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**Cowan, Liebowitz & Latman**

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**Copyright Review  
2022**

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*“Recent Developments In Copyright”  
Selected Annotated Cases*

**By Thomas Kjellberg**

**with**

**Joelle Milov and Dasha Chestukhin**

**and**

**Jeremy Berman  
Jeffrey Chery  
Shana Dunning  
Allison Furnari  
Justin Karasick  
Sarah Sue Landau  
Raphael Nemes  
Reema Pangarkar  
Emily Stein  
Lyndsey Waddington**

**Cowan, Liebowitz & Latman, P.C.  
114 West 47th Street, New York, NY 10036-1525  
(212) 790-9200 • [www.cl.com](http://www.cl.com) • fax (212) 575-0671**

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**These annotations cover cases reported since our report at  
the 45th Copyright Society Annual Meeting of 2021.**

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## TABLE OF CONTENTS

I.	JURISDICTION AND PROCEDURAL ISSUES .....	1
A.	Subject Matter Jurisdiction.....	1
B.	Personal Jurisdiction and Venue .....	2
C.	Pleadings .....	8
D.	Standing.....	15
E.	Miscellaneous.....	17
II.	COPYRIGHTABILITY .....	18
A.	Originality .....	18
B.	Pictorial, Graphic and Sculptural Works.....	20
C.	Miscellaneous.....	21
III.	OWNERSHIP .....	23
A.	Works Made for Hire .....	23
B.	Termination of Transfers.....	26
C.	Joint Works and Co-Ownership .....	27
D.	Contracts and Licenses.....	31
IV.	FORMALITIES.....	36
A.	Registration .....	36
V.	INFRINGEMENT .....	42
A.	Access.....	42
B.	Copying and Substantial Similarity.....	45
C.	Contributory/Vicarious Infringement.....	54
D.	Miscellaneous.....	61
VI.	DEFENSES/EXEMPTIONS.....	64
A.	Fair Use .....	64
B.	Statute of Limitations .....	77
C.	Res Judicata/Collateral Estoppel.....	82
D.	First Sale Doctrine.....	83
E.	Misuse .....	83
F.	Sovereign Immunity .....	84
G.	Miscellaneous.....	85
VII.	REMEDIES .....	86
A.	Damages and Profits.....	86
B.	Attorneys' Fees .....	94
C.	Injunction/Impoundment.....	107

VIII. PREEMPTION.....	113
IX. DIGITAL MILLENNIUM COPYRIGHT ACT .....	119
X. VISUAL ARTISTS RIGHTS ACT.....	128

## TABLE OF CASES

<i>ABC v. Goodfriend</i> , 557 F. Supp. 3d 409 (S.D.N.Y. 2021).....	85
<i>Acuti v. Authentic Brands Grp. LLC</i> , 33 F.4th 131 (2d Cir. 2022).....	26
<i>Advanta-STAR Auto. Research Corp. of Am. v. DealerCMO, Inc.</i> , No. 20-1150, 2022 U.S. Dist. LEXIS 10343 (E.D. La. Jan. 20, 2022).....	53
<i>Alfred v. Walt Disney Pictures</i> , No. 18-8074, 2021 U.S. Dist. LEXIS 253308 (C.D. Cal. Dec. 16, 2021) .....	51
<i>Alwand Vahan Jewelry, Ltd. v. Lustour, Inc.</i> , No. 21-1959, 2021 U.S. Dist. LEXIS 152935 (S.D.N.Y. Aug. 13, 2021) .....	4
<i>Am. Clothing Express, Inc. v. Cloudflare, Inc.</i> , No. 20-2007, 2022 U.S. Dist. LEXIS 14050 (W.D. Tenn. Jan. 27, 2022).....	83
<i>Am. Soc’y for Testing &amp; Materials v. Public.Resource.Org, Inc.</i> , No. 13-1215, 2022 U.S. Dist. LEXIS 60922 (D.D.C. Mar. 31, 2022).....	74, 108
<i>APL Microscopic v. Steenblock</i> , No. 21-356, 2021 U.S. Dist. LEXIS 134299 (C.D. Cal. July 8, 2021) .....	11
<i>Armes v. Post</i> , No. 20-3212, 2022 U.S. Dist. LEXIS 71155 (C.D. Cal. Apr. 18, 2022) .....	28
<i>Ass’n of Am. Publr’s., Inc. v. Frosh</i> , No. 21-3133, 2022 U.S. Dist. LEXIS 27892 (D. Md. Feb. 16, 2022) .....	112
<i>Athos Overseas, Ltd. v. YouTube, Inc.</i> , No. 21-21698, 2022 U.S. Dist. LEXIS 57302 (S.D. Fla. Mar. 29, 2022).....	81
<i>Baker v. Baker</i> , 860 F. App’x 502 (9th Cir. 2021).....	1, 95
<i>Baker v. Weber</i> , No. 19-1093, 2021 U.S. Dist. LEXIS 188544 (S.D.N.Y. Sept. 30, 2021).....	33, 78
<i>Baron A. Wolman Archives Trust v. BuzzFeed, Inc.</i> , No. 19-9461, 2022 U.S. Dist. LEXIS 43095 (S.D.N.Y. Mar. 10, 2022) .....	77
<i>Baron A. Wolman Archives Trust v. Complex Media, Inc.</i> , No. 20-152, 2022 U.S. Dist. LEXIS 31079 (S.D.N.Y. Feb. 22, 2022).....	77
<i>Bedford v. Trang Kien Nguyen</i> , No. 19-10524, 2021 U.S. Dist. LEXIS 200986 (S.D.N.Y. Oct. 14, 2021) .....	107
<i>Bell v. Eagle Mt. Saginaw Indep. Sch. Dist.</i> , 27 F.4th 313 (5th Cir. 2022).....	65, 97
<i>Bell v. Wilmott Storage Servs., LLC</i> , 12 F.4th 1065 (9th Cir. 2021).....	61
<i>Berry Hill Dev. Corp. v. Scott</i> , No. 20-1874, 2021 U.S. Dist. LEXIS 165494 (E.D.N.Y. Aug. 31, 2021).....	19, 47, 123

<i>Best Carpet Values, Inc. v. Google LLC</i> , No. 20-4700, 2021 U.S. Dist. LEXIS 183693 (N.D. Cal. Sept. 24, 2021) .....	116
<i>Big Run Studios Inc. v. AviaGames Inc.</i> , No. 21-4656, 2022 U.S. Dist. LEXIS 7115 (N.D. Cal. Jan. 13, 2022) .....	100
<i>Bmaddox Enters. LLC v. Oskouie</i> , No. 17-1889, 2021 U.S. Dist. LEXIS 157010 (S.D.N.Y. Aug. 18, 2021) .....	47, 89
<i>Bmaddox Enters. LLC v. Oskouie</i> , No. 17-1889, 2022 U.S. Dist. LEXIS 4786 (S.D.N.Y. Jan. 10, 2022).....	87
<i>Boesen v. United Sports Publ'ns, Ltd.</i> , No. 21-1029, 2022 U.S. App. LEXIS 4079 (2d Cir. Feb. 15, 2022) .....	86
<i>Bonilla v. Ancestry.com Operations Inc.</i> , No. 20-7390, 2021 U.S. Dist. LEXIS 233870 (N.D. Ill. Dec. 7, 2021) .....	117
<i>Brittney Gobble Photography, LLC v. Sinclair Broad. Grp.</i> , No. 18-3403, 2021 U.S. Dist. LEXIS 222009 (D. Md. Nov. 17, 2021) .....	60, 63, 76, 128
<i>Broecker v. Widows Sons Grand Chapter The King's Guard Inc.</i> , No. 21-6309, 2021 U.S. Dist. LEXIS 220254 (W.D.N.Y. Nov. 15, 2021) .....	80
<i>Brooks v. Dash</i> , 852 F. App'x 40 (2d Cir. 2021).....	27, 86
<i>Brownstein v. Lindsay</i> , No. 10-1581, 2021 U.S. Dist. LEXIS 187485 (D.N.J. Sept. 29, 2021) .....	104
<i>Bruce Munro &amp; Bruce Munro Ltd. v. Fairchild Tropical Botanic Garden</i> , No. 20-20079, 2022 U.S. Dist. LEXIS 27504 (S.D. Fla. Jan. 13, 2022) .....	18
<i>Bungie, Inc. v. Aimjunkies.Com</i> , No. 21-811, 2022 U.S. Dist. LEXIS 76823 (W.D. Wash. Apr. 27, 2022).....	14
<i>Bus. Casual Holdings, LLC v. TV-Novosti</i> , No. 21-2007, 2022 U.S. Dist. LEXIS 45283 (S.D.N.Y. Mar. 14, 2022) .....	66, 121
<i>Bus. Casual Holdings, LLC v. YouTube, LLC</i> , No. 21-3610, 2022 U.S. Dist. LEXIS 50166 (S.D.N.Y. Mar. 21, 2022) .....	55
<i>Callahan v. PeopleConnect, Inc.</i> , No. 20-9203, 2021 U.S. Dist. LEXIS 210857 (N.D. Cal. Nov. 1, 2021).....	115
<i>Can. Hockey, L.L.C. v. Marquardt</i> , No. 20-20530, 2022 U.S. App. LEXIS 2371 (5th Cir. Jan. 26, 2022) .....	24, 119
<i>Can. Hockey, L.L.C. v. Tex. A&amp;M Univ. Ath. Dep't</i> , No. 20-20503, 2022 U.S. App. LEXIS 3976 (5th Cir. Feb. 14, 2022) .....	54, 84
<i>Canadian Standards Ass'n v. P.S. Knight Co.</i> , No. 20-1160, 2022 U.S. Dist. LEXIS 22970 (W.D. Tex. Feb. 9, 2022).....	63
<i>Capitani v. World of Miniature Bears, Inc.</i> , 552 F. Supp. 3d 781 (M.D. Tenn. 2021) .....	81, 82, 93, 111
<i>Capitani v. World of Miniature Bears, Inc.</i> , No. 19-9461, 2022 U.S. Dist. LEXIS 33412 (M.D. Tenn. Feb. 25, 2022) .....	105

<i>Capitol Records, LLC v. ReDigi Inc.</i> , No. 12-95, 2022 U.S. Dist. LEXIS 65110 (S.D.N.Y. Apr. 7, 2022).....	98
<i>Carlini v. Paramount Pictures Corp.</i> , No. 21-55213, 2022 U.S. App. LEXIS 5480 (9th Cir. Mar. 2, 2022).....	45
<i>Cat &amp; Dogma, LLC v. Target Corp.</i> , No. 20-50674, 2021 U.S. App. LEXIS 30282 (5th Cir. Oct. 8, 2021).....	46
<i>Cates v. Schlemovitz</i> , No. 21-805, 2022 U.S. Dist. LEXIS 76241 (N.D.N.Y. Apr. 27, 2022).....	49
<i>CDK Global LLC v. Brnovich</i> , 16 F.4th 1266 (9th Cir. 2021).....	113
<i>Clanton v. UMG Recordings, Inc.</i> , 556 F. Supp. 3d 322 (S.D.N.Y. 2021).....	47
<i>Collection v. Latham Cos.</i> , No. 20-217, 2022 U.S. Dist. LEXIS 71523 (E.D. Ky. Apr. 19, 2022) .....	105
<i>Compulife Software v. Rutstein</i> , No. 16-80808, 2021 U.S. Dist. LEXIS 160881 (S.D. Fla. July 12, 2021).....	22, 51
<i>Conrad v. Latido Mitu Holdings, LLC</i> , No. 21-3596, 2021 U.S. Dist. LEXIS 236952 (S.D.N.Y. Dec. 10, 2021) .....	4
<i>Control Tech. &amp; Sols., LLC v. Omni Energy Partners, LLC</i> , No. 21-686, 2021 U.S. Dist. LEXIS 243084 (E.D. Mo. Dec. 21, 2021) .....	119
<i>Coscarelli v. ESquared Hosp. LLC</i> , No. 18-5943, 2021 U.S. Dist. LEXIS 226738 (S.D.N.Y. Nov. 24, 2021).....	62
<i>Cub Club Inv., LLC v. Apple Inc.</i> , No. 21-6948, 2022 U.S. Dist. LEXIS 28086 (N.D. Cal. Feb. 16, 2022) .....	18
<i>Dellamorte, LLC v. Michaels Cos.</i> , No. 21-2029, 2022 U.S. Dist. LEXIS 14887 (D.N.J. Jan. 27, 2022).....	20
<i>Design Basics, LLC v. Kerstiens Homes &amp; Designs, Inc.</i> , 1 F.4th 502 (7th Cir. 2021).....	46
<i>Design Basics, LLC v. Mitch Harris Bldg. Co.</i> , No. 16-14109, 2021 U.S. Dist. LEXIS 227529 (E.D. Mich. Nov. 29, 2021) .....	127
<i>Designworks Homes, Inc. v. Columbia House of Brokers Realty, Inc.</i> , 9 F.4th 803 (8th Cir. 2021).....	85
<i>Designworks Homes, Inc. v. Thomson Sailors Homes, L.L.C.</i> , 9 F.4th 961 (8th Cir. 2021).....	97
<i>Di Angelo Publ'ns, Inc. v. Kelley</i> , No. 20-20523, 2021 U.S. App. LEXIS 24031 (5th Cir. Aug. 12, 2021) .....	1
<i>Digit. Dream Labs, LLC v. Living Tech. (Shenzhen) Co.</i> , No. 20-1500, 2022 U.S. Dist. LEXIS 35045 (W.D. Pa. Feb. 28, 2022) .....	52
<i>Dr. Seuss Enters., LP v. ComicMix LLC</i> , 553 F. Supp. 3d 803 (S.D. Cal. 2021).....	38, 51

<i>Easter Unlimited, Inc. v. Rozier,</i> No. 18-6637, 2021 U.S. Dist. LEXIS 184636 (E.D.N.Y. Sept. 27, 2021).....	71
<i>Elohim EPF USA, Inc. v. 162 D&amp;Y Corp.,</i> No. 19-2431, 2022 U.S. Dist. LEXIS 45114 (S.D.N.Y. Mar. 12, 2022) .....	32, 56, 61
<i>Emmerich Newspapers, Inc. v. Particle Media, Inc.,</i> No. 21-32, 2022 U.S. Dist. LEXIS 49376 (S.D. Miss. Mar. 21, 2022) .....	41, 118
<i>Energy Intelligence Grp. Inc. v. Peco Energy Co.,</i> No. 21-2349, 2022 U.S. Dist. LEXIS 19445 (E.D. Pa. Feb. 2, 2022) .....	13
<i>Erickson Prods. Inc. v. Kast,</i> No. 13-5472, 2021 U.S. Dist. LEXIS 165127 (N.D. Cal. Aug. 31, 2021).....	101
<i>Estate of Martino v. Fountain Christian Bilingual Sch. Carolina, Inc.,</i> No. 18-1509, 2022 U.S. Dist. LEXIS 24843 (D.P.R. Feb. 10, 2022).....	129
<i>Evox Prods. v. Verizon Media,</i> 556 F. Supp. 3d 1139 (C.D. Cal. 2021).....	62
<i>Farrington v. BackChina, LLC,</i> No. 19-3546, 2021 U.S. Dist. LEXIS 117464 (S.D. Tex. Jun. 23, 2021).....	75
<i>Farrington v. Jewish Voice Inc.,</i> No. 21-1575, 2022 U.S. Dist. LEXIS 21812 (E.D.N.Y. Feb. 7, 2022).....	90, 100
<i>Fields v. Baseline Props., LLC,</i> No. 19-864, 2021 U.S. Dist. LEXIS 117158 (W.D. Okla. June 23, 2021).....	130
<i>Fioranelli v. CBS Broad. Inc.,</i> 551 F. Supp. 3d 199 (S.D.N.Y. 2021).....	48, 69, 79
<i>Fit &amp; Fun Playscapes, LLC v. Sensory Path, Inc.,</i> No. 19-11697, 2022 U.S. Dist. LEXIS 6606 (S.D.N.Y. Jan. 12, 2022).....	2
<i>Flo &amp; Eddie, Inc. v. Sirius XM Radio, Inc.,</i> 9 F.4th 1167 (9th Cir. 2021).....	21
<i>Foss v. E. States Exposition,</i> No. 20-12167, 2022 U.S. Dist. LEXIS 51812 (D. Mass. Mar. 23, 2022).....	82
<i>Framework MI, Inc. v. CVS Health Corp.,</i> No. 20-907, 2021 U.S. Dist. LEXIS 110005 (S.D.N.Y. June 11, 2021).....	114
<i>Frye v. Lagerstrom,</i> No. 20-3134, 2021 U.S. App. LEXIS 26646 (2d Cir. Sept. 3, 2021) .....	64
<i>Gaffney v. Muhammad Ali Enters.,</i> No. 20-7113, 2021 U.S. Dist. LEXIS 151090 (S.D.N.Y. Aug. 10, 2021).....	79
<i>Gareaux v. Aronik LLC,</i> No. 21-529, 2021 U.S. Dist. LEXIS 225963 (D. Utah Nov. 22, 2021) .....	127
<i>Gayle v. Villamarin,</i> No. 18-6025, 2021 U.S. Dist. LEXIS 126836 (S.D.N.Y. July 7, 2021) .....	42
<i>Grant v. Trump,</i> No. 20-7103, 2021 U.S. Dist. LEXIS 185674 (S.D.N.Y. Sept. 28, 2021).....	68

<i>Gray v. Hudson</i> , 28 F.4th 87 (9th Cir. 2022).....	18
<i>Great Bowery v. Cascade Digital Media LLC</i> , No. 20-9, 2021 U.S. Dist. LEXIS 159802 (D. Or. July 15, 2021).....	17
<i>Greenspan v. Qazi</i> , No. 20-3426, 2021 U.S. Dist. LEXIS 117332 (N.D. Cal. June 23, 2021) .....	73, 124
<i>Greg Young Publ’g, Inc. v. Zazzle, Inc.</i> , No. 20-55812, 2021 U.S. App. LEXIS 24931 (9th Cir. Aug. 20, 2021) .....	95
<i>Gregorini v. Apple Inc.</i> , Nos. 20-55664, 20-55846, 2022 U.S. App. LEXIS 4640 (9th Cir. Feb. 22, 2022) .....	8, 45
<i>Harrington v. Pinterest, Inc.</i> , No. 20-5290, 2021 U.S. Dist. LEXIS 167983 (N.D. Cal. Sept. 3, 2021) .....	57, 125
<i>Harris v. Am. Accounting Ass’n</i> , No. 20-1057, 2021 U.S. Dist. LEXIS 226517 (N.D.N.Y. Nov. 24, 2021) .....	115
<i>Hartmann v. Amazon.com, Inc.</i> , No. 20-4928, 2021 U.S. Dist. LEXIS 157035 (S.D.N.Y. Aug. 19, 2021).....	57
<i>Hartmann v. Apple, Inc.</i> , No. 20-6049, 2021 U.S. Dist. LEXIS 178822 (S.D.N.Y. Sept. 20, 2021).....	10
<i>Heard v. Trax Records, Inc.</i> , No. 20-3678, 2021 U.S. Dist. LEXIS 135849 (N.D. Ill. July 21, 2021).....	38
<i>Hines v. W Chappell Music Corp.</i> , No. 20-3535, 2021 U.S. Dist. LEXIS 107398 (S.D.N.Y. Jun. 8, 2021) .....	49
<i>Hong v. Rec. Equip.</i> , No. 19-435, 2022 U.S. Dist. LEXIS 19367 (D. Idaho Feb. 1, 2022).....	41
<i>Horror Inc. v. Miller</i> , 15 F.4th 232 (2d Cir. 2021).....	23
<i>Hudson Homes &amp; Designs, LLC v. Kennedy</i> , No. 20-720, 2022 U.S. Dist. LEXIS 3862 (E.D. Ark. Jan. 7, 2022).....	54
<i>Hunley v. BuzzFeed, Inc.</i> , No. 20-8844, 2021 U.S. Dist. LEXIS 189420 (S.D.N.Y. Sept. 30, 2021).....	67
<i>Hunley v. Instagram, LLC</i> , No. 21-3778, 2022 U.S. Dist. LEXIS 18036 (N.D. Cal. Feb. 1, 2022) .....	12
<i>Imapizza v. At Pizza Ltd.</i> , No. 17-2327, 2021 U.S. Dist. LEXIS 112314 (D.D.C. June 8, 2021) .....	103
<i>Imapizza, LLC v. At Pizza Ltd.</i> , No. 17-2327, 2021 U.S. Dist. LEXIS 139234 (D.D.C. July 27, 2021).....	104
<i>In re DMCA § 512(h) Subpoena to Twitter, Inc.</i> , No. 20-80214, 2021 U.S. Dist. LEXIS 247680 (N.D. Cal. Dec. 29, 2021) .....	72
<i>In re DMCA Section 512(h) Subpoena to YouTube (Google, Inc.)</i> , No. 18-268, 2022 U.S. Dist. LEXIS 9029 (S.D.N.Y. Jan. 18, 2022).....	67

<i>Incredible Features v. Backchina</i> , No. 20-943, 2021 U.S. Dist. LEXIS 250121 (C.D. Cal. Dec. 16, 2021) .....	72, 126
<i>InSync Training, LLC v. Am. Soc’y for Training &amp; Dev., Inc.</i> , No. 21-594, 2022 U.S. Dist. LEXIS 68604 (D.N.H. Apr. 13, 2022).....	14, 118
<i>Jay Blahnik Inc. v. WaterRower, Inc.</i> , No. 21-26, 2022 U.S. Dist. LEXIS 56491 (D.R.I. Mar. 29, 2022) .....	15
<i>Johannsongs-Publishing, Ltd. v. Lovland</i> , Nos. 20-55552, 20-55759, 2021 U.S. App. LEXIS 35135 (9th Cir. Nov. 29, 2021).....	46
<i>Johnston v. Kroeger</i> , No. 20-497, 2021 U.S. Dist. LEXIS 150587 (W.D. Tex. Aug. 11, 2021) .....	43, 60
<i>Joint Stock Co. “Channel One Russ. Worldwide” v. Infomir LLC</i> , No. 16-1318, 2022 U.S. Dist. LEXIS 35107 (S.D.N.Y. Feb. 25, 2022).....	21
<i>Kahn v. CJ E&amp;M Am., Inc.</i> , No. 21-3230, 2022 U.S. Dist. LEXIS 58044 (C.D. Cal. Mar. 28, 2022) .....	50
<i>Kev &amp; Cooper, LLC v. Furnish My Place, LLC</i> , No. 20-1509, 2022 U.S. Dist. LEXIS 54445 (C.D. Cal. Mar. 15, 2022) .....	50, 57
<i>Kifle v. YouTube LLC</i> , No. 21-1752, 2022 U.S. Dist. LEXIS 20014 (N.D. Cal. Feb. 3, 2022) .....	37
<i>Kipp Flores Architects, LLC v. Pradera SFR, LLC</i> , No. 21-673, 2022 U.S. Dist. LEXIS 68040 (W.D. Tex. Apr. 13, 2022).....	13, 126
<i>Kobi Karp Architecture &amp; Interior Design, Inc. v. RG Mich. 2014 LLC</i> , No. 18-21079, 2021 U.S. Dist. LEXIS 198691 (S.D. Fla. Oct. 14, 2021).....	59
<i>Latin Am. Music Co. v. Spanish Broad. Sys.</i> , No. 20-2332, 2021 U.S. App. LEXIS 29866 (2d Cir. Oct. 5, 2021).....	95
<i>LeSEA, Inc. v. LeSEA Broad. Corp.</i> , No. 18-914, 2022 U.S. Dist. LEXIS 37501 (N.D. Ind. Mar. 3, 2022) .....	111
<i>Lew v. City of Los Angeles</i> , No. 20-10948, 2021 U.S. Dist. LEXIS 166223 (C.D. Cal. Aug. 31, 2021).....	129
<i>Lew v. City of Los Angeles</i> , No. 20-10948, 2022 U.S. Dist. LEXIS 3196 (C.D. Cal. Jan. 6, 2022) .....	115, 128
<i>Lieb v. Korangy Publ’g, Inc.</i> , No. 15-40, 2022 U.S. Dist. LEXIS 69510 (E.D.N.Y. Apr. 14, 2022) .....	36
<i>Lievano v. Cointelegraph Media United States</i> , No. 21-3255, 2021 U.S. Dist. LEXIS 211933 (S.D.N.Y. Nov. 2, 2021) .....	89
<i>Live Face On Web, LLC v. Cremation Soc’y of Ill., Inc.</i> , No. 16-8608, 2022 U.S. Dist. LEXIS 48439 (N.D. Ill. Mar. 18, 2022).....	102
<i>Markham Concepts, Inc. v. Hasbro</i> , 1 F.4th 74 (1st Cir. 2021) .....	24
<i>Markham Concepts, Inc. v. Hasbro, Inc.</i> , No. 15-419, 2021 U.S. Dist. LEXIS 214365 (D.R.I. Nov. 5, 2021).....	106

<i>Martin v. Pure Spectrum CBD, LLC</i> , No. 20-910, 2022 U.S. Dist. LEXIS 404 (D. Colo. Jan. 3, 2022).....	35
<i>McGucken v. Newsweek LLC</i> , No. 19-9617, 2022 U.S. Dist. LEXIS 50231 (S.D.N.Y. Mar. 21, 2022) .....	32, 66
<i>MCS Indus. v. Michael’s Stores, Inc.</i> , No. 21-2563, 2022 U.S. Dist. LEXIS 77948 (E.D. Pa. Apr. 29, 2022) .....	14
<i>Melendez v. Sirius XM Radio, Inc.</i> , No. 20-6620, 2021 U.S. Dist. LEXIS 118160 (S.D.N.Y. June 24, 2021).....	114
<i>Michael Grecco Productions, Inc. v. Time USA, LLC</i> , No. 20-4875, 2021 U.S. Dist. LEXIS 140274 (S.D.N.Y. Jul. 27, 2021) .....	34
<i>Millennium Funding, Inc. v. 1701 Mgmt. LLC</i> , No. 21-20862, 2021 U.S. Dist. LEXIS 153554 (S.D. Fla. Aug. 13, 2021).....	109
<i>Millennium Funding, Inc. v. 1701 Mgmt. LLC</i> , No. 21-20862, 2021 U.S. Dist. LEXIS 237925 (S.D. Fla. Dec. 13, 2021) .....	7, 59
<i>Miller v. French Pastry Sch. LLC</i> , No. 18-4738, 2021 U.S. Dist. LEXIS 225836 (N.D. Ill. Nov. 23, 2021).....	30, 35
<i>Miller v. Hurst</i> , No. 21-5506, 2022 U.S. App. LEXIS 2494 (6th Cir. Jan. 26, 2022) .....	97
<i>Milo Enters. v. Bird-X, Inc.</i> , No. 18-6315, 2022 U.S. Dist. LEXIS 53097 (N.D. Ill. Mar. 24, 2022).....	16
<i>MLGenius Holdings LLC v. Google LLC</i> , No. 20-3113, 2022 U.S. App. LEXIS 6206 (2d Cir. Mar. 10, 2022).....	113
<i>Monsarrat v. Newman</i> , 28 F.4th 314 (1st Cir. 2022) .....	64
<i>Moonbug Entm’t Ltd. v. Babybus (Fujian) Network Tech. Co.</i> , No. 21-6536, 2022 U.S. Dist. LEXIS 33613 (N.D. Cal. Feb. 25, 2022) .....	73, 84, 125
<i>Morisky v. MMAS Research LLC</i> , No. 21-1301, 2022 U.S. Dist. LEXIS 75136 (W.D. Wash. Apr. 15, 2022).....	110
<i>Morisky v. MMAS Research LLC</i> , No. 21-1301, 2022 U.S. Dist. LEXIS 75234 (W.D. Wash. Apr. 8, 2022).....	2
<i>Morningstar Films, LLC v. Nasso</i> , 554 F. Supp. 3d 525 (E.D.N.Y. 2021).....	5
<i>Muhammad v. HBO, Inc.</i> , No. 21-1168, 2021 U.S. Dist. LEXIS 143854 (C.D. Ill. Aug. 2, 2021).....	38, 43
<i>MultiTracks, LLC v. Palmer</i> , No. 21-645, 2022 U.S. Dist. LEXIS 35387 (W.D. Tex. Mar. 1, 2022) .....	117
<i>Nat’l Academy of Television Arts &amp; Sciences v. Multimedia Sys. Design, Inc.</i> , 551 F. Supp. 3d 408 (S.D.N.Y. 2021).....	69
<i>Neman Bros. &amp; Assoc. v. Interfocus, Inc.</i> , No. 20-11181, 2022 U.S. Dist. LEXIS 17971 (C.D. Cal. Jan. 11, 2022) .....	37

<i>Nintendo of Am. Inc. v. Storman</i> , No. 19-7818, 2021 U.S. Dist. LEXIS 148119 (C.D. Cal. Aug. 5, 2021).....	91, 125
<i>NOCO Co. v. Shenzhen Dingjiang Tech. Co.</i> , No. 21-1483, 2022 U.S. Dist. LEXIS 3911 (N.D. Ohio Jan. 7, 2022).....	19
<i>NSI Int’l, Inc. v. Horizon Grp. USA, Inc.</i> , No 20-8389, 2021 U.S. Dist. LEXIS 132995 (S.D.N.Y. July 16, 2021) .....	48
<i>O’Neil v. Ratajkowski</i> , No. 19-9769, 2021 U.S. Dist. LEXIS 185675 (S.D.N.Y. Sept. 28, 2021).....	70
<i>Optimistic Invs. LLC v. Kangaroo Mfg.</i> , No. 21-2212, 2022 U.S. Dist. LEXIS 74108 (D. Ariz. Apr. 22, 2022).....	109
<i>Parisienne v. Scripps Media, Inc.</i> , No. 19-8612, 2021 U.S. Dist. LEXIS 154960 (S.D.N.Y. Aug. 17, 2021) .....	78
<i>Parker v. Hinton</i> , No. 19-214, 2022 U.S. Dist. LEXIS 40624 (M.D. Tenn. Mar. 8, 2022) .....	40
<i>Paul Rudolph Found. v. Paul Rudolph Heritage Found.</i> , No. 20-8180, 2021 U.S. Dist. LEXIS 188648 (S.D.N.Y. Sept. 30, 2021).....	15, 122
<i>Penske Media Corp. v. Shutterstock, Inc.</i> , 548 F. Supp. 3d 370 (S.D.N.Y. 2021).....	10, 123
<i>Perea v. Editorial Cultural, Inc.</i> , 13 F.4th 43 (1st Cir. 2021) .....	31
<i>Philips N. Am. LLC v. Advanced Imaging Servs.</i> , No. 21-876, 2022 U.S. Dist. LEXIS 71283 (E.D. Cal. April 15, 2022) .....	83
<i>Philpot v. MyArea Network, Inc.</i> , No. 20-1239, 2021 U.S. Dist. LEXIS 119423 (M.D. Fla. June 28, 2021).....	75
<i>Pilkin v. Google LLC</i> , No. 21-1483, 2021 U.S. Dist. LEXIS 153028 (N.D. Cal. Aug. 13, 2021).....	22
<i>Planck LLC v. Particle Media, Inc.</i> , No. 20-10959, 2021 U.S. Dist. LEXIS 214604 (S.D.N.Y. Nov. 3, 2021).....	9
<i>Poppington, LLC v. Brooks</i> , No. 20-8616, 2021 U.S. Dist. LEXIS 140262 (S.D.N.Y. July 27, 2021) .....	5
<i>Pyrotechnics Mgmt. v. XFX Pyrotechnics LLC</i> , No. 19-893, 2021 U.S. Dist. LEXIS 131697 (W.D. Pa. July 15, 2021) .....	39
<i>Rearden LLC v. Walt Disney Co.</i> , No. 17-4191, 2021 U.S. Dist. LEXIS 172679 (N.D. Cal. Aug. 16, 2021).....	90
<i>Reiffer v. Active Certification Servs. LLC</i> , No. 21-20177, 2021 U.S. Dist. LEXIS 215729 (S.D. Fla. Nov. 8, 2021).....	92
<i>Reilly v. Wozniak</i> , No. 18-3775, 2021 U.S. Dist. LEXIS 223175 (D. Ariz. Nov. 18, 2021).....	106
<i>Restellini v. Wildenstein Plattner Inst. Inc.</i> , No. 20-4388, 2021 U.S. Dist. LEXIS 181149 (S.D.N.Y. Sept. 22, 2021).....	9

<i>Reynolds v. Apple Inc.</i> , No. 19-5440, 2021 U.S. Dist. LEXIS 167958 (N.D. Cal. Sept. 3, 2021) .....	34
<i>Reynolds v. Google LLC</i> , No. 21-3029, 2022 U.S. Dist. LEXIS 19248 (N.D. Cal. Feb. 2, 2022) .....	34
<i>Roethlisberger v. Oxido Corp.</i> , No. 20-1909, 2021 U.S. Dist. LEXIS 235942 (S.D.N.Y. Dec. 6, 2021) .....	88, 100
<i>Ross v. Dejarnetti</i> , No. 18-11277, 2021 U.S. Dist. LEXIS 143608 (E.D. La. July 30, 2021).....	30
<i>Sadowski v. Ng</i> , No. 18-10113, 2022 U.S. Dist. LEXIS 46315 (S.D.N.Y. Mar. 15, 2022) .....	120
<i>Scott v. Domus Constr. &amp; Design, Inc.</i> , No. 21-623, 2021 U.S. Dist. LEXIS 227024 (S.D. Cal. Nov. 24, 2021) .....	6
<i>Segal v. Segel</i> , No. 20-1382, 2022 U.S. Dist. LEXIS 11832 (S.D. Cal. Jan. 21, 2022).....	42, 50
<i>Sessa v. Ancestry.com Operations Inc.</i> , No. 20-2292, 2021 U.S. Dist. LEXIS 177337 (D. Nev. Sept. 16, 2021) .....	119
<i>Seven Oaks Millwork v. Royal Foam US, LLC</i> , No. 20-28, 2021 U.S. Dist. LEXIS 171534 (M.D. Fla. Aug. 10, 2021) .....	103
<i>Shepard v. Wo Hop City, Inc.</i> , No. 18-9634, 2021 U.S. Dist. LEXIS 178861 (S.D.N.Y. Sept. 20, 2021).....	88
<i>Shull v. TBTF Prods.</i> , No. 20-3529, 2021 U.S. App. LEXIS 21220 (2d Cir. 2021).....	45
<i>SoundExchange, Inc. v. Music Choice</i> , No. 19-999, 2021 U.S. Dist. LEXIS 242394 (D.D.C. Dec. 20, 2021).....	17
<i>Speedway Motors, Inc. v. Perlmutter</i> , 553 F. Supp. 3d 703 (D. Neb. 2021) .....	20
<i>Spin Master v. Alvy</i> , No. 19-3452, 2021 U.S. Dist. LEXIS 222374 (S.D.N.Y. Nov. 17, 2021) .....	8
<i>Stebbins v. Polano</i> , No. 20-4184, 2021 U.S. Dist. LEXIS 122591 (N.D. Cal. June 30, 2021) .....	11
<i>Stross v. Centerra Homes of Tex.</i> , No. 17-676, 2021 U.S. Dist. LEXIS 219239 (W.D. Tex. Sept. 27, 2021).....	35
<i>Suzhou Angela Online Game Tech. Co., Ltd. v. Snail Games USA, Inc.</i> , No. 21-9552, 2022 U.S. Dist. LEXIS 20164 (C.D. Cal. Jan. 31, 2022) .....	107
<i>Symbria, Inc. v. Callen</i> , No. 20-4084, 2022 U.S. Dist. LEXIS 2719 (N.D. Ill. Jan. 6, 2022) .....	13, 117
<i>Tabak v. LifeDaily, LLC</i> , No. 21-4291, 2021 U.S. Dist. LEXIS 217755 (S.D.N.Y. Nov. 9, 2021) .....	88, 122
<i>Take-Two Interactive Software, Inc. v. Sims</i> , No. 20-4441, 2021 U.S. Dist. LEXIS 111287 (N.D. Cal. June 14, 2021) .....	5

<i>Talavera v. Global Payments, Inc.</i> , No. 21-1585, 2021 U.S. Dist. LEXIS 221365 (S.D. Cal. Nov. 16, 2021) .....	108
<i>TD Ameritrade, Inc. v. Matthews</i> , No. 16-136, 2021 U.S. Dist. LEXIS 160362 (D. Alaska Aug. 25, 2021) .....	41
<i>Tee Turtle, LLC v. Swartz</i> , No. 21-1771, 2021 U.S. Dist. LEXIS 107745 (S.D. Ohio June 9, 2021) .....	112
<i>Thomas v. Carter</i> , No. 21-8682, 2022 U.S. Dist. LEXIS 13346 (S.D.N.Y. Jan. 25, 2022).....	62
<i>Tolbert v. Discovery, Inc.</i> , No. 18-680, 2021 U.S. Dist. LEXIS 161742 (N.D. Ala. Aug. 26, 2021) .....	44, 54
<i>Treadway Gallery, Inc. v. John Toomey Gallery, Inc.</i> , No. 19-664, 2022 U.S. Dist. LEXIS 57949 (S.D. Ohio Mar. 30, 2022) .....	25
<i>Trombetta v. Novocin</i> , No. 18-993, 2021 U.S. Dist. LEXIS 244587 (S.D.N.Y. Dec. 21, 2021) .....	3, 122
<i>UMG Recordings v. Kurbanov</i> , No. 18-957, 2021 U.S. Dist. LEXIS 250844 (E.D. Va. Dec. 16, 2021) .....	91
<i>Valancourt Books, LLC v. Perlmutter</i> , 554 F. Supp. 3d 26 (D.D.C. 2021) .....	39
<i>VHT, Inc. v. Zillow Grp., Inc.</i> , No. 15-1096, 2022 U.S. Dist. LEXIS 14453 (W.D. Wash. Jan. 26, 2022).....	93
<i>Viacom Int’l v. Pixi Universal, LLC</i> , No. 21-2612, 2022 U.S. Dist. LEXIS 57400 (S.D. Tex. Mar. 25, 2022).....	74
<i>Wahlhuetter v. Collegehumor</i> , No. 19-1501, 2021 U.S. Dist. LEXIS 230034 (S.D.N.Y. Nov. 29, 2021) .....	4
<i>Walker v. Kemp</i> , No. 21-528, 2022 U.S. Dist. LEXIS 35373 (E.D. Pa. Feb. 28, 2022) .....	43, 53
<i>Walsh v. Townsquare Media, Inc.</i> , No. 19-4958, 2021 U.S. Dist. LEXIS 188466 (S.D.N.Y. Sept. 30, 2021).....	68
<i>Walsh v. Townsquare Media, Inc.</i> , No. 19-4958, 2022 U.S. Dist. LEXIS 79444 (S.D.N.Y. May 2, 2022).....	98
<i>Wareka v. Faces</i> , No. 20-62466, 2021 U.S. Dist. LEXIS 201546 (S.D. Fla. Oct. 19, 2021).....	92
<i>Warner Bros. Entm’t v. Tusa</i> , No. 21-5456, 2021 U.S. Dist. LEXIS 206716 (C.D. Cal. Oct. 25, 2021).....	58
<i>Webber v. Dash</i> , No. 19-610, 2021 U.S. Dist. LEXIS 163780 (S.D.N.Y. Aug. 30, 2021) .....	27
<i>White v. UMG Recordings, Inc.</i> , No. 20-9971, 2021 U.S. Dist. LEXIS 243464 (S.D.N.Y. Dec. 21, 2021) .....	121
<i>Whyte Monkee Prods., LLC v. Netflix, Inc.</i> , No. 20-933, 2022 U.S. Dist. LEXIS 76440 (W.D. Okla. Apr. 27, 2022) .....	25, 76

<i>Wicked Grips LLC v. Badaan</i> , No. 21-2131, 2021 U.S. Dist. LEXIS 195218 (M.D. Fla. Oct. 8, 2021) .....	109
<i>Will Co. Ltd. v. Yeung Lee</i> , No. 20-5802, 2021 U.S. Dist. LEXIS 122635 (W.D. Wash. June 30, 2021).....	8
<i>Williams v. Elliott</i> , No. 18-5418, 2021 U.S. Dist. LEXIS 138405 (E.D. Pa. July 23, 2021).....	7
<i>Wood v. Observer Holdings, LLC</i> , No. 20-7878, 2021 U.S. Dist. LEXIS 127484 (S.D.N.Y. July 8, 2021) .....	70, 124
<i>Yamashita v. McGraw-Hill Glob. Educ. Holdings, LLC</i> , No. 16-3934, 2022 U.S. Dist. LEXIS 73757 (D.N.J. Apr. 21, 2022) .....	80, 92
<i>Yang v. Mic Network Inc.</i> , Nos. 20-4097, 20-4201, 2022 U.S. App. LEXIS 8195 (2d Cir. Mar. 29, 2022).....	64, 94
<i>Yellow Pages Photos, Inc. v. YP, LLC</i> , 856 Fed. Appx. 846 (11th Cir. 2021) .....	31, 87
<i>Yellowcake, Inc. v. Hyphy Music, Inc.</i> , No. 20-988, 2021 U.S. LEXIS 135269 (E.D. Cal. July 20, 2021).....	16, 30
<i>Yellowcake, Inc. v. Morena Music, Inc.</i> , No. 20-787, 2021 U.S. Dist. LEXIS 144231 (E.D. Cal. Aug. 2, 2021).....	29
<i>Yoakam v. Warner Music Grp. Corp.</i> , No. 21-1165, 2021 U.S. Dist. LEXIS 164915 (C.D. Cal. July 12, 2021).....	26, 116
<i>YZ Prods. v. Redbubble, Inc.</i> , 545 F. Supp. 3d 756 (N.D. Cal. 2021) .....	58
<i>Zorikova v. Kineticflix, LLC</i> , No. 19-4214, 2022 U.S. Dist. LEXIS 77788 (C.D. Cal. Apr. 28, 2022) .....	83



## I. JURISDICTION AND PROCEDURAL ISSUES

### A. Subject Matter Jurisdiction

*Baker v. Baker*, 860 F. App'x 502 (9th Cir. 2021)

Ninth Circuit vacated district court's judgment on jurisdictional grounds. Plaintiff sued defendant alleging copyright infringement and state law fraud, asserting that defendant's false representations regarding authorship in copyright applications for certain sound recordings and compositions resulted in inaccurate registrations. Defendant counterclaimed for declaration that registered authorship splits were true and correct. On summary judgment, district court dismissed plaintiff's claim as to defendant on grounds that plaintiff failed to register his copyright claims as to one set of songs prior to bringing suit, and that plaintiff had already obtained judgment against defendant as to another set of songs. District court then dismissed plaintiff's fraud claim but decided defendant's declaratory judgment claim in defendant's favor. On appeal, Ninth Circuit held that defendant's declaratory counterclaim sought mere declaration of ownership rights and therefore district court lacked federal subject matter jurisdiction over counterclaim, even though it incidentally involved copyright. Further, district court abused its discretion by retaining jurisdiction over defendant's counterclaim while dismissing plaintiff's closely related fraud claim. Accordingly, Ninth Circuit remanded with instruction to dismiss defendant's counterclaim without prejudice to refile in state court.

*Di Angelo Publ'ns, Inc. v. Kelley*, No. 20-20523, 2021 U.S. App. LEXIS 24031 (5th Cir. Aug. 12, 2021)

Fifth Circuit reversed district court's dismissal of declaratory judgment claim involving contract and copyright law for lack of subject matter jurisdiction, finding that contract turned on construction of Act. Plaintiff publisher claimed copyright ownership in book conceived by notable makeup artist whose name appeared on cover and inside as sole holder of copyright, though plaintiff allegedly wrote, edited, and provided photographs, illustrations, and layout for book. When defendant makeup artist attempted to prepare revised book directly without plaintiff in order to save costs, and was rebuffed by printer, artist filed state complaint for breach of contract, in which she alleged she held complete copyright ownership in book. Publisher brought action in district court seeking declaratory judgment that it owned copyrights in book. District court dismissed action for lack of subject matter jurisdiction, finding that ownership of copyright in book ultimately hinged on interpretation of contract which called artist "author," and complaint mostly alleged contractual facts. Fifth Circuit reversed, finding that while issues of copyright assignment are contractual, questions of ownership grounded in authorship touch on federal concerns. Authors gain exclusive rights in work upon creation, not subject to registration, and description of artist as "author" in contract did not preclude plaintiff publisher from being statutory author for purposes of Act. Whether plaintiff's contributions were sufficient for statutory authorship of work, and

whether any rights held by plaintiff applied to revised version of book, were questions district court failed to answer, requiring remand.

*Morisky v. MMAS Research LLC*, No. 21-1301, 2022 U.S. Dist. LEXIS 75234 (W.D. Wash. Apr. 8, 2022)

Plaintiff, creator of medication assessment tool, entered into licensing agreement with defendant to create electronic version of tool. Over time, relations between parties broke down, and parties sued each other both in state and federal court for several claims including copyright infringement. Parties ultimately entered into Settlement Agreement (“SA”) but disagreed about proper dispute resolution mechanism under SA and returned to court to resolve. Court determined that mediation was necessary under SA, but parties never engaged in post-settlement agreement mediation. Instead, plaintiff initiated new action in Washington district court, and defendant moved to dismiss for failure to state claim upon which relief can be granted, arguing that federal court did not have subject matter jurisdiction over plaintiff’s claims because complaint was based on enforcement of SA contract. Plaintiff argued that federal jurisdiction was proper because plaintiff alleged new copyright infringement claim. Court found that, because plaintiff sought remedies expressly granted by Act, federal subject matter jurisdiction was proper, even if some rights and liabilities in complaint sounded in contract law.

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

*Fit & Fun Playscapes, LLC v. Sensory Path, Inc.*, No. 19-11697, 2022 U.S. Dist. LEXIS 6606 (S.D.N.Y. Jan. 12, 2022)

District court granted defendant’s motion to transfer case. Plaintiff (“FAF”) and defendant (“SPI”) both offered children’s educational stencils and decals. On September 28, 2019 (one day after FAF sent SPI second of two cease-and-desist letters relating to copyright infringement), SPI filed lawsuit against FAF in N.D. Miss. for declaratory judgment of non-infringement and various trademark infringement and unfair competition claims. On November 15, 2019, FAF filed motion to dismiss SPI’s complaint for lack of personal jurisdiction, which N.D. Miss. court granted as to non-infringement declaratory judgment but not other claims. On December 20, 2019, FAF filed suit against SPI in S.D.N.Y. asserting, *inter alia*, copyright infringement. On September 17, 2020, FAF filed answer in N.D. Miss. Action, asserting counterclaims including declaratory judgment of non-infringement; and on November 11, 2020, FAF filed motion for summary judgment against SPI’s surviving claims. Upon SPI’s request, N.D. Miss. court granted stay pending S.D.N.Y.’s determination on FAF’s copyright infringement claim and further provided that, if S.D.N.Y. transferred case to N.D. Miss., SPI would not oppose FAF’s motion for leave to amend counterclaim to include S.D.N.Y. claims. On January 19, 2021, SPI filed, in S.D.N.Y., motion to dismiss or transfer case to N.D. Miss. On October 21, 2021, N.D. Miss. court denied FAF’s summary judgment motion and lifted stay because S.D.N.Y. had not yet ruled on SPI’s motion to dismiss or transfer. S.D.N.Y. court, in deciding SPI’s motion and in recognition of resources already expended by N.D. Miss., held that SPI established applicability of first-filed rule,

which gives precedence to earlier filed action in determining venue. Although parties' respective claims in both lawsuits arose under different legal theories and asserted different harms to different types of intellectual property, all claims in both actions involved same work or product (stencils and decals). Thus, FAF should have asserted its copyright infringement claim as compulsory counterclaim in N.D. Miss. action because, though N.D. Miss. court ruled that it lacked personal jurisdiction over SPI as to FAF's copyright-related claim, inverse is not true, and N.D. Miss. has such jurisdiction over SPI. S.D.N.Y. court further held that SPI's N.D. Miss. action was not improper anticipatory action because FAF's demand letters did not contain sufficient notice of imminent lawsuit, as they failed to mention specific forum, filing date or relevant deadlines. Moreover, SPI's commencement of suit in N.D. Miss. was not jurisdictional bootstrap because, if it were so, SPI's claims would have been dismissed by N.D. Miss. court already. Finally, balance of convenience favored transfer to N.D. Miss. because SPI was indisputably Mississippi resident, SPI's officers and employees would be key witnesses for FAF's copyright infringement claim, relevant evidence and operative facts located in Mississippi, parties were already litigating in N.D. Miss., and N.D. Miss. had already confirmed that FAF could include its copyright infringement claim in action pending there.

*Trombetta v. Novocin*, No. 18-993, 2021 U.S. Dist. LEXIS 244587 (S.D.N.Y. Dec. 21, 2021)

District court dismissed complaint against CEO defendant. Defendant worthpoint.com provided users with historical pricing data from artwork auctions and retail sales. Defendant Seippel was CEO of worthpoint.com. Defendants Marie and Norb Novocin were operators of defendant Estate Auctions Inc. (EAI), which sold art and other collectibles on eBay. Plaintiff sued for infringement after discovering that worthpoint.com contained eBay listing of 1972 "shabby chic" painting with description that stated painting was painted by plaintiff and had been sold on eBay for \$181.50. Plaintiff claimed she was not painter of work at issue, and that such information damaged her reputation and business. Defendant Seippel moved to dismiss for lack of personal jurisdiction. Plaintiff claimed jurisdiction existed under all three provisions of New York's personal jurisdiction statute. District court held that: (1) defendant had not transacted business within New York, because emails from worthpoint.com to New York customers were either not written by Seippel or were written by Seippel but were not soliciting business; (2) plaintiff did not allege that Seippel engaged in tortious acts while in New York; and (3) plaintiff did not allege that Seippel engaged in persistent course of conduct or derived revenue from New York market as individual. District court also rejected agency theory of personal jurisdiction, finding that complaint did not allege that transactions at issue were for benefit of or at direction of Seippel, nor did plaintiff allege that Seippel controlled his company's actions regarding worthpoint.com posts at issue. District court therefore dismissed all claims against Seippel for lack of personal jurisdiction.

*Conrad v. Latido Mitu Holdings, LLC*, No. 21-3596, 2021 U.S. Dist. LEXIS 236952 (S.D.N.Y. Dec. 10, 2021)

District court granted motion to transfer venue to C.D. Cal. due to lack of personal jurisdiction where alleged infringement had no connection to New York. Plaintiff photographers owned copyrights in photographs of Meghan Markle, and defendants published photographs on website without permission. Plaintiffs filed suit for infringement, and defendants moved to dismiss for lack of personal jurisdiction or to transfer venue to C.D. Cal. Though defendants transacted business in New York, that business was unrelated to publishing photographs at issue, and public website operated by defendants did not specifically target New York. Court found transfer proper because plaintiffs and defendants resided in C.D. Cal.

*Wahlhuetter v. Collegehumor*, No. 19-1501, 2021 U.S. Dist. LEXIS 230034 (S.D.N.Y. Nov. 29, 2021)

Plaintiff, professional photographer based in Austria, filed suit against defendant, CollegeHumor.com, alleging violations of Act and DMCA for reproducing plaintiff's photograph of dog in Himalayan mountains. Court issued default judgment, then referred case to magistrate judge for damages inquest. Magistrate recommended that default judgment be vacated and action dismissed for lack of personal jurisdiction. Plaintiff alleged that court had personal jurisdiction over defendant because defendant resided and conducted business in New York. However, plaintiff failed to allege that New York was defendant's "principal" place of business or to plead facts sufficient to show that either of his claims arose from any business transacted by defendant in New York. While plaintiff argued that defendant posted photograph at issue to website that was accessible in New York, website without interactive component is not sufficient to show jurisdiction. Under New York law, only interactive websites that are purposefully used to sell goods or services in New York or charge membership fees to New Yorkers can trigger specific personal jurisdiction, and only if cause of action arises out that activity.

*Alwand Vahan Jewelry, Ltd. v. Lustour, Inc.*, No. 21-1959, 2021 U.S. Dist. LEXIS 152935 (S.D.N.Y. Aug. 13, 2021)

Court granted motion to dismiss. Plaintiff, New York based jewelry designer and dealer, sued defendant, Georgia wholesale jewelry supplier, in New York for infringement of plaintiff's jewelry design, which included three-dimensional petal motif. Defendant moved to dismiss complaint for lack of personal jurisdiction. Plaintiff alleged that court had general and specific jurisdiction over defendant. On claim for general personal jurisdiction, court found plaintiff's allegations insufficient because plaintiff failed to allege defendant's place of incorporation or principal place of business was in New York; mere allegations that defendant conducts business in New York and engages in acts targeted to New York were insufficient. On claim for specific personal jurisdiction, court found pleading insufficient because there were no allegations specifying connection between defendant's alleged infringement and New York.

*Poppington, LLC v. Brooks*, No. 20-8616, 2021 U.S. Dist. LEXIS 140262 (S.D.N.Y. July 27, 2021)

Court denied motion to dismiss. Plaintiff Poppington, company founded by defendant's former production partner, filed suit against defendant, novelist Edwyna Brooks, for infringement of photograph taken during production of *Mafietta*, film adaptation of defendant's novel. Defendant moved to dismiss for lack of personal jurisdiction and failure to state claim. As to personal jurisdiction, court found it could exercise jurisdiction over defendant because defendant transacted business within New York by means of selling book into New York via third-party seller Amazon.com, with whom defendant conducted regular business with high volume of sales. As to motion based on failure to state claim, defendant asserted issue and claim preclusion, but failed to state which issue should be precluded. Court additionally found claim preclusion inappropriate because third element of claim preclusion not met, because copyright had not been registered at time of previous lawsuit. Infringement claim could not have been brought in prior suit, since registration is required for filing claim. Defendant claimed plaintiffs lacked legal right to photograph in question under derivative work and/or work made for hire theories, but court found neither argument persuasive, because defendant was unable to show that photography was derivative of novel or film, and there was no written agreement for work made for hire.

*Morningstar Films, LLC v. Nasso*, 554 F. Supp. 3d 525 (E.D.N.Y. 2021)

Court granted motion to dismiss for lack of personal jurisdiction. Plaintiffs brought infringement action regarding distribution of film, entitled *Darc*. Some defendants moved to dismiss for lack of personal jurisdiction. Court analyzed whether personal jurisdiction was proper under New York long-arm statute, i.e., whether defendant committed tortious act (infringement) outside New York that defendant expected or reasonably should have expected would have consequences in New York, and defendant derived substantial revenue from interstate or international commerce. Court found plaintiff's domicile in New York insufficient to establish jurisdiction. Further, plaintiff's allegations only related to business loss and were otherwise conclusory. Because plaintiff did not allege direct injury to bundle of intellectual property rights within New York, court found that it lacked personal jurisdiction, and granted motion to dismiss.

*Take-Two Interactive Software, Inc. v. Sims*, No. 20-4441, 2021 U.S. Dist. LEXIS 111287 (N.D. Cal. June 14, 2021)

District court granted defendant's motion to dismiss for lack of personal jurisdiction and improper venue. Plaintiff sought declaratory judgment that plaintiff's inclusion of dance routine "Crank That Dance," also known as "Soul Jah Boi" dance ("SJB Dance") in video game did not infringe defendant's copyright. In 2018, plaintiff released its video game NBA 2K19, which included basketball players performing SJB Dance. Defendant sent plaintiff two cease-and-desist letters, and plaintiff filed declaratory judgment claim in Northern District of California. Defendant moved to dismiss for lack of personal jurisdiction and improper venue. Court utilized purposeful direction test, stating defendant (1) must have

committed intentional act (2) expressly aimed at California that (3) caused harm he knew was likely to be suffered in California. Plaintiffs argued that cease-and-desist letters combined with defendant's participation in concerts in California provided requisite minimum contacts for personal jurisdiction. Court followed *Yahoo! Inc. v. La Ligue Contre Le Racisme*, 433 F.3d 1199 (9th Cir. 2006), and held defendant's letters were normal cease-and-desist letters that were not abusive, tortious, or otherwise wrongful. Additionally, when defendant performed SJB Dance in 2009, he had no knowledge of plaintiff, and thus there was no purposeful direction. In interest of justice, court transferred matter to Northern District of Georgia, as defendant resided in Georgia.

*Scott v. Domus Constr. & Design, Inc.*, No. 21-623, 2021 U.S. Dist. LEXIS 227024 (S.D. Cal. Nov. 24, 2021)

District court denied defendant's motion to dismiss complaint for improper venue. Plaintiff sued for infringement of his printed publication "Memory Jogger & Home Inventory Tool," spreadsheet that "serves to assist people whose homes have been damaged or destroyed by natural disasters." Upon learning that defendant, general contractor "specializing in the restoration and repair of residential and commercial properties damaged due to fire," was distributing for free through its website and Facebook page identical spreadsheet bearing identical title, plaintiff sued for infringement. Defendant moved to dismiss complaint for improper venue, arguing that it was domiciled in Eastern District of California, not Southern District where action was filed, and that plaintiff improperly based jurisdiction and venue on distribution of work through its "static website" and Facebook page. In considering whether specific jurisdiction lay in Southern District of California, district court found that defendant purposefully directed its activities towards Southern District by committing intentional act of downloading plaintiff's work from his website, which "plainly stated" that plaintiff lived in San Diego, California, in Southern District. In considering whether defendant expressly aimed its conduct at Southern District of California, court analyzed defendant's activities under "sliding scale" approach to determine whether its website was "active" or "passive." Court found defendant's website interactive because it "required individuals to enter their e-mail address in order to download" infringing work, and because it "encouraged visitors" to share defendant's website with their Facebook friends. On "express aiming" prong of analysis, court found that parties were "competitors in small or specialized industry" in "niche area" of fire restoration, and therefore held that defendant expressly aimed its intentional conduct at Southern District of California. Finally, court found that defendant's conduct resulted in foreseeable harm in Southern District of California because plaintiff suffered economic harm by defendant's distribution of its copyrighted work, and that defendant actively solicited distribution of work and promotion of his business to residents of Southern District. Concluding that asserting personal jurisdiction over defendant was not unreasonable, court denied defendant's motion to dismiss complaint and/or transfer venue.

*Millennium Funding, Inc. v. 1701 Mgmt. LLC*, No. 21-20862, 2021 U.S. Dist. LEXIS 237925 (S.D. Fla. Dec. 13, 2021)

District court held that plaintiffs had established personal jurisdiction over defendants, but ultimately granted defendants' motion to dismiss due to failure to state claim. Plaintiffs asserted claims against defendants, including contributory and vicarious infringement, based on defendants' alleged publishing of false WhoIs records, which prevented plaintiffs from contacting end users and VPN companies regarding their infringing activities. Defendants argued that district court lacked personal jurisdiction and that venue was improper. First, court concluded that certain defendants were alter egos of each other due to overlapping CEO and directors, shared IP address, and shared counsel. Second, court concluded that general jurisdiction did not exist, as defendants were not registered in Florida and principal places of business were in other states. However, plaintiffs alleged that defendants had office in Miami and that defendants received IP addresses for its servers in Miami, and that some of those IP addresses were addresses through which copyright infringement allegedly took place. Court therefore concluded that basis existed for specific jurisdiction. Court further held that due process would not be violated by asserting personal jurisdiction over defendants, because defendants had established office in Miami, alleged infringement took place at Miami office, it was reasonably foreseeable that defendant could be haled into court in Florida due to office in Miami, and Florida had interest in adjudicating claims involving tortious acts alleged to have occurred within state borders. District court therefore held that exercising personal jurisdiction was proper. Although all defendants were not residents of Florida, substantial part of plaintiffs' claims allegedly took place in Florida, i.e., infringement via defendants' Miami IP addresses. District court accordingly concluded venue was proper.

*Williams v. Elliott*, No. 18-5418, 2021 U.S. Dist. LEXIS 138405 (E.D. Pa. July 23, 2021)

Court granted motion to dismiss. Plaintiff *pro se* filed complaint against defendants regarding songs allegedly written by plaintiff and Missy Elliott in Philadelphia between 1993 and 1996. Defendant Mosely, Florida resident, moved to dismiss complaint for lack of personal jurisdiction. In support of claim of jurisdiction, plaintiff relied on 1997 concert in Philadelphia, at which singer Aaliyah performed song in which defendant Mosley holds copyright interest. Court noted that courts have repeatedly rejected notion that deliberate targeting can be established solely through third party. Here, plaintiff relied entirely upon conduct of third party, *i.e.*, Aaliyah, rather than any conduct by defendant Mosley. Significantly, plaintiff did not present evidence to show that defendant Mosley collaborated with Aaliyah in any way to promote 1997 concert, such that he could be deemed to have deliberately targeted Pennsylvania, nor was there any evidence that defendant Mosley was physically present at concert. Court granted motion to dismiss for lack of personal jurisdiction.

*Will Co. Ltd. v. Yeung Lee*, No. 20-5802, 2021 U.S. Dist. LEXIS 122635  
(W.D. Wash. June 30, 2021)

District court granted motion to dismiss copyright claim brought by Japan-based adult film company against Hong Kong resident for lack of personal jurisdiction. Japan-based plaintiff created adult films that Hong Kong-based defendants hosted online without authorization. Plaintiff, which targeted U.S. market as well as Japan market, filed suit before it knew identities of owners of allegedly infringing site, and discovered through early discovery that defendants were based in Hong Kong. Plaintiff argued that jurisdiction was proper because approximately 4% of user traffic to defendants' site came from United States over past two years, representing approximately 5 million visitors; site had reference to DMCA in terms of service; site's servers were hosted in Utah; site's domain was registered with United States-based GoDaddy; and site received privacy services and domain resolution services from U.S. companies. On other hand, plaintiff and defendants were based in Asia, 96% of user traffic was based in Asia, and site revenue came from advertisements which came from outside of United States, though advertisers sometimes used geo-targeted ads that might have appeared to target U.S. visitors. Court found that defendants did not purposefully direct site at United States, citing previous cases finding that use of U.S. servers and web services, small percentage of U.S. visitors, and reference to DMCA, are insufficient to create jurisdiction. United States was also not focal point of harm suffered, with no allegations that any U.S. visitors to site actually viewed plaintiff's copyrighted videos. With these findings, court dismissed without analyzing remaining jurisdictional factors.

### **C. Pleadings**

*Gregorini v. Apple Inc.*, Nos. 20-55664, 20-55846, 2022 U.S. App. LEXIS  
4640 (9th Cir. Feb. 22, 2022)

Ninth Circuit reversed district court's dismissal of plaintiff's infringement complaint. Plaintiff, writer and producer of film *The Truth About Emanuel*, brought suit alleging that three episodes of defendants' television series *Servant* infringed her work. District court dismissed complaint on summary judgment on grounds that works were not substantially similar as matter of law. Ninth Circuit held that summary judgment is only appropriate at pleading stage when "as a matter of law the similarities between the two works are only in uncopyrightable material or are *de minimis*." Because "reasonable minds could differ on the issue of substantial similarity" and discovery would shed light on substantial similarity issue, Ninth Circuit reversed.

*Spin Master v. Alvy*, No. 19-3452, 2021 U.S. Dist. LEXIS 222374 (S.D.N.Y.  
Nov. 17, 2021)

Magistrate judge declined to recommend default judgment on plaintiff's infringement claims because claims insufficiently pleaded. Plaintiff toy and entertainment company designed and sold successful Twisty Petz products, and obtained copyright registration for Twisty Petz Packaging Artwork and Collectors' Guides. Plaintiff sued numerous sellers of counterfeit

Twisty Petz products for infringing plaintiff's copyright by "manufacturing, importing, exporting, advertising, marketing, promoting, distributing, displaying, offering for sale and/or selling infringing products which bear such Twisty Petz Work, or artwork that is, at a minimum, substantially similar to the Twisty Petz Work." Complaint did not provide any other factual support or show or describe defendants' allegedly infringing packaging, collector's guides or other artwork covered by plaintiff's registered copyright.

*Planck LLC v. Particle Media, Inc.*, No. 20-10959, 2021 U.S. Dist. LEXIS 214604 (S.D.N.Y. Nov. 3, 2021)

Court denied defendant's motion to dismiss, finding plaintiff sufficiently pleaded copyright and DMCA claims. Plaintiff Patch Media operated Patch.com, website divided into around 1,200 pages or "patches," each of which provided local news, classified ads, weather and other information for localities across United States. Defendant, competing company offering service called News Break, approached Patch Media in 2019 regarding acquisition or content sharing deal. Agreement never materialized but negotiations resulted in Patch sharing content with defendant under non-disclosure agreement. In addition, Patch attempted to work with defendant to disseminate information during COVID. To resolve issues with defendant's technology, Patch provided general feed of all headlines to defendant, allowing defendant to filter for and disseminate COVID-related content, and created profile on Patch's platform, which required Patch's IT employee to sign defendant's Terms of Service agreement on Patch's behalf. Without permission, defendant began publishing links to Patch's non-COVID-related content as well, resulting in misattribution of Patch's content and disruption of Patch's business model, which relied on web-based advertising. Defendant argued that license to Patch's content was created under Patch's Terms of Service agreement and, therefore, defendant did not infringe Patch's copyrights and also did not know or have reasonable grounds to know that distribution of Patch's content would result in removal of copyright management information and conceal infringement. Court disagreed, finding that Patch's IT employee lacked authority to bind Patch to agreement, and that defendant lacked reasonable basis to think otherwise, as court found that Patch also plausibly alleged that defendant was acting with fraudulent intent.

*Restellini v. Wildenstein Plattner Inst. Inc.*, No. 20-4388, 2021 U.S. Dist. LEXIS 181149 (S.D.N.Y. Sept. 22, 2021)

Court granted motion to dismiss infringement counterclaim for failure to identify works with specificity. Plaintiff art historian and defendant art institute had collaborated for years on creation of catalogue raisonné documenting works of artist Amedeo Modigliani. After collaboration ended prior to completion of catalogue, defendant digitized some of materials parties had created, with intention of making materials available to public at no cost. Plaintiff sued for infringement under U.S. and French law, following which defendant brought counterclaim alleging plaintiff infringed its collective work. On motion to dismiss counterclaim, district court considered whether claim was pleaded with sufficient specificity. Although plaintiff was not required, at motion to dismiss stage, to allege which elements of identified work were infringed, plaintiff must at least allege "'exhaustive' list of the

potentially infringed copyrighted works to ensure the claims reach all those works.” Here, counterclaim plaintiff alleged that its description was sufficient because notice requirement is satisfied “when large collections of allegedly infringing works are identified by categories rather than individually.” Court disagreed, pointing to S.D.N.Y. precedent finding that “even when large number of works are allegedly infringed and the works are identified by category,” plaintiffs are still required to identify, “at a minimum, representative examples of the works allegedly infringed.” Finding that counterclaim plaintiff failed to allege sufficient facts to allow court to evaluate other portions of infringement claim, court granted motion to dismiss counterclaim.

*Hartmann v. Apple, Inc.*, No. 20-6049, 2021 U.S. Dist. LEXIS 178822  
(S.D.N.Y. Sept. 20, 2021)

District court dismissed plaintiff’s claims for contributory infringement and foreign copyright infringement with leave to replead, and held that plaintiff had properly stated claim for direct infringement. Plaintiff alleged that Apple violated his copyright to *Austin Powers* and *After the Rain* by reproducing and distributing films on iTunes store. Plaintiff alleged that rights to films had been assigned to him. Apple argued that complaint failed to allege signed assignment, but district court found that facts alleged were sufficient to reasonably infer that assignments were signed. Apple also argued plaintiff made conflicting allegations of ownership of copyrights in state court case, but district court found that judicial notice was not appropriate for truth of matters asserted in other litigation and that statements in other case did not contradict complaint here. Apple additionally argued that plaintiff cited to certificates of recordation rather than copyright registration itself; district court held that plaintiff sufficiently pleaded ownership of copyrights even if he failed to state registration number. Regarding contributory infringement claims, district court held that plaintiff failed to allege Apple had knowledge that it was not authorized to copy or distribute films at issue. Instead, at most he alleged that Apple had general ability to discover his rights, but such allegations were too conclusory. Regarding foreign infringement, district court concluded that plaintiff’s complaint had failed to give Apple adequate notice of any foreign copyright laws it had allegedly violated and provided only non-exclusive list of countries where violations allegedly occurred. District court thus declined to dismiss direct infringement claim, dismissed contributory and foreign infringement claims, and granted leave to replead dismissed claims.

*Penske Media Corp. v. Shutterstock, Inc.*, 548 F. Supp. 3d 370 (S.D.N.Y. 2021)

Court denied motion to dismiss. Plaintiff, owner of archive of photographs taken for its magazines, including *Women’s Wear Daily*, *Variety*, *Deadline Hollywood*, and *Rolling Stone*, filed complaint against defendant licensing organization for infringement and violation of DMCA after defendant failed to remove nearly 2,300 photographs from its website after it terminated parties’ licensing agreement. Defendant moved to dismiss plaintiff’s amended complaint. Court found plaintiff sufficiently made out infringement

claim by alleging ownership of copyright and that defendant's license to use photographs terminated with termination of agreement.

*APL Microscopic v. Steenblock*, No. 21-356, 2021 U.S. Dist. LEXIS 134299 (C.D. Cal. July 8, 2021)

District court granted defendant's motion to dismiss without granting plaintiff leave to amend. Plaintiff's principal was "skilled and experienced creator of microscopic art," and owned copyright registrations for certain artworks. Plaintiff sent defendant "industry leader in the use of stem cells" demand letter, alleging that its artwork appeared on defendant's Facebook and Instagram pages. In response, defendant denied that it controlled those pages and denied that it had used plaintiff's images, but commented "that the photos were beautiful and asked how much" plaintiff would charge for using them. Plaintiff sued for direct, contributory and vicarious infringement and removal of CMI. District court first noted that plaintiff lacked standing to sue, as copyright registrations for artwork were held by plaintiff's principal personally and not by plaintiff entity, and plaintiff failed to show chain of title demonstrating its ownership of works. On motion to dismiss direct copyright infringement claim, district court found that plaintiff failed to plead sufficient facts and that allegations that defendant operated or controlled infringing Facebook or Instagram pages "are no more than conclusory and are based on mere speculation." District court criticized plaintiff for failing to fully inquire into ownership of pages, failing to respond to defendant's statements that it did not control pages, and responding to defendant's request for license by suing for infringement. Vicarious and contributory infringement claims similarly dismissed both because complaint did not identify instance of direct infringement and because, even if direct infringement was pleaded, other elements of those claims were not pleaded with sufficient particularity. DMCA claim for removal of CMI also dismissed, on basis that complaint contained "conclusory allegations that Defendant altered" CMI "but fail[ed] to provide enough facts about how this occurred." Court dismissed all claims with prejudice, noting that plaintiff already had opportunity to amend, and still "failed to clarify its initial pleading and instead included inconsistent facts" regarding ownership and infringement.

*Stebbins v. Polano*, No. 20-4184, 2021 U.S. Dist. LEXIS 122591 (N.D. Cal. June 30, 2021)

District court granted plaintiff leave to amend complaint to properly set forth factual allegations stemming from alleged infringing use of plaintiff's video content. Plaintiff accidentally broadcast live video on his Twitch channel. "Unbeknownst to Plaintiff, people who followed his Twitch channel could watch him in his daily activities. At one point, the live video included strange sounds that Plaintiff does not recognize. The strange noises were the most memorable part of an otherwise banal video." After he realized video was broadcast, plaintiff registered copyright and posted video on his YouTube channel, with access limited to followers who pay him \$20 per month. Defendant posted 50-second video on YouTube comprising 43-second clip directly from plaintiff's video, which defendant alleged was fair use parody. Court stated complaint adequately alleged ownership and copying; however, court held complaint did not comply with general pleading rules. Court

granted leave to amend to allow plaintiff to properly set forth claims, including numbering paragraphs, identifying factual allegations for each claim, and not referring to prior complaint.

*Hunley v. Instagram, LLC*, No. 21-3778, 2022 U.S. Dist. LEXIS 18036 (N.D. Cal. Feb. 1, 2022)

Court granted motion to dismiss without leave to amend. In prior proceeding, plaintiff sued defendant Instagram alleging that Instagram was secondarily liable for third-party infringement. Specifically, plaintiff argued that Instagram's embedding technology allowed third parties to copy HTML code of Instagram user's posts and paste it into third parties' websites, causing photo or video posted to Instagram user's accounts to be simultaneously displayed on third party sites. In response, Instagram cited *Perfect 10, Inc. v. Amazon.com, Inc.*, which held that "an alleged infringer displays an image in violation of a copyright holder's rights only if a copy of the image is embodied (stored) in a computer's server (or hard disk, or other storage device)," and argued that, because Instagram's embedding technology did not store images, third parties did not have copies of images for purpose of Act. Court granted Instagram's motion to dismiss, reasoning that court was bound by opinion in *Perfect 10* and that facts were similar, such that instant case should not be distinguished. However, court also recommended that plaintiff appeal case to Ninth Circuit, suggesting that plaintiff's arguments might be persuasive to Ninth Circuit, which has power to update precedent. Instead, plaintiff filed amended complaint, again arguing that *Perfect 10* had been decided incorrectly. Court concluded that deficiency in plaintiff's first two complaints could not be cured.

*Tucker v. Music Royalty Consulting, Inc.*, No. 20-6702, 2021 U.S. Dist. LEXIS 234198 (C.D. Cal. Oct. 26, 2021)

District court granted defendant's motion to dismiss plaintiff's "negligent" and "criminal" infringement claims. *Pro se* plaintiff alleged that she had entered into agreement with defendant pursuant to which she sold defendant four existing songs. Although plaintiff was informed that she would keep her copyright to songs, she was later informed that defendant had taken her entire catalog and therefore wrongfully received royalties from plaintiff's songs. Plaintiff's first complaints were so garbled and incomprehensible that they failed to comply with Fed. R. Civ. P. 8 and, upon her filing of third amended complaint, defendant moved to dismiss. One of plaintiff's claims was designated as "Negligence of United States Copyright Protected Intellectual Property under 17 U.S.C. §§ 1-1203 et. al. seq.; and 18 U.S.C. as it relates to 18 U.S.C. § 2319, relating to criminal infringement of a copyright," which court interpreted as raising negligent and/or criminal copyright infringement claims. Although plaintiff generally alleged "ownership of copyrights," she did not allege which of these copyrights were subject to this action. Moreover, negligent copyright infringement claim was not legally cognizable, and no private right of action exists for criminal copyright infringement.

*Symbria, Inc. v. Callen*, No. 20-4084, 2022 U.S. Dist. LEXIS 2719 (N.D. Ill. Jan. 6, 2022)

Court denied defendant's motion to dismiss. Plaintiff, parent company of businesses providing clinical health services for senior living and post-acute care providers, sued defendants, former corporate officers and employees of plaintiff, when defendants formed venture to compete against plaintiff in field of rehabilitation and wellness services to senior living and skilled nursing facilities. Plaintiff alleged that defendant infringed plaintiff's rights in its presentation slides relating to rehabilitation and wellness services, as well as disease management models. Defendant moved to dismiss claims, arguing that plaintiff had only identified copyrighted works without further describing their original elements or identifying their authors. Court sided with plaintiff, finding that plaintiff properly alleged that it owned copyright registrations for all works at issue and that plaintiff did not need to allege more at pleadings stage to demonstrate ownership of valid copyright. Two defendants also individually argued that they should not be lumped in because they did not have fair notice or access to plaintiff's copyrighted materials. Court disagreed, finding that plaintiff plausibly alleged that all corporate defendants worked in concert to reproduce and distribute copyrighted works. Accordingly, court found that collective pleading was permissible in context of case at hand and denied defendant's motion.

*Kipp Flores Architects, LLC v. Pradera SFR, LLC*, No. 21-673, 2022 U.S. Dist. LEXIS 68040 (W.D. Tex. Apr. 13, 2022)

District court denied motion to dismiss. Architectural firm brought infringement claim against developers and architect of residential project, where developers initially obtained designs from plaintiff before showing designs to defendant architect and asking defendant architect to make similar designs. Defendants moved to dismiss on basis that plaintiff failed to allege that defendant actually used copyrighted material to create work, by failing to identify protectible elements or make side-by-side comparison between works. Court held that plaintiff was not required to make such specific allegations in complaint, and merely needed to provide enough factual allegations to draw reasonable inference that elements of claim exist. Plaintiff alleged that defendants had access to plans, distributed plans among themselves, and that final buildings were copies of original plans. These allegations were sufficient and gave defendants notice of claims against them. Plaintiff also pleaded claim for contributory infringement based on defendant developer distributing plans to defendant architect.

*Energy Intelligence Grp. Inc. v. Peco Energy Co.*, No. 21-2349, 2022 U.S. Dist. LEXIS 19445 (E.D. Pa. Feb. 2, 2022)

Court granted plaintiff Energy Intelligence Group Inc.'s ("EIG") motion for leave to amend complaint. EIG sued defendant, another energy company, for infringement, alleging that defendant wrongfully distributed EIG's specialized newsletters, which provided articles and analysis on natural gas industry and global energy sector, to employees, even though defendant had maintained only one annual subscription since 2004. EIG's original claim was

based on data from its email monitoring system that indicated that emails to defendant delivering copyrighted newsletters were opened multiple times, over short period of time, using multiple unique devices. However, defendant revealed during settlement conference in August 2021 that since 2004 defendant had also been posting EIG's newsletters to shared drive accessed by several of defendant's employees. Within months, EIG sought additional discovery and moved to add allegations based on newly uncovered method of infringement to complaint. Court granted EIG's motion, finding that (1) amendment would not prejudice defendant (i.e., EIG did not meaningfully shift legal strategies and parties would not need to undertake substantial additional discovery); (2) EIG's motion was not unduly delayed; and (3) proposed amendment was not futile (i.e., EIG's new allegations of infringing acts since 2004 were timely, despite three-year statute of limitations, because claim did not accrue until EIG learned about shared drive in 2021). Further, as statute of limitations is affirmative defense, pleadings stage is not appropriate time for courts to consider whether plaintiff exercised reasonable diligence.

*MCS Indus. v. Michael's Stores, Inc.*, No. 21-2563, 2022 U.S. Dist. LEXIS 77948 (E.D. Pa. Apr. 29, 2022)

Court denied motion to dismiss. Plaintiff, owner of retail stores, owned two registrations for instructions for its Format Frames. Defendants owned art retail stores or designed and distributed retail picture frames. Plaintiff brought suit for infringement of Format Frames instructions. Defendants moved to dismiss second amended complaint, arguing that plaintiff failed to provide each defendant with notice of specific accusations, which amounted to group pleading. Court found plaintiff sufficiently specified acts each defendant committed and further alleged that "all share overlapping and inextricably intertwined roles in the governance and operation of" defendant's retail stores. Defendants also argued that plaintiff had no standing to sue because it failed to factually plead concrete examples of damages, but court found that complaint, which included request for compensatory damages and injunction and alleged reduction in sales since alleged infringement, was sufficient at pleadings stage.

*Bungie, Inc. v. Aimjunkies.Com*, No. 21-811, 2022 U.S. Dist. LEXIS 76823 (W.D. Wash. Apr. 27, 2022)

District court granted motion to dismiss. Plaintiff, owner of Destiny videogame franchise, brought copyright suit against creator and seller of cheat software called "Destiny 2 Hacks." Defendants moved to dismiss, arguing that plaintiff failed to sufficiently state claim. District court granted motion to dismiss because, although plaintiff had pleaded facts sufficient to establish ownership of copyright in games, it had not pleaded facts sufficient to plausibly allege that defendants had copied elements of work, and simply relied on conclusory allegations that cheat software infringed copyright in games.

*InSync Training, LLC v. Am. Soc'y for Training & Dev., Inc.*, No. 21-594, 2022 U.S. Dist. LEXIS 68604 (D.N.H. Apr. 13, 2022)

District court granted plaintiff's motion to amend complaint. Plaintiff, developer of "virtual and online training courses," had entered into license agreement with defendant, provider of

“professional development training,” granting defendant access to certain of its course materials. After defendant terminated license, defendant began offering its own courses, which plaintiff alleged were copied from its licensed materials. Plaintiff sued for infringement. Shortly after filing of complaint, defendant produced its competing course materials and plaintiff accordingly moved to amend pleadings to add details gathered from those documents. Defendant opposed motion to amend on grounds of futility. In considering whether motion to amend was futile, district court considered whether amended complaint sufficiently pleaded elements of infringement. District court found that defendant had access to plaintiff’s copyrighted materials (as result of license); that defendant developed its own competing materials in short time frame following grant of license; and that comparison of respective materials showed both probative and substantial similarity. Viewing claims in light most favorable to plaintiff, district court concluded that plaintiff adequately pleaded factual copying and substantial similarity, and granted motion to amend.

*Jay Blahnik Inc. v. WaterRower, Inc.*, No. 21-26, 2022 U.S. Dist. LEXIS 56491 (D.R.I. Mar. 29, 2022)

Court denied motion for judgment on pleadings. Plaintiff created media about rowing techniques and tutorials, and defendant manufactured rowing machines. Plaintiff released video for rowing techniques which described original method of rowing called 3x3, for which plaintiff held copyright registration. Plaintiff licensed rights in work to defendant from 2013 to 2017. After expiration of license, in 2020, plaintiff wrote to defendant informing it that defendant’s videos infringed plaintiff’s work. Defendant moved for judgment on pleadings, arguing that plaintiff could not claim exclusive rights in principles and techniques for achieving ideal rowing stroke, and that plaintiff failed to establish substantial similarity in copyrightable elements of videos, as defendant’s videos copied no images or charts and did not reference 3x3 technique. Court found defendant’s argument unconvincing, as defendant’s videos included language, organization, and examples similar to those in plaintiff’s work. Judgment on pleadings is proper only if uncontested and properly considered facts conclusively establish movant’s entitlement to favorable judgment, and court declined to deconstruct plaintiff’s videos to determine copyrightability at pleadings stage.

#### **D. Standing**

*Paul Rudolph Found. v. Paul Rudolph Heritage Found.*, No. 20-8180, 2021 U.S. Dist. LEXIS 188648 (S.D.N.Y. Sept. 30, 2021)

Court denied motion to dismiss copyright claim for lack of standing. Plaintiff alleged ownership of copyrights in several photographs, though plaintiff did not register copyrights until year after defendants used those photographs. Defendants moved to dismiss for lack of standing, arguing that plaintiff was not assigned rights to photographs by third party at time of defendant’s use. Court found that plaintiff sufficiently alleged that it was assigned rights to photographs at some point between their creation and alleged infringement, creating

standing. “One must register a copyright in order to bring suit for infringement; but one can own a copyright that is not registered.”

*Yellowcake, Inc. v. Hyphy Music, Inc.*, No. 20-988, 2021 U.S. LEXIS 135269 (E.D. Cal. July 20, 2021)

District court granted counter-defendant Yellowcake Inc.’s motion to dismiss counter-plaintiff’s claim alleging infringing use of musical albums created by counter-plaintiff Hyphy Music and counter-defendant Jesus Chavez. Chavez entered into oral agreement with music label, Hyphy, to provide services as recording artist and collectively produced four music albums. Chavez agreed Hyphy would own all title, right, and interest in masters of albums. Chavez purportedly sold his rights in albums to counter-defendant music label, Yellowcake. Yellowcake subsequently brought claim against Hyphy for infringement, and Hyphy filed counterclaim alleging same. Court discussed that Section 204 of Act requires that transfer of copyright ownership be in writing unless by operation of law, and further cannot be invoked defensively by third party to challenge such transfer when owner and transferee do not dispute its existence. Nonetheless, third party may challenge ownership for purpose of standing, as plaintiff must establish qualifying ownership interest as element of infringement claim and predicate for standing to bring claim. Hyphy, in its opposition, alternatively argued license was granted. Court stated license would not convey ownership interest sufficient to confer standing upon Hyphy. Thus, court held absence of written agreement between Hyphy and Chavez defeated Hyphy’s standing to bring infringement claim because cause of action did not allege valid ownership interest in copyrights at issue.

*Milo Enters. v. Bird-X, Inc.*, No. 18-6315, 2022 U.S. Dist. LEXIS 53097 (N.D. Ill. Mar. 24, 2022)

Defendant Bird-X, Inc. sold bird repellent products, including items marked with predator eyes to scare away birds, under mark SCARE-EYE. Plaintiff began selling similar bird repellent balloons under name VisualScare, describing products as “Scary Eye Balloons.” Upon learning of plaintiff’s products, Bird-X filed several Amazon takedown requests claiming trademark infringement, and filed one takedown request mistakenly claiming copyright infringement, instead of trademark infringement. It was undisputed that defendant intended to claim only trademark infringement, and mistakenly included copyright infringement claim due to confusion about relevant law. Defendant’s Amazon complaints were successful, resulting in removal of several of plaintiff’s posts and images. In response, plaintiff filed instant action seeking declaratory judgment that plaintiff had not infringed Bird-X’s copyrights. Court found plaintiff had no grounds to bring action, given that defendant’s copyright takedown request had been filed by mistake, and therefore there was no evidence of any real or immediate threat that Bird-X would bring copyright infringement lawsuit. Accordingly, court granted defendant’s motion for summary judgment. Court also granted defendant’s motion for summary judgment as to plaintiff’s claim of DMCA violation, reasoning that defendant’s allegation of copyright infringement should not be considered evidence of material misrepresentation, even though claim led to removal of allegedly infringing material, due to defendant’s confusion.

*Great Bowery v. Cascade Digital Media LLC*, No. 20-9, 2021 U.S. Dist. LEXIS 159802 (D. Or. July 15, 2021)

District court granted defendant's motion for summary judgment. Plaintiff, photography licensing agency, brought infringement action against defendant for display of photographs on website. Plaintiff entered into agreement with photographer Annie Liebovitz to license certain copyrighted images of her photographs. At issue in case were two images of Caitlyn Jenner taken by Liebovitz for *Vanity Fair*. Liebovitz sent authorization letter to plaintiff to act on her behalf in all matters relating to copyright infringement of work. Defendant moved for summary judgment, arguing agreement not sufficient to confer on plaintiff standing to bring copyright action, and authorization letter did not transfer copyright ownership or exclusive license to plaintiff. Court agreed and granted motion. Agreement allowed photographs to become licensed images only when provided to plaintiff by photographer. Plaintiff did not submit evidence showing photographer provided photographs to plaintiff. Therefore, images not subject to agreement and no transfer of copyright ownership occurred. Because plaintiff did not provide documents showing exclusive right to photographs, it had no standing to bring action.

#### **E. Miscellaneous**

*SoundExchange, Inc. v. Music Choice*, No. 19-999, 2021 U.S. Dist. LEXIS 242394 (D.D.C. Dec. 20, 2021)

Court referred dispute to Copyright Royalty Board ("Board"). Plaintiff SoundExchange, organization responsible for distributing performance-based royalties for sound recordings, brought suit against defendant Music Choice, Business Establishment Service ("BES"), for unpaid royalties, which are set by Board. Parties disputed interpretation of "Gross Proceeds" in Board's regulations, of which portion constitute statutory royalty rate for BES providers. Under Music Choice's interpretation, "Gross Proceeds" are portion of actual proceeds that correspond to music channels offered only as part of its BES service. Plaintiff, however, argued that defendant owed royalties on proceeds that correspond to music channels used in BES service, even if defendant used channels as part of separate service. In response to court's request for supplemental briefing, plaintiff argued that court should refer regulatory interpretation question to Board based on doctrine of primary jurisdiction, due to Board's expertise over interpreting its own rate regulations; defendant argued that reference was not appropriate because Board lacked authority to enforce license regulations or to determine payment disputes, and further argued that statutory and regulatory interpretation is routinely determined by district courts. Court first determined that Board had jurisdiction to clarify its regulations, despite fact that it was not initial entity from which regulations originated. Court then determined that referral was appropriate because factors supported invoking primary jurisdiction weighed in favor of referral: dispute fell within Board's expertise; guidance from Board regarding regulatory interpretation would lessen risk of inconsistent rulings; and there was no evidence that reference would lead to significant delay. Court ordered that regulatory interpretation question be referred to Board and stayed district court action pending decision from Board.

## II. COPYRIGHTABILITY

### A. Originality

*Gray v. Hudson*, 28 F.4th 87 (9th Cir. 2022)

Ninth Circuit affirmed district court's order vacating jury award and granting judgment as matter of law to defendants on plaintiff's copyright infringement claims. Plaintiffs, Christian hip-hop artists, claimed that ostinato (repeating instrumental figure) in Katy Perry's "Dark Horse" infringed similar ostinato in their earlier-released song "Joyful Noise." After trial centered on musical expert testimony regarding substantial similarity, jury awarded plaintiffs \$2.8 million in damages; district court vacated award and granted JMOL to defendants, concluding that trial evidence was legally insufficient to show that "Joyful Noise" ostinato was copyrightable. On appeal, under extrinsic test for substantial similarity, Ninth Circuit affirmed, holding that trial evidence was insufficient to establish that "Joyful Noise" ostinato's musical elements were individually copyrightable. Shared elements of two ostinatos were nothing more than common musical building blocks. Works' similar timbre did not help plaintiffs because they sued only for infringement of "Joyful Noise" composition, not sound recording, and in any case use of synthesizers to accompany vocal performers is commonplace in popular music. Plaintiffs' specific combination of unprotectable musical elements was likewise unprotectable because overlapping portion of parties' works consists of manifestly conventional arrangement of musical building blocks, especially in light of limited number of expressive choices available for eight-note repeated musical figure such as ostinatos at issue.

*Cub Club Inv., LLC v. Apple Inc.*, No. 21-6948, 2022 U.S. Dist. LEXIS 28086 (N.D. Cal. Feb. 16, 2022)

District court granted defendant's motion to dismiss. Plaintiff, developer of phone application that allowed users to send racially diverse emojis, brought copyright claim against Apple, Inc., alleging that Apple copied plaintiff's application. Apple moved to dismiss. Court found that plaintiff had not alleged copying of any protectable element of its emoji. Specifically, plaintiff's emoji was entitled to "thin" copyright protection against "virtually identical" work because "there aren't many ways that someone could implement" plaintiff's idea of racially diverse emoji. Court held that there were numerous differences between Apple's emoji and plaintiff's, namely how emojis were filled in, shape of emojis, and coloring of skin tones, such that Apple's emoji were outside realm of plaintiff's protected expression.

*Bruce Munro & Bruce Munro Ltd. v. Fairchild Tropical Botanic Garden*, No. 20-20079, 2022 U.S. Dist. LEXIS 27504 (S.D. Fla. Jan. 13, 2022)

District court granted defendants' motion for summary judgment on direct infringement, contributory infringement, and DMCA claims. Plaintiffs artists filed infringement claim against defendants for allegedly infringing display of sculptures at event. Defendants argued

plaintiffs could not prove valid copyrights because works were merely useful articles and lacked requisite originality. Court granted deference to Copyright Office's determination that sculptures were simply useful articles – as evidenced by Office's three rejections (once initially and twice on reconsideration) of plaintiff's application to register design – and did not contain requisite originality to support copyright. Court found sculpture's arrangement of individual elements was not sufficiently original combination of functional components. As first element of direct copyright infringement claim was not satisfied, court found defendants were entitled to summary judgment. Contributory infringement claim also failed because there was no direct infringement, so defendants were also entitled to summary judgment on that claim. Finally, court agreed with defendants that DMCA claim failed. Plaintiffs did not create allegedly infringing works and therefore could not establish defendants knowingly and with intent to enable infringement provided or distributed false CMI. Defendants entitled to summary judgment on DMCA claim.

*NOCO Co. v. Shenzhen Dingjiang Tech. Co.*, No. 21-1483, 2022 U.S. Dist. LEXIS 3911 (N.D. Ohio Jan. 7, 2022)

Court denied defendant's motion to dismiss infringement claim. Plaintiff designed, produced and sold battery chargers, jump starters, related products and accessories for motor vehicles. Plaintiff also created images, designs and displays to market its products, including photograph "Boost in Hand," which showed battery being held in hand. Plaintiff sued defendant, claiming that defendant's marketing photograph, which also showed hand-held battery being held by hand, infringed plaintiff's copyrighted image. Court indicated that common image of hand holding battery, which court identified as main similarity between photos, was arguably subject to only thin protection. Court also stated that plaintiff's claims appeared to be "very weak" and that it was questionable whether plaintiff should have been permitted to copyright photo of hand holding battery in first place, as there are relatively few ways that handheld device can be displayed, and that even slight differences between those elements of originality, such as posing of subjects, lighting, angle, and evoking certain desired expression, in each image were discernable. Nevertheless, court found plaintiff properly alleged claim, emphasizing low threshold for establishing originality of image (i.e., independently created and possessing minimal degree of creativity), and denied defendant's motion to dismiss.

*Berry Hill Dev. Corp. v. Scott*, No. 20-1874, 2021 U.S. Dist. LEXIS 165494 (E.D.N.Y. Aug. 31, 2021)

Magistrate judge recommended denial of defendants' motion to dismiss plaintiff's infringement claims. Plaintiff, high end residential property designer and builder, contracted with architect to create architectural plans for defendants Billy and Alexa Joel via their LLC, defendant F. Scott. Plaintiff registered copyrights in main house and garage plans, then sued Joels, their management firm, F. Scott, and replacement architect Neil-James Stufano for, *inter alia*, copyright infringement. Defendants moved to dismiss, arguing that plaintiff's plans were unprotectable as unoriginal because they merely incorporated design aspects of existing residence and garage, and because certain elements of garage plan (e.g., number of

parking spots) were functional. Magistrate recommended denial of motion because it was impossible to conclude as matter of law that all elements of plaintiff's plans were unprotectable, as certain elements thereof (e.g., wall arrangements) possessed some creative spark. Accordingly, plaintiff's allegations were sufficient to allow comparison of parties' respective plans' total concept and overall feel.

*Speedway Motors, Inc. v. Perlmutter*, 553 F. Supp. 3d 703 (D. Neb. 2021)

Court denied plaintiff's motion for summary judgment and granted Register's motion for summary judgment in dispute arising from Copyright Office's denial of protection for plaintiff's corporate logos on basis that logos not sufficiently creative. Plaintiff marketed goods in performance vehicle field, including parts for race cars, hot rods, and vintage cars. Speedway applied for following logos: (1) "Speedway Motors Logo" which "features multiple elements which are the result of deliberate creation, selection, and arrangement," including "highly stylized" font, and "the tail of the 'y' extending into a complex, asymmetric dark purple line art"; (2) "S Logo" featuring "highly stylized 'S' shape" and "multi-featured asymmetric dark purple line art shape" resulting in "unique, non-typical, stylistic" logo creating "striking impression"; and (3) "Team Speedway Motors Logo" with "many of the same features" as Speedway Motors Logo and addition of word "Team" in "different stylized form from the other words." Copyright Office argued that logos lacked creative authorship necessary for copyright protection, and instead comprised familiar symbols or designs; basic geometric shapes; words and short phrases; and/or typography, none of which are protectable, and that arrangement of such elements was also insufficiently creative. Plaintiff argued that logos "symbolized the racing and performance automotive industries while still referencing classic features of the Speedway Motors brand" and were sufficiently creative as matter of law given author's inspiration and intended effect, and that Office's denial was arbitrary and capricious, given registration of corporate logos in past. Court agreed with Copyright Office, finding that Office provided satisfactory explanation for rejection of applications, including that issue should properly turn on how work is perceived and not on author's intent. Court further reasoned that, given rational basis for rejection, denial of applications was not "arbitrary and capricious," and, instead, was more likely difference of opinion, especially given how difficult it is to draw simple line between "some" and "not enough" creative authorship.

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

*Dellamorte, LLC v. Michaels Cos.*, No. 21-2029, 2022 U.S. Dist. LEXIS 14887 (D.N.J. Jan. 27, 2022)

Court denied defendant's motion to dismiss for failure to state claim. Case centered around defendant's alleged infringement of plaintiff's Vampire Bat Mug. Artist Locascio sculpted and created Vampire Bat Mug and, upon receiving registration, assigned all rights to plaintiff, who manufactured, advertised and sold work. Plaintiff alleged that defendant began selling vase decorated with bat design copied from work. Defendants argued that there was no substantial similarity between protectable elements of mug and vase. While

court agreed that mug shape was not protectable, court found bat sculpture, waxing moon and arch handle were all protectable elements, as design could be separated from mug without simply replicating mug and could exist in another medium. Further, court found sufficient similarity between designs to pass pleading stage. Lastly, plaintiff alleged facts sufficient to establish defendant had access to Vampire Bat Mug, specifically those related to plaintiff's extensive advertising on social media and internet.

### C. Miscellaneous

*Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 9 F.4th 1167 (9th Cir. 2021)

Ninth Circuit reversed district court's grant of partial summary judgment to plaintiff, holding that California's common law copyright statute did not create public performance right for pre-1972 sound recordings. Plaintiff, company managing rights in Turtles sound recordings, sued Sirius XM, digital and satellite radio provider, for, *inter alia*, violating California's copyright law by publicly performing pre-1972 sound recordings without compensating artists. California's copyright statute was first enacted in 1872, providing creators with "exclusive ownership" of unpublished works. Most current (1982) version of California's copyright statute provides that author of pre-1972 sound recording has "exclusive ownership" therein until 2047 as against all persons except those making cover recordings. District court held, based on dictionary definitions of "exclusive" and "ownership" as well as 1982 statute's exception for only cover recordings, that "exclusive ownership" included right of public performance. Ninth Circuit reversed, holding that, due to statute's continued use of "exclusive ownership" (despite three amendments), that wording had to be given same meaning as it had under California's common law copyright in 1872, which did not include right of post-sale public performance. Because Sirius only publicly performed (and did not buy, reproduce or resell) plaintiff's pre-1972 sound recordings, Sirius did not violate plaintiff's copyright rights.

*Joint Stock Co. "Channel One Russ. Worldwide" v. Infomir LLC*, No. 16-1318, 2022 U.S. Dist. LEXIS 35107 (S.D.N.Y. Feb. 25, 2022)

Summary judgment denied to Russian broadcasters on copyright infringement claim against U.S. entity that rebroadcast plaintiffs' channels, as plaintiffs' claimed rights were "neighboring rights," category of rights protected by Russian law, rather than copyright rights. Plaintiff producers and broadcasters of local Russian-language television channels sued defendants, who sold plaintiff's programming to Russian speakers in United States over internet without authorization. Defendants admitted to business model but argued that channels were local "free to air" Russian channels not produced for licensed broadcast in United States and elsewhere. Court denied summary judgment for plaintiffs, finding that because plaintiffs did not claim to own registered copyright in works at issue, they could only invoke Act if they established that they owned unregistered copyrights under foreign law protected by Berne Convention, and those works were not "United States works." Plaintiffs failed on both counts. First, rights claimed by plaintiffs were "neighboring rights," category of rights not protected by Berne Convention. Neighboring rights under Russian law

are rights of broadcaster to broadcast and rebroadcast content, even if broadcaster does not own rights to all copyrightable elements within work, and this concept is not recognized by Berne Convention. Second, because plaintiffs claimed to hold only neighboring rights during discovery to avoid producing documents concerning any ownership of rights in underlying works, they could not then claim to hold copyrights in underlying works to obtain summary judgment. Third, plaintiffs failed to factually substantiate their alleged underlying rights, or that works were not “United States works.”

*Pilkin v. Google LLC*, No. 21-1483, 2021 U.S. Dist. LEXIS 153028 (N.D. Cal. Aug. 13, 2021)

District court granted defendant’s motion to dismiss. Plaintiff, Moscow resident, filed suit against Google for infringement. Plaintiff alleged that his “nondramatic literary original work” was incorporated into Google Maps without his authorization. Google moved to dismiss, arguing that plaintiff was improperly seeking copyright protection for ideas and functional concepts. Plaintiff’s work described various alternative processes of implementing interactive map. Court found that while work described wide range of ideas for possible expressions of features described, it did not actually convey any particular expression of those features. Accordingly, court granted defendant’s motion to dismiss with prejudice.

*Compulife Software v. Rutstein*, No. 16-80808, 2021 U.S. Dist. LEXIS 160881 (S.D. Fla. July 12, 2021)

Following bench trial, district court held that significant portions of plaintiff’s software code were unprotectable. Plaintiff and defendants were competitors who generated online life insurance quotes. Plaintiff registered source code with Copyright Office via several registrations and later became aware that defendants were using plaintiff’s source code without permission to provide life insurance quotes to consumers. After plaintiff shut down defendant’s access to plaintiff’s software, plaintiff discovered its life insurance quotes had reappeared on defendant’s website. Another defendant engaged in scraping attack, sending over 800,000 quote requests to plaintiff’s server. Plaintiff sued defendants for copyright infringement. At trial, plaintiff alleged that its sales declined due to defendants’ activities. Factual copying of plaintiff’s copyrighted material was not disputed. Regarding legal question of copying, court reviewed plaintiff’s copyrighted material in detail and determined that although defendants appeared to copy high portion of plaintiff’s code, majority of copied elements were not protectable: menu options within plaintiff’s site fell within merger doctrine, because it is industry standard to request age, gender, health, and location of applicant, and only few ways exist to gather and ask for such information. For example, district court held that using radio button rather than drop-down menu to identify applicant’s gender did not constitute original expression. Court thus concluded that defendants met their burden of establishing that much of plaintiff’s source code did not constitute protectable expression, and held that small of amount of copied material that was potentially protectable did not support infringement claim.

### III. OWNERSHIP

#### A. Works Made for Hire

*Horror Inc. v. Miller*, 15 F.4th 232 (2d Cir. 2021)

Second Circuit affirmed district court judgment for plaintiff, holding that plaintiff was independent contractor such that his screenplay was not work for hire. In 1979, appellee Miller, screenwriter and member of union Writers Guild of America, East, entered into standard WGA employment agreement with appellant Manny Co. to write *Friday the 13th* screenplay in exchange for two lump-sum payments, with Manny unable to assign additional projects under parties' agreement. Miller and Manny's principal collaborated, but Miller drafted screenplay in his own home, on his own time schedule and using his own materials. Miller also received sole "written by" credit, even though Manny's assignee subsequently registered screenplay as work for hire with Copyright Office. Appellant Horror Inc. ultimately acquired rights to *Friday the 13th* franchise, including screenplay. In 2016, Miller gave notice to Manny purporting to terminate Miller's transfer of copyright rights under § 203; Manny countered that, because Miller was Manny's employee when writing screenplay, copyright ownership vested in Manny as work made for hire, so that Miller's termination notice was of no effect. On parties' cross-motions, district court granted summary judgment to Miller, holding that screenplay was not work for hire, and that Miller was screenplay's author and entitled to terminate Manny's and Horror's U.S. copyright rights. Manny and Horror appealed, arguing, *inter alia*, that Miller's WGA membership inherently created employer-employee relationship between Manny and Miller. Second Circuit held that under *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989), Miller's status as "employee" is determined under common law of agency, rather than labor law (which has more expansive definition of "employee" in light of its goal of protecting workers). Because Miller's treatment under WGA collective bargaining agreement was not determinative, district court properly looked at *Reid* factors for determining employment status. Although Manny had control over manner and means of creation of Miller's screenplay – which weighed in favor of Miller being classified as employee, all other *Reid* factors weighed in favor of independent contractor classification. Miller: was professional screenwriter with skill and expertise; received no traditional employee benefits (such as vacation time, workers' comp or pension); was not treated as employee for tax purposes; could not be assigned additional projects by Manny; was engaged only for short period of time; received lump-sum payments upon project completion; and created screenplay using own tools in own home on own schedule. Further, registration of screenplay copyright as work for hire was not determinative. Because Miller was not Manny's employee when creating screenplay, it could be work for hire only if specially commissioned by Manny pursuant to express signed agreement, which did not exist. Therefore, screenplay could not be work for hire, and Miller was its author, such that he could terminate grant of rights to Manny and Horror.

*Can. Hockey, L.L.C. v. Marquardt*, No. 20-20530, 2022 U.S. App. LEXIS 2371 (5th Cir. Jan. 26, 2022)

Fifth Circuit dismissed Defendant's interlocutory appeal of denial of summary judgment for lack of jurisdiction. Plaintiff sportswriter and publishing company owner hired writer to create book entitled *12th Man*, regarding athlete E. King Gill at Texas A&M University ("TAMU"), who suited up at halftime during 1922 football game due to concern that injured TAMU team would run out of reserve players. Plaintiff interviewed defendant, associate director of media relations at TAMU, regarding Gill and later sent defendant draft copy of book. Defendant copied selected portions of draft to create article for university fundraising purposes and removed references to plaintiff. After TAMU posted article online, plaintiff asserted direct and contributory infringement claims under Copyright Remedy Clarification Act (CRCA) and claim under DMCA. District court denied both parties' motions for summary judgment due to genuine issues of material fact as to ownership of copyright and rejected defendant's qualified immunity defense. On appeal, defendant argued that plaintiff had not entered into valid work for hire agreement with writer, and therefore did not own copyright in work at issue. Court held that such dispute created genuine issue of fact over ownership of copyright, but court lacked jurisdiction to review factual dispute in connection with interlocutory appeal. Fifth Circuit accordingly dismissed defendant's appeal with respect to copyright claims due to lack of jurisdiction.

*Markham Concepts, Inc. v. Hasbro*, 1 F.4th 74 (1st Cir. 2021)

First Circuit affirmed district court's finding that work was made for hire and therefore plaintiffs did not have termination rights. In 1959, Reuben Klamer contacted Bill Markham about developing "The Game of Life" boardgame. Klamer worked with Markham and his firm to create prototype, and Klamer paid Markham and his firm's expenses. Milton Bradley expressed interest in game following pitch by Klamer and Markham, and parties entered into two agreements. First agreement was license between Milton Bradley and organization co-owned by Klamer and third-party Art Linkletter ("Link Research"), and second agreement was assignment between Link Research and Markham, noting that "Markham had 'invented, designed[,] and developed [the] game,'" and assigning all of Markham's interest to Link Research. In exchange, Markham was provided non-refundable advance and amount to cover prototype costs, which had already been covered by Klamer. Markham and Klamer fought for decades over creation of game, and, in current suit, plaintiffs, successors-in-interest to Markham, sued Klamer, Linkletter's heirs, and Hasbro, successor to Milton Bradley, seeking declaration that they have right to terminate under 1976 Act. Parties agreed termination rights are not at issue for works made for hire, so question of whether work was made for hire was central to dispute. After bench trial, district court found that game was work for hire under "instance and expense" test. Plaintiff appealed, arguing that district court applied incorrect test on work for hire determination and, even if test was correct, court's conclusion was faulty. First Circuit first determined that "instance and expense" test under 1909 Act was proper test, and rejected appellants' argument that "standard agency principles" from *Reid* should apply to pre-1976 works, finding it was precedent bound and otherwise not persuaded to apply different test. Second, in applying test, court found that

work was made for hire. In doing so, court found district court's conclusion that game was made at Klamer's expense supported. It also found that language from assignment did not rebut presumption that resulted from "instance and expense" test.

*Treadway Gallery, Inc. v. John Toomey Gallery, Inc.*, No. 19-664, 2022 U.S. Dist. LEXIS 57949 (S.D. Ohio Mar. 30, 2022)

District court granted summary judgment in favor of defendants after determining that works at issue were not owned by plaintiff. Plaintiff acquired, consigned and auctioned high-end works of art, décor, and furniture, and operated gallery and conducted auctions. Defendant Toomey was another gallery that published catalogs of merchandise with plaintiff and conducted joint auctions with plaintiff. Defendant Thomas Vogel was photographer who took photos for plaintiff's catalogs. Plaintiff sued defendants for infringement due to defendants' alleged copying and displaying photographs at issue on defendant Toomey's website. Plaintiff claimed that Vogel was employee of plaintiff when works were created. District court evaluated nonexclusive list of 13 *Reid* factors to determine employment status of photographer. Plaintiff had ultimate control over which images were suitable to publish in joint auctions' print and online catalogs. In addition, photographer often used plaintiff's equipment and was available to plaintiff "24/7" before working relationship ended. Such factors weighed in favor of concluding that photographer was plaintiff's employee. However, district court ultimately concluded that photographer was not plaintiff's employee, because of high degree of skill required of photographer, and because plaintiff and photographer perceived photographer as independent contractor at various points throughout photographer's business relationship with plaintiff. District court therefore held that works at issue were not owned by plaintiff and dismissed infringement claims.

*Whyte Monkee Prods., LLC v. Netflix, Inc.*, No. 20-933, 2022 U.S. Dist. LEXIS 76440 (W.D. Okla. Apr. 27, 2022)

District court granted defendants' motion for summary judgment. Defendant Netflix released *Tiger King: Murder, Mayhem and Madness*, featuring story of Joe Exotic. Series was produced by defendant Royal Goode Productions. Plaintiff Timothy Sepi filmed eight videos, which were allegedly produced by plaintiff Whyte Monkee Productions, LLC, while Sepi was working at Exotic's Gerald Wayne Interactive Zoological Park. After release of *Tiger King*, Sepi registered works and brought suit for infringement. Defendants moved for summary judgment on grounds that seven videos were not owned by plaintiff because they were works for hire; inquiry therefore centered on whether videos were made within scope of Sepi's employment by Park. Employing three-party test from Restatement (Second) of Agency, court found that videos were made in scope of Sepi's employment. First, videography was conduct "of the kind" Sepi was employed to perform because at earlier deposition in unrelated case Sepi testified that he was hired to perform videography and court found contrary deposition testimony was attempt to create sham issue of fact. Further, third-party declaration was insufficient to create question of fact because it was conclusory and bereft of supporting facts. Finally, even if recent deposition testimony, where Sepi maintained he was employed to provide photographs and not videos, was credited,

videography is sufficiently related to photography to be “of the kind” Sepi was hired to perform. Second, Sepi’s work was filmed at or near Park and at least some of his work was completed at Park’s studio, using equipment provided by someone at Park for Sepi to use. Third, Sepi’s work was created, in part, to serve Park’s purpose to provide publicity for park and Exotic. Court therefore found that no reasonable juror could find videos were created outside Sepi’s scope of employment.

## **B. Termination of Transfers**

*Acuti v. Authentic Brands Grp. LLC*, 33 F.4th 131 (2d Cir. 2022)

Second Circuit affirmed dismissal of claim. Plaintiffs were successors in interest to Hugo Peretti, who in 1961 authored, in part, composition “Can’t Help Falling in Love,” later popularized by Elvis Presley. In 1983, after passage of 1976 Act, Peretti and family members assigned rights and interests in composition’s renewal term to defendants’ predecessors-in-interest. Peretti, however, died in 1986, three years before end of initial term. In 1989, Peretti’s successors-in-interest registered copyright for renewal term, and, in 2014, Peretti’s daughter and widow served defendants with Notice of Termination pursuant to § 203. After defendants disputed termination, plaintiffs sought declaratory judgment that termination was effective. District court dismissed plaintiffs’ claim, finding that Notice of Termination was ineffective because 1983 assignment was not assignment “executed by the author” under § 203. Plaintiffs appealed. Beginning with statutory text, Second Circuit rejected plaintiffs’ argument that author’s signature on document granting rights in copyrighted work constituted “execution” of grant by author. Instead, § 204(a) states that execution of transfer of ownership must be “in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.” But individual cannot convey rights she does not yet have and court held that, because, at time of 1983 assignment, Peretti’s interest in renewal period had not yet vested, 1983 assignment provided defendants’ predecessors with Peretti’s unvested right to renew copyright, contingent upon him surviving to renew. Rights that were granted by Peretti’s wife and daughters in assignment were effective, but they were not “grants executed by the author.” Accordingly, because 1983 assignment did not fall within purview of § 203, it could not be terminated by Peretti’s daughter and widow in 2014. Court found that language of § 203 was clear and that statutory context, further supported by legislative history, indicated Congressional intent that termination rights were not available to Perettis.

*Yoakam v. Warner Music Grp. Corp.*, No. 21-1165, 2021 U.S. Dist. LEXIS 164915 (C.D. Cal. July 12, 2021)

Court denied defendant’s motion to dismiss infringement claim. Plaintiff, country artist Dwight Yoakam, entered into recording agreement with defendant Warner Bros. Records in 1985. Agreement granted Yoakam’s copyright interests in numerous sound recordings and music videos to defendant. On February 5, 2019, Yoakam served termination notices on defendant for several of plaintiff’s songs and videos. Notices gave effective termination dates exactly thirty-five years from date of publication, which was first date on which

termination could be affected under Section 203 of Act. However, due to clerical error, service date of notice fell five days short of two-year minimum notice period. As result, defendants refused to acknowledge that Yoakam had validly terminated copyright grant for those songs. Yoakam sued, claiming infringement. Defendant argued that plaintiff failed to state claim for infringement because he did not plausibly allege ownership of copyrights in songs, given clerical error concerning service date, and that harmless error rule cannot be invoked to cure error in effective date of termination listed in author's notice. Court disagreed, finding that error alleged by plaintiff plausibly fell within ambit of harmless error regulation, which states that error is harmless if it does not materially affect adequacy of information required to serve purpose of notice. Court further found that excusing plaintiff's error in this case was consistent with statutory termination requirements. Accordingly, court held that plaintiff plausibly alleged ownership of copyrights in works and, therefore, defendant's motion to dismiss infringement claim was denied.

### **C. Joint Works and Co-Ownership**

*Brooks v. Dash*, 852 F. App'x 40 (2d Cir. 2021)

Second Circuit affirmed district court's ruling that defendant infringed plaintiff's copyright because parties were not co-authors. Prior to meeting defendant, plaintiff wrote book series as well as film script based thereon. Parties' unsigned agreements provided that plaintiff would make all final decisions regarding film, while defendant would provide directing and marketing services for plaintiff's film on work-for-hire basis in exchange for 50% royalty. Defendant made substantial contributions to film, including some cast and crew selection, shooting and directing film, and making certain creative decisions. Defendant claimed that parties had orally agreed to 50/50 split of ownership of film's copyright and therefore film was joint work of which he was co-author, or else that he was dominant author and therefore copyright owner. After bench trial, district court held that testimony and documentary evidence supported conclusion that parties did not intend to be co-authors, permanently enjoined defendant from marketing or copying film, and awarded plaintiff actual damages of \$300,000. Second Circuit, finding no clear error in district court's holdings, affirmed, holding that defendant's contributions to film did not evidence mutual intent of co-authorship but merely reflect services in exchange for which defendant received 50% of film's profits. Moreover, because book series and film were written prior to parties' agreement, district court reasonably concluded that plaintiff was dominant author.

*Webber v. Dash*, No. 19-610, 2021 U.S. Dist. LEXIS 163780 (S.D.N.Y. Aug. 30, 2021)

Court denied plaintiff's summary judgment motion, finding factual issues existed as to intended ownership or authorship of film. Plaintiff film production company sued defendant for, *inter alia*, declaration that plaintiff was sole author and owner of copyright in film. Parties agreed that no written agreement existed, but defendant advanced numerous contradictory statements as to existence of oral agreement, first testifying that nature of parties' relationship was unclear, then claiming that he became co-owner in exchange for

directing and producing film, before again testifying that he had no recollection of any agreement with plaintiff. Parties disputed one another's intentions with respect to authorship and contributions to film. Plaintiff submitted evidence that it entered into cast and crew contracts, that defendant admitted he was "hired" by plaintiff and was not co-owner, and that defendant was high and disruptive on set without making any material contributions. Defendant submitted evidence that he provided equipment, his house for shooting location, input on film script and editing, and coaching to actors and crew. Court held that no enforceable agreement existed regarding ownership or authorship because defendant violated sham affidavit rule by submitting declaration intended to contradict deposition testimony, thus there was no competent evidence of oral agreement and, even if oral agreement existed, it was unenforceable under statute of frauds. However, court found that factual issues regarding parties' intent and contributions to film precluded summary judgment as to whether parties intended to be co-authors or, even if not, whether defendant was dominant author.

*Armes v. Post*, No. 20-3212, 2022 U.S. Dist. LEXIS 71155 (C.D. Cal. Apr. 18, 2022)

Court granted in part and denied in part defendants' motion for summary judgment. Plaintiff, professional musician, was encouraged by manager of defendant Austin Richard Post p/k/a Post Malone ("Post") to collaborate with Post. On August 8, 2018, plaintiff worked with Post and defendant Adam King Feeney p/k/a Frank Dukes ("Dukes") to create composition that three musicians reduced to recorded file on Dukes's laptop, containing bassline, looping chord progression, drums, lead guitar lines, and fragments of vocals with and without lyrics ("Session File"). Approximately one year later, after other collaborators made contributions to composition, composition was released as "Circles" ("Commercial Release Composition"), as Post's fourth number one song on U.S. Billboard Hot 100. Plaintiff reached out to manager for co-writer credit and royalties, but parties did not reach agreement, and defendants refused to credit plaintiff as co-writer of work. Plaintiff sued for declaration that he was joint author of "Circles" composition and entitled to royalties. On same day plaintiff filed suit in California, Post filed suit in New York, seeking declaration that plaintiff was not co-author of Commercial Release Composition. Parties stipulated to transfer venue of Post's suit and cases were consolidated. Defendants moved for summary judgment on plaintiff's complaint and their own complaint. Court first found that defendant met burden of showing that plaintiff could not establish joint authorship in work. Specifically, defendants met their burden of showing lack of (a) originality in plaintiff's contributions, because he did not write lyrics for composition, chord progression and bass line he authored were common and not original, and contributions to lead guitar melody were sung as add-on to what Post contributed; (b) shared intent to create joint work with plaintiff, because he admitted defendants did not acknowledge that they were co-writing song or that plaintiff would be author, defendants did not follow up with plaintiff after August session for plaintiff's input, and other collaborators did not know of plaintiff's contributions or intend for him to be joint-author; (c) fixation, because Session File, which only contained performance by Post and Dukes, was recorded on Dukes's laptop; and (d) control of creation of joint work, because plaintiff indicated that Dukes had sole control over laptop used to

record file, and further that plaintiff had no contributions in post August session song development. Upon finding that defendants met initial burden of proof, burden then shifted to plaintiff. As initial matter, court found that Post sought declaration that plaintiff was not joint author of Commercial Release Composition, while plaintiff's complaint sought declaration that plaintiff was joint author of both Session File and Commercial Release Composition. Because plaintiff had no involvement with composition after August 8, 2018, plaintiff could not meet burden related to fixation and control over Commercial Release Composition. Therefore, court granted judgment in defendants' favor on claim that plaintiff was not joint author of Commercial Release Composition. As to Session File, however, court found there was factual dispute as to whether plaintiff was joint author; specifically, genuine factual questions remained related to: whether plaintiff contributed sufficiently original material to Session File because court could not determine that plaintiff's contribution of bass line and lead guitar line were unoriginal as matter of law; whether Session File was fixed by plaintiff or with his authorization because three musicians agreed which takes of work would be included; whether plaintiff, Post, and Dukes intended to create joint work; and whether plaintiff controlled relevant composition because while Dukes had control over his laptop there was no indication he or Post had veto power over decisions. Court granted in part and denied in part defendants' motion for summary judgment.

*Yellowcake, Inc. v. Morena Music, Inc.*, No. 20-787, 2021 U.S. Dist. LEXIS 144231 (E.D. Cal. Aug. 2, 2021)

District court granted defendant's motion to dismiss, finding defendant and plaintiff were co-owners of copyrights. Plaintiff, record label, alleged exclusive copyright ownership of cover art and at least co-ownership of albums with musical group. Musical group entered into agreement to sell entirety of right, title, and interest in and to albums and cover art to defendant, but musical group did not possess such exclusive right. Plaintiff sued defendant for infringement based on defendant creating copies of copyrighted works and distributing, selling, and exploiting works without plaintiff's authorization. Court previously dismissed any copyright infringement claim by plaintiff based on plaintiff being co-author/co-owner of albums. Court required amendment to explain why defendant was not co-owner. Plaintiff contended it was co-owner with musical group and defendant was not co-owner because agreement was void. Plaintiff's complaint alleged it was exclusive owner of copyrights; documents from Copyright Office indicated plaintiff was sole claimant to album copyrights by written transfer; and First Amended Complaint alleged musical group and defendant entered into agreement for sale of all rights, titles, and interests in albums. Court found that FAC, when read in light of copyright documents, indicated that defendant was selling everything, including all of his own rights in the albums, to defendant. Court did not find indication or allegation musical group reserved any kind of ownership interest. Court determined musical group had full co-ownership interest in albums and could transfer without consent of plaintiff. Court found even if musical group misunderstood extent of rights, transfer of all rights in copyrights was accomplished. Thus, court determined plