patrick*, 97 F. Supp. 2d at 544; *Johnson v. Gordon,* 409 F.2d at 23 (where the court held that the harmonic progression at issue "is a stereotypical building block of musical composition . . . lack[ing] originality. Accordingly, it is unprotectable.");
(3) The compositions at issue and the expressions of the musical ideas contained in "Caribbean Rock" and "Tropical Rock" are different, in the sequence of pitches, rhythm, style, and context. (Copeland Decl. ¶ ___.); and
(4) Defendants' musical composition "Caribbean Rock" is not substantially similar to any protectable expression in "Tropical Rock." Any "similarities" that may exist are of no legal significance because they merely represent commonplace musical building blocks. (See Copeland Decl. ¶ __.)

Thus, this Court's application of the average-listener test will demonstrate that Defendant's work does not bear any substantial similarity in protectable expression to Plaintiff's composition. *See, e.g., Davis v. United Artists, Inc.,* 547 F. Supp. 722, 725 (S.D.N.Y. 1982) ("[i]ndeed, if the Court had read plaintiff's book and seen defendants' motion picture, unaware of this infringement action, it never would have dawned upon it, as an average observer, that there was the slightest connection between the two works other than [as may] . . .

relate to non-copyrightable material"); *Arnstein v. Twentieth Century-Fox Film Corp.,* 52 F. Supp. 114, 115 (S.D.N.Y. 1943) ("the two compositions are so dissimilar that one cannot be held to be a copy of the other. They do not sound alike when played as written. The melodies, the harmonies, the accent and the rhythm of the two compositions are entirely different. They were written for entirely different purposes.").

Because the two works are not substantially similar as a matter of law, there can be no copyright infringement, and Defendant's Motion for Summary Judgment should be granted.

VII. IN THE ABSENCE OF SUBSTANTIAL SIMILARITY OF PROTECTABLE EXPRESSION AS BETWEEN ALLEGEDLY INFRINGING AND INFRINGED WORKS, A RELATED CLAIM UNDER SECTION 43(a) OF THE LANHAM ACT MUST BE DISMISSED

In *Warner Bros., Inc. v. American Broad. Cos.,* the Second Circuit, in affirming a summary judgment dismissing the plaintiff's copyright claims, stated:

> Turning to the merits of the unfair competition claims, we have noted that "the absence of substantial similarity leaves little basis for asserting a likelihood of confusion or palming off" for purposes of a claim under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1976).

Warner Bros., 720 F.2d at 246.

Here, Manfred Tunesmith's Lanham Act claim must likewise fail based on the complete absence of any substantial similarity between "Caribbean Rock" and "Tropical Rock." No one has been or can be confused as to the source of the respective works.

VIII. CONCLUSION

As the Ninth Circuit previously has observed in affirming a summary judgment granted by a court within this district against a plaintiff in another meritless copyright action:

> As is too often the case, [plaintiff's] action was premised "partly upon a wholly erroneous understanding of the extent of copyright protection; and partly upon

> that obsessive conviction, so common among authors and composers, that all similarities between their works and any others which appear later must inevitably be ascribed to plagiarism."

Litchfield v. Spielberg, 736 F.2d at 1358 (quoting *Dellar v. Samuel Goldwyn, Inc.,* 150 F.2d 612 (2d Cir. 1945)).

In the instant case, any alleged similarities, no matter how significant or trivial, are the result of independent creation with both composers drawing upon common antecedent sources from the language of music. Therefore, for all the foregoing reasons, summary judgment should be granted in favor of the Defendant, and the Complaint should be dismissed.

Dated: _____

Respectfully submitted,

_____

By: _____

Attorneys for Defendant Anthony Crater

[ATTORNEY NAMES]
[LAW FIRM]

Attorneys for Defendants Anthony Crater,
professionally known as Master A.C.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MANFRED TUNESMITH, professionally known as Mick Ringo,	Case No.
Plaintiff,	STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT (Fed. R. Civ. P. 56; Local Rule _____)
v.	
ANTHONY CRATER, professionally known as Master A.C.,	
Defendant.	Date: Time: Dept:

STATEMENT OF UNCONTROVERTED FACTS

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Defendant submits this Statement of Uncontroverted Facts and Conclusions of Law in support of its Motion for Summary Judgment (the "Motion").

As used within this Separate Statement: (a) "Copeland Decl." means the concurrently submitted Declaration of Carl Y. Copeland; (b) "_____ Decl." means the concurrently submitted Declaration of [DEFENDANT'S COUNSEL].

UNDISPUTED MATERIAL FACT	EVIDENTIARY BASIS
1. Plaintiff Manfred Tunesmith (professionally known as Mick Ringo) is an individual who resides in the State of California and is the composer of the musicalwork TROPICAL ROCK.	1. Copeland Decl. ¶ 6 and 7 Pl.'s Interrog Answers, 10, 13 and 20, Pl.'s Depo. 10:17-13:4; 23:7-24:12; 68:2-71:8.[165]
2. Defendant Anthony Crater (professionally known as Master A.C.), is an individual who resides in the State of Oregon and is the composer of the musical work CARIBBEAN ROCK.	2.
3. Plaintiff contends that an harmonic progression of four notes (pitches) (1, 4, 5, 1) in the musical scale in CARIBBEAN ROCK infringes the four-note harmonic progression (1, 4, 5, 1) found in Plaintiff's composition TROPICAL ROCK.	3.
4. Plaintiff also authored a sound recording embodying his performance of TROPICAL ROCK.	4.
5. Plaintiff contends that the structure of CARIBBEAN ROCK is substantially similar to the structure of TROPICAL ROCK.	5.
6. Plaintiff registered claims to the composition and the sound recording of TROPICAL ROCK in the United States Copyright Office, at which time an audio compact disk ("CD") recording of TROPICAL ROCK was deposited with the United States Copyright Office.	6.

165 The references to depositions (*e.g.*, 10:17-13:4) refer to page and line numbers. As previously disclosed these references are fictitious and included only by way of example.

UNDISPUTED MATERIAL FACT	EVIDENTIARY BASIS
7. In 2003, TROPICAL ROCK was re-released as TROPICAL ROCK on Bongo Records.	7.
8. In or about 2005, Defendant Crater created, authored and recorded the musical composition entitled CARIBBEAN ROCK.	8.
9. Both the musical composition and sound recording of CARIBBEAN ROCK were duly registered in the Copyright Office of the United States, at which time an audio CD was deposited with the United States Copyright Office.	9.
10. The audio CD of TROPICAL ROCK deposited in the United States Copyright Office contains a musical accompaniment figure that Plaintiff alleges has been infringed, which consists of three or four pitches (1, 4, 5, 1). The audio CD of TROPICAL ROCK contains the following structure—introduction, verse, chorus and bridge sections—which plaintiff claims has been infringed by CARIBBEAN ROCK.	10.
11. The rhythms used in TROPICAL ROCK and CARIBBEAN ROCK are substantially different.	11.
12. The four-note progression (1, 4, 5, 1) in CARIBBEAN ROCK is placed in a different context within that composition than is the placement of the four-note progression in TROPICAL ROCK.	12.
13. The harmonic progress in and structure in the copyrighted version of TROPICAL ROCK, which Plaintiff alleges has been infringed by the creation, recording and distribution of CARIBBEAN ROCK, are commonplace building blocks of music and, as such, are for use by all composers.	13.
14. Defendant did not use, copy or embody any portion or elements of TROPICAL ROCK in the creation and writing of CARIBBEAN ROCK.	14.

UNDISPUTED MATERIAL FACT	EVIDENTIARY BASIS
15. CARIBBEAN ROCK is an independent creation of defendant Anthony Crater, professional known as Master A.C.	15.
16. There is no substantial similarity of protectable expression as between the relevant portions of TROPICAL ROCK and CARIBBEAN ROCK.	16.

CONCLUSIONS OF LAW

1. This Court has jurisdiction of the counts in the First Amended Complaint under 17 U.S.C. §§ 101 et seq., 15 U.S.C. § 1125(a), 28 U.S.C. §§ 1331 and 1388, and 15 U.S.C. § 1121.

2. The entry of summary judgment is required "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." *Celotex Corp. v. Catrett,* 477 U.S. 317, 322, 106 S. Ct. 2548, 2552, 91 L. Ed. 2d 265 (1986).

3. "[T]here is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. . . . If the evidence is merely colorable . . . or is not significantly probative . . . , summary judgment may be granted." *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 249-50, 106 S. Ct. 2505, 2511, 91 L. Ed. 2d 202 (1986). Moreover, "the mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact." *Id*. at 247-48, 106 S. Ct. at 2510 (emphasis in original).

4. In the Circuit, it is recognized "that a statutory copyright does not give a monopoly over an idea or a musical phrase, but merely protects against the unlawful reproduction of an original work." *Granite Music Corp. v. United Artists Corp.,* 532 F.2d 718, 720 (9th Cir. 1976).

5. "[T]he fewer the methods of expressing an idea, the more the allegedly infringing work must resemble the copyrighted work in order to establish substantial similarity." *Cooling Sys. and Flexibles, Inc. v. Stuart Radiator, Inc.,* 777 F.2d 485, 491 (9th Cir. 1985).

6. As the United States Supreme Court has held:

> The *sine qua non* of copyright is originality. To qualify for copyright protection a work must be original to the author. . . . Original, as the term is used in

> copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.

Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 345, 111 S. Ct. 1282, 1287, 113 L. Ed. 2d 358 (1991) (citations omitted). "Originality is a constitutional requirement." *Id*. at 346, 111 S. Ct. at 1288.

7. "Similarity of tone succession . . . is . . . inevitable in all musical compositions." *Hirsch v. Paramount Pictures, Inc.,* 17 F. Supp. 816, 817 (S.D. Cal. 1937). Thus, pitch similarity alone cannot establish copyright infringement. Copyright protection for music usually involves at least pitch, rhythm, and harmony. *See, e.g., Northern Music Corp. v. King Record Distrib. Co.,* 105 F. Supp. 393, 397 (S.D.N.Y. 1952). More specifically, as noted by the court in *Granite Music*, the copyrightability of a song is not contained in any four-note sequence, but in the fitting together of that sequence "with other melodious phrases into a unique composition." *Granite Music,* 532 F.2d at 721. This is because "statutory copyright does not give a monopoly over an idea or a musical phrase." Id. at 720. As stated by Professor Nimmer:

> Even in a musical composition, ordinarily, similarity must be found in more than a brief and commonplace musical sequence, or merely in motif.

Melville B. Nimmer & David Nimmer, 4 *Nimmer On Copyright* § 13.03[A][2], at 13-57 (2008).

8. In this Circuit, substantial similarity of protectable expression is dependent upon an "intrinsic" test that tries to determine the response of the ordinary reasonable person to the works. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.,* 562 F.2d 1157, 1164 (9th Cir. 1977).

9. "To the extent that it is necessary to determine whether similarities result from unprotectable expression, it is appropriate under *Krofft's* intrinsic test to perform analytic dissection of *similarities*. Although even unprotectable material should be considered when determining if there is substantial similarity of expression, . . . no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas." *Aliotti v. R. Dakin & Co.,* 831 F.2d 898, 901 (9th Cir. 1987) (emphasis in original) (citation omitted). *Accord Olson v. National Broad. Co., Inc.,* 855 F.2d 1146 (9th Cir. 1988).

10. Courts have increasingly disposed of copyright infringement claims by summary judgment where, as a matter of law, there is no substantial similarity of protectable expression. *See, e.g., Litchfield v. Spielberg*, 736 F.2d 1352; *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982), *aff'g and incorp'g by reference* 526 F. Supp. 774 (C.D. Cal. 1981); *Hoehling v. Universal City Studios, Inc.,* 618 F.2d 972 (2d Cir. 1980); *Giangrasso v. CBS, Inc.,* 534 F. Supp. 472 (E.D.N.Y. 1982); *Warner Bros., Inc.,* 720 F.2d at 240 (holding that courts may determine non-infringement as a matter of law by summary judgment, either (1) because the similarity between the works concerns only non-copyrightable elements of

the plaintiff's work; or (2) because no reasonable jury, properly instructed, could find the two works are substantially similar in protectable expressions).

11. "'Infringement . . . must be founded upon more than the adoption of a few measures here and there. The theme and general melody or composition must be substantially lifted. . . . There must be in the last analysis such a substantial appropriation that the general public will detect the same air in the new arrangement.'" *Gingg v. Twentieth Century-Fox Film Corp.,* 56 F. Supp. 701, 709-10 (S.D. Cal. 1944) (quoting *Arnstein v. Broadcast Music, Inc.,* 46 F. Supp. 379, 381 (S.D.NY. 1942) (citations omitted)).

12. Here, in applying the intrinsic or average listener test, it is clear that Defendant's work does not bear any substantial similarity in protectable expression to plaintiff's composition. *See, e.g., Arnstein v. Twentieth Century-Fox Film Corp.,* 52 F. Supp. 114, 115 (S.D.N.Y. 1943) ("the two compositions are so dissimilar that one cannot be held to be a copy of the other. They do not sound alike when played as written. The melodies, the harmonies, the accent and the rhythm of the two compositions are entirely different.").

13. There is no substantial similarity of protectable expression as between TROPICAL ROCK, the composition alleged to have been infringed, and CARIBBEAN ROCK, the alleged infringing composition.

14. Defendant has not infringed Plaintiff's copyright in and to TROPICAL ROCK by reason of the creation, recording, manufacturing, and distribution of CARIBBEAN ROCK.

15. By reason of the lack of substantial similarity of protectable expression as between TROPICAL ROCK and CARIBBEAN ROCK, there is no likelihood of confusion or palming off to support plaintiffs' claims under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). *See Durham Indus., Inc. v. Tomy Corp.,* 630 F.2d 905, 918 (2d Cir. 1980).

16. By reason of the lack of substantial similarity of protectable expression as between TROPICAL ROCK and CARIBBEAN ROCK, plaintiffs are not entitled to relief under the Lanham Act, 15 U.S.C. § 1125(a), as alleged in the Complaint. *See Durham Indus.,* 630 F.2d at 918.

17. As a matter of law, there are no genuine issues as to any material fact, as a result of which Defendant is entitled to summary judgment and the dismissal of Plaintiff's Complaint.

18. Defendant is entitled to an award of attorneys' fees and costs that he has incurred and expended in defending this action. *See*17 U.S.C. § 505; *Fogerty v. Fantasy, Inc.,* 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994).

_____

United States District Judge

Respectfully submitted by

_____

[LAW FIRM]

By:_____

Attorneys for Defendant Anthony Crater

APPENDIX
10-A

Attached are the "slip opinion" and official published opinion in *Baxter v. MCA, Inc*., discussed in Section VII of this Chapter. The "slip opinion" contains references to *Arnstein v. Porter* and other reported authorities in which references are made to the *Arnstein* holding that summary judgment is a disfavored remedy. In defendants' Petition For Rehearing (*en banc*), after counsel pointed out that that holding in *Arnstein* was no longer viable, the court struck all references to Arnstein, its holding and rationale, but retained the holdings and conclusions supported by the rationale set forth in the deleted language. Those portions stricken are indicated by brackets in bold face "**[ ]**" (paragraphs 5 and 7).

SLIP OPINION

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

LESLIE T. BAXTER, *Plaintiff-Appellant*, v. MCA, INC., a Delaware corporation; UNIVERSAL CITY STUDIOS, INC., a Delaware corporation, MUSIC CORPORATION OF AMERICA, a California corporation; MCA Records, Inc., a California corporation; MERCHANDISING CORPORATION OF AMERICA, a California corporation; and JOHN T. WILLIAMS, *Defendants-Appellees*.	No. 84-5522 D.C. No. CV 8 3-7081 HLH OPINION

Argued and Submitted October 9, 1985—San Francisco, California

Filed March 5, 1987

Before: Thomas Tang, Robert Boochever and Alex Kozinski*, Circuit Judges.

Opinion by Judge Tang

OPINION

TANG, Circuit Judge

In this copyright infringement action, plaintiff-appellant Leslie T. Baxter appeals the district court's grant of summary judgment to John Williams and the other defendants-appellees. The district court granted defendants' motion based upon its determination that no substantial similarity of expression existed as between Baxter's copyrighted song Joy and the theme from the motion picture "E.T.: The Extra-Terrestrial" [hereinafter cited as Theme from E.T.]. We reverse the grant of summary judgment and remand for trial.

* Judge Duniway, since deceased, was a member of the panel that originally heard oral argument in this case. Judge Kozinski was chosen by lot to replace Judge Duniway on the panel, and has had the benefit of listening to the tapes of oral argument, as well as reading the briefs and reviewing the record and exhibits in his consideration of the case.

FACTS AND PROCEDURAL HISTORY

In 1953, Leslie Baxter composed a collection of seven songs intended to invoke or represent emotions. These songs were recorded and published by Capitol Records in 1954 on an album entitled **The Passions**. **Joy**, one of the compositions on that album, is the subject of this action.[166] Baxter is the sole owner of all right, title and interest in the copyright to Joy.

Baxter and John Williams, a successful composer and conductor of music, have been personally acquainted for several decades. Williams had previously played the piano for Baxter at a number of recording sessions, and had knowledge of Joy. He participated as the pianist in the orchestra for a public performance of **Joy** in the Hollywood Bowl in the 1960s. In 1982, Williams composed **Theme from E.T**. for which he received an Academy Award for best original music. The other appellees utilized **Theme from E.T**. in the motion picture "**E.T**.: The Extra-Terrestrial," sound recordings and merchandising.

On November 2, 1983, Baxter filed a complaint for copyright infringement and demand for jury trial in district court. He alleged that **Theme from E.T**. was largely copied from his copyrighted song **Joy**. On September 17, 1984, defendants moved for summary judgment on the ground that, as a matter of law, **Theme from E.T**. was not substantially similar to protectible expression in **Joy**, and therefore did not infringe it. For the limited purpose of the summary judgment motion only, defendants conceded that: (1) Baxter owned a duly registered copyright in **Joy;** (2) Williams had "access" to **Joy** before the creation of **Theme from E.T.;** and (3) the "general ideas" in the subject songs were substantially similar.

Defendants attached to their motion papers the following items: (1) cassette tape recordings of **Joy** as it appeared on the album **The Passions** and the movie soundscore of **Theme from E.T.,** (2) the twenty-three page written instrumental sheet music of **Joy** that was copyrighted; and (3) the five page piano score of **Theme from E.T**. Baxter introduced into evidence expert testimony and five comparison tapes by Professor Harvey Bacal regarding the degree of similarity between the two compositions.

After reviewing the submitted evidence, the district court granted defendants' motion for summary judgment, stating:

> This Court's "ear" is as lay as they come. The Court cannot hear any substantial similarity between defendant's expression of the idea and plaintiff's. Until Professor Bacal's tapes were listened to, the Court could not even tell what the complaint was about. Granted that Professor Bacal's comparison exposes a musical similarity in

166 Since Joy was published and fixed in a sound recording prior to February 15, 1972, it was not eligible for copyright registration. Baxter's claim rests on Joy as registered sheet music which was copyrighted on February 8, 1954 and renewed on August 20, 1982.

> sequence of notes which would, perhaps, be obvious to experts, the similarity of expression (or impression as a whole) is totally lacking and could not be submitted to a jury.

Baxter timely appealed.

II. STANDARD OF REVIEW

[1] After the defendants stipulated to the plaintiff's ownership of the copyright and access to his work, the district court ruled as a matter of law that there was no substantial similarity between the two works. That holding is subject to our *de novo* review. *Berkic v. Crichton,* 761 F.2d 1289, 1292 (9th Cir. 1985), *cert. denied,* __ U.S__, 106 S. Ct. 85 (1985). We review the evidence and the inferences therefrom in the light most favorable to the nonmoving party, and determine whether there exists any genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *RFD Publications, Inc. v. Oregonian Pub. Co.,* 749 F.2d 1327, 1328 (9th Cir. 1984) *accord Twentieth Century Fox Film Corp. v. MCA,* 715 F.2d 1327, 1328 (9th Cir. 1983). The district court's grant of summary judgment to the defendants must be affirmed if reasonable minds could not differ as to the presence or absence of substantial similarity of expression. *See v. Durang,* 711 F.2d 141 (9th Cir. 1983). ***See also*** *Twentieth Century-Fox,* 715 F.2d at 1329.

DISCUSSION

[2] To establish a successful claim for copyright infringement, the plaintiff must prove (1) ownership of the copyright, and (2) "copying" of protectible expression by the defendant. *See Sid & Marty Krofft Television Productions, Inc., v. McDonald's Corp.,* 562 F.2d 1157, 1162 (9th Cir. 1977)(citing *Reyher v. Children's Television Workshop,* 533 F.2d 87, 90 (2d Cir. 1976), *cert. denied,* 429 U.S. 980 (1976); *Universal Athletic Sales Co. v. Salkeld,* 511 F.2d 904, 907 (3d Cir. 1975), *cert. denied,* 423 U.S. 863 (1975); 2 M. Nimmer, Nimmer on Copyright §141 at 610-611 (1979) [hereinafter cited as "Nimmer"]). Because direct evidence of copying is rarely available, a plaintiff may establish copying by circumstantial evidence of: (1) defendant's access to the copyrighted work prior to the creation of defendant's work, and (2) substantial similarity of both general ideas and expression between the copyrighted work and the defendant's work. *See Krofft,* 562 F.2d at 1162. Absent evidence of access, a "striking similarity" between the works may give rise to a permissible inference of copying. *See Selle v. Gibb,* 741 F.2d 896, 901 (7th Cir. 1984); *Shultz v. Holmes,* 264 F.2d 942 (9th Cir. 1959); Nimmer § 13.02[B] at 13-14 (1986). Baxter's ownership of

the copyright to **Joy** is undisputed, and defendants conceded access for the purpose of their summary judgment motion. Defendants further assumed for purposes of their motion that there was substantial similarity of ideas as between the two compositions. Therefore, the only question[167] before us is whether the district court's finding, based on its ear, that substantial similarity of expression was "totally lacking and could not be submitted to a jury," can sustain a grant of summary judgment to the defendants.

[3] Summary judgment cannot be granted if there exists a genuine dispute as to a material fact. Fed. R. Civ. P. 56(c). Rule 56 calls for the judge to determine whether there exists a genuine issue for trial, not to weigh the evidence himself and determine the truth of the matter. ***See*** *Anderson v. Liberty Lobby, Inc.,* __ U.S. __, 106 S. Ct. 2505, 2516 (1986). The non-moving party must present evidence sufficient to require a jury or judge to resolve the parties' differing versions of the truth at trial. *First National Bank of Arizona v. Cities Service Co.,* 391 U.S. 253, 288–289 (1968). Inferences to be drawn from facts contained in the moving party's papers are to be viewed by the district court in the light most favorable to the non-moving party. ***See*** *Adickes v. S.H. Kress* & Co., 398 U.S. 144 (1970). Weighing evidence, determining credibility, and drawing inferences from facts remain jury functions which may not be undertaken by the trial judge. ***See*** *Anderson,* 106 S. Ct. at 2513.

[4] Determinations of substantial similarity of expression are subtle and complex. The test to be applied has been labeled an "intrinsic" one by this Court in that it depends not upon external criteria, but instead upon the response of the ordinary reasonable person to the works. *Krofft,* 562 F.2d at 1164. "Analytic dissection" and expert testimony are not called for; the gauge of substantial similarity is the response of the ordinary lay hearer. ***Id.,*** *quoting Arnstein v. Porter,* 154 F.2d 464, 468 (2d Cir. 1946), *cert. denied,* 330 U.S. 851 (1947).

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167 Baxter argues that he should also have been permitted to prove copyright infringement by way of Expert testimony and analytic dissection which allegedly demonstrated the two works' "striking similarity." This contention misapprehends the nature of the "striking similarity" doctrine. Proof of striking similarity is an alternative means of proving "copying" where proof of access is absent. *See Selle v. Gibb,* 741 F.2d 896, 901 (7th Cir. 1984); Nimmer § 13.02[B] at 13–14, 13–15 (1986). Yet here, access was conceded and is thus not in issue. It was thus unnecessary to consider the possibility that **Theme from E.T.** was the product of independent creation, coincidence, a prior common source, or any source other than copying. *See id.* Upon remand, however, Baxter's expert testimony and analytic dissection offered as to "striking similarity" would certainly merit submission to a jury as to the substantial similarity of general ideas as between the two works. *See Krofft,* 562 F.2d at 1164.

Baxter further contends that judicial protection beyond the "lay audience" test is required for authors of works in technical fields such as music because an infringer can easily deceive the unsophisticated by immaterial variations in the copyrighted work. It is unnecessary to reach this issue, given our holding that the grant of summary judgment constituted reversible error. No compelling reason appears, however, to depart from the principles enunciated in *Krofft,* which reiterates that the test of substantial similarity depends upon the response of the ordinary lay listener. *See Krofft,* 562 F.2d at 1164.

Accordingly, in *Krofft,* this Court rejected extrinsic analysis of similarities and differences among characters in plaintiff's television show and defendants' TV commercials, in favor of asking whether the defendants' works captured the total concept and feel of plaintiffs' works. *Krofft,* 562 F.2d at 1167. ***See also*** *Berkic,* 761 F.2d at 1292; *Litchfield v. Spielberg,* 736 F.2d 1352, 1357 (9th Cir. 1984), *cert. denied*, _U.S. _, 105 S. Ct. 1753 (1985); *Overman v. Universal City Studios, Inc.,* 605 F.Supp. 350, 353 (CD. Cal. 1984), *aff'd mem.,* No. 84–6009 (9th Cir. July 2, 1985).

[[5] Since substantial similarity is usually an extremely close issue of fact, summary judgment is disfavored on that issue as a general rule. ***See*** *Berkic.* 761 F.2d at 1292; *Litchfield,* 736 F2d at 1355–1356; *Jason v. Fonda,* 526 F.Supp. 774, 777 (CD. Cal. 1981), *incorporated by reference,* 698 F.2d 966 (9th Cir. 1982). By no means does this general rule bar a grant of summary judgment, however, where the works are so dissimilar that reasonable minds could not differ as to the absence of substantial similarity. ***See*** *Litchfield,* 736 F.2d at 1355-1356 (play and movie); *Berkic.* 761 F.2d at 1292 (screenplay and movie); *Jason,* 698 F.2d at 967 (novel and movie); *Twentieth Century-Fox Film Corp. v. MCA, Inc.,* 715 F.2d 1327, 1330 (9th Cir. 1983)(movie and television show); *See,* 711 F.2d at 142-143 (plays); *Walker v. Time Life Films, Inc.,* 784 F.2d 44, 48 (2d Cir. 1986)(book and movie), *cert. denied,* _ U.S. _, 106 S. Ct. 2278 (1986); *Overman,* 605 F.Supp. at 354 (screenplay and movie). The question before us, then, is whether reasonable minds could differ as to the absence of substantial similarity of expression as between **Joy** and **Theme from E.T**.**]**

[6] We do not suggest that our ears are any more sophisticated than those of the district court. Nevertheless, based on our review of the record, we are persuaded that reasonable minds could differ as to whether **Joy** and **Theme from E.T**. are substantially similar. As in *Twentieth Century-Fox,* we do not suggest that the works are, in fact, substantially similar. We only state that reasonable minds could differ as to the issue and thus that summary judgment was improper [***See*** *Twentieth-Century-Fox.* 715 F.2d at 1329. This is simply not a case in which the absence of similarities is so patent as to warrant summary judgment. ***See*** *Arnstein.* 154 F.2d at 473.]

[[7] The result we reach is also appropriate in light of the fact that defendants' concession of access may have lowered the quantum of proof required for a jury to find substantial similarity, had there been a trial. ***See*** *Krofft,* 562 F.2d at 1172 (degree of access justifies lower standard of proof necessary to show substantial similarity), *quoting* Nimmer § 143.4 at 634 (1976). As in *Krofft,* this case presents ample evidence of access. Defendant Williams had personal knowledge of **Joy** and participated as the pianist in the orchestra for a public performance of **Joy** in the Hollywood Bowl. In a trial, such evidence of access is relevant to substantial similarity, and merits submission to a jury.[168]**]**

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168 It is clear, however, that no amount of proof of access will suffice to show copying if similarities are found to be absent. *Krofft,* 562 F.2d at 1172 (citing *Williams v. Kaag Manufacturers, Inc.,* 338 F.2d 949, 951 (9th Cir. 1964); *Arnstein,* 154 F.2d at 468).

We finally address defendants' contention that any similarity between the works can be reduced to a six-note sequence which is not protectible expression under the copyright laws. We disagree.

