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**Cowan, Liebowitz & Latman**

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**Copyright Review  
2023**

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*“Recent Developments In Copyright”  
Selected Annotated Cases*

By Thomas Kjellberg, Joelle Milov and Dasha Chestukhin

and

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**These annotations cover cases reported since our report at  
the 46th Copyright Society Annual Meeting of 2022.**

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## I. JURISDICTION AND PROCEDURAL ISSUES

### A. Subject Matter Jurisdiction

*Martin v. New Am. Cinema Group., Inc.*, No. 22-5982, 2023 U.S. Dist. LEXIS 26014 (S.D.N.Y. Feb. 15, 2023)

Defendant NACG was non-profit corporation that acted as custodian to certain films and artistic works for benefit of its members. Defendant's collection included film created by plaintiff, for which plaintiff alleged that she possessed copyright registration. In 2019, defendant created digital version of plaintiff's film and rented it to Carnegie Museum for exhibition. Upon discovering that her film was included in exhibit, plaintiff filed suit – styled as class action – alleging that defendant (a) reproduced film without her authorization or knowledge, and (b) created “derivative work” when it produced digital version of plaintiff's film. Defendants moved to dismiss complaint on two grounds: (a) that plaintiff was not alleging copyright claim, but instead breach of contract claim, and therefore, court lacked subject matter jurisdiction, and (b) plaintiff failed to state claim on any of causes of action alleged in complaint, including infringement. As to subject matter jurisdiction, defendants alleged that plaintiff gave them non-exclusive license to distribute film by submitting film to defendant and agreeing to its terms of membership. Plaintiff argued that she only gave defendant permission to rent single original copy of film, and that by creating digital copy and renting it to Carnegie Museum, defendant exceeded scope of limited agreement. Court found that plaintiff facially alleged claim arising under Copyright Act. Court disagreed with defendant's argument that terms of plaintiff's agreement permitted them to create digital version and rent it without prior authorization, finding that review of defendant's materials did not provide any clarity as to scope or terms of agreement with plaintiff. Court therefore held that plaintiff's claim arose under federal law, and defendant's motion to dismiss for lack of subject matter jurisdiction was denied.

*Superama Corp. v. Tokyo Broad. Sys. TV*, No. 22-299, 2022 U.S. Dist. LEXIS 220948 (C.D. Cal. Dec. 6, 2022)

Court granted defendant's motion to dismiss without prejudice based on lack of subject matter jurisdiction. Plaintiff Superama, which organized sumo wrestling in United States, discovered that defendant Tokyo Broadcasting System TV downloaded its copyrighted material from YouTube, altered it, and rebroadcast it throughout Japan without permission. Plaintiff originally sued defendant for copyright infringement under § 501 of Act (“Prior Action”). Court dismissed Prior Action for lack of subject matter jurisdiction, holding that all relevant acts of copyright infringement occurred in Japan. Plaintiff brought instant suit against defendant based on same series of events, but instead argued that defendant violated § 1201 of DMCA by employing “hacking and stream ripping” technology to circumvent YouTube's technological protection measures, which occurred in United States. Court applied *Nabisco's* two-part extraterritoriality test, namely (a) examining whether statutory provision applies extraterritorially on its face, or (b) if case involves domestic application of

statute. Under first prong, court determined that plaintiff had not rebutted presumption against extraterritoriality. Court found that DMCA's technological subject matter is not inherently subject to non-domestic acts given that DMCA was enacted to implement WIPO Treaties – where it was understood that other signatories would enact similar law that would apply in signatories' jurisdictions. Court also rejected plaintiff's argument that language “work protected *under this title*” was another basis for application of extraterritoriality, finding that phrase says nothing about whether act of circumvention may occur abroad, but instead makes clear that protections under provision are only afforded to works under U.S. copyright protection. Under second prong, court disagreed with plaintiff's argument that action sought domestic application of § 1201 because technological measure was on U.S. servers, websites, and streaming services. Court indicated that focus of § 1201 is not technical measure protecting copyrighted work, but rather circumvention of such measures to gain access to copyrighted work. Court rejected plaintiff's theory that location of circumvention is where allegedly pirated content is stored (here, U.S.) and held that there is no basis for finding jurisdiction where stolen material is stored in U.S., but all other circumventing activities occur in another country. It would make little sense to conclude that infringement in this case – download of plaintiff's material – occurred in Japan but that circumvention – stream ripping – occurred in U.S. Court believed that such conclusion would lead to influx of copyright cases where plaintiffs add circumvention claims to wholly foreign infringement claims in order to invoke federal jurisdiction. Therefore, court concluded that circumvention happened in Japan, even though defendant's system may have communicated with U.S. servers in some fashion. Therefore, court lacked subject matter jurisdiction and granted defendant's motion.

*Jamieson v. Hoven Vision, LLC*, No. 22-117, 2022 U.S. Dist. LEXIS 193695 (S.D. Cal. Oct. 24, 2022)

District court denied defendant's motion to dismiss. Plaintiff photographer brought suit against defendant eyewear manufacturer based on defendant's use of plaintiff's images. Defendant moved to dismiss for lack of subject matter jurisdiction, contending dispute was centered around contract, not copyright. Plaintiff claimed subject matter jurisdiction was present because (1) agreement between parties was not reached; (2) even if agreement had been reached, no license was ever granted due to fact defendant never paid plaintiff; and (3) even if agreement had been reached and payment was not conditional, plaintiff already rescinded agreement. Court held that case arose under Act because plaintiff asserted claim for direct and contributory infringement and sought remedy pursuant to Act, and further held that resolution of facts related to subject matter jurisdiction must be left to trier of fact when subject matter jurisdiction is intertwined with claim's merits.

*Fidogenx, LLC v. GMH Tequesta Holdings, LLC*, No. 22-80914, 2022 U.S. Dist. LEXIS 226020 (S.D. Fla. Dec. 15, 2022)

Court granted plaintiff's motion to remand. Since court found no diversity jurisdiction, motion to remand turned on whether there was federal question jurisdiction. Defendant argued that there was federal question jurisdiction because claims related to copyrights.



Court disagreed. Complaint alleged parties entered into Digital Marketing Services Agreement under which plaintiff created landing pages and advertising campaigns. Core issue in case was whether Agreement gave ownership of landing pages, graphic design, and Google Ads campaigns to plaintiff or defendant. Complaint did not reference copyright material or remedies under Act. Dispute would be resolved under state law contract principles, not under Act, and as such federal question jurisdiction not found.

## **B. Personal Jurisdiction and Venue**

*Will Co. v. Ka Yeung Lee*, 47 F.4th 917 (9th Cir. 2022)

Ninth Circuit reversed dismissal of copyright suit for lack of specific personal jurisdiction, finding that Hong Kong website owner chose to host website in Utah to target United States viewers. Plaintiff Japanese adult entertainment producer sued owners and operators of website based in Hong Kong that displayed plaintiff's videos without authorization. District court dismissed for lack of personal jurisdiction, finding that defendants' site was not expressly aimed at United States market, and it was not foreseeable that operating site would cause jurisdictionally significant harm in United States. Ninth Circuit reversed, finding that defendants aimed website at forum state by developing advertising structure intended to cultivate audience in United States, and by hosting site in Utah and purchasing delivery network services to make website faster in North America. Defendants also posted legal compliance pages on site relevant almost exclusively to United States viewers. Because site had almost 1.3 million visits from United States in relevant period, harm was foreseeable. Defendants thus purposefully directed their operation of site at United States viewers, creating specific personal jurisdiction.

*Lang Van, Inc. v. VNG Corp.*, 40 F.4th 1034 (9th Cir. 2022)

Ninth Circuit reversed district court and held that court had personal jurisdiction over defendant. Plaintiff, producer and distributor of Vietnamese music, sued defendant, Vietnamese company that ran website and mobile application that made copyrighted music available for download worldwide, in Central District of California. Defendant itself uploaded infringing content to its website and app; intentionally released its mobile app in United States through Apple and Google; sought and received U.S. trademark registration for its mark based on U.S. use; admitted that it had made plaintiff's songs available for download without plaintiff's authorization, after parties had corresponded about potential licensing; sent letter to U.S. Trade Representative asking that it be removed from international list of internet pirates based on defendant working with U.S. copyright owners such as Sony and Universal; and failed to geoblock U.S. users generally despite geoblocking U.S. users' access to certain U.S. studios' content. Foregoing constituted substantial evidence of plaintiff's intentional direction into U.S. market, which predictably caused harm in United States. As defendant admitted it was not subject to general jurisdiction in any state, court held that exercise of personal jurisdiction over defendant under federal long-arm statute in Fed. R. Civ. P. 4(k)(2) was justified. Venue also proper in California because

plaintiff was located in California, and Vietnam would be inappropriate court to hear U.S. copyright law dispute, due in part to complicated procedures and unpredictable outcomes.

*Hargrove v. Fraport United States Inc.*, No. 22-2038, 2022 U.S. Dist. LEXIS 195921 (E.D.N.Y. Oct. 26, 2022)

Plaintiff alleged that defendants made infringing use of plaintiff's photograph by using image as display outside vacant storefront in Nashville International Airport to promote new James Avery jewelry store. Plaintiff and defendants sought to transfer venue, with plaintiff seeking transfer to Western District of Texas and defendants to Western District of Pennsylvania. Because venue for copyright case is proper where court has personal jurisdiction, court assessed whether exercise of jurisdiction over defendants in Texas was proper. First, court found defendants had sufficient minimum contacts with Texas under *Calder* "effects" test because defendants knew or should have known that effect of actions would be felt in Texas because plaintiff's website clearly stated she was located and worked in Texas, and James Avery's website, other place from which defendants could have appropriated infringing photo, noted company's location in Texas. Second, court found exercise of jurisdiction over defendants in Texas was not unreasonable, even if it would be inconvenient. Court transferred case to Western District of Texas.

*MG Premium Ltd. v. Does*, No. 21-8533, 2022 U.S. Dist. LEXIS 217228 (C.D. Cal. Dec. 1, 2022)

District court denied defendant's motion to dismiss for lack of personal jurisdiction. Plaintiff, copyright owner of adult audiovisual works, sued defendants, owners and operators of adult film sharing website, for allowing users to upload copyrighted adult videos without authorization or license. Sole defendant appeared and moved to dismiss for lack of personal jurisdiction. Court found defendant expressly aimed conduct at U.S. by using U.S.-based CDNs and purchasing domestic domain name hosting services. Website also purported to avail itself of DMCA's safe harbor provision and provided notice of compliance with record-keeping requirements. Court found defendant purposefully directed conduct at United States because U.S.-based visits were substantial. Court determined that plaintiff's claim arose out of defendant's forum-related activities because but for defendant operating website, plaintiff would not have suffered alleged infringements. Court found exercising jurisdiction over defendant reasonable. Court found degree of interjection substantial. Plaintiff was willing to conduct mediation and discovery remotely, so court found defendant's burden to litigate mitigated. Court found exercising jurisdiction would not impinge on sovereignty of India or Cyprus because defendant's relationship to U.S. was substantial. Court determined U.S. had interest in adjudicating plaintiff's claims because alleged infringement directly implicated copyrights. Weighing against exercising jurisdiction, court found litigation in U.S. unlikely to provide most efficient resolution because parties located abroad. But, while not most convenient, most effective at providing relief because copyrights registered in U.S. Court determined plaintiff did not meet burden of establishing no other forum available. Nonetheless, court concluded exercise of jurisdiction comported with fair play and substantial justice.

*Lee v. TV Chosun Corp.*, No. 22-933, 2022 U.S. Dist. LEXIS 209775 (C.D. Cal. Nov. 18, 2022)

District court dismissed copyright infringement complaint because it lacked personal jurisdiction over defendants. Plaintiff, California citizen and owner of Korean composer's musical compositions, sued defendants, entertainment companies based in South Korea, alleging copyright infringement based on their upload of several of plaintiff's copyrighted works to their YouTube channels and streaming platforms. In second amended complaint, plaintiff claimed that defendants (which were not alleged to have any U.S. offices, employees or agents), *inter alia*, operated U.S.-accessible YouTube channel, made television shows available on U.S. Netflix, offered music on U.S.-accessible streaming platforms, and exported karaoke machines to U.S. establishments. Court held that such contacts were not so continuous and systematic as to render defendants at home in California, so general jurisdiction did not exist. Neither did court have case-specific jurisdiction simply because defendants uploaded copyrighted works to their YouTube channel and internet generally. Plaintiff did not allege that defendants profited from their internet uploads or specifically targeted California audience, or that California market was integral to defendants' business model and profitability. Plaintiff thus failed to plead purposeful direction required for exercise of California or federal long-arm jurisdiction.

*Krikor v. Sports Mall LLC*, No. 22-5600, 2022 U.S. Dist. LEXIS 204451 (C.D. Cal. Nov. 9, 2022)

District court denied defendant's motion to dismiss for lack of personal jurisdiction. Defendant owned and managed sportscollectibles.com. "one stop shop for authentic sports memorabilia and sports collectibles." Plaintiff, photographer and owner of photos of sports memorabilia, sued defendant for infringement after discovering his photos were copied from plaintiff's sister's eBay store. Defendant moved to dismiss for lack of jurisdiction. Applying *Calder* "effects test," district court held that (1) defendant directed its conduct towards forum, as defendant's website was targeted at California residents and defendant had at least one employee based in California; (2) it was reasonably foreseeable that harm would be experienced in California where plaintiff resided and did business and infringement arose out of defendant's activities in forum state; and (3) exercise of personal jurisdiction would not offend fair play and substantial justice.

*Riot Games, Inc. v. Suga PTE, Ltd.*, No. 22-429, 2022 U.S. Dist. LEXIS 201598 (C.D. Cal. Nov. 3, 2022)

Court granted in part and denied in part defendants' motions to dismiss. Plaintiff produced, developed, published, distributed, and marketed video games, including "League of Legends" ("LoL"), which game allows teams or champions to battle against one another. Defendant Suga PTE, Ltd. ("Suga") was incorporated in Singapore, and defendant IMBA Technology Co. Ltd. ("Imba") was division or subsidiary of Suga and was mobile game development studio in Vietnam. Non-moving defendant Imba Network, LLC was registered in Delaware. Plaintiff alleged that defendants infringed its works by releasing mobile game

entitled “I Am Hero – AFK Tactical Teamfight,” whose heroes were substantially similar to LoL’s champions. Suga and Imba moved to dismiss for lack of jurisdiction. Court assessed jurisdiction over Imba under Fed. R. Civ. P. 4(k)(2) and held that Imba purposefully directed its actions at United States because it committed an intentional act, as illustrated, *inter alia*, by averments that Imba advertised, marketed, and distributed “I Am Hero” in U.S.; Imba expressly aimed conduct at form, by, *inter alia*, advertising and marketing game to U.S. consumers; and caused harm it knew would be likely to be suffered in forum by including allegations that Imba admitted to similarity between characters in its games and LoL. Court further found claim arose out of Imba’s activities and that exercise of jurisdiction was reasonable. Court denied motion to dismiss as to Imba. Court granted motion to dismiss as to Suga, however. Plaintiff alleged that jurisdiction was appropriate over Suga because it was alter ego or agent of Imba, but court found supporting allegations insufficient. Because its claims for jurisdiction over Suga were not “attenuated,” court granted plaintiff’s request for jurisdictional discovery on alter ego theory.

*Changing the World Films, LLC v. Parker*, No. 21-2787, 2022 U.S. Dist. LEXIS 217947 (D.D.C. Dec. 2, 2022)

Court dismissed infringement claim for lack of personal jurisdiction when no advertisements or promotional activities were directly targeted at Washington D.C. Plaintiffs alleged that Spike Lee film *American Skin*, which debuted at Venice Film Festival, infringed their screenplay. Court found that plaintiffs failed to allege that any of defendants transacted relevant business in District. Plaintiffs alleged that promotional activities for *American Skin* were directed to residents of D.C., but those activities consisted of nationwide broadcasts and social media posts not targeted at D.C. One Instagram post listing theaters across United States at which movie was playing, including one West Virginia theater listed under header titled “Washington, DC,” was not sufficiently targeted. Nor were Spike Lee’s visits to D.C. for reasons unrelated to promoting *American Skin* sufficient to create jurisdiction.

*Brunswick Records Corp. v. Lastrada Entm’t Co., Ltd.*, No. 21-23580, 2022 U.S. Dist. LEXIS 214743 (S.D. Fla. Nov. 29, 2022)

Plaintiffs Brunswick Records Corp. and Exuma Music Publishing, corporations based in Miami, Florida, contended that they owned sound recording and underlying music composition rights to song titled “Vinzerelli’s Bounce,” aka “Bounce Rock Roll Skate” (“Bounce”). Defendant Lastrada and its President Stephen Moelis also claimed to have ownership interests in Bounce. Plaintiffs filed copyright infringement suit, alleging that defendants had been falsely representing that defendants owned copyright, including on various websites. Because of defendant’s representations, plaintiffs had suffered injury because many third-party streaming platforms had removed plaintiff’s master recordings, and some third parties had inadvertently paid defendants instead of plaintiffs. Defendants filed motion to dismiss for failure to state claim, improper service, and lack of personal jurisdiction. Court focused on personal jurisdiction, and recommended that defendant’s motion be granted and case transferred to New York. Court found that Florida’s long-arm statute was satisfied because plaintiffs demonstrated their residence in Florida – plaintiffs

were both corporations with principal places of business in Miami –and that defendants engaged in tortious conduct that caused injury to plaintiffs in Florida by claiming ownership interest in Bounce on websites accessible in Florida. However, court held that it should not exercise personal jurisdiction over defendants because doing so would be violative of due process. Court applied Eleventh Circuit’s three-part test. Under first prong, court concluded that defendant’s alleged infringing conduct – claiming ownership of Bounce on websites accessible in Florida – was type of claim-causing contact sufficient to satisfy first prong, despite fact that defendants did not engage in any direct marketing, maintain business contacts, or similar activity in Florida. Under second prong, court determined that plaintiff failed to make *prima facie* showing of personal jurisdiction under either “effects test” or “minimum contacts test.” Court concluded that there was no meaningful connection with forum aside from websites or plaintiff’s injuries, and therefore, defendants’ connections were insufficient for them to have availed themselves of benefits of conducting business in Florida. Under third prong, court determined that (a) first factor weighed against plaintiff because defendants would face significant burden defending lawsuit in Florida, where defendants had essentially no contact and very little documentation or evidence was located; (b) second factor also weighed against plaintiff because focus of defendants’ alleged infringing conduct occurred in New York; (c) third factor failed because plaintiffs provided no compelling reason as to why Florida would offer most effective relief; and (d) fourth factor favored defendants because case could be resolved with minimal disruption if moved to New York. Therefore, court granted motion on grounds of lack of personal jurisdiction and transferred case to New York for decision on remaining issues in motion.

*Power v. Connectweb Techs., Inc.*, No. 22-10030, 2023 U.S. Dist. LEXIS 875 (D. Mass. Jan. 4, 2023)

Plaintiff brought infringement claim against former employer and some of its clients, alleging that he was sole owner or co-owner of software used by company because he created derivative version while working as independent contractor for employer, registered that work with Copyright Office, and never assigned his rights to anyone. Plaintiff failed to meet burden to show court had personal jurisdiction over defendant client of plaintiff’s employer. Plaintiff presented no evidence that defendant, incorporated in Delaware and doing business in Nebraska, successfully sold any products in Massachusetts or generated any revenue in state. Nor did defendant carry out advertising that specifically targeted residents in state. Though defendant entered into contract with plaintiff’s employer where employer’s software would be used to host defendant’s website, plaintiff did not describe in complaint how contract was formed, or employer’s role in hosting its clients’ websites.

*Ctr. for Gestalt Dev., Inc. v. Bowman*, No. 22-2058, 2022 U.S. Dist. LEXIS 190596 (E.D. Pa. Oct. 19, 2022)

District court granted motion to dismiss for lack of personal jurisdiction. Plaintiff Center for Gestalt Development owned copyright in unfinished manuscript authored by Frederick Peris, “a founder of Gestalt therapy.” Defendant Charles Bowman, “psychotherapist and counselor who utilizes Gestalt therapy” and resident of Indiana, obtained access to unpublished

manuscript and collaborated with Institut Français de Gestalt-thérapie, institute located in France, to publish book containing complete text of manuscript accompanied by commentary from other Gestalt therapist. Plaintiff sued for infringement in Eastern District of Pennsylvania, and defendant Bowman moved to dismiss for lack of personal jurisdiction and improper venue. Finding defendant not resident or domiciliary of Pennsylvania and thus not subject to general personal jurisdiction, district court considered whether he was subject to specific jurisdiction. In finding no specific jurisdiction, district court dismissed each of following theories of plaintiff: (1) defendant's travel to Pennsylvania to present speeches or attend conferences did not create specific jurisdiction because it was not "suit-related conduct," and claims in case did not arise from attendance at said conferences; (2) solicitation of contributions to book did not give rise to specific jurisdiction because he "did not solicit any of those contributions in Pennsylvania"; (3) defendant's emails promoting book did constitute purposeful availment of privileges of doing business in Pennsylvania, as these emails constituted "efforts to exploit a national market" for book, which "necessarily included" Pennsylvania; and (4) fact that "multiple residents of Pennsylvania" purchased book did not demonstrate *defendant's* direct targeting of sales to Pennsylvania sufficient to give rise to specific jurisdiction. Finding defendant lacked contacts in connection with alleged infringement, district court found no personal jurisdiction. Having found defendant not subject to personal jurisdiction, district court likewise found District of Pennsylvania improper forum and dismissed infringement claims without prejudice.

*Schork Grp., Inc. v. Choice! Energy Servs., Retail, LP*, No. 20-6507, 2022 U.S. Dist. LEXIS 130167 (E.D. Pa. July 21, 2022)

District court denied motion to dismiss or transfer copyright infringement claim. Plaintiff provided price range forecasting and market analysis for energy industry in newsletter. Terms and conditions of subscription did not permit copying of contents of newsletter for any reason. Individual defendant reached out to subscribe, accumulated contents of newsletter over years, and distributed it on his company's website as company's own work. Plaintiff sued individual and company for infringement. Individual defendant argued that he was not subject to personal jurisdiction in location where plaintiff was based, as plaintiff's agreement was only with company, not him. Court found minimum contacts present because individual defendant used his own subscription and contacted plaintiff in his personal capacity.

*Harrington v. Deepak Dugar, M.D.*, No. 22-295, 2022 U.S. Dist. LEXIS 203700 (D.N.M. Nov. 8, 2022)

District court granted motion to transfer venue. Plaintiff photographer sued defendant California-based medical services company for posting one of his photographs of Albuquerque skyline on their website without authorization. Defendant brought motion to dismiss for lack of personal jurisdiction or in alternative to transfer venue. Plaintiff argued that specific jurisdiction existed because defendant's webpage was targeted towards residents of District of New Mexico. Defendant's website was titled "Albuquerque Patients looking for specialist Rhinoplasty Surgeon!" and provided link for out-of-town patients to access

more information. Court concluded that it lacked personal jurisdiction over defendant because defendant did not direct its activities at forum state, and there was no evidence that any New Mexico resident visited defendant's website or sought or obtained medical services from defendant. Court held that even if plaintiff established minimum contacts, he did not prove that personal jurisdiction comported with fair play and substantial justice. Court found that it would be unreasonable burden on defendant to go to trial in New Mexico, and that forum state had no interest in resolving dispute. Court also held that matter should be transferred to Central District of California. First, parties agreed that venue was proper in California, and that discretionary factors weighed in favor of transfer for convenience of parties and interests of justice. Court noted that cost was likely to decrease if case was transferred because all identified witnesses resided in California. Second, court determined that case was likely to be expeditiously tried in California because New Mexico had heavier criminal docket, which was prioritized over civil cases. Third, any judgment would need to be enforced in Central District of California, and there was no evidence that any New Mexican saw advertisement and inquired about medical services.

*Xinuos, Inc. v. IBM*, No. 21-31, 2022 U.S. Dist. LEXIS 205657 (D.V.I. Nov. 14, 2022)

District court, upon defendants' motion, transferred case to another proper venue. When defendants moved to transfer to convenient venue, plaintiff was U.S. Virgin Islands corporation that had moved its offices there in May 2019. In March 2019, plaintiff, then still located in California, brought suit in Virgin Islands against IBM (New York corporation) and its wholly owned subsidiary (Delaware corporation), claiming that defendants had infringed computer code created by plaintiff's predecessor-in-interest. Court held that defendants were subject to personal jurisdiction in Virgin Islands because they had marketed and sold their accused software to Virgin Islands and, even if court lacked such personal jurisdiction, defendants had waived this defense by failing to raise it. Court then transferred case to Southern District of New York after determining venue was also proper there. First, transferee court indisputably had general jurisdiction over IBM and thus over its subsidiary. Second, convenience factors tipped in defendants' favor. Facts operative to suit arose outside Virgin Islands, no material witness was in Virgin Islands, and neither party would be particularly inconvenienced by litigating in other's forum.

### **C. Pleadings**

*Evox Productions, LLC v. Verizon Media, Inc.*, No. 21-56046, 2022 U.S. App. LEXIS 33551 (9th Cir. Dec. 6, 2022)

Ninth Circuit reversed district court's judgment dismissing plaintiff's copyright claim. Plaintiff, creator and distributor of digital automobile images, brought suit against defendant Verizon, alleging that Verizon continued to reproduce, display, and distribute plaintiff's photos from Verizon's servers to website visitors after termination of parties' licensing agreement. Court held that district court's threshold dismissal of copyright claim was in error and determined that plaintiff plausibly pleaded its copyright claim within bounds of

*Perfect 10*, which requires image to be both stored on infringer's servers and delivered by infringer to website viewers' screens. Court found that facts alleged by plaintiff were sufficient to make out claim that while unlicensed, Verizon not only saved defendant's images on its servers, but also displayed and distributed them directly to visitors to its websites. Therefore, district court's judgment dismissing plaintiff's copyright claim was reversed.

*APL Microscopic, LLC v. Steenblock*, No. 21-55745, 2022 U.S. App. LEXIS 27541 (9th Cir. Oct. 3, 2022)

Plaintiff sued defendant for posting versions of photographs created by plaintiff on defendant's Facebook and Instagram pages. District court found that plaintiff lacked standing to sue for copyright infringement because there was no evidence that plaintiff owned exclusive rights in works. Ninth Circuit reversed, finding that plaintiff's amended complaint contained "prima facie evidence" that plaintiff owned works. Plaintiff alleged that works were assigned to plaintiff, and court found that this was sufficient to allege ownership at motion to dismiss stage. Additionally, Ninth Circuit found that plaintiff had plausibly alleged that defendant owned social media pages on which infringement appeared and that plaintiff plausibly alleged that defendant had knowingly removed CMI since watermark had been removed. Lastly, Ninth Circuit explained that district court had improperly dismissed plaintiff's vicarious and contributory liability claim, since claims were sufficiently alleged in complaint and it was not necessary for plaintiffs to conclusively demonstrate anything at pleading stage. Ninth Circuit reversed and remanded for further proceedings.

*Office for Planning & Architecture, Inc. v. City of Harrisburg*, No. 21-2296, 2022 U.S. App. LEXIS 25844 (3d Cir. Sept. 15, 2022)

Third Circuit held district court properly dismissed case for failure to state claim. Defendant City contracted with plaintiff, planning firm, to draw up land-use plans; contract gave City right to keep using plans until firm gave City notice of breach and chance to cure. Firm sued City for infringement, but because firm did not follow contract procedure, City still had right to use plans. Since firm failed to give notice and chance to cure default, it did not terminate contract. Thus, City did not infringe by using plans, and district court properly dismissed case.

*Williams v. D'Youville Coll., JBCN Educ., Inc.*, No. 21-1001, 2022 U.S. Dist. LEXIS 178950 (W.D.N.Y. Sep. 29, 2022)

Magistrate judge recommended that motion to dismiss be granted. In face of financial difficulties, defendant D'Youville College needed its Education Department to generate more revenue. Plaintiffs were asked to develop course materials for Masters in Education degree. Plaintiffs developed course material and obtained copyright registration listing them as joint authors. Later, College terminated all plaintiffs, but defendants continued to use course materials, and plaintiffs brought suit. Plaintiffs were parties to union agreement that stated all intellectual property was owned by employee, but College retained permanent license in syllabi. Defendants move to dismiss for failure to state claim. First, court found



that plaintiffs failed to attach copyrighted work to complaint and did not describe work with particularity, making it impossible for court to determine precisely what works were infringed and whether use went beyond scope of license. Court similarly found that plaintiffs' secondary liability claims failed to meet pleading standards. Plaintiffs failed to allege that defendant College induced/encourage infringement or had ability to supervise to support contributory and vicarious infringement claims. Finally, court found plaintiffs' unjust enrichment claim preempted. Magistrate judge recommended that motion to dismiss be granted with leave to replead copyright claims.

*Paul Rudolph Found. v. Paul Rudolph Heritage Found.*, No. 20-8180, 2022 U.S. Dist. LEXIS 162451 (S.D.N.Y. Sep. 8, 2022)

District court granted plaintiff's motion to dismiss defendants' counterclaim for copyright infringement. Plaintiff, nonprofit organization, sued defendants, founding member of nonprofit and new nonprofit he founded, for copyright infringement for display of work of architect Paul Rudolph. Defendant nonprofit organization argued founding member inherited all material prepared by Rudolph in connection with professional practice of architecture and filed counterclaim for copyright infringement. Court agreed with plaintiff's argument that defendant's counterclaim for copyright infringement was full of deficiencies and therefore dismissed. Court found defendant failed to specify which works within group copyright registration were used by plaintiff in violation of defendant's rights, and failed to plead how and when plaintiff infringed copyrights. Defendants attached two examples of plaintiff's alleged infringing activity, both of which predated date of registration, and one example which was in public domain and therefore could not constitute copyright infringement as matter of law. Moreover, other evidence submitted with motion indicated that defendants did not own copyright in second example.

*Underwood v. Prince*, No. 22-1884, 2023 U.S. Dist. LEXIS 53294 (C.D. Cal. Jan. 26, 2023)

District court denied defendants' motion to dismiss copyright infringement claims. In 2018, plaintiff musician provided song demo to defendants Damien Prince and Biannca Raines, married couple who post videos depicting their family to millions of social media followers, to use as potential new theme song. Defendants posted to YouTube "new intro video" that used plaintiff's demo and, between 2018 and 2020, used intro video with plaintiff's demo on about 350 videos that were viewed over a billion times thereby generating more than \$5 million in profit. Plaintiff did not consent to or receive credit for this use. In 2019, plaintiff, upon assurance that compensation from defendants was forthcoming, recorded full version of her song and delivered it to defendants, who used it in official music video for song. Defendants published song on other platforms and it has since been used as background music in over 10,000 third-party TikTok videos that credit defendants instead of plaintiff. In 2020, plaintiff complained about defendants' use and, in March 2021, parties entered into settlement agreement that included payment to plaintiff, release of claims against defendants and mandatory collaboration between parties. In March 2022, one defendant's relative wrote to plaintiff's counsel to inform her that this defendant repeatedly told his relative that he

would never use his platform to promote someone who had threatened to sue him as plaintiff had. Plaintiff sued defendants for rescission of settlement agreement and copyright infringement. Plaintiff's copyright claims were contingent upon rescission of settlement agreement because plaintiff had released her copyright claims therein. Court held that plaintiff sufficiently pled rescission because she had alleged that defendants never intended to perform obligations in settlement agreement other than payment. Therefore, plaintiff could proceed with her copyright infringement claims.

*Tracy Anderson Mind & Body, LLC v. Roup*, No. 22-4735, 2022 U.S. Dist. LEXIS 225714 (C.D. Cal. Dec. 12, 2022)

Plaintiff created Tracy Anderson Method ("TA Method") for choreography-based fitness. Plaintiff fixed TA Method in media including DVDs for which plaintiff obtained copyright registrations. Plaintiff brought infringement claim against defendant, former employee of plaintiff who for six years had access to and taught TA Method. Upon termination of employment defendant started teaching and publishing videos featuring choreography-based fitness classes. Defendant filed motion to dismiss, which court denied. Plaintiff pleaded *prima facie* case of copyright infringement by providing copyright registrations, and sufficiently alleging access and that works were substantially similar. Defendant argued that TA Method was functional exercise movements which were not copyrightable. Court held, however, that determining protectability of plaintiffs' copyrighted works would require detailed factual analysis unfit for ruling on motion to dismiss.

*BMG Rts. Mgmt. United States LLC v. Joyy Inc.*, No. 22-1578, 2022 U.S. Dist. LEXIS 224699 (C.D. Cal. Dec. 5, 2022)

District court held that plaintiff failed to state claim for direct copyright infringement. Plaintiff music publisher and record label sued defendants, owners and operators of Likee, social media platform similar to TikTok, which offered Creator Academy encouraging content creators to upload "better music" to reach more viewers. Likee allowed users to upload music from their personal music libraries. Court held that plaintiff failed to state claim for direct copyright infringement because it failed to establish volitional conduct by defendants, which did not select material for upload, download, transmission or storage. Also, although Creator Academy instructed users how to upload copyrighted music generally, users themselves selected actual songs, so there was no causal nexus between defendants' conduct and their users' unauthorized copying even where Likee copied songs uploaded by users onto its platform. Likee's differentiation between licensed and original music likewise did not rise to activate participation. Court gave plaintiff leave to replead, but not until plaintiff had availed itself of DMCA remedies, namely, submitting takedown notices for specific instances of copyright infringement to Likee.

*Whitehead v. Netflix, Inc.*, No. 22-4049, 2022 U.S. Dist. LEXIS 215901 (N.D. Cal. Nov. 30, 2022)

*Pro se* plaintiff, self-published author of novel *No Fairy Tales*, filed suit against defendant Netflix alleging that defendant's series *Family Reunion* was unlawful derivative of her work.

Complaint alleged that *Family Reunion* was derivative because it shared “substantial similarities ... such as but not limited to the main character of the show, plots and obstacles that the main character [has] with other characters, and even dialogue,” and that main character in *Family Reunion* “cannot be separated from the main character” in *No Fairy Tales*. Plaintiff, however, did not describe contents of either work in detail or attach them to complaint. Defendant filed request that court take judicial notice of both works, which court granted. Defendant also moved to dismiss plaintiff’s complaint for failure to state claim. Upon comparing works closely, court held that plaintiff failed to allege substantial similarity, and that two works were not substantially similar. Although works shared some unprotectable elements such as black teenage characters named Jade and subplots about interracial relationships, protectable elements in works’ plots, characters, dialogue, themes, setting, mood, pace and sequence of events were quite different. Court granted defendant’s motion to dismiss without leave to amend.

*Perfywaybelayouix v. Graham-Drake*, No. 22-1019, 2022 U.S. Dist. LEXIS 216913 (D.D.C. Dec. 1, 2022)

District court dismissed copyright infringement complaint where plaintiff failed to adequately plead access or striking similarity. *Pro se* plaintiff sued Drake, Universal Music Group and other defendants, asserting that defendants’ “Way 2 Sexy” song infringed his copyright in his earlier song “Reach for the Skies.” Court held that plaintiff sufficiently alleged copyright ownership by including copyright registration number in response to defendants’ motion to dismiss. Plaintiff alleged that he had uploaded his song and lyric sheet to Spinnup, internet platform owned by UMG that allowed independent artists to upload music for UMG’s possible attention. In support of his claims, plaintiff submitted both songs’ lyrics with emphases on specific terms, almost all of which were common single words (like “sexy,” “yeah,” and “kickin”). Court held that upload to Spinnup did not show specific defendants had reasonable opportunity to hear plaintiff’s song and that uploading song to public website was insufficient to show widespread dissemination absent allegations of commercial success or distribution. Court further held that none of called-out terms, alone or collectively, constituted protectable elements and plaintiff failed to allege that any other part of his song was protectable. Even if plaintiff had alleged protectable elements, his claim would still fail because each song’s respective total concept and feel had nothing in common such that no trier of fact could reasonably determine them to be substantially similar. Court dismissed suit with prejudice due to extensive abusive, threatening and/or sexually lewd letters sent by plaintiff both to defendants’ counsel and to court.

*Foxmind Canada Enter., Ltd. v. Individuals*, No. 22- 2552, 2022 U.S. Dist. LEXIS 213504 (N.D. Ill. Nov. 28, 2022)

Plaintiff seller of MATCH MADNESS “pattern matching board game” sued numerous defendants for infringement in connection “counterfeit” games on online marketplaces. At preliminary injunction hearing, district court denied request for preliminary injunction on infringement claim, finding defendant’s board game not substantially similar to MATCH MADNESS game. Defendants then moved to dismiss infringement claim, arguing that

court's comments on substantial similarity at preliminary injunction phase "definitively shows that the products are not substantially similar," and claim should be dismissed. District rejected this reasoning, finding that parties reasonably disagreed on plausibility of infringement claim, and noting that mere fact that court denied motion for preliminary injunction did not mean that plaintiff did not have plausible claim and could not succeed on merits of claim after discovery. Court used different standards to evaluate motion for preliminary injunctions than it did for motions to dismiss. Finding infringement claim met pleading standard, and viewing facts in light most favorable to plaintiff, motion to dismiss infringement claim denied.

*Wicked Grips, LLC v. Badaan*, No. 21-2131, 2022 U.S. Dist. LEXIS 111022 (M.D. Fla. June 22, 2022)

Plaintiff, company that "designs and manufactures handgun grips and accessories" incorporating "unique artwork" designs, sued for infringement alleging defendants "fabricated exact likenesses" of its grip designs. Plaintiff alleged that certain designs were copied from its grips, and others were copied from its website. Defendant moved to dismiss for failure to state claim. Defendants argued that plaintiff could not maintain copyright infringement claim because it had not alleged that it owned grip designs or website. Complaint alleged that plaintiff's principal "made the grip designs" in his capacity as employee and within scope of employment. Plaintiff, accordingly, had alleged that it owned designs. As for website, complaint alleged that independent contractor made website for plaintiff and transferred ownership of website copyright to plaintiff. Plaintiff, accordingly, alleged that it owned website as well. Defendant next argued that plaintiff only alleged ownership of registration for one grip design (incorporating tarot card theme) but did not allege registration for other allegedly infringed grip designs. Court noted, however, that plaintiff alleged that it owned registration for designs as displayed on its website, and complaint alleged that defendant copied grip designs that appeared on plaintiff's website. Further finding that defendant's challenge to originality of plaintiff's grip designs question of fact (and thus not appropriate for dismissal at pleadings stage), court denied motion to dismiss infringement claim.

*Affordable Aerial Photography, Inc. v. Showroom Interiors, LLC*, No. 21-81777, 2022 U.S. Dist. LEXIS 195874 (S.D. Fla. Oct. 27, 2022)

Plaintiff professional photographer was hired by real estate broker to take photographs of luxury home. Plaintiff took over 200 photographs, most of which he registered with Copyright Office. Plaintiff granted broker limited license to use photographs for listing home for sale. Broker subsequently gave copies of plaintiff's photographs to defendant Tillinghast, holding company for builder of home, and defendant Ross, manager of Tillinghast and builder of home. Upon discovering copies of his photographs on website of company contracted to stage home and other websites, plaintiff brought claims of copyright infringement, inducement of copyright infringement, and vicarious copyright infringement against 11 defendants, including Tillinghast and Ross. Defendants Tillinghast and Ross moved for judgment on pleadings on basis that claims against them failed to state claims

upon which relief can be granted for infringement, inducement, and that some of plaintiff's photographs were not properly registered. First, defendants argued that plaintiff could not pursue infringement claims on 52 photographs because works were not properly registered, insofar as names listed in registration certificate annexed to complaint did not match names listed in complaint. Court disagreed, holding that complaint plausibly alleged that 52 works were registered even if there was discrepancy between names in complaint and in registration certificate. Second, defendants argued that complaint did not sufficiently allege that (a) defendant Ross infringed plaintiff's works, (b) defendant Tillinghast could be held vicariously liable for infringement, and (c) defendants took steps to induce third parties to display copyrighted works. Court disagreed, holding that complaint contained allegations that (i) defendants distributed plaintiff's works to promote defendant's business, and plaintiff never gave defendants permission to distribute works; (ii) defendant Ross was manager of defendant Tillinghast and, as agent, conveyed rights to staging company, which he had no authority to do; and (iii) defendant Ross, as agent, signed contract with staging company, which was step towards inducing third party to infringe plaintiff's copyright. Magistrate judge recommended that district court deny defendant's motion for judgment on pleadings.

*Cortés-Ramos v. Martin-Morales*, No. 21-1374, 2022 U.S. Dist. LEXIS 140897 (D.P.R. Aug. 8, 2022)

District court denied defendant's motion to dismiss infringement claim, finding copyright vested in plaintiff and plaintiff stated plausible infringement claim. Plaintiff sued defendant, Ricky Martin, for copyright infringement alleging Martin distributed, performed, and displayed music video nearly identical to one plaintiff submitted to Sony in SuperSong Contest. Martin moved to dismiss claim, arguing plaintiff relinquished rights in video. Martin argued plaintiff did not own copyright in video because work was made for hire or alternatively, plaintiff assigned its rights to Sony when plaintiff submitted video and signed release and affidavit. Plaintiff claimed never received copy of contest's rules and Sony fraudulently induced him to sign release. Court determined work was not work made for hire because work for hire agreement was not signed before creating video and Sony did not comply with statutory requirements to make video work made for hire, so copyright vested in plaintiff as creator and author of video. Court found at current procedural posture that plaintiff had standing to bring infringement claim because Martin did not support position with case law. Plaintiff alleged copyright was registered before filing suit and submitted video in SuperSong Contest, which Martin was involved in, and Martin's video was identical to plaintiff's video, which was enough to raise reasonable inference Martin had access to video. Court therefore found plaintiff alleged plausible infringement claim.

*McFee v. Carolina Pad, LLC*, No. 21-633, 2022 U.S. Dist. LEXIS 107280 (W.D.N.C. June 16, 2022)

District court denied motion to dismiss for lack of standing. Plaintiff Jacqueline McFee was lead designer at stationery and office supply company CPP International, LLC ("CPP"), creating multiple patterns used on CPP's products. Employment agreement between plaintiff and CPP provided CPP would transfer plaintiff's intellectual property rights in plaintiff's

designs once they had no longer been used by CPP for certain period of time. After departing CPP, plaintiff sued CPP for transfer of copyright ownership. District court held that absent assignment from CPP, plaintiff lacked ownership of copyright and failed to state claim for infringement. Plaintiff then filed state court action, asserting claims of breach of contract and fraud. While suit was pending, CPP sold its assets to affiliate of Carolina Pad, LLC (“Carolina Pad”). After CPP defaulted in state court action, state court assigned copyright in disputed works to plaintiff McFee. Plaintiff then discovered Carolina Pad was selling infringing notebooks and office supplies. Carolina Pad publicly claimed to be successor to CPP. Plaintiff thereafter sued Carolina Pad for infringement. Carolina Pad moved to dismiss for lack of standing and failure to state claim. Regarding failure to state claim, defendant argued that even if plaintiff could prove ownership of copyrights, plaintiff failed to plead sufficient factual allegations to support claim of infringement, because plaintiff’s complaint allegedly contained only generic references to designs created at CPP, and failed to identify defendant’s infringing products, how they copied plaintiff’s copyrighted material, and how they were substantially similar. District court held that plaintiff sufficiently identified designs that were allegedly infringed by Carolina Pad.

*Chiusa v. Stubenrauch*, No. 21-545, 2022 U.S. Dist. LEXIS 125622 (M.D. Tenn. July 15, 2022)

District court denied defendant’s motion to dismiss. Plaintiff owned copyrights in websites and brochure designed by plaintiff as part of collaboration with defendant to sell defendant’s copper goods. Plaintiff sued defendant alleging infringement because defendant created his own competing websites using photos and text from plaintiff’s websites. Defendant moved to dismiss for failure to state claim under Rule 12(b)(6), arguing that plaintiff’s copyright registration certificates did not make clear which elements of underlying websites and brochures were considered to be protected. District court found that while plaintiff could have been more specific, plaintiff plausibly identified some specifically protected elements that were replicated in defendant’s materials. Defendant then argued that since registration was not made within five years of first publication plaintiff should not receive presumption of validity. District court explained that lack of presumption did not mean plaintiff could not plead that certificates were valid. Because plaintiff had alleged that copyrighted images in websites and brochure were created, taken, bought by or assigned to plaintiff, this was sufficient to be considered plausible pleading. District court denied motion to dismiss for failure to state claim.

*Mattsson v. Pat McGrath Cosmetics LLC*, No. 21-5187, 2022 U.S. Dist. LEXIS 122260 (S.D.N.Y. July 11, 2022)

Magistrate judge recommended that plaintiff’s motion for judgment on pleadings be denied. Plaintiff, fashion artist, sued Pat McGrath Cosmetics LLC (PMG), marketer of makeup and cosmetics, for infringement. In early 2017, PMG and plaintiff entered agreement by which PMG licensed Original Fly Face Image for two-years. Further, parties entered into service and IP agreements, whereby plaintiff would act as consultant to PMG. In mid-2018, plaintiff alleged PMG was infringing on plaintiff’s rights through its use of Golden Fly Face Image.

In early 2020, plaintiff applied to register Golden Fly Face Image with Copyright Office, listing herself as sole author and copyright claimant, and was granted registration. Plaintiff brought suit for infringement and declaration that license agreement was voidable. PMG answered and asserted three counterclaims: first, seeking declaration of ownership of Golden Fly Face Image; second, that plaintiff's 2020 registration was invalid; and third, that it had not infringed Golden Fly Face Image. Plaintiff moved for judgment on pleadings on counterclaims. As to ownership, district court found that disputed issues of fact as to authorship, as well as interpretation of service agreement, prevented it from granting motion. On validity counterclaim, court found that it had authority to declare registration invalid and that defendant had sufficiently alleged claim for invalidity. Court recommended denial of motion for judgment on pleadings.

#### **D. Standing**

*Beatriz Ball, L.L.C. v. Barbagallo Co., L.L.C.*, 40 F.4th 308 (5th Cir. 2022)

Fifth Circuit reversed district court's holding that plaintiff lacked standing to bring copyright claim. Plaintiff, owner, founder and designer of line of tableware, sued defendant for infringement. District court found that plaintiff lacked legal standing to sue because plaintiff's assignment of ownership from "Beatriz Ball Collection" (trade name) to "Beatriz Ball, LLC" (corporate entity) did not actually assign right of action. Fifth Circuit reversed and found that plaintiff had standing because initial filing was sufficient under Act's safe harbor for innocent errors. Plaintiff's erroneously listing its trade name rather than corporate designation was unknowing and immaterial. Citing Supreme Court's recent *Unicolors* decision, court reasoned that plaintiff's lack of knowledge in fact or law should excuse inaccuracy in application.

*Lackey v. Sheppard*, No. 22-5653, 2022 U.S. Dist. LEXIS 228215 (C.D. Cal. Dec. 16, 2022)

District court dismissed plaintiff's copyright infringement claim for failure to allege standing. Individual plaintiff claimed that he created video series about group of "superhero girls" but copyright registration for relevant works listed third-party company as author and copyright claimant. Although plaintiff conclusorily described himself as copyright owner of works at issue and as "successor in interest that acquired" third-party company, these facts were insufficient to plead standing. Accordingly, court granted defendant's motion to dismiss for failure to state claim.

*Ehrenberg v. Walt Disney Co.*, No. 22-1136, 2022 U.S. Dist. LEXIS 151365 (C.D. Cal. July 15, 2022)

District court denied in part and granted in part motion to dismiss. Plaintiffs, Jeffrey Scott, screenwriter previously involved in production of *Muppet Babies* television show, and Howard Ehrenberg, Chapter 7 Trustee of Scott's bankruptcy estate, alleged Walt Disney Company ("Disney") misappropriated Scott's copyrighted contributions when Disney

rebooted series in 2018. Defendant argued that plaintiffs lacked standing because Scott never owned copyright in works at issue, and that plaintiffs' pleadings were inadequate under Rule 12(b)(1). Disney's standing argument depended on 1984 production agreement between Marvel and Henson Associates Inc. for Marvel to license *Muppet Babies* intellectual property. Ninth Circuit held 12(b)(1) motion did not provide proper framework on motion to dismiss to argue plaintiff lacked ownership interest in copyrighted work because "issue is whether [the plaintiff] has a statutory right to sue for infringement under the Copyright Act, which is properly addressed in a 12(b)(6) motion, not whether [he] has satisfied the requirements of Article III, which is properly addressed in a 12(b)(1) motion." Since contractual document was not mentioned in complaint, district court could not consider contract under 12(b)(6), and court found Disney did not establish that plaintiffs failed to sufficiently allege copyright ownership of works at issue. Disney presented two arguments under 12(b)(6) challenge. As to protectability, Disney argued Scott's contributions to existing *Muppet Babies*' intellectual property belonging to Henson and his company were so trivial as to be unprotectable. While Disney plausibly alleged that some of Scott's additions were not original, it did not show that no elements of production bible or scripts were protectable. As to substantial similarity, court held that plaintiff failed to sufficiently allege Disney's use of protectable elements of Scott's works. Court granted motion to dismiss with leave to replead.

*Well Cell Glob. LLC v. Calvit*, No. 22-3062, 2022 U.S. Dist. LEXIS 204742 (S.D. Tex. Nov. 10, 2022)

District court dismissed preliminary injunction claim for lack of standing where plaintiff had not yet completed transaction through which it would become owner of copyright it sued under. Nonparty developed treatment plan for diabetes for which nonparty obtained patents and copyright registrations, which plaintiff was in process of purchasing through asset purchase agreement. Deal would not be complete until plaintiff paid full purchase price, and it had not yet done so. During this transaction, plaintiff licensed patents and copyrights to clinics. Clinics continued to use intellectual property after licenses expired, causing plaintiffs to sue for infringement and seek preliminary injunction. Court found that because copyright assignment was not complete, plaintiff could not enforce copyrights as beneficial owner, and had no standing to pursue copyright claims.

*Glob. Music Rts., LLC v. S. Stone Communs., LLC*, No. 22-1792, 2023 U.S. Dist. LEXIS 65194 (M.D. Fla. Apr. 13, 2023)

Court denied defendants' motion to dismiss. Case flowed from defendants' radio stations playing copyrighted songs for which they allegedly did not receive prior authorization. Plaintiff held exclusive licenses to publicly perform songs at issue. Defendants argued that court should dismiss complaint either as shotgun pleading or for failure to state claim. Court disagreed. Defendants alleged that complaint was full of "conclusory, vague, and immaterial facts," but failed to allege which pleadings were at issue. Further, defendants' argument that plaintiff should have separated allegations of each individual infringement into separate actions, and argument that plaintiff failed to specify which defendant is responsible for each



alleged act or omission lacked merit. Lastly, plaintiff plausibly alleged status as exclusive licensee of registered compositions and defendants' copying of constituent elements of copyrighted works by stating that defendants' radio stations performed compositions knowingly without authorization on air thousands of times since January 2020.

*Lines+Angles, Inc. v. Adagio Teas, Inc.*, No. 20-831, 2022 U.S. Dist. LEXIS 118395 (D.N.J. July 5, 2022)

Stockfood America, plaintiff's predecessor, owned and licensed database of stock images, including copyrighted photograph of pumpkin pie, which defendant, online retailer, posted to its website without permission. Stockfood America sued defendant for infringement. At issue was whether plaintiff had standing to sue. Photographer had granted exclusive license to Stockfood America for image in 2009. However, Stockfood GmbH (Stockfood America's parent company) had signed exclusive license with Getty Images for photo in question in 2010. Defendant argued that Agreement between Stockfood GmbH and Getty Images undermined Stockfood America's exclusive license with photographer. However, district court found that plaintiff had standing to sue either way, because it still had exclusive license to enforce its rights regardless of whether Stockfood America was viewed as separate from its parent or part of single entity. After resolving standing issue, district court granted plaintiff's motion for summary judgment for infringement since defendant had copied exact photo to website.

*McFee v. Carolina Pad, LLC*, No. 21-633, 2022 U.S. Dist. LEXIS 107280 (W.D.N.C. June 16, 2022)

District court denied motion to dismiss. Plaintiff Jacqueline McFee was lead designer at stationery and office supply company CPP International, LLC ("CPP"), creating multiple patterns used on CPP's products. Employment agreement between plaintiff and CPP provided that CPP would transfer plaintiff's intellectual property rights in plaintiff's designs once they had no longer been used by CPP for certain period of time. After departing CPP, plaintiff sued CPP for transfer of copyright ownership. District court held that absent assignment from CPP, plaintiff lacked ownership of copyright and failed to state claim for infringement. Plaintiff then filed state court action, asserting claims of breach of contract and fraud. While suit was pending, CPP sold its assets to affiliate of Carolina Pad, LLC ("Carolina Pad"). After CPP defaulted in state court action, state court assigned all copyright in disputed works to plaintiff McFee. Plaintiff then discovered Carolina Pad was selling infringing notebooks and office supplies. Carolina Pad publicly claimed to be successor to CPP. Plaintiff thereafter sued Carolina Pad for infringement. Carolina Pad moved to dismiss for lack of standing and failure to state claim. Regarding standing, Carolina Pad asserted that, per prior district court holding, plaintiff did not own copyrights at issue and therefore lacked standing and claimed that state court lacked jurisdiction to confer copyright ownership. District court reviewed state court judgment for preemption issues, but found that it did not arise under copyright law. Defendant further argued that first sale doctrine barred copyright claim because Carolina Pad and its affiliate bought inventory from CPP and were then free to re-sell it. However, district court found significant questions of fact existed

surrounding alleged sale of inventory by CPP, which put first sale doctrine outside of scope of motion to dismiss.

*Sensory Path Inc. v. Fit & Fun Playscapes LLC*, No. 19-219, 2022 U.S. Dist. LEXIS 209192 (N.D. Miss. Nov. 17, 2022)

District court held that plaintiff had standing to bring copyright infringement claim. Sensory Path (“SP”) and Fit and Fun (“FF”) both created and sold adhesive stickers allowing users to create paths for children’s sensory integrated movement. In relevant part, FF claimed that SP had infringed, *inter alia*, work titled Alphabet Snake. Initial copyright application for Alphabet Snake omitted name of individual who contributed artwork (“artist”). On December 2, 2019, artist signed *nunc pro tunc* assignment assigning his copyrights to FF and, on December 2, 2019, assignment was recorded in Copyright Office. FF filed copyright infringement suit on December 20, 2019. Because suit was filed after recordal of assignment, FF could rely thereon. Moreover, as artist transferred all his rights, assignment was permissible because it did not assign solely right to sue.

## II. COPYRIGHTABILITY

### A. Originality

*ACT, Inc. v. Worldwide Interactive Network, Inc.*, 46 F.4th 489 (6th Cir. 2022)

Sixth Circuit affirmed district court’s grant of preliminary injunction based on finding of infringement on summary judgment, rejecting defendant’s argument that copied works were not copyrightable due to insufficient originality. Plaintiff, developer of “workforce-development assessments that measure skills affecting job performance,” alleged that defendant directly copied its copyrighted “Skill Definitions.” Defendant, which formerly collaborated with plaintiff but later developed competing (and allegedly infringing) products, admitted to directly copying certain Skill Definitions but argued that description, selection and arrangement of Skill Definitions were not creative or original, were merged with underlying ideas, and were thus uncopyrightable. Sixth Circuit agreed with defendant that plaintiff’s selection of skills (namely, “Locating Information,” “Reading for Information” and “Applied Mathematics”) are likely unprotectable, as decision to test for those categories was insufficiently expressive and instead merely constituted unprotectable “ideas.” However, Sixth Circuit found that plaintiff’s “description” of Skills, including its compilation and arrangement of various “subskills” constituted protectable expression, and thus found plaintiff’s compilation copyright valid. Because plaintiff’s works were found protectable and defendant admitted direct copying, finding of infringement and consequent grant of preliminary injunction were affirmed.

*Structured Asset Sales, LLC v. Sheeran*, No. 18-539, 2022 U.S. Dist. LEXIS 177266 (S.D.N.Y. Sept. 29, 2022)

District court held that factual issues precluded summary judgment as to whether plaintiff's work sufficiently original. Plaintiff sued Ed Sheeran and others, claiming that Sheeran's song "Thinking Out Loud" infringed copyright in "Let's Get It On" composition. Plaintiff's claim was based on alleged copying of chord progression and harmonic rhythm (collectively, "backing pattern"). Because parties' experts disagreed as to whether particular musical elements were original and whether backing pattern was sufficiently uncommon to warrant copyright protection, there was factual issue as to copyrightability of plaintiff's work.

*Krikor v. Sports Mall, LLC*, No. 22-5600, 2023 U.S. Dist. LEXIS 13063 (C.D. Cal. Jan. 24, 2023)

District court granted plaintiff partial summary judgment on infringement claim, but denied judgment regarding defendant's willfulness and its unclean hands defense. Defendant operated online sports memorabilia store. Plaintiffs, eBay store owner and photographer for store owner, sued for infringement after discovering that defendant had reproduced more than six images of sports memorabilia from plaintiff's eBay store; plaintiffs claimed copyright in subject works. Photographer plaintiff moved for summary judgment regarding two images for which photographer owner copyright registration. Defendants argued registrations were not valid because subject images were not original. Plaintiff submitted testimony describing his intentional choices with respect to lighting, composition, and framing of subject works. District court held that such evidence showed at least minimal degree required for finding of originality, and ultimately granted partial summary judgment to plaintiff on infringement claim.

*Doskocil Mfg. Co. v. Make Ideas, LLC*, No. 21-1098, 2023 U.S. Dist. LEXIS 16652 (N.D. Tex. Jan. 31, 2023)

District court dismissed copyright infringement claim on summary judgment on ground that bullet point informational sheet insufficiently original to warrant copyright protection. Plaintiff, designer, manufacturer and seller of pet products, sued defendant company run by dog toy inventor on various grounds and defendant counterclaimed for, *inter alia*, copyright infringement. Defendant claimed that plaintiff infringed defendant's copyright in three-page booklet containing bullet point list promoting defendant's pet toy product. Court noted that defendant had insufficiently clarified which specific content plaintiff alleged infringed, nor had defendant proven copying by plaintiff. Ultimately this was irrelevant because all phrases at issue were not copyrightable subject matter because they were short or stock phrases and, in any case, merged with underlying idea of specific pet toy product, which idea was not susceptible to wide array of expressions.

*Morford v. Cattelan*, No. 21-20039, 2022 U.S. Dist. LEXIS 118967 (S.D. Fla. July 6, 2022)

District court denied motion to dismiss. Plaintiff artist alleged that his sculptural diptych, “Banana & Orange,” was infringed by work entitled “Comedian” by internationally famous artist Maurizio Cattelan. Both works prominently featured banana affixed to wall with silver duct tape. Court acknowledged that plaintiff “cannot claim copyright in the idea of a banana taped to a wall,” but went on to hold that “[w]hile using silver duct tape to affix a banana to a wall may not espouse the highest degree of creativity, its absurd and farcical nature meets the minimal degree of creativity needed to qualify as original.” Court observed in footnote that plaintiff had registered work with Copyright Office, which “provides additional support in favor of the validity of Morford’s copyright.”

*Eggleston v. Twentieth Century Fox Film Corp*, No. 21-11171, 2022 U.S. Dist. LEXIS 146350 (E.D. Mich. Aug. 16, 2022)

Plaintiff wrote memoir detailing her life growing up, her involvement in drug operation and gang, and finding redemption. Defendants created television series *Empire* with primary character named Cookie Lyon. Plaintiff alleged that Cookie Lyon was based on plaintiff’s portrayal of herself in her memoir, and that defendants violated her copyright by taking material from her book. Defendants filed motion to dismiss, contending that copyright protection for characters is limited to fictional characters entirely based on creative expression, and, in light of fact that plaintiff’s book was autobiography, she cannot claim copyright protection for factual depiction of herself described in work. Plaintiff argued that depiction of herself involved creativity and was therefore protected. Court granted defendant’s motion to dismiss. Court noted that Sixth Circuit had not addressed question of whether real-life person can be copyrighted and relied on holdings of two out-of-circuit cases cited by defendant, *Corbello v. Valli* and *Vallejo v. Narcos*. Court distinguished *Corbello* from facts at issue in this case, noting that *Vallejo* was more on point. In *Vallejo* complaint, plaintiff’s claim of infringement described three scenes in television show *Narcos* that were taken from her memoir at high level of detail – plaintiff did not claim that writers of *Narcos* were prohibited from including character in show based on plaintiff’s description of self in memoir, as plaintiff did in this case. Court found that plaintiff could not claim copyright protection in historical recitation of individual facts presented in her memoir, but that she could claim protection in way her life is expressed and depicted through her writing in her memoir, as plaintiff in *Narcos* did. However, plaintiff’s complaint did not include any allegations that defendants lifted lines of dialogue from her memoir, or structured scene to mimic one described by plaintiff. Court therefore held that even if defendants used certain facts from plaintiff’s life to create fictional character, this did not violate copyright without demonstration that expression regarding portrayal of character unique to plaintiff’s memoir was copied.

*Motamoa Holdings Ltd. v. VL Media LLC*, No. 21-198, 2023 U.S. Dist. LEXIS 27653 (D. Wyo. Feb. 16, 2023)

Plaintiff, producer of “Metalbird” “lifelike two-dimensional metal silhouette sculptures of birds” designed to be nailed into trees, sued producer of alleged copycat “Magicbird” bird sculptures for infringement. On motion for default judgment, district court considered whether copyrighted sculptures were sufficiently original, and whether defendant’s sculptures unlawfully appropriated protectable elements. District court began by noting that “concept or idea or two-dimensional metal bird silhouettes” and functional aspects of plaintiff’s sculptures not protectable, and that realistic depiction of wildlife at best subject to “thin” copyright limited to exact or near-exact duplication by others. District court therefore found that plaintiff did not establish infringement for several of plaintiff’s works because defendant’s allegedly infringing sculptures are not “exact copies” of plaintiff’s copyrighted “realistic sculptures of natural subjects,” and thus did not violate plaintiff’s “thin” copyright. However, district court found that defendant’s logo displayed on its website “substantially similar” and nearly identical to plaintiff’s registered *Hummingbird* sculpture, and thus infringing. Even though plaintiff’s copyright in *Hummingbird* was for sculptural work, court found defendant’s two-dimensional logo was derivative of plaintiff’s copyright, and thus infringing. District court also found defendant infringed copyright in *Pair of Swallows* sculpture, as defendant’s sculpture of same name was “nearly identical” and thus copied protectable expressive elements of plaintiff’s sculpture. Court also considered plaintiff’s claim that defendant’s website, which shared “generally similar layouts, color schemes, and overall structure” as plaintiff’s copyrighted website, was infringing. Although defendant’s website had “meaningful differences” from plaintiff’s site, court pointed to portions of near-identical text on respective websites in finding infringement. Default judgment on several (though not all) infringement claims for plaintiff.

## **B. Compilations and Derivative Works**

*Steeplechase Arts & Prods., L.L.C. v. Wisdom Paths, Inc.*, No. 22-02031, 2023 U.S. Dist. LEXIS 13408 (D.N.J. Jan. 26, 2023)

Court granted defendant’s motion for summary judgment and dismissed infringement claim. Plaintiff was owner of copyright in book for teaching adults how to play piano (“Piano Book”), which, as purchased, was paperback book with glue binding. Defendant, seller of various items on Amazon marketplace, purchased hundreds of copies of Piano Book from authorized distributors. At some point, defendant removed original glue bindings from Piano Books it had purchased and replaced with spiral bindings. Plaintiff filed copyright infringement lawsuit on grounds that defendant infringed its copyrights in Piano Book by creating unauthorized derivative works. Defendant moved to dismiss, plaintiff cross-moved for summary judgment, and parties agreed to treat defendant’s motion to dismiss as one for summary judgment. Crux of parties’ dispute was whether “derivative work” must possess some level of creativity such that it could be considered original work of authorship. Plaintiff alleged that derivative work that makes creative contributions to existing work may constitute original work of authorship, but that question was separate from whether work is

derivative of existing work. Plaintiff relied on plain language of Act and canons of statutory interpretation to support conclusion that “work” and “work of authorship” are not one and same. Defendant argued that two questions are same, and that because spiral binding is purely utilitarian and makes no creative contribution, it had not created derivative work. Third Circuit cited to Seventh Circuit, which, when presented with same statutory interpretation argument plaintiff, found that it was not necessary to decide issue and instead focused on whether underlying work had been recast, transformed, or adapted to make allegedly infringing work, as set forth in statutory definition of “derivative work.” Court found that, although defendant altered Piano Books, it did not recast, transform, or adapt underlying work because (a) defendant did not present content in different manner; (b) spiralbound books had same use as paperback versions; and (c) no major changes were made by modifying binding. Therefore, court held defendant did not create derivative work in rebinding works and granted motion for summary judgment.

### **C. Pictorial, Graphic and Sculptural Works**

*Dennis v. Nike, Inc.*, No. 22-4515, 2023 U.S. Dist. LEXIS 24328 (C.D. Cal. Feb. 13, 2023)

Plaintiff owner of copyright in “technical drawing” showing “series of shoe design patterns containing springs on the bottom heel of a shoe” sued Nike for infringement, claiming Nike’s SHOX line of shoes infringed his works. On motion to dismiss, district court first considered whether drawings were subject to protection. Plaintiff conceded that he was not seeking copyright protection on functionality of actual springs contained in work, but rather in “arrangements of the four small circulate columns in a square formation,” and “four small circular columns containing springs ... arranged in a square formation.” However, district court found these features not actually displayed in copyrighted drawings, and held that even if they were shown, arrangements would be “useful article” not subject to copyright protection; finding of useful article further supported by plaintiff’s concession that springs served utilitarian purpose, namely, “impact absorption.” Finding that plaintiff failed to identify element of design that could be separated from utilitarian purpose, court held plaintiff’s work not subject to copyright protection. Even if plaintiff’s work was subject to protection, court found that Nike’s creation of functional three-dimensional shoe was not “copying” within meaning of Act. Infringement claim dismissed with prejudice.

### **D. Miscellaneous**

*SAS Inst., Inc. v. World Programming Ltd.*, 64 F.4th 1319 (Fed. Cir. 2023)

Federal Circuit affirmed district court ruling that plaintiff SAS failed to establish copyrightability of its claimed software program elements. SAS created and sold software solutions used for data access, management, analysis, and presentation (“SAS System”). SAS owned copyright registrations for various aspects of SAS System. Defendant World Programming Limited (“WPL”) created competitor to SAS System (“WPS System”), which used SAS programming language to allow users to run programs to complete certain

analytics tasks. SAS sued WPL for nonliteral infringement of SAS System. District court decided to hold special hearing to assist it in deciding scope of protection provided under copyright law for elements asserted by SAS. After receiving supplemental briefing, district court concluded that SAS possessed valid copyrights. Court then determined that WPL met its burden on copyrightability by showing that software program elements were not within scope of protection under copyright law, namely because (a) earlier version of SAS System was in public domain, (b) SAS language was free for public use, and (c) allegedly copied material contained unprotectable open-source elements, among other things. District court held that SAS failed to establish copyrightability and show which specific elements of SAS System that SAS alleged were copied were protectable under abstraction-filtration-comparison test. District court also excluded opinion of SAS's expert as unreliable. Federal Circuit affirmed district court's holding. Federal Circuit rejected SAS argument that district court legally erred in its application of abstraction-filtration-comparison test. Instead, court held that district court properly shifted burden to SAS to establish that its asserted elements were protected by copyright because WPL showed that at least substantial portion of allegedly infringed elements of SAS System were not protectable. Federal Circuit found that where SAS failed to rebut WPL's assertion and did not otherwise provide evidence in relation to "filtration step" under three-part test, district court correctly determined that SAS did not meet its burden. Court also rejected SAS argument that district court erred in (a) its use of "Copyrightability Hearing" because such procedures were well-supported by rules of civil procedure, and (b) excluding testimony of its technical expert because SAS's expert clearly did not conduct filtration analysis as ordered by court and was clearly unreliable. Dissent argued that Fifth Circuit law protected SAS system from non-literal copying, and that district court improperly shifted burden of proof to copyright holder.

*Carroll Shelby Licensing, Inc. v. Halicki*, No. 20-1344, 2022 U.S. Dist. LEXIS 221974 (C.D. Cal. Nov. 29, 2022)

Defendants owned copyrights in 1974 film *Gone in 60 Seconds*, 1982 film *The Junkman*, 1983 film *Deadline Auto Theft* ("Trilogy") and 2000 remake of *Gone in 60 Seconds* ("Remake"). Over decade ago, defendants sued plaintiffs, claiming that plaintiffs were improperly licensing trademarks related to "Eleanor" – designation used to refer to series of automobiles across four feature films – for manufacture of imitation vehicles. Parties entered into settlement agreement. Plaintiffs brought claims against defendants for breach of settlement agreement, and defendants counterclaimed for copyright infringement, arguing that defendants were continuing to make series of vehicles that infringed their rights in Eleanor character. Parties moved for summary judgment on whether Eleanor was character subject to copyright protection. Court concludes that Eleanor was not subject to copyright protection and granted plaintiff's motion for summary judgment on issue of copyrightability, and denied defendant's motion. Court used Ninth Circuit's three-element character copyrightability test to resolve whether character featured in work is independently copyrightable. Court focused on second and third elements because first element was met. Under first prong, court determined that Ford Mustang automobiles are given designation Eleanor and assigned feminine pronouns across all four movies. Court found that characteristics common to vehicles depicted in film are "too lightly sketched to meet the

second prong” of Ninth Circuit’s test. Court explained that films inconsistently depict vehicles called Eleanor, which diminished any other delineating physical characteristics and weakened conceptual connotations about vehicles. Regarding physical appearance, court cited to fact that (1) there were contrasting makes, models, and years of vehicle classes depicted by Eleanor designation in Trilogy and Remake; (2) physical condition and appearance of Eleanors was inconsistent across films; and (3) no set of modifications or customizations associated with vehicles were consistently portrayed in films or readily identifiable. Court found that conceptual characteristics consistent to depictions of Eleanor were limited to Eleanor designation itself. Court therefore found second prong unmet. Under third prong, court evaluates whether character is especially distinctive and contains unique elements of expression. Court also founds third prong unmet because Eleanor’s consistent and identifiable characteristics – name Eleanor, concept of assigning human name to inanimate vehicle, Eleanor’s make and model – did not make character distinct enough for independent copyright protection. Therefore, court ruled in favor of plaintiffs on issue of copyrightability.

### **III. OWNERSHIP**

#### **A. Works Made for Hire**

*Gentile v. Crededio*, No. 21-8528, 2022 U.S. Dist. LEXIS 116928 (S.D.N.Y. July 1, 2022)

District court ordered plaintiffs to amend their complaint in response to motion to dismiss. Plaintiffs alleged that they hired defendant to assist in drafting screenplay for pilot of television show of which plaintiffs had initially conceived. Defendant was allegedly provided detailed verbal instructions and physical outlines, and was paid for each act drafted. Plaintiff alleged that defendant signed confidentiality agreement with plaintiff. Defendant later registered work with Copyright Office. Plaintiffs sought declaratory judgment that plaintiffs were holders of only valid copyright registration for disputed work, and alleged “infringement over Crededio’s having registered the Work with the Copyright Office in her name.” Defendant moved to dismiss both counts on grounds that plaintiffs failed to plead joint authorship, and that plaintiffs failed to adequately plead application of work-for-hire doctrine. Regarding work-for-hire allegations, plaintiffs argued that applicable doctrine required fact-intensive analysis not suitable for motion to dismiss. District court concluded that complaint appeared to portray defendant as independent contractor, and likely did not sufficiently plead facts relating to tax treatment of how plaintiffs paid defendant. However, rather than issue order granting or denying motion to dismiss, district court noted that both parties agreed that amended complaint would be acceptable way to proceed, and therefore granted plaintiffs leave to amend their complaint.



*Poppington LLC v. Brooks*, No. 20-8616, 2022 U.S. Dist. LEXIS 105311  
(S.D.N.Y. June 13, 2022)

District court granted defendant's motion for summary judgment in part, by dismissing plaintiff's infringement claims, declaring defendant owner of subject work, and enjoining plaintiffs from again attempting to register copyright of subject work. Defendant Edwyna Brooks wrote novel *Mafietta*, which was then adapted to film with help of plaintiff Raquel Horn, Horn's production company Poppington LLC, and others. Horn took multiple photos while on set and registered at least one, which defendant allegedly used as book cover on subsequent book. Plaintiffs sued for infringement. Defendant claimed photo was still image from film recording, while plaintiffs claimed it was photo taken by Horn. Regarding ownership, court first noted that (a) due to Horn's copyright registration, court was required to presume that Horn was author; and (b) registration did not claim that work was made for hire. Though Brooks claimed that Horn was employee, no indica of employment existed: Brooks did not claim there was signed, written agreement confirming work-for-hire relationship, which was fatal to work-for-hire claim. However, Brooks also claimed she owned photo at issue as derivative work of film, because it was taken on set and depicted actor portraying main character of storyline. Plaintiffs claimed photo contained Horn's photographic expression, but district court held that photograph was clearly work based upon Brooks's existing work. Court therefore held that photo was derivative work of *Mafietta*, of which Brooks was sole author and copyright holder. Defendants' motion for summary judgment was therefore granted and infringement claim dismissed.

## **B. Termination of Transfers**

*Atticus LLC v. Dramatic Publ'g Co.*, No. 22-10147, 2023 U.S. Dist. LEXIS  
73732 (S.D.N.Y. Apr. 27, 2023)

District court denied defendant's motion to dismiss and granted in part plaintiff's motion for summary judgment, finding that defendant did not currently possess exclusive right to perform amateur theatrical productions of *To Kill a Mockingbird*. In 1969, author Harper Lee granted defendant publishing company right to create dramatization of novel *To Kill a Mockingbird* for amateur productions (e.g., community theaters and schools). License agreement contained arbitration clause. In 2011, Lee issued termination notice to defendant. In 2015, Lee entered into agreement with non-party to select playwright for new dramatic adaptation of novel. Aaron Sorkin wrote new adaptation. In 2019, Dramatic filed arbitration demand against Lee estate, arguing breach of 1969 agreement. Arbitrator largely found Lee estate liable on Dramatic's claims. In 2022, plaintiff, which owned production rights to Sorkin play, sought declaratory judgment that plaintiff and Sorkin had right to present certain performances of play in United States, and that such productions did not infringe any purported copyright interest of defendant. Dramatic moved to dismiss, plaintiff cross-moved for summary judgment, and Sorkin was named as involuntary plaintiff. District court concluded that, under § 304 of Act, exclusive license to perform derivative work does not remain exclusive after valid termination of license. Though § 304 provides for derivative works exception, district court held that exception does not prevent author from exercising its

termination right, but rather permits grantee to continue to utilize derivative works created during license term without threat of litigation from author of original work. In other words, playwright who created derivative work continues to have rights in its creation, but cannot bar author from licensing others to create new derivative works. Exclusive license to defendant therefore was no longer exclusive following termination of grant of rights.

*Waite v. UMG Recordings, Inc.*, No. 19-1091, 2022 U.S. Dist. LEXIS 165370 (S.D.N.Y. Sept. 13, 2022)

District court dismissed putative class representative from class action because there was no evidence that defendants infringed plaintiff's copyrights after applicable termination date. In September 1980, plaintiff Kasim Sulton entered into recording agreement with recording company that was predecessor to one of defendants. In July 2016, plaintiff served notice of termination effective July 21, 2018. In June 2019, Sulton, seeking to be appointed representative of putative class, joined class action lawsuit against defendant recording companies that alleged defendants had failed to honor class members' termination notices (which defendants contended were ineffective). Sulton alleged that defendants continued to exploit his sound recordings after July 21, 2018. However, defendants submitted declaration that they had no record of exploiting Sulton's work nor of any revenues associated with same. Sulton failed to adduce any contrary evidence and further argued that defendants' refusal to relinquish their rights in his sound recordings following termination's effective date constituted infringement. On defendants' summary judgment motion, court dismissed Sulton from case because he failed to show that any infringement occurred after purported termination date. Moreover, court rejected Sulton's argument that defendants' contention that his termination notice was ineffective could, in and of itself, constitute infringement.

*Finch v. Casey*, No. 22-20144, 2023 U.S. Dist. LEXIS 20635 (S.D. Fla. Feb. 7, 2023)

Court granted defendant's motion for summary judgment, finding plaintiff's copyright termination action barred by statute of limitations. Plaintiff filed suit in November 2022 seeking declaration that he properly exercised his termination rights under § 203 of Copyright Act with respect to 1983 agreement ("Agreement") whereby he allegedly transferred his copyright interests in 99 songs to defendant. Since executing Agreement, plaintiff consistently attempted to challenge its validity and defendant's ownership of songs. On August 12, 2012, plaintiff served notice of termination ("2012 Notice") under § 203 seeking to terminate copyright grants he purportedly made to defendant. Defendant did not respond to 2012 Notice. In May 2015, plaintiff's lawyer sent letter to defendant's counsel concerning 2012 Notice. Defendant responded, challenging validity of 2012 Notice and repudiating plaintiff's claim of authorship in songs. Plaintiff did not respond to defendant's letter. In September 2019, plaintiff's counsel served another notice of termination on defendant ("2019 Notice") with effective date of termination of October 2021. Plaintiff responded rebutting defendant's claims. Plaintiff commenced lawsuit in November 2022. Court held that plaintiff's lawsuit was barred by Copyright Act's three-year limitations period because undisputed facts showed that, as matter of law, plaintiff's § 203 claim

accrued no later than May 2015, given that defendant sent response to plaintiff's termination notice in 2012 disputing plaintiff's authorship claim and his corollary termination rights under § 203. Court found that defendant's response was sufficient to place plaintiff on notice that defendant was affirmatively challenging his authorship and termination rights over songs. Court determined that plaintiff's claims were legally unsound, unpersuasive, or relied on inapplicable case law. Court explicitly rejected plaintiff's argument that defendant's statute of limitations defense should not be considered because it was untimely, finding that defendant had mischaracterized nature of plaintiff's defense by portraying it as claim or counterclaim that should be subject to three-year statute of limitations, and by cherry-picking authorities. Because there were no genuine issues of material fact, court held defendant entitled to judgment as matter of law because plaintiff's declaratory judgment action was time-barred.

*Merrill v. Hyman*, No. 21-551, 2022 U.S. Dist. LEXIS 191437 (D. Conn. Oct. 20, 2022)

District court denied plaintiff's motion for summary judgment and granted defendant's motion for summary judgment. Plaintiff was successor in interest and widow of Bob Merrill, who authored lyrics to Broadway musical *Funny Girl*. At that time, Merrill and co-authors made deal to produce show in U.S. and Canada in exchange for royalties. Merrill then entered into agreement with producer Eliot Hyman, defendants' predecessor in interest, to exchange 2/3 future royalties from full musical for instant \$82,500. Later, show creators entered agreement with Tams-Witmark Library to license *Funny Girl* to third party theater companies who wanted to put on show. Under this agreement, Merrill and coauthors would get percent share of royalties, but, due to agreement with Hyman, Merrill only received 1/3 of this amount. In 2015, Merrill's widow purported to serve notice to terminate Merrill-Hyman agreement, and instructed Tams-Witmark to send full royalties to her. After defendants objected, plaintiff brought suit for declaratory judgment that she validly terminated Merrill-Hyman agreement, and defendants counterclaimed for breach of agreement, tortious interference with Tams-Witmark agreement, declaratory judgment that Merrill-Hyman agreement could not be terminated; and injunction for plaintiff to cease interfering with their royalty stream. Parties cross-moved for summary judgment. As to plaintiff's purported termination of Merrill-Hyman agreement pursuant to § 304(c), court held that because Merrill did not transfer or license work to Hyman, § 304 termination was inapplicable. Merrill-Hyman agreement was neither transfer, pursuant to § 201(d), nor license of work, and instead was solely financial in nature. Court held that plaintiff's interpretation of agreement to find that it was transfer was unsupported by plain language of Merrill-Hyman and Tams-Hyman agreements. Accordingly, court granted defendants' motion for summary judgment on declaratory judgment, breach of contract, and permanent injunction claims and denied as moot tortious interference claim.

### C. Joint Works and Co-Ownership

*Gentile v. Crededio*, No. 21-8528, 2022 U.S. Dist. LEXIS 116928 (S.D.N.Y. July 1, 2022)

District court ordered plaintiffs to amend their complaint in response to motion to dismiss. Plaintiffs alleged that they hired defendant to assist in drafting screenplay for pilot of television show plaintiffs had “initially conceived.” Defendant was allegedly provided detailed verbal instructions and physical outlines, and was paid for each act drafted. Plaintiff also alleged that defendant signed confidentiality agreement with plaintiff. Defendant later registered work with Copyright Office. Plaintiffs sought declaratory judgment that plaintiffs were holders of only valid copyright registration for disputed work, and alleged “infringement over Crededio’s having registered the Work with the Copyright Office in her name.” Defendant moved to dismiss both counts on grounds that plaintiffs failed to plead joint authorship, and that plaintiffs failed to adequately plead application of work-for-hire doctrine. Regarding joint authorship allegations, defendant argued that plaintiffs failed to allege precisely what they wrote in work at issue. Court held that plaintiffs seemed to plead that they provided defendant with ideas, rather than any particular manner of expression. However, rather than issue ruling on these issues and grant or deny motion to dismiss, district court noted that both parties agreed that amended complaint would be acceptable way to proceed, and therefore granted plaintiffs leave to amend their complaint.

*Shah v. NYP Holdings, Inc.*, No. 21-6148, 2023 U.S. Dist. LEXIS 8076 (N.D. Ill. Jan. 18, 2023)

District court dismissed complaint for failure to state claim. Plaintiff Vivek Shah, former aspiring actor, attended several parties in Hollywood and appeared in photographs with various celebrities. Plaintiff was arrested in 2012 for attempted extortion after sending letters to millionaires threatening to kill their families if they did not pay him millions of dollars. After release from prison, plaintiff sued numerous media organizations who reported his arrest; plaintiff claimed that defendants used 20 photos of him with various celebrities without authorization. Defendants alleged that plaintiff failed to allege copyright ownership. Though plaintiff registered copyright in each photo at issue, district court held that plaintiff failed to allege he was sole author of subject works; plaintiff had alleged in part that he gave camera to another individual to take photos for him. District court considered and rejected possibility of joint authorship, because plaintiff’s allegations did not indicate any intent for plaintiff and photographer to be joint authors.

*Pisciotti v. Brittingham*, No. 20-5924, 2022 U.S. Dist. LEXIS 116951 (W.D. Wash. July 1, 2022)

Court denied plaintiff’s motion for summary judgment and granted in part and denied in part defendant’s motion for summary judgment. Defendant approached plaintiff in 2012 about creating film entitled “Kaleidoscope.” Between 2012 and 2014, plaintiff worked on film. In July 2014, defendant showed plaintiff cover of DVDs for works, which listed her as sole owner of copyright, and parties’ relationship soured as plaintiff’s requests for payment went

unheeded. In March 2015, plaintiff filed for copyright registration for work, but did not alert defendant of this fact. Meanwhile, defendant continued to reproduce work and represent that copyright was owned by her. In 2020, plaintiff brought suit for infringement and violation of DMCA, and defendant counterclaimed for declaration that she was co-author and sole owner of copyright in work. Parties filed cross-motions for summary judgment. Assuming that defendant's claim to co-authorship and ownership was timely, court found that plaintiff's claim failed because she was not co-author of work. First, neither defendant nor third party were co-authors because they did not make copyrightable contributions: they did not participate in production, compose or arrange music, or participate in filming, and generalized feedback to plaintiff did not amount to copyrightable contribution. Second, court found defendant's work for hire argument conclusory and unsupported: defendant did not argue plaintiff was employee, and parties did not agree in writing that work would be work for hire. Third, defendant could not be copyright owner through transfer from third party because third party, who was not co-author, had no ownership rights to provide. Court granted plaintiff's motion for summary judgment on defendant's counterclaim.

#### **D. Contracts and Licenses**

*ABKCO Music, Inc. v. Sagan*, 50 F.4th 309 (2d Cir. 2022)

Defendants acquired archives of late concert promoter Bill Graham, which contained audiovisual and audio recordings from many top-selling musical artists, which defendants made available for streaming online for fee. Following summary judgment rulings on infringement and trial on damages, Second Circuit heard appeal on whether defendants had valid license authorizing reproduction or distribution of works. Defendants alleged they obtained compulsory licenses for all works at issue, including 146 which were reproduced and distributed as audiovisual recordings, and 51 works which were audio-only recordings. Second Circuit affirmed district court's finding that defendants' audiovisual recordings of live concert performances were not "phonorecords," which are defined in Act as "material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed." Reading plain language of Act, Second Circuit rejected defendants' argument that word "accompany" in definition limits exclusion "to such things as a soundtrack, in which the sound is layered over a motion picture," and found that definition of phonorecords excludes audiovisual recordings of live concert performance. Turning to audio-only recordings, defendants appealed district court's finding on summary judgment that defendant's reproduction was unauthorized by compulsory license because defendant failed to satisfy § 115's substantive requirements for "duplicating a sound recording fixed by another." On appeal, defendants argued that their reproduction was lawful and thus eligible for compulsory license for musical work because sound recordings duplicated were fixed lawfully by their predecessors (from whom defendants purchased recordings) and, thus, not "unlawfully" or "by another." Second Circuit agreed with defendants, ruling that district court erred in finding that recordings were made unlawfully because: (i) concert recordings were not made in contravention of any anti-bootlegging statutes (which were enacted "many years after the recordings at issue were fixed"); and (ii)

since defendant's predecessor lawfully created recordings, defendant was authorized to reproduce them pursuant to compulsory license for musical works.

*Gaffney v. Muhammad Ali Enter. LLC*, No. 20-7113, 2022 U.S. Dist. LEXIS 161663 (S.D.N.Y. Sept. 7, 2022)

Plaintiff, professional photographer, alleged parent brand development and licensing company, Authentic Brands Group LLC ("Authentic"), Muhammad Ali Enterprises ("MAE"), subsidiary of Authentic, Roots Of, Inc, and other named individuals willfully infringed copyrighted photographs by continuing to distribute select photographs to sublicensees and customers after expiration of license and by promoting and marketing works on social media after expiration of license agreement. As to non-social media uses, court noted that provision of license allowed defendant ability "to exercise the license rights granted to it in Paragraph 1.1 with respect to all licenses and/or agreements made prior to the date of termination," provided defendants paid royalties. However, because neither party established when objectionable license agreements were entered into by defendants, court denied plaintiff's motion for summary judgment. As to social media uses, court found ambiguity as to terms of contract: while language may appear to show that right to use works on social media ended upon termination of agreement, viewing contract as whole, it was similarly plausible that defendants were allowed to continue to use works for promotional and marketing purposes, particularly because doing so would have been in plaintiff's best interest. Accordingly, summary judgment with respect to defendant's social media usage or works was also denied.

*Schneider v. YouTube, LLC*, No. 20-4423, 2023 U.S. Dist. LEXIS 1878 (N.D. Cal. Jan. 5, 2023)

District court held that music publisher's failure to give artist notice of assignment to another entity did not negate subsequent license, but factual issues still precluded summary judgment. Plaintiff musician entered into music publishing administration agreement (AA) appointing ArtistShare Music Publishing (AMP) as sole and exclusive administrator of her musical compositions. AA contained provision stating that AMP "must notify" plaintiff and obtain "prior written approval for any license" granted on her behalf (Section 7). AMP subsequently assigned all its duties under AA to Modern Works Music Publishing (MWP). MWP and defendant YouTube subsequently entered into publishing license agreement (PLA) that granted YouTube license to composition "owned or controlled" by MWP. Plaintiff, as one of three named plaintiffs in putative class action, sued YouTube and Google for infringing copyrights in her compositions and sound recordings. Plaintiff alleged, *inter alia*, that because she did not receive notice of or provide written consent to PLA (as provided for in Section 7), this negated PLA as to her works. Court held that Section 7 was mere covenant such that failure to adhere thereto could constitute breach of AA, but would not negate PLA. After noting that, under New York law, contractual provisions are presumed to be covenants absent clear indication they are conditions precedent, court noted that AA contained numerous provisions with express language for condition precedent and chose not to use such language in Section 7. Although terms that limit scope of copyright

license are construed as conditions, this was irrelevant because AA was administration agreement, not copyright license. Despite finding that PLA was not negated, court declined to grant summary judgment because issues of fact remained as to whether plaintiff granted any ownership or control rights to MWP and whether plaintiff's compositions were in catalog of works provided by MWP to YouTube.

*Marvez v. Uproar Entm't*, No. 22-2866, 2022 U.S. Dist. LEXIS 225572 (C.D. Cal. Dec. 12, 2022))

District court granted defendant's motion to dismiss because plaintiff failed to allege copyright infringement claim. Plaintiff comedian and defendant comedy entertainment company entered into recording agreement giving defendant exclusive rights to reproduce and distribute master sound recordings of two comedy albums. Agreement provided for payment of royalties, but specifically not mechanical royalties, to plaintiff. Defendant subsequently uploaded plaintiff's recordings to YouTube channel. Plaintiff sued, alleging that defendant, *inter alia*, infringed copyright in her underlying compositions by uploading recordings. Court held that plaintiff failed to state claim because parties' recording agreement gave defendant right to reproduce and distribute recordings, which would be impossible if defendant did not also have permission to use underlying comedy routines fixed in those recordings. Moreover, agreement specifically stated that mechanical royalties were neither due nor payable, implying parties' intent that defendant have right to underlying routine because otherwise defendant would have to pay mechanical royalties as well.

*Whitley v. Maguire*, No. 22-1837, 2022 U.S. Dist. LEXIS 219064 (C.D. Cal. Dec. 5, 2022)

District court granted in part defendant's motion to dismiss. Plaintiff artist Whitley set up Discord server, online community via Discord platform, where Whitley promoted his work and digital goods, including NFTs, for sale. Whitley partnered with defendant Wiriadjaja and transferred control of Discord account to Wiriadjaja. Whitley remained active in hiring decisions and paid maintenance fees for Discord server. Other defendants were also hired in connection with Discord project. Whitley then formed and was sole member of digital art agency, plaintiff WTF.Industries LLC (WTF). Whitley and defendants collaborated on art project involving design authored by Whitley and registered in Whitley's name alone. Defendants agreed to provide share of revenues to Whitley and WTF. After defendants allegedly failed to pay revenue shares, plaintiffs brought multiple claims, including for direct and vicarious copyright infringement. Plaintiffs alleged that Whitley revoked authorization for defendants to use subject design following their alleged failure to pay revenues, yet defendants continued to sell works incorporating Whitley's design. Defendants moved to dismiss claims. Noting that owner who grants nonexclusive copyright license usually has remedy in contract law, not copyright, district court reviewed claim to determine if alleged copying exceeded scope of license and if plaintiffs' complaint was based on exclusive right under copyright. Court held plaintiffs had failed to plausibly allege defendants violated Whitley's exclusive rights under copyright, instead focusing on breach of contract. In addition, court held that certain of plaintiffs' allegations – that defendants continued to sell

works incorporating subject design after authorization was revoked – were conclusory and contrary to plaintiffs’ other well-pleaded allegations. Court therefore dismissed plaintiffs’ copyright claim with leave to amend.

*nKlosures, Inc. v. Avalon Lodging LLC*, No. 22-459, 2022 U.S. Dist. LEXIS 210907 (C.D. Cal. Nov. 17, 2022)

Plaintiff, architectural firm, sued defendants for copyright infringement for alleged unauthorized use of copyrighted drawings in advertisement for sale of hotel and in construction of hotel. Defendants moved to dismiss, asserting agreement granted them express, or at least implied, license to use drawings. Defendants were not parties to agreement, and contended license was transferred to third party who sold land, drawings, and license to them. District court denied defendant’s motion because at motion to dismiss stage, court need not determine whether license transferred or legally could be transferred to defendants when they purchased hotel project. Court did not consider express license defense because no evidence plaintiff authorized license transfer. Court declined to determine whether defendants possessed implied license because affirmative defense was not apparent from allegations and agreement. Court noted plaintiff explicitly alleged agreement contained clause restricting right to copy or disseminate drawings and plaintiff told defendants it was sole owner, author, and copyright holder of drawings and would only grant license for use upon execution of contract. Agreement stated same. Allegations and agreement did not clearly establish implied license, particularly considering agreement purported to limit license’s scope and transferability.

*Concannon v. Lego Sys. Inc.*, No. 21-1678, 2023 U.S. Dist. LEXIS 43329 (D. Conn. Mar. 15, 2023)

District court denied defendant’s motion to dismiss infringement claim on implied license grounds. Plaintiff artist designed custom, hand-painted leather jacket worn by Antoni Porowski from *Queer Eye* Netflix series. Although Netflix had obtained plaintiff’s authorization to feature several of plaintiff’s products, it did not do so in connection with leather jacket and plaintiff did not object. Defendants subsequently produced *Queer Eye* LEGO set that included character wearing similar leather jacket, and plaintiff sued for infringement. Defendants moved to dismiss on ground that they had implied license to use plaintiff’s jacket and its likeness in part because plaintiff delivered jacket to Porowski with understanding that Porowski would wear it in public without restrictions. Plaintiff argued that there was no implied license in part because he had no knowledge that jacket would be used beyond show. District court sided with plaintiff, rejecting defendants’ affirmative defense and finding that, just because plaintiff saw jacket on show and did not take further action, did not mean he intended for it to be copied and distributed. In any case, court noted that filing of lawsuit constituted revocation of implied license, but defendants continued to distribute allegedly infringing LEGO set.



*Shah v. NYP Holdings, Inc.*, No. 21-6148, 2023 U.S. Dist. LEXIS 8076 (N.D. Ill. Jan. 18, 2023)

District court dismissed complaint for failure to state claim. Plaintiff Vivek Shah, former aspiring actor, attended several parties in Hollywood and appeared in photographs with various celebrities. Plaintiff was arrested in 2012 for attempted extortion after sending letters to millionaires threatening to kill their families if they did not pay him millions of dollars. After release from prison, plaintiff sued numerous media organizations who reported his arrest; plaintiff claimed that defendants used 20 photos of him with various celebrities without authorization. Though other individuals took photos at issue, plaintiff claimed that ownership was transferred to him by operation of law when photographer handed camera back to plaintiff. Plaintiff failed to allege how simply taking camera back would amount to transfer by operation of law. District court therefore rejected plaintiff's allegation that he owned copyright in subject works.

*iPurusa, LLC v. Bank of N.Y. Mellon Corp.*, No. 22-966, 2022 U.S. Dist. LEXIS 204076 (D.N.J. Nov. 9, 2022)

District court granted motion to dismiss. Plaintiff iPurusa, LLC sued Bank of New York Mellon ("BNY") along with three other defendants for infringement of its Moksha software. Plaintiff was hired as independent contractor for defendants to perform services for BNY pursuant to two agreements. Defendants moved to dismiss. As to non-BNY parties, plaintiff's allegations amounted to assertions that defendants supported and expressly assented to BNY's actions or tacitly supported BNY by failing to do anything about unauthorized use of Moksha. Court, however, found that allegations regarding "tacit approval" or mere "inaction" could not sustain infringement claims and vicarious liability claims failed because there was no allegation as to any other defendant, other than BNY, profiting from alleged infringement, or that other defendants could have prevented BNY's infringement. As to BNY's motion, court first rejected argument that plaintiff's registration was not *prima facie* evidence of copyright validity because it was obtained approximately nine years after Moksha was created. Although law provides that evidentiary weight to be accorded to certificate of registration secured more than five years after first publication of work are within court's discretion, court found determination inappropriate at motion to dismiss phase. Court also found that it could not conclude whether or not contracts granted BNY irrevocable license to use Moksha. However, because of contradiction in amended complaint where plaintiff indicated it voluntarily allowed BNY to use work and simultaneously that it had not done so, and because plaintiff did not explain contradiction, court found infringement claim improperly pleaded and granted motion.

*Mpay Inc. v. Erie Custom Comput. Applications, Inc.*, No. 19-704, 2022 U.S. Dist. LEXIS 229311 (D. Minn. Dec. 21, 2022)

District court denied plaintiff's motion for new trial because licensee's use did not exceed license's scope. Plaintiff and defendants entered into member control agreement (MCA) that allowed defendant OnePoint and its members to use plaintiff's payroll-processing software

and sublicense it to entities in which one of defendants owned majority stake with voting control. Plaintiff claimed that defendants licensed its in violation of MCA and therefore violated plaintiff's copyrights. At trial, defendants successfully proved that parties amended agreement to allow defendants to sublicense software to whomever they chose. Jury held that two defendants had not breached MCA and therefore, pursuant to jury instruction, did not reach question of whether defendants infringed plaintiff's copyright. Plaintiff moved for new trial, arguing that jury instructions were incorrect since jury could have found defendants committed copyright infringement even in absence of contractual breach. Court held that copyright licensee can be liable for infringement if its use exceeds license scope and, in this instance, there was written agreement that unambiguously contemplated sublicensing by defendants. In jury's view, parties amended MCA to permit broader sublicensing that under original agreement, meaning that defendants' sublicenses did not exceed scope of parties' agreement, necessarily foreclosing copyright infringement claim.

*Ford Motor Co. v. Airpro Diagnostics LLC*, No. 20-10518, 2022 U.S. Dist. LEXIS 228708 (E.D. Mich. Dec. 20, 2022)

District court granted summary judgment to plaintiff Ford Motor Co. regarding copyright infringement claims, and denied AirPro's motion for summary judgment regarding Ford's claims. Airpro performed remote automotive diagnostic services for third-party collision repair shops and Original Equipment Manufacturer (OEM) dealership body shops, using scan tool that identified issues within vehicles requiring repair. AirPro would first run scan using aftermarket software within AirPro scan tool; if AirPro determined Ford's software was necessary, AirPro would then install Ford's software on AirPro scan tool at its customer's location. AirPro obtained software licenses from Ford in name of AirPro's customers, but transferred licenses between scan tools, and blocked AirPro's customers from accessing software. Ford alleged such actions violated End User License Agreement, which prohibited transfer of software. District court agreed, finding that AirPro's actions violated Ford's exclusive rights to authorize reproduction and distribution of copies of work. Ford had granted AirPro right to use Ford's software only under conditions specified in license agreement. District court therefore granted summary judgment regarding copyright infringement claim.

*Aquarian Found v. Lowndes*, No. 19-1879, 2022 U.S. Dist. LEXIS 106105 (W.D. Wash. June 14, 2022)

District court dismissed infringement claim based on finding of valid license agreement. Plaintiff owner of "Church of Higher Spiritualism" sued defendant, former associate of church's deceased founder, for copying and uploading onto internet copyrighted audio and video recordings of church's founder discussing church's teachings. Following bench trial, district court found that recordings of works were copyrighted by church's founder in his personal name, and applications to register works were not labeled "works for hire." Church's founder entered into 1985 license agreement granting defendant permission to use works; in 1999 founder died and ownership of works was transferred by will to plaintiff church. In 2013, church discovered works being used online and sent takedown demands; in

2019 church sued for infringement; and in 2021 (18 months into litigation) church sought to terminate license with immediate effect. District court found license valid and found that church's founder (and not church) had authority to grant license, as works were owned by founder and were not works for hire. District court found license termination ineffective because it did not meet requirements of § 203 of Act: termination notice did not provide two years' advance notice, and church did not have authority to terminate license as executor, administrator or personal representative of founder's estate over decade after estate closed. Infringement claim dismissed due to valid license held by defendant.

### **E. Miscellaneous**

*Sensory Path Inc. v. Fit & Fun Playscapes LLC*, No. 19-219, 2022 U.S. Dist. LEXIS 209192 (N.D. Miss. Nov. 17, 2022)

District court held that factual issues precluded summary judgment as to claimant's ownership of asserted copyright. Sensory Path ("SP") and Fit and Fun ("FF") both created and sold adhesive stickers allowing users to create paths for children's sensory integrated movement. In relevant part, FF claimed that SP had infringed, *inter alia*, works titled Daisy Hopscotch and Log Design ("Works"). SP asserted that Works had been created by independent contractor who did not assign copyright to FF. Because there were material issues of fact as to contractor's contribution, summary judgment was denied.

## **IV. FORMALITIES**

### **A. Registration**

*Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 52 F.4th 1054 (9th Cir. 2022)

On remand from Supreme Court, Ninth Circuit affirmed district court's judgment, upholding Unicolors' ability to maintain copyright infringement suit against H&M. Unicolors, which created designs for use on textiles and garments, had alleged that garments sold by H&M in 2015 featured design that was substantially similar to design it had created in 2011. Following Supreme Court's 2022 ruling clarifying knowledge standard required for invalidating copyright registrations based on inaccuracies in application, Ninth Circuit reviewed anew issue of whether Unicolors held valid copyright registration in its 31 textile designs that were included in single copyright application. Ninth Circuit held that Unicolors' registration was valid because Unicolors did not have requisite knowledge of legal inaccuracy on its registration application to invalidate it. In discussing Supreme Court analysis, Ninth Circuit noted that decision effectively abrogated its 2019 decision in *Gold Value International Textile v. Sanctuary Clothing*, and now made clear that "a registration is invalid under § 411(b) if the registrant perpetrated fraud on the Copyright Office by knowingly misrepresenting material facts." Court then held that party seeking to invalidate copyright registration under § 411(b) must demonstrate that (1) registrant submitted

application with inaccuracies; (2) registrant knew that application did not comply with legal requirements; and (3) inaccuracies were material to registration decision. As to first prong, court relied on holding in earlier opinion, concluding that Unicolors' registration contained inaccuracy, namely that it was inaccurate for Unicolors to register collection of works as single unit of publication when works were not initially published as singular bundled collection. As to second prong, court concluded that district court's finding that Unicolors did not have requisite knowledge of its application's inaccuracy was not clearly erroneous in light of unsettled nature of law over how court would rule on single-unit requirements. Therefore, court determined that Unicolors' registration fell within safe-harbor provision, notwithstanding failure to comply with "single unit" requirement, and held that Unicolors' registration was valid. Court found that district court's award of attorneys' fees to Unicolors was not abuse of discretion, but determined that district court erred in inflating Unicolors' post-remittitur damages. Panel instructed district court on remand to grant H&M's request for new trial, limited only to damages, if Unicolors rejected new amount of damages.

*Beatriz Ball, L.L.C. v. Barbagallo Co., L.L.C.*, 40 F.4th 308 (5th Cir. 2022)

Fifth Circuit reversed district court's holding that plaintiff lacked standing to bring copyright claim. Plaintiff, owner, founder and designer of line of tableware, sued defendant for infringement. District court found that plaintiff lacked legal standing to sue because plaintiff's assignment of ownership from "Beatriz Ball Collection" (trade name) to "Beatriz Ball, LLC" (corporate entity) did not actually assign right of action. Fifth Circuit reversed and found that plaintiff had standing because initial filing was sufficient under Act's safe harbor for innocent errors. Plaintiff's erroneously listing its trade name rather than corporate designation was unknowing and immaterial. Citing Supreme Court's recent *Unicolors* decision, court reasoned that plaintiff's lack of knowledge in fact or law should excuse inaccuracy in application.

*Greene v. Pete*, No. 22-4220, 2023 U.S. Dist. LEXIS 40140 (S.D.N.Y. Jan. 3, 2023)

District court granted defendants' motion to dismiss because plaintiff had not registered copyright in allegedly infringed work prior to filing suit. Around 2000, plaintiff music producer created sound recording titled "It's About To Be On" and, in April 2015, obtained sound recording copyright therefor as part of instrumental music album. In March 2020, song "Savage," performed by defendant Megan Thee Stallion and featuring defendant Beyoncé, was released. In April 2022, plaintiff sued pro se, alleging that "Savage" infringed his sound recording. In August 2022, plaintiff obtained performing arts registration for same album containing "It's About To Be On." Interpreting plaintiff's complaint as raising strongest arguments suggested therein, court held that plaintiff brought suit for infringement of underlying music composition rather than sound recording, since plaintiff conceded that "Savage" has different chords, tempo and siren than plaintiff's song. However, when plaintiff filed his complaint, he possessed only SR registration and acquired PA registration only after filing. Because plaintiff therefore limited to asserting sound recording infringement claim and had not done so, dismissal was warranted.

*Gaffney v. Muhammad Ali Enter. LLC*, No. 20-7113, 2022 U.S. Dist. LEXIS 161663 (S.D.N.Y. Sept. 7, 2022)

District court granted in part and denied in part parties' motions for summary judgment. Plaintiff, professional photographer, sued parent brand development and licensing company, Authentic Brands Group LLC, Muhammad Ali Enterprises (MAE) and others for infringement and DMCA violations stemming from MAE's unauthorized copying of photographs authored by plaintiff. Parties disputed validity of two registrations pursuant to § 411(b). Defendants asserted invalidity of first registration, which claimed to cover unpublished works, because of prior licensing agreement. Plaintiff, however, pleaded that he believed agreement was fraudulent and therefore could not amount to publication. Applying rule from *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S.Ct. 941 (2022), in which Court held that "[l]ack of knowledge of either *fact or law* can excuse an inaccuracy in a copyright registration," court found that plaintiff sufficiently pleaded that he lacked knowledge of inaccuracy because he believed works were not legally published. As to second registration, defendants claimed that it was similarly invalid because works were published prior to date claimed by plaintiff due to plaintiff's provision of work to newspaper, display of works at exhibition, and licensing agreement with defendants. Court, however, found that plaintiff sufficiently showed that he lacked requisite knowledge. Court found both registrations satisfied requirements of §§ 411 and 412.

*Neman Bros. & Assoc. v. Interfocus, Inc.*, No. 20-11181, 2023 U.S. Dist. LEXIS 2143 (C.D. Cal. Jan. 4, 2023)

Court dismissed infringement claims because subject compilation registrations should have been refused for failing to identify other authors involved in creation of constituent works. Plaintiffs alleged that garments sold on defendant's website infringed two of plaintiffs' copyrights, and defendant was liable for direct, vicarious, and contributory infringement. Defendant asserted that registrations were invalid for containing inaccurate information, as copyrights were for collections in which some designs had third-party authors, but plaintiff was listed as sole author in applications. Question was whether plaintiff's submission of inaccurate information was done with knowledge that it was inaccurate. Court found that plaintiff was at least willfully blind, as instructions in application forms contained information sufficient for plaintiff to realize it was not disclosing ownership in compilation properly. Court, accordingly, sent inquiry to Register regarding whether inaccuracies included in copyright registration applications would have caused Copyright Office to refuse registration. Register responded that Office would not have registered plaintiff's applications for unpublished collections had it known information about authorship, work for hire status, and derivative work status was inaccurate. Court therefore dismissed infringement claims on summary judgment.

*Dow Jones & Company, Inc. v. Harris*, No. 22- 564, 2023 U.S. Dist. LEXIS 12930 (W.D. Tex. Jan. 24, 2023)

Magistrate judge recommended dismissal of copyright infringement claims based on unregistered works. Plaintiff Dow Jones, publisher of *The Wall Street Journal* and *Barron's*, sued defendant, professor at Texas A&M, for copyright infringement based on his unauthorized distribution of plaintiff's copyrighted articles in defendant's daily curated newsletter. Plaintiff also alleged that, in sharing articles, defendant removed or altered copyright management information such as copyright notices. Defendant moved to dismiss infringement claim, arguing that 690 of 6,186 allegedly infringed articles were not registered with Copyright Office. Plaintiff conceded that it was not pursuing copyright infringement claims as to unregistered works, but argued that registration status was irrelevant to plaintiff's DMCA claims for alteration of CMI. Magistrate recommended dismissal of copyright infringement claims as to 690 unregistered works and noted that defendant had not sought dismissal of DMCA claims as to those works.

*Trial Laws. Coll. v. Gerry Spences Trial Laws. Coll. at Thunderhead Ranch*, No. 20-80, 2022 U.S. Dist. LEXIS 179221 (D. Wyo. Sept. 28, 2022)

District court found that genuine issue of material fact existed as to validity of plaintiff's copyright registration. Plaintiff legal training nonprofit sued numerous defendants alleging, *inter alia*, that defendants' agents infringed plaintiff's copyrighted trial skills outline, which was work for hire. Defendants presented evidence that plaintiff's registered work was not for hire but instead derivative of defendant Gerry Spence's earlier book. Court held that evidence presented by defendants was sufficient to overcome presumption of validity enjoyed by plaintiff's registration. Thus, factual issue existed as to validity of plaintiff's copyright registration.

*Ty Inc. v. Target Corp.*, No. 18-2354, 2022 U.S. Dist. LEXIS 170581 (N.D. Ill. Sep. 21, 2022)

District court denied motion for referral to Copyright Office to reconsider copyright registration where court found no basis for defendant's argument that plaintiff misled Office. Ty, creator of Beanie Babies, developed BEANIE BOOS line of plush toy dogs, and obtained copyright registrations for various designs. One such design was "Rainbow," filed as derivative work of earlier Ty BEANIE BOOS registrations. Rainbow looked like other BEANIE BOOS, but with rainbow fabric. Ty brought infringement claim against Target, in response to which Target asserted that Ty made knowingly false representations to Office to obtain "Rainbow" registration. Target moved court to issue request to Office to advise whether Office would have refused registration if it were aware of false representations. Target argued that Rainbow was nothing more than color variation of prior work, and variations in coloring are not copyrightable. Target also argued that rainbow color and fabric were used on earlier Ty owl doll, which Ty failed to disclose in Rainbow application. Court held that there was no evidence that Ty based Rainbow on owl toy or incorporated that toy into Rainbow design, so there was no obligation to disclose owl. And because Ty claimed to

use different fabric in Rainbow than other BEANIE BOOS, not just different coloring, court could not grant motion.

*Brunson v. Cook*, No. 20-1056, 2023 U.S. Dist. LEXIS 52717 (M.D. Tenn. Mar. 28, 2023)

Court sent question to Register whether it would have denied registration had it known that work was previously published, contrary to statement in application. Plaintiff wrote congregational worship music. Defendant purportedly administered copyright to song by separate artist. Plaintiff wrote and registered musical bridge that was written primarily to be performed as part of defendant's song, replacing section that was in defendant's song as originally written. In Plaintiff's 2020 application, she initially stated that work was previously published in 2017, and as part of application submitted deposit copy including excerpt of defendant's song, explaining where plaintiff's work began in defendant's song. Copyright Office asked plaintiff whether she had submitted full published work, whether she was sole author of entire song, and whether work was previously published. Plaintiff told Copyright Office work was actually unpublished, and application was approved on that basis. Defendants moved court to issue request to Register to state whether Office would have denied registration if it had known plaintiff included inaccurate information in application. First, court found that plaintiff's assertion that mark was unpublished was inaccurate, as placement online for streaming on sites such as YouTube, Instagram, and Twitter was publishing work. Plaintiff's argument that work had not been published because it could not be downloaded was not correct. This inaccuracy was not mere clerical error, as plaintiff only made assertion in response to Copyright Office communication pointing out apparent online publications. Court therefore put question to Register to determine if registration would have been withheld had that inaccuracy been known. Court did not put to Register question whether application inaccurately stated that entire work was submitted, as that question depended on determination of whether work was derivative of defendant's song, which was not properly briefed in this motion. Court reserved right to pick that question up later depending on Register's response to initial question.

*Brunson v. Capitol CMG, Inc.*, No. 20-1056, 2022 U.S. Dist. LEXIS 153033 (M.D. Tenn. Aug. 25, 2022)

District court granted motion to dismiss counterclaim for declaratory judgment, finding defendants had failed to properly plead fraud on Copyright Office. Plaintiff Lisa Brunson, Christian singer/songwriter sued defendants including music publisher, music administrator, and songwriter "Sinach" for infringement. Sinach wrote religious-themed song "Way Maker"; more than one year later, Brunson created new version of song by removing original bridge and incorporating plaintiff's composition in its place. Brunson's performance of song garnered over 1.8 million views on YouTube. Defendants counterclaimed for infringement and fraud on Copyright Office. Regarding fraud, defendants alleged that Brunson failed to submit complete copy of her work to Copyright Office, by intentionally failing to state Brunson's work was created to be part of larger work that belonged to Sinach. Defendants had alleged that Brunson's removal of original bridge and insertion of her work constituted

unauthorized derivative work, but district court concluded such allegation was conclusory. Defendants also alleged that Brunson deleted measure notation at top of deposit copy, which prior to deletion had indicated that such work was fifty-sixth measure of larger work. However, district court noted that actual test for determining whether work is derivative is whether ordinary listener would find work substantially similar to other work at issue; here, defendants' allegations suggested to court that Brunson's work was new composition and not derivative. District court accordingly held that defendants failed to plead derivative work and thus failed to state claim for fraud on Copyright Office.

*Stringer v. Richard*, No. 21-632, 2022 U.S. Dist. LEXIS 149572 (N.D. Ohio Aug. 19, 2022)

Court granted summary judgment dismissing sound recording infringement claim because sound recording was not registered. Court rejected assertion that applicant accidentally applied for composition registration. Plaintiffs released song and initially obtained copyright registration for composition, but not recording. Defendant released song using sample of plaintiffs' recording. Plaintiffs claimed that they incorrectly selected "Music Composition" instead of "Sound Recording" when registering copyright 30 years ago, but court found that this did not fall under Act's safe harbor provision for registration process errors. This was not error of information entry; applicant applied for incorrect type of registration, so there is no safe harbor. Because portion of composition sampled by defendant was not independent creation of plaintiffs, and came from well-known hymn, plaintiffs' composition infringement claim also failed.

## V. INFRINGEMENT

### A. Access

*Klauber Bros. v. M.J.C.L.K., LLC*, No. 21-4523, 2022 U.S. Dist. LEXIS 181739 (S.D.N.Y. Oct. 4, 2022)

District court dismissed copyright infringement action where plaintiff failed to adequately plead access or striking similarity. Plaintiff lace wholesaler sued, *inter alia*, Badgley Mischka for infringing its rights in registered lace design. Plaintiff alleged that defendant previously had business relationship with plaintiff, accessed plaintiff's design library and received samples of plaintiff's designs. Plaintiff also alleged that, beginning in 2016, it had sold almost 24,000 yards of subject lace fabric to retail and apparel industry customers in New York City, where defendant was located. Court held that plaintiff had not pleaded access because it failed to substantiate allegations regarding widespread dissemination or to otherwise provide adequate link between copyrighted design and defendants. It was unclear when plaintiff's business relationship with defendant occurred or whether copyrighted design was part of plaintiff's design library when defendant had access thereto. Moreover, parties' respective designs were not strikingly similar, such that access could be inferred.



*Poppington LLC v. Brooks*, No. 20-8616, 2022 U.S. Dist. LEXIS 105311  
(S.D.N.Y. June 13, 2022)

District court granted defendant's motion for summary judgment in part, by dismissing plaintiff's infringement claims, declaring defendant owner of subject work, and enjoining plaintiffs from again attempting to register copyright in subject work. Defendant Edwyna Brooks wrote novel *Mafietta*, which was then adapted to film with help of plaintiff Raquel Horn, Horn's production company Poppington LLC, and others. Horn took multiple photos while on set, one of which defendant allegedly used as book cover on subsequent book. Plaintiffs sued for infringement. Defendant claimed photo was still image from film recording, while plaintiffs claimed it was photo Horn had taken. At summary judgment, district court first evaluated whether defendant had access to subject work. Plaintiffs cited no direct evidence indicating defendant actually copied Horn's photo. Defendant's evidence provided plausible explanation that, although book cover might look similar to Horn's photo, it could be still image from movie footage. Due to factual dispute regarding access, *inter alia*, district court denied summary judgment on copyright claim.

*Klauber Bros., Inc. v. City Chic Collective Ltd.*, No. 22-1743, 2022 U.S. Dist. LEXIS 220103 (C.D. Cal. Dec. 6, 2022)

District court found that plaintiff adequately pleaded access. Plaintiff composed two-dimensional artworks for purposes of lace production. Plaintiff alleged that defendant, which had long purchased laces from plaintiff, copied those patterns to create its own garments. Court found that access was pleaded even though there was no proof that defendant purchased specific design at issue. Plaintiff alleged that defendant reviewed plaintiff's entire sample library, and that allegation was sufficient for access.

*Morford v. Cattelan*, No. 21-20039, 2022 U.S. Dist. LEXIS 118967 (S.D. Fla. July 6, 2022)

District court denied motion to dismiss. Plaintiff artist alleged that his sculptural diptych, "Banana & Orange," was infringed by work entitled "Comedian" by internationally famous artist Maurizio Cattelan. Both works prominently feature banana affixed to wall with silver duct tape. Court framed legal question as whether Morford's *pro se* complaint sufficiently alleged that "Cattelan's banana infringes his banana." Court stated that unless similarities and differences between parties' works "render a plaintiff's case bunk as a matter of law, such questions should go to the trier of fact." Regarding access, plaintiff "generally alleged that Cattelan had access" to plaintiff's work. In response defendant cited "multitude of cases for the proposition that access cannot be established by mere internet publication," but court noted that all but one of those authorities were decided on summary judgment, and that "courts in this District have held that plaintiffs must have the opportunity to establish evidence showing the extent of internet presence in support of access."

*Cooley v. Target Corp.*, No. 20-2152, 2022 U.S. Dist. LEXIS 175623 (D. Minn. Sept. 28, 2022)

District court dismissed copyright infringement claims because plaintiff failed to establish defendant's access to plaintiff's works. Between 2012 and 2018, autistic minor and artist NOC created various artistic works featuring scribble dots. Works were posted on social media and NOC's website during same timeframe. In summer 2018, defendant Target became aware of NOC's works via NYC art supply company's Instagram video posted in May 2018. NOC, at Target's invitation, participated in social media promotion event in July 2018. Few months following event, NOC's mother discovered that Target was using, on children's clothing line, pattern alleged to be strikingly similar to NOC's works. Plaintiff NOC's mother sued Target for copyright infringement. Because there was no evidence of direct copying (and indeed there was evidence that Target's allegedly infringing pattern was independently created by in-house designers in summer 2017), plaintiff tried to establish copying by showing access to NOC's works coupled with substantial similarity between parties' respective works. Court held that plaintiff failed to show widespread dissemination necessary to establish access because, although works posted online, likes and shares of social media posts were modest (less than 200 interactions); and though website views were around 130,000 over four years, it was unclear which pages visitors actually viewed and therefore whether works were seen. Moreover, works were included in some videos where they were distant or only visible for seconds. Court likewise rejected plaintiff's argument that Target's contact of NOC itself showed chain of events establishing access, because there was no evidence that anyone from Target knew of NOC or viewed NOC's art prior to 2018.

*Sensory Path Inc. v. Fit & Fun Playscapes LLC*, No. 19-219, 2022 U.S. Dist. LEXIS 209192 (N.D. Miss. Nov. 17, 2022)

District court held that factual issues existed regarding counter-claimant's access to claimant's copyright. Sensory Path ("SP") and Fit and Fun ("FF") both created and sold adhesive stickers allowing users to create paths for children's sensory integrated movement. In relevant part, FF claimed that SP had access to FF's asserted works, relying in part on visit to FF's website from IP address in Oxford, Mississippi (where SP is located). SP's principal admitted to searching Pinterest (where FF had published some of its works) and Google for sensory paths and painted and interactive playgrounds. SP's searches and IP address together created genuine issue of material fact as to whether SP had access to FF's works.

## **B. Copying and Substantial Similarity**

*Klauber Bros., Inc. v. URBN US Retail LLC*, No. 21-4526, 2023 U.S. Dist. LEXIS 21619 (S.D.N.Y. Feb. 8, 2023)

District court granted defendants' motion to dismiss because modest alterations did not cure deficiencies identified in prior court opinion. Plaintiff alleged defendants created, manufactured, and sold two dress styles with lace straps bearing patterns copied from one of plaintiff's lace designs, and sued for copyright infringement. Court in prior opinion

concluded plaintiff had not adequately pleaded defendants had access to protected work. However, court also found that lace defendants used was strikingly similar to plaintiff's protected work, and granted plaintiff leave to amend complaint. Defendants argued given limited additional allegations in amended complaint, court should not reach different conclusion. Court found plaintiff failed to allege substantial similarity between design and dresses because of "numerous evident differences between the patterns." Plaintiff's new allegation that any differences on lace of infringing products result in part from defendant's using cruder, lower-quality techniques and machinery did not change analysis, as those differences were not material to court's finding that designs were not substantially similar. Court found plaintiff's allegation that it sent defendant two samples of "sister design" along with several unrelated designs did not support claim that defendants had access to design. Court found plaintiff's allegations insufficient to establish actual copying because there were no specific facts from which court could infer access, and plaintiff failed to allege design so widely disseminated that defendants would have had access to it. Plaintiff's allegation did not establish how much lace bearing design was distributed and failed to indicate where, and to whom lace was distributed. Court held plaintiff did not adequately allege claim for copyright infringement. Court also held plaintiff did not adequately plead vicarious or contributory infringement because conclusory allegations insufficient. Court found plaintiff's allegations vague regarding roles defendants played in any alleged infringement, and plaintiff's substantive allegations conclusory and mere boilerplate. Court granted defendants' motion to dismiss without leave to amend.

*Structured Asset Sales, LLC v. Sheeran*, No. 18-539, 2022 U.S. Dist. LEXIS 177266 (S.D.N.Y. Sept. 29, 2022)

District court held that factual issues precluded summary judgment as to whether plaintiff's work sufficiently original. Plaintiff sued Ed Sheeran and others, claiming that Sheeran's song "Thinking Out Loud" infringed copyright in "Let's Get It On" composition. Plaintiff's claim was based on alleged copying of chord progression and harmonic rhythm (collectively, "backing pattern"). Although copyright afforded to particular arrangement of backing pattern was thin, court, citing parties' respective experts' testimony, denied summary judgment as to substantial similarity, concluding that jury could find that overlap between respective backing patterns was very close.

*Krafton, Inc. v. Apple, Inc.*, No. 22-209, 2023 U.S. Dist. LEXIS 53494 (C.D. Cal. Feb. 24, 2023)

Court denied defendant YouTube's motion to dismiss infringement action. Plaintiffs Krafton, Inc. and PUBG Santa Monica owned videogame called *PlayerUnknown's Battlegrounds* ("Battlegrounds"), which was "non-linear, network-connected, dynamic, and interactive game with infinite outcomes." Plaintiffs alleged that YouTube hosted Chinese film titled *Biubiubiu*, allegedly infringing live-action dramatization of *Battlegrounds*. Court determined that, given nature of *Battlegrounds* game, where there was virtually no way of having typical gameplay experience, it was not capable of examining and comparing copyrighted work and accused material in real and meaningful sense. Court also found that,

because copyrighted work and accused work were different forms of media, it was not comfortable concluding that “plot, themes, dialogue, mood, setting, pace, characters, and sequence of events” were appropriate substantial similarity factors to consider for type of video games that *Battlegrounds* fell into. Court also dismissed YouTube’s alternative arguments for dismissal – that *Biubiubiu* constituted “fair use” of *Battlegrounds*. Court found that first, third, and fourth factors needed to be influenced and informed by development of evidence via discovery. Court accordingly held that substantial similarity and fair use inquiries could not be conducted on basis of pleadings alone, and denied defendant’s motion to dismiss.

*Fisher v. Nissel*, No. 21-5839, 2023 U.S. Dist. LEXIS 11491 (C.D. Cal. Jan. 20, 2023)

District court dismissed plaintiff’s copyright infringement claims without leave to amend. Plaintiff individual sued defendants that included Disney and ABC based on the alleged infringement of copyrights in plaintiff’s comedy series MIXED by defendants’ series Mixed-ish and Black-ish. Plaintiff alleged that Mixed-ish shared numerous similarities to plaintiff’s work, including female protagonist battling racial stereotypes, going on awkward first date, struggling to identify as black or white, dealing with crush on parents’ subordinate, and attending church. As for Black-ish, plaintiff alleged it too shared numerous similarities to plaintiff’s work, such as female protagonist who references Condolezza Rice, deals with cold weather jokes and encounters Nation of Islam bean pies. Court held that allegations concerning similarities between parties’ respective works (and, as to Mixed-ish, their titles) insufficient to state copyright infringement claim because they do not include allegations concerning similarities between works’ dialogue, mood, setting, pace or sequence of events.

*Woodland v. Hill*, No. 22-3930, 2022 U.S. Dist. LEXIS 221842 (C.D. Cal. Dec. 8, 2022)

Plaintiff, freelance visual artist, photographer, figure model and creator of online works, sued defendant for copyright infringement for posting series of Instagram photos which “copied, appropriated, and mimicked” twelve of plaintiff’s copyrighted photographs. Defendant filed motion to dismiss, arguing that plaintiff failed to plausibly allege infringement. District court granted defendant’s motion with leave to amend because even though plaintiff’s photographs were available on Instagram and online, this was not sufficient to demonstrate wide dissemination. Additionally, court held that plaintiff did not plausibly allege unlawful appropriation under two-part extrinsic and intrinsic tests. Although both sets of photos depicted “nude, but unexposed black male,” photographer cannot claim monopoly on right to photograph particular subject, and cannot claim copyright protection for elements that flow from natural phenomena, such as features of human body. Further, although plaintiff argued that defendant copied poses of his models, court reasoned that that “poses” are not copyrightable. Instead, plaintiff would only be entitled to protection for way pose is depicted (i.e., decisions about light, angle, shutter speed, etc.), but plaintiff did not offer any facts about these choices.

*Klauber Bros., Inc. v. City Chic Collective Ltd.*, No. 22-1743, 2022 U.S. Dist. LEXIS 220103 (C.D. Cal. Dec. 6, 2022)

District court found that plaintiff adequately pleaded substantial similarity. Plaintiff composed two-dimensional artworks for purposes of lace production. Plaintiff alleged that defendant, which had long purchased laces from plaintiff, copied those patterns to create its own garments. Court found that substantial similarity was adequately pleaded. Though similar elements in parties' designs were not complicated and might not be individually copyrightable, this did not make entire design non-copyrightable, as selection, coordination, and arrangement of unprotectible elements may be protectible. Court had previously found that designs were not strikingly similar, but plaintiff met its burden to plead substantial similarity.

*Whitehead v. Netflix, Inc.*, No. 22-4049, 2022 U.S. Dist. LEXIS 215901 (N.D. Cal. Nov. 30, 2022)

*Pro se* plaintiff, self-published author of novel *No Fairy Tales*, filed suit against defendant Netflix alleging that defendant's series *Family Reunion* was unlawful derivative of her work. Complaint alleged that *Family Reunion* was derivative because it shared "substantial similarities ... such as but not limited to the main character of the show, plots and obstacles that the main character [has] with other characters, and even dialogue," and that main character in *Family Reunion* "cannot be separated from the main character" in *No Fairy Tales*. Plaintiff, however, did not describe contents of either work in detail or attach them to complaint. Defendant filed request that court take judicial notice of both works, which court granted. Defendant also moved to dismiss plaintiff's complaint for failure to state claim. Upon comparing works closely, court held that plaintiff failed to allege substantial similarity, and that two works were not substantially similar. Although works shared some unprotectable elements such as black teenage characters named Jade and subplots about interracial relationships, protectable elements in works' plots, characters, dialogue, themes, setting, mood, pace and sequence of events were quite different. Court granted defendant's motion to dismiss without leave to amend.

*Moement, Inc. v. GrooMore, Inc.*, No. 22-2871, 2022 U.S. Dist. LEXIS 216330 (C.D. Cal. Nov. 29, 2022)

Plaintiff owner and operator of "online pet grooming scheduling software system" Moego sued former software engineering employees for infringement, alleging defendants stole software and source code to create competing online pet grooming scheduling service GrooMore. On motion to dismiss, district court analyzed substantial similarity between plaintiff's website and defendant's allegedly infringing website. Applying "extrinsic" substantial similarity test, court analyzed source code of website and found it "highly similar to Moego's copyrighted source code." Turning to "intrinsic" substantial similarity analysis, court found numerous similarities between website including categories of displays on interface; word selection and layout; look and feel of website interfaces; and "nearly identical word choice" used in various website features. Court noted that even if these

features were functional and thus not *per se* subject to copyright protection, they were protectable because “the author had multiple ways to express the underlying idea” and defendant copied expression used by plaintiff. Court further noted that “most glaring” allegation of substantial similarity was that defendant’s code included Apple and Google API certificates that could have appeared in defendant’s code only if copied from plaintiff’s code – such copying of “functionally unnecessary scripts” is strong evidence of substantial similarity. Finding plaintiff sufficiently pleaded ownership and copying, motion to dismiss infringement claim denied.

*Brasserie de Tahiti v. Oceandless Design, Inc.*, No. 22-3363, 2022 U.S. Dist. LEXIS 214072 (C.D. Cal. Nov. 28, 2022)

District court dismissed infringement claim where designs in question were starkly different. Defendants provided clothing designs to plaintiff under agreement under which defendants were to create technical files for use in manufacturing garments. Plaintiff alleged that defendants later sold these “tech packs” and designs to third party in violation of agreement. While plaintiff sufficiently pleaded breach of contract, court found that plaintiff failed to plead substantial similarity, and therefore failed to plead infringement. Though plaintiff’s ownership of copyrights was not disputed, floral prints used by third party were found to be starkly different from floral prints used by plaintiff. Only similarity was that same type of flower appeared in each print.

*Saunders v. Brown*, No. 21-9237, 2022 U.S. Dist. LEXIS 210910 (C.D. Cal. Nov. 21, 2022)

District court denied defendants’ motion to dismiss, rejecting defendants’ argument that plaintiffs failed to allege facts sufficient to satisfy extrinsic test for unlawful appropriation. Plaintiffs, recording artist, songwriter, and entertainer, sued defendants for copyright infringement of song. Plaintiffs alleged songs substantially similar and defendants had access to song. Defendants moved to dismiss unlawful appropriation claim, arguing that plaintiffs did not meet extrinsic test because chanting “wet” is not protectable. Court found plaintiffs plausibly alleged rhythmic chanting of “wet” in song was protectable, and clearly were not claiming word “wet” alone is protectable. Defendants also argued rhythmic chant of “wet” not protectable because other artists have included repetitious chants of word “wet.” Court determined it could not make judgment at this stage just by listening to three songs. Court found plaintiffs plausibly alleged two songs were objectively similar because alleged expert found lyrics and rhythmic placements mostly identical and transcription demonstrated songs rhythmically aligned.

*Milkcrate Ath. Inc. v. Adidas Am., Inc.*, No. 21-9328, 2022 U.S. Dist. LEXIS 204544 (C.D. Cal. Nov. 9, 2022)

Court dismissed copyright infringement claim. Plaintiff Milkcrate, “major player in the streetwear industry,” sued defendant Adidas for infringement for use of logos that were “confusingly similar” to plaintiff’s logos on shoes. Court found Milkcrate’s allegations regarding access not meaningfully disputed for purposes of motion, so court’s analysis

concerned parties' arguments regarding scope of copyright protection on logos and unlawful appropriation. Court found alleged similarities based on logos' use of real-world objects and use or absence of shading accompanying descriptive text were unprotectable because they were expressions common to medium. However, court found that similarities between Milkcrate's logos and defendant's shoes related to plaintiff's choices of placing sleeved record inside milkcrate, black-and-white motif, perspective and style of shading, cross-hatch pattern on milkcrate, as well as style of arching scripted text, were protectable under copyright law. Court determined range of potential arrangements of records and milkcrates too limited to exceed thin protection under copyright. Having determined logos entitled to thin protection, court considered whether artwork on shoes was virtually identical to logos. Court determined logos not virtually identical to logos on shoes and dismissed infringement claim.

*Hanagami v. Epic Games Inc.*, No. 22-2063, 2022 U.S. Dist. LEXIS 161823 (C.D. Cal. Aug. 24, 2022)

District court dismissed infringement claim, finding that defendant did not copy any protectable aspects of plaintiff's copyrighted choreography. Plaintiff choreographer published five-minute-long YouTube video showing dance routine and obtained copyright for choreographic work shown in video. Defendant published popular video game *Fortnite*, which allowed players to purchase "emotes" consisting of animated movements or dances. Defendant published emote which plaintiff contended contained exact copies of certain steps in defendant's copyrighted choreographic work. Defendant moved to dismiss infringement claim, arguing that dance steps contained in *Fortnite* game should be "filtered out" as unprotectable element of plaintiff's work. District court, analyzing Copyright Office's guidance on registration of choreographic works, found that such works comprising "social dance steps and simple routines" are not protectable. District court held that, although plaintiff's five-minute-long dance routine in its entirety was protectable, dance steps copied by defendant were not separately registrable or protectable. Having filtered out relevant dance steps, district court found works not substantially similar and dismissed infringement claim.

*Zeleny v. Burge*, No. 21-5103, 2022 U.S. Dist. LEXIS 136241 (C.D. Cal. July 1, 2022)

District court granted parties' motions to dismiss. Plaintiff, along with one of defendants and non-party, were literary executors of famed computer scientist Alonzo Church. Between 1991-1998, plaintiff helped create collection of Church's written works without significant contributions from co-literary executors; specifically, plaintiff created first bibliography of Church's published works, unpublished manuscripts, and reviews; created typescript code needed to render Church's works in print format; and selected works for inclusion in collection. By mid-1998, plaintiff reported to co-executors that he had partially completed version of collected works and delivered it to them. In mid-2005, Burge informed plaintiff he planned to publish incomplete, non-definitive version of collected works. to which plaintiff objected. and incomplete version never came to fruition. Fourteen years later,

plaintiff learned Burge and MIT Press published incomplete version of works, which plaintiff alleged were “substantially derived” from work he completed between 1991-1998 without plaintiff’s consent. Plaintiff brought suit for infringement. and defendant counterclaimed for declaratory judgment regarding ownership and non-infringement. Defendants moved to dismiss complaint, and plaintiff moved to dismiss counterclaims. First, defendant contested validity of copyright in bibliography and typescript. Plaintiff conceded that registration did not cover bibliography, but argued typescript was covered by registration. Court held that typescript was not covered by registration, relying in part on plaintiff’s communications with Copyright Office about scope of registration. Because amendment could not cure lack of registration, court dismissed claim as to bibliography and typescript with prejudice. As to claim related to compilation, court found plaintiff failed to sufficiently plead copying and unlawful appropriation of protectable aspects of compilation and granted motion to dismiss with leave to amend. Court declined to hear counterclaim for declaratory relief, because plaintiff stated he would no longer maintain infringement claim, meaning that there was no controversy between parties.

*Walkie Check Prods., LLC v. ViacomCBS Inc.*, No. 21-1214, 2022 U.S. Dist. LEXIS 113357 (S.D.N.Y. June 27, 2022)

District court denied defendants’ motion to dismiss because plaintiff had alleged sufficient similarities between plaintiff’s and defendants’ television program concepts. In 2015, plaintiff created treatment for show called *House Party* (“Treatment”), which followed party hostess weaving through raucous house party at Manhattan brownstone, filming musical performances and unscripted celebrity interviews, alternating between selfie-friendly vertical and traditional horizontal camera orientations. Plaintiff first pitched Treatment to defendant media companies in 2015. Although parties engaged in serious negotiations until July 2016, when defendants officially passed on Treatment, parties continued to correspond sporadically between 2017 and early 2020. On March 29, 2020, defendants debuted, on Instagram Live, own *House Party* series that featured widely varying tone, duration and formats (from baking videos, dance tutorials and interviews with doctors), with some episodes filmed in vertical and others in horizontal orientation. After 86 episodes, *House Party* ended on January 20, 2021. Defendants conceded that plaintiff adequately pleaded actual copying, but claimed that defendants’ series was not substantially similar to Treatment, which contained both protectable and unprotectable elements, under “more discerning” ordinary observer test applied to such mixed works. Court held that though Treatment’s elements were potentially unprotectable on their own, sum total of these artistic choices was sufficient to constitute protectable work even under “more discerning” substantial similarity analysis that disregards unprotectable elements. Moreover, court found that incompleteness of evidentiary record precluded dismissal because defendants had provided only fraction of their show’s episodes (25 of 86), and therefore court lacked all information necessary to compare parties’ respective works.



*Gaede v. DeLay*, No. 22-380, 2022 U.S. Dist. LEXIS 219386 (D. Or. Dec. 6, 2022)

Plaintiff, author of book *Why God Doesn't Exist*, alleged that defendants' work *Demystifying Science* infringed his work. Court first dismissed infringement allegations based on images and diagrams in plaintiff's book and not based on copyrighted text. Court similarly dismissed allegations based on YouTube videos because complaint did not allege that plaintiff held valid copyright in that work. As to substantial similarity between textual passages, court noted that there was "some surface-level similarity," but essence of plaintiff's complaint related to protection of ideas and concepts, which are not protectable by copyright. Accordingly, court granted defendants' motion to dismiss.

*Morford v. Cattelan*, No. 21-20039, 2022 U.S. Dist. LEXIS 118967 (S.D. Fla. July 6, 2022)

District court denied motion to dismiss. Plaintiff artist alleged that his sculptural diptych, "Banana & Orange," was infringed by work entitled "Comedian" by internationally famous artist Maurizio Cattelan. Both works prominently feature banana affixed to wall with silver duct tape. Court framed legal question as whether Morford's *pro se* complaint sufficiently alleged that "Cattelan's banana infringes his banana." Court stated that unless similarities and differences between parties' works "render a plaintiff's case bunk as a matter of law, such questions should go to the trier of fact." With respect to substantial similarity, court began by considering which test to apply: traditional lay observer standard, extrinsic/intrinsic analysis developed in Ninth Circuit, or abstraction-filtration-comparison method most often applied in software and literary cases. Whichever title is given to controlling test, court stated, it must determine "whether a reasonable jury could find the [works at issue] substantially similar at the level of protected expression." Court found that Morford had plausibly alleged such similarity. Applying abstraction-filtration-comparison approach, court declined to filter out Morford's specific "choices in color, positioning and angling" of sculptural elements. In sum, court stated, "[w]hile Morford is afforded no protection for the idea of a duct-taped banana or the individual components of his work, Morford may be able to claim some degree of copyright protection in the 'selection, coordination, [and] arrangement' of these otherwise unprotectable elements." Court found similarities with respect to those elements: in both works, single piece of silver duct tape runs upward from left to right at angle, affixing centered yellow banana, angled downward left to right, against wall. In both works, banana and duct tape intersect at roughly midpoints of each, although duct tape is less centered on the banana in Morford's work than in defendant's. Disregarding differences between works, court found that "the alleged infringement of Morford's banana is sufficient, quantitatively and qualitatively, to state a claim."

*Fitzgerald v. Murray*, No. 21-1822, 2022 U.S. Dist. LEXIS 166668 (S.D. Ind. Sept. 15, 2022)

Court granted plaintiff's motion for summary judgment on copyright infringement claim. Plaintiff Fitzgerald was executor of estate of Frithjof Schuon ("Schuon"), philosopher and author, who died in 1998. Defendant Murray was close friend of Schuon and wife until Murray became estranged following her divorce. Schuon died in 1998 and his wife inherited his right of publicity and copyrights, which were subsequently assigned to plaintiff World Wisdom. In 2018, defendant Murray published website containing numerous allegations about Schuons, and infringed some of Mrs. Schuon's copyrighted works. In 2021, Murray and defendant Beacon Books published book titled *Third Wife of the Muslim Shaykh Frithjof Schuon* ("*Third Wife*"), which included allegations about Schuons and plaintiff, and infringed Mrs. Schuon's copyright in work titled *Points of Reference*, owned by plaintiff World Wisdom. Later in 2021, Beacon Books withdrew *Third Wife* from circulation, although Murray continued to disseminate electronic versions. In June 2021, plaintiffs filed copyright infringement claim and sought injunctive relief. Court issued preliminary injunction prohibiting defendants from distributing *Third Wife*. Thereafter, plaintiffs moved for summary judgment on copyright infringement claim. Court granted plaintiffs' motion. First, court determined that plaintiff World Wisdom owned valid copyright in *Points of Reference*, as it was handwritten letter created by its author Mrs. Schuon, and registered with Copyright Office. Second, court found direct evidence of actual copying, insofar as defendants admitted to reproducing identical copy of *Points of Reference* in *Third Wife*.

*Sumner Co. v. Jordan*, No. 21-127, 2023 U.S. Dist. LEXIS 29562 (D. Alaska Feb. 22, 2023)

Court granted summary judgment for defendant on infringement. Defendant homeowner engaged plaintiff home builder to design home, but defendant later provided home design plans to different builder, who modified plans by "25%"; plaintiff saw copy of modified plan "on the desk of a lumber salesman and immediately recognized it" as plaintiff's plan, and sued for infringement. On motion for summary judgment, defendant did not dispute plaintiff's ownership of copyright in house design (as plaintiff submitted copyright registration), but did argue that allegedly copied designs were not substantially similar to plaintiff's designs. Applying Ninth Circuit "extrinsic test" to examine substantial similarity, district court considered what elements of architectural plans are *scenes a faire* and/or mere ideas that are so "merged" into expression in drawings that they are not eligible for protection. Relying on expert testimony, district court concluded that plaintiff's plans consisted of architectural themes common to "modern prairie-style" homes, and that no reasonably jury could conclude that plaintiff's plans included protectable elements. District court further found noted that even if overall plans were protectable, copyright in such architectural plans is "thin," and to infringe plans must be "virtually identical." Because defendant's plans were modified and thus not identical, district court found defendant had not violated any "thin" copyright plaintiff may have been entitled to. Summary judgment for defendant.

### C. Contributory/Vicarious Infringement

*ABKCO Music, Inc. v. Sagan*, 50 F.4th 309 (2d Cir. 2022)

Second Circuit reversed district court's finding on summary judgment of direct infringement, finding district court erred in applying vicarious liability standard even though plaintiffs only pleaded direct infringement. Defendants acquired archives of late concert promoter Bill Graham, which contained audiovisual and audio recordings from many top-selling musical artists and which defendants made available for streaming online for fee. Following summary judgment rulings on infringement and trial on damages, Second Circuit heard appeal on whether defendant William Sagan was liable for direct infringement. Considering precedent that direct infringement liability attaches only to "the person who actually pushes the button," Second Circuit found deposition testimony from defendant's Chief Technology Officer that "it was Sagan who instructed him 'which concerts to make available for download'" insufficient to establish that Sagan was "the one who actually pushed the button." District court's order granting judgment against Sagan reversed.

*Klauber Bros., Inc. v. URBN US Retail LLC*, No. 21-4526, 2023 U.S. Dist. LEXIS 21619 (S.D.N.Y. Feb. 8, 2023)

District court granted defendants' motion to dismiss because modest alterations did not cure deficiencies identified in prior court opinion. Plaintiff alleged defendants created, manufactured, and sold two dress styles with lace straps bearing patterns copied from one of plaintiff's lace designs, and sued for copyright infringement. Court in prior opinion concluded plaintiff had not adequately pleaded defendants had access to protected work. However, court also found that lace defendants used was strikingly similar to plaintiff's protected work, and granted plaintiff leave to amend complaint. Defendants argued given limited additional allegations in amended complaint, court should not reach different conclusion. Court found plaintiff failed to allege substantial similarity between design and dresses because of "numerous evident differences between the patterns." Plaintiff's new allegation that any differences on lace of infringing products result in part from defendant's using cruder, lower-quality techniques and machinery did not change analysis, as those differences were not material to court's finding that designs were not substantially similar. Court found plaintiff's allegation that it sent defendant two samples of "sister design" along with several unrelated designs did not support claim that defendants had access to design. Court found plaintiff's allegations insufficient to establish actual copying because there were no specific facts from which court could infer access, and plaintiff failed to allege design so widely disseminated that defendants would have had access to it. Plaintiff's allegation did not establish how much lace bearing design was distributed and failed to indicate where, and to whom lace was distributed. Court held plaintiff did not adequately allege claim for copyright infringement. Court also held plaintiff did not adequately plead vicarious or contributory infringement because conclusory allegations insufficient. Court found plaintiff's allegations vague regarding roles defendants played in any alleged infringement, and plaintiff's substantive allegations conclusory and mere boilerplate. Court granted defendants' motion to dismiss without leave to amend.

*Petersen v. Diesel Power Gear LLC*, No. 21-8827, 2022 U.S. Dist. LEXIS 229983 (S.D.N.Y. Dec. 21, 2022)

District court granted partial summary judgment to plaintiff artist Shane Petersen. Plaintiff, known professionally as SRIL, created original mural entitled “Godlike.” Plaintiff alleged that defendant Diesel twice photographed portion of Godlike behind truck, and posted images to social media to promote Diesel’s truck giveaway. Plaintiff also sued individual owners of Diesel for vicarious and contributory infringement. Diesel admitted that plaintiff had established direct infringement, but issue of fact remained regarding whether individual defendants personally participated in acts of infringement, as none took photos used in infringing posts. Regarding vicarious liability, district court held that although individual defendants had ability to supervise employees who posted infringing photos, no undisputed evidence existed showing that individual defendants reaped financial benefit from Diesel’s infringing activities. Regarding contributory infringement, district court held that material issues of fact existed regarding whether individual defendants encouraged or assisted infringement. District court therefore granted plaintiff’s motion for summary judgment with respect to Diesel’s liability for infringement, and denied all other parts of motion.

*Schneider v. YouTube, LLC*, No. 20-4423, 2023 U.S. Dist. LEXIS 1878 (N.D. Cal. Jan. 5, 2023)

District court held that plain language of Terms of Service precluded direct, but not indirect, infringement liability for works uploaded by plaintiff. Plaintiff musician, as one of three named plaintiffs in putative class action, sued YouTube and Google for infringing copyrights in her compositions and sound recordings. Plaintiff had established YouTube account in 2012 and both uploaded videos with her works and authorized others to do so. YouTube’s Terms of Service granted it “worldwide, nonexclusive, royalty-free, sublicensable and transferable license to use, reproduce, distribute, prepare derivative works of, display, and perform” user-uploaded content. Terms of Service also granted non-exclusive license to YouTube users to use, reproduce, distribute and perform user-uploaded content as permitted through Terms of Service (which prohibited upload of infringing content). Court held that YouTube could not be liable for direct infringement of any works uploaded to YouTube by plaintiff. However, YouTube could be liable for indirect infringement because infringing user uploads were outside YouTube’s user license and therefore YouTube could be liable for such infringement if YouTube materially contributed to, induced or supervised infringement with impunity.

*Whitley v. Maguire*, No. 22-1837, 2022 U.S. Dist. LEXIS 219064 (C.D. Cal. Dec. 5, 2022)

District court granted in part defendant’s motion to dismiss complaint. Plaintiff artist Whitley set up Discord server, online community via Discord platform, where Whitley promoted his work and digital goods, including NFTs, for sale. Whitley partnered with defendant Wiriadjaja and transferred control of Discord account to Wiriadjaja. Whitley remained active in hiring decisions and paid maintenance fees for Discord server. Other

defendants were also hired in connection with Discord project. Whitley then formed and was sole member of digital art agency, plaintiff WTF.Industries LLC (WTF). Whitley and defendants collaborated on art project involving design authored by Whitley and registered in Whitley's name alone. Defendants agreed to provide share of revenues to Whitley and WTF. After defendants allegedly failed to pay revenue shares, plaintiffs brought multiple claims, including for direct and vicarious copyright infringement. Plaintiffs alleged that Whitley revoked authorization for defendants to use subject design following their alleged failure to pay revenues, yet defendants continued to sell works incorporating Whitley's design. Defendants moved to dismiss claims. Noting that owner who grants nonexclusive copyright license usually has remedy in contract law, not copyright, district court reviewed claim to determine if alleged copying exceeded scope of license and if plaintiffs' complaint was based on exclusive right under copyright. Court held plaintiffs had failed to plausibly allege that defendants violated Whitley's exclusive rights under copyright, instead focusing on breach of contract. In addition, court held that certain of plaintiffs' allegations – that defendants continued to sell works incorporating subject design after authorization was revoked – were conclusory and contrary to plaintiffs' well-pleaded allegations. District court therefore dismissed plaintiffs' direct copyright claim, and dismissed vicarious claim as well, due to plaintiffs' failure to state claim for direct infringement.

*Arias v. Universal Music Grp.*, No. 21-2551, 2022 U.S. Dist. LEXIS 204579 (D.D.C. Nov. 10, 2022)

District court granted defendant's motion to dismiss. Plaintiff, music producer and composer, sued defendant, recording group, for direct, contributory, and vicarious copyright infringement for alleged unauthorized use of composition. On direct infringement claim, court found plaintiff lumped defendants together and provided no factual basis to distinguish conduct. Plaintiff mentioned defendants individually only in "Parties" section of complaint but made no reference to any individual alleged conduct. Court found plaintiff successfully pleaded originality and authorship requirement for direct infringement, but plaintiff did not register copyright before bringing lawsuit, and court accordingly held plaintiff's direct infringement claim failed against all defendants. Regarding contributory and vicarious infringement, court found analysis for both claims overlapped because liability cannot attach in either case absent underlying act of infringement by third party. Court found plaintiff did not identify which third party or parties provided basis for claims. Plaintiff provided no specific factual allegations as to who persons were and how they participated in infringement.

*Wallster, Inc. v. Redbubble, Inc.*, No. 22-2958, 2022 U.S. Dist. LEXIS 198181 (C.D. Cal. Oct. 21, 2022)

Defendant Redbubble owned and operated e-commerce system where users could create online storefronts. Plaintiff, which sold high quality wallpaper, brought suit, alleging infringement of artist Turner's Palm Design Wallpaper. Defendant moved to dismiss contributory infringement claim, arguing that plaintiff failed to sufficiently plead knowledge element. Plaintiff alleged "recklessness or willful blindness" by defendant. Court rejected

plaintiff's argument that recklessness is enough to meet knowledge requirement for contributory infringement, noting that Ninth Circuit court has approved of only "actual knowledge of specific acts of infringement," "willful blindness of specific facts," or, potentially, "know or have reason to know" standards, recklessness. Court held further that plaintiff failed to sufficiently allege willful blindness, as plaintiff's allegations regarding willful blindness related to copyright infringement on defendant's website in general and not to specific instances of infringement at issue in this case. Because plaintiff failed to sufficiently allege knowledge element of contributory claim, court granted motion to dismiss.

*Bodyguard Prods. v. RCN Telecom Servs., LLC*, No. 21-15310, 2022 U.S. Dist. LEXIS 185965 (D.N.J. Oct. 11, 2022)

District court denied motion to dismiss claims of contributory and vicarious infringement, finding plaintiff had properly pleaded such claims. Owners of motion pictures sued internet service provider defendants (ISPs), alleging that ISPs were liable for their subscribers' use of peer-to-peer file-sharing protocol BitTorrent to download plaintiffs' films, in violation of Act and DMCA. After finding that plaintiffs plausibly pleaded direct infringement by ISPs' subscribers, district court turned to question of secondary liability. Regarding contributory infringement, district court found that plaintiffs sufficiently pleaded that ISPs had knowledge of infringement via notices from plaintiffs' investigator, and that ISPs continued to provide services to subscribers despite knowledge of subscribers' infringing activities. With respect to vicarious infringement, district court held plaintiffs sufficiently pleaded that ISPs had right and ability to supervise or control infringing activity. Plaintiffs alleged ISPs control content accessible to subscribers and maintain right to remove or block access to suspected illegal files. Moreover, plaintiffs properly pleaded that ISPs had direct financial interest in purported infringement, because subscribers would likely be drawn to ISPs' services to access infringing works without having services terminated by ISPs.

*UMG Recordings, Inc. v. Vital Pharm., Inc.*, No. 21-60914, 2022 U.S. Dist. LEXIS 122046 (S.D. Fla. July 11, 2022)

Court granted in part and denied in part plaintiffs' motion for partial summary judgment. Plaintiffs were record companies and music publishers and defendants were energy drink and supplement company and its CEO. Defendant advertised its products only through social media and "experiential events for marketing." Specifically, defendant paid influencers to market its products online, and owned those videos through its agreements with influencers. Influencer videos on TikTok contained copyrighted music, including plaintiff's works. Plaintiffs sued bringing claims for direct and contributory and/or vicarious infringement, and plaintiffs moved for summary judgment. On direct infringement claim, court found plaintiffs were entitled to summary judgment on liability, finding that defendants' defense that they believed TikTok provided them with license to use plaintiffs' works was relevant, if at all, to damages and not liability. On contributory infringement claim, plaintiffs argued that defendants induced and encouraged influencers to create infringing videos: Defendants believed videos were advertisements for defendants; defendants' social media team audited influencer videos, including video music, before posting; defendants influencers were

required to submit videos to auditing team with music links as condition of payment, and auditing team ensured videos adhered to company's social media guidelines; and social media guidelines were only policies for assessment of influencer videos. In opposition, defendants argued that defendants did not play role in production of influencer videos and did not play role in selecting music in videos. Because court found plaintiff did not "meaningfully respond to this argument," court denied plaintiffs' motion for summary judgment on contributory infringement claims. On vicarious infringement claim, plaintiffs argued that defendants failed to exercise control over influencers' infringement because defendants knew or should have known about infringement since they had right to review each video prior to posting and additionally had right to refuse payment to any influencers posting infringing content, but did not do so. Although defendants argued that they had no right to stop influencers' infringement, court disagreed and found plaintiffs met summary judgment burden on control element of vicarious infringement test. On financial benefit prong, however, court found that plaintiffs failed to sufficiently support assertion that defendants profited from infringement. Therefore, court denied summary judgment on vicarious infringement claim.

#### **D. Miscellaneous**

*Martin v. New Am. Cinema Group., Inc.*, No. 22-05982, 2023 U.S. Dist. LEXIS 26014 (S.D.N.Y. Feb. 15, 2023)

Defendant NACG was non-profit corporation that acted as custodian to certain films and artistic works for benefit of its members. Defendant's collection included film created by plaintiff, for which plaintiff alleged that she possessed copyright registration. In 2019, defendant created digital version of plaintiff's film and rented it to Carnegie Museum for exhibition. Upon discovering that her film was included in exhibit, plaintiff filed suit – styled as class action – alleging that defendant (a) reproduced film without her authorization or knowledge, and (b) created "derivative work" when it produced digital version of plaintiff's film. Defendants moved to dismiss complaint on two grounds: (a) that plaintiff was not alleging copyright claim, but instead breach of contract claim, and therefore, court lacked subject matter jurisdiction, and (b) plaintiff failed to state claim on any of causes of action alleged in complaint, including infringement. Defendants argued that plaintiff failed to state claim for copyright infringement because, under agreement, defendant was allowed to distribute film, and creation of digital version was not creation of derivative work. Plaintiff argued that she sufficiently pleaded infringement based on use beyond scope of license because, in making digital version of film, creative decision had to be made. Court agreed with plaintiff. Given that parties did not dispute that some type of license existed between them, and plaintiff had plausibly alleged that whatever agreement was in place did not permit reproduction of plaintiff's film in digital form, court denied defendant's motion.

*Bus. Casual Holdings, LLC v. YouTube, LLC*, No. 21-3610, 2022 U.S. Dist. LEXIS 212212 (S.D.N.Y. Nov. 22, 2022)

Court rejected copyright infringement claims against YouTube, finding that when YouTube timely removes infringing videos, it is not obligated to also terminate infringer's account. Plaintiff uploaded videos for which it owned copyright registrations to YouTube. YouTube purported to have three-strike DMCA policy under which it bans users who have three videos removed under DMCA. Plaintiff alleged that YouTube failed to apply its three-strike policy against alleged third-party infringer after plaintiff filed DMCA notices, and asserted that YouTube was therefore directly, contributorily, and vicariously liable for infringement. Court found that YouTube did not engage in volitional conduct that caused infringement when it timely blocked all three videos complained about by plaintiff. Failure to terminate third party's entire channel afterward was not act that had anything to do with three videos being uploaded in first place. Neither was YouTube liable for contributory infringement, as there was no allegation that YouTube knew of alleged infringement before DMCA notices were filed, and YouTube's removal of videos was not action in concert with or contributing to alleged infringement. Neither was YouTube liable for vicarious infringement, as it did not decline to exercise its right to stop infringement. Court dismissed motion to amend complaint, as plaintiff alleged no new volitional conduct by YouTube, and made no new allegations of YouTube's knowledge of infringement prior to DMCA notices or YouTube's failure to stop infringement. Plaintiff was attempting to assert independent cause of action under DMCA's repeat infringer provision, but such claim does not exist. DMCA is safe harbor, and YouTube met requirements to be within safe harbor.

*Wakefield v. Olen*, No. 21-1585, 2023 U.S. Dist. LEXIS 38376 (C.D. Cal. Jan. 4, 2023)

District court held that plaintiff entitled to pursue statutory damages. In 1997, plaintiff artist created copyright large-scale granite sculpture called *Untitled*. In 2012, plaintiff registered copyright in his sculpture and sued billionaire real estate developer Igor Olenicoff and his estate company for copyright infringement after plaintiff discovered seven infringing copies of *Untitled* and other derivative sculptures on defendants' properties. After jury trial and Ninth Circuit appeal, plaintiff was awarded \$450,000 in damages and defendants were required to destroy infringing copies. In 2014, after trial in first lawsuit, plaintiff discovered eighth infringing sculpture copy that defendants had not disclosed and, in 2017, plaintiff brought second copyright infringement suit against defendants, which ultimately settled. In 2021, plaintiff discovered two additional copies of *Untitled* that defendants never disclosed. Defendants moved for summary judgment holding that plaintiff cannot recover statutory damages. Court held that, although some of defendants' infringing sculptures existed as early as 2008 and plaintiff did not register his copyright until 2012, defendants' activity did not constitute one continuous, ongoing series of infringing acts. In particular, there was legally significant difference between defendants' pre-registration infringement and their infringement after first lawsuit that culminated in award to plaintiff.



*Kremer v. Reddit, Inc.*, No. 21-38, 2022 U.S. Dist. LEXIS 153988 (M.D. Tenn. Aug. 26, 2022)

District court dismissed infringement claim against Reddit based on image of plaintiff's business posted on Reddit by user. Plaintiff owned business and obtained copyright registration for logo. User of reddit.com posted photograph of plaintiff's business, which had sign reading "Do Not Photograph this property. NO CONSENT." Plaintiff filed *pro se* complaint against Reddit for felony copyright infringement, seeking \$100 million in damages. Despite lower pleading standard for *pro se* litigants, court found that criminal copyright statute does not provide private right of action. Plaintiff also did not sufficiently allege that any direct actions causing infringement were taken by Reddit, causing court to dismiss any civil copyright infringement claim. Plaintiff did not attempt to plead secondary infringement or DMCA claim.

*Artisan Est. Homes, LLC v. Hensley Custom Bldg. Grp., LLC*, No. 19-566, 2022 U.S. Dist. LEXIS 132185 (S.D. Ohio July 25, 2022)

Homeowners had used defendants to design and construct their home in 2009. In 2014, they decided to construct new home, and approached plaintiff to design and built it. Using homeowner's current home and photo of turrets as inspiration, plaintiff made design that it called "Villa de Wendy." However, review board of neighborhood rejected design, so homeowners approached their former designers, defendants, to design new home instead. Board approved defendant's new design, which they built and completed for homeowners in 2018. In 2019, plaintiff registered copyright for "Villa de Wendy" design and filed suit against defendants alleging that defendants had infringed "Villa de Wendy" design. Defendants counterclaimed, arguing that, instead, plaintiffs had infringed on defendant's design of homeowner's original home. Plaintiff was granted permission to add officers of defendant companies as individual defendants. Individual defendants filed motion to dismiss, arguing that plaintiff did not allege any specific acts against officers of defendant companies. District court explained that while Sixth Circuit had yet to address issue, most other circuit courts and most authority in Sixth Circuit used two-pronged test to determine whether corporate officers were jointly and severally liable with corporation for infringement. Court found that here plaintiffs had plausibly alleged that individual defendant officers (1) had right to supervise design and/or construction of homes based on defendant company's design and (2) had direct financial interest in designing or building design. Court accordingly rejected individual defendant officers' motion to dismiss.

## VI. DEFENSES/EXEMPTIONS

### A. Fair Use

*Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023)

Supreme Court affirmed Second Circuit's determination that use of artistic work incorporating copyrighted photograph in magazine was not fair. In 1981, appellee, renowned photographer Lynn Goldsmith, photographed Prince and, in 1984, Vanity Fair licensed one of Goldsmith's Prince photographs to be used (on credited, one-time-only basis) as artist reference for Andy Warhol to create image that would be used to illustrate article about Prince. In addition to purple-hued illustration used in 1984 article, Warhol created 15 additional works based on Goldsmith's Prince photo, collectively known as Prince Series. Between 1981 and 2016, Goldsmith's photos of Prince appeared in numerous publications, including on magazine covers. In 2016, after Prince's death, Vanity Fair's parent company, Condé Nast, obtained license from appellant Andy Warhol Foundation (which asserted copyrights in Prince Series) to use different, orange-colored image from Prince Series ("Orange Prince") as cover of special edition magazine tribute to Prince. Goldsmith learned of Prince Series when she saw orange Prince image on magazine cover, at which time she notified AWF that it had infringed her copyright in underlying Prince photograph. AWF sued for declaratory judgment of non-infringement or, alternatively, fair use and Goldsmith counterclaimed for infringement. District court granted summary judgment for AWF on fair use, in part on ground that each Prince Series work was transformative and immediately recognizable as "Warhol" rather than as Goldsmith's photograph. Second Circuit reversed, rejecting idea that any secondary work that adds new aesthetic or expression to source work is necessarily transformative, and noting that immediate recognizability of secondary work as emanating from famous artist would create impermissible celebrity-plagiarist privilege. AWF appealed to Supreme Court solely on first fair use factor, arguing that Orange Prince was transformative use of Goldsmith's photograph and therefore Second Circuit erred in holding that "purpose and character" of AWF's use weighed against fair use finding. Supreme Court held that analysis of first fair use factor focuses on whether allegedly infringing use has further purpose or different character, which is matter of degree, and degree of difference must be weighed against other considerations, like commercialism. Thus, new expression is relevant to but not, without more, dispositive of first fair use factor. Because Copyright Act protects author's right to derivative transformations of her work (subject to fair use), degree of transformation required to make "transformative" use of original must go beyond that required to qualify as derivative work. Highlighting Copyright Act's balancing act between rewarding creativity and protecting availability, Court noted that first factor considers reasons for, and nature of, copier's use of original work. Fact that use is commercial is additional element of first factor analysis, as is whether use has distinct purpose justified by furtherance of copyright's goals without disincentivizing creation (e.g., parody, commentary). Latter independent justification is particularly relevant to fair use assessment where original and copying works share same or highly similar purpose, or where wide dissemination of copied work risks

substituting for original, and copying use is commercial. Same copying may therefore be fair for one purpose but not another. Instant decision looked only at AWF's licensing of Orange Prince to Condé Nast and expressed no opinion as to any of original Prince Series works. Here, purpose of AWF's use was substantially identical to that of Goldsmith's original photograph in that both works used in magazines to illustrate stories about Prince. Moreover, AWF's use was commercial because it involved paid license, and transformativeness of use did not outweigh its commercial character. Finally, AWF offered no compelling justification for copying Goldsmith's photograph independent of conveying new meaning. Court therefore affirmed Second Circuit's decision.

*McGucken v. Pub. Ocean Ltd.*, 42 F.4th 1149 (9th Cir. 2022)

Ninth Circuit reversed district court's grant of summary judgment for defendant and remanded for further proceedings. Plaintiff, author of photographs of ephemeral lake in Death Valley, licensed works to websites for use in articles. Defendant publisher posted article about ephemeral lake and, without authorization, used 12 of plaintiff's works. Plaintiff brought suit and moved for summary judgment on defendant's fair use defense. District court granted summary judgment *sua sponte* for defendant. Plaintiff appealed. On first fair use factor, court found that plaintiff and defendant used work in same way—to show ephemeral lake. Court also found that defendant's embedding of works into text of article was not transformative, rejecting defendant's argument that placing works in "wider [factual] context" was transformative use. Fact that defendant was reporting news did not make defendant's use of work fair use *per se*. On second fair use factor, court noted that works were creative, and fact plaintiff had published on Instagram and online did not weigh in favor of fair use. On third factor, court found defendants took entirety of plaintiff's work with minimal cropping, even if defendant's article also included 28 photos from other sources. On fourth fair use factor, court held that harm to plaintiff would be significant if use was widespread, particularly because defendant used works in same way as did plaintiff's licensees. Finding that all factors weighed against fair use, court reversed grant of summary judgment and directed trial court to enter partial summary judgment for plaintiff on fair use.

*De Fontbrune v. Wofsy*, 39 F.4th 1214 (9th Cir. 2022)

Ninth Circuit reversed grant of summary judgment and remanded to district court for further proceedings. Photographer Christian Zervos captured 16,000 photographs of Pablo Picasso's work to be included in catalogue raisonné. Plaintiff subsequently acquired IP rights in brand that published catalogue raisonné. In 1991, organization associated with one of defendants received permission from Picasso's estate to publish book about Picasso's works. Defendant thereafter produced series of books on Picasso, entitled "The Picasso Project," which provided chronological catalogue of Picasso's works. The Picasso Project contained reproductions of works from Zervos's catalogue raisonné. In 1996, police in France seized two volumes of The Picasso Project that were for sale at Parisian book fair, and plaintiff thereafter sued defendant for infringement in France. French Court of Appeal found defendant liable for infringement and awarded plaintiff 10,000 francs in damages for each infringement. Plaintiff then brought suit in California state court seeking recognition of

French judgment. After removal, district court granted motion to dismiss and Ninth Circuit reversed. On remand, district court granted summary judgment for defendant, declining to recognize French judgment because defendant would have been successful in asserting fair use defense in underlying action and, because French law did not permit fair use defense, district court found “judgment repugnant to U.S. public policy protecting expression.” Plaintiff appealed, and Ninth Circuit found that under U.S. fair use standard, defendant’s use did not qualify as fair use; court therefore did not opine on whether judgment that imposed liability on defendant’s work, which would have qualified as fair use, was contrary to public policy. On first fair use factor, court found that defendant’s use was infringing and fact that end users would use book for academic pursuits did not change this factor. Court also was not persuaded by defendant’s argument that he used works differently than plaintiff did, because that did not amount to transformation, and purpose of both works overlapped. On second factor, court found creative nature of works prevented it from finding that factor weighed in favor of fair use. On third factor, while district court noted that defendant took only 1,492 of 16,000 photos in Zervos’s book, Ninth Circuit noted that what defendant reproduced included whole work and therefore found factor to weigh against fair use, particularly due to its finding that defendant’s use was not transformative. On fourth fair use factor, court noted that record was bereft of evidence that appropriating works would not significantly affect plaintiff’s market, and applied presumption of market harm due to fact work was commercial and did not transform original. Court granted plaintiff’s motion for summary judgment.

*Brody v. Fox Broad. Co., LLC*, No. 22-6249, 2023 U.S. Dist. LEXIS 58362 (S.D.N.Y. Apr. 3, 2023)

District court granted defendant’s motion to dismiss on fair use grounds. During January 6, 2021 insurrection, plaintiff photojournalist filmed motion picture that included imagery of Kelly Meggs and other insurrectionists on Capitol stairs. When FBI filed criminal complaint, it included screenshot from motion picture with markings. On one-year anniversary of insurrection, Fox news channel in Orlando, Florida, conducted remote interview with Meggs in his jail cell. Entire image from FBI complaint was shown during broadcast news segments. Plaintiff sued numerous Fox defendants alleging copyright infringement claims based on use of FBI image. Defendants moved to dismiss on fair use grounds. Court held that, though fair use is affirmative defense not normally appropriate ground for dismissing claim, it can be raised in pre-answer motion if defense appears on face of complaint. Here, Fox’s use of image from high-profile criminal complaint was clearly transformative because Fox provided news coverage of Meggs’ criminal complaint (of which image was essential part) and placed story in context of reporter’s interview with Meggs. Nature of motion picture was factual and it had been previously published. Only single screenshot from motion picture was used, as sourced and edited by FBI. Finally, Fox’s segments did not affect licensing market for motion picture. Thus, with-prejudice dismissal of infringement claim was warranted.

*Hachette Brook Grp., Inc. v. Internet Archive*, No. 20-4160, 2023 U.S. Dist. LEXIS 50749 (S.D.N.Y. Mar. 24, 2023)

District court granted plaintiff book publishers summary judgment on infringement claims, finding no fair use when Internet Archive (IA) scanned print copies of plaintiffs' books and lent those digital copies to users without plaintiffs' permission. IA, non-profit better known for operating "Wayback Machine" archive of public web pages, scanned print books and distributed digital copies to users while retaining print copies in storage, without permission of publisher. IA typically would only loan one digital copy at time for each physical copy it possessed, though between March and June 2020, when COVID-19 pandemic began, IA lifted its one-to-one owned-to-loaned ratio and allowed up to 10,000 patrons at time to "borrow" each e-book in its possession. Plaintiff book publishers filed complaint alleging copyright infringement of 127 works, not limited to time period during early 2020, and IA asserted defense of fair use. First fair use factor weighed against IA on several grounds. Court found that use was not transformative, insofar as IA simply scanned books and gave them away in their entirety without alteration, competing directly with nearly identical e-books sold by plaintiffs. IA's use was also commercial due to its monetization of each page on its library site with link where users could purchase books from partner, with portion of proceeds going to IA. Second factor weighed in favor of plaintiffs, with court rejecting IA's argument that most of books being more than five years old made difference. Third factor plainly weighed against IA due to wholesale copying of books. Fourth factor also strongly favored plaintiffs in that IA's use directly competed with legal e-book libraries, which pay licensing fee to publishers when e-book is checked out. Evaluating factors, court found that any benefit to public due to increased access to works did not outweigh market harm to plaintiffs. Neither did first sale doctrine protect IA, as that doctrine does not permit owner of copy of copyrighted work to reproduce that work and distribute new copy. For this reason, IA's lending was not fair use even if it strictly enforced its one-to-one owned-to-loaned ratio – not to mention that IA did not strictly enforce that ratio. Court therefore granted summary judgment for plaintiffs on their copyright infringement claims. Court also expressly noted that its analysis only concerned fair use and did not affect library provisions of § 108 of Act, which allow libraries limited authorization to reproduce and distribute certain copyrighted works without permission for preservation, replacement, and research.

*Whiddon v. BuzzFeed, Inc.*, No. 22-4696, 2022 U.S. Dist. LEXIS 197694 (S.D.N.Y. Oct. 31, 2022)

District court granted motion to dismiss infringement claim on fair use defense. Plaintiff photographer took series of photos of "lifestyle blogger" Tiffany Mitchell before and after Mitchell suffered motorcycle accident. Mitchell posted photos to her Instagram account, and post generated "controversy surrounding her social media post about the accident," with public commentary and speculation surrounding whether accident photos were staged or inappropriate. Defendant BuzzFeed posted article about controversy, and article featured screenshots of Instagram post including reproductions of photographs in their entirety. After registering copyright in photos, photographer sued for infringement and defendant moved to dismiss based on fair use. On first factor, district court found defendant's use of works

transformative because works were used “help to explain a controversy involving Ms. Mitchell’s social media post, and the [p]hotographs contained therein,” and were not used “simply to present the content of” plaintiff’s works. District court reasoned that article’s reporting on controversy could not have simply reproduced negative comments on Instagram page, as public controversy was specifically grounded in photos and “no other images could serve the same purposes as the screenshots.” On second factor, court found works creative but assigned “this secondary statutory factor much less heft than the first.” On third factor, court found that even though defendant reproduced works in their entirety, defendant “could not have displayed anything less than entirety of the [p]hotographs” to provide full context of subject of controversy, thus favoring defendant. On fourth factor, district court found that defendant’s use of photographs did not impact plaintiff’s licensing opportunities. Motion to dismiss based on fair use granted.

*Hannley v. Mann*, No. 21-2043, 2023 U.S. Dist. LEXIS 40022 (C.D. Cal. Mar. 8, 2023)

Court granted defendant’s motion for summary judgment. Claim was based on three photographs taken by plaintiff of himself. Defendants used photographs on their Twitter page and in YouTube video. Court found use of photographs to be fair use. Defendant’s Twitter account was parody/criticism of plaintiff. Court found that use of photographs was non-commercial, transformative because it was satirical/critical, not merely informational as original use was, and most importantly, plaintiff failed to show market for such photographs. While defendant argued that fair use should not apply because use was derogatory and salacious in nature, court disagreed; fair use inquiry does not ask whether criticism or parody is just or accurate, or mean-spirited, but simply whether use is of kind that copyright is designed to protect.

*Krafton, Inc. v. Apple, Inc.*, No. 22-209, 2023 U.S. Dist. LEXIS 53494 (C.D. Cal. Feb. 24, 2023)

Court denied defendant YouTube’s motion to dismiss infringement action. Plaintiffs Krafton, Inc. and PUBG Santa Monica owned videogame called *PlayerUnknown’s Battlegrounds* (“*Battlegrounds*”), which was “non-linear, network-connected, dynamic, and interactive game with infinite outcomes.” Plaintiffs alleged that YouTube hosted Chinese film titled *Biubiubiu*, allegedly infringing live-action dramatization of *Battlegrounds*. Court determined that, given nature of *Battlegrounds* game, where there was virtually no way of having typical gameplay experience, it was not capable of examining and comparing copyrighted work and accused material in real and meaningful sense. Court also found that, because copyrighted work and accused work were different forms of media, it was not comfortable concluding that “plot, themes, dialogue, mood, setting, pace, characters, and sequence of events” were appropriate substantial similarity factors to consider for type of video games that *Battlegrounds* fell into. Court also dismissed YouTube’s alternative arguments for dismissal – that *Biubiubiu* constituted “fair use” of *Battlegrounds*. Court found that first, third, and fourth factors needed to be influenced and informed by development of evidence via discovery. Court accordingly held that substantial similarity

and fair use inquiries could not be conducted on basis of pleadings alone, and denied defendant's motion to dismiss.

*Krikor v. Sports Mall, LLC*, No. 22-5600, 2023 U.S. Dist. LEXIS 13063 (C.D. Cal. Jan. 24, 2023)

District court granted plaintiff partial summary judgment on infringement claim, but denied judgment regarding defendant's willfulness and its unclean hands defense. Defendant operated online sports memorabilia store. Plaintiffs, eBay store owner and photographer for store owner, sued for infringement after discovering that defendant had reproduced more than six images of sports memorabilia from plaintiff's eBay store; plaintiffs claimed copyright in subject works. Photographer plaintiff moved for summary judgment regarding two images of sports jerseys for which photographer owned copyright registration. After finding that plaintiff's works were original, district court evaluated whether fair use defense applied. First, defendant's use of photos was not transformative, as it simply reproduced copies of plaintiff's subject works on defendant's online store; first factor favored plaintiff. Second, subject works were not artistic expressions, but rather used for advertising, and plaintiff photographer allowed plaintiff store owner to publish works; second factor did not favor either party. Third, defendant copied entirety of subject works, weighing third factor against defendant. Fourth, court found that copying of photos of sports jerseys made it less likely that potential buyers would want to purchase jerseys directly from plaintiff's eBay store; fourth factor favored plaintiff. Therefore, district court held that defendant failed to demonstrate fair use.

*Backgrid USA, Inc. v. Haute Living Inc.*, No. 21-06543, 2023 U.S. Dist. LEXIS 38113 (C.D. Cal. Jan. 6, 2023)

District court granted summary judgment in favor of plaintiff on elements of copyright infringement claim and all affirmative defenses raised by defendant. Plaintiff, owner and operator of celebrity photograph agency, sued defendant, owner and operator of website and social media accounts targeted toward high-end goods and services, for copyright infringement for alleged use of plaintiff's copyrighted images. District court held plaintiff established *prima facie* case that defendant directly infringed plaintiff's copyrighted works. Court found plaintiff sufficiently demonstrated it owned valid copyrights in photographs at issue by submitting copyright registrations. Court found no material dispute that defendant copied plaintiff's work because Instagram posts strikingly similar, if not essentially identical, to registered works. Defendant acknowledged it selected photographs at issue to report on Instagram account, so court found plaintiff sufficiently demonstrated volitional conduct. Defendant raised affirmative defense of fair use. Court found purpose and character of use neutral and did not support fair use claim because adding descriptive captions otherwise unadorned photographs not transformative, but posting photographs on social media accounts constituted noncommercial purpose. It was undisputed that plaintiff's photographs were published works, and parties agreed defendant sourced from Instagram account of third parties. Court found that while photographs concerned still images of factual matter – celebrity sightings – and were previously published, this did not weigh in favor of fair use

because photographs incorporated identifiable creative elements. Court found defendant used entirety of plaintiff's photographs and did not show copying of entirety of photograph was necessary. Court found market effect factor neutral because neither party set forth evidence probative of effect of defendant's use on market for photographs at issue. Totality of fair use factors favored plaintiff, so court granted summary judgment for plaintiff on fair use defense.

*Concannon v. Lego Sys. Inc.*, No. 21-1678, 2023 U.S. Dist. LEXIS 43329 (D. Conn. Mar. 15, 2023)

District court denied defendant's motion to dismiss copyright infringement claim on implied license grounds. Plaintiff artist designed custom, hand-painted leather jacket worn by Antoni Porowski from *Queer Eye* Netflix series. Defendants subsequently produced *Queer Eye* LEGO set that included character wearing similar leather jacket and plaintiff sued for copyright infringement. Defendants moved to dismiss on ground that jacket constituted fair use. As to first factor, defendants argued that jacket was inconsequential portion of LEGO set and was necessary to accurately depict Porowski (similar to depiction of basketball players' tattoos in video game, which was held to be transformative use). Court held that LEGO jacket's design elements were easily identifiable and that, unlike tattoos, LEGO jacket included elements that differed from plaintiff's jacket. Moreover, defendants attracted consumers via, *inter alia*, advertisements that prominently featured LEGO jacket, suggesting that defendants' use may not have been merely incidental to set's commercial value. As to second factor, plaintiff's jacket featured hand-painted designs and had nature of artistic creation so further factual development needed. As to third factor, amount and substantiality of plaintiff's jacket used in LEGO jacket was not evident from complaint's face. Finally, although LEGO jacket not substitute for plaintiff's jacket, plaintiff adequately alleged harm to his potential licensing market. Court held that fair use factors would be properly weighed on summary judgment after factual record development.

*Hayden v. 2K Games, Inc.*, No. 17-2635, 2022 U.S. Dist. LEXIS 170098 (N.D. Ohio Sept. 20, 2022)

District court denied defendants' motion for summary judgment. Plaintiff, tattoo artist, inked notable NBA players LeBron James, Danny Green, and Tristan Thompson. Plaintiff obtained copyright registration for six tattoos ("Registered Tattoos") which appeared on simulated versions of these athletes through defendants' popular basketball video game *NBA 2K*. Plaintiff sued for infringement. Defendants moved for summary judgment on fair use grounds. On first factor, court found issue of fact as to whether defendants made transformative use of plaintiff's work and how commercial nature of video game should affect outcome of first factor. On second factor, court found nature of works weighed against fair use, but fact that works were published weighed in favor of fair use. On third factor, court noted that tattoos were small part of defendants' work, but were used in their entireties, and held how observable and important tattoos were to game were questions for jury. On fourth factor, court found defendants' use of entirety of six Registered Tattoos weighed in favor of plaintiff; but since jury could find that likelihood is less than someone



might choose to acquire tattoos from defendants' video games rather than obtain tattoos from plaintiff, that evidentiary weight was reduced; burden of proving potential market remained with plaintiff, and genuine factual disputes were within jury's purview. Court denied motion for summary judgment.

*Creative Photographers, Inc. v. Julie Torres Art, LLC*, No. 22-655, 2023 U.S. Dist. LEXIS 41343 (N.D. Ga. Mar. 13, 2023)

District court dismissed complaint for lack of standing. Plaintiff was commercial photography agency that represented select photographers, including Ruvén Afanador. Afanador took copyrighted photograph of Supreme Court Justice Ruth Bader Ginsburg in 2009. Defendants Julie Torres and her company produced derivative works that used Afanador photograph of Justice Ginsburg in print and mixed-media form. In 2015, Afanador entered into agreement with plaintiff, pursuant to which Afanador retained plaintiff as exclusive agent to sell, syndicate, license, market or otherwise distribute photos submitted to plaintiff by Afanador. Plaintiff subsequently discovered defendants' allegedly unauthorized use of Afanador photograph and sued for infringement and removal of copyright management information. Defendants moved to dismiss. District court assessed whether plaintiff possessed statutory standing. Agreement between Afanador and plaintiff made clear that Afanador reserved ownership of copyright, so district court evaluated whether agreement made plaintiff *exclusive* licensee of Afanador's rights under copyright. Plaintiff argued that it was granted sole right to distribute, license, and sell Afanador work, and therefore was exclusive licensee, while defendants argued that agreement was simply contract to provide Afanador with representation but was not copyright license. Noting plain language of agreement that made plaintiff Afanador's exclusive *agent* but did not expressly convey exclusive license to any § 106 rights, district court concluded that agreement only rendered plaintiff exclusive agent, not exclusive licensee. Even if agreement had made plaintiff exclusive licensee, district court noted, there was no language in agreement that conferred on plaintiff exclusive right to authorize preparation of derivative works. District court therefore concluded that plaintiff lacked standing to sue for infringement, and dismissed complaint without prejudice.

*Robinson v. Visio, LLC*, No. 22-928, 2022 U.S. Dist. LEXIS 216282 (E.D. Mo. Dec. 1, 2022)

District court denied defendants' motion to dismiss based on fair use. Plaintiff, photographer, sued defendants for infringement for publishing photograph plaintiff took on website without permission. Defendants argued fair use doctrine applied because image was reduced in size, not shown as creative work, and was not substitute for original. Defendants claimed image was used with public service announcement. Court disagreed with defendants because court could not decide effect of use on potential market for or value of copyrighted work based on complaint's allegations or exhibits. Defendants did not provide allegation from complaint that would support argument that use of image did not cause economic harm. Court held fair use could not be determined on face of complaint.

*Emmerich Newspapers, Inc. v. Particle Media, Inc.* No. 21-32, 2022 U.S. Dist. LEXIS 141283 (S.D. Miss. Aug. 9, 2022)

District court granted in part and denied in part parties' motion for partial summary judgment on fair use grounds and for injunctive relief. Plaintiff, newspaper distributor in Mississippi, Louisiana, and Arkansas, sued defendant, developer of NewsBreak, application that curates users' news feeds, for copyright infringement stemming from defendant's unauthorized use of plaintiff's nine news articles. Users viewed plaintiff's works in two manners: full reproduction of articles on Android devices or using Snippet Display, which contained republications of registered works' thumbnail image, headlines, and portion of article. Court separately analyzed fair use of full text articles and Snippet Display. As to full text articles, court held all factors weighed against fair use, and granted plaintiff's motion. On first factor, court found defendant's complete republication of plaintiff's work in full-text format with no new purpose was not transformative. On second factor, while recognizing articles were factual, district court held defendant indiscriminately included entire text from articles including all of plaintiff's expressive components, weighing against fair use. On third factor, court highlighted that defendant took quantitatively and qualitatively significant amount of plaintiff's work. On fourth factor, court held that wholesale copying could affect plaintiff's market, weighing against fair use. As to defendant's use of Snippet Displays, district court found questions of material fact prevented it from ruling on summary judgment motion as to fair use.

*Bell v. Alexander*, No. 21-24301, 2022 U.S. Dist. LEXIS 138300 (S.D. Fla. Aug. 3, 2022)

District court denied motion to dismiss on fair use grounds. Plaintiff, author and copyright holder of book *Winning Isn't Normal* and "WIN Passage," alleged that Miami Dolphins defensive back coach infringed his work when he posted version of WIN Passage on his Twitter page, which had, at time, at least 18,000 followers. Defendant moved to dismiss on fair use grounds. Citing multiple instances of Eleventh Circuit's unfavorable view toward resolving fair use on motion to dismiss, district court held that unless plaintiff adequately sets forth *prima facie* case involving fair use in complaint, determination was inappropriate at motion to dismiss stage. Nevertheless, district court considered fair use factors. Court found first factor was inconclusive because it was unclear whether defendant wanted to financially profit from Twitter account; second factor suggested that work was minimally creative and widely available, but court was uncertain as to how widely published work was; third factor weighed against finding of fair use at current procedural posture because, although work was one of 72 pages of book, plaintiff argued that it was "heart" of work; and fourth factor was inconclusive because, while plaintiff did not specifically plead amount of damages, he did allege that retweet caused damage. Court denied defendant's motion to dismiss.

*Pickersgill v. Egotist, LLC*, No. 22-1037, 2022 U.S. Dist. LEXIS 166051 (D. Colo. Sept. 14, 2022)

Plaintiff photographer alleged that defendant *The Denver Egotist* infringed his work when it posted six of plaintiff's images on its website. Defendant moved to dismiss, arguing that images were used with text that described photographic work, and that it therefore had made fair use of plaintiff's photographs. In report and recommendation, magistrate found on first fair use factor that defendant's use was not transformative because post largely consisted of plaintiff's images and text was copied from another online source; text, in any event, was only two sentences that did not comment, criticize, or report on images. Court also noted that defendant used photos without authorization to generate income for itself. On second factor, court found nature of photographs weighed against finding fair use. On third factor, court found that posting six full size and high-resolution images constituted qualitatively substantial portion of plaintiff's work. On fourth factor, court found that if defendant's practice were widespread and plaintiff's works were published online, there would be little reason for people to purchase plaintiff's images or attend his gallery shows, weighing against fair use. Magistrate recommended denying defendant's motion to dismiss.

## **B. Statute of Limitations**

*Starz Ent., LLC v. MGM Domestic TV Dist., LLC*, 39 F.4th 1236 (9th Cir. 2022)

Ninth Circuit held district court correctly applied discovery rule to conclude plaintiff timely filed copyright infringement claims and was not barred from seeking damages. Plaintiff, subscription video programming service, entered into licensing agreement with defendant studio, for exclusive right to exhibit specific defendant-owned content on services for defined period. Agreement provided contractual warranties that defendant would not exhibit or license to third parties licensed content. Plaintiff discovered defendant violated exclusivity provisions and sued for infringement. Defendant moved for dismissal arguing infringement claims barred by statute of limitations. District court denied motion to dismiss and concluded Act has three year damages bar except when plaintiff reasonably not aware of infringement at time it occurred. Infringement claim may accrue when owner discovers or reasonably should have discovered infringement. Circuit court found Supreme Court's *Petrella* decision solely concerned with laches and could not have been intended to address situation where copyright holder does not know about infringement to which discovery rule, not incident of injury rule, applies. Court held discovery rule for accrual allows copyright holders to recover damages for all infringing acts that occurred before plaintiff knew or reasonably should have known of infringing incidents, and three-year limitations period runs from date claim accrued. Court found plaintiff's claim timely because copyright infringement claim brought less than year from discovery of infringement. Court disagreed with defendant's argument that three-year damages bar was determined solely by date complaint filed even in cases where discovery rule applies. Court held claim under Act does not arise until accrual because had Congress intended to limit recoverable damages arising only from acts of infringement during three-year period before suit was commenced, it would

have said so, and intent is promotion of timely prosecution and discouragement of delay, so makes little sense to bar recovery where copyright holder did not delay but acted in accordance with Act by filing complaint within three years of discovery. District court's denial of defendant's motion to dismiss affirmed.

*Evox Productions, LLC v. Chrome Data Sols., LP*, No. 22-35113, 2023 U.S. App. LEXIS 3293 (9th Cir. Feb. 10, 2023)

Ninth Circuit affirmed grant of summary judgment to defendant. Plaintiff created images of cars and, between 2003 and 2008, licensed them to, *inter alia*, defendant Chrome, which then sublicensed them. Agreement provided for two-year statute of limitations for all claims arising out of license agreement. Plaintiff brought suit in 2016. Court held that, because copyright infringement based on license agreement breach requires that copyright be beyond original license scope, plaintiff's claims arose out of parties' license agreement and two-year statute of limitations applied even though agreement did not explicitly reference copyright infringement claims.

*Nealy v. Warner Chappell Music, Inc.*, 60 F.4th 1325 (11th Cir. 2023)

Court of appeals answered district court's certified question of whether damages in copyright action were limited to three-year lookback period as calculated from date of filing of complaint. Plaintiffs, alleged copyright owners of musical works, claimed that defendants were infringing because defendants were using works based on invalid licenses obtained from third parties that plaintiffs claimed were not copyright owners. Parties agreed that only disputed substantive issue relating to plaintiffs' claims was whether plaintiffs owned copyrights. District court held that their claims accrued when plaintiffs knew or should have known that defendants were challenging their ownership of works. District court found genuine dispute of material fact existed about when accrual occurred, and denied summary judgment for defendants on statute of limitations grounds. District court certified for interlocutory appeal question whether "damages in this copyright action are limited to the three-year lookback period as calculated from the date of the filing of the Complaint pursuant to the Copyright Act and *Petrella*." Circuit court first confirmed that discovery rule governed timeliness of plaintiffs' claims. Second, assuming claims were timely, court evaluated Act and Supreme Court's *Petrella* decision to determine whether plaintiffs may recover damages for infringement that occurred more than three years before filing of lawsuit. Defendants relied on *Petrella* for contention that plaintiffs may not recover for infringement that occurred more than three years before they filed suit. In *Petrella*, Supreme Court identified several reasons that it was unnecessary to apply doctrine of laches to copyright claims, including that "Section 507(b) ... bars relief of any kind for conduct occurring prior to the three-year limitations period." Supreme Court explained that, by dint of statute of limitations, retrospective relief is available to copyright plaintiff "running only three years back from the date the complaint was filed." Eleventh Circuit disagreed with Second Circuit decision in *Sohm* that under *Petrella*, even under discovery rule copyright plaintiff may not recover for infringement occurring more than three years before plaintiff filed suit. Court agreed with Ninth Circuit *Starz* decision, in which Ninth Circuit split with

Second and held that *Petrella* does not mean that plaintiff cannot recover for infringement that occurred more than three years before filing of an otherwise timely suit, reasoning that absolute three-year bar on damages would “eviscerate” discovery rule. First, court found *Petrella*’s statements about availability of relief to be directed to way statute of limitations works when claims accrue under injury rule, not discovery rule. Second, court stated, text of Act does not place time limit on remedies for otherwise timely claim. It would be inconsistent with *Petrella*’s preservation of discovery rule to read *Petrella* to bar damages for claims that are timely under discovery rule, court stated. Court also found that plain text of Act does not support existence of separate damages bar for otherwise timely copyright claim. Court accordingly held that copyright plaintiff with timely claim under discovery rule may recover retrospective relief for infringement that occurred more than three years prior to filing of lawsuit.

*Martinelli v. Hearst Newspapers, L.L.C.*, 65 F.4th 231 (5th Cir. 2023)

Fifth Circuit affirmed district court ruling granting plaintiff’s motion for summary judgment and denying defendant’s motion. Defendant used plaintiff’s photographs in article. Plaintiff sued defendant for copyright infringement. Plaintiff brought claims within three years of discovering infringements but more than three years after infringements occurred. Defendant argued intervening Supreme Court decisions undermined Fifth Circuit decision in *Graper v. Mid-Continent Casualty Co.* that limitations period starts running "once the plaintiff knows or has reason to know of the injury upon which the claim is based," also known as discovery rule, and that plaintiff’s claims were untimely because they accrued when defendant infringed copyrights. Defendant argued *Graper* no longer binding in light of Supreme Court decisions in *Petrella* and *Rotkiske*. Circuit court disagreed because *Petrella* and *Rotkiske* leave open possibility that in later case, Supreme Court might decide that discovery rule does not apply. Court found *Petrella*’s statements that suggest copyright infringement claim accrues when infringement occurs are *dicta* and do not bind court. Court found defendant overstated extent that *Rotkiske* governs court’s interpretation of Copyright Act, as it did not introduce “clear statement rule” that limitations period runs from occurrence of injury unless statute expressly says discovery rule applies, but instead identified how to resolve limitations question when unambiguous and when two plausible constructions. Court held Supreme Court cases left room for exceptions upon which court might have relied in *Graper*. Other circuits have rejected arguments that *Petrella* and *Rotkiske* overturned Copyright Act discovery rule. Thus, Supreme Court decisions did not unequivocally overrule *Graper* and under *Graper*, plaintiff’s copyright infringement claims timely because brought within three years of discovering infringements.

*Lixenberg v. Complex Media, Inc.*, No. 22-354, 2023 U.S. Dist. LEXIS 4510 (S.D.N.Y. Jan. 10, 2023)

District court dismissed plaintiff’s copyright infringement claim as time-barred. Plaintiff photographer owned rights to photograph of rapper Notorious B.I.G. Defendant Complex Media reproduced subject photograph on its website in May 2016. Plaintiff alleged that she discovered infringing photos in September 2021 and had no reason to know of unauthorized

use of photo before that. Plaintiff brought suit in January 2022. Court held that, although Second Circuit follows discovery rule, whereby copyright infringement claim does not accrue until “actual or constructive” discovery of relevant infringement, this is objective standard. Plaintiff was “seasoned litigator” and had filed nearly 20 lawsuits since 2015, including two concerning subject photo, it was not plausible that plaintiff, exercising reasonable diligence, would not have discovered unauthorized use until 2021. Accordingly, court granted defendants’ motion to dismiss claim as time-barred.

*Garza v. Everly*, 59 F.4th 876 (6th Cir. 2023)

Sixth Circuit affirmed finding that singer failed to exercise his rights under Copyright Act when singer took no action for decades after his partner repudiated singer’s authorship in 1980. Estates of famous musical duo Everly Brothers contested authorship over classic hit song. In 1980, older brother Don expressly repudiated younger brother Phil’s authorship in song, opening three-year window for Phil to reassert authorship under Copyright Act. In 2017, Don sued Phil’s estate for declaratory judgment that he was sole author of song, and district court found at trial that repudiation was successful, and Phil’s estate was time-barred from asserting ownership. Phil’s estate argued that three-year statute of limitations only applied to authorship claims, not defenses, so it began to run only when claims were filed in 2017. Sixth Circuit found that statute began to run when claim accrued, which was when plain and express repudiation occurred in 1980. Repudiation is like adverse possession in this way, and landowner need not be served with document for adverse possession clock to run. Sixth Circuit reviewed evidence that repudiation took place in 1980, and found that district court did not clearly err in so finding. Court also held that Phil’s estate could not escape clear statute of limitations by asserting co-authorship as defense instead of as claim.

*Howard v. Records*, 615 F. Supp. 3d 190 (W.D.N.Y. 2022)

District court granted defendant’s motion to dismiss. Plaintiff, songwriter, sued defendant, Jay-Z Carter, over copyright ownership. Plaintiff alleged Jay-Z failed to pay royalties for songs “both had copyrights to and [Carter] has performed.” Jay-Z argued claim should be dismissed with prejudice because it was barred by statute of limitations. Jay-Z claimed albums at issue were publicly released without giving credit to plaintiff, and because albums were commercial successes, plaintiff’s claim accrued on day albums released. Based on three-year statute of limitations, plaintiff’s claims expired. Plaintiff argued claim accrued every time music at issue was downloaded. Court agreed with Jay-Z that claim was time-barred. Court found that plaintiff attempted to reclassify copyright ownership claim as copyright infringement claim but there can be no action for infringement between joint owners. Court held copyright ownership claim accrues only once, when reasonably diligent plaintiff would have been put on inquiry notice as to existence of right. Court found plaintiff should have known he was not receiving royalties. Court also found plaintiff’s claim not subject to equitable tolling because he did not show defendant made definite misrepresentation of fact and had reason to believe plaintiff would rely on it, and that plaintiff reasonably relied on misrepresentation to his detriment.

*Schneider v. YouTube, LLC*, No. 20-4423, 2023 U.S. Dist. LEXIS 1878 (N.D. Cal. Jan. 5, 2023)

District court held that some of plaintiff's claims time-barred by statute of limitations in Terms of Service (TOS). Plaintiff musician, as one of three named plaintiffs in putative class action, sued YouTube and Google for infringing copyrights in her compositions and sound recordings. When setting up YouTube account in 2012, plaintiff accepted TOS, which included all-caps provision shortening statute of limitations to one year from accrual. Record showed that plaintiff had actual knowledge of 121 allegedly infringing videos for more than one year before filing suit. Plaintiff argued that one-year statute of limitation was unenforceable as unconscionable under California law. Court held that, though TOS were adhesive and non-negotiable, that was only "minor degree of procedural unconscionability." There was no surprise because shortened limitation period was clearly identifiable and in all caps. Although plaintiff argued that she had no reasonably available alternatives to creating YouTube account because it was prerequisite for submitting takedown notices, this was contradicted by evidence showing that such notices could also be sent by email, fax, web form and other sources.

*Energy Intel. Grp. Inc. v. Kirby Inland Marine LP*, No. 19-3520, 2022 U.S. Dist. LEXIS 175805 (S.D. Tex. Sept. 28, 2022)

Court denied parties' motions for summary judgment. Defendant, "one user" single subscriber to plaintiff's daily newsletter from August 2003 through July 2019, routinely forwarded emails to company executives and administrators. Copyright notices and subscription agreement "forbid copying, forwarding copies, and/or distributing" material "without express written permission" from plaintiff. Plaintiff alleged that defendant's actions constituted infringement. Parties moved for summary judgment on statute of limitations. Defendant sought to limit claims to those brought within three years of when complaint was filed, and damages to three years prior to suit's filing. As to claim accrual, court recognized that Fifth Circuit allows for discovery rule to toll claims, but defendant argued that Supreme Court overturned such precedent when it held that discovery rule did not apply to claims brought pursuant to Fair Debt Collection Practices Act ("FDCPA") because its limitations provision did not expressly authorize tolling. Court disagreed, finding differences in statutory language justified different outcomes. As to damages, court found no differences in approach to claims versus damages and noted that Fifth Circuit precedent indicated that two issues were not analyzed separately. Court found issue of fact precluded granting of summary judgment as to issue of when plaintiff knew or should have known of infringement. Court denied motions for summary judgment.

*Martinelli v. Hearst Newspapers, LLC*, No. 21-3412, 2022 U.S. Dist. LEXIS 124361 (S.D. Tex. July 5, 2022)

District court granted plaintiff's motion for summary judgment and denied defendant's motion for summary judgment, finding claim not barred by statute of limitations. Plaintiff, photographer, sued defendant for direct and contributory copyright infringement based on

use of photographs in news article without permission. Defendant conceded it infringed plaintiff's copyrights. Defendant argued court should apply injury rule, meaning statute of limitations begins to run when infringing act takes place, regardless of when copyright owner discovers infringement, and that claim accordingly was time barred. Court held discovery rule, under which claim accrues once plaintiff knows or has reason to know of injury upon which claim is based, governed in Fifth Circuit. Because plaintiff discovered infringement within three years of date first filed suit, defendant liable for infringement.

*Brunson v. Capitol CMG, Inc.*, No. 20-1056, 2022 U.S. Dist. LEXIS 153033 (M.D. Tenn. Aug. 25, 2022)

District court denied motion to dismiss counterclaim for infringement, finding counterclaim was not time-barred. Plaintiff Lisa Brunson, Christian singer/songwriter, sued defendants including music publisher, music administrator, and songwriter "Sinach" for infringement. Sinach wrote religious-themed song "Way Maker"; more than one year later, Brunson created new version of song by removing original bridge and incorporating plaintiff's composition in its place. Brunson's performance of song garnered over 1.8 million views on YouTube. Defendants counterclaimed for infringement and fraud on Copyright Office. Brunson moved to dismiss infringement claim, alleging that her "derivative work" was created more than three years prior to filing of defendants' counterclaim. Defendants claimed that discovery rule precluded dismissal, as they had not discovered Brunson's infringement until less than three years prior to filing counterclaim. District court held that defendants were not required to affirmatively plead date of discovery to avoid statute-of-limitations defense; burden fell on Brunson to prove that defendants discovered alleged infringement more than three years prior to filing of counterclaim. District court concluded that Brunson failed to carry her burden on motion.

*Finch v. Casey*, No. 22-20144, 2023 U.S. Dist. LEXIS 20635 (S.D. Fla. Feb. 7, 2023)

Court granted defendant's motion for summary judgment, finding plaintiff's copyright termination action barred by statute of limitations. Plaintiff filed suit in November 2022 seeking declaration that he properly exercised his termination rights under § 203 of Copyright Act with respect to 1983 agreement ("Agreement") whereby he allegedly transferred his copyright interests in 99 songs to defendant. Since executing Agreement, plaintiff consistently attempted to challenge its validity and defendant's ownership of songs. On August 12, 2012, plaintiff served notice of termination ("2012 Notice") under § 203 seeking to terminate copyright grants he purportedly made to defendant. Defendant did not respond to 2012 Notice. In May 2015, plaintiff's lawyer sent letter to defendant's counsel concerning 2012 Notice. Defendant responded, challenging validity of 2012 Notice and repudiating plaintiff's claim of authorship in songs. Plaintiff did not respond to defendant's letter. In September 2019, plaintiff's counsel served another notice of termination on defendant ("2019 Notice") with effective date of termination of October 2021. Plaintiff responded rebutting defendant's claims. Plaintiff commenced lawsuit in November 2022. Court held that plaintiff's lawsuit was barred by Copyright Act's three-year limitations



period because undisputed facts showed that, as matter of law, plaintiff's § 203 claim accrued no later than May 2015, given that defendant sent response to plaintiff's termination notice in 2012 disputing plaintiff's authorship claim and his corollary termination rights under § 203. Court found that defendant's response was sufficient to place plaintiff on notice that defendant was affirmatively challenging his authorship and termination rights over songs. Court determined that plaintiff's claims were legally unsound, unpersuasive, or relied on inapplicable case law. Court explicitly rejected plaintiff's argument that defendant's statute of limitations defense should not be considered because it was untimely, finding that defendant had mischaracterized nature of plaintiff's defense by portraying it as claim or counterclaim that should be subject to three-year statute of limitations, and by cherry-picking authorities. Because there were no genuine issues of material fact, court held defendant entitled to judgment as matter of law because plaintiff's declaratory judgment action was time-barred.

*Pisciotti v. Brittingham*, No. 20-5924, 2022 U.S. Dist. LEXIS 116951 (W.D. Wash. July 1, 2022)

Court granted in part and denied in part defendant's motion for summary judgment. Defendant approached plaintiff in 2012 about creating film titled "Kaleidoscope." Between 2012 and 2014, plaintiff worked on film. In July 2014, defendant showed plaintiff cover of DVDs for works, which listed her as sole owner of copyright, and parties' relationship soured as plaintiff's requests for payment went unheeded. In March 2015, plaintiff filed for copyright registration for work, but did not alert defendant of this fact. Meanwhile, defendant continued to reproduce work and represent that copyright was owned by her. In 2020, plaintiff brought suit for infringement and violation of DMCA. Parties filed cross-motions for summary judgment. Court found plaintiff's claim, which amounted to ownership dispute, was barred by statute of limitations. Court found defendant repudiated plaintiff's claim to copyright ownership when she presented DVD jackets to defendant in July 2014, stating she was sole copyright owner, and when defendant later made apparent she would continue to market and sell work without payment of profits or royalties to plaintiff. Because repudiation happened more than three years prior to when plaintiff filed suit, court granted defendant's motion for summary judgment on plaintiff's infringement and DMCA claims.

*Amo Dev., LLC v. Alcon Vision, LLC*, No. 20-842, 2022 U.S. Dist. LEXIS 219368 (D. Del. Dec. 6, 2022)

District court granted defendant's motion for summary judgment, reasoning that Act bars monetary relief for act of infringement that was discovered more than three years before plaintiff filed suit. Plaintiff manufactured laser system used for eye surgery that employed copyrighted software. Defendant marketed different cataract surgery system. In 2014, plaintiff obtained one of defendant's devices and inspected its object code. Years later, in June 2020, plaintiff filed complaint alleging that defendant 's software infringed plaintiff's patents. Weeks later, in July 2020, plaintiff sent letter to defendant indicating that plaintiff "had every reason to believe" that defendant had copied plaintiff's source and/or object code,

and invited defendant to share released versions of its source code. Defendant did not comply. In September 2020, plaintiff filed First Amended Complaint alleging that defendant's software incorporated protected copyrighted elements. In November 2020, plaintiff obtained access to defendant's source code through discovery and filed second amended complaint alleging two counts of copyright infringement after discovering that over 26,000 lines of plaintiff's code were incorporated into defendant's device, including typos and dates from before development of defendant's product. Defendant argued that plaintiff's claim was barred under Act's three-year statute of limitations and that plaintiff should not be able to claim monetary relief for acts that occurred more than three years before plaintiff filed First Amended Complaint. Defendants argued that Discovery Rule, which says copyright claim accrues when plaintiff discovers or with due diligence should have discovered injury that forms basis for claim, should not apply. Court disagreed regarding application of Discovery Rule, but held that even under Discovery Rule, plaintiff could not recover damages because it had sufficient information as of 2014 to be on inquiry notice that defendant may have infringed its source code and failed to exercise reasonable diligence before July 2020.

### **C. Res Judicata/Collateral Estoppel**

*Atticus LLC v. Dramatic Publ'g Co.*, No. 22-10147, 2023 U.S. Dist. LEXIS 73732 (S.D.N.Y. Apr. 27, 2023)

District court denied defendant's motion to dismiss and granted in part plaintiff's motion for summary judgment, finding that defendant did not currently possess exclusive right to perform amateur theatrical productions of *To Kill a Mockingbird*. In 1969, author Harper Lee granted defendant publishing company right to create dramatization of novel *To Kill a Mockingbird* for amateur productions (e.g., community theaters and schools). License agreement contained arbitration clause. In 2011, Lee issued termination notice to defendant. In 2015, Lee entered into agreement with non-party to select playwright for new dramatic adaptation of novel. Aaron Sorkin wrote new adaptation. In 2019, Dramatic filed arbitration demand against Lee estate, arguing breach of 1969 agreement. Arbitrator largely found Lee estate liable on Dramatic's claims. In 2022, plaintiff, which owned production rights to Sorkin play, sought declaratory judgment that plaintiff and Sorkin had right to present certain performances of play in United States and that such productions do not infringe any purported copyright interest of defendant. District court concluded that, under § 304 of Act, defendant's exclusive license to perform derivative work did not remain exclusive after valid termination of license. However, Dramatic claimed that plaintiff was bound by arbitrator's contrary decision due to claim preclusion. District court evaluated whether plaintiff, which was not party to arbitration, was in privity with Lee estate, which was bound by arbitration. Otherwise, rule against nonparty preclusion would likely apply. District court evaluated four potential exceptions to nonparty preclusion rule, and found none applied: plaintiff did not agree to be bound by prior arbitration, plaintiff was not in pre-existing relationship with Lee estate, interests of plaintiff were not adequately represented by party to arbitration with same interest, and plaintiff did not assume control over prior litigation between Lee estate and Dramatic. District court therefore denied motion to dismiss.

*Wakefield v. Olen Props. Corp.*, No. 21-1585, 2022 U.S. Dist. LEXIS 193691  
(C.D. Cal. Oct. 14, 2022)

District court granted plaintiff's motion to dismiss counterclaim and strike defenses, holding that defendants' counterclaims and affirmative defenses asserting invalidity were barred by doctrine of issue preclusion. Plaintiff artist Donald Wakefield sued defendants for copyright infringement after finding several copies of plaintiff's large-scale granite sculpture *Untitled* on defendants' properties. Plaintiff sued defendants multiple times for infringement after finding additional infringing copies of plaintiff's work on defendants' property over time – instant suit was number three out of four. In first lawsuit, defendants asserted that plaintiff's copyright was invalid, but jury found otherwise. Here, defendants alleged, *inter alia*, that plaintiff was not true owner of valid and enforceable copyright. District court noted that validity of plaintiff's copyright was already decided in first litigation brought by plaintiff against defendants. Therefore, defendants were barred from raising their identical claims and defenses again in present case.

*Oppenheimer v. Scarafile*, No. 19-3590, 2022 U.S. Dist. LEXIS 123782  
(D.S.C. July 12, 2022)

Plaintiff alleged that defendants, who offered real-estate services in Charleston area, copied and distributed his images in online and newspaper listings for boat slip at Marina. Defendants moved for summary judgment on equitable estoppel defense. Court found genuine disputes of material fact existed with respect to defendant's equitable estoppel defense, and declined to bar defense despite existence of copyright notice affixed to plaintiff's photographs. Defendants argued that plaintiff induced defendants to use copyrighted photographs by making them easy to find, download, and share online, and also because plaintiff did not employ warnings, other than copyright notice, to deter infringement. Plaintiff argued that making his photographs easy to find and download, and not employing more explicit warnings, were part of his marketing strategy and should not be considered invitation to infringe. Court determined that, even though defendants should have "used the means at hand to ascertain the extent of the interest asserted," estoppel defense was not barred because plaintiff did more than hold out from filing suit. Therefore, court denied both plaintiff's and defendants' motions for summary judgment as to defendants' estoppel defense.

#### **D. Misuse**

*Oppenheimer v. Scarafile*, No. 19-3590, 2022 U.S. Dist. LEXIS 123782  
(D.S.C. July 12, 2022)

Plaintiff, professional photographer, brought suit against defendants, alleging infringement of his original photographs of Toler's Cove Marina in Mount Pleasant, South Carolina. Plaintiff alleged that defendants, who offered real-estate services in Charleston area, copied and distributed his images in online and newspaper listings for sale of boat slip at Marina. Defendants moved for summary judgment on copyright misuse defense. Court denied

summary judgment as to defendants' misuse defense, holding that there was genuine dispute of material fact as to why plaintiff copyrighted his work. Court found evidence showed that plaintiff could be considered excessive filer of copyright infringement suits because plaintiff earned more than \$400,000 from litigation settlements and less than \$5,000 from license and print sales in 2017. But evidence also showed that plaintiff conducted legitimate professional photography business where he sold products and services and licensed his photographs. Court determined that jury should decide whether plaintiff was more focused on business of litigation than licensing or selling his work, and whether plaintiff employed abusive litigation tactics.

### **E. Sovereign Immunity**

*ACT, Inc. v. Worldwide Interactive Network, Inc.*, 46 F.4th 489 (6th Cir. 2022)

Sixth Circuit affirmed district court's denial of defendant's assertion of derivative sovereign immunity defense, on basis that defense was untimely asserted. Plaintiff, developer of "workforce-development assessments that measure skills affecting job performance," sued defendant for infringement after learning that defendant won contract with South Carolina Department of Education and Workforce using materials plaintiff alleged were "virtually identical" to plaintiff's copyrighted materials. District court granted partial summary judgment for plaintiff on infringement claims on March 10, 2020. On March 23, 2020, Supreme Court rendered decision in *Allen v. Cooper*, 140 S. Ct. 994 (2020), invalidating Copyright Remedy Clarification Act of 1990 and clarifying that "states may validly assert sovereign immunity defenses against copyright-infringement claims." After loss on partial summary judgment, defendant created new "revised" materials and plaintiff filed amended complaint alleging infringement as to those newly created materials. In answering amended complaint, defendant, on August 27, 2021, asserted for first time defense of derivative sovereign immunity on basis that allegedly infringing materials were created pursuant to contract with South Carolina Department of Education and Workforce. District court found, and Sixth Circuit affirmed, that defendant's delay in asserting derivative sovereign immunity defense was untimely as being asserted "about a year and a half" after becoming available following *Allen* decision. Sixth Circuit rejected defendant's contention that defense could only be raised upon filing of amended answer, noting that defendant could and should have moved district court to reconsider partial summary judgment order soon after *Allen* decision. District's court's striking of derivative sovereign immunity defense on timeliness grounds was affirmed.

### **F. Miscellaneous**

*Canadian Standards Ass'n v. P.S. Knight Co., Ltd.*, No. 20-1160, 2023 U.S. Dist. LEXIS 20412 (W.D. Tex. Jan. 4, 2023)

Summary judgment granted to plaintiff on infringement claim where plaintiff owned Canadian copyright, even though plaintiff's work was incorporated into Canadian law. Plaintiff developed voluntary standards and codes in Canada, including electrical, propane

storage and handling, and oil and gas pipeline standards, all of which had Canadian copyright registrations. Parts of these had been incorporated by reference into Canadian regulations and statutes. Defendant published book which referenced one of plaintiff's standards with attribution, and later expanded it into near-replica of plaintiff's standard. Plaintiff filed Canadian copyright infringement suit and prevailed. Defendant created United States corporation and re-released book with deliberate intent to avoid Canadian jurisdiction, and registered United States copyright in book. Court found that because Canada is signatory to Berne Convention, Canadian copyright holders enjoy same rights under Copyright Act as United States copyright holders. Defendant argued that plaintiff's copyrights were exempt because they were incorporated into Canadian law, and no one can own law. Court found that government edicts doctrine is American legal doctrine and does not exist in Canada; and even if it did, copyrighted works were merely incorporated into law, and were not law themselves. Nor was defendant's book educational fair use, as it explicitly was advertised as containing all of plaintiff's work for less than half cost.

*Kipp Flores Architects, LLC v. AMH Creekside Dev., LLC*, No. 21-1158, 2022 U.S. Dist. LEXIS 142279 (W.D. Tex. Aug. 9, 2022)

Plaintiff architectural firm brought suit against defendant real estate developers for copyright infringement and DMCA violation. Defendant received copies of works from plaintiff electronically; each contained copyright notice. As part of developments, defendant hired third parties to create stylized floorplans or renderings for marketing purposes. Third parties received plaintiff's works after executing license agreements, preventing them from removing plaintiff's CMI, but floorplans and renderings created by third parties did not include plaintiff's CMI. Plaintiff claimed that defendants infringed works by distributing third party renderings without plaintiff's CMI. Defendants moved to dismiss direct, vicarious, and contributory infringement claims. Defendant specifically moved to dismiss direct liability claim on basis that floorplans and renderings were protected from liability under § 120(a). Finding that defendant had shown that floorplans and renderings were pictorial representations under statute and that homes themselves were constructed prior to when marketing materials were distributed, court granted motion to dismiss.

*Equine Legal Sols., PC v. This Old Horse, Inc.*, No. 22-269, 2022 U.S. Dist. LEXIS 117596 (D. Or. July 5, 2022)

Plaintiff alleged defendant infringed legal forms plaintiff created for equine-related legal services. Defendant Turner moved to dismiss for failure to state claim. Plaintiff's legal forms were accessible for download after agreeing to licensing agreement and paying fee. Licensing agreement prohibited users from editing forms and creating derivative works. Defendant paid and signed licensing agreement to download forms. Plaintiff alleged that Turner used forms to create derivative works and later distributed forms. Defendant Turner argued that she could not be personally liable for infringement because at all relevant times she was acting as agent of Defendant This Old Horse, Inc., equine non-profit. Court disagreed with Turner's argument, finding it well established for individual liability for infringement to be extended to officers. Turner additionally alleged that plaintiff failed to

state sufficient facts to claim infringement, but court found that plaintiff sufficiently alleged valid copyright, access, and that form in question contained nearly identical language to copyrighted form. Finally, court agreed with Turner that plaintiff's conversion claim was preempted by Act because plaintiff did not allege additional elements specific to conversion claim beyond intent. Court granted in part and denied in part motion to dismiss.

## VII. REMEDIES

### A. Damages and Profits

*Sullivan v. Flora, Inc.*, 63 F.4th 1130 (7th Cir. 2023)

Illustrator plaintiff sued herbal defendant supplement and health product manufacturer for infringement of plaintiff's illustrations. Plaintiff had granted exclusive license to defendant to use illustrations in two ad campaigns, but discovered that defendant also used them for other purposes. Plaintiff then registered her 33 illustrations as two collections, and filed suit. At trial, defendant argued plaintiff could only recover one award per registration, not per illustration, and alternatively, that independent economic value test applied. District court held that plaintiffs' individual illustrations were individual works, entitling plaintiff to separate statutory damages awards. Jury awarded \$3.6 million in statutory damages and \$143,500 in actual damages; plaintiff elected statutory damage award. Defendant appealed. In that appeal (*Flora I*), court adopted independent economic value test, i.e., whether works have value only in and through their composite whole, for determining whether multiple works are entitled to separate statutory damages awards. After remand, defendant requested (via motion deemed to be summary judgment motion) reopening of discovery to determine economic value; district court refused, holding that *Flora* waived its argument that some illustrations did not have economic value. District court then found that plaintiff's illustrations were separate works. Defendant appealed district court's ruling, alleging that district court erred in finding defendant waived arguments, violated court's mandate by refusing to reopen discovery, and improperly weighed evidence at summary judgment (*Flora II*). After affirming district court's finding of waiver and refusal to reopen discovery, court held that district court erred in awarding summary judgment to plaintiff and awarding original amount of statutory damages. First, invoices submitted by defendant to plaintiff indicated that plaintiff produced subject works as "illustration collections," not separate illustrations. Court also noted that subject works were registered as *group* registrations. District court rejected defendant's argument that plaintiff's failure to individually market illustrations was evidence that they did not have independent economic value, and fact that market "failed to respond to Sullivan's copyright registrations" was evidence that market did not consider individual illustrations to have independent economic value. Circuit court held that district court improperly weighed evidence in evaluating defendant's arguments, which required reversal of decision. Court held that defendant created genuine issue of material fact regarding whether content of illustrations created separate economic value. Finally, Court held that district court improperly failed to evaluate whether illustrations depicting only one solid color lacked independent economic value. Court therefore reversed district

court's grant of summary judgment, for violating mandate and improperly weighing evidence, and remanded for trial on question of damages, as well as answer to question whether plaintiff's illustrations constituted many individual works or two compilations.

*Johnson v. Tennyson*, No. 22-5683, 2023 U.S. Dist. LEXIS 39181 (S.D.N.Y. Mar. 8, 2023)

Magistrate judge recommended award of statutory damages to plaintiff. Plaintiff award-winning photographer created Aaliyah Photograph in 2021 and registered it. Defendant paint kit companies created unauthorized paint kits depicting Aaliyah Photograph and distributed them to wholesale customers with expectation that latter would resell kits to retail customers. Defendants knowingly and willfully falsified copyright management information by placing their own names on paint kits to enable their customers' infringement. Plaintiff and defendants entered into settlement agreement, with Defendants agreeing to pay plaintiff monthly payments if plaintiff released defendants from claims arising from use of Aaliyah Photograph. However, Defendants failed to satisfy contractual payment obligations and started using different company that was not signatory to settlement agreement to continue selling and distributing infringing paint kits. Plaintiff filed new suit and, when defendants failed to appear, court entered default judgment for plaintiff for copyright infringement claims and referred matter to magistrate for damages inquest. Magistrate recommended award of maximum statutory damages of \$150,000 because defendants were willful, discovery in first lawsuit showed that defendants likely reaped significant profits from their infringing activities and court should deter future infringements. Magistrate further recommended award of \$5,000 in statutory damages for seven DMCA violations, for total of \$35,000, since defendants distributed Aalyiah Photograph with defendants' name on it.

*Prepared Food Photos, Inc. v. Silver Star of Brooklyn*, No. 22-4196, 2023 U.S. Dist. LEXIS 22037 (E.D.N.Y. Jan. 23, 2023)

Court granted plaintiff's motion for default judgment. Plaintiff created high-end professional photographs for food industry, which were licensed by subscription starting at \$999 month. Defendant used plaintiff's photograph of lasagna without authorization or license. Plaintiff sent infringement notice to defendant, which went unanswered, and defendant failed to answer complaint. By failing to answer, defendant was deemed to admit factual allegations in complaint. Court reviewed allegations to determine if valid claim existed, and found evidence of registration of work, direct copying of work, and willful infringement. Turning to of damages, court found that for each year that defendant published work, plaintiff would be owed annual license fee of \$11,988.00. Work was published as of November 2018 (based on Wayback Machine) and remained published by defendant until at least April 2022. Given these facts, cost of 3X annual license payments (\$35,964.00) was most accurate measure of actual damages based on presently-known facts. Court noted, however, that defendants' inaction and refusal to participate in lawsuit suppressed information necessary to calculate actual damages. As such court awarded statutory damages amounting \$71,928.00. Court also awarded fees and costs and entered permanent injunction against defendant.

*Lee v. 162 D&Y Corp.*, No. 18-2580, 2022 U.S. Dist. LEXIS 234322  
(E.D.N.Y. Dec. 30, 2022)

Plaintiff, heir to South Korean composer Jae Ho Lee and exclusive owner in copyright in composer's songs, sued numerous karaoke room operators for infringement, alleging works available for performance through karaoke machines at defendants' businesses. Plaintiff personally visited karaoke bars and filmed himself browsing through works in catalog on karaoke machine and singing/performing certain of works. Defendants initially appeared through counsel and submitted Answer, but following withdrawal of counsel defendants' answer stricken by court. On motion for default judgment, magistrate judge found defendants infringed performance rights (by playing songs through karaoke machines) and distribution rights (by offering songs for performance through karaoke machines). Plaintiff moved for actual damages in amount of \$28,000 from each defendant as "discounted flat rate" based on licensing rate for works, and alternatively for statutory damages. Finding plaintiff submitted insufficient evidence to support fair market license value for works, magistrate instead considered award of statutory damages. Magistrate found defendants infringement willful, due to both their failure to participate in litigation, and also because defendants "are in the business of providing customers with access to published works of music and should have been aware of the need to comply with copyright laws." District court calculated plaintiff's estimated licensing revenue as about \$9,000 per defendant and applied multiplier of licensing fee in recommending award of \$27,000 statutory damages against each defendant.

*Structured Asset Sales, LLC v. Sheeran*, No. 18-539, 2022 U.S. Dist. LEXIS 177266 (S.D.N.Y. Sept. 29, 2022)

District court held that plaintiff could be entitled to direct but not indirect damages. Plaintiff sued Ed Sheeran and others, claiming that Sheeran's song "Thinking Out Loud" infringed copyright in "Let's Get It On" composition. Plaintiff's claim was based on alleged copying of chord progression and harmonic rhythm (collectively, "backing pattern"). Plaintiff sought, *inter alia*, damages based on touring profits, i.e., sale of concert tickets and concert merchandise. Court held that damages based on concert ticket sales were direct because Sheeran paid to perform songs, including accused song. However, damages based on concert merchandise sales were indirect because source of profits was from another good separate from any infringing performance.

*Dow Jones & Company, Inc. v. Harris*, No. 22- 564, 2023 U.S. Dist. LEXIS 12930 (W.D. Tex. Jan. 24, 2023)

Magistrate judge recommended dismissal of copyright infringement claims based on unregistered works. Plaintiff Dow Jones, publisher of *The Wall Street Journal* and *Barron's*, sued defendant, professor at Texas A&M, for copyright infringement based on his unauthorized distribution of plaintiff's copyrighted articles in defendant's daily curated newsletter. Defendant moved to dismiss plaintiff's claim for statutory damages to extent based on number of individual articles, rather than number of issues or compilations, that



defendant allegedly infringed. Plaintiff alleged ownership of group registrations of sets of magazine and newspaper issues, group registrations for database updates, and registrations for single magazine or newspaper issues. Magistrate judge held that each type of plaintiff's registrations constituted a single compilation or work for purposes of statutory damages claim, and therefore recommended that plaintiff be limited to damages for each group work rather than each individual article alleged to be infringed.

*Millennium Funding, Inc. v. Micfo LLC*, No. 21-1594, 2022 U.S. Dist. LEXIS 197756 (D. Colo. Oct. 31, 2022)

District court awarded maximum statutory damages under Act. Plaintiffs, owners of 28 copyrighted motion pictures, sued defendant, company that leased services and IP addresses to customers that worked with operators of websites that pirated plaintiffs' works. Through anti-piracy provider, plaintiffs had sent at least 140 notices to defendant concerning IP addresses used for infringement, but defendant failed to take any action. Since infringement was willful and defendants marketed their services specifically for pirating movies, court awarded maximum statutory damages of \$4,200,000. Although defendants had included in their Terms of Service indemnity clause to indemnify them from liability, court ordered writ of execution transferring claims defendant had against its customers for breach of Terms of service to plaintiffs so that monetary relief would go toward remedying plaintiff.

*Wolf Designs LLC v. Five 18 Designs LLC*, No. 21-1789, 2022 U.S. Dist. LEXIS 190183 (D. Ariz. Oct. 18, 2022)

Plaintiff and defendants both designed and installed vehicle wraps. Plaintiff alleged that defendant copied its designs and stole its customers. Defendants moved for judgment on pleadings on copyright claim on grounds that claim was time-barred, and statutory damages and attorneys' fees were unavailable. As to statute of limitations, defendants claimed that allegations related to copying of plaintiff's designs for one customer should be dismissed as time-barred because plaintiff alleged it knew of infringement more than three years before filing suit. Plaintiff, in opposition, argued that claim was not time-barred because it combined each of three instances of infringement in one claim. While noting that most courts decline to grant judgment on pleadings as to only portion of claim, court found it would be efficient in this case to do so. As to statutory damages and attorneys' fees, defendants requested dismissal because plaintiff did not register copyrights within three months of publication and infringement occurred prior to effective date of registration. In opposition, plaintiff claimed that group registration saved one instance of infringement. Although defendants argued that group registration should not be considered because application incorrectly stated that works were unpublished, court found validity of registration could not be determined at current procedural state. Court granted motion on pleadings only to extent of dismissing portion of infringement claim related to allegedly infringing incident dating more than three years prior to commencement of suit.

*Premier Dealer Servs. v. Allegiance Adm'rs, LLC*, No. 18-735, 2022 U.S. Dist. LEXIS 153768 (S.D. Ohio Aug. 25, 2022)

Plaintiff and defendant competed as administrators of automobile service contracts and loyalty programs. Another automobile service contractor, Tricor, not party to case, acted as obligor in all service contracts in case. Plaintiff used Tricor's loyalty program and to do so created administrative form, LPLP Certificate, which was subject of copyright claim. Plaintiff ceased working with Tricor in 2018. Defendant then began working with Tricor, including using LPLP Certificate. As to damages, plaintiff only sought disgorgement profits, amount defendant earned from LPLP Certificate. To calculate profits, plaintiff must show proof of gross revenue, then burden shifts to defendant to show deductible expenses. If defendant does not meet burden then gross revenue is determined to be lost profits. Evidence here consisted of sworn testimony. Plaintiff met its burden by proving defendant's gross revenue was \$1,169,851. Court applied absorption approach, which includes general overhead costs, to defendant's deductible expenses as opposed to incremental approach, which does not include all general overhead costs. Defendant was able to prove \$765,817 in deductible expenses for period from April 1, 2018 to October 31, 2021. To calculate remaining profit plaintiff was entitled to court applied profit margin to defendant's applicable revenue from October 2021 through April 2022, and found plaintiff entitled to additional \$37,206 on top of \$404,034 in profit from April 2018 to October 2021. Court held plaintiff entitled to \$441,239 in profits.

*Fitzgerald v. Murray*, No. 21-1822, 2022 U.S. Dist. LEXIS 166668 (S.D. Ind. Sept. 15, 2022)

Court granted plaintiff's motion for summary judgment on copyright infringement claim. Plaintiff Fitzgerald was executor of estate of Frithjof Schuon ("Schuon"), philosopher and author, who died in 1998. Defendant Murray was close friend of Schuon and wife until Murray became estranged following her divorce. Schuon died in 1998 and his wife inherited his right of publicity and copyrights, which were subsequently assigned to plaintiff World Wisdom. In 2018, defendant Murray published website containing numerous allegations about Schuons, and infringed some of Mrs. Schuon's copyrighted works. In 2021, Murray and defendant Beacon Books published book titled *Third Wife of the Muslim Shaykh Frithjof Schuon* ("*Third Wife*"), which included allegations about Schuons and plaintiff, and infringed Mrs. Schuon's copyright in work titled *Points of Reference*, owned by plaintiff World Wisdom. Later in 2021, Beacon Books withdrew *Third Wife* from circulation, although Murray continued to disseminate electronic versions. In June 2021, plaintiffs filed copyright infringement claim and sought injunctive relief. Court issued preliminary injunction prohibiting defendants from distributing *Third Wife*. Plaintiffs moved for summary judgment on copyright infringement claim and for statutory damages and permanent injunctive relief. Court granted plaintiff's motion on copyright infringement claim. As to statutory damages, plaintiffs sought minimum amount – \$750 – based on suspicions that defendant did not have assets to compensate them for either actual or statutory damages. Court granted plaintiffs' request.

*Karzo v. Matador Recs., Inc.*, No. 21-667, 2022 U.S. Dist. LEXIS 165421  
(M.D.N.C. Sept. 14, 2022)

District court granted defendant's motion for judgment on pleadings denying plaintiff's claims for statutory damages and attorneys' fees, finding plaintiff's delay in registering work rendered such claims unavailable. Plaintiff, Tuareg musician from Niger, alleged he wrote song "Mafelawen" in 2006 or 2007, and registered work in April 2021. Defendant, likewise Tuareg musician, began performing song "Afrique Victime" in 2012, and released album via Matador Records containing recording of work in May 2021. Plaintiff sued for infringement in August 2021, contending that "Afrique Victime" constituted "exact copy" and infringement of "Mafelawen." Defendant moved for partial judgment on pleadings, arguing that plaintiff's complaint failed to state claim for statutory damages or attorneys' fees because alleged infringement began in 2012 but plaintiff did not register his copyright until April 2021. District court considered language of § 412(a) which precludes statutory damages or fees for "any infringement of copyright in an unpublished work commenced before the effective date of its registration" or "any infringement of copyright commenced after first publication of the work and before the effective date of its registration," and found that plain language of statute precluded recovery of statutory damages for infringement that commenced before registration. Defendant further contended that plaintiff was precluded from recovering statutory damages and attorneys' fees for alleged infringement after plaintiff's registration, on basis that infringement actually commenced in 2012 and defendant's release of album in May 2021 constituted "a continuation of the 2012 infringing conduct." District court agreed with defendant that its recording of album was "continuation" of its conduct that could be "traced" to its original 2012 infringement, and thus found statutory damages and fees unavailable. District court noted that this result comports with legislative intent of promoting "speedy registration" by "making registration a precondition for the 'extraordinary remedy' of statutory damages."

*Oppenheimer v. Scarafile*, No. 19-3590, 2022 U.S. Dist. LEXIS 123782  
(D.S.C. July 12, 2022)

Plaintiff, professional photographer, brought suit against defendants, alleging infringement of his original photographs of Toler's Cove Marina in Mount Pleasant, South Carolina. Plaintiff alleged that defendants, who offered real-estate services in Charleston area, copied and distributed his images in online and newspapers listings for sale of boat slip at Marina. Defendants argued that plaintiff's copyright registration constituted single work, entitling plaintiff to only one statutory damages award, based on Copyright Office note on plaintiff's certificate of registration stating that work was "registered as an unpublished collection, not as a published group." Court found that defendants cited to no authority supporting argument. Difference between group registration and unpublished collection registration, if there is one for statutory damages purposes, would not be enough to find that registration constituted single work because method of registration is not dispositive of works' status as compilation. Moreover, works in unpublished collection can be considered individually for purposes of statutory damages. Court therefore reserved for jury question of whether plaintiff issued works together or separately, and whether works had independent value.

## B. Attorneys' Fees

*Webber v. Dash*, No. 19-610, 2022 U.S. Dist. LEXIS 125124 (S.D.N.Y. July 14, 2022)

District court granted plaintiff's motion for fees for full amount \$117,884.71. Plaintiffs brought copyright action against defendants over film titled *The List* and later *Dear Frank*. After three-year litigation and four-day jury trial, jury found for plaintiffs. Plaintiffs filed motion for fees. While court found genuine disputed facts regarding intent and contribution to film, defendants' litigation misconduct and interest in deterrence weighed heavily in favor of awarding fees. Misconduct included intimidating and threatening plaintiffs' lawyer, repeatedly defying court orders, refusing to comply with discovery requests, and failing to appear for deposition numerous times. On one actual appearance for deposition local counsel had to call 911 and have defendant removed from premises due to unruly behavior. Lastly, while defendant opposed fees, he had not contested amount sought. Court found both rates charged and hours worked to be reasonable.

*Horror Inc. v. Miller*, No. 16-1442, 2022 U.S. Dist. LEXIS 173290 (D. Conn. Sep. 26, 2022)

District court awarded attorneys' fees to defendant pursuant to § 505 of Act and California anti-SLAPP statute. In 2016, Victor Miller, writer of *Friday the 13<sup>th</sup>* screenplay, sought to reclaim ownership of screenplay from production company Manny Company and its successors, including Horror Inc., via termination of transfer. Plaintiffs Manny and Horror Inc. sought declaratory judgment that screenplay was work made for hire, but lost, both in district court and at Second Circuit. Defendant Miller sought attorneys' fees. District court first evaluated whether § 505 fees are proper for copyright claim brought under Declaratory Judgment Act, which does not contain fee shifting provision. Noting that § 505 authorizes attorneys' fees in *any* civil action brought under Title 17, district court held that § 505 applies to declaratory judgment action concerning termination rights under Act. District court further held that plaintiffs' claims were objectively unreasonable – but not frivolous – and were likely intended to intimidate Miller from exercising termination rights. District court further concluded that fee award would serve important deterrent purpose. After determining reasonable hourly rates and hours to calculate lodestar, district court awarded defendant more than \$886,000 in attorneys' fees.

*Keck v. Mix Creative Learning Ctr., LLC*, No. 21-430, 2023 U.S. Dist. LEXIS 51249 (S.D. Tex. Mar. 27, 2023)

District court held that prevailing defendants entitled to recover attorneys' fees. Plaintiff mixed media artist sued children's art studio and its owner for selling art kits with plaintiff's art. Defendants sold only six kits (two of which were sold to plaintiff) for gross revenues of \$240 and, once notified of suit, removed all art kits from website. Despite defendants' offer to repay all profits to plaintiff, plaintiff proceeded with suit. All plaintiff's claims, including that of willful infringement, on defendants' summary judgment motion, were dismissed and court found that defendants' use was fair. Defendants moved for attorneys' fees. Court

awarded attorneys' fees, with 20% discount proffered by defendants' counsel at oral argument, because plaintiff's willful infringement claims and extensive damages requests were unreasonable and unsubstantiated, especially in light of defendants' meagre revenues and immediate cooperation. However, court noted that plaintiff's social media posts disparaging defendants were not additional factor in awarding attorneys' fees.

*Novedea Sys. v. Colaberry, Inc.*, No. 20-180, 2022 U.S. Dist. LEXIS 169925 (E.D. Tex. Sep. 20, 2022)

District court denied defendants' motion for attorneys' fees on infringement claim voluntarily dismissed upon joint stipulation of parties. Litigation stemmed from ownership dispute over software company, and plaintiff alleged that defendants copied without authorization certain of plaintiff's copyrighted software. Following voluntary dismissal of infringement and certain other claims and jury trial on remaining claims, court entered judgment in ownership dispute; defendants then moved for attorneys' fees. As initial matter, court considered whether defendants were "prevailing party" on voluntarily dismissed infringement claim. Court found that infringement claim, dismissed pursuant to joint stipulation, did not bear "judicial imprimatur necessary to find the prevailing party." Moreover, defendants unable to demonstrate that plaintiff withdrew claim "on the eve of a jury verdict to avoid a disfavorable judgment on the merits," and that parties' mutual stipulation to dismiss competing claims "resembles the quid pro quo of a private settlement rather than Plaintiffs unilaterally withdrawing their claims to avoid a negative judgment." After finding defendants not prevailing party on infringement claim (and thus not eligible for attorneys' fees), district court considered merits of attorneys' fees motion, applying *Fogerty* factors. On frivolousness/objective reasonableness factor, district court found plaintiff's evidence showing its ownership of certificate of registration and evidence showing transfer of copyright source code sufficient to show infringement claim reasonable and not frivolous. On motivation factor, court noted that copyright claims were "of many claims brought by both sides in this complex litigation" and thus not brought with improper motivation or malevolent intent to injure defendants' business, drive up legal expenses, or extract settlement. On compensation and deterrence factor, court found that even though plaintiff did not succeed on infringement claim, there was no suggestion that claims were "overaggressive" or should never have been brought. Having considered *Fogerty* factors, court found that defendants were not entitled to attorneys' fees on plaintiffs' copyright claims even if defendants had prevailed on claims.

*Caracol TV, S.A. v. Telemundo TV Studios, LLC*, No. 18-23443, 2022 U.S. Dist. LEXIS 138908 (S.D. Fla. Aug. 4, 2022)

Plaintiff filed for declaratory and injunctive relief for issues relating to infringement of Spanish-language telenovela series ("Series"). Plaintiff's copyright claims turned on whether Letter Agreement gave defendant sole ownership rights in Series. Court found that Letter Agreement transferred all of plaintiff's ownership rights to defendant and entered final judgment in favor of defendant. Defendant then moved for attorneys' fees, and motion was stayed pending outcome of appeal to Eleventh Circuit. Upon denial of appeal in full, court

considered motion for fees based on *Fogerty* factors. Court found that while there was no evidence in record to support frivolousness or bad faith motivation, plaintiff's position was objectively unreasonable. Plaintiff's four-year delay in filing suit likely barred claim under statute of limitations, and untimely claims are objectively unreasonable. Additionally, plaintiff failed to defend several of its copyright claims in reply to defendant's motion. Court also held that appeal to Eleventh Circuit was unreasonable because circuit court held that lower court did not err. Finally, court held that "defendants have an interest in being compensated for their successful defense." After finding fees appropriate, court then calculated reasonable fee amount. In calculating lodestar, after finding rates requested reasonable, court reduced number of hours requested and awarded fees of \$783,256.25 for trial proceedings and \$194,335.93 for appellate proceedings, for total of \$977,592.18.

*Miller v. 4Internet, LLC*, No. 18-2097, 2022 U.S. Dist. LEXIS 228547 (D. Nev. Dec. 20, 2022)

District court applied Ninth Circuit's server test in determining reasonableness of plaintiff's claim and awarding defendant attorneys' fees. Freelance photographer for New York Post brought action against defendant for displaying his photograph on subsidiaries' website through inline links without obtaining licensing rights. Plaintiff conceded that contested image was inline linked; however, it was not stored on defendant's servers. Court granted defendant's summary judgment motion, concluding that Ninth Circuit's "server test," which permits copyright infringement claim only if purported infringer "store[s] a copy of the copyrighted image on its own server," precluded claim. Defendant then moved for fees. Plaintiff's infringement claim had slim chances of success given that Ninth Circuit's server test clearly precludes infringement for inline-linked images. Furthermore, plaintiff presented no circuit authority narrowing server test, instead arguing that U.S. Supreme Court precedent invalidated Ninth Circuit server test. However, Ninth Circuit crafted server test utilizing plain language of Act and continued to apply test years after Supreme Court's opinion. District court therefore was obligated to apply server test. Accordingly, plaintiff's conduct was objectively unreasonable; "that Miller's counsel *subjectively* believed that this case was distinguishable does not make Miller's claim *objectively* reasonable under existing precedent." If plaintiff sought to change Ninth Circuit's views on inline-linked images, that would not have been unreasonable. Instead, plaintiff acknowledged that images were inline-linked only after defendant moved for summary judgment; plaintiff should have already known images were inline-linked when filing his complaint.

*Johnson v. Mold Sols. & Insp., LLC*, No. 21-2589, 2022 U.S. Dist. LEXIS 225428 (E.D. Pa. Dec. 13, 2022)

District court granted plaintiff's motion for attorneys' fees, but reduced amount sought. Plaintiff claimed that defendant's use of his image constituted infringement and violation of DMCA. Matter proceeded to arbitration, where plaintiff was successful on his infringement claim, and was awarded \$5,000 instead of \$15,000 sought. Plaintiff successfully moved for attorney's fees as prevailing party; however, district court reduced amount sought after evaluating reasonableness of fee request. Court concluded that rates were generally

reasonable in geographic region, based on historic rates and fee schedule established by Community Legal Services of Philadelphia. After considering rates, court determined whether counsel spent reasonable number of hours working on matter. Court determined that plaintiff's counsel expended more hours at higher rates than required, because some work billed at higher rates could have been performed by less senior attorneys. Number of hours expended appeared excessive and not consistent with exercise of sound billing judgment. There were only 26 items on docket, only few of which were filed by plaintiff, and there was no motion practice. Last, plaintiff's results were not "excellent," since he received only \$5,000 compared to \$15,000 sought. Once lodestar calculation has been reached, court may then reduce amount to account for limited success by plaintiff, focusing on "significance of the overall relief obtained by the plaintiff in relation to the hours reasonably expended on the litigation." Court thus concluded that while plaintiff's counsel was entitled to fees, fees should be reduced to one-third, amounting to \$15,520.

*Live Face on Web, LLC v. Rockford Map Gallery, LLC*, No. 17-539, 2022 U.S. Dist. LEXIS 190691 (D. Del. Oct. 19, 2022)

District court awarded defendants attorneys' fees, with one-third reduction. Plaintiff, which had filed well over 100 other similar suits against unknowing infringers that bought third-party computer code, sued defendant for unauthorized distribution of said code. Summary judgment was granted in defendants' favor on statute of limitations grounds. Plaintiff's damages claims were suspect as were its motivations, which appeared to be to extract payments rather than protect expression. Plaintiff also continued to pursue claim after it should have been clear it was brought too late. In defending, defendants filed motions to dismiss, undertook fact and expert discovery, filed four summary judgment motions and defended against plaintiff's three summary judgment motions. Court held defendants entitled to attorneys' fees but reduced award by one-third because defendants had engaged in block billing, conducted more research than apparently necessary, and expended overmuch time on discovery.

*Hebenstreit v. Merchs. Bank*, No. 18-56, 2022 U.S. Dist. LEXIS 119664 (S.D. Ind. July 6, 2022)

Richard Bell sued Merchants Bank of Indiana for copyright infringement after he saw one of his photographs on its website. Court found infringement but determined that it was innocent, and awarded minimum statutory damages of \$200. Before damages hearing, Bell's trustee in his bankruptcy proceeding, Hebenstreit, was substituted in as plaintiff. At issue was Hebenstreit's motion seeking over \$17,000 in attorneys' fees and costs. Hebenstreit argued that attorneys' fees and maximum statutory damages were appropriate, since Merchants pursued legally frivolous defenses and carelessly infringed on Bell's copyright. Court disagreed, finding that Merchants merely provided affirmative defenses in response to Mr. Bell's damages demands. Upon seeing his photo on Merchant's website, Bell demanded that Merchants pay him \$5,000. Before checking to see if Merchants took it down, Bell filed suit. Bell then increased demand to \$150,000. District court found that since Bell would not reduce or dismiss his damages claim, Merchant's had no choice but to continue litigation.

Additionally, court found that there was no evidence that Merchants intended to infringe Bell's copyright. Need for compensation and deterrence weighted against Hebenstreit. As such, court denied motion for attorneys' fees and costs.

*Ehmann v. Metropulos*, No. 19-586, 2022 U.S. Dist. LEXIS 127533 (W.D. Wis. July 19, 2022)

Court granted attorneys' fees to victorious defendants in infringement suit, but discounted them because defendants could have avoided issue by requesting written license. Plaintiffs sued defendants for infringement of copyrighted artwork, but jury found that plaintiffs had granted oral license to defendants, and therefore found no infringement. Defendants sought attorneys' fees. Seventh Circuit affords defendants who prevail against copyright claims strong presumption that they are entitled to attorneys' fees, and evidence suggested that plaintiffs' claim that separate, more limited license existed was untrue. Court reduced size of award in light of plaintiffs' *pro se* status, and defendants' failure to require written licensing contract up front.

### **C. Injunction/Impoundment**

*Suzhou Angela Online Game Tech. Co. v. Snail Games USA, Inc.*, No. 22-55137, 2022 U.S. App. LEXIS 27971 (9th Cir. Oct. 6, 2022)

Ninth Circuit affirmed denial of preliminary injunction. Defendant filed takedown notice over alleged copyright infringement and trade secrets violations in video game *Myth Empires* owned by Plaintiff. Plaintiff sought preliminary injunction to withdraw takedown notice because of financial loss from removal of video game from streaming site. Ninth Circuit held that district court did not err in denying injunctive relief, as plaintiff failed to meet burden of proof. Plaintiff argued that defendant must obtain its own preliminary injunction to keep takedown letter in effect, but court disagreed, holding that burden is on moving party to demonstrate it meets elements for preliminary injunction. Further, court held that district court did not abuse its discretion in finding that plaintiff failed to make clear showing that preliminary injunction factors were met. Defendant provided evidence of copying of source code and showed significant similarities in code. Plaintiff failed to provide contrary evidence and thus failed to show likelihood of success on merits.

*Pyrotechnics Mgmt. v. XFX Pyrotechnics LLC*, 38 F.4th 331 (3d Cir. 2022)

Court reversed grant of injunction against defendant's product because plaintiff's work, communication protocol used to control fireworks, was not copyrightable. Plaintiff developed hardware and software that controlled fireworks displays and its devices communicated with each other through proprietary protocol. Defendant competitor reverse-engineered hardware to learn communication protocol and developed its own machine that could work with plaintiff's machines. Plaintiff then filed for and received copyright registration in protocol and sued defendant, receiving injunction. District court found that plaintiff's "command codes" within communication protocol were copyrightable. Third



Circuit disagreed, finding that deposit copy submitted to Copyright Office contained instructions on how to generate digital messages and convert them to analog signals, but not actual messages themselves. Instructions, as methods of operation, are ineligible for copyright. Additionally, communication protocol at issue was utilitarian work created only for purpose of communication, as opposed to entire firework system which was created to control fireworks displays. Court further found that individual messages were insufficiently original to be copyrightable. Messages lacked even spark of creativity, as they were generated by mechanical application of communication protocol. Beyond circumstances of their generation, messages were standard communication practices lacking any creativity.

*Lee v. 162 D&Y Corp.*, No. 18-2580, 2022 U.S. Dist. LEXIS 234322  
(E.D.N.Y. Dec. 30, 2022)

Plaintiff, heir to South Korean composer Jae Ho Lee and exclusive owner in copyright in composer's songs, sued numerous karaoke room operators for infringement, alleging works available for performance through karaoke machines at defendants' businesses. Plaintiff personally visited karaoke bars and filmed himself browsing through works in catalog on karaoke machine and singing/performing certain of works. Defendants initially appeared through counsel and submitted Answer, but following withdrawal of counsel defendants' answer stricken by court. On motion for default judgment, magistrate judge found defendants infringed performance rights (by playing songs through karaoke machines) and distribution rights (by offering songs for performance through karaoke machines). Plaintiff sought permanent injunction, and also requested impoundment of karaoke machines if defendants did not pay court-ordered damages. Magistrate judge recommended granting of injunction, finding that actual damages were unmeasurable and balance of hardships favored plaintiff, particularly when defendants operated karaoke machines which "have the ability to delete or restore all songs." However, magistrate did not recommend seizure of machines, particularly because request was not calculated to ensure against future infringement, but rather "as a means of enforcing payment of damages." However, magistrate recommended that should any defendant fail to comply with court's order, plaintiff should be permitted to make request for further remedies, including seizure of karaoke machines.

*Bayam Grp., Inc. v. Id Tech, LLC*, No. 22-8910, 2022 U.S. Dist. LEXIS  
206529 (S.D.N.Y. Nov. 10, 2022)

District court crafted narrow injunction to discourage defendant from continuing its campaign of filing fraudulent DMCA notices against plaintiff. Plaintiff and defendant were similar New York online jewelry businesses. Defendant believed that plaintiff was copying its website and jewelry photographs, and filed two separate lawsuits alleging various copyright and trademark claims. Defendant also issued DMCA takedown notices to Shopify, plaintiff's website host, that caused Shopify to take down plaintiff's site. Plaintiff filed this separate lawsuit with claims for harms to its business by alleged harassment campaign by defendant. Defendant then voluntarily withdrew one suit, admitting that its copyright registrations did not cover material at issue. Court noted that defendant's counsel violated Fed. R. Civ. P. 11 by failing to look at what was on file with Copyright Office before filing

suit. Plaintiff sought preliminary injunction in this case to prevent defendant from filing further DMCA notices. Court was uncomfortable issuing injunction against future filings that may be meritorious, but ordered defendant's counsel to represent to court that for duration of this suit, they would not file DMCA notices relating to products covered by this suit or other remaining suit.

*Santos Elecs., Inc. v. Outlaw Audio, LLC*, No. 22-827, 2022 U.S. Dist. LEXIS 224798 (C.D. Cal. Dec. 12, 2022)

Plaintiff moved for preliminary injunction to stop defendant from selling products containing user manuals for multichannel amplifiers, which allegedly infringed plaintiff's copyright. Upon hearing oral arguments, court denied plaintiff's motion. Defendant disputed plaintiff's ownership of copyrighted material. Plaintiff provided copyright registration for manual dated May 18, 2022. However, certificate listed publication date as January 23, 2015. Accordingly, plaintiff was not entitled to presumption that its copyright was valid, because user manual was registered more than five years after publication. Burden fell on plaintiff to establish ownership, which plaintiff had done here. While defendant argued that user manual was not subject to copyright protection because it was utilitarian, court disagreed, even if only thin copyright protection applied. Plaintiff met burden by providing evidence of exact copying. On question of irreparable harm, plaintiff fails to meet burden of showing continuing and present adverse effects. Defendant had stopped using infringing user manual and created updated versions. Plaintiff argued that it had not confirmed that all infringing material was removed, but failed to point to infringing material in updated user manuals. Plaintiff's five-year delay in filing for preliminary injunction further demonstrated lack of irreparable harm.

*Sysco Mach. Corp. v. Cymtek Sols., Inc.*, No. 22-11806, 2022 U.S. Dist. LEXIS 228448 (D. Mass. Dec. 20, 2022)

District court denied plaintiff's request for preliminary injunction, finding plaintiff failed to establish likelihood of success on copyright claims. Parties were both Taiwanese entities; plaintiff alleged several of its employees stole trade secrets in order to form new entity. Among several allegations in its complaint, plaintiff alleged violation of copyright law. Specifically, plaintiff claimed it held copyrights in various technical drawings delineating layouts of parts forming portions of large machinery. Plaintiff contended that defendant used copyrighted works to manufacture its version of plaintiff's machine, thereby violating its copyrights in drawings by manufacturing derivative work "embodying" copyright. "For this novel proposition, [plaintiff] offers no direct legal authority applying copyright law in this manner." District court did not find plaintiff's arguments grounded in copyright law and found additional support for its position in Sixth Circuit precedent holding that copyright protection does not extend to use of technical drawings to create useful article described in drawings. Accordingly, plaintiff failed to meet its burden to establish likelihood of success.

*Tecnoglass, LLC v. Paredes*, No. 22-22356, 2022 U.S. Dist. LEXIS 233784 (S.D. Fla. Dec. 30, 2022)

District court granted preliminary injunction because plaintiff was likely to succeed in showing that defendants infringed its copyrighted works by incorporating material in plaintiff's public filings. Plaintiff, window and glass door manufacturer, registered copyrights in technical drawings for sliding glass doors and window walls. Plaintiff sued defendants, also window and door companies, seeking to, *inter alia*, enjoin defendants from using plaintiff's intellectual property. Court held that evidence supporting finding that plaintiff owned technical drawings, which were incorporated into asserted copyright registrations. Plaintiff sufficiently showed that defendants had access to plaintiff's technical drawings through plaintiff's publicly-available municipal filings, which supported inference of access where defendants' works were striking similar to plaintiff's. Because plaintiff had made showing of irreparable harm based on defendants' prior unauthorized use of other of plaintiff's works, and showing that public interest was served by preventing misleading conduct, court granted preliminary injunction.

*Desirous Parties Unlimited Inc. v. Right Connection Inc.*, No. 21-1838, 2022 U.S. Dist. LEXIS 162000 (D. Nev. Sept. 7, 2022)

District court granted plaintiff's motion for preliminary injunction. Plaintiff, company that organized adult oriented entertainment, entered into oral agreement with defendant to organize events together using name "Dirty Vibes." When defendant learned that plaintiff had filed trademark application for "Dirty Vibes," defendant terminated relationship and set up competing website and social media accounts using similar photographs and branding. Plaintiff sent cease-and-desist letters and brought suit alleging that defendant had copied its protected photographs. District court found that plaintiff was owner of valid copyright and that copying was highly likely due to similarity between sites and photos. District court found that plaintiff demonstrated irreparable harm in providing evidence of consumers who had mistakenly booked events through defendant when looking for plaintiff, thereby threatening plaintiff's goodwill. Although court agreed that both parties would suffer some loss due to issuance of injunction, court found that preliminary injunction was appropriate due to public policy of mitigating consumer confusion and plaintiff's strong showing of likelihood of success on merits.

*Wright v. Snider*, No. 22-347, 2022 U.S. Dist. LEXIS 222103 (W.D. Wis. Dec. 9, 2022)

District court denied plaintiff's motion for preliminary injunction. Plaintiff "wildlife artist specializing in detailed illustrations of animals and nature scenes" sued operator of fishing campsite and logo design company for creating allegedly infringing "illustration of a walleye fish pursuing a green and yellow lure" and displaying logo at campsite and on internet. District court first considered whether plaintiff would suffer irreparable harm without injunction. Noting that plaintiff's business was "licensing his artwork," district court found that only harm plaintiff would suffer was lack of monetary compensation for defendant's use

of artwork. Since this harm can be remedied through award of damages, court found no irreparable harm. Having found no irreparable harm and that monetary damages would be adequate remedy for infringement, district court did not reach issue of whether plaintiff had likelihood of success on merits and denied motion for preliminary injunction.

## VIII. PREEMPTION

*Greer v. Fox News Media*, No. 22-1970, 2023 U.S. App. LEXIS 7407 (2d Cir. Mar. 29, 2023)

Second Circuit upheld district court's determination that plaintiff's unfair competition and unjust enrichment claims were preempted. Plaintiff argued that, because works at issue were unprotectable ideas from blogs and emails rather than books, they fell outside copyright law. Second Circuit upheld District Court's ruling, explaining that copyright law protects ideas expressed in *any* tangible medium, including blogs and emails. Because ideas that were subject of claim were fixed in writing, they fell under copyright law for preemption purposes.

*Melendez v. Sirius XM Radio, Inc.*, 50 F.4th 294 (2d Cir. 2022)

Second Circuit affirmed judgment of district court. Plaintiff performed under name "Stuttering John" and appeared on *The Howard Stern Show* ("HS Show") for approximately 15 years. After plaintiff left HS Show, defendant Sirius XM licensed current and newly released episodes from HS Show, as well as archival episodes in which plaintiff appeared. Defendant used excerpts from such shows to advertise and promote HS show, and plaintiff claimed such use violated his right of publicity under California common and statutory law. Defendant moved to dismiss on grounds that right of publicity claims were preempted by Act, and district court granted motion. On appeal, Second Circuit applied two-prong preemption test. On subject matter prong, court held that plaintiff's right of publicity claims came within copyright's subject matter: recordings were original sound recordings, and plaintiff's claims were predicated on defendant's use of works themselves. Court rejected plaintiff's claim that he was trying to control his identity rather than underlying works, because plaintiff did not allege defendant used his name or likeness in any way beyond airing archival episodes that featured plaintiff or used his identity to sell goods or services unconnected to plaintiff. Fact that defendant aired such episodes on channels that did not air HS Show did not change court's analysis. On general scope prong, court held that while right of publicity under California law does contain extra element – commercial purpose – such purpose does not negate equivalency to rights under Act, as focus of inquiry is on nature of state claim. Because plaintiff's claims sought to stop reproduction of works embodying his identity and not use of identity to sell unrelated goods, claims were sufficiently equivalent to rights protected under Act. Court affirmed dismissal and denial of leave to amend.

*Reilly v. Wozniak*, Nos. 21-16140, 21-17047, 2023 U.S. App. LEXIS 505 (9th Cir. Jan. 10, 2023)

Ninth Circuit affirmed district court's holding that plaintiff's state law claim was preempted. Plaintiff professor sued defendants, including Apple co-founder Steve Wozniak, for developing online university that allegedly infringed rights in similar concept previously discussed by plaintiff and Wozniak. Plaintiff asserted, *inter alia*, California state law claim for money had and received by defendants from their use of plaintiff's ideas, designs, business plans and related educational concepts. Ninth Circuit held that district court correctly determined that plaintiff's claim could rest only on his contention that defendants improperly made use of tangible materials that embodied his ideas. Because such claim did not assert rights qualitatively different from those under copyright, it was preempted.

*JBrick, LLC v. Chazak Kinder, Inc.*, No. 21-2883, 2022 U.S. Dist. LEXIS 212810 (E.D.N.Y. Nov. 23, 2022)

District court granted defendants' motion to dismiss unfair competition claims as preempted. Plaintiff toy company created custom, Jewish-themed LEGO set depicting Second Holy Temple, which was accompanied by educational materials. Defendants allegedly used façade of joint venture with plaintiff to learn key details about production of set before terminating communications with plaintiff, then producing and selling substantially similar set at fraction of plaintiff's price. Plaintiff sued for copyright infringement, then amended complaint to add state law unjust enrichment claim, which defendants moved to dismiss. Because plaintiff's unjust enrichment claim was grounded solely in defendants' copying of plaintiff's protected expression, without extra element beyond copying itself, it was preempted. Even if defendants' conduct was deceptive or fraudulent, this would alter scope rather than nature of plaintiff's unfair competition claim.

*Red Apple Media, Inc. v. Batchelor*, No. 22-7547, 2022 U.S. Dist. LEXIS 193620 (S.D.N.Y. Oct. 24, 2022)

Court denied motion to remand to state court where claims arose under and were preempted by Act. Plaintiff claimed to own exclusive rights to podcast hosted by defendant, and when host and other defendants copied and broadcast show after podcast was discontinued by plaintiff, plaintiff brought state law claims including breach of contract, unjust enrichment, conversion, and common law copyright. Defendants removed case to federal court, and plaintiff filed motion to remand. Court found that because plaintiff's alleged ownership of podcast recordings was governed by copyright law, and because claims were based on defendants' alleged unauthorized copying of those copyrighted works, claims were preempted. Plaintiff alternatively argued that certain claims based in state law should be remanded, but court found that removal of entire case was proper because all claims involved same common core of facts.

*Greer v. Fox Corp.*, No. 20-5484, 2022 U.S. Dist. LEXIS 161617 (S.D.N.Y. Sept. 7, 2022)

District court adopted magistrate judge's report and recommendation on defendant's motion to dismiss. Plaintiff medical doctor and writer appeared as guest speaker on defendant Fox News' various programs. Plaintiff brought copyright and various state law claims based on defendants' allegedly improper copying or misappropriation of ideas contained in plaintiff's works. Magistrate judge concluded that plaintiff's four state law claims were preempted by Act; plaintiff objected because (1) he had no copyright registration; (2) mere ideas are not copyrightable; (3) implied-in-fact contract existed between him and defendant. Court held that plaintiff's first point failed as scope of copyright for preemption purposes extended beyond scope available for copyright protection. On plaintiff's second point, court held that Second Circuit precedent rejects this type of "partial preemption" notion that preemption should only apply to claims based on misappropriation of tangible mediums of expression such as books or recordings. Finally, court held that plaintiff's third point failed because he failed to articulate how his history of passing on news tips and ideas to Fox reporters created implied in fact contract that would relate to copyright preemption. Court overruled plaintiff's objections and granted motion to dismiss.

*Hines v. Warner Chappell Music Corp.*, No. 20-3535, 2022 U.S. Dist. LEXIS 151760 (S.D.N.Y. Aug. 23, 2022)

District court held plaintiff's state law unjust enrichment claim preempted. Plaintiff sued, *inter alia*, Jay-Z, Timbaland and Ginuwine, alleging that they infringed his copyright in his 1960s song by incorporating elements thereof into two hip-hop songs. In his third amended complaint, plaintiff for first time asserted state law unjust enrichment claim. Court granted defendants' motion to dismiss unjust enrichment claim as preempted. Unjust enrichment claim based solely on defendants' alleged use of protectable elements of plaintiff's song without authorization, with no allegations that defendants enriched by anything other than such unauthorized use. Because there was no basis for unjust enrichment claim independent of copyright infringement acts, claim was preempted. Plaintiff could not overcome preemptive scope of Act by pleading unjust enrichment in alternative.

*Hanagami v. Epic Games Inc.*, No. 22-2063, 2022 U.S. Dist. LEXIS 161823 (C.D. Cal. Aug. 24, 2022)

District court dismissed plaintiff's California Unfair Competition claim, finding claim preempted. Plaintiff choreographer sued defendant, publisher of popular video game *Fortnite*, for infringement and for unfair competition. Plaintiff alleged that defendant offered within *Fortnite* "emote" feature (consisting of animated movements and dances) which plaintiff contended contained exact copies of certain steps in defendant's copyrighted choreographic work, and that defendant's use of plaintiff's registered copyright "created a 'false impression' that plaintiff endorsed *Fortnite*." After noting that "subject matter" of state-law claim was clearly within subject matter of copyright, district court considered whether unfair competition claim involved "extra element" which would change nature of

action. District court rejected plaintiff's contention that defendant's use of his dance steps would create false impression that he endorsed *Fortnite*, finding argument insufficient to render unfair competition claim different than copyright infringement. Motion to dismiss unfair competition claim granted.

*Am. Airlines, Inc. v. Red Ventures LLC*, No. 22-44, 2022 U.S. Dist. LEXIS 125428 (N.D. Tex. July 15, 2022)

District court dismissed unfair competition claim as preempted. Plaintiff American Airlines entered into discussions with The Points Guy (TPG) regarding sharing of frequent flyer customer data for potential TPG app designed to help users maximize benefits of various airline rewards programs; discussions, however, ultimately did not produce partnership. American later sued TPG and other related defendants, alleging *inter alia* that TPG incorporated American's proprietary frequent flyer data and intellectual property into TPG app, in violation of Texas law against unfair competition by misappropriation. On motion to dismiss, TPG argued that copyright law preempted unfair competition claim. American argued its claim was based on defendants' unauthorized access of American's systems to misappropriate American's relationships with its customers. District court evaluated preemption question under two-prong test: (1) whether state claim falls within subject matter of copyright; and (2) whether state cause of action protects rights that are equivalent to any exclusive rights of federal copyright. Under first prong, district court concluded that substance of American's claim fell within subject matter of Act: American had alleged that defendants copied proprietary data from American's proprietary website, and American's platform and systems were analogous to software, which is tangible medium under Act. Under second prong, district court observed that Fifth Circuit had thrice held that Texas's unfair competition law protected same or equivalent rights as copyright law. With both elements of test satisfied, district court held unfair competition claim was preempted.

*Wicked Grips, LLC v. Badaan*, No. 21-2131, 2022 U.S. Dist. LEXIS 111022 (M.D. Fla. June 22, 2022)

Plaintiff, company that "designs and manufactures handgun grips and accessories" incorporating "unique artwork" designs. sued for infringement and common law and Florida unfair competition claims, alleging defendants "fabricated exact likenesses" of its grip designs. Plaintiff alleged that certain designs were copied from its grips, and others were copied from its website. Defendant moved to dismiss unfair competition claims as preempted. Applying Eleventh Circuit precedent, district court considered whether unfair competition claims require "extra element" sufficient to render action "qualitatively different from" infringement claim. Noting that Florida unfair competition claim requires allegations of "deceptive or fraudulent conduct" which "goes to the question of marketing" rather than question of "copying in the manufacture of a product," district court found that plaintiff's claims did not allege deceptive act "other than the copying and selling of" plaintiff's grip designs. Having alleged no "extra element" or other conduct beyond infringement, unfair competition claims dismissed as preempted.

*Brand Design Co. v. Rite Aid Corp.*, No. 22-1174, 2022 U.S. Dist. LEXIS 153783 (E.D. Pa. Aug. 26, 2022)

Plaintiff created design font *Neutraface*, which it licensed to third parties. Defendants used *Neutraface* first without license and then in violation of licenses purchased from plaintiff. Defendants moved to dismiss complaint on preemption grounds. While unjust enrichment claims based on Act are routinely preempted, here court found that they were not because *Neutraface* was typeface, and typeface alone is not subject to copyright protection, thus failing to satisfy second prong of preemption test. Court held additional state law claims of breach of contract and unfair competition were additionally not preempted by Act.

*Wilson v. Ancestry.com LLC*, No. 22-861, 2023 U.S. Dist. LEXIS 16607 (S.D. Ohio Jan. 31, 2023)

District court denied defendant's motion to dismiss class action complaint. Plaintiff alleged defendant used his name and persona to promote paid subscriptions to website without consent. Defendant asserted affirmative defense that Act preempted plaintiff's right of publicity claims. Court found no merit to argument because plaintiff's right of publicity claims did not satisfy subject matter requirement. Defendant argued claims fell within subject matter of copyright because claims arose solely from defendant's distribution and display of copyrighted yearbook. However, court found inconsistent with plaintiff's complaint because complaint made clear that alleged unlawful conduct was use of plaintiff's name and likeness in advertisements promoting paid subscriptions. Court found such use did not fall within subject matter of Copyright Act. Defendant did not simply offer database of photos that customers may download solely for personal use. Instead, defendant used plaintiff's name and likeness to promote its products and services. As complaint alleged, defendant used plaintiff's persona to defendant's commercial advantage, rather than simply reproducing and distributing yearbook photographs, court held plaintiff's claims not preempted.

*Cheairs v. Thomas*, No. 20-2494, 2023 U.S. Dist. LEXIS 16988 (W.D. Tenn. Feb. 1, 2023)

Plaintiff brought infringement and VARA claims, and state law claims for violations of Tennessee Consumer Protection Act, tortious interference with prospective business relationships, common law conspiracy, unjust enrichment and libel, against defendants. Defendants moved for summary judgment that state law claims were preempted. Copyright claim revolved around infringement and forgery of artworks. Defendants argued that all of state law claims sought to vindicate legal and equitable rights that are equivalent to one or more of exclusive rights protected by Act. Court found plaintiff's state law claims failed to allege elements qualitatively different from Act rights of reproduction, distribution, display, and attribution. Defendants argued that state law claims fell squarely within scope of materials protected by Act, as alleged forgeries involved art in fixed medium. Plaintiff argued that state law claims arose from defendant's use of inferior physical materials, which damaged her reputation as artist. Court disagreed; matter was fundamentally about



unauthorized reproduction and distribution of plaintiff's work. State law claims accordingly dismissed.

*Ass'n of Am. Publishers, Inc. v. Frosh*, 607 F. Supp. 3d 614 (D. Md. 2022)

Plaintiff sought to enjoin enforcement of recently enacted Maryland statute that required publishers to offer to license their e-books and audiobooks to Maryland public libraries on reasonable terms. Plaintiff argued statute was expressly preempted by and conflicts with Act, and sought declaration that statute was invalid and preempted by Act, and preliminary and permanent injunctions enjoining State from enforcing it. Court granted preliminary injunction on February 16, 2022. Court found statute was likely preempted by Copyright Act because it forced publishers to forgo their exclusive rights to decide when, to whom, and on what terms to distribute their copyrighted works. Court then issued Show Cause Order asking State why permanent injunction should not be issued. State argued that permanent injunction was unnecessary as State had not and would not enforce statute. Plaintiff argued for permanent injunction. Court agreed with State, and issued order declaring statute unconstitutional and unenforceable, which obviated need for permanent injunction, as State would abide by court's declaration.

## **IX. DIGITAL MILLENNIUM COPYRIGHT ACT**

*Kinsley v. Udey, Inc.*, No. 21-15787, 2022 U.S. App. LEXIS 29023 (9th Cir. Oct. 19, 2022)

Ninth Circuit affirmed district court's grant of summary judgment, holding that defendant Udey, Inc. satisfied all of requirements under DMCA safe harbor provision. Plaintiff Harrison Snow Kinsley had alleged that defendant did not immediately ban users that uploaded plaintiff's courses to defendant's platform. However, factual record demonstrated that defendant maintained internal and public policies regarding repeat infringers, and it banned users who posted plaintiff's courses to defendant's platform. Moreover, defendant acted within three days or less after receiving DMCA takedown notices from plaintiff, and no evidence in record indicated that defendant had prior knowledge of infringement.

*Green v. United States DOJ*, 54 F.4th 738 (D.C. Cir. 2022)

Plaintiff Green, professor and researcher, planned to publish book "to instruct readers in the methods of security research," which would include examples of code that can bypass security measures. Green was concerned that circumvention instructions would violate DMCA. Plaintiff Huang was inventor and engineer who wanted to create and sell "NeTVCR," which contained code that can circumvent technological measure that prevents content from being copied or displayed on certain devices. Huang also wished to publish code that would tell others how his technology works and would encourage them to improve code. Huang was concerned that distribution of code and NeTVCR would violate § 1201(a)(1) or (a)(2) of DMCA. Green and Huang brought pre-enforcement action, challenging DMCA on facial and as-applied First Amendment grounds. District court

granted motion to dismiss all but as-applied claims, and plaintiffs later moved for preliminary injunction. District court denied motion, finding as to Green's as-applied challenge that publication would not likely implicate § 1201(a) because book would be used for educational rather than circumvention purposes. As to Huang, court also denied motion for preliminary injunction because he was unlikely to succeed on merits of claims. Plaintiffs appealed and D.C. Circuit affirmed. As to Green's challenge, court found Green lacked standing because, although Green believed publication of book would violate DMCA's antitrafficking provision, government agreed at oral argument that publication would not violate DMCA, so Green lacked "credible threat of prosecution." As to Huang, court analyzed as-applied challenge by applying three-factor test: first, determining whether activity is First Amendment-protected speech; second, determining whether regulation is content based or content neutral; and third, applying correct level of scrutiny based on outcome of second factor. Here, on first factor, court found code was expressive speech. On second factor, court found anticircumvention and antitrafficking provisions did not target expressive part of code, even if they "incidentally ma[d]e it more difficult to express things with computer code if that code also facilitates circumvention, [because] that expressive activity is not the statute's target." Because court found DMCA was content neutral, it applied intermediate scrutiny and found statute to be appropriately tailored to government's interest in combating piracy. Finding that Huang was not likely to succeed on merits, court affirmed denial of motion for preliminary injunction.

*Victor Elias Photography, LLC v. ICE Portal, Inc.*, 43 F.4th 1313 (11th Cir. 2022)

Eleventh Circuit affirmed district court's grant of summary judgment to defendant where plaintiff failed to establish essential element of DMCA claim. Between 2013 and 2017, plaintiff commercial photographer took photographs of hotels, then granted broad licenses to subject hotels allowing them to use, without quantity or time limitations, photographs to promote their properties both on own websites and through online travel agents (OTAs) such as Expedia or Travelocity. Plaintiff's photographs, when sent to hotels and used on their websites, contained embedded metadata that included plaintiff's name and image title, which constituted copyright management information. Plaintiff used this CMI to patrol internet and identify infringement. Defendant served as intermediary between hotels and OTAs by downloading images sent by hotels to defendant's server and converting images to JPEG format, during which CMI was sometimes lost. Plaintiff discovered unauthorized copies of his photographs, without CMI, posted on non-party, non-OTA websites; he subsequently realized that CMI was also stripped out of photographs on OTA websites. Plaintiff sued defendant under § 1202(b) of DMCA, which requires double scienter, namely, that defendant removing CMI (or distributing images with wrongfully removed CMI) had, first, actual knowledge that CMI had been removed and, second, actual or constructive knowledge that such removal or distribution will induce, enable, facilitate or conceal infringement. Plaintiff claimed that second scienter requirement was met because defendant was previously involved in arbitration where third-party competitor alleged defendant had wrongfully accessed competitor's image database, knowingly removed CMI and republished images for defendant's commercial gain. Plaintiff further alleged second scienter requirement was

satisfied because plaintiff used CMI to police infringement and that defendant's modus operandi was to remove CMI knowing that this would result in infringement. Eleventh Circuit held that arbitration's fact pattern was insufficient to put defendant on notice that defendant's mere role as intermediary image optimizer could induce or enable third-party infringement. Moreover, there was no evidence that defendant knew that copyright owners used CMI to police infringement or even that defendant's removal of CMI was linked to specific infringements uncovered by plaintiff.

*Bus. Casual Holdings, LLC v. YouTube, LLC*, No. 21-3610, 2022 U.S. Dist. LEXIS 212212 (S.D.N.Y. Nov. 22, 2022)

Court rejected copyright infringement claims against YouTube, finding that when YouTube timely removes infringing videos, it is not obligated to also terminate infringer's account. Plaintiff uploaded videos for which it owned copyright registrations to YouTube. YouTube purported to have three-strike DMCA policy under which it bans users who have three videos removed under DMCA. Plaintiff alleged that YouTube failed to apply its three-strike policy against alleged third-party infringer after plaintiff filed DMCA notices, and asserted that YouTube was therefore directly, contributorily, and vicariously liable for infringement. Court found that YouTube did not engage in volitional conduct that caused infringement when it timely blocked all three videos complained about by plaintiff. Failure to terminate third party's entire channel afterward was not act that had anything to do with three videos being uploaded in first place. Neither was YouTube liable for contributory infringement, as there was no allegation that YouTube knew of alleged infringement before DMCA notices were filed, and YouTube's removal of videos was not action in concert with or contributing to alleged infringement. Neither was YouTube liable for vicarious infringement, as it did not decline to exercise its right to stop infringement. Court dismissed motion to amend complaint, as plaintiff alleged no new volitional conduct by YouTube, and made no new allegations of YouTube's knowledge of infringement prior to DMCA notices or YouTube's failure to stop infringement. Plaintiff was attempting to assert independent cause of action under DMCA's repeat infringer provision, but such claim does not exist. DMCA is safe harbor, and YouTube met requirements to be within safe harbor.

*Harrington v. Pinterest, Inc.*, No. 20-5290, 2022 U.S. Dist. LEXIS 168788 (N.D. Cal. Sept. 19, 2022)

District court granted defendant's motion to dismiss plaintiff's claims for copyright infringement and violation of Digital Millennium Copyright Act (DMCA). Plaintiff, professional travel photographer, brought suit alleging that defendant Pinterest displayed his copyrighted photos without his consent and stripped of their copyright management information (CMI). Plaintiff contended that Pinterest knowingly removed CMI to make its paid advertisements more effective and to conceal its own infringement of copyrighted images on its website and mobile application. Pinterest contended that DMCA claim should be dismissed because plaintiff failed to allege facts to establish first and second scienter requirements under DMCA. As to first scienter requirements, court determined that plaintiff failed to allege sufficient facts that Pinterest intentionally removed CMI, or had actual

knowledge that CMI was removed, from plaintiff's photographs, as complaint did not allege that Pinterest was even aware that plaintiff's works carried CMI at time they were uploaded to Pinterest's platform. As to second scienter requirement, court determined that complaint lacked sufficient factual basis to infer Pinterest knew or had reasonable basis to know that removal or alteration of CMI or distribution of plaintiff's works with CMI removed would aid infringement, because plaintiff failed to allege facts that Pinterest knew about his use of CMI to identify and enforce his copyrights. Court found that plaintiff's allegations as to Pinterest's (a) motivation to render its paid advertisements more effective by removing indications of copyright ownership; (b) change in metadata removal practices by resuming its preservation of metadata after two-year period in 2021; and (c) response in discovery dispute in different action, did not overcome plaintiff's pleading deficiencies. Court found Pinterest's argument that its display of visible CMI on its website refuted any inference of unlawful scienter to be well-supported by case law, finding that fact that thumbnail images on defendant's site link to full-sized version of images where visible CMI is shown, and then link users to original source of image where CMI is again available, demonstrated that defendant did not have reason to know it would cause users to infringe defendant's copyrights.

*Bungie, Inc. v. Aimjunkies.com*, No. 21-811, 2022 U.S. Dist. LEXIS 205282 (W.D. Wash. Nov. 10, 2022)

District court dismissed defendants' counterclaims. Plaintiff, creator and seller of videogames, brought action to prevent defendants from distributing cheat software relating to videogame. Defendants brought counterclaims for violation of anti-circumvention provision of DMCA. Defendants claimed plaintiff accessed defendants' computer and obtained information from personal files without knowledge or authorization. Defendants contended plaintiff bypassed, removed, deactivated, and/or impaired technological measures. Court found defendants did not allege plaintiff accessed any copyrighted work. Defendants only alleged plaintiff accessed files without addressing whether files were protected under Act. Court held defendants must allege additional factual content in order to state claim under DMCA's anti-circumvention provision.

*Logan v. Meta Platforms, Inc.*, No. 22-1847, 2022 U.S. Dist. LEXIS 194431 (N.D. Cal. Oct. 25, 2022)

Plaintiff filed class action against defendant Meta, claiming infringement of photographs as result of Facebook's embedding tool. Defendant moved to dismiss. Plaintiff alleged that Facebook's embedding tool itself was direct infringement of plaintiff's photographs and that embedding tool allowed third parties to infringe, making defendant liable under theory of secondary liability. Court found that plaintiff failed to meet threshold requirement for direct infringement claim by failing to allege copyright registration for infringed photographs. Regarding secondary liability, defendant argued that complaint failed to plead infringement by third parties. Court found that complaint failed to sufficiently plead facts supporting Ninth Circuit "server test" under *Perfect 10, Inc. v. Amazon.com, Inc.* Complaint included no allegation that third parties stored photographs, and without fixing copyrighted work in

tangible medium of expression, there was no underlying infringement and therefore no secondary liability. Lastly, plaintiff claimed that defendant removed his CMI from photographs and replaced it with false CMI, thus violating DMCA. Plaintiff's alleged false CMI was generic copyright tag displayed at bottom of all Facebook pages. Court found that copyright tag was not CMI, because it was not "conveyed in connection with" works. Court also disagreed with plaintiff's contention that by embedding photographs defendant intentionally removed CMI, finding that embedding itself cannot meet knowledge requirement required under DMCA. Court granted motion to dismiss with leave to amend.

*Bodyguard Prods. v. RCN Telecom Servs., LLC*, No. 21-15310, 2022 U.S. Dist. LEXIS 185965 (D.N.J. Oct. 11, 2022)

District court denied motion to dismiss plaintiffs' claims of contributory and vicarious infringement, finding plaintiff had properly pleaded such claims. Owners of motion pictures sued internet service provider defendants (ISPs), alleging that ISPs were liable for their subscribers' use of peer-to-peer file-sharing protocol BitTorrent to download plaintiffs' films, in violation of Act and DMCA. After concluding that plaintiffs plausibly pleaded direct infringement by ISPs' subscribers, and concluding that plaintiffs properly pleaded contributory and vicarious liability under Act against ISPs, district court turned to question of secondary liability under DMCA. Defendants first argued that DMCA does not allow for secondary liability; district court disagreed, noting that Sixth Circuit case law and legislative history of DMCA lead to conclusion that DMCA allows for secondary liability. Defendants further argued that plaintiffs failed to allege direct liability, and therefore secondary liability was not plausibly pleaded. District court again disagreed, finding that plaintiffs adequately pleaded that ISPs' subscribers (1) altered titles of plaintiffs' works when engaging in peer-to-peer sharing and (2) were aware they were accessing illegal copies of works at issue with altered copyright management information. District court also found that plaintiffs had properly pleaded double scienter requirement regarding defendants' subscribers; i.e., that ISPs' subscribers knowingly provided false copyright information and did so with intent to induce, enable, facilitate, or conceal infringement. Turning to question of secondary liability itself, court held that plaintiffs adequately pleaded ISPs materially contributed to DMCA violations by failing to terminate services to subscribers after receiving notices of infringement, and adequately pleaded that ISPs profited from such infringement by failing to terminate their subscribers.

*Yout, LLC v. Recording Indus. Ass'n of Am., Inc.*, No. 20-1602, 2022 U.S. Dist. LEXIS 178462 (D. Conn. Sept. 30, 2022)

District court granted motion to dismiss DMCA claims. Plaintiff Yout created and operated service by which user could create personal copy of internet content. For example, Yout user could download copy of YouTube video. Defendant RIAA sent takedown notices to Google under DMCA, alleging that plaintiff's software allowed for circumvention of YouTube's technological protection measures. Plaintiff filed complaint seeking, *inter alia*, declaratory judgment that plaintiff's software did not violate § 1201, and alleging that RIAA had violated § 512(f) of DMCA by knowingly misrepresenting that plaintiff's software

circumvented Google's technological protection measures. District court concluded that plaintiff failed to plausibly plead that YouTube lacked or had ineffective technology measures; that plaintiff did not circumvent such measures; and that plaintiff had not violated § 1201. Plaintiff's allegations regarding complex steps needed to download video file on YouTube led district court to hold that YouTube did employ technological protection measures, and that plaintiff admitted in allegations that it avoided or bypassed technological measure of YouTube. Court criticized Yout's assertions that YouTube had already provided authority to public to access downloads of content and that some content creators encourage use of Yout; district court noted that someone who buys copy of film on DVD does not have authority of copyright owner to access digital files therein. Yout's declaratory judgment claim regarding § 1201 was accordingly dismissed. Regarding § 512(f), and taking plaintiff's allegations as true for purposes of motion to dismiss, district court concluded that RIAA's takedown notices to Google failed to allege any copyrighted works that were infringed; notices were thus incapable of being misrepresentations under § 512. District court further found no basis in statute for plaintiff's additional argument that RIAA's notices constituted allegation of secondary copyright infringement. Finally, court held that plaintiff failed to allege any facts that RIAA knowingly misrepresented nature of Yout's service. Court thus dismissed plaintiff's DMCA claims.

*Steinmetz v. Shutterstock, Inc.*, No. 21-7100, 2022 U.S. Dist. LEXIS 169110 (S.D.N.Y. Sept. 19, 2022)

District court granted defendant's motion for summary judgment. Plaintiff photographer brought suit against defendant Shutterstock for direct and contributory infringement and false CMI under § 1202. On defendant's platform, third party contributors can upload images to make them available for licensing. Third party uploaded cropped version of plaintiff's work without plaintiff's consent. Parties cross-moved for summary judgment and court determined (1) whether defendant qualified for safe harbor under § 512; and (2) whether plaintiff set forth *prima facie* claim under § 1202(a). As to defendant's safe harbor status, court found that defendant qualified under safe harbor because (a) defendant qualified as "service provider" under DMCA, despite fact that plaintiff licensed photos to others, based on weight of case law and because defendant's actions were largely passive; (b) defendant had repeat infringer policy set forth in its terms of service; (c) there was no evidence defendant interfered with standard technical measures; (d) defendant stored images at direction of contributors; (e) defendant acted expeditiously to remove infringing works once it became aware of them; (f) defendant had no right to control contributors' infringing conduct; and (d) defendant had DMCA agent and process for responding to submitted takedowns. As to plaintiff's false CMI claim under § 1202(a), court held that (i) defendant's use of watermark did not constitute false CMI, and (ii) plaintiff could not establish double scienier. Court granted defendant's motion for summary judgment.

*Kipp Flores Architects, LLC v. AMH Creekside Dev., LLC*, No. 21-1158, 2022 U.S. Dist. LEXIS 142279 (W.D. Tex. Aug. 9, 2022)

District court granted defendant's motion to dismiss plaintiff's DMCA claim. Plaintiff architectural firm brought suit against real estate developers for copyright infringement and removal or alteration of CMI under DMCA. Plaintiff and defendant entered into licensing agreement for use of plaintiff's copyrighted architectural works in Austin, TX market. Defendant received copies of works from plaintiff electronically and they each contained copyright notice. As part of developments, defendant hired third parties to create stylized floorplans or renderings for marketing purposes. Third parties received plaintiffs' works after executing license agreements, preventing them from removing plaintiff's CMI, but floorplans and renderings created by third parties did not include plaintiff's CMI. Plaintiff additionally alleged that defendant's employees created drawings and renderings based on works, which did not include plaintiff's CMI. Defendants moved to dismiss DMCA claim on basis that plaintiff did not allege that its CMI was "removed or altered" from works. Defendants argued that plaintiff sent third parties files of works with CMI. Based on receipt of plaintiff's files, third parties created floorplans and renderings and did not add plaintiff's CMI. Court held that "[r]emoval' of CMI from a copyrighted work is not the same as the failure to add CMI to a nonidentical rendition or a derivative of the protected work." Court dismissed plaintiff's DMCA claim.

*Shork Grp., Inc. v. Choice! Energy Servs., Retail, LP*, No. 20-6507, 2022 U.S. Dist. LEXIS 130167 (E.D. Pa. July 21, 2022)

District court dismissed claim for circumvention of copyright protection systems, finding plaintiff's password protection was insufficient to support claim. Plaintiff provided price range forecasting and market analysis for energy industry in newsletter. Terms and conditions of subscription did not permit copying of contents of newsletter for any reason. Defendants subscribed, accumulated contents of newsletter over years, and distributed it on website as their own work. Court dismissed plaintiff's § 1201 claim for circumvention of copyright protection systems, finding that defendants had lawfully gained access to material they ultimately copied, and no technological measures as defined by statute were taken by plaintiff that defendants circumvented. Putting material behind password was not DRM sufficient to create claim under statute.

*Oppenheimer v. Scarafile*, No. 19-3590, 2022 U.S. Dist. LEXIS 123782 (D.S.C. July 12, 2022)

Plaintiff, professional photographer, brought suit against defendants, alleging infringement of his two photographs of Toler's Cove Marina in Mount Pleasant, South Carolina. Plaintiff alleged that defendants, who offered real-estate services in Charleston area, copied and distributed images in online and newspapers listings for sale of boat slip at Marina. Defendants moved for summary judgment on plaintiff's DMCA claim. Court granted summary judgment for defendants on DMCA claim, rejecting plaintiff's claims that defendants removed or obscured physical metadata of CMI on his images and then

distributed images. Plaintiff could not show that defendants intentionally removed facial or metadata CMI because alleged instances of removed or altered CMI were done after defendants submitted real estate listing for boat slip to database syndicated by local brokerages. Plaintiff had also admitted that his images were lawfully published in different locations, which could result in alteration or removal of metadata. Additionally, defendant's agent who acquired images testified that she did not know how to remove or alter metadata. Court also held that no reasonable jury would find that plaintiff could meet double scienter requirement because only evidence that plaintiff pointed to was copyright notice on defendant's website, which could not show that defendants knew removal of CMI would enable or facilitate infringement. Court therefore grants defendants' motion for summary judgment as to plaintiff's DMCA claim.





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