[8] Even were we to accept *arguendo* defendants' argument over Baxter's response that it is not a six-note sequence but the entire work whose similarity is at issue, this argument ignores the fundamental notion that no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity. ***See generally*** 3 M. Nimmer, Nimmer on Copyright § 13.03[A][2] (1986). Here, the ear of the court must yield to the ears of jurors. ***See*** *Roy Export Co. Establishment v. CBS,* 503 F.Supp. 1137, 1145 (S.D.N.Y. 1980), *aff'd,* 672 F.2d 1095 (2d Cir. 1982), *cert. denied,* 459 U.S. 826 (1982). Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity. ***See*** *Walt Disney Productions v. Air Pirates,* 581 F.2d 751 (9th Cir. 1978), *cert. denied,* 439 U.S. 1132 (1978); *Universal Pictures v. Harold Lloyd,* 162 F.2d 354 (9th Cir. 1947); *Heim v. Universal Pictures Co.,* 154 F.2d 480, 488 (single brief phrase so idiosyncratic as to preclude coincidence might suffice to show copying)(dictum); *Fred Fisher, Inc. v. Dillingham,* 298 F. 145 (S.D.N.Y. 1924)(L. Hand, J.)(eight note "ostinato" held to infringe copyright in song). ***See also*** *Meeropol v. Nizer,* 560 F.2d 1061 (2d Cir. 1977)(words copied amounted to less than one percent of defendant's entire work; fair use), *cert. denied,* 434 U.S. 1013 (1977); *Robertson v. Batten, Barton, Durstine & Osborne, Inc.,* 146 F.Supp. 795, 798 (S.D. Cal. 1956)(portions of song used constituted element upon which popular appeal and hence commercial success depended; fair use). ***See generally*** Nimmer § 13.03[A][2] at 13–36, and citations therein (notion that copying of three bars from musical work can never constitute infringement is without foundation). Certainly, evidence that the sequence in question is found in other works would be admissible to rebut an inference of copying; such evidence demonstrates that the sequence is so common that the probability of independent, coincidental creation was high. *Granite Music Corp. v. United Artists Corp.,* 532 F.2d 718, 720 (9th Cir. 1976).

[9] But we do not understand Baxter's claim to center solely on one six-note sequence. The jury upon remand may, of course, determine that any similarity is confined to the sequence, and that the similarity is insubstantial.

CONCLUSION

[10] Based upon our review of the record, we cannot say that **Joy** and **Theme from E.T.** are so dissimilar that reasonable minds could not differ as to a lack of substantial similarity between them. Therefore, the district court erred in granting defendants' motion for summary judgment.

Reversed and remanded for proceedings not inconsistent with this opinion.

OFFICIAL PUBLISHED OPINION

Leslie T. BAXTER, Plaintiff-Appellant,

v.

MCA, INC., a Delaware corporation; Universal City Studios, Inc., a Delaware corporation; Music Corporation of America, a California corporation; MCA Records, Inc., a California corporation; Merchandising Corporation of America, a California corporation; and John T. Williams, Defendants-Appellees.

No. 84–6522.

United States Court of Appeals, Ninth Circuit.

Argued and Submitted Oct. 9, 1985.

Decided March 5, 1987.

As Amended May 11, 1987.

Composer of copyrighted song brought copyright infringement action, alleging that theme from movie was largely copied from his copyrighted song. The United States District Court for the Central District of California, Harry L. Hupp, J., granted summary judgment for the defendant. Plaintiff appealed. The Court of Appeals, Tang, Circuit Judge, held that material issue existed as to whether theme from motion picture "E.T.: The Extra-Terrestrial" was substantial similar to copyrighted song "Joy," precluding summary judgment in copyright infringement action.

Reversed and remanded

John T. Blanchard, Los Angeles, Cal., for plaintiff-appellant.
Louis P. Petrich, Los Angeles, Cal., for defendants-appellees, MCA, et al.
Ronald S. Rosen, Los Angeles, Cal., for defendant-appellee, John T. Williams.

Appeal from the United States District Court for the Central District of California.

Before TANG, BOOCHEVER and KOZINSKI*, Circuit Judges.

TANG, Circuit Judge:

In this copyright infringement action, plaintiff-appellant Leslie T. Baxter appeals the district court's grant of summary judgment to John Williams and the other defendants-appellees. The district court granted defendants' motion based upon its determination that no substantial similarity of expression existed as between Baxter's copyrighted song Joy and the theme from the motion picture

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* Judge Duniway, since deceased, was a member of the panel that originally heard oral argument in this case. Judge Kozinski was chosen by lot to replace Judge Duniway on the panel, and has had the benefit of listening to the tapes of oral argument, as well as reading the briefs and reviewing the record and exhibits in his consideration of the case.

"E.T.: The Extra-Terrestrial" [hereinafter cited as Theme from E.T.]. We reverse the grant of summary judgment and remand for trial.

FACTS AND PROCEDURAL HISTORY

In 1953, Leslie Baxter composed a collection of seven songs intended to invoke or represent emotions. These songs were recorded and published by Capitol Records in 1954 on an album entitled The Passions. Joy, one of the compositions on that album, is the subject of this action.[169] Baxter is the sole owner of all right, title and interest in the copyright to Joy.

Baxter and John Williams, a successful composer and conductor of music, have been personally acquainted for several decades. Williams had previously played the piano for Baxter at a number of recording sessions, and had knowledge of Joy. He participated as the pianist in the orchestra for a public performance of Joy in the Hollywood Bowl in the 1960s. In 1982, Williams composed Theme from E.T. for which he received an Academy Award for best original music. The other appellees utilized Theme from E.T. in the motion picture "E.T.: The Extra-Terrestrial," sound recordings and merchandising.

On November 2, 1983, Baxter filed a complaint for copyright infringement and demand for jury trial in district court. He alleged that Theme from E.T. was largely copied from his copyrighted song Joy. On September 17, 1984, defendants moved for summary judgment on the ground that, as a matter of law, Theme from E.T. was not substantially similar to protectible expression in Joy, and therefore did not infringe it. For the limited purpose of the summary judgment motion only, defendants conceded that: (1) Baxter owned a duly registered copyright in Joy; (2) Williams had "access" to Joy before the creation of Theme from E.T.; and (3) the "general ideas" in the subject songs were substantially similar.

Defendants attached to their motion papers the following items: (1) cassette tape recordings of Joy as it appeared on the album The Passions and the movie sounds-core of Theme from E.T.; (2) the twenty-three page written instrumental sheet music of Joy that was copyrighted; and (3) the five page piano score of Theme from E.T. Baxter introduced into evidence expert testimony and five comparison tapes by Professor Harvey Bacal regarding the degree of similarity between the two compositions.

After reviewing the submitted evidence, the district court granted defendants' motion for summary judgment, stating:

> This Court's "ear" is as lay as they come. The Court cannot hear any substantial similarity between defendant's expression of the idea and plaintiff's. Until Professor

169 Since Joy was published and fixed in a sound recording prior to February 15, 1972, it was not eligible for copyright registration. Baxter's claim rests on Joy as registered sheet music which was copyrighted on February 8, 1954 and renewed on August 20, 1982.

> Bacal's tapes were listened to, the Court could not even tell what the complaint was about. Granted that Professor Bacal's comparison exposes a musical similarity in sequence of notes which would, perhaps, be obvious to experts, the similarity of expression (or impression as a whole) is totally lacking and could not be submitted to a jury.

Baxter timely appealed.

DISCUSSION

[1, 2] After the defendants stipulated to the plaintiffs ownership of the copyright and access to his work, the district court ruled as a matter of law that there was no substantial similarity between the two works. That holding is subject to our *de novo* review. *Berkic v. Crichton,* 761 F.2d 1289, 1292 (9th Cir.1985), *cert. denied,* — U.S. —, 106 S.Ct 85, 88 L.Ed.2d 69 (1985). We review the evidence and the inferences therefrom in the light most favorable to the nonmoving party, and determine whether there exists any genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *RFD Publications, Inc. v. Oregonian Pub. Co.,* 749 F.2d 1327, 1328 (9th Cir.1984) *accord Twentieth Century Fox Film Corp. v. MCA,* 716 F.2d 1327, 1328 (9th Cir.1988). The district court's grant of summary judgment to the defendants must be affirmed if reasonable minds could not differ as to the presence or absence of substantial similarity of expression. *See v. Durang,* 711 F.2d 141 (9th Cir.1983). *See also Twentieth Century-Fox,* 715 F.2d at 1329.

[3–8] To establish a successful claim for copyright infringement, the plaintiff must prove (1) ownership of the copyright, and (2) "copying" of protectible expression by the defendant. *See Sid & Marty Krofft Television Productions, Inc., v. McDonald's Corp.,* 562 F.2d 1157, 1162 (9th Cir.1977) (citing *Reyher v. Children's Television Workshop,* 533 F.2d 87, 90 (2d Cir. 1976), *cert. denied,* 429 U.S. 980, 97 S.Ct. 492, 50 L.Ed.2d 588 (1976); *Universal Athletic Sales Co. v. Salkeld,* 511 F.2d 904, 907 (3d Cir.1975), *cert. denied,* 423 U.S. 863, 96 S.Ct. 122, 46 L.Ed.2d 92 (1975); 2 M. Nimmer, Nimmer on Copyright § 141 at 610–611 (1979) [hereinafter cited as "Nimmer"]). Because direct evidence of copying is rarely available, a plaintiff may establish copying by circumstantial evidence of: (1) defendant's access to the copyrighted work prior to the creation of defendant's work, and (2) substantial similarity of both general ideas and expression between the copyrighted work and the defendants work. *See Krofft,* 562 F.2d at 1162. Absent evidence of access, a "striking similarity" between the works may give rise to a permissible inference of copying. *See Selle v. Gibb,* 741 F.2d 896, 901 (7th Cir. 1984); *Shultz v. Holmes,* 264 F.2d 942 (9th Cir.1959); Nimmer § 13.02[B] at 13–14 (1986). Baxter's ownership of the copyright to. Joy is undisputed, and defendants conceded access for the purpose of their summary judgment motion. Defendants further assumed for purposes of their motion that there was substantial similarity of ideas as between the two compositions.

Therefore, the only question[170] before us is whether the district court's finding, based on its ear, that substantial similarity of expression was "totally lacking and could not be submitted to a jury," can sustain a grant of summary judgment to the defendants.

[9] Summary judgment cannot be granted if there exists a genuine dispute as to a material fact. Fed.R.Civ.P. 56(c). Rule 56 calls for the judge to determine whether there exists a genuine issue for trial, not to weigh the evidence himself and determine the truth of the matter. *See Anderson v. Liberty Lobby, Inc.,* — U.S. —, 106 S.Ct. 2505, 2516, 91 L.Ed.2d 202 (1986). The nonmoving party must present evidence sufficient to require a jury or judge to resolve the parties' differing versions of the truth at trial. *First National Bank of Arizona v. Cities Service Co.,* 391 U.S. 258, 288–289, 88 S. Ct. 1575, 1592, 20 L.Ed.2d 569 (1968). Inferences to be drawn from facts contained in the moving party's papers are to be viewed by the district court in the light most favorable to the nonmoving party. *See Adickes v. S.H. Kress & Co.,* 898 U.S. 144, 90 S.Ct. 1598, 26 L.Ed.2d 142 (1970). Weighing evidence, determining credibility, and drawing inferences from facts remain jury functions which may not be undertaken by the trial judge. *See Anderson,* 106 S.Ct. at 2513.

Determinations of substantial similarity of expression are subtle and complex. The test to be applied has been labeled an "intrinsic" one by this Court in that it depends not upon external criteria, but instead upon the response of the ordinary reasonable person to the works. *Krofft,* 562 F.2d at 1164. "Analytic dissection" and expert testimony are not called for; the gauge of substantial similarity is the response of the ordinary lay hearer. *Id., quoting Arnstein v. Porter,* 154 F.2d 464, 468 (2d Cir.1946), *cert. denied,* 330 U.S. 851, 67 S.Ct. 1096, 91 L.Ed.

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170 Baxter argues that he should also have been permitted to prove copyright infringement by way of expert testimony and analytic dissection which allegedly demonstrated the two works' "striking similarity." This contention misapprehends the nature of the "striking similarity" doctrine. Proof of striking similarity is an alternative means of proving "copying" where proof of access is absent. *See Selle v. Gibb,* 741 F.2d 896, 901 (7th Cir. 1984); Nimmer § 13.02[B] at 13–14, 13–15 (1986). Yet here, access was conceded and is thus not in issue. It was thus unnecessary to consider the possibility that Theme from E.T. was the product of independent creation, coincidence, a prior common source, or any source other than copying. *See id.* Upon remand, however, Baxter's expert testimony and analytic dissection offered as to "striking similarity" would certainly merit submission to a jury as to the substantial similarity of general ideas as between the two works. *See Krofft,* 562 F.2d at 1164.

Baxter further contends that judicial protection beyond the "lay audience" test is required for authors of works in technical fields such as music because an infringer can easily deceive the unsophisticated by immaterial variations in the copyrighted work. It is unnecessary to reach this issue, given our holding that the grant of summary judgment constituted reversible error. No compelling reason appears, however, to depart from the principles enunciated in *Krofft,* which reiterates that the test of substantial similarity depends upon the response of the ordinary lay listener. *See Krofft,* 562 F.2d at 1164.

1294 (1947). Accordingly, in *Krofft,* this Court rejected extrinsic analysis of similarities and differences among characters in plaintiff's television show and defendants' TV commercials, in favor of asking whether the defendants' works captured the total concept and feel of plaintiffs' works. *Krofft,* 562 F.2d at 1167. *See also Berkic,* 761 F.2d at 1292; *Litchfield v. Spielberg,* 736 F.2d 1352, 1367 (9th Cir.1984), *cert. denied,* 470 U.S. 1052, 105 S.Ct. 1753, 84 L.Ed.2d 817 (1985); *Overman v. Universal City Studios, Inc.,* 605 F.Supp. 350, 353 (C.D.Cal.1984), *aff'd mem.,* 767 F.2d 933 (9th Cir.1985).

[10] We do not suggest that our ears are any more sophisticated than those of the district court. Nevertheless, based on our review of the record, we are persuaded that reasonable minds could differ as to whether Joy and Theme from E. T. are substantially similar. As in *Twentieth Century-Fox,* we do not suggest that the works are, in fact, substantially similar. We only state that reasonable minds could differ as to the issue and thus that summary judgment was improper. *See Twentieth Century-Fox*; 715 F.2d at 1329.

We finally address defendants' contention that any similarity between the works can be reduced to a six-note sequence which is not protectible expression under the copyright laws. We disagree.

[11–13] Even were we to accept, *arguendo* defendants' argument over Baxter's response that it is not a six-note sequence but the entire work whose similarity is at issue, this argument ignores the fundamental notion that no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity. *See generally* 3 M. Nimmer, Nimmer on Copyright § 13.03[A][2] (1986). Here, the ear of the court must yield to the ears of jurors. *See Roy Export Co. Establishment v. CBS,* 503 F.Supp. 1137, 1145 (S.D.N.Y.1980), *aff'd,* 672 F.2d 1095 (2d Cir.1982), *cert. denied,* 459 J.S. 826, 103 S.Ct. 60, 74 L.Ed.2d 63 (1982). Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity. *See Walt Disney Productions v. Air Pirates,* 581 F.2d 751 (9th Cir.1978), *cert. denied,* 439 U.S. 1132, 99 S.Ct. 1054, 59 L. Ed.2d 94 (1978); *Universal Pictures v. Harold Lloyd,* 162 F.2d 354 (9th Cir.1947); *Heim v. Universal Pictures Co.,* 154 F.2d 480, 488 (single brief phrase so idiosyncratic as to preclude coincidence might suffice to show copying) (dictum); *Fred Fisher, Inc. v. Dillingham,* 298 F. 145 (S.D.N.Y. 1924) (L. Hand, J.) (eight note "ostinato" held to infringe copyright in song). *See also Meeropol v. Nizer,* 560 F.2d 1061 (2d Cir.1977) (words copied amounted to less than one percent of defendant's entire work; fair use), *cert. denied,* 434 U.S. 1013, 98 S.Ct. 727, 54 L.Ed.2d 756 (1977); *Robertson v. Batten, Barton, Durstine & Osborne, Inc.,* 146 F.Supp. 795, 798 (S.D. Cal.1956) (portions of song used constituted element upon which popular appeal and hence commercial success depended; fair use). *See generally* Nimmer § 13.03[A][2] at 13–36, and citations therein (notion that copying of three bars from musical work can never constitute infringement is without foundation). Certainly, evidence that the sequence in question is found in other works would be admissible to rebut an inference of copying; such evidence

demonstrates that the sequence is so common that the probability of independent, coincidental creation was high. *Granite Music Corp. v. United Artists Corp.,* 532 F.2d 718, 720 (9th Cir.1976).

But we do not understand Baxter's claim to center solely on one six-note sequence. The jury upon remand may, of course, determine that any similarity is confined to the sequence, and that the similarity is insubstantial.

CONCLUSION

Based upon our review of the record, we cannot say that Joy and Theme from E.T. are so dissimilar that reasonable minds could not differ as to a lack of substantial similarity between them. Therefore, the district court erred in granting defendants' motion for summary judgment.

Reversed and remanded for proceedings not inconsistent with this opinion.

CHAPTER
11

Copyright and Music in the Courtroom

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I do not mean to reproach the draftsmen for failing to face squarely the questions of validity and infringement which are in the end insoluble. Rather I make the point that the statute, like its predecessors, leaves the development of fundamentals to the judges. Indeed the courts have had to be consulted at nearly every point, for the text of the statute has a maddeningly casual prolixity and imprecision throughout.

Benjamin Kaplan

An Unhurried View of Copyright[1]

I. The Copyright Act and the Judiciary

This "maddeningly casual prolixity and imprecision," referenced by Professor Kaplan is not only found in the 1909 Copyright Act (to which he was referring) but is also one of the hallmarks of the Copyright Act of 1976. This lack of specificity, especially in defining infringement of copyright, as discussed in Chapter 1 of this book, is not the result of an oversight. Rather, it is a recognition by Congress of the necessity for a broad and open definition to avoid a listing—no matter how generic—of those acts constituting copyright infringement. This approach is both practical and wise because of the varying and nuanced factual contexts from which potential infringement claims may arise. As noted earlier in this text, the Copyright Office, unlike the Patent and Trademark Office of the United States, does not, except on rare occasions, review applications for registration of copyright, leaving it to the litigation process to determine whether a copyright in one work has been infringed by the author of another. *Baxter v. MCA, Inc.*[2] is a microcosm of the many factual settings that arise in music infringement claims. It is also a case study of the many contentious issues involved in infringement disputes, the critical decisions counsel must make under the unique stress and pressures of a trial and, in the case of *Baxter*, the particular problems created by the reversal of a summary judgment in favor of defendants necessitating either a settlement or the trial which is recounted in this chapter.

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1. BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 40 (1967).
2. 812 F.2d 421 (9th Cir.), *cert. denied*, 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987).

II. The Composers and the Works at Issue

Although little remembered today, Les Baxter, during the 1950s and 1960s, was a prominent conductor and composer of approximately fifty or more scores for "B" motion pictures.[3] He was also a highly successful conductor/recording artist of exotically-themed L.P. albums for Capitol Records. One of his most exotic and best-selling albums (over 500,000 sold) bore the title, *The Voice Of Xtabay*, the "voice" being that of Yma Sumac,[4] a Peruvian soprano with a range of over four octaves from deep contralto to a high coloratura soprano. Baxter composed and/or arranged the selections on this album, and conducted the orchestra. In 1954, Baxter, then at the height of his prominence as a composer/conductor, created the music for an L.P. album about the moods of women,[5] which was entitled *The Passions*. Among one of these moods or "passions" was a selection entitled "Joy," the work Baxter claimed had been infringed. Unlike *The Voice of Xtabay*, which quickly sold over 500,000 after its release in 1949, *The Passions* album, after its limited release and a brief period of air (radio) play, attracted little attention and virtually disappeared from public awareness. The same was true of "Joy" which was never released as a single.

Today, John Williams is universally known as one of the most prolific and successful film composers in the history of motion pictures. There is more, however: His concert works include concertos for violin, cello (composed for Yo Yo Ma), flute, and tuba. He has been nominated for an Academy Award® over thirty-five times and has won the Award five times. In the 1950s, when Baxter was a prominent recording artist, Williams was serving in the U.S. Air Force (from 1951 to 1954). When he returned from active duty he studied with the renowned pedagogue Rosina Lhevine at the Juilliard School and then returned to Los Angeles, where he became a sought-after studio pianist in 1956. In the 1960s, he began composing for television productions, and began scoring feature films, eventually including *Jaws*, *Close Encounters of the Third Kind*, *Superman*, *Star Wars*, *The Empire Strikes Back*, *Raiders of the Lost Ark*, and *E.T. The Extra-Terrestrial* in 1982.

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3. Among his many motion picture credits are scores for *The Black Sheep*, *The Invisible Boy, Pharaoh's Curse, The House Of Usher, Alakazam The Great, X (The Man With The X-Ray Eyes), Master Of The World*, and *How To Stuff A Wild Bikini*. The year 1957 was Baxter's high for productivity when fourteen motion pictures with his scores were released.
4. At the time this album became a bestseller, there was a rumor that her real name was Amy Camus (Yma Sumac spelled backwards) and that she was from Brooklyn. This was apparently disproved many years ago: On the Internet Movie Database, www.imdb.com, for example, her birth name is listed as Zoila Augusta Emperatriz Chavarri del Castillo, and she is listed as having been born in Ichocan, Peru.
5. As politically incorrect as this theme may appear today, it caused no controversy in 1954 when the album was released.

III. Baxter's Claims

A. "Joy"'s Resurrection

Through a serendipitous occurrence, "Joy" was resurrected in 1983 when a friend of Baxter's saw *E.T. The Extra-Terrestrial* in a theater. The friend, who was a musician, told Baxter that a theme from "Joy" had been copied and was repeated a number of times in the *E.T.* score accompanying the action on the screen. Baxter saw the film and filed a complaint for copyright infringement in Federal District Court, seeking damages and profits as well as injunctive relief. Before trial, he abandoned his claim for damages and elected to seek recovery of a share of the profits from *E.T.* At the time of the trial in August/September 1988, *E.T.* had earned the following distinction and awards: the most financially successful motion picture in motion picture history, two first-run releases (1982 and 1985), and Academy Awards for Best Score (Williams), Best Visual Effects, and Best Sound. Two additional factors: *E.T.* had never been shown on television, and its videocassette release had been held back until October 1988, with ten to eleven million units for sale to the public both before and during the holiday season.

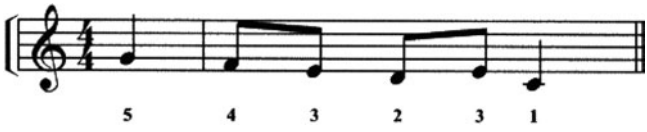
B. The Claims of Williams's Access to "Joy"

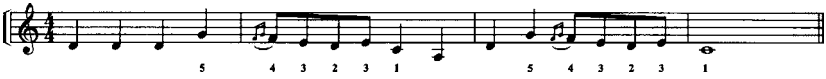
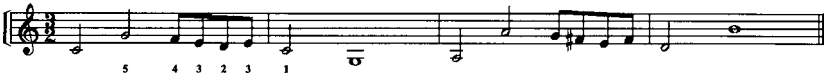
Baxter initially claimed that Williams was the pianist during the recording session of the *Passions* L.P. album in 1954. He also had a specific recollection that Williams played "Joy" at a Hollywood Bowl concert conducted by Baxter sometime during a period stretching from 1955–1967. A search of the programs at Hollywood Bowl during that period did not provide any record of a concert where (1) Williams appeared with an orchestra conducted by Baxter; or (2) "Joy" was performed.[6] Since neither the Hollywood Bowl nor the Los Angeles Philharmonic kept records of independently presented programs, Baxter's contention that Williams had access to "Joy" retained some viability.

C. The Commonplace Building Block

In his complaint, Baxter claimed that a material part of "Joy" had been copied by Williams when he composed the score for *E.T.* The motif which Baxter

6. The defendants located a Hollywood Bowl program from a concert on August 27, 1955 where Baxter conducted his works "Quiet Village," "Rio," and "Havannah." However, "Joy" from plaintiff's album, *The Passions*, was not performed at this concert.

alleged had been infringed by the "Flying Theme" in the *E.T.* score (the "*E.T.* Theme") consists of the following notes (or pitches):[7]

The complete phrases from which this motif was abstracted by Baxter encompasses the following pitches and durational values:

Joy

"*E.T.* Theme"

Although there are six pitches in common—G-F-E-D-E-C (5-4-3-2-3-1)—between "Joy" and the "*E.T.* Theme," in considering not just pitch sequence, but also the durational values of the two sequences, the only "substantial similarity" between them is four eighth notes: F-E-D-E (4-3-2-3).[8]

Faced with what the counsel for defendants believed to be an unsupportable claim for infringement, they sent recordings of the works and a written designation of the specific pitches or notes at issue to a forensic musicologist. These materials were submitted "blind" (i.e., without revealing who counsel represented). The musicologist concluded that the two works were different in melody, form, structure, harmony, tempo, meter, and rhythm. In addition, he

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7. Plaintiff based his claim on pitch sequence alone, which included the foregoing six notes, although during the course of the litigation he appeared to be claiming that the infringed motif or fragment included additional pitches. Some of his recorded examples were synthesized versions of the above sequence, without rhythm or harmony, which were played for the jury.
8. *See supra*, Prelude note 1 regarding the assignment of numbers to pitches (or notes). A portion of *"Joy"* contains the following sequence of pitches (grace notes are in parenthesis): 2-2-2-5 (4-5)-4-3-2-3-1-6. The *E.T. Theme* contains the following sequence: 1-5-4-3-2 3-1-5. Six of the middle pitches (ignoring grace notes) are thus the same [5-4-3-2-3-1]. The duration of the pitches as between "Joy" and the "*E.T.* Theme" is also different with the result that the only notes that are identical in pitch and duration are the four eighth-notes in the middle of the two sequences (4-3-2-3).

concluded that the fragment at issue (G-F-E-D-E-C) was merely a motif embodying a basic descending scale from the dominant (the fifth note of the scale) to the tonic (the first note of the scale) with a repetition of the third note of the scale before the final note (the third and fifth pitches were the same).[9] Based on their experts' initial analysis, defendants' counsel began constructing the defenses primarily based on examples of prior art to demonstrate that the sequence of pitches at issue (G-F-E-D-E-C) (and the four-eighth-note motif within it [F-E-D-E]) was a commonplace building block of music found in many works antedating both "Joy" and the "*E.T* Theme," proving (1) "Joy" and the "*E.T.* Theme" were each independently created, and used this unprotectable sequence available to all composers; (2) it was highly unlikely that Williams had access to "Joy" but rather created the "*E.T.* Theme" using an unprotectable and therefore available musical motif; and, (3) as a result, Williams had not infringed Baxter's "Joy." Reliance upon prior art as a means to identify and filter out unprotectable musical building blocks and ideas is by far the most effective analytic tool in copyright infringement cases. In the situation reflected in *Baxter*, the prior art motif found in both compositions could literally be found in treatises on musical theory and harmony, in a piano exercise book, in thematic indices, and in the works of composers from all historical musical periods.

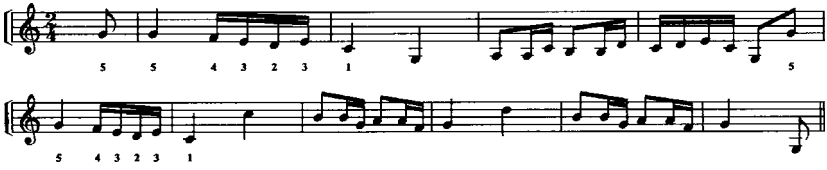
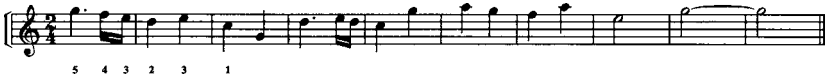
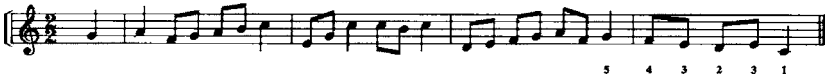
Initially, it must be observed that the downward progression of the fifth note of the scale (dominant) to the first note of the scale (tonic) is a standard cadence which, in Western music, is used to end and signal the completeness of an entire musical work or subset of that work, such as, for example, movements of symphonies and concertos.[10] In the case of "Joy" (in the key of C major), and the "*E.T.* Theme" sheet music (which was transcribed by the publisher from its original key to C-major), the cadence begins with the pitch of G(5) and ends on C(1). The notes in between—F-E-D-E—are in fact another standard musical device: *a turn*. The turn is represented in printed scores as a curved line like the letter "S" on its side which is a shorthand symbol for a musical figure containing four notes described in treatises as the note above, the note itself, the note below, and the note itself.[11] This is exactly what occurs in the motif, consisting of four eighth-notes, in both the "*E.T.* Theme" and

9. Based upon the expert's opinion and a belief that, in listening to the two compositions played in their original recorded performances where the judge is a member of the "audience," the court would find that as a matter of law no reasonable juror could find the two works substantially similar in protectable expression, defendants filed a summary judgment which was granted by the district court, but was reversed by the Ninth Circuit Court of Appeals. The jury trial discussed, *infra*, followed.

10. *See* Willi Apel, Harvard Dictionary of Music 118–120 (2d ed. 1972) (defining and explaining "cadence").

11. *See id*. at 878–79 (defining and explaining "turn"). *See also* Percy A. Scholes, The Oxford Companion To Music liv-lv, Tables 14–15 (John Owen Ward ed., 1984).

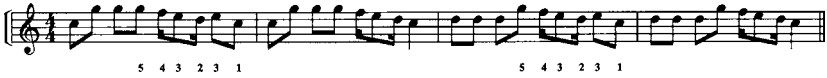
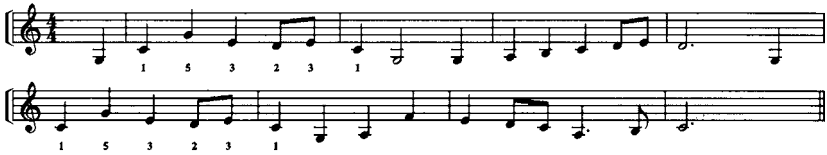
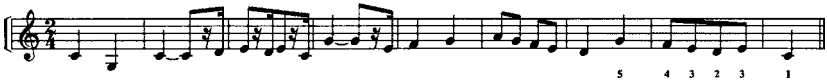
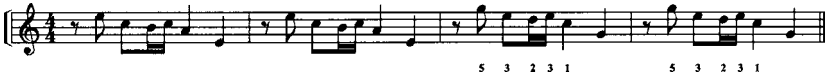
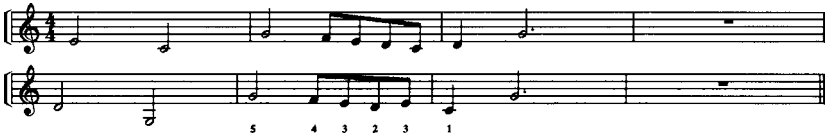
"Joy": the note above (F), the note itself (E), the note below (D), and back to the note itself (E). Under the numbering system explained in footnote 8 (referring to footnote 1 of the Prelude), *supra*, the *turn* in both works would be noted numerically as 4-3-2-3. Armed with the foregoing, it was relatively easy to find examples of prior art, which included the following passages containing the motif at issue (G-F-E-D-E-C) (leaving aside durational values and harmony, thus limiting the analysis to pitch sequence):

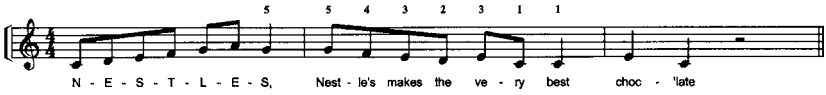
Schubert: *Rondo for Violin and Orchestra.*[12]

Borodin: *In The Steppes of Central Asia.*

Bach: *Bourré from Partita No. 3, in E major for Unaccompanied Violin.*

12. In *Baxter*, the prior art analysis was focused on Western music with a particular emphasis on music of the Romantic Period. This approach was a natural consequence of the fact that "Joy"and the "*E.T.* Theme" were both based on music of that period. As the late Dr. Earl V. Spielman, a noted forensic musicologist, observed:

> As we are well aware, and are undoubtedly reminded of daily, the music in our society today is considerably more than the music that is studied in colleges and universities. We are coaxed into believing by the academic "powers that be" that there is some higher art form in what we hear performed by Vladimir Horowitz or Itzhak Perlman, as compared with Liberace or Chet Atkins, or the music that is sung by Placido Domingo or Luciano Pavariotti, as compared with Garth Brooks or Shania Twain.
>
> But whatever our personal tastes in music, we accept the undeniable fact that many different kinds of music exist. Furthermore, we are aware, if not integrally involved with the fact, that music business may be spelled with a lower case "m," but it definitely has a capital "B." There is money involved with music, and for the most part, the kind of music that generates the bulk of that money is not the music being studied at universities!

Earl V. Spielman, Address to the Copyright Society of the United States (March 1991) (transcript with author).

Czerny: extract from Exercise No. 25 from *The Little Pianist*.[13]

Milhaud: *L'Homme et Son Desir*.

Newman: from film score for *Young Mr. Lincoln.*

Bizet: *Farandole* from *L'Arlesienne Suite*.

Mendelssohn: *Fingal's Cave Overture*.

Neil Diamond: *Song Sung Blue*.

13. The studies in this set of pieces are so basic that the collection is subtitled "Easy Progressive Exercises—Beginning with the First Rudiments."

Nestle's Commercial

These examples of prior art were used by defendants' experts to demonstrate that the motif (or fragment) at issue had been employed by composers from Bach to Neil Diamond as a standard building block of music. As such, it was not protectable under the copyright laws because "a statutory copyright does not give a monopoly over . . . a musical phrase, but merely protects against the unlawful reproduction of an original work."[14]

IV. The Defendants' Trial Strategy

A. An Initial Concern: The Reversal of Defendants' Summary Judgment

The district court's grant of summary judgment and its reversal by the Ninth Circuit in *Baxter v. MCA, Inc.*[15] has been discussed in these pages. What has not been discussed is the strategy employed by defendants which, upon reversal of the summary judgment, had potentially serious consequences. The strategy—to concede access for the sake of argument in support of the summary judgment motion—was driven by the *Arnstein/Krofft* bifurcated test to first establish through similarities (whether or not protectable by copyright) that (1) copying had occurred, proceeding to the second prong, that (2) defendant copied protected expressions from plaintiff's work.[16] Counsel for defendants concluded that, since "Joy" and the "*E.T.* Theme" taken as a whole were dissimilar, the judge would listen to both compositions and could rule as a matter of law that the average juror, properly instructed, would not find them substantially similar in protected expression. If the issue had involved literature, such dissimilarity would have been relatively easy to determine. The bottom line on the strategy was that counsel for defendants wanted to foreclose consideration of testimony by plaintiff's expert, which would have included dissection and analysis to prove copying of some musical element,

14. Granite Music Corp. v. United Artists Corp., 532 F.2d 718, 720 (9th Cir. 1976).
15. 812 F.2d 421.
16. *See* Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977); Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946).

whether or not protectable. Plaintiff submitted expert testimony anyway. Defendants' strategy still carried the day, and the judge, stating that his ear "is as lay as they come," granted summary judgment.[17]

The Ninth Circuit reversed and enunciated a *no-bright line rule*, mandating that, in music infringement cases, a jury, as the lay listeners, must decide the issue of actionable copying.[18] Stated another way, since the audience test must be used to determine actionable copying, that issue could not be determined by summary judgment. The result of the decision: If the jury returned a verdict for plaintiff, the trial judge could not grant a defense motion for judgment *n.o.v*. Arguably, the court could grant a motion for a new trial. With ten to eleven million videocassette units of *E.T*. ready to be shipped in October, 1988 for the holiday season, defense counsel had more than the rigors of trial to consider.

B. Following the Lead of the Ninth Circuit: The Audience Test and the Jury

Given the Ninth Circuit's mandate that the issue of substantial similarity of protected expression was to be decided under the "audience test" (the response of the lay listener), counsel for defendants—still convinced that "Joy" and the "*E.T*. Theme" taken as a whole were dissimilar in expression—decided to move for an order that the trial be trifurcated (with the audience test tried first) as follows: First Phase (the *audience test*)—play the works for the jury as they were heard by the "real" audiences in 1954 and 1982, respectively, without expert dissection and analysis, with the expectation that the jury would not find the works substantially similar; Second Phase (if necessary) try liability for actionable infringement; and Third Phase (if necessary)—damages and remedies.

This is, if nothing else, a graphic illustration of the mental gymnastics in which counsel engaged in their efforts to avoid the effect of expert testimony on the jury with its emphasis on similarities including those not protected by copyright. The district court judge granted the defendants' motion, thus activating the trifurcation strategy. The First Phase yielded a surprising result—especially for the defendants.

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17. *Baxter*, 812 F.2d at 423.

18. *See id*. at 425 ("no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity").

V. The Trial: First Phase (The Audience Test)

A. Prelude: Determining What Would Be Played for the Jury

The court, in chambers, conducted a day-long hearing regarding whether plaintiff's musical exhibits were admissible replete with expert testimony, and the playing of the following recordings:

- "Joy" and the "*E.T.* Theme" in their original versions as heard by the public in 1954 and 1982, respectively;
- Synthesized works in their entirety to obviate technical differences between the 1954 and 1982 recordings—but adding new problems; and,
- Synthesized "fragments" of each work—to allow plaintiff to show exactly what he claimed was taken.

Defendants objected on the grounds that the plaintiff's exhibits constituted improper dissection in violation of the *intrinsic test* to be applied during this phase and that the inaccurate reproduction of the works in synthesized forms was prejudicial.

The judge, over defendants' objections, ruled that all these exhibits would be admitted. The next day, a jury of six lay members (the "audience") and two alternates was selected, and the trial began.

B. The "Audience" Test

Given the court's ruling admitting the plaintiff's synthesized recreations of the motif discussed above and used by both composers, the result of this phase of the trial was foreordained: the pitches at issue (G-F-E-D-E-C or 5-4-3-2-3-1) in their synthesized versions, some of which were without harmony or rhythm, were not merely substantially similar, they were identical. Each side made brief opening statements, the recorded exhibits were played and the jury was instructed, including defendants' instruction based on comparison of the two works as originally heard by the "audience" in 1954 ("Joy") and 1982 (the "*E.T.* Theme"). After deliberating for one hour, the jury returned with a finding of substantial similarity under a test mimicking the *intrinsic* test, but which was actually neither *intrinsic* nor *extrinsic*, because, even in the wake of the jury's finding, the trial proceeded to the "liability" phase. The issue for the second phase was whether that portion of "Joy" upon which plaintiff based his claim constituted original expression or merely a musical idea, *scène à faire*, motif or commonplace building block of music falling outside the scope of copyright protection.

Comment

In planning the trifurcation strategy, counsel for defendants assumed that the versions of "Joy" and the "*E.T.* Theme" to be played for the jury would be those heard by the public (the audience) in their original (non-synthesized) versions. That was a logical, but as it turned out, unwarranted assumption. In hindsight, it may be viewed as a pilot project for a referendum on the audience test in music infringement cases. In the *Baxter* case, defense counsel implemented the audience test under the purest of circumstances: The works were played (1) as heard by the audiences in 1954 and 1982; and (2) in synthesized versions submitted by the plaintiff. No experts testified, and, as a result, the jury proceeded to the jury room without any knowledge of those elements of the works that were or were not protected by copyright. Would the result have been different if only the original versions were played for the jury? Perhaps, but we will never know for sure. What we do know—given the result of the trial's second phase—is that expert opinions and examples of prior art likely would have resulted in a jury verdict for defendants.

VI. A Note On Direct and Cross-Examination: A Brief Refresher before Proceeding to the Trial

A. Direct Examination

It has often been expressed that direct examination, as employed by counsel when questioning his or her party and witnesses, is, compared to cross-examination, the easier of the two. Though there is some support for this view, direct examination—like cross—is also an art form with its own structure, nuances and challenges. The basic objective of direct examination is to tell, through a quasi-dialogue, a free-flowing, coherent and interesting story, in a manner and language that is accessible without being demeaning. The latter is especially important to keep in mind when a jury is the finder of fact. As such the story should be told by the witness, with the lawyer, for the most part, acting as the director who sets the scene and facilitates the scenario being related by the witness. With the exception of those times on the stand when the witness falters or inexplicably blurts out something unexpected, attention should be focused on the client/witness and the other witnesses supporting the client's position. If, however, the unexpected and damaging pops out of the witness's mouth, the lawyer must step in, ask rehabilitative questions and try to repair the damage. Examples of direct examination appear in excerpts from transcripts of the trial, set forth in Section VII of this Chapter *infra*.

B. Cross-Examination

In Section VI of Chapter 9 (regarding discovery) on the taking of depositions, the author deals with the differences between and uses of three distinct types of questions calculated to obtain information from the adverse party and his or her witnesses: direct, open, and oblique. These three types of questions may still be asked during trial subject to a distinction and a caveat: (1) the rules of evidence apply at trial, thus limiting admissibility to evidence relevant to the issues being litigated (rather than the broader scope applicable to discovery: relevancy to the subject matter of the actions or calculated to lead to the discovery of admissible evidence); and (2) although open questions may be posed on direct examination, their use should be avoided in cross-examining adverse witnesses. Instead, the use of closed-ended questions to reign in and control the testimony of the cross-examined witness as much as possible, should be the governing principle, except in rare "safe" situations.

C. Scenario Number One: A Non-Musical Analogy

Many years ago, in a notorious divorce case involving an iconic female motion picture star—amid charges of infidelity and neglect of the parties' children—the lawyer for the actress, in cross-examination of her husband, asked the following *open* question (paraphrased):

> Q. Why do you believe *Miss X* is an unfit mother?
> Answer: From contemporary reports of this trial, the husband then proceeded for approximately two hours listing chapter and verse of his wife's infidelities, prolonged absences from home and neglect of their children.

Obviously, such an open question, allowing for a long, unrestrained narrative by the witness, should never have been asked, because it unleashed a virtually inexhaustible stream of damaging allegations at a time in California when parties were required to prove "grounds" for divorce, including cruelty, adultery, etc., rather than the now-applicable no-fault standard, making these areas of inquiry largely irrelevant.

D. Scenario Number Two: The Aggrieved Plaintiff/Composer

The plaintiff in this scenario is a renowned composer of Broadway musicals. Audiences attending his musicals, virtually without exception, leave the theater humming or singing hit tunes from the show. He has won several Tony Awards,

and recordings of individual songs from his musicals have sold in the hundreds of thousands. Unlike many copyright claims, this claim is based on allegations that the defendant copied, but failed to disguise, the obviousness of the theft of twelve measures of a hit song from a smash-hit Broadway musical, including a singable melody, unusual harmonies, and a structure of the cadence ending the twelve-bar phrase at issue.

On cross-examination of the plaintiff, the lawyer for the defendants asks the following question: "Why do you believe that my client's work infringes the song, [title of work], found in your musical?"

Answer: "In the melody I composed, I wrote a harmonic progression, which employed something akin to a tone row used melodically and not in any atonal sense, with harmony that is very traditional. I constructed this melody so that the scene in which it is sung creates an unworldly, almost unrooted atmosphere because that is when and where my heroine and hero meet in a fantasy scene set in heaven. Now I have to also tell you about the music for this love duet which I structured so that, rather than having the hero and heroine sing their lines as solos and then joining in the duet employing traditional harmony in thirds, I have them harmonizing in fourths rather than in thirds. In addition, to underscore the unrooted and tragic quality of the action, I decided that it would be a dialog with one singing a short phrase, the other singing a short phrase, first in a major key, with the response being in the relative minor of that major key. In other words, the heroine and hero would sing in this extended dialog of short Hemingway-like phrases in C major and A minor, respectively. This continues to the conclusion of the scene when they sing together, harmonizing in fourths. That is all contained in the one duet which lasts about fifteen minutes and which, in itself, is lengthy for the typical Broadway song and presented a number of structural problems that I believe I solved.

"I should add that, in the action on stage, the two protagonists follow one another to different points of contact. They would be looking at one another and never touching, which accompanies the music in trying to show the unfortunate gulf between these two people who really love each other, but cannot overcome the emotional distance that has developed between them."

Comment

This is obviously an extreme illustration, which in this fictional hypothetical is played out for demonstration purposes only. In the ordinary course of a trial, no lawyer should ever ask such an open question on cross-examination. There are, however, less disastrous open questions which could cause damage and, of course, should be avoided.

E. Closed Questions

Examples of direct and open questions are set forth in Section VI of Chapter 9, "Discovery." An example of a direct/closed question is the following:

Isn't it correct that, in your musical training at the conservatory, you were taught that a cadence of dominant (five) to tonic (one) is one of the most commonplace in Western tonal music?

The witness should answer "yes." If she or he answers "no," her or his credibility will be seriously damaged by refutational testimony from an opposing expert who can cite authority from musical dictionaries and treatises, and play recorded examples accompanied by charts of numbered notes demonstrating the ubiquity of the dominant to tonic cadence in Western music.

F. Oblique Questions

Please see an example of oblique questions in Chapter 9, Section VI.C.

VII. The Trial: Second Phase

A. Transformation of a Courtroom

The courtroom of Judge Harry L. Hupp of the Federal District Court, Central District of California, the trial judge in *Baxter v. MCA, Inc*., was and is located in the Federal Building in Los Angeles constructed during the Great Depression. It is wood paneled (as is the bench area) with the judge's bench elevated in front of a marbled background. The American flag is to the judge's right when he or she is seated. The jury box (also wood paneled) is to the judge's left; counsel for the plaintiff sit at a table closest to the jury, while the defense table—parallel to the plaintiff—is farther from the jury box. Between these two tables is the lectern (wood paneled, of course) facing the judge's bench. The court clerk sits at the front of the courtroom just below the judge. The bailiff and court reporter sit on either side of the court clerk, but removed from the clerk by approximately six feet on each side. The judge's law clerks sit at a polished wooden table to the judge's right approximately twenty feet removed from the bench. It is a setting both formal and solemn.

Although the physical structure of the courtroom obviously remained intact, it was changed to accommodate the requirements of a music infringement trial. Since much of the demonstrative evidence was aural, equipment to play audio tapes for the jury was installed at both counsel tables. A spinet (a small upright) piano was placed in front of the court clerk for the experts and the parties to demonstrate with musical examples as they explained how

the two works were created, and to play standard musical materials and sections of prior art to explain their testimony.

B. The Plaintiff's Experts and Their Testimony

1. Cross-Examination Designed to Elicit Answers Favoring the Adverse (Cross-Examining) Party

Plaintiff presented testimony from two experts in his efforts to prove that portions of the "*E.T.* Theme" similar to those in "Joy" were his original expression. It appeared that plaintiff was contending that the six notes (G-F-E-D-E-C or 5-4-3-2-3-1), which were identical to "Joy" in pitch but not duration, had been copied. Plaintiff also argued that the contours of two bars (twelve notes or eight notes)[19] containing those notes, plus others, had been copied. The "infringed" original may also have been a "turn" (F-E-D-E) contained within the six-note motif or fragment.[20]

One of plaintiff's experts first testified, in an attempt to prove "striking similarity"[21] between the two works, that Williams could not have written the G-F-E-D-E-C without having copied those notes from Baxter's "Joy." In invoking "striking similarity" to prove copying, plaintiff has the burden of ruling out the possibility that the similarities occurred because of other factors (e.g., the notes at issue are found in prior art, raising the probability that both composers found these notes from the same source; the passage is a commonplace building block of music; the appearance of these notes in both compositions is a musical *scène à faire;* etc.). Under cross-examination, however, he testified as follows:[22]

BY MR. RUTTENBERG:[23]

Q. In looking at your six criteria, going through the 8th note[s] F-E-D-E, that's something that appears in many other works; correct?

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19. During the course of this litigation, plaintiff's positions changed with respect to the extent of alleged copying.
20. *See, supra*, note 11 and accompanying text.
21. *See* Selle v. Gibb, 741 F.2d 896, 901–02 (7th Cir. 1984) (explaining that evidence of "striking similarity" of the works can be used to raise an inference of access to prove copying).
22. This testimony, as well as all other testimony set forth throughout this Chapter from the trial for *Baxter v. MCA, Inc.,* is excerpted from the official trial transcript for *Baxter v. MCA, Inc*., No. CV 83-7081 HLH (C.D. Cal. 1988).
23. This cross-examination of plaintiff's expert was conducted by Edward A. Ruttenberg. Mr. Ruttenberg and Louis P. Petrich were co-counsel representing defendants MCA, Inc., Universal City Studios, Music Corp. of America, MCA Records, Inc. and Merchandising Corporation of America.

A. In isolation by itself, yes.
Q. It's not an uncommon device. It appears in many works, correct?
A. It's a common enough device. Not real common.
Q. The appearance of six consecutive pitches, G-F-E-T [*sic*: D] -E-C that occurs in many works; correct?
A. If you didn't have any criteria other than the pitches you can probably find them, yes.
Q. And eight-bar phrases, symmetrical eight bar phrases occur in many works?
A. If that's all you are looking for.

The same expert witness underscores this testimony in response to the following questions on cross-examination:

Q. With regard to the harmonic sequencing or the sequencing in bars 9 through 12 of "E.T." you're sure that there are many other pieces that also sequence in that fashion, aren't you?
A. I'm not quite sure how you mean. Could we rephrase the question? Do you mean do bars 9 and 10 and then what happens in bars 11 and 12, is that kind of up a step essentially, sequence a common kind of sequence. Is that the question?
Q. Yes.
A. Yes. That's common enough a harmonic sequence there that goes up a step.
Q. Done in many works?
A. Yes, I would think so.

. . .

Q. So if it contained the definition that I just gave you, you—

THE COURT: Counsel, don't ask an argumentative question.
BY MR. RUTTENBERG:

Q. Turns have been used for hundreds of years, have they not?
A. The figure, the notation figure itself goes back to the earlier years of the 17th century. So we're past the century of it, that's correct.
Q. Going back to before the time of Bach, is that correct?
A. That's correct.
Q. Regardless of whether the four 8th notes in these two compositions, "Joy" and "E.T.", are called by you a turn or not, if that were the only similarity that you found in these two works it would not be sufficient in your mind, would it, to conclude that these works were similar in any substantial fashion?
A. That's correct.

. . .

Q. The appearance of six consecutive pitches, G-F-E-T [*sic*: D] -E-C, that occurs in many works; correct?

A. If you didn't have any criteria other than the pitches you can probably find them, yes.
Q. And eight-bar phrases, symmetrical eight bar phrases occur in many works?
A. If that's all you are looking for.

Comment

Even though the witness hedged and qualified some of his answers in an effort to lessen the impact of a "yes" answer, this testimony is centered on the succession of pitches at issue, which are not protected by copyright.[24] Thus, even though the plaintiff is trying to prove actionable copying, when the musical materials are stripped of contentions and argument, it is clear that the motif (or fragment) forming the basis of plaintiff's claim is an unprotectable musical building block. To have answered the questions any differently would have been without any support musicologically and seriously damaged the expert witness's credibility.

2. Cross-Examination Calculated to Prove Independent Creation of the "*E.T.* Theme"

The second of plaintiff's experts, after testifying that, if Williams could win an Academy Award®, then anyone could, provided this testimony during cross-examination:

BY MR. ROSEN:[25]

Q. In your preparation for rendering your report, did you examine any discourse from Mr. Williams' works?
A. At what point in my preparation, Mr. Rosen?
Q. Before you rendered your opinion.
A. No.
Q. Do you know that he's written a symphony?
A. Yes.
Q. A violin concerto?
A. I have his biography right in my notes. I'm aware of the many serious compositions that Mr. Williams wrote.

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24. *See* Hirsch v. Paramount Pictures, Inc., 17 F. Supp. 816, 817 (S.D. Cal. 1937) (in explaining the lack of originality in the musical pattern at issue, the court noted that "[s]imilarity of tone succession. . . is, to a certain degree, inevitable in all musical compositions, because of the limits of the chromatic scale").
25. This cross-examination of the second of plaintiff's experts was conducted by this book's author, who represented defendant John Williams.

Q. And a flute concerto?
A. I couldn't list off. I believe he wrote a tuba concerto, I believe he wrote a woodwind concerto, if I recall, I'm sure he wrote things from the piano. I don't recall all the classical works that Mr. Williams has written. I haven't been privileged to hear all of it.

Counsel then cross-examined this expert on his deposition testimony:

MR. ROSEN:

Q. Do you think that the "Star Wars" theme and the "E.T." theme sounds different from one another?
A. I think to a layman they would, yes. To me they sound like each other.
Q. You think Mr. Williams was kind of repeating himself when he wrote the "E.T." theme after the "Star Wars" theme?
A. I never tell a lie, Mr. Rosen. Yes, I do.
Q. Many composers do repeat themselves, don't they?
A. Yes, but not with quite such banal material.
Q. You consider Mr. Williams' material to be banal?
A. I consider the "Star Wars" theme to be banal, yes.
Q. Why?
A. Well, because again, this is again—I'm speaking now as a sophisticated composer, not like a layman. I don't have a layman's ear. I can surmise what the layman will hear, that's why I've been able to write hit songs. But the way I hear it is kind of corny.
Q. Banal?
A. Kind of corny.
Q. Why did you use the word banal?
A. I think corny is a better word. I would rewrite what I said as corny rather than banal.
Q. Common?
A. No, I can't say common.
Q. Cheap?
A. No, I can't say cheap.
Q. Why not?
A. Because it's not cheap.

BY MR. ROSEN:

Q. Now, when you use the word "banal," that means commonplace, right?
A. Yes.
Q. Contrite [sic: trite]?
A Yes.

Comment

This witness alluded to the probability that Mr. Williams did not copy from Mr. Baxter, but rather like many composers, has "musical signatures" (i.e., favorite motifs, phrases, etc.) that he repeats, in this case, testifying that the "*E.T.* Theme" repeats notes appearing in the *Star Wars* title theme, both of which were composed by John Williams. This is correct, except that, in the *Star Wars* theme, the "E" is not repeated in the turn and the remainder of the motif goes up an octave. In addition, the context, spirit, tempo, meter, and harmony are different from that in the "*E.T.* Theme."

3. A Musicological *Scène à Faire*

This witness then testified that it was easy to win an Academy Award because of the simplicity of the materials John Williams employed:

Q. And you consider it to be easy to win an Academy Award?
A. Well, Mr. Rosen I have to answer your question more fully before I feel it would be fair for me to go on.
Q. Well, perhaps you can answer the question first, with the court's permission, and then explain it?
A. Okay. May I have that question again, please?
Q. Do you consider it to be easy to win an Academy Award?
A. I have to answer that question in a serious way, Mr. Rosen, because I take the question as a serious question. In my class at that time, I was showing how "Star Wars," "Born Free" and the thing that Vanjelis [*sic*: Vangelis] wrote, "Chariots of Fire" were basically all—basically all the same musical sort of an idea. And, in fact, what I did with the class was I played them all simultaneously, all three of these themes, and they went together.

. . .

Q. All right. And would you describe for us, once again, what the composers were using?
A. Yes. Basically, the composers were using very similar—type melody with exactly the same chords.
Now—Your Honor, must refresh, if I may, what a chord is here.

THE COURT: Go ahead.
THE WITNESS: A chord is what you play in your left hand [playing piano at tape #200]. So put harmony to a melody. Let's say a composer has written a melody [playing piano at tape #208].

Well, many of us could play that. I could teach people to play that. But it wouldn't sound right, because it needs something else. It needs accord [*sic:* a chord], and here's what accord [*sic*: a chord] is. It's when your left hand plays three notes at the same time, or four notes. Usually three. [Playing piano at tape #225.] That's a chord. And a chord very often gives a pleasing quality to the

sound of a melody. And so all these examples are built on the same chord, namely C [playing piano at tape #236] going to F, going back to C.

The melodies are built, using a certain formula. The formula is this: There are two notes that go (playing piano at tape #248), or they go like this [playing piano at tape #248], or they go like this [playing piano at tape #253]. They always seem to he [*sic*] hanging around C and G, these two notes [playing piano at tape #259].

And then, that is harmonized with a C chord [playing piano at tape #266], or, the case of "Star Wars," [playing piano at tape #268], or, the case of "Chariots of Fire," [playing piano at tape #272].

Q. What is the last one you played?
A. [playing piano at tape #278]. I'm not sure whether it's a C or an E, Mr. Rosen. I have to see the sheet music.
Q. In "Chariots of Fire"?
A. Yes. It's either a C or an E, it can be a C—
Q. Would you try C F G A G E?
A. C F [playing piano at tape #297]. Is that it?
Q. E?
A. Yeah, it could be that. It could be. It also could be this [playing piano at tape #303]. It could be. I'm not sure which it is.

But in any event, the formula really is the same. It's this chord going to this chord and back to this chord [playing piano at tape #314], and it's notes [playing piano at tape #317], it's always notes outlining c-triad, and going to three other notes outlining the F chord in between the melody. That is, in the case of "Star Wars," it's [playing piano at tape #329], in the case of "Born Free" it's [playing piano at tape #332], [playing piano at tape #334].

I think that anybody can hear. But basically they are following a formula.

Q. What is it in the case of "E.T."?
A. Totally different.
Q. Show us.
A. Sure. [Playing piano at tape #346].

Now, you will notice, ladies and gentlemen, that there is not this progression [playing piano at tape #351]. Now, I'm aware that the sheet music says F over G in that key spot, but it is not the case.

Q. That would indicate a progression?
A. Yes, the F over the G doesn't exist in the "E.T." Theme. That's a mistake on the part of whoever transcribed it on the sheet music.
Q. I think it was a term that was used here. I'm not sure we defined it. C–triad?
A. Yes.
Q. Would you tell us what that is?

THE COURT: What was that term again?
MR. ROSEN: C-triad.
THE COURT: T-R-I-A-D?
MR. ROSEN: Yes.
THE COURT: Go ahead.
THE WITNESS: A C–triad is this chord [playing piano at tape #391]. Again, it [*sic*] you were to take piano lessens [*sic*], it's the first chord you use. It's the first chord in music, it's the simplest one. I dare say anyone in this room, if ever read a note of music, could sit down in two or three minutes, play a C–triad. Very easy to teach someone to do that, and the notes are C G E [playing piano at tape #413.] I'm sure many people have tried the C–triad.

Q. The "E.T." Theme is based on the C–triad, isn't it?
A. Yes, it is.
Q. Did you undertake any review?
A. Yes.
Q. And could you just briefly describe that review.
A. Yes. I thought about it in my mind the way Dr. Winter did. I've been a musician all my life so I know a lot of themes, a lot of tunes and I had a couple of hints, and I thought about it. I did not make an encyclopedic search for this theme. I didn't think that at that time it was necessary.
Q. In that review and in your general knowledge of music—
A. Yes.
Q. —can you think of examples of where we might find just the announcement part of "Joy" and "E.T." this upward motion.
A. There were endless, there were endless examples of a C going to a G or three D's going to a G as here. There are endless examples. And, you know, I don't know if I can think of any now, but with any kind of time one could think of, you know.
Q. But that—
A. Things that start out of DE, DUM [witness singing].
Q. —that portion. The announcement portion, is common you would say?
A. Extremely.
Q. Now, what about the middle portion. The transitional phrase. The four eighth notes which we sometimes call a turn figure?
A. Right. Well, I tried to express before my belief that these four notes do not constitute a turn. Because if they did, then we would say well. We have the precedent prior art of these four notes in hundreds and hundreds of pieces in the classical error [*sic*: era] I don't recognize that. However, if you say to me: Are there compositions where these four notes are used in a melodic way similar to this, I would say yes, there are probably quite a number of compositions where the turn is used. And again with using the word "turn" in quotes.
Q. That's because it's not an ornament?
A. I don't believe it's really a turn, right.

Q. Are there a number of instances where we might find what you would term the fanfare-like conclusion, this downward motion of the last two notes this theme song?
A. I would assume, as I think anybody who knew any music, that the note C going to the G below it occurs thousands of times in every century. And that would be a vast understatement.

Comment

The witness has quite literally testified that, in his opinion, portions of two other motion picture scores for *Born Free* and *Chariots of Fire*, along with the "*E.T.* Theme," are based on a *formula* using variants of a C major triad. Obviously, if these works are based on a formula—such as breaking a C major triad into its component parts (C-E-G)—we are dealing with an unprotectable building block of music, as are the three pitches standing alone. He is also advancing the opinion (apparently without intending to weaken the plaintiff's case) that if Williams copied anything he "copied" from himself. Lastly, he is literally expressing the opinion that all three composers (of *Born Free*, *Chariots of Fire*, and *E.T.*) are using unprotectable building blocks of music available to all composers.

C. The Plaintiff's Testimony

1. Direct Examination[26]

As noted above, the objective of direct examination is to provide an account of the facts upon which the party's case is based in a coherent and interesting fashion. In other words, the facts should be told as a story that grabs the interest of the trier of fact early in the direct examination. When a party (as distinguished from third-party witnesses) is the witness, direct examination also serves to introduce that party to the judge and jury. These were the likely aims of plaintiff and his counsel. To a large measure they succeeded, as the following extract from the transcript demonstrates:

a. Background and Experience[27]

BY MR. BLANCHARD:

Q. Mr. Baxter, you are the plaintiff in this action. What's your occupation?

26. Direct examination is by Baxter's lawyer, John T. Blanchard.
27. These descriptive titles are not part of the transcript of trial proceedings, but rather the author's attempt to organize (in outline form) and highlight the areas of examination.

A. Music.
Q. Have any of your compositions been published?
A. Yes.
Q. How many albums of your work have been published?
A. About 50.
Q. And how many singles?
A. Pardon me?
Q. How many singles?
A. That I've written?
Q. Yes.
A. I don't know.
Q. Can you give me your best estimate?
A. Pardon me?
Q. Give me your best estimate.
A. I've never counted them or thought how many singles I've had published.
Q. Have you ever done a motion picture score?
A. Yes.
Q. About how many of those?
A. Something over a hundred and twenty.
Q. How old are you?
A. 66.
Shame on you.
Q. When did you first get into the music business in Los Angeles?
A. Professionally?
Q. Yes.
A. When I was in my teens.
Q. And was that orchestrating and arranging other people's material?
A. No, I think I started out playing instruments.
Q. And singing?
A. And singing.
Q. Were you with a singing group?
A. Yes.
Q. What was the name of that group?
A. "Mel Torme and the Meltones."
Q. You were one of the Meltones?
A. Yes.
Q. When did you first compose—let me take that back. When did you first begin composing, orchestrating or arranging as opposed to just performing music?
A. Playing with dance bands. I wrote and arranged for the bands I was playing with.
Q. You were arranging other people's music at that time?
A. And my own.

b. "Joy" and *The Passions*

Q. In or about 1953, did you compose seven songs which became "The Passions" record album?
A. Yes, in -— I'm not good at dates.
Q. "Joy" was one of the songs on "Passions"?
A. Yes.
Q. Have you ever performed at the Hollywood Bowl?
A. Yes.

MR. BLANCHARD: Your Honor, counsel have also reached a stipulation as to the first of those Hollywood Bowl concerts. If we could read that into the record now.
THE COURT: All right. . . .

. . .

MR. BLANCHARD: The stipulation is that on Saturday, August 27, 1955, plaintiff, Les Baxter, appeared in concert as a guest conductor at the Hollywood Bowl and conducted his works "Quiet Village" from his album "Le Sacre du Sauvage" and "Rio" and "Havannah" from his album "Tamboo."
THE COURT: The Reporter who diligently researched ahead of time already has it.
Sorry for the interruption.
MR. BLANCHARD: No problem. Plaintiff's work "Joy" from his album "The Passions" was not performed at the 1955 concert.

. . .

BY MR. BLANCHARD:

Q. How many times did you perform at the Hollywood Bowl?
A. Well, we know of three. I've told you that I did other concerts there.
Q. Of the three that you specifically recall, were there programs for all three?
A. No.

. . .

BY MR. BLANCHARD:

Q. Other than the program that we have just marked for the 1955 Hollywood Bowl concert, were there programs handed out at the door elsewhere for either of the other two shows at the Hollywood Bowl?
A. No, there were not.
Q. Was one of these concerts at the Hollywood Bowl after the 1955 program with Johnny Green, one where you played the piano and conducted the orchestra from the piano?
A. Yes.
Q. What kinds of material did you play at that concert?
A. I played all of the heavy-weight, popular material of the day that would adapt to a big orchestra.

Q. Can you give us a few examples?
A. "Exodus," "Hava Nagila," "Never on Sunday," "Autumn Leaves." I'd go through it if you want me to.
Q. That's enough. I just wanted a sample.
Did anyone else appear on the concert program with you, by that I mean not necessarily on stage, but at the same time you were on stage, but some other performers?
A. Yes, the Kingston Trio shared the concert.
Q. About when did that concert take place to the best of your recollection?
A. I don't remember.
Q. Did you ever hear "Joy" played on the radio here in Los Angeles?
A. Yes.
Q. Can you give me an estimate of how many times?
A. No, I couldn't.
Q. More than once?
A. Oh, yes.

c. Acquaintance with Williams: Contention that Williams Played the Piano Part in "Joy"

Q. Are you personally acquainted with the defendant John Williams?
A. Yes.
Q. How did you first become acquainted with him?
A. As a piano player.
Q. Was he working for you?
A. Yes.
Q. At a live performance or on record days?
A. Record days.
Q. Could you describe for us the difference between a conference performing slide [*sic*: a concert performed live] and a record date?
A. A record date, they are recordings, recordings to be played on the air and sold in stores, and a concert is a live performance.
Q. Now, it's already been agreed that between mid-1957 and early 1959, you used Mr. Williams' services as a pianist 11 times.
Do you recall which albums you were recording at that time?
A. No, I don't remember.
Q. Do you recall whether you used any other piano player during that period of time, approximately 18, 19 months?
A. During the time that I used John on the piano, I tried to get him every time. There may have been a time when he was unavailable and I used someone else, but it was a pretty steady stream.
Q. Was "Joy" ever performed at a concert at the Hollywood Bowl?
A. Yes.

Q. Do you know whether Mr. Williams was a part of that performance, live at the Hollywood Bowl?
A. Yes.
Q. How can you be certain that "Joy" was played at that concert?
A. Well, I wouldn't forget that.
Q. Why—You had a great many concerts and you played a great many pieces of music. Why do you remember "Joy" being played?
A. I only had certain pieces that were orchestrated through large orchestra, and I had to make do with what I had and it was one of the best pieces to play live.
Q. Was that because of its feeling, its mood?
A. Yes, the other pieces on the album are not suitable really.
Q. At that concert where Mr. Williams played "Joy," did you also play "Quiet Village"?
A. Yes.
Q. How do you recall that you probably played "Quiet Village"?
A. I always played "Quiet Village." I had it orchestrated for a large orchestra on purpose.
Q. Was "Quiet Village" your biggest hit?
A. Yes.
Q. Was "Joy" reorchestrated for the Hollywood Bowl concert?
A. Yes.
Q. Who did that?
A. Paul Daniels did that.
Q. Was there a vocalist who sang at the Hollywood Bowl?
A. For me or during—
Q. Yes. We heard the 1953 record album. There is a soloist there, a singer.
A. Not on my cases [*sic*: concerts].
Q. Who—which instruments then took the vocal line?
A. Well, there was several. I had the put—I orchestrate, I don't just give it all to one instrument. Some of it to piano, some to flute, some to piano, harp and bells was more orchestration, is more my style.
Q. Did you consider "Joy" to be a difficult piano part?
A. Well, it's not an easy one.
Q. Compared to what?
A. An easy piano part is the piano part in a dance band where the piano is just given chord symbols a lot of times. Or, if it's written out, it's just playing chords. It's not a written piano part as in concert. Whereas "Joy" is a written piano part as in a concert piece, read specific phrases and so forth.

. . .

Q. Why do you remember—well, let me just go at it a different way. [H]ow do you usually—I got a whole bunch of false starts here. Let me— let me collect myself and start this over.

Did you have a rehearsal for the Hollywood Bowl performance?

A. Yes.

Q. Have you had a number of other concerts both at the Hollywood Bowl and elsewhere?

A. Yes.

Q. Do you take breaks during those rehearsals?

A. Yes.

Q. In those instances when you've been the composer—excuse me, the conductor, how do you signal the orchestra to come back from break?

A. Well, I use the interval from "Joy" for one specific reason, that [sic] the thing that's used most, I have to either sing or play it, is dum-da-da-dum-dum, which I really dislike.

[Play tape at 1419].

Q. That's the way everybody brings the orchestra back.

Q. And what figure musically did you play? I take it you played it on the piano?

A. No, sir. I can play it on the piano. Why I—I played it on the piano.

Q. Which figure to [sic] you play or would you like to play it now?

A. What do you want me to do?

Q. How about you play it?

A. [Complies.]

[Play tape at # 1455.]

THE WITNESS: I don't like [playing piano]. I would play it a number of ways, and it was usually [playing piano at tape #1463], or [play tape at #1461.] Once again, [play tape at #1471].

Just to relax people and be a little funny, I might do it [playing piano at tape #1481].

But in general, that with variations is what I would do. This is usual [play tape at #1490].

Q. Are you certain that "Joy" was reorchestrated for this performance at the Hollywood Bowl?

A. Absolutely.

MR. ROSEN: Objection, the question is leading.

THE COURT: All right. Sustained. Restate it. The answer will be stricken.

Q. Did you give Mr. Daniels instructions regarding the reorchestration of "Joy" for the Hollywood Bowl?

A. Yes, I wanted to be able to play it. A couple of other pieces that I played—when I performed live at concerts and at the Paramount Theater in New York, for example, I would take the original instrument and put it on piano so that I would be on piano all the time.

Q. And did you put the entire vocal line from "Joy" in the piano?
A. No.
Q. Was at least a part of it in piano?
A. Some of it.
Q. After "Joy" was released, did you use these musical figures that you just played for us, did you use them to recall the orchestra at all your concerts or just this one?
A. I use it all the time.
Q. Other than using that figure derived from "Joy's" B theme as your recall from orchestra breaks, do you have any other reason to remember that "Joy" was played at the Hollywood Bowl?
A. I don't know. I just wouldn't forget that.
Q. Well, we have to be more specific than that.
A. I—
Q. Give us the reasons why you remember "Joy" was played at the Hollywood Bowl?
A. It's the best big orchestra piece that I have. I mean, I would play it still if I had the parts.
Q. Is there any other reason you remember it?
A. I don't know.

. . .

Q. What I'm driving at, something very, very simple and obvious. Don't look for anything complex. [L]et's go onto another area.
Why do you remember Mr. Williams played the piano at that concert?
A. Because one has a tendency to stick with who they call their piano player at the time. Every bandleader does that or orchestra leader, whomever, you have favorites that always play with you. I always had Felix Slatkin on concert as my concert master, and there were other marvelous violinists at the section. Like the first violinist for the L.A. Philharmonic, but he sat in the back row.
I had Felix Slatkin, I had favorites. Drummers particular. That piano and the drummer were the ones I always asked for.
Q. Do you have any particular about why Mr. Williams' services for this particular concert at the Hollywood Bowl where "Joy" was played?
A. Well, I asked for him and my contractor said that he couldn't play it. And I said it's important that I have him. We asked again. And again he said that he couldn't do it. And I understand perfectly, and I said please tell him how important it is to me and asked him a third time, and the third time he agreed.
Q. Was it difficult requiring Mr. Williams' services that made you recall him?
A. Well he refused two times and I wanted very much, and he did agree on the third occasion to play the concert.
Q. Was Mr. Williams a good piano player?
A. Pardon me?

Q. Was Mr. Williams a good piano player?
A. The best.
Q. Did Mr. Williams play at the concert where the Kingston Trio were on the bill with you?
A. No, I played the piano on everything, at every piece, I had redone for piano that was not a piano solo, so that I was at the piano constantly.
Q. At the Kingston Trio concert?
A. Yes. At the Hollywood Bowl concert where "Joy" was played and I wanted Mr. Williams for that, I also wanted him for "Quiet Village." I mean, I wanted it played right, and there are more reasons that I needed a good piano player.

2. Cross-Examination of Baxter[28]

a. Setting the Stage: A Memory Test (Part One)

Based on Baxter's answers on direct examination and his deposition testimony during which he related events that occurred in the mid- to late 1950s, it was logical to ask questions probing the reliability of his memory. These questions are either direct questions or "closed questions," as defined earlier in this Chapter.

BY MR. ROSEN:

Q. Mr. Baxter —
A. Yes.
Q. —at the time the album "Passions" was recorded, how long did it take to record it?
A. I don't remember that. Usually it takes three sessions, but I don't know how many this album took.
Q. That was one time, at least, where the music was actually played by live musicians, wasn't it?
A. Yes, for the recording, yes.
Q. At the John Green concert, do you recall at the time of your deposition you didn't recall the names of any of the soloists that played at that concert?
A. Would you speak a little louder.
Q. Do you recall that at the time your deposition was taken on April 13th, 1983, you did not recall the name of any soloist who played on the John Green concert.?
A. I could guess—

. . .

28. Cross-examination by the author.

THE WITNESS: The John Green concert was not my choice of musicians, a guest conductor.
BY MR. ROSEN:

Q. At the time—

THE COURT: The question was, back when the deposition was taken, about six months ago, could you recall who the soloist [*sic*] were?
THE WITNESS: Oh, the soloist. Beg your pardon.
No, I did not.
BY MR. ROSEN:

Q. At this time you could not?
A. I did not remember the soloist.
Q. And you did not remember any of the members of your orchestra, did you?
A. No, I didn't.
Q. And you did not remember the name of the concert master?
A. No, I did not remember who the concert master was at that concert. It wasn't my concert master.
Q. And after 30 years, your dates are a little bit dim, aren't they, and mixed up?
A. They are very dim.
Q. When you first met Mr. Williams, he had not gained any notoriety as a composer, conductor, had he?
A. Only as a pianist that I knew of.
Q. He was young and just starting out, isn't that correct?
A. I don't know.
Q. He was your new canonist [*sic*: pianist]—
A. He was recommended. I used only the best people. So he was not just starting out.
Q. Incidentally, on this concert where you say "Joy" was played, what was the date of that concert?
A. I have no idea.
Q. You had another concert in which you played heavy-weight classics, I think you said, or heavy-weight popular pieces?
A. Uh-huh.
Q. Yes?

THE COURT: Is that a yes?
THE WITNESS: Yes, I beg your pardon.
BY MR. ROSEN:

Q. Did the "Joy" concert take place after that second concert?
A. I think before.
Q. Did it take place after the Green concert?
A. I think so, yes.

Q. You don't have any idea of any of the other compositions that were played on that concert other than "Quiet Village." That is the additional concert between the Green concert and the one where you played the popular pieces.
A I can only surmise.
Q. You don't recall?
A. Probably. I can't remember definitely, but I can think what I probably would have played because I have a limited number of pieces written for a big orchestra.
Q. It's what you probably would have played?
A. What I probably would have played, yes.
Q. During this "Joy" concert which you claim took place, did Mr. Williams play any other instrument at that concert to your recollection?
A. Only piano with the possibility of cellist at the side of the piano.
Q. Anything else?
A. No.
Q. In the past you stated that John Williams couldn't play at the John Green concert, is that correct?
A. Yes, he says not, and I trust his memory on this. I feel that he could have, but I don't remember exactly.
Q. Did he play on all three concerts that you are talking about?
A. He would not have played the one where I played the piano all the way through myself.
Q. Isn't it a fact that you testified you don't know whether he played on the first concert?
A. The John—
Q. —or on the so-called "Joy" concert?
A. That's two questions? The first concert is the John Green concert?
Q. Yes.
A. No, I don't know whether he played that. I said that maybe he could have. I would have liked for him to.
Q. Now, on the first concert, the John Green concert—
A. Yes.
Q. —are you sure that you played "Quiet Village"?
A. Yes. I'm fairly certain I did.
Q. And on the third concert, are you sure that you played "Quiet Village," what we call the third concert—
A. Yes.
Q. —which is the one where you soloed it for the piano?
A. I'm absolutely sure.

Comment

Baxter, by his answers, has demonstrated that his memory is a bit dim and more likely reconstructed based on what he believed to be practices that were

followed in the 1950s and events that should or must have happened, as distinguished from those that actually took place.

b. Williams's Lack of Access to "Joy" (Part One)

Q. Now, sir, isn't your recollection that Mr. Williams played for you at the Hollywood Bowl based upon your assumption that he was familiar with "Joy" because he played on "The Passions" album?
A. No, no.
Q. Would you please get your deposition. Would someone hand the witness a deposition?

. . .

BY MR. ROSEN:

Q. Let me read this to you, Mr. Baxter.

"Q. At this time do you have any specific recollection that Mr. Williams played on "The Passions" album?
"A. No, I have an assumption.
"Q. On what do you base that assumption?
"A. Because of the reason that I wanted him to play the Hollywood Bowl concert in that he was familiar with the piece.
"Q. You believe he was familiar with the piece from having performed it on "The Passions" album?
"A. Yes, that's my assumption."

That was your testimony when you gave your deposition.

A. Yes.
Q. Isn't it true that you base your whole assumption by Mr. Williams having played at the Hollywood Bowl based on your further assumption that he played on "The Passions" album as you stated in your deposition?
A. No.

THE WITNESS: No.

. . .

BY MR. ROSEN:

Q. Isn't it true that at the time you claim you hired Mr. Williams, you did so because you thought he already knew the piece, "Joy" from the "Passions" album?
A. It was an assumption. I have other assumptions that I can give you that are possibilities also.
Q. Is it including an assumption that the concert even took place?
A. The concert took place. I think Mr. Williams remembers that.

MR. ROSEN: I move to strike the latter part—
THE COURT: The latter part of the answer will go out.
BY MR. ROSEN:

Q. There's no doubt—

THE COURT: What counsel is asking you, of course, iyour own recollection. Go ahead.
BY MR. ROSEN:

Q. There's no doubt that you gave the answers to the questions that were posed to you that I just read at the taking of your deposition—
A. Ask me what you want to ask me.
Q. I just asked you a question.
A. I didn't understand it.
Q. You gave that testimony at your deposition which I just read to you, did you not?
A. Oh, yeah. Yes.
Q. And I ask you again:
At the time you gave this answer, you were telling us that you thought Mr. Williams played at Hollywood Bowl because of your assumption that he played in the "Passions" album, isn't that correct, sir?
A. That was an assumption, yes.
Q. You have since found out that Mr. Williams was in the armed services nowhere near that recording studio when "The Passions" album was recorded, isn't that a fact, sir?
A. That's correct.
Q. And, therefore, you changed your testimony, isn't that a fact, sir?
A. I don't think I changed my testimony.
Q. Do you disavow this assumption that you made in your deposition?
A. No.
Q. Didn't you base your assumption that Mr. Williams played at the Bowl on the fact that you believed that he knew the piano part to "Joy" already?
A. The words are in the wrong order. That was an assumption of what might have happened. It was very logical to me. I can give you another possibility if you wish.
Q. I haven't asked that question yet.
A. All right.
Q. I'd like you to answer this—

MR. BLANCHARD: Shouldn't he be allowed to finish his answer, Your Honor?
THE WITNESS: I answered it—
THE COURT: Yes, it started to go off in other assumptions.

Let me explain, Mr. Baxter, that we want to be careful about assumptions. What we are trying to get at is how much you remember and how much you

don't. So try to distinguish in your own mind in between what you can recall and what you have *reconstructed* from other items. [Emphasis added].

Comment

This testimony was designed (1) to demonstrate that Baxter took a firm position that Williams was at the 1954 recording session of *The Passions* at a time when Williams was actually stationed in Greenland with the U.S. Air Force, and (2) to prove that he changed his position in answer to written interrogatories claiming under oath that Williams was the pianist at a Hollywood Bowl concert conducted by Baxter, in 1967 or 1968, thus setting up the fact that Williams was not performing as an orchestral pianist in those years. (See subparagraph G, *infra*.)

c. A Memory Test (Part Two): Baxter's Failure to Remember Personnel at Concerts between 1954 and 1967

BY MR. ROSEN:

Q. I'd like to read from the witness' deposition, on Page 141. Actually, it begins at Page 140.

. . .

THE COURT:—you may read those excerpts.
BY MR. ROSEN:

Q. This is your testimony:

"Q. And who are the pianists at the other two concerts?
"A. I don't remember the pianist on John Green—Johnny Green concert, but the other concert was John Williams and—
"Q. How do you remember that it's John Williams on the one concert?
"A. Because he was working for me at that time as my pianist and at the tail end the last thing he did for me, the reason it's so memorable. Obviously he had to—he had gotten work programs in a motion picture somewhere.
Shall I elaborate?
"Q. Yes, that's fine.
"A. I asked for John because I liked his playing. He worked my record dates and I wanted him to do the Hollywood Bowl with me and he refused. So I told the contractor, who I believe was Jack, if Gruberman—either Dave Klein or Jack Gruberman, but I really wanted John and he refused again. Very definitely memorable.

"I asked a third time and I insisted, and I said tell him I won't have anyone else. I won't play without him. And reluctantly, very reluctantly, he came and played my concert.

"And I understand now why he didn't want to, but—

"Q. Which is why, why do you understand?

"A. I think he was acquiring a career of his own and he didn't want to sit back there in the back of the orchestra. He said, 'les,' in quotes, "'les can get anyone to do that,'" unquote, didn't want to sit in the back of orchestra and play piano for me, but I wanted him because I knew he could play it, he knew the music.

"Q. Knew the music.

"A. "Joy," for one.

"Q. Other than "Joy"?

"A. I played some tough things. I might have played "Havannah."

"Q. Is that something he wrote?

"A. Yes.

"Q. Anything else?

"A. No, but the reason for wanting John is that "Joy" is a very difficult piano part. It may be that he worked the record date, I don't know. It was the exact period of time, but for some reason, I felt that he knew the part and should play it. And the fact that he refused three times to play the date and I insisted and he showed up and played it and it was difficult stuff. I didn't write simple popular music not even as simple as the other people's composition.

"Q. Is that true of all your compositions?

"A. Yes. Yeah, they are difficult.

"Q. And they are difficult across-the-board as far as all the instruments are concerned?

"A. Yes, yes.

"Q. What makes a piano part so difficult?

"A. I don't know, a lot of notes, difficult finger stretches, difficult fast passages, it was difficult. He wasn't dance band ['Umsha']—try that one, ['Umsha']."

THE COURT: Is that the end of the answer?

MR. ROSEN: Yes.

BY MR. ROSEN:

Q. Isn't it a fact that you base this recollection on Mr. Williams having been at Hollywood Bowl upon your assumption that he knew the music to "Joy"?

A. At the time of the deposition, I assumed that would be a logical reason.

Q. And from that, you worked backwards and concluded that he had been there at that concert?

A. No, I remember him at the concert.

Q. I'm asking you, yes or no?
A. What did you ask me?
Q. Let me ask you this:
Do you have any newspaper clipping of that concert in which "Joy" was supposedly performed?
A. No.
Q. Do you have any other piece of writing that you can give us showing that that concert was actually performed?
A. No.
Q. You don't even know who your concert master was at that concert, do you?
A. No.
Q. Let's talk about concert masters for just a minute.
The concert master is the person who sits in the first violin desk, isn't that a fact?
A. Yes.
Q. Now, that person is a very important element in the orchestra, as far as the conductor is concerned, is he not? I should say, he or she.
A. That would be a wrong assumption where you are going with that. But, yes, he would be an important person to the orchestra.
Q. And that person is in charge of bowing markings for the strings?
A. Yes.
Q. And what else?
A. I don't know.
Q. You don't know?
A. What do you want to know?
Q. What else the concert master does.
A. He sits in the first chair.
Q. He is the leader of the first violin section?
A. Yes.
Q. As a matter of fact, he is the person who's the leader of most of the strings because he controls the bowing markings, doesn't he?
A. Yes.
Q. And you don't remember the name of that person who played any of these concerts, do you?
A. No. I can tell you five.
Q. I didn't ask you that.
A. All right.
Q. Now, the person who's the principal viola, that's the first violist, you don't recall the name of that person either, do you?
A. No.
Q. In this concert—in these concerts, let's say there were three, the pianist other than for the last concert is somebody who's a member of the orchestra, isn't that a fact? Not a soloist?

A. That's not always true.
Q. I'm asking about these concerts?
A. Well, I have to say no. Or, I don't remember what the question was. But I disagree with what you said.
Q. The part that you claim Mr. Williams played wasn't a solo, the supposed concert, and it wasn't even prominent, isn't that a fact, sir?
A. Would you say that again, please. Repeat it. I didn't hear you correctly.
Q. Let me ask it this way: In the original "Joy" score, the piano part is not a solo, is it?
A. There are solo sections, but not all the way through, no.
Q. It's a part of the orchestra, isn't it?
A. Yes.
Q. Let me read your testimony at Page 193 of your deposition.

Comment

It is unlikely that Baxter would not have remembered names of key orchestra musicians with whom he worked on a regular basis at recording and motion picture studios. This was a time in Hollywood when many musicians were not only members of the Los Angeles Philharmonic (which played at the Hollywood Bowl) but also played in studio orchestras and at record dates. The point of the cross-examination was that, if Baxter could not remember other key musicians, he could not in good conscience remember John Williams as the pianist who (1) played "Joy" at a 1954 recording date, from among the many pianists who played studio and recording dates in the 1950s; or (2) who played "Joy" at the Hollywood Bowl in 1967 and 1968, years when Williams was no longer working as a studio/recording musician.

d. Woodwinds, the Phantom Piano Part, and the Missing Orchestra Parts

THE COURT: Are you going to read the section?
MR. ROSEN: I am.
BY MR. ROSEN:

"Q. In the score you have in front of you, Exhibit 101, that is the piano part at the bottom to which you were referring yesterday in your deposition?
"A. Yes.
"Q. Is this the piano part you claim Mr. Williams played in the Hollywood Bowl?
"A. Yes.

"Q. Would you consider this piano part to be prominent in the score?
"A. No more prominent than Stravinsky's use of piano and concert piece. It's part of the orchestration.
"Q. It is not a solo?
"A. It is not a solo."

That's your testimony, isn't it—

A. Yes.
Q. —at the time of your deposition?
A. That's correct.
Q. Now, the testimony you've given here today, you say that the piano part was used to take part of the singer's line?
A. Yes. I think so.
Q. I'd like to invite your attention to Exhibit 101.
If you'll look at the top line, that's the line for the [vocal], is it not?
A. That's correct.
Q. And the piano solo is at the bottom?
A. What do you mean the piano solo?
Q. I mean the piano part is at the bottom?
A. Yes.
Q. And that is the piano part that Mr. Williams played at the Hollywood Bowl, if in fact he played anything at the Hollywood Bowl as you are claiming?
A. There are two statements there. One is incorrect and one is a question.
Q. Well, isn't it a fact that you claimed, at the time your deposition was taken, that Mr. Williams played the part and not a solo?
A. He didn't play a solo but I had a new piano part written that had some of the vocal line in it and it also had some of the flute, harp and bells reorchestrated for it. I wouldn't consider it solo because it becomes an orchestration. An instrumental orchestration isn't a solo for anybody really.

. . .

BY MR. ROSEN:

Q. Tell me, isn't it true that at the time your deposition was taken, you pointed to the bottom line of Exhibit 101 as a part you claim Mr. Williams played?
A. I must have made a mistake. Either that, or I didn't understand your question.
Q. Well, let's read the question again.

"In the score you have in front of you, Exhibit 101, that is a piano part at the bottom to which you referred yesterday in your deposition?

"A. Yes.
"Q. Is this the piano part you claim Mr. Williams played at the Hollywood Bowl?
"A. Yes.

"Q. Would you consider this piano part to be prominent in the score?

"A. No more prominent than Stravinsky's use of piano in the concert piece. It's part of the orchestration.

"Q. It is not a solo?

"A. It is not a solo."

You understood all those questions and answers?

A. Yes. Yes, it's not a solo.

Q. And there's no question that you stated your claim that Mr. Williams played the piano part at your deposition, not a rearrangement of the vocal part.

A. It was a statement, in answer to your question, it was not a claim. And if I were to think about it, I would have corrected it, as I'm doing now, because there were, I felt, some trick questions during the deposition.

Q. You consider those to be—those direct questions to be trick questions, Mr. Baxter?

A. Well, I didn't understand it, apparently.

Q. You understand it now?

A. Yes, I understand it now.

Q. You also understand you had an opportunity to correct your deposition before it was filed?

A. Well, I trust whatever I said and I thought that I could be honest with you. I didn't feel the need to correct anything.

Q. Were you being honest at the time you gave those answers to my questions in the deposition?

A. As I understood your question at the time.

Q. Is there something that has changed between now and the time your deposition was taken that makes my questions more understandable now than they were then?

A. Possibly.

Q. Tell me what.

A. The nature of your questioning at the time and—I don't know, there was something about it. I didn't have a chance to think about it. They came out wrong.

Q. Did you have a chance actually to reconstruct your testimony for the purpose of this trial?

A. No, I wouldn't do that. I don't really see any discrepancy.

. . .

BY MR. ROSEN:

Q. Isn't your better recollection, if you were really to think about it, that "Joy," if it was played at all, was not rearranged for piano but for woodwinds?

A. It was reorchestrated putting the vocal line into the orchestration on several different instruments, no one had a solo. It was an orchestral piece. They were not playing solos.

Q. Weren't those instruments prominent, though, the wind instruments?
A. I don't know what's prominent in the orchestration and what isn't.

MR. ROSEN: I would like to read from Page 147 of the witness' deposition, commencing at Line 11, and going through and inclusive, Page 148, Line 1—I'm sorry, line 7.
THE COURT: All right. Hearing no objection, you may read that excerpt.
BY MR. ROSEN:

"Q. At the Hollywood Bowl, when you testified that you performed "Joy," did Ras [*sic*] Sheva, B-A-S S-H-E-V-A, sing?
"A. No, no.
"Q. Did you have another singer?
"A. Instrument, we went to an instrument.
"Q. What instrument?
"A. Flute, and I think we went over to woodwinds to carry the melody, maybe a French horn here and there.
"Q. What winds?
"A. I thought it was a marvelous instrumental. What woodwinds in—
"Q. Yes.
"A. Flute, maybe English horn, I don't recall, clarinet, and French horn.
"Q. They all took Bas Sheva's place?
"A. Yes, all my favorite instruments.
"Q. Who are the people who played those instruments at that performance?
"A. I would have no memory of any member of that orchestra except perhaps the harpist because she caused a fuss. There has to be a distinctive reason for my remembering."

That was your testimony at the time your deposition was taken. Now, does it refresh your recollection?

THE COURT: Before you do that, counsel, would you spell for the Reporter the name of the vocalist.
MR. ROSEN: The vocalist. Bas—B-A-S S-H-E-V-A.
THE COURT: Thank you. Go ahead.

BY MR. ROSEN:

Q. Your better recollection at the time of the deposition, before you got to this courtroom, was rearranged for woodwinds, not piano?
A. That wasn't a better recollection. I was asked—
Q. Are you telling me—

THE COURT: Wait a minute. Let him finish the answer.
MR. ROSEN: I'm sorry.

THE WITNESS: It was a quick answer to what I thought you wanted to know. And I would have assumed that I would have used certain instruments that I liked. It was, at best, a weak recollection. It's a better recollection when I had time to think about it.

BY MR. ROSEN:

Q. And reconstruct, is that not true, sir?
A. Think about it.
Q. Pardon?
A. Think about it.
Q. And "reconstruct" would he a pretty good word too, wouldn't it?
A. I don't know what you are getting at, but it sounds nasty.
Q. You thought the woodwinds were a marvelous instrumental, didn't you?
A. Yes.
Q. And that was at this concert that you claim took place in Hollywood Bowl?
A. Yes, yes.
Q. Where is the orchestration for that performance?
A. The orchestration is the only orchestration that we have, parts that would be recopied would be only the parts that were needed to redo it. I've done that a number of times. I did it on a song called "Ruby," which was for the harmonica, and I had rewritten for piano. So there would only be one part. The orchestration would be the same thing we originally had.

MR. ROSEN: I move the answer be stricken as non-responsive.
THE COURT: The answer will go out. Pose the question again.

BY MR. ROSEN:

Q. Where is the music for that reorchestration or rearrangement of "Joy" that you claim was played in the Hollywood Bowl?
A. The reorchestration would only involve the parts that were changed, as in "Ruby," where the harmonica part was played on the piano. Nothing else would be changed. This is the original orchestration.

MR. ROSEN: Move to strike the answer as non-responsive.
THE COURT: Well, it's at least peripherally responsive.
The question is: Do you know where the sheet music is for the reorchestration?
THE WITNESS: Well, the orchestra parts—he said orchestration. The orchestra parts—Did I understand your question, Mr. Rosen? You want to know where the piece of paper—where the orchestration is written down?
MR. ROSEN: Yes.
THE COURT: Do you have any of [*sic*] idea at this point?
THE WITNESS: I'm trying to explain that this is the orchestration. We would only copy the melody onto a few orchestra parts. They would be called parts not

orchestration or not score, but parts. That's all we'd have to do over. Everything else would be the same.

BY MR. ROSEN:

Q. You don't have those any more?
A. The orchestra parts? No.
Q. When is the last time you claim to have seen them?
A. It's been many many years.

. . .

THE COURT: For it's purpose, Exhibit 294 is before the witness.
THE WITNESS: Yes, it probes my recollection, and I played it at the Johnny Green concert.

BY MR. ROSEN:

Q. This is a program that was provided to you by the defendants, isn't that correct?
A. By what?
Q. By the defendants, isn't that correct?
A. Yes.
Q. And now you know that "Quiet Village" was played on the first and third concerts?
A. Yes.
Q. And your testimony in the deposition was that you believed it was played on only two out of the three concerts?
A. I believe that was a good guess, yes.
Q. Doesn't that suggest to you, Mr. Baxter, that there was no third concert?
A. Not at all. We know that there was another concert.
Q. You mean you know.
A. Yeah, I know, and I think others know.
Q. Can you give us any approximation of the date of this concert?
A. No.
Q. Would you take a look at Exhibit 101, please?

THE COURT: This is the score of "Joy"?
MR. ROSEN: Well—
THE COURT: This is a score?
MR. ROSEN: This is a score. I'm only using 101, which is the same as score 12, because this is the one we had at the time of Mr. Baxter's deposition.
THE COURT: Go ahead.

. . .

BY MR. ROSEN:

Q. Would you look at the piano part.
A. Yes.

Q. Do you find that piano part to be especially difficult?
A. More so than a dance band piano part. You have to read this. I think it's difficult. There are passages that would have to be played over or looked at before you can sight-read them on a recording, at least for a concert.
Q. Isn't it rather easy for a professional pianist to play this?
A. Nowadays, yes, and for Mr. Williams, yes. They could sight-read it. But it's not an easy part.
Q. You are sure that a professional pianist could play that very easily?
A. Yes.
Q. And there was no reason to need Mr. Williams' special talents at that alleged concert, was there?
A. Yes, he's the person I wanted. I wanted him on eleven other record dates. There were other pianists that were very good, but I wanted him. I was comfortable with him.
Q. But you didn't want him necessarily because the piano part was difficult?
A. That's the reason you want good pianists because you want someone who could play a difficult piano part.
Q. But this piano part is not difficult, is it?
A. I think so, yes.
Q. For a professional pianist?
A. For a good, professional pianist we decided could play it, yes.
Q. You were here when Dr. Winter gave his testimony. I think he said maybe an hour or so he could play it?
A. Yes, that would make it more difficult than I think a simple piano player, otherwise, he'd sight-read it the first time.
Q. Was Mr. Williams, in your opinion, expert enough pianist, in your opinion, just to sight-read it?
A. Yes.

Comment

The thrust of this cross-examination is to demonstrate—through the mouth of the opposing party—that Baxter's testimony was not credible that a piano part was substituted at the alleged Hollywood Bowl performance of "Joy" for the female singer on *The Passions* album, when in fact woodwinds were actually used to recreate the vocal line. In addition, the basis for an argument was established that Baxter reconstructed events to conform to his contention that Williams *must have* performed the "Joy" piano part at the Hollywood Bowl, which (1) in reality, was not arranged for piano, but rather for woodwinds; and (2) set up the questions and answers further establishing that he did not perform as an orchestral pianist after 1961 or 1962. (See Section G, *infra*.)

e. Williams's Lack of Access to "Joy" (Part Two)

Q. Have you ever made the statement under oath that you did not know when this concert took place?
A. I don't know when it took place.
Q. Did you make that statement under oath?
A. Oh, yes.
Q. Have you ever made the statement under oath that this concert that you claimed took place took place on any particular year, in any particular year?
A. If I talked about a year, I was very broad, because I don't remember even—even the range of the years in which it took place. I didn't remember the Johnny Green concert's year, or my other one.
If I may continue.
Q. Yes.
A. On thinking about it, I have a closer fix on when the third concert took place, because memories have to be refreshed, and I've thought about it and I have a date, not an exact year, but I have—within ten years of when it took place.
Q. Did you ever make a statement under oath where you set forth a particular year or day or date for this concert in which you claim "Joy" was performed and that which you also claim John Williams was present?
A. I don't remember fixing a date.

MR. ROSEN: Excuse me, Your Honor.
THE COURT: Yes.

[Pause in proceedings.]

. . .

THE COURT: What are they, deposition excerpts?
MR. ROSEN: They are interrogatory answers, Your Honor.
THE COURT: All right. Let me explain to the jury what an interrogatory is.

Ladies and gentlemen, an interrogatory is a written question which the parties are allowed to send each other prior to trial, then which must be answered in writing under oath.

When an interrogatory question and answer is read into evidence, it's evidence just like any other evidence in the case and it's to be evaluated by you as any other evidence is.

Now, are you going to offer an interrogatory question of an answer, Mr. Rosen?
MR. ROSEN: Yes, Your Honor.
THE COURT: All right. What's the number of the interrogatory?
MR. ROSEN: Interrogatory No. 13, its response.
THE COURT: And what are the dates—
MR. ROSEN: The supplemental—
THE COURT:—you are sending in response.

MR. ROSEN: All right, the interrogatory is included with the response, and that is February 24, 1984.
THE COURT: The answers to '84?
MR. ROSEN: Yes, Your Honor.
THE COURT: '84, you say?
MR. ROSEN: That's correct.
THE COURT: All right.
MR. ROSEN: And there's also supplemental response which is dated—to the same interrogatory, dated October 16, 1987.
THE COURT: All right. Supplemental response, October 16, '87.
All right. You may read those interrogatory [*sic*], the answer and the supplemental answer.
MR. ROSEN: May I put them up?
THE COURT: Certainly. But I'd like them also read orally into the record so it's part—
MR. ROSEN: We shall.
THE COURT: Go ahead.

[Pause in proceedings.]

. . .

BY MR. ROSEN:

Q. Here's Interrogatory No. 13: "State to the best of your ability and recollection the date, time, place and purpose of each occasion on which you allege John Williams heard 'Joy.'"

Response to Interrogatory No. 13: "'Joy' was frequently played on the radio during the mid-1950s.

"In addition, defendant John Williams played in the plaintiff's orchestra in at least one public performance of 'Joy' at the Hollywood Bowl. Plaintiff is currently undertaking research regarding the exact date of that concert and will supplement his answer to this interrogatory when the date of the aforementioned concert has been ascertained with particularity."

Is this photo of your signature on the verification, Mr. Baxter?

A. I think so.

Q. And it says: "I am a party to this action. The matters stated in it are true of my own knowledge except as to those matters which are stated on information and belief and as to those matters I believe them to be true. . . . I declare under penalty of perjury and the laws of the State of California that the foregoing is true and correct. Leslie T. Baxter."

Q. Did you verify that?

A. Yes.

MR. ROSEN: May I now put up 466, which I'll also read?

. . .

THE COURT: All right. They'll be marked for identification only.

[Exhibit marked.]

THE COURT: 466 is the supplemental answer in October of 1987?
MR. ROSEN: That's correct, Your Honor.
THE COURT: All right. Go ahead.
BY MR. ROSEN:

Q. Supplemental response to Interrogatory No. 13—and this is October 16, 1987.

"Plaintiff's best recollection of the date of the Hollywood Bowl performance of 'Joy' in which defendant John Williams participated is 1967 or 1968. Plaintiff specifically recalls that 'Joy' was performed at that concert because he utilized the musical figure from 'Joy' in question in this case to recall the orchestra, including Defendant Williams, from breaks during rehearsal."

I have a verification here which is also under penalty of perjury, Leslie T. Baxter.

Is that a photocopy of your signature, Mr. Baxter?

A. Yes.
Q. Do you realize you made that statement under oath?
A. Yes.
Q. You also realize that John Williams did not play as a performing musician after 1960 or '61 in the recording studios?
A. No, I didn't know that.
Q. So now you don't know.

Are you aware that he could not have been at the Hollywood Bowl in 1967 or '68 as a performer because he was not performing at that time?

A. No, I don't understand the details of that.
Q. If I were to tell you that John Williams was no longer performing as an orchestral pianist in 1967 or '68, you would have to agree with me, sir, that he didn't play at the "Joy" concert?
A. Yes, I would agree with that, yes.

Comment

This section of the trial transcript provides an illustration of what happens when a witness is confronted with facts that destroy the last refuge for his claim, in this case, that Williams did not play the piano part for "Joy" at Hollywood Bowl in 1967 or 1968, because he ceased performing as an orchestra musician in the 1960–1961 time period. Baxter parried the thrust of these questions until confronted with one he had to agree with. It also underscores the importance of persistence and continued pursuit of the objective of the

line of inquiry. At the end of this line of questions, the probability that Williams ever had access to "Joy" was firmly established as, at best, so remote as to be virtually nonexistent.

D. Defendants' Expert Testimony: Direct Examination

1. Prior Art and Its Uses

The direct examination of Earl Spielman was carefully structured substantially along the lines of deductive logic, beginning with a statement of musicological principles and methodology, and then applying these principles and methodologies to the facts at issue, leading to a logical conclusion. Since the analyses and application of prior art were essential to the defense in *Baxter*, the first series of questions was devoted to that subject, as documented in the following extract:

BY MR. PETRICH:[29]

Q. You understand, Dr. Spielman, we are asking how you evaluate prior art, or how you consider it in your evaluation.

A. Exactly.

If I find a musical line that's similar in two works and also can find that that same musical line exists in a work of prior art, a work that preceded either of the two earlier works—I mean either of the two works that are at issue, and if those works are well-known, then it's logical and reasonable to suspect or to think that the person who created example B could have been equally influenced by an earlier work or perhaps even more likely to have been influenced by an earlier work. That's one aspect.

The second is to confirm or to substantiate in my idea that a musical fragment or a musical idea or a musical figure that's at issue is not a unique melody, but is a common compositional device.

In this regard, any—any example that I can find that uses aspects of this common compositional device will give additional evidence or will show, will support my position—

THE COURT: Don't talk in terms of what's evidence or not.

THE WITNESS: Will support my position—

THE COURT: That's in my field. You talk about what musicians know about. Go ahead.

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29. As noted above, Louis P. Petrich was co-counsel who, with Mr. Ruttenberg, represented the MCA entities. The witness in this entire section D is defendants' expert, Dr. Earl Spielman.

THE WITNESS:—would support my suspicion or my contention that a musical aspect is very common, is something that could have been arrived at independently, or created independently.

BY MR. PETRICH:

Q. Okay. Now, when you look for prior art, what kinds of music do you look at?
A. Of course, this all depends upon the music that's at issue.

In most cases, if it's a common compositional device that I'm looking for, I will try to find how common it is by looking in a variety of different genres, or different times of music. . . .

. . .

2. Comparison and Analysis of "Joy" and the "*E.T.* Theme"

After testifying that his methodology was to listen to the sound recordings of both works and then to transcribe those sounds to musical notation for comparison (the initial answer, below), Dr. Spielman gave his rationale and conclusions regarding the presence of similarities between the two works:

A. There were various other small differences in the arrangements, but, as I indicated in my initial report, the difference in the sound recordings and in the presentation of the written materials, was, although they were noticeable differences did not affect my analysis in any way.

It then following—I'm sorry.

Q. Okay. Tell us what you did after that.
A. Following—comparing each sound recording with the written work that was provided, and/or the transcription of the sound recording with the written work provided, I then proceeded to do a comparative analysis using my sound—my transcriptions of the work together with the written versions, and comparing, instead of the two versions of each example with each other, comparing example A, which I called "Joy" and example B which was "E.T.," with each other.
Q. Okay. And at some point, did you come to a conclusion about the two?
A. Yes.
Q. Let me ask you first: What were you looking for? Were you—had you been told by anyone what to look for?
A. No. No, I was given absolutely no specific information. I was only asked to do a comparison of "Joy" and "E.T.," and to determine if in fact there were any similarities that could be considered sufficient to provide a basis for a claim of infringement.
Q. Okay. Now, how did you go about that?
A. Well, I first look at—I mean I look at all of the various aspects of the music. I look at—

Q. Excuse me. At that point.

When you were looking at the music, are you looking to see how an audience might hear it, or are you looking for—looking at it in some other way?

A. I'm not—at that point I'm not looking at it the way an audience would list into [*sic:* listen to] it. I'm looking specifically as around [*sic*] musicologist would look and compare two musical works. I'm trying to identify all the similarities that I can find. Then I try to determine whether those similarities that I identify are relevant. The fact that, for example, both songs are in major is certainly a similarity between the two works, but it's not a relevant similarity.

Q. What do you mean by major?

A. In the major mode, using the organization of half steps and whole steps, that—that fit into the pattern of what is known as the major tonality.

As opposed to minor. We talked about this earlier.

Q. Are you talking about scale, major scale?

A. The major scale.

Q. Okay. What else do you look to?

A. Well, I—as I indicated, I follow my own methodology to determine all possible similarities between the two works that are at issue.

These I then label—I mean, I discuss under the heading "my findings."

Then under my leding [*sic:* heading] of conclusions, I make the evaluation of whether the similarities that are at issue are relevant, are material, are important in determining whether the two works are substantially similar.

And following that, I—I make my conclusions. I can determine—I write up my preliminary determination, and what I found, in this case, comparing "Joy" and "E.T.," was that basically what was at issue was six notes, and that in terms of the work that I had been doing, the work that what I understand to be important in evaluating plagiarism claims, this was insufficient to determine that there had been any copying or that there had been—that the two works were substantially similar, and my conclusions, in other words, were that there was insufficient evidence.

3. Testimony and Demonstrative Evidence: Color Charts and Numbering

A. . . . What I have done here on the color chart is another way of representing music. This is nothing subjective here. It is strictly an absolute, accurate transferral of the pitches and the rhythmic values onto a time line, and someone who wanted to could actually learn or read music using the color chart.

What it does, however, it allows people who are not particularly well versed in reading notes or in understanding the dots on a staff, the dots on the horizontal lines, to be able to very readily see how the notes in one example correspond to the notes in the other example.

What can be seen here is that the only place where there is any similarity, in terms of the pitches, and the durational values is right here, end of measure 18 in "Joy," the end of measure 9, or the middle of measure 9, going [*sic*] these six notes as indicated.

If you'll notice, throughout the rest of the entire phrase, or the two respective phrases, there's an occasional pitch, such as here [indicating], 22 and 12, but this is an accidental pitch. This is nothing coming before or after it that is relevant. . . .

. . .

Q. Okay. Now tell us about the five criteria or factors that you felt were relevant the in evaluating these works?

A. Very simply. The first ingredient that I look at or I try to find similarities in are the actual pitches themselves, "pitch" meaning how high or how low a note is.

Pitch, for example, in "Joy" and "E.T.," with aspects that I found to be similar, were limited to just six pitches.

As I indicated yesterday, if you assign numbers to pitches, the six pitches that I found to be similar were the notes 6——I'm sorry——were the notes 5, 4, 3, 2, 3, 1.

Those six pitches were the only ones I found to be relevant in my analysis.

The second—–

Q. If I could ask—–

A. Certainly.

Q. —in context of those numbers. We've all heard about. the F E D E phrase. Where does that fit in within your numbering system?

A. F E D E would be the numbers 4, 3, 2, 3. We have at different times discussed that in different ways.

4, 3, 2, 3, is what we have frequently discussed as being the turn figure. . . .

. . .

[At which time the cassette was played to the jury, found on tape at #1088.]

[The witness is pointing to the chroma–transcription while the tape is beg [*sic*: being] played.]

BY MR. PETRICH:

Q. Okay. And what's your purpose in showing us this?

A. The purpose in showing that, even though all of the notes that are in common with "Joy" and "E.T." are not identical here, the outline of the

phrase, the shape of the phrase, and the way in which the thematic idea is presented can be heard as being similar to the two works that are at issue.

Q. Okay. Now, do you want. to show us another example?
A. Yes, I did.
Q. Please. What's that?
A. On the same chart, I want to show the composition Song Sung Blue as recorded—as written and recorded by Neil Diamond.

THE COURT: What was the name of the song again?
THE WITNESS: "Song Sung Blue."
MR. BLANCHARD: Your Honor, again, I'd ask for the same limiting instruction since "Song Sung Blue" was composed after "Joy."
THE COURT: It hasn't been offered yet. Are we talking about 487 still?
MR. PETRICH: Correct.
THE COURT: This is another item on the same exhibit?
MR. PETRICH: That's right.
THE COURT: All right. It will be admitted but only for the purpose of illustrating the witness' testimony, not as independent evidence.

BY MR. PETRICH:

Q. Okay. Did you want to show us something on the chart?
A. Yes. In this case, especially in measures 6 and 7, all of the pitches and rhythmic values, as has been indicated being similar between the songs "Joy" and "E.T." are included in the song, "Song Sung Blue."

Red, brown, green, yellow, green, blue. 5–4–3–2–3–1. This can also be shown by comparing the previously shown Exhibit 486. Red, brown, green, yellow, green, blue, are all in the dissonance in the song, "Song Sung Blue." And I believe we also have a sound, Exhibit 2.

A. Well, one example that I can start with where the ear hears tremendous similarity between the works as the theme from the television series "Dallas." And I have demonstration or an exhibit to demonstrate the similarity.

MR. PETRICH: Would you show that to us.
THE COURT: This is exhibit number?

BY MR. PETRICH:

Q. Are we talking now about a chroma–transcription?
A. A chroma–transcription and a sound record.
Q. Let's start with the chroma–transcription. That's Exhibit 487.

MR. BLANCHARD: Objection, relevance. "Dallas" was obviously composed far after "Joy."

BY MR. PETRICH:

Q. Well, would you tell us—is it your understanding that "Dallas" was composed after "Joy"?
A. Yes.
Q. Would you have—tell us whether that would have any relevance to prior art for "E.T."
A. Well, it has relevance, and one of the reasons I explained why I looked for prior art, in that what I find to also be important is the commonality, the fact that an aspect can be so common that it would then give evidence to the fact that any composer could arrive at an idea independently.

THE COURT: All right.
MR. PETRICH: Thank you.
THE COURT: The objection will be overruled on that ground. Any other objection?
MR. BLANCHARD: If the point is commonality, it. certainly doesn't prove it's common as of 1953. I'd like a cautionary instruction limiting the evidence to just—just "E.T."
THE COURT: All right. The evidence is limited for whatever is convincing of that particular limited instruction here. The facts have not been brought out as to when it was published.
487 is a pictorial representation?
THE WITNESS: That's correct.
THE COURT: Is it on transparency?
THE WITNESS: It is on a different transparency.
THE COURT: Okay. Go ahead. Make sure the number is on it.

[Pause in proceedings.]

THE COURT: This is 487, right?
MR. PETRICH: That's correct, Your Honor.

4. Playing and Explaining Examples of Prior Art

BY MR. PETRICH:

. . .

Q. Did you have any other examples for us?
A. Yes, I did.
Q. Before you turn that on, what are we about to see?
A. Okay. This is a color chart or a chroma-transcription of the Franz Schubert "Rondo" in A for violin and orchestra.
Q. What exhibit number is that? That's 488.

. . .

Q. Okay. Please tell us what we should be focused on on this one?
A. Once begin, the same color key is being used and the same idea. Except what is seen here, the ruler that is above it, there are only two beats in each measure, two quarter note beats in each measure which would mean there are two quarter notes, or 2/4 is the meter of this work. Nonetheless, those are difference here, it's still duple meter and would not make any difference in the way in which the work is heard.

What you are seeing here is the red, which is G or the 5, brown, green, yellow, green, blue, coming right at the beginning.

5, 5, 4, 3, 2, 3, 1 [singing] [found on tape at #1614]. 5 below.

This is exactly the same figure that had been used in "Joy" and "E.T.," and, of course, Franz Schubert predated both—

MR. BLANCHARD: Objection, and move to have strike this last commentary. This isn't just describing what the exhibit is and what it will show.
THE COURT: That's true. All right. The last—start of the last sentence will be out at this point.

BY MR. PETRICH:

Q. Could you tell us when Franz Schubert composed his notes?
A. Yes, Franz Schubert flourished, lived in the early part of the 1800s. And this work was living approximately approximately [*sic*] 1810 to 1820.
Q. Okay. Have you told us everything you need to know about that?
A. Yes. I'm pointing out that that figure here [indicating] is exactly the same figure that [*sic*] at issue in "Joy" and in "E.T."
Q. Instead of telling us that issue, it's the same figure that appears in that five and six-note phrase that we heard about?
A. That's correct. Do we have a sound recording for this?

MR. PETRICH: Yes, we do. And Your Honor we'd like to offer in evidence at this point Exhibit 267.

. . .

BY MR. PETRICH:

Q. Okay. Tell us what this is.

[Whereupon the cassette was played, found on tape at #2112.]

BY MR. PETRICH:

Q. Okay.
A. If I can demonstrate on the piano.
Q. All right.
A. I would like to show that same figure is used in here

[playing piano, found on tape at #2192].

5, 4, 3, 2, 3, 1 [playing piano, found on tape at #2207].

Again, this is an example where the exact same notes are used. It's not at the beginning of a phrase, it's at the end of the phrase, nonetheless I'm showing it's a common compositional device—

MR. BLANCHARD: Objection. This is arguing the evidence. This isn't presenting the evidence.

THE COURT: All right. Just state the musical significance of it.

BY MR. PETRICH:

Q. Why did you take this into consideration in your evaluation?

A. Well the tones 5, 4, 3, 2, 3, 1 all exist in this composition where the 5 is longer than the 4 3 2 3 and the 1 is also longer than the four short notes.

Q. Okay. Did you have another example?

A. Yes, I do. I have Donizetti. This was previously submitted.

Q. 470. Was this the one that was played yesterday?

A. Yes, it was.

. . .

THE WITNESS: This example is just the keyboard version, just one hand on the piano.

[At which time the cassette was played to the jury, found on tape at #2349.]

Once again, the figure [playing piano, found on tape at #2382] appears in the middle of that example [playing piano, found on tape at #2388].

MR. PETRICH: Oh, okay.

THE WITNESS: The next example is Bizet.

MR. PETRICH: Exhibit 320, Your Honor.

THE COURT: All right. And which composer is this?

THE WITNESS: This is Georges Bizet.

THE COURT: Would you spell that for the Reporter.

THE WITNESS: B I Z E T.

THE COURT: And the name of the tune is?

BY MR. PETRICH:

Q. What's the name of the composition?

A. This is the "Farandole" from "L'Arlesienne."

THE COURT: Do you need to have this?

COURT REPORTER: No.

THE COURT: 320 received. Hearing no objection, it's in.

[Exhibit received.]

BY MR. PETRICH:

Q. I'll tell you what. Can you play the figure for us on the piano?

A. Yes, I can.

. . .

THE WITNESS: [playing piano, found on tape at #2554].
THE WITNESS: It comes in the middle of that.
MR. BLANCHARD: Wait, wait. I'd like to know what was just played. Does that little figure show up the end or was that just for emphasis at the end, the illustration?
THE WITNESS: I'm sorry.

BY MR. PETRICH:

Q. Tell us what you played.
A. I played the theme from "Farandole L'Arlesienne," and then at the end of my playing I played it for emphasis to show how the figure that's at issue occurs in the middle of that theme.
Q. Okay. And when is Bizet composed?
A. Bizet composed also in the 1800s.
Q. All right.

MR. PETRICH: Your Honor, at this time I'd like to offer tape 321, that's "Young Mr. Lincoln." That may already be in evidence.

. . .

Q. Okay, what are we going to be hearing here?
A. This is the portion of the musical score for the movie "Young Mr. Lincoln" composed by Alfred Newman. This was composed in 1939.
Q. Okay.
Is this taken right off the soundtrack of the movie?
A. I believe it was.
[At which time cassette was played to the jury, found on tape at #2684.]

E. A Brief and Effective Extract from Williams's Testimony on Direct Examination[30]

John Williams, who, at the time, was conductor of the Boston Pops Orchestra, is a first-rate pianist and commentator on music. In conducting the direct examination of John Williams, the strategy was to ask open questions (remember, he was under questioning by his counsel), permitting him latitude to explain how and why he created the "*E.T.* Theme," all the while allowing him to perform at the piano when required to explain his testimony:

THE COURT: Go ahead.

THE WITNESS: I'm trying to establish the psychology of the fifth, and that it belongs to human—it belongs to our collective human memory.

30. Direct examination by the author.

It's a call to battle for millennia, [singing, found on tape at #811], through the woods, the Nordsmen, it's been with us for centuries in our memories, because of the sympathetic vibration. It's the most natural, forceful instrument we have [playing piano, found on tape at #823].

So how did I create the melody for "E.T."? I wrote first the clarion call, which is the first thing you are going to hear in the film that relates to this and the last thing that you are going to hear in the film.

And the clarion call had to do with a little boy looking out of a window and he's looking out at a field at a starry sky, and he's trying to make contact with, he thinks, a creature from the other world.

And what do I write? [playing piano, found on tape at #852]. Listening. [playing piano, found on tape at #85E]. Probably any composer would start with a fifth, it's so part of our psychology.

So I know what I want to compose first is a signal, not a melody, a signal, clarion call, which all of these scores and copies and the movie will show is there.

And the clarion call is the basis for the "E.T." theme, and the clarion call is this: It starts with a fifth, it goes like this: [playing piano, found on tape at #887].

A lot of things are happening here. First the fifth [playing piano, found on tape at #905], which by now you know is the "E.T." theme. It's not the "Joy" theme.

We have the fifth and two long notes, down/up. [playing piano, found on tape at #918].

Followed by a little group [playing piano, found on tape at #922].

Again [playing piano, found on tape at #927], two long notes, a little group [playing piano, found on tape at #931].

That's the first thing I composed. That's the clarion call. It already has the shape of the "E.T." melody, up, down. Up, little group, down, up, little group, down.

Terribly important, germinal, first part of the creation.

You'll hear it when the little boy looks up in the sky. You'll hear it for about four reels in the picture before you hear the "E.T." theme. Let me explain why that is, just very quickly, a little composition lesson. Simple.

We are going to write a script, and the way you make a script strong is to build vertebrate strength, which means connect parts, build parts, you're going to write a love story. Guy goes out with a girl and the first night he says to her: I love movies. Next date she says to him: I love hamburgers. Third or fourth date, he says: I love my car.

And you build—the professional writer is building—building up an expectancy with the two words "I love" until finally, in Reel 13, he says to the girl: I love you.

And suddenly it's a completion for the audience. We don't know it as an audience, but it's interrelatedness of material that's been prepared in the

beginning, Reel 1, let's say, in the movie, with the dialogue, and with the music to mature, to metamorphosize and through different shapes and become something else, and the something else should satisfy us.

And if they didn't say that to each other in Reels 1, 3 and 4, it wouldn't have the same impact when they finally do say it in Reel 16.

Back to the clarion call [playing piano, found on tape at #1047]. You are going to hear this over and over again in the picture, long fifth [playing piano, found on tape at #1052]. Little group of notes. Long fifth [playing piano, found on tape at #1059].

What am I doing? [playing piano, found on tape at #1062]. Pretty soon I'm going to do this—the first thing I did was [playing piano, found on tape at #1067]. And so on. Something was a little different than you've been hearing, was that the first part of the grouplet [playing piano, found on tape at #1085]—what I played the first time for you was an F--sharp.

The first thing I wrote and the first thing I presented to Mr. Spielberg[31] was the theme with the F-sharp [playing piano, found on tape at #1097]. You hear the difference? One is [playing piano, found on tape at #1102]. This is [playing piano, found on tape at #1104]. Why F-sharp? Because the clarion call has F-sharp [playing piano, found on tape at #1109].

I thought about it., and I changed it to an F natural because I thought the F-sharp was too exotic for the first statement of the melody, that a diatonic scaling approach would be better [playing piano, found on tape at #1124]. So we play this [playing piano, found on tape at #1128], the clarion call. And we finish it, second phrase [playing piano, found on tape at #1133].

Now, how do I get my melody? I want two long notes and a group of short ones, just like the clarion call, which will mature into the theme, note [playing piano, found on tape at #1144], note [playing piano, found on tape at #1150], fifth, a little group of notes going down again [playing piano, found on tape at #1151]. Now I'm beginning to compose my melody.

We've talked a lot about a turn, some of the musicologists object to [playing piano, found on tape at #1162] that being called a turn. That's F-E-D-E-C. They're correct. It isn't correctly a turn. One of them said a turn is usually quicker, they are correct.

A turn is this [playing piano, found on tape at #1174]. That's the way you play it. [Playing piano, found on tape at #1177], de-da-da [singing] [playing piano] in older, baroque music, F-E-D-E and it usually goes up. What is this? [playing piano, found on tape at #1188]. It's a turn backwards. It's like a finger exercise [playing piano, found on tape at #1192].

Like Mr. Baxter played yesterday, when he did his little gliss.[32]

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31. Steven Spielberg is the director of *E.T. The Extra-Terrestrial*.
32. This is short for *glissando*, a term used to refer to the execution of rapid scales through a fast sliding movement such that the performer will play a passage either ascending or descending

Okay. Let's talk a little bit about how—what this means in terms of the melody.

When writing melody, we define tonal space not by contiguous or conjunct or adjacent tones [playing piano, found on tape at #1220], but by the space that's covered by those tones [playing piano, found on tape at #1226]. If we play [playing piano, found on tape at #1229], we've defined the fifth. Okay? If I play [playing piano, found on tape at #1234], I've defined an octave.

You define the space by the span, and what's in between is important, very important, but it's less important in terms of the architectural structure of a melody than the outward beacons of what the melody does. I'll show you.

What is "E.T."? The beacons are the fifth [playing piano, found on tape at #1259]; fourth [playing piano, found on tape at #1262].

Now [playing piano, found on tape at #1264]—sorry. [playing piano, found on tape at #1267].

The whole development of this melody doesn't come out of this. It. comes out of this [playing piano, found on tape at #1276].

That fifth has grown. It's connected different ways. Sometimes it's this [playing piano, found on tape at #1291]. I think once it's that [playing piano, found on tape at #1294]. It could have been—it could have been [playing piano, found on tape at #1296].

The beacons are still the same [playing piano, found on tape at #1303] [singing].

What are the beacons of "Joy"? Very different? It's [playing piano]—I'm going to talk about that later, hut [*sic*: but] the beacons are [playing piano, found on tape at #1316], something like [playing piano, found on tape at #1320], something like that. Very different than [playing piano, found on tape at #1324].

THE COURT: Mr. Williams, let me suggest you stay within the scope of the question which was how the theme from "E.T." has developed.

THE WITNESS: I want to try to avoid comparison.

THE COURT: All right. Go ahead.

THE WITNESS: Excuse me.

Talking about these beacon intervals, the fifth being the absolute core kernel of this thing [playing piano, found on tape at #1354]. Now, it's an octave, it's gotten bigger, beacon, beacon, next one [play piano, found on tape at #1362]—the connecting tones here are just a scale, not all that important [playing piano,

---

by rapidly sliding from one note to the next without pausing between notes. On the piano, the performer executes a *glissando* by sliding rapidly over the white keys, most typically using the thumb, the third finger or the fingernails of the hand as the contact point on the keyboard. *Glissandos* are often used on the harp, the violin, and other string instruments, and they can also be sung by vocalists. *See* Harvard Dictionary Of Music, *supra* note 10, at 348; 10 The New Grove Dictionary of Music And Musicians ("Grove") 13 (Stanley Sadie ed., 2d ed. 2001).

found on tape at #1369].

You've seen on the board what's similar and what is dissimilar between the two terms.

Your Honor, may I play the opening phrase of—

THE COURT: I think your counsel should introduce a new subject with a question.

Comment

At this point in the testimony, since the witness was sitting at the piano and, with musical examples, was demonstrating the creative process for the "*E.T.* Theme" and the differences between "Joy" and the "*E.T.* Theme," the author merely asked the witness, from his perspective as the creator of one of the works at issue, how and why his work was created independently of any access to "Joy." Mr. Williams then continued his instructive monologue for an extended period of time, with the author receding to the background so that the jury's attention was totally focused on the witness.

A. The basic tempo is the same, but the meter, the kenetic, the energy of both melodies is totally different. That's why one is written in quarter notes, and the other is written in half notes. Mine has long notes, it has to give us exaltation.

The end of the B theme, which you haven't heard yet in "E.T." ends like this [playing piano, found on tape at #1928].

It's great tension, unresolved, great expectation to go [playing piano, found on tape at #1937.]

That's not joy that's exaltation.

If I made my piece the same rhythm as Baxter's, it would be like this [playing piano, found on tape at #1953], [singing]. Then we are coming to the big tune, and it will be [playing piano, found on tape at #1958].

The length of the notes is absolutely of the essence. That's the reason it's in 3/2 and not 4/4. I don't want to again take the time to write this out. I hope you all remember that the "E.T." music is written in 3/2 and the notes were big and they were round [indicating].

Now, to conduct "Joy" [playing piano, found on tape at #1985], a well-titled piece [singing, found on tape at #1988], it has a bounce to it, that's why he's got da-da-da-dum, it's always marked separate, separate bows, *marcato*[33] and woodwinds and so on, da-da-da-da-de-da-bum-bum. It's not the same emotion as da-de-da-da-da-da-da-dum. It won't work [found

33. *Marcato* (or *marcando*) means "marked," "stressed," or "accented" (i.e., to draw attention to a particular musical passage that might not otherwise receive the prominence intended by the composer). *See* Harvard Dictionary Of Music, *supra* note 10, at 504; 15 Grove, *supra* note 32, at 808.

on tape at #2013] if the notes are too short. It won't work if the tempo doesn't have a broad kenetic to it.

"E.T." will not work if I shorten those notes.

The length of the note is of the essence in determining what the emotional meaning is.

Again, [playing piano, found on tape at #2038], very nice [playing piano, found on tape at #2042].

For my purposes, impossible to use. I have to [playing piano, found on tape at #2048], the end of a resolution, whatever this is, I will not confuse you. I must have [playing piano, found on tape at #2054]. Where does this come from [playing piano, found on tape at #2059], that fifth? It comes from antiquity, it comes from the battle horn, it comes from the clarion call [playing piano, found on tape at #2068]. It has to be a fifth [playing piano, found on tape at #2071], and they have to be long notes. If they are played short, today de-da-da-da-da da-da, [playing piano, found on tape at #2078], [singing].

. . .

THE WITNESS:

. . . All out of the fifth, that little [playing piano, found on tape at #2756] is important, but it's a little thread, it's a little connecting tissue. What Baxter and I did in common was to connect the G to the C in the same way that probably hundreds of thousands of people might have done it.

We did it thirty years apart. I created this melody completely independently of any knowledge of his music. It is purely the result of the clarion call [playing piano, found on tape at #2787], long, long, grouplets [playing piano, found on tape at #2792].

Long, long, grouplets [playing piano, found on tape at #2796].

Long, long, grouplets [playing piano, found on tape at #2803].

Long, long, grouplets [playing piano, found on tape at #2809].

Long, long, different grouplets [playing piano, found on tape at #2815].

Resolution [playing piano, found on tape at #2818] and so on, B theme, which I played for you [playing found on tape at #2822].

So I'm suggesting to you that the climaxes that I build before [singing] [playing piano, found on tape at #2831], in every case in the film, have to be delivered on the tonic chord, the result of this tension [playing piano, found on tape at #2841]. We must follow it by resolution if we are going to satisfy the expectation we've created by that chord. It's unresolved, there it is [playing piano, found on tape at #2854].

When are you going to resolve it? When the bicycle goes up [playing piano, found on tape at #2860] or whatever the relevant action is. And we time it on the screen exactly. I wait for that moment. The orchestra plays this [playing piano, found on tape at #2869]. Now when that bicycle goes off, we play tonic, home, mother chord [playing piano, found on tape at #2875]. We can't play [playing piano, found on tape at #2879]. It doesn't

resolve yet, it's too late. It's impossible to use a dominant chord at that point.

So our pieces are insufficiently alike, intervalically in their melody. That is insufficient to identify either piece.

They're completely different rhythmically. One has short little quick notes, which is joyful [playing piano, found on tape at #2907], the other has big, broad strokes which are exaltant and exuberant, completely different psychology, completely different context.

Comment

This testimony can scarcely be improved. The author asked very few questions during this direct examination. There were just enough questions to satisfy foundational requirements for the answers, which allowed the witness to engage in conversation (and in this case also to demonstrate at the piano) with the jury and others in the courtroom. When a lawyer is fortunate enough to have such a client/witness, the lawyer should assume the role of facilitator, leaving all attention focused on the witness.

F. Reacting to the Screen: The Role of the Motion Picture Composer and a Private Screening for the Jury

Music is an abstract art form asleep in the hibernation of lines, dots, empty circles, and the intermittent rest symbols on a page of lined music paper. It is awakened only by the performer, who translates those dots, circles, lines, and rests into organized sounds constituting musical expression that creates *something* in the ears and minds of the listener. But what is it that is created? The only reasonable answer is that it is something different among listeners. Even in programmatic music such as *La Mer* ("*The Sea*") or *The Pines of Rome*, if the listener is not told the titles, it is unlikely that he or she would think of different times on the seas[34] or that Respighi was giving us a musical portrait of the pines, let alone pines growing in specific areas of Rome. As someone once observed, music is the manifestation of the thing itself, and we might add, of nothing else.

Entering this philosophical landscape is the film composer with the job of screening the picture, being inspired by the action and acting and writing a score which is reactive to the scenario on the screen, the music of which supports and captures the feeling, mood, and character of the action while, at the

34. *From Dawn to Noon on the Seas*, *Play of Waves*, and *Dialogue of the Wind and the Sea*, the titles given by Debussy to the three sections of this great monument to musical impressionism.

same time, not becoming intrusive so as to focus more attention on the music than on the audiovisual story the director has created. It is not an easy job. This was accomplished by John Williams in his score for *E.T. The Extra-Terrestrial*. He explained all this for the jury, at one point demonstrating on the piano how the "*E.T.* Theme" gave the feeling of taking off and flying during the sequence in the film when the bicycles did just that. At the conclusion of his testimony about his reactions to the events chronicled on the screen, court was recessed and the film was screened for the jury in a room at the Federal Courthouse.

This screening accomplished two objectives:

(1) it demonstrated that Williams had on overriding goal—to fulfill the role of a film composer as discussed above; and
(2) it supported Williams' testimony that the motif or fragment—of whatever length—grew from his reaction to the various feelings, moods and characters in *E.T.*, and not from Baxter's "Joy," with its lighthearted, jocular mood and expression.

This screening by itself did not win the case, but it was a major contribution in helping the jury understand the creative process and the result of that process that produced a work totally unrelated to, and different from, the plaintiff's composition.

G. The Defense Rests and the Case Goes to the Jury

The judge instructed the jury, and both sides delivered their final arguments. The strategy for the defendants at this most crucial time in the trial was to focus the jury on the lack of copyright protection for the isolated pitch sequence in "Joy" upon which Baxter based his claim. To do so, the defense crafted a very specific jury instruction and a special verdict form to be sent into the jury room. (Copies of these are attached as Appendix 11-A to this Chapter.)

After three hours of deliberation, the jury concluded that what Baxter sought to protect was, in fact, unprotectable, which they documented in the special verdict form. They found that it was not only a motif (a common building block of music), as proven by the examples of prior art, but was also based upon a formula or musical *scène à faire*, in that it logically follows in the Western scale as a typical cadence (with a turn between 5 and 1 of the scale) concluding a passage or phrase or one ending a composition.[35]

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35. *See* Harvard Dictionary of Music, *supra*, note 10, at 118–120 (defining and explaining "cadence").

Conclusion

The approach followed in *Baxter v. MCA, Inc.* is an example of reliance on prior art from "classical" Western music. That approach was virtually dictated by the nature and type of the musical expressions at issue. The music for *E.T. The Extra-Terrestrial* was written in the genre established for motion picture scores by composers from the European Romantic tradition—Korngold, Tiomkin, Steiner, Rosza, Newman, and Waxman. Such a limited approach would, however, be an extremely insular one. This is because the major commercial underpinnings to the music business are in the worlds of pop music, rock, hip hop, rap and music created for radio and television commercials. In a litigious society—such as ours—lawsuits follow apace when composers claim that their compositions have been stolen. Though the "literature" may be newer and different in popular forms of musical expression (e.g., rock, rap and hip hop, etc.), the same methodology discussed in the *Baxter* case is applicable in analyzing the claimed infringing elements in popular music.

Regardless of the type of musical genre, the question that must always be asked in infringement litigation is: Is what the plaintiff seeks to protect in fact protectable? Stated another way: Has Plaintiff isolated commonplace musical ideas and motifs which appear in both his/her composition and that of the alleged infringer, or has he/she through creativity transformed the commonplace into original expression, just as Mozart, Beethoven, Cole Porter, George Gershwin, Paul Anka, Carly Simon, the Beatles, and Radiohead were able to accomplish in their works?

The correct answers to these questions can be achieved only by careful and honest musicological and legal research and analysis by the lawyer and forensic musicologist involved in infringement litigation. The remaining goal—convincing a judge or a jury that a defendant has copied plaintiff's protectable expression or that what was copied is a commonplace musical idea or device—can best be accomplished by the recognition and understanding that (1) music is a language through which musical ideas are expressed; and (2) there are ideas, *scènes à faire* and other unprotectable elements expressed in musical language that are not entitled to copyright protection. As discussed in an earlier chapter, a plaintiff has the burden of proving substantial similarity of protectable expression. As also noted, this makes plaintiff's likelihood of obtaining a summary judgment more difficult than a defendant's chances of success in achieving that result. At trial, however, plaintiff's chances to obtain a judgment in his or her favor are improved, especially in a jury trial. However, the reliance of many plaintiffs on similarity of pitch succession will, more often than not, end in disappointed expectations. Plaintiffs, in order to state a more viable music infringement claim, must, if possible, add harmony and

rhythm to the work, so that whatever is expressed will at the very least be comprised of the basic trinity of music. Though there are no guarantees, the probabilities are increased that a correct and just result will be achieved in music infringement litigation by the acquisition of knowledge and understanding of musical ideas and the abstract language through which they are expressed.

APPENDIX

11-A

Instruction No. 16 and Special Verdict

Ownership of a Copyrighted Work

I will address first the issue of originality and protected material.

It has already been established that plaintiff is the owner of the copyright for the song "Joy." However, ownership involves certain other issues as follows:

1. To what extent plaintiff's work was original; and
2. To what extent material in plaintiff's work is protected by the copyright laws.

First, because copyright protection for musical works depends upon originality, plaintiff must prove that the expression for which he seeks protection was created by him and not copied by him from other sources.

Second, plaintiff must prove that what he attempts to protect is capable of being protected by the copyright laws.

You will recall my earlier instruction that a copyright protects only the expression of an idea and never the idea itself. The task of separating the unprotected material in a work from the author's protected expression is a difficult one. But it is your responsibility in this case and I will give you the following general rules to assist you in that task.

In the case of musical works, the law does not protect (1) musical concepts or ideas, (2) trite or commonplace musical expressions, (3) musical motifs. Thus, a basic concept or idea is not protectible. A trite or commonplace expression is one that has been used frequently in the musical world in works which proceeded either of the works in question here. However, an original use of a combination of commonplace ideas might be found to be protectible. A motif is a common musical basic outline for a musical work.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

LESLIE T. BAXTER, an individual,	)	NO. CV83-7081-HLH (JRx)
	)	
Plaintiff,	)	SPECIAL VERDICT
	)	
vs.	)	
	)	
MCA, INC., etc., et al.,	)	
	)	
Defendants.	)	
	)	

We, the Jury in the above entitled action, find the following special verdict in the second phase of the trial of the above entitled action:

Question No. 1: Does the portion of the "B Theme" of the song "Joy" claimed to have been copied contain original material which may be protected by copyright?

Answer "yes" or "no."

Answer: NO

If you answer question No. 1 "yes," answer question No. 2. If you answer question No. 1 "no," sign and return this verdict.

Question No. 2: Does the musical score from "E.T." contain music which is substantially similar to the original protectible material from "Joy"?

Answer "yes" or "no."

Answer: _____

If you answer question No. 2 "yes," answer question No. 3. 7 If you answer question No. 2 "no," sign and return this verdict.

Question No. 3: Was a significant amount of substantially similar original protectible expression from "Joy" copied by the composer into the musical score of "E.T."?

Answer "yes" or "no."

Answer: _____

Sign and return this verdict.

Dated: September 13, 1988.

/s/_____
FOREPERSON

CHAPTER
12

Music, Copyright and the Impact of New Technology

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Copyright protection became necessary with the invention of the printing press and had its early beginnings in the British censorship laws. The fortunes of the law of copyright have always been closely connected with freedom of expression, on the one hand, and with technological improvements in means of dissemination, on the other. Successive ages have drawn different balances among the interest of the writer in the control and exploitation of his intellectual property, the related interest of the publisher, and the competing interest of society in the untrammeled dissemination of ideas.

Benjamin Kaplan[1]

I. Introduction

The explosion of technology has had a dramatic impact on the distribution of copyrighted works via means of mass communication, the principal vehicle at this time in history being the Internet. This has ignited a cultural and business war between (1) copyright owners and content providers, on the one hand, and (2) manufacturers of technology and consumers who use that technology in violation of the rights of copyright owners, on the other hand. Though being contested in the late twentieth and early twenty-first centuries, this conflict is another sequel involving the efforts of creators and copyright owners to protect their intellectual property against the manufacturers and users of new technology. As such, this is the latest of the "turf wars" going back to the advent of the player piano,[2] the invention of motion pictures,[3] and the distribution of television programming via community antenna systems;[4] to the

1. *Forward* to Benjamin Kaplan, An Unhurried View of Copyright vii–viii (1967), *quoted in* Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 430, n.12, 104 S. Ct. 774, 783 n.12, 78 L. Ed. 2d 574 (1984).
2. *See* White-Smith Music Book Publ'g Co. v. Apollo Co., 209 U.S. 1, 28 S. Ct. 319, 52 L. Ed. 655 (1908). The Court held that perforated music rolls that, when run on a "player" piano, produced copyrighted tunes did not constitute a "copy" under the then-current Copyright Act.
3. *See* Edison v. Lubin, 122 F. 240, 242 (3d Cir. 1903) (motion pictures originally given copyright protection as photographs by the federal courts).
4. *See* Fortnightly Corp. v. United Artists Television, Inc., 392 U.S. 390, 88 S. Ct. 2084, 20 L. Ed. 2d 1176 (1968). A community antenna television ("CATV") system provided customers with television signals for programs licensed to it by United Artists. Certain of Fortnightly's customers, who lived in hilly areas, could not receive those signals. To solve the problem, Fortnightly not only received the signal for programs, but also reproduced and transmitted them over cable to its customers. In taking "the Copyright Act of 1909 as we find it," the Court declined to render a compromise decision suggested by the Solicitor General and stated that, "[w]ith due regard to changing technology, we hold that the petitioner did not under that law 'perform' the respondent's copyrighted works." *Id*. at 401–02, 88 S. Ct. at 2090.

present day of file-sharing and distribution of copyrighted audio and audiovisual content over the Internet. As we have learned, whether considering the early forays in the technology wars at the beginning of the twentieth century or the battles that are currently being fought, those who directly or indirectly infringe copyrighted works will have to contend with the doctrines of vicarious infringement and contributory infringement. The reason: These two subcategories of secondary liability are now playing a central role in the efforts of copyright owners to protect their intellectual property in this age of digital reproduction, storage of content, mass communication, and distribution of that content via the Internet. Each of the forces—whether content providers or content users and their enablers—must understand the strengths and fallibilities of their positions.

II. Secondary Liability: General Principles Established Before the Advent of File-Sharing[5]

A. Vicarious Infringement and Contributory Infringement

Vicarious infringement and contributory infringement are, respectively, recastings of *respondeat superior* and joint and several liability and have been defined as follows: (1) contributory infringement occurs when "one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another";[6] (2) vicarious liability attaches when one "has the right and ability to supervise the infringing activity and also has a direct financial interest in such activities."[7] In *Sony Corporation of America Inc. v. Universal City Studios, Inc.*,[8] Justice Stevens, however, in addressing the issues of vicarious and contributory liability, engages in an exegesis of these two concepts from a different perspective than those encountered in the opinions of other courts and commentators. Justice Stevens appears to conflate these two distinct types of secondary liability in defining "vicarious liability" as a generic rule of law and contributory liability as a subset of vicarious liability when he states that "vicarious liability is imposed in virtually all areas of the law, and the concept of contributory infringement is merely a species of

5. The term "secondary liability" is generic and includes under its umbrella both contributory infringement and vicarious infringement.
6. Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc., 443 F.2d 1159, 1162 (2d Cir. 1971).
7. *Id.*
8. 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984).

the broader problem of identifying the circumstances in which it is just to hold one individual accountable for the actions of another."[9]

For either vicarious liability or contributory infringement, there must be a direct infringement or as the Ninth Circuit stated in *A&M Records, Inc. v. Napster, Inc.*: "[s]econdary liability for copyright infringement does not exist in the absence of direct infringement by a third party."[10] It is to be noted that vicarious liability and contributory infringement share the same objective, that is, to hold secondary infringers liable based on some nexus to the infringer and his or her infringing activities. They differ, however, in that contributory infringement requires a relationship between the defendant and the *acts* constituting the direct infringement, whereas vicarious liability is based on a relationship with the direct infringer (i.e., the defendant must have the ability to control the conduct of the direct infringer coupled with financial interest in the infringing acts and conduct). In the case of the former, the secondary infringer may not even know the identity of the direct infringer and may still be found liable, while the latter is actually involved in facilitating or inducing the infringing conduct.

B. Reported Authorities: A Brief Overview

1. *Shapiro, Bernstein & Co., Inc. v. H. L. Green Company, Inc.*[11]

In this case from 1963, the Second Circuit sets forth a concise framework within which to analyze the elements of vicarious liability. The facts are relatively uncomplicated: Defendant Jalen Amusement Company Inc. was granted a concession to operate phonograph record departments in twenty-three stores owned by H. L. Green Co. pursuant to written licenses. Shapiro, Bernstein & Co., a prominent music publisher, and its co-plaintiffs were the copyright proprietors of a number of musical compositions. In the complaint, plaintiffs charged Jalen with infringement of copyrighted recordings of hit songs produced by major record manufacturers in violation of Section 101 of the 1909 Copyright Act. The plaintiffs also alleged that Green infringed their copyrights because it "'sold or contributed to and participated actively in the sale of' the so-called 'bootleg' records manufactured by Jalen and sold by Jalen in Green stores."[12] The lower court found Jalen liable for manufacturing bootleg records but found that Green was not liable because it had not sold any of the records for sales made by Jalen. The appellate court affirmed liability

9. *Id.* at 435, 104 S. Ct. at 785.
10. 239 F.3d 1004, 1013 n.2 (9th Cir. 2001).
11. 316 F.2d 304 (2d Cir. 1963).
12. *Id.* at 306.

against Jalen but reversed the dismissal of the claims against Green and remanded for further proceedings.

The appellate court, per Judge Kaufman, in remanding, held that Green was vicariously liable. Pursuant to its relationship with Green, Jalen had been operating for thirteen years as a record department concessionary in twenty-three of Green's stores. Under its licensing agreement Jalen was required to "'abide by, observe and obey all rules and regulations promulgated from time to time by H. L. Green Company, Inc. . . .' Green, in its 'unreviewable discretion,' had the authority to discharge any employee believed to be conducting himself improperly. Jalen, in turn, agreed to save Green harmless from any claims arising in connection with the conduct of the phonograph record concession."[13] In addition, pursuant to the license, Green was entitled to receive a percentage, in some cases, 10% and in others 12%, of Jalen's gross receipts from record sales as its full compensation as licensor. All sales were made by Jalen's employees, who were under the control and supervision of Jalen. All proceeds from record sales were run through Green's cash registers, from which Green deducted its percentage of those sales and deducted the salaries of all Jalen employees, which were then handed over to Jalen to be distributed to its employees. Receipts were given to record purchasers marked "H. L. Green Co., Inc." with Jalen's name nowhere to be found.

Even though Green did not participate in the sale of records and had no knowledge of the unauthorized manufacture of "bootleg" records, the appellate court found that Green was severally liable. The court relied on the "dance hall" cases, holding the dance hall proprietor liable for infringements of copyright resulting from performances of musical compositions by a band or orchestra "whose activities provide the proprietor with a source of customers and enhanced income [such that] [h]e is liable whether the bandleader is considered, as a technical matter, an employee or an independent contractor, and whether or not the proprietor has knowledge of the compositions to be played or any control over their selection."[14] Thus, the court held that "by reserving for itself a proportionate share of the gross receipts from Jalen's sales of phonograph records, Green had a most definite financial interest in the success of

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13. *Id.*

14. *Id.* at 307–08 (citing "dance hall cases" of Buck v. Jewell-LaSalle Realty Co., 283 U.S. 191, 198–99, 51 S. Ct. 410, 75 L. Ed. 971 (1931); Dreamland Ball Room, Inc. v. Shapiro, Bernstein & Co., 36 F.2d 354 (7th Cir. 1929); M. Witmark & Sons v. Tremont Social & Athletic Club, 188 F. Supp. 787 (D. Mass. 1960); Remick Music Corp. v. Interstate Hotel Co., 58 F. Supp. 523 (D. Neb. 1944), *aff'd*, 157 F.2d 744 (8th Cir. 1946), *cert. denied*, 329 U.S. 809, 67 S. Ct. 622, 91 L. Ed. 691 (1947); Buck v. Pettijohn, 34 F. Supp. 968 (E.D. Tenn. 1940); Buck v. Crescent Gardens Operating Co., 28 F. Supp. 576 (D. Mass. 1939); Buck v. Russo, 25 F. Supp. 317 (D. Mass. 1938); Irving Berlin, Inc. v. Daigle, 26 F.2d 149, *rev'd on other grounds*, 31 F.2d 832 (5th Cir. 1929); M. Witmark & Sons v. Pastime Amusement Co., 298 F. 470 (E.D.S.C.), *aff'd*, 2 F.2d 1020 (4th Cir. 1924); Harms v. Cohen, 279 F. 276 (E.D. Pa. 1922)) (other citation omitted).

Jalen's concession; 10% or 12% of the sales price of every record sold by Jalen, whether 'bootleg' or legitimate, found its way—both literally and figuratively—into the coffers of the Green Company. . . . [¶] The imposition of liability upon the Green Company, even in the absence of an intention to infringe or knowledge of infringement, is not unusual. As one observer has noted, 'Although copyright infringements are quite generally termed piracy, only a minority of infringers fly the Jolly Roger.'"[15] The court, in analogizing to innocent infringement, also observed that "courts have consistently refused to honor the defense of absence of knowledge or intention."[16]

The bottom line was that H. L. Green Company was held to be a vicarious infringer because it had the ability to control Jalen and had a direct financial interest in the proceeds from the infringing records.

2. *Gershwin Publishing Corporation v. Columbia Artists Management, Inc.*[17]

Columbia Artists Management, Inc. ("CAMI") operates (to this day) primarily as a manager of concert artists in the field of classical music. Through its community concert division, it also creates local organizations in smaller communities to hire CAMI artists for annual concert series. For these series, CAMI was compensated in two ways: (1) a differential for services rendered by CAMI, which may be up to 25% of gross fees paid to performers whether or not represented by CAMI; and (2) 15% of fees earned by CAMI artists after deducting the differential.

During one of these community concerts, CAMI artists performed "Bess, You Is My Woman Now" from George Gershwin's opera *Porgy and Bess* without permission from Gershwin Publishing Corporation, the copyright proprietor. Gershwin sued the performers, the local association, and CAMI for copyright infringement. In its defense, CAMI took the position that its involvement with the infringing performers did not make it jointly or severally liable for infringement. Upon appeal from plaintiff's summary judgment, the Second Circuit held that CAMI was both a vicarious and contributory infringer. It was vicarious, the court explained, because it had a financial interest in the enterprise, in that it was compensated as discussed above. In addition, CAMI, through a representative, handled most of the planning for the concert series and specifically chose not to secure copyright clearances (including those for the Gershwin song) because it claimed it had no responsibility for any infringement which might occur. In other words, it exercised

15. *Id.* at 308 (citations omitted).
16. *Id.*
17. 443 F.2d 1159 (2d Cir. 1971).

control and had the requisite financial interest in the presentation of community concerts.

The court also held CAMI liable as a contributory infringer because it was "one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another, may be held liable as a 'contributory infringer.'"[18]

3. *Famous Music Corporation v. Bay State Harness Horse Racing and Breeding Association, Inc.*[19]

Famous Music presents a classic example of contributory infringement as a subcategory of the doctrine of *respondeat superior*. It is ultimately classic in the sense that musicians hired by the defendants were independent contractors (and not employees). The district court entered a summary judgment for plaintiff; the First Circuit Court of Appeals affirmed. The appellate court, in support of its affirmance, stated that "[t]he courts have rejected the 'independent contractor' theory. . . . and with good reason. The proprietor of a public establishment operated for a profit could otherwise reap the benefits of countless violations by orchestras, itinerate or otherwise, by merely claiming ignorance that any violation would take place."[20]

4. *Fonovisa, Inc. v. Cherry Auction, Inc.*[21]

Fonovisa produced recordings of Latin/Hispanic music for which it held copyrights. Cherry Auction operated a flea market (swap meet) in Fresno, California. Cherry Auction rented booth space to vendors for a daily fee, for which it provided parking, conducted advertising campaigns, and retained the right to terminate vendors "for any reason, at any time."[22] The operators of Cherry Auction were aware that vendors were selling counterfeit recordings

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18. *Id.* at 1162.
19. 554 F.2d 1213 (1st Cir. 1977).
20. *Id.* at 1214–15 (citations omitted). *Cf.* Columbia Pictures Indus., Inc. v. Aveco, Inc., 800 F.2d 59 (3d Cir. 1986). In *Aveco*, plaintiffs, who were producers and copyright proprietors of motion pictures, sued defendant Aveco, a company that rented to customers videocassettes of movies in conjunction with rented rooms that contained videocassette players. The court held that this was an unauthorized public performance violating Section 106(5) of the Copyright Act, pursuant to which the copyright owner has the exclusive right to authorize public displays of a copyrighted work. Like *Famous Music Corp.*, *Aveco* also was resolved by a plaintiff's summary judgment that was affirmed on appeal. The appellate court rebuffed Aveco's reliance on the "first sale doctrine." As the court explained, "the first sale doctrine . . . prevents the copyright owner from controlling future transfers of a particular copy of a copyrighted work after he has transferred its 'material ownership' to another" *Id.* at 64.
21. 76 F.3d 259 (9th Cir. 1996).
22. *Id.* at 261.

of Fonovisa's copyrighted records. Fonovisa's complaint for vicarious and contributory copyright infringement and for contributory trademark infringement was dismissed on the pleadings. The Ninth Circuit reversed, holding that Fonovisa stated claims for vicarious infringement and contributory infringement. Turning first to vicarious infringement, the court relied primarily on the *Shapiro, Bernstein & Company* case discussed above: Cherry Auction was a vicarious infringer because (1) it realized a direct financial benefit in that it received a daily rental fee from the vendors and an entrance fee from customers attending the swap meet; and (2) it exercised control through its right to terminate its relationships with vendors at any time, for any reason.[23] The court also found that Cherry Auction was a contributory infringer because it contributed to the concessionaires' infringing conduct. It observed: "Contributory infringement originates in tort law and stems from the notion that one who directly contributes to another's infringement should be held accountable. . . . [¶] There is no question that plaintiff adequately alleged the element of knowledge in this case. The disputed issue is whether plaintiff adequately alleged that Cherry Auction materially contributed to the infringing activity. We have little difficulty in holding that the allegations in this case are sufficient to show material contribution to the infringing activity. Indeed, it would be difficult for the infringing activity to take place in the massive quantities alleged without the support services provided by the swap meet. These services include, *inter alia*, the provision of space, utilities, parking, advertising, plumbing, and customers. . . . [¶] Moreover, we agree with the Third Circuit's analysis . . . that providing the site and facilities for known infringing activity is sufficient to establish contributory liability."[24]

III. The File-Sharing Craze: Secondary and Direct Liability

A. Section 106 of the Copyright Act[25]

In confronting the issues of sharing files containing unauthorized copies of copyrighted musical works, it is not only necessary to analyze factual settings,

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23. *See id*. at 263–64 (citing Shapiro, Bernstein & Co., Inc. v. H. L. Green Co., Inc., 316 F.2d 304 (2d Cir. 1963)).
24. *Id*. at 264 (citations omitted); *see also id*. (citing and quoting William F. Patry, Copyright Law & Practice 1147 ("'Merely providing the means for infringement may be sufficient' to incur contributory copyright liability")).
25. Section 106 of the Copyright Act provides that "the owner copyright under this title has the exclusive rights to do and to *authorize* any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted

which may or may not give rise to secondary liability, but also the exclusive rights granted to the copyright owner as provided in Section 106, with particular reference to subsections (1) and (3). The rationale for focusing on Section 106 in the context of file-sharing is that the copyright owner's "exclusive" rights are not only the right to use, but also to *authorize* the use of his work in the ways set forth in the subsections of Section 106, as qualified, in particular, by Section 107 dealing with fair use.[26] It is the authorization right that has particular relevance to secondary liability.

B. Secondary Liability From *Sony* to *Grokster*: Betamax, File-Sharing and the Courts

1. *Sony Corporation of America v. Universal City Studios, Inc.*[27]

a. The Betamax Video Tape Recorder: Features and Advantages

At issue in *Sony* was the Betamax videotape recorder ("VTR" or "Betamax") manufactured by defendant Sony and commercially exploited by its codefendants. It enabled the consumer to videotape copyrighted television product off the air for later private viewing (a practice referred to as "time-shifting") and potentially also for library purposes (i.e., to keep the tape copy for as long as the television viewer desired repeat viewings). Plaintiff Universal sought to enjoin production of Sony's Betamax VTR, which consisted of three basic components: "(1) a tuner, which receives electromagnetic signals transmitted over the television band of the public airwaves and separates them into audio and visual signals; (2) a recorder, which records such signals on a magnetic tape; and (3) an adapter, which converts the audio and visual

work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission." 17 U.S.C. § 106 (emphasis added).

26. *See, supra*, Chapter 7: *Fair Use—Part One: An Introduction*. It should also be noted that, in addition to Section 107, other limitations on the copyright owner's rights are set forth in Sections 108 through 121 of the Copyright Act.

27. 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984).

signals on the tape into a composite signal that can be received by a television set."[28]

The Betamax also provided the following advantages: (1) it was capable of permitting the viewer to watch one program live, while recording another being broadcast simultaneously on another channel for later viewing ("time-shifting"); (2) after having been recorded, tapes could be erased, either before or after viewing them; (3) tapes could be reused; (4) a timer could be used to activate and de-activate the equipment at predetermined times, enabling the Betamax user to record programs broadcast when he or she was not at home; and (5) the Betamax, since it was equipped with a pause button and fast-forward control, could be used to omit commercials from the recording, a feature that could be activated only when the viewer was present as the program was being recorded.[29]

Plaintiff Universal argued that Sony and its codefendants were secondary infringers. In the bench trial, the district court, in extensive findings of fact and conclusions of law, denied all relief requested by plaintiffs and entered judgment for Sony and its codefendants.[30] The district court also held that, even though some of the uses made available by the Betamax VTR would constitute copyright infringement, the VTR was a "staple article of commerce" capable of noninfringing uses to record noncopyrighted material and material whose owners consented to copying of their works.[31] The Ninth Circuit reversed the district court's judgment, holding that the Sony Defendants were liable for contributory infringement with a remand to the district court to fashion appropriate relief.[32] The Supreme Court reversed the Ninth Circuit.

b. Vicarious and Contributory Infringement

In its reversal of the Ninth Circuit's opinion regarding the issues of vicarious and contributory infringement, the Supreme Court first turned to the Patent Act for Congress' treatment of "contributory infringers" for analogous treatment in the context of copyright infringement.[33] The Court laid the groundwork

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28. 464 U.S. at 422, 104 S. Ct. at 778.
29. *See id*. at 422–23, 104 S. Ct. at 778–79.
30. *See* Universal City Studios, Inc. v. Sony Corp. of Am., 480 F. Supp. 429 (C.D. Cal. 1979), *rev'd*, 659 F.2d 963 (9th Cir. 1981), *rev'd*, 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984).
31. *Id*. at 459–61.
32. 464 U.S. at 427–28, 104 S. Ct. at 781–82.
33. Section 271 of the Patent Act provides, in relevant part:

> "(b) Whoever actively induces infringement of a patent shall be liable as an infringer.
>
> . . .
>
> "(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension

for holding that Sony and its codefendants were not *contributory infringers* by reviewing Justice Holmes's opinion in the 1911 copyright case of *Kalem Company v. Harper Brothers, Inc.*[34] when it observed that "Justice Holmes stated that the producer had 'contributed' to the infringement of the copyright, and the label 'contributory infringement' has been applied in a number of lower court copyright cases involving an ongoing relationship between the direct infringer and the contributory infringer at the time the infringing conduct occurred. In such cases, as in other situations in which the imposition of vicarious liability is manifestly just, the 'contributory' infringer was in a position to control the use of copyrighted works by others and had authorized the use without permission from the copyright owner. This case, however, plainly does not fall in that category. The only contact between Sony and the users of the Betamax that is disclosed by this record occurred at the moment of sale. The District Court expressly found that 'no employee of Sony, Sonam or DDBI had either direct involvement with the allegedly infringing activity or direct contact with purchasers of Betamax who recorded copyrighted works off-the-air. . . . And it further found that 'there was no evidence that any of the copies made by Griffiths or the other individual witnesses in this suit were influenced or encouraged by [Sony's] advertisements.'"[35]

The Court concludes (continuing its interchanging of "vicarious" with "contributory" infringement) when it states that "[i]f vicarious liability is to be imposed on Sony in this case, it must rest on the fact that it has sold equipment with constructive knowledge of the fact that its customers may use that equipment to make unauthorized copies of copyrighted material. There is no precedent in the law of copyright for the imposition of vicarious liability on such a theory. The closest analogy is provided by the patent law cases to which it is appropriate to refer because of the historic kinship between patent law and copyright law."[36]

Among the functions provided by the Betamax, time-shifting was the only act of copying that clearly constituted a fair use. The Court therefore held that time shifting, whether authorized or unauthorized, was nonactionable because "the record and findings of the District Court lead us to two conclusions. First, Sony demonstrated a significant likelihood that substantial numbers of

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of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; *(2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent. . . .*"

35 U.S.C. § 271(b) & (d) (emphasis added).

34. *See* 464 U.S. at 435–37, 104 S. Ct. at 785–86 (reviewing and citing Kalem Co. v. Harper Bros., Inc., 222 U.S. 55, 32 S. Ct. 20, 56 L. Ed. 92 (1911)).

35. *Id.* at 437–38, 104 S. Ct. at 786–87 (citations omitted).

36. *Id.* at 439, 104 S. Ct. at 787.

copyright holders who license their works for broadcast on free television would not object to having their broadcasts time-shifted by private viewers. And second, respondents failed to demonstrate that time-shifting would cause any likelihood of nonminimal harm to the potential market for, or the value of, their copyrighted works. The Betamax is, therefore, capable of substantial noninfringing uses. Sony's sale of such equipment to the general public does not constitute contributory infringement of respondents' copyrights."[37]

2. *A&M Records, Inc. v. Napster, Inc.*[38]

Napster, Inc., through its MusicShare software, provided the means of transmission of MP3 music files between and among its users. Among the developing short-form expressions to "label" this practice spawned by new technology, this one is known as "peer-to-peer" ("P2P") file-sharing. "Napster allows its users to: (1) make MP3 music files stored on individual computer hard drives available for copying by other Napster users; (2) search for MP3 music files stored on other users' computers; and (3) transfer exact copies of the contents of other users' MP3 files from one computer to another via the Internet."[39] It is also to be noted that (1) none of the pirated songs are stored on Napster's server, but rather on the computers of its users; and (2) the exchange of music files never takes place through Napster's server, which only provides information to facilitate the transaction between the two users. In order to activate file-sharing, Napster provided its MusicShare software to its users free of charge to be downloaded from its Internet site, and from Napster's network servers and server-side software. Napster's involvement in this process, however, did not stop there, but continued as follows: Napster provided support for indexing and searching files; obtained through its server software the address of the "host user" (the one whose file of copied music is to be shared) and the P2P user requesting the MP3 file; and the stored of MP3 file names on a server-side library under the user's name to make the information available to other users.

The district court, in granting a preliminary injunction, found that: (1) there was a likelihood that plaintiffs would succeed on the merits; and (2) the balance of hardships resulting from a preliminary injunction tipped in plaintiff's favor. It thus enjoined Napster "from engaging in, or facilitating others in copying, downloading, uploading, transmitting, or distributing plaintiffs' copyrighted musical compositions and sound recordings, protected by either

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37. *Id.* at 456, 104 S. Ct. at 795–96. *See also, supra*, Chapter 7: *Fair Use—Part One: An Introduction.*
38. 239 F.3d 1004 (9th Cir. 2001).
39. *Id.* at 1011.

federal or state law, without express permission of the rights owner."[40] It found that "Napster, Inc. maintains and supervises an integrated system that users must access to upload or download files,"[41] unlike the facts in *Sony* where, "'[t]he only contact between Sony and the users of the Betamax . . . occurred at the moment of sale.'"[42]

The Ninth Circuit affirmed in part and reversed in part and remanded to the district court for further proceedings to modify the preliminary injunction, which the court stayed until the district court amended the preliminary injunction to conform with its opinion. After rejecting Napster's fair use arguments, the court turned to the issue of secondary liability for copyright infringement. With respect to contributory infringement, the appellate court quoted *Gershwin Publishing Corporation v. Columbia Artists Management, Inc*. that "'one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another, may be held liable as a 'contributory' infringer.'"[43] Based on Napster's conduct, the court held that it "knowingly encourages and assists the infringement of plaintiffs' copyrights."[44] In reaching this result, the court held that Napster knew or had reason to know of the direct infringement by its users and therefore made a material contribution to the infringing activities, underscoring the district court's conclusion that "'without the support services defendant provides, Napster users could not find and download the music they want with the ease of which defendant boasts'" and that "'Napster is an integrated service designed to enable users to locate and download MP3 music files.'"[45]

In analyzing vicarious infringement, the Ninth Circuit observed that this theory was an extension of the doctrine of *respondeat superior* and therefore extended beyond a employee relationship where the defendant "'has the right and ability to supervise the infringing activity and also has a direct financial interest in such activities.'"[46] It rejected Napster's argument that it had no direct financial interest in the infringing activities, finding that "[f]inancial benefit exists where the availability of infringing material 'acts as a 'draw' for customers.'"[47] It also found that Napster had "the right and ability to supervise its users' conduct" as determined by the district court when it observed that

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40. A&M Records, Inc. v. Napster, Inc., 114 F. Supp. 2d 896, 927 (N.D. Cal. 2000), *aff'd in part, rev'd in part*, 239 F.3d 1004 (9th Cir. 2001).
41. *Id*. at 916.
42. *Id*. at 916–17 (quoting Sony Corp. of Am. v. Universal City Studios,, Inc., 464 U.S. 417, 438, 104 S. Ct. 774, 787, 78 L. Ed. 2d 574 (1984)).
43. 239 F.3d at 1019 (quoting Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc., 443 F.2d 1159, 1162 (2d Cir. 1971)).
44. *Id*. at 1020.
45. *Id*. at 1022 (quoting A&M Records, Inc. v. Napster, Inc., 114 F. Supp. 2d at 919–20).
46. *Id*. at 1022 (citations omitted).
47. *Id*. at 1023 (citations omitted).

"'its improved methods of blocking users about whom rights holders complain . . . is tantamount to an admission that defendant can, and sometimes does, police its service.'"[48] In addition, Napster reserved its "'right to refuse service and terminate accounts in [its] discretion, including, but not limited to, *if Napster believes that user conduct violates applicable law . . . or for any reason in Napster's sole discretion, with or without cause.*'"[49] Stating that it was bound by the holding in *Sony*, the Ninth Circuit nevertheless found enough evidence to support the district court's finding that the plaintiffs would likely prevail on the issue that Napster had knowledge of the infringements of plaintiffs' copyrights resulting from file-sharing over its system.[50]

3. *In re Aimster Copyright Litigation*[51]

John Deep, the defendant/appellate, was the mastermind driving Aimster's activities, where the Aimster service was attempting to be the alternative to the recently shuttered Napster. It is therefore no surprise that the technology and protocols employed by Aimster were essentially the same as those at issue in the Napster cases, with one marked difference: Aimster made its services available to its users by piggybacking on AOL's instant-messengering system. As Judge Posner of the Seventh Circuit observed: "[t]he fact that copyrighted materials might sometimes be shared between users of such a system [referring to AOL's IM service] without the authorization of the copyright owner or a fair-use privilege would not make the firm a contributory infringer. Otherwise AOL's instant-messaging system . . . might be deemed a contributory infringer" because some of the attachments on AOL's service were copyrighted material.[52] Thus, by piggybacking on AOL's instant-messaging service, people could swap files when users of the Aimster system went online and connected in a chat room enabled by the AOL IM service. The district court granted a preliminary injunction that resulted in Aimster being shut down.

The opinion for the Seventh Circuit, written by Judge Posner, nicely capsulizes the rationale for framing the liability issue in terms of "contributory infringement" when discussing direct infringers—those who swap computer files containing digital copies of copyrighted music. It provides the rationale for affirming the decision of the district court, but it explains that "[r]ecognizing the impracticability or futility of a copyright owner's suing a multitude of individual infringers, . . . the law allows the copyright holder to sue a contributor to the infringement instead, in effect as an aider and abettor. Another

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48. *Id.* (quoting *Napster*, 114 F. Supp. 2d at 920–21).
49. *Id.* at 1023 (emphasis added).
50. *See id.* at 1024.
51. 334 F.3d 643 (7th Cir. 2003), *cert. denied*, 540 U.S. 1107, 124 S. Ct. 1069, 157 L. Ed. 2d 893 (2004).
52. *Id.* at 647.

analogy is to the tort of intentional interference with contract, that is, inducing a breach of contract."[53]

Even though the participation of file sharing is active and substantial, the exchange of music files did not take place in Aimster's server, but rather between the computers of the requesting user and the host user. The court rejected Deep's argument that Aimster's situation was akin to the Sony Betamax videotape recorder in that, like the Betamax, Aimster's proprietary software (provided free of charge to the user) was capable of non-infringing uses. The court pointed out that Deep did not demonstrate that Aimster could be used for non-infringing purposes, but it also rejected his argument that, since Aimster was encrypted, Aimster was prevented from knowing which songs were being copied. This reduction to absurdity ended with the claim that Aimster therefore had no knowledge of infringing uses required to prove contributory infringement. The court, in a few dismissive sentences, rejected that contention: "Willful blindness is knowledge, in copyright law (where indeed it may be enough that the defendant *should* have known of the direct infringement . . . as it is in the law generally. . . .). One who, knowing or strongly suspecting that he is involved in shady dealings, takes steps to make sure that he does not acquire full or exact knowledge of the nature and extent of those dealings is held to have a criminal intent . . . because a deliberate effort to avoid guilty knowledge is all that the law requires to establish a guilty state of mind."[54]

To bury further the contention regarding Deep's and Aimster's knowledge of their users' infringing activities, a tutorial for using Aimster gave as examples of materials for file-sharing only those works protected by copyright, including the previously unauthorized copying of music of which the recording industry had notified Aimster were copyrighted works that were being infringed.[55]

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53. *Id*. at 645–46 (citations omitted).

54. *Id*. at 650 (emphasis in original) (citations omitted).

55. *See id*. at 651–52. Judge Posner then provides the following colorful analogy the meaning of which could escape only innocent children or unworldly adults: "There are analogies in the law of aiding and abetting, the criminal counterpart to contributory infringement. A retailer of slinky dresses is not guilty of aiding and abetting prostitution even if he knows that some of his customers are prostitutes—he may even know which ones are. . . . The extent to which his activities and those of similar sellers actually promote prostitution is likely to be slight relative to the social costs of imposing a risk of prosecution on him. But the owner of a massage parlor who employs women who are capable of giving massages, but in fact as he knows sell only sex and never massages to their customers, is an aider and abettor of prostitution (as well as being guilty of pimping or operating a brothel). . . . The slinky-dress case corresponds to *Sony*, and, like *Sony*, is not inconsistent with imposing liability on the seller of a product or service that, as in the massage-parlor case, is capable of noninfringing uses but in fact is used only to infringe. To the recording industry, a single known infringing use brands the facilitator as a contributory infringer. To the Aimsters of this world, a single noninfringing use provides complete immunity from liability. Neither is correct." *Id*. at 651 (citations omitted).

The court affirmed the decision of the district court, though it expressed "less confiden[ce]" than the district judge that the "recording industry would . . . be likely to prevail on the issue of vicarious infringement should the case be tried."[56]

4. *Grokster* and a New Look at Inducement

In *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*[57] the Supreme Court, in addition to its holding finding the defendants liable for contributor infringement, provides an analytical overview of those circumstances where secondary liability will be found by conduct at opposite ends of a continuum. The two defendants, Grokster, Ltd. and StreamCast Networks, Inc., set up a peer-to-peer ("P2P") file-sharing network by distributing software products free of charge to potential users with a view toward selling advertising on the network and then streaming the ads to its users. The principle advantage of a P2P network is that it permits and facilitates the exchange of files directly from one user to another, thereby eliminating the need for a central server to mediate the exchange of files or information and dispensing with the high-band communication capacity needed for a server, as well as the need for costly storage space. This results in faster transmission in sharing files.

Plaintiffs showed that the most popular uses for the Grokster and StreamCast services were for the unauthorized sharing of copyrighted music and video files. In addition, the MGM plaintiffs hired a statistician to conduct a systematic search of the networks, and his report showed that approximately 90% of the files available for download were protected by copyright. In response, defendants argued that significant non-infringing uses were potentially available, including new audiences acquired by musical performers who distributed their copyrighted works free of charge and by some distributors of unprotected content who distributed various files (e.g. works of Shakespeare). Plaintiffs' evidence, however, established that over 100 million copies of the software in question were downloaded resulting in billions of files being shared across the networks each month, which would result in a "staggering scope" of copyright infringement.[58] Grokster and StreamCast did not contest the fact that there were infringements in most downloads, claiming they were passive recipients of information about infringing uses. This contention was belied by the evidence, however. For example: (1) MGM notified the defendants of "8 million copyrighted files that could be obtained using their software;"[59] (2) after Napster was sued for infringement, Grokster and StreamCast

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56. *Id*. at 654.
57. 545 U.S. 913; 125 S.Ct. 2764; 162 L.Ed. 2d 781 (2005).
58. *See id*. at 923, 125 S. Ct. at 2772.
59. *Id*.

solicited Napster users with software compatible with Napster's software for downloading files;[60] and (3) StreamCast exerted substantial efforts to attract former Napster users to its network should that company be forced out of business, in which event "[it would] be positioned to capture the flood of their 32 million users that will be actively looking for an alternative," as quoted from an email written by a StreamCast executive.[61] One of StreamCast's proposed advertisements put the following statement and questions to prospective users: "'Napster Inc. has announced that it will soon begin charging you a fee. That's if the courts don't order it shut down first. What will you do to get around it?'"[62] The evidence against Grokster was also revealing: Grokster's own "OpenNap" contained codes enabling users to look for "Napster" or "free file sharing" which would direct the user to Grokster's website. Its software also provided users with the ability to search for "Top 40 songs" which, because of their popularity, were obviously copyrighted.[63]

The Court, in addressing the rationale for secondary liability, advises us that, when a widely shared service or product is used to commit infringement, it may be impossible to enforce rights in the protected work effectively against all direct infringers, leaving one practical alternative: sue the distributor of the copying device for secondary liability on a theory of contributory or vicarious infringement. "One infringes contributorily by intentionally inducing or encouraging direct infringement . . . and infringes vicariously by profiting from direct infringement while declining to exercise a right to stop or limit it."[64]

The Court distinguished *Grokster* from *Sony* as follows:

- First, the Court in discussing *Sony* observes that "the only conceivable basis for imposing liability was on a theory of contributory infringement arising from [Sony's] sale of VCRs to consumers with knowledge that some would use them to infringe. . . . But because the VCR was 'capable of commercially significant noninfringing uses,' we held the manufacturer could not be faulted solely on the basis of its distribution,"[65]
- Second, after leaving intact the *Sony* decision regarding a safe harbor for technology that is "capable of commercially significant noninfringing uses" the Court stated that "[i]n sum, where an article is 'good for nothing else' but infringement, . . . there is no legitimate public interest in its

60. *See id*. at 924–25, 125 S. Ct. at 2772–73.
61. *Id*. at 925, 125 S. Ct. at 2773.
62. *Id*.
63. *See id*. at 925–26, 125 S. Ct. at 2773–74.
64. 545 U.S. at 930, 125 S. Ct. at 2776 (citations omitted).
65. *Id*. at 931–32, 125 S. Ct. at 2777 (quoting Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 442, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984)).

> unlicensed availability, and there is no injustice in presuming or imputing an intent to infringe."[66]

The Court remanded to the lower court to determine whether Grokster and StreamCast were liable as contributory infringers, emphasizing that "[t]he rule on inducement of infringement as developed in the early cases is no different today. Evidence of 'active steps . . . taken to encourage direct infringement' . . . such as advertising an infringing use or instructing how to engage in an infringing use, show an affirmative intent that the product be used to infringe, and a showing that infringement was encouraged overcomes the law's reluctance to find liability when a defendant merely sells a commercial product suitable for some lawful use."[67]

Comment

Although the Court observes that "the rule on inducement" is the same today as it was in the past, it does appear that something has been added; that is, by requiring that *affirmative intent* of the alleged infringer must now be demonstrated, an apparently new evidentiary requirement is added to prove a highly particularized type of intent. This very specific requirement creates a problem for those moving for summary judgment: Proof of *affirmative intent* would appear to raise a "genuine issue of material fact" and could arguably foreclose summary judgments, especially since counsel will now be wrestling with various levels of intent to find the right amount of *affirmative intent* supporting the grant of a summary judgment. As usual, the answer will be provided on a case-by-case basis exploring various factual permutations of *affirmative intent*.

C. File-Sharing and Infringement: Targeting the Downloaders

The financial and tactical reasons for actions against manufacturers of technology capable of digital copying, file-sharing websites, and others facilitating or inducing infringements are the following: (1) they are known and available targets that provide the means to infringe copyrighted works; (2) the individuals using technology to copy—whether off the air, (e.g., a television program, motion picture, etc.) or by downloading from a website—are either unknown (the former) or too numerous to justify suing them individually or even in groups (the latter); and (3) the actions against these manufacturers

66. *Id.* at 932, 125 S. Ct. at 2777 (citations omitted).
67. *Id.* at 936, 125 S. Ct. at 2779 (citations omitted).

and websites send a message to the "consumers" who are the direct or primary infringers. The record labels did not, however, write off the primary (or direct) infringers as targets. Cease and desist letters were, and are still, being sent to them and, where deemed advisable, the record labels and their lawyers, select particular infringers to sue. These targets have included college students,[68] a single mother[69] and, recently, a fourteen-year-old boy.[70] These filings attract the attention not only of the press, but also of other infringers, some of whom get the message and abandon their infringing ways. The war on infringers, however, has not halted the copying of protected music through file-sharing.

A reported appellate opinion involving a primary infringer—*BMG Music v. Gonzalez*[71] —is worth noting, not necessarily as an example of a familiar fact pattern, but rather for the Seventh Circuit's statements and the rationale on which its opinion is grounded. In *BMG Music*, the defendant, Cecilia Gonzalez, downloaded more than 1,370 copyrighted songs during a few weeks. She claimed that she downloaded the music merely to listen to it to determine whether she wanted to buy it. She asserted that her downloading was a fair use. In support of this defense, she contended that she had purchased legitimate compact discs containing some of the songs she downloaded. She did not, however, erase the copies of 30 downloaded songs that she decided not to buy. There was no dispute that BMG owned the copyrights for each of these 30 songs, thus leaving no genuine issue of material fact as a matter of law.

The district court granted BMG's motion for summary judgment, issued an injunction and awarded $750 statutory damages for each of the 30 songs, or a total of $22,500. The Seventh Circuit affirmed and rejected Gonzalez's fair use and other defenses. The court also showed no sympathy for the defendant, as summed up in the following comments:

> Licensed Internet sellers, such as the iTunes Music Store, offer samples—but again they pay authors a fee for the right to do so, and the teasers are just a portion of the original. Other intermediaries (not only Yahoo! Music Unlimited and Real Rhapsody but also the revived Napster, with a new business model) offer licensed access to large collections of music; customers may rent the whole library by the month or year, sample them all, and purchase any songs they want to keep. New technologies, such as SNOCAP, enable authorized trials over peer-to-peer systems. . . .

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68. ***See*** *Record Labels Launch New Campaign Against Music File Sharing On Campuses*, 75 Pat., Trademark & Copyright J. (BNA) 162–63 (Dec. 14, 2007).
69. *See* David Kravets, *RIAA Jury Finds Minnesota Woman Liable for Piracy, Awards $220,000*, Wired Oct. 24, 2007, http://blog.wired.com/27bstroke6/2007/10/riaa-jury-finds.html.
70. *See* Electra Entm't. Group, Inc. v. McDowell, 84 U.S.P.Q.2d 1850 (M.D. Ga. 2007); *see also Music Downloading Teen's Innocence Is Fact Question Allowing Jury Trial*, 75 Pat., Trademark & Copyright J. (BNA) 63–64 (Nov. 16, 2007).
71. 430 F.3d 888 (7th Cir. 2005).

> Authorized previews share the feature of evanescence: if a listener decides not to buy (or stops paying the rental fee), no copy remains behind. With all of these means available to consumers who want to choose where to spend their money, downloading full copies of copyrighted material without compensation to authors cannot be deemed "fair use."[72]

In other words, there is no excuse for free downloads when there are sources to purchase copyrighted music legitimately at reasonable prices. A potential benefit will come from lower prices for CDs, and individual selections from those CDs, which will alleviate the need to copy because of what some perceive to be exorbitant prices for a CD or selection from that CD. As a result, the number of unauthorized downloads of copyrighted music should decrease substantially.

IV. The Reduced Role of Digital Rights Management ("DRM")

A. The Digital Millennium Copyright Act ("DMCA")

The DMCA was implemented by the United States on May 14, 1988. Its anti-circumvention provisions are codified in Section 1201 of Title 17 of the United States Code, the effect of which provisions is to criminalize the manufacture, distribution, and sale of technology that provides the means to circumvent methods restricting unauthorized copying of works protected by copyright.[73] These methods restricting unauthorized copying of copyrighted works, known as Digital Rights Management or DRM, include features such as limiting the number of playings allowed and/or the number of copies made, restricting ability to play music using certain devices and brands, and automatic erasure of downloaded content after a fixed period of time.

B. The Current State of DRM

In a few words: DRM is no longer an effective means to limit unauthorized copying. It is in the process of becoming obsolete because DRM technology has neither eliminated, limited, nor even made the proverbial dent in this virtually unchecked copying. As discussed below, major labels and publishers have recognized DRM's limitations and, in response, have launched new business

72. *Id.* at 891 (citations omitted).
73. *See* 17 U.S.C. § 1201.

models, the most significant being the availability of DRM-free recorded music to consumers.[74] This is, in great part, the result of a dramatic demonstration of "civil disobedience" involving one DJ Danger Mouse, which is chronicled in the following section.

C. A Demonstration of Civil Disobedience

1. Background: Sampling and Mashups

On February 24, 2004, a demonstration took place over the Internet, the *modus* for which was the massive downloading of a mashup of a Beatles album and a Jay-Z rap vocal. Before discussing the impact of the demonstration conducted by the downloading of the file containing this mashup, a brief description of a sample and a mashup will set the stage for the event and its importance.

2. Sampling and Mashups

a. Sampling

Mashups are an outgrowth of enabling through technology digitally copying of the exact sounds embodied in a digital recording. The word "sample" is used because this practice usually involves a brief snippet from a sound recording that is then used in another recording, usually for an effect desired by the creator of the second recording. Examples of this technique are found in recordings by Eminem, Dr. Dre, and the Beastie Boys, among others.

b. Mashups: a Musical Collage

The observations of Professor Kaplan quoted at the beginning of this chapter regarding the tensions between copyright law and new technology are dramatically illustrated by a new form of artistic expression given various names, the name most widely used currently being "mashups."[75]

What distinguishes a mashup from a digital sample is that all or a portion of *two* existing works are digitally copied and the music track from one song is then combined with an *a cappella* vocal track from another. The aim of the creator of a mashup is to juxtapose music and a vocal performance (whether melody or rap) from genres, styles, and even disparate philosophies, political

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74. *See* Caroline McCarthy *EMI, Apple Partner On DRM-free Premium Music*, CNET News.com, Apr. 2, 2007, http://www.news.com/EMI%2C-Apple-partner-on-DRM-free-premium-music/2100-1027_3-6172398.html.
75. Other names include, among others, "bootlegs," "boots," "bastard pop," "edits," and "remixes."

views, etc., which, through rearrangement (sometimes including distortion of the copied samples), will produce a logically integrated work. Mashups, as digital sampling did at an earlier time, not only created a multitude of aficionados of this new form of artistic expression, but also attracted the attention of the recording industry. The mashup became another catalyst for igniting the issue between those trying to protect their copyrights and to prevent people from stealing their work without having to provide compensation to the artists, on the one hand, and consumers, on other hand, who—especially those in this Internet age of file-sharing—raised the flag of free expression (whether innocently or cynically), and vigorously advanced their position that the mashup is an example of artistic expression that the music recording industry was trying to crush. The truth, of course, lies somewhere between these two hard-and-fast positions. The mashup album that generated this controversy and precipitated a confrontation between the record labels, on the one hand, and the Alliance of Digital Samplers, creators of mashups, various advocates and committees and websites devoted to the cause of free use of digital samples, on the other hand, is known as *The Grey Album*.

c. *The Grey Album:* A Symbolic Day of Civil Disobedience

The creator of *The Grey Album* was a twenty-six-year-old man named Brian Burton, professionally known as DJ Danger Mouse. In December of 2003, Danger Mouse digitally sampled vocals from a recording by Jay-Z entitled *The Black Album* and laid those vocals over music sampled from the Beatles' *White Album*—with the slyly humorous title *The Grey Album*. Danger Mouse describes his moment of inspiration as follows: "'I had gotten the Jay-Z vocal tracks and wasn't going to do anything with them. . . . A week or so after that, I was at home in Los Angeles, listening to the Beatles and cleaning up my room. Then it hit me: Oh shit, 'White Album,' 'Black Album' . . . I can probably do this.'"[76]

In creating *The Grey Album*, DJ Danger Mouse, through the miracles that can be accomplished by the use of a computer, broke down the component parts of *The White Album* to create beats integrated with Jay-Z's lyrics. As this was to be an underground operation flying below the radar, DJ Danger Mouse pressed only 3,000 copies of *The Grey Album*. Through the Internet and by word of mouth, *The Grey Album* generated tremendous enthusiasm and drew the displeased attention of EMI, which controlled the sound recording of the Beatles, and of Sony Music/ATV Publishing, a venture between Sony Music and Michael Jackson, who owned the Beatles' catalogue. Lawyers for EMI served cease and desist letters on DJ Danger Mouse, on record stores stocking *The Grey Album*, and on websites making *The Grey Album* available

76. Ben Greenman, *The Mouse That Remixed,* The New Yorker, Feb. 9, 2004, at 24.

for downloading. By so doing, however, EMI and Sony placed not only the controversy in focus but also provided *The Grey Album* with the type of publicity its creator never could have purchased. This erupted into postings of MP3s on the websites and blogs of bootleg music lovers, finally culminating in a Ghandi-like outbreak of civil disobedience among music-loving denizens of the web. The force behind this mass Internet demonstration to save *The Grey Album* was a website, Downhill Battle. One of its founders, Nicholas Reville, issued the following plea that "[r]emixes and pastiche are words defining aesthetics of our era. How will artists continue to work if corporations outlaw what they do? Artists and musicians have always borrowed and built upon each other's work. . . .now they have to answer to corporate interests."[77] In further addressing this issue, Reville in a very basic fair use argument stated that "[i]t's clear that this work devalues neither of the originals. There is no legitimate artistic or economic reason to ban this record. . . .this is just arbitrary exertion of control."[78]

With this type of zeal and a compelling sense of righteousness, Downhill Battle called for *A Grey Album Day* on February 24, 2004, which encompassed a twenty-four-hour period during which members of the public could download *The Grey Album* free of charge in open defiance of the threat of litigation from EMI. In that twenty-four-hour period, all participating websites transferred over 100,000 copies of *The Grey Album* to members of the public. For that day, *The Grey Album* was purportedly the number one "selling" album in the United States. With a massive demonstration of support such as this one, even though no one was keeping score, EMI lost the battle—and perhaps the war—from what may be the eventual fallout from this dramatic and highly visible confrontation in the continuing war between content owners and consumers armed and emboldened by the technology they can now use for copying.

d. EMI Makes A Move: Others Follow

The following events represent a shift away from DRM among major labels.

- In the aftermath of *Grey Album Day*, EMI, the second largest major label, took a significant step in a deal with iTunes. Confronting the problem of unauthorized downloads, EMI granted a license to Apple Computer authorizing downloads from iTunes at $0.99 per song. The

77. Posting of disbooya to zeropaid.com, http://www.zeropaid.com/news/3966/Music+Industry+Outlaws+Best+Album+of+the+Year, *Music Industry Outlaws Best Album of the Year* (February 11, 2004).

78. *Id.*

consumers for these downloads were, however, restricted as to their uses of the downloaded songs (e.g., the music could not be played on all computers; the downloaded tracks would be erased after a limited period of time; and the tracks could only be replicated or shared a limited number of times). In January 2007, EMI stopped pressing audio CDs with DRM protection. In March 2007, EMI granted a license to Apple to issue DRM-free downloads (i.e. without restrictions, the charge for which was approximately 30% higher than the $0.99 applying to limited uses by the consumer). In August, EMI, facing the inevitable, authorized Apple to sell all music licensed to it DRM free for $0.99 per song.[79] The Beatles songs controlled by EMI, however, were not part of EMI's agreement with Apple.

- Sony BMG implemented DRM for its CDs in 2005. The problem: DRM could be easily bypassed, resulting in extremely limited protection to prevent copying. When the defects in its DRM system became apparent, Sony BMG was also plagued with a number of class-action suits that were settled either by cash payments or free downloads to the class of plaintiffs.
- In August 2007, Universal Music Group ("UMG") authorized gbox, a startup company selling songs for $0.99 each, to sell unrestricted UMG tunes encoded on MP3s which can be played on virtually all computers in many regions of the globe.[80]
- In September 2007, Amazon launched the Amazon MP3 store, a DRM-free online music store. Its "library" encompasses more than 2.9 million tracks of music from 33,000 different labels. UMG and EMI have both entered into agreements with Amazon, along with a number of independent labels. Individual music tracks are priced from $0.89 to $0.99, albums from $5.99 to $9.99.
- In December 2007, Sony BMG decided to make the performance of specific artists DRM-free.
- In December 2007, Amazon.com and Warner Music Group ("WMG") announced that WMG's entire catalog would be available DRM-free for partners of Amazon's MP3 store. Thus all four major labels—UMG, EMI, WMG, and Sony BMG—have instituted DRM-free downloads in varying degrees.

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79. An exception to the $0.99 per song rate was made for higher-quality music files, which sell for $1.99 per song. Digital files for both are available.
80. The months in this bullet-point and the following bullet-points are included, because these dates are within a single year—2007—and thus demonstrate how quickly events occur when businesses are responding to both the advance of and the threat from new technology.

As one analyst (with Yankee Group), Michael Goodman, put it, "'The music industry has clearly and completely capitulated on DRM, but is it too little too late? . . . The power shift from the labels to the artists has already begun. The labels are well on their way to becoming simply music distributors, not unlike your local beer distributor.'"[81]

e. The Artists' Declaration of Independence

i. Radiohead's Unorthodox Release of In Rainbows: *Part One*

In October 2007, the music group Radiohead released its album *In Rainbows* online for downloading by the public. The terms of sale: Buyers could pay whatever they wished ranging from zero to £99.99 for the album (or about $212 more or less depending on the exchange rate). Along with Radiohead's release via the Internet, and the multitude of songs and albums made available on the Internet during 2007, were two events that made 2007 a watershed year in the music business: Prior to taking this audacious step, Radiohead not only elected not to renew its relationship with EMI, but also turned down a multimillion dollar deal from another major label.[82]

ii. Radiohead's Unorthodox Release of In Rainbows: *Part Two*

In the first week of January 2008, following the group's unorthodox release (i.e., with the price determined by the customer, from nothing to £99.99) on the Internet of *In Rainbows*, the CD album of *In Rainbows* was released to the retail market.[83] At 122,000 copies, it was the best-selling album for that

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81. Casimir Medford, *Amazon, Warner Rock MP3s*, Red Herring, Dec. 27, 2007, http://www.redherring.com/blog/CassimirMedford?bid=23366.

82. During this period, online sales of music accelerated. iTunes took its place as the third largest music retailer in the United States. Equally, if not more important was the sale, offered by Amazon, of physical albums, along with on-line music downloads.

83. On January 1, 2008, in a world dominated by digital files, *In Rainbows* was released, not only on plastic CD, but also on old-fashioned vinyl LPs. As Eric Levin, owner of Criminal Records, an independent record shop in Atlanta, and founder of an 18-member alliance of independent retailers, observed "'[h]aving a physical, archival high-fidelity master recording that you can side-load into your MP3 player of choice for a similar price is significantly better than just purchasing zeroes and ones . . . I feel like that's what 75 percent of the people are saying.'" Mr. Levin also stated that, at his store, the LP "outsold the CD by a wide margin." Jeff Leeds, *Radiohead Finds Sales, Even After Downloads*, N.Y. Times, Jan. 10, 2008, at E1, *available at* http://www.nytimes.com/2008/01/10/arts/music/10radio.html?_r=1&scp=2&sq=radiohead&oref=slogin.

week, though below the sale of 300,000 units for Radiohead's previous album, *The Thief*.[84]

D. Lower Prices, Convenience and the "Price" of Free Downloads: Their Impact on Unauthorized Copying

1. The Hidden "Price" of Free Downloads

At first reading, this subheading seems self-contradictory. The "price," however, is not measured only by dollars or other currencies, but rather by time spent searching files, downloading the wrong files because of inaccurate or misleading titles, potential loss of sound quality (depending on the equipment used), and the possibilities that files may be incomplete or edited, or perhaps contain a virus. The process of unauthorized copying also includes opening firewalls to the portals employed by the user, and sharing an open connection from the user to the Internet, using a search engine to locate the desired file, maintaining an Internet connection while the file is downloaded (which can take many hours), and, once the file is downloaded, it often must be converted from one file format to another, requiring additional software.

2. The Convenience of Purchasing On-Line

Taking into account the lowered prices of downloads, driven in great part by the reduced role of DRM in acting as a brake on unauthorized digital copying, and coupled with the difficulties experienced by some file-sharers (as discussed briefly above), the following scenario should play out in addressing the issue of illegal digital copying:

- Purchases of authorized digital copies should increase because of reasonable pricing practices by the labels and online outlets such as Amazon.com, iTunes Music Store, and the revived and reformed Napster, as examples;
- The major and independent labels, online retail outlets, and recording artists will be in a position to profit in a regime of lower prices and increased volume, driven by what should be a meaningful decrease in unauthorized copying;[85]

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84. Others have either preceded Radiohead or followed similar paths: Lil Wayne, Cam'ron and Kanye West released their own works. Paul McCartney abandoned the major labels and made an arrangement with Starbuck's to create new works for release on its independent label, *Hear Music*.

85. In a report from London, Musical America.com reports that revenue from digital music sales rose by 40% to $2.9 billion during 2007. That is the good news. The bad news is that the

- The courts will have little or no patience or sympathy for a smaller and manageable number of unauthorized downloaders, which should deter this practice;
- If downloaders still persist in unauthorized copying in the face of availability of recorded music at reasonable prices, the copyright owners may then elect to proceed against targeted primary and contributory infringers, this time in an environment less supportive of their activities.

E. Another Invitation to Look Further and Probe Deeper

This invitation is similar to the one extended by the author at the beginning of Chapter 1. In this instance, however, that invitation includes not only looking further and probing deeper into the facts and the law, but also doing so by staying current with the news of improvements in current technology and the discovery and invention of new means for the recording and dissemination of copyrighted works. The reason is obvious, but I will state it anyway: The brief discussion in this chapter about new technology may no longer be applicable in the very near future. The message is clear: Keep abreast of the law—also check the latest in newspapers and magazines, in journals, and on the Internet. In our brave new world, those who fail to embrace the challenges posed by new technology may be left behind.

International Federation of the Phonographic Industry reported "that the increase in legitimate sales did not come close to offsetting the billions of dollars being lost to music piracy, with illegal downloads outnumbering the number of tracks [legitimately] sold by a factor of 20-to-1." Raphael G. Satter, *Digital Music Sales Up 40 Percent*, The Associated Press, Jan. 24, 2008, http://www.msnbc.com/id/22822252.

Postlude

Culture shock is relatively mild in comparison with a much more serious malady that might be called 'future shock'. Future shock is the dizzying disorientation brought on by the premature arrival of the future.

Alvin Toffler in *Horizon* (Summer 1965)[1]

There may be trouble ahead,But while there's moonlight and music and love and romance, Let's Face the Music and Dance.

Irving Berlin[2]

With the enactment of the Statute of Anne in 1710, England witnessed the birth of copyright in a landscape that, until that time, had no system, statutory or otherwise, for the protection of authors' rights. Under the statute, however, the rights granted to creators were limited to books, plays, and maps. It was not until the end of the eighteenth century that composers of musical works won the right to copyright their creations in a written language consisting, not of words or cartography but, rather, of lines and notes, the duration of which was conveyed to the performer by black dots, empty circles, and other symbols; spaces between notes; time signatures; and something called tonality. Creative works became property and the copyright regime, launched in England, migrated to the United States where, under the guiding words of the Constitution, creative individuals were encouraged to write, compose, paint, and sculpt, thus giving artistic life to the original expression in their works, while ensuring that the ideas embodied in those works remained free for all to use.

At the time copyright protection made its appearance in England, copyright did not exist in nations and other political entities located on the European continent. J.S. Bach, Handel, Vivaldi, and others of their time did not consider it stealing if they "borrowed" phrases, even entire works, written by another composer for use in their own compositions. As noted in the

1. The Oxford Dictionary of Quotations 795 (Elizabeth Knowles ed., 6th ed. 2004) (quoting Alvin Toffler, Horizon (1965)). *Future Shock*, Alvin Toffler's best selling book, was published in 1970. *See id.*
2. *Id.* at 69 (quoting, Irving Berlin, *Let's Face the Music and Dance*, *from* Follow The Fleet (1936)). The song "Let's Face the Music and Dance" was composed for and featured in the Broadway Show, *Follow The Fleet*. *See id.*

Prelude to this book, copyright laws were enacted much later on the Continent: France in 1791 and 1793; Prussia (Germany) in 1837; and Italy in 1865. In the United States, through codification and judicial construction, copyright law grew in scope and sophistication (e.g., *the idea/expression dichotomy*). Music catalogs of works were, and still are, aggressively protected under the copyright laws and by performing rights societies such as ASCAP and BMI.

But …

The deference to copyright protection under law is now challenged by the advance of technology, especially when used by individuals who copy protected works without authorization from the copyright owners. As we have noted, before copyright was finally implemented on the European continent, copying from another's work was done routinely without any thought of wrongdoing. Today—in the twenty-first century—the same attitude prevails among consumers who contend that they are entitled to copy from protected works for various reasons, including the justification that they are only tapping into and using "information" and ideas rightfully available to the public. For those who are younger, that code of conduct is all they have known. So, have we come full circle from the early days in Europe to the contemporary world where all works—especially music—are freely copied without any thought of paying the price for the CD or other form that embodies those protected works? Have we spent all this time creating and refining the *idea/expression dichotomy*, only to prepare for its burial?

These questions can be answered in the negative. It is obvious that the march of technology is not going to be halted, and the growing sophistication of devices capable of legitimate uses will not be stopped even though they can also be used for the unauthorized copying of protected works. As demonstrated by the twenty-four-hour civil disobedience demonstration of downloading the *Grey Album* (the mash-up of a Jay-Z rap and the Beatles' *White Album)*, unauthorized copying of copyright protected works cannot be effectively stopped, because of the sheer numbers using these recording devices. It is true that targeted lawsuits against individuals engaged in illegal copying have experienced some success. The actions filed against students in universities and other individuals who copy protected music also send a message that those engaging in illicit copying are not above or beyond the law. There are, however, other approaches that are being tried: for example, iTunes obtains licenses from copyright owners and offers a wide variety of recorded music to their consumers at a price of $.99 per song,[3] and Universal Music Group has entered into an arrangement to place its music on a website for a payment calculated on the extent to which BMG's music is downloaded. At some point in time, with a lowered price for CDs and for individual selections from those CDs, the record labels should sell more units. This may well mirror the decline

3. Please note that not all music on iTunes is priced at $.99.

in costs of manufacture and retail unit prices that occurred after videotape cassettes first went on the market at relatively high prices, only to drop with the passage of time and waning public interest in the content of the cassettes. It may well be that lower prices will also lead to less sympathy for the infringers who copy protected works without authorization.

Leonard Bernstein, in his six Norton Lectures delivered at Harvard University in 1973 collectively entitled "The Unanswered Question," attempted to clarify the American composer Charles Ives' choice of that title for an enigmatic composition by hypothesizing that Ives was asking the question, "Whither Music?" And in the jungle of copyright theory, musical language, and ideas, that is also our question with one slight addition: "Whither Music—and Copyright?"

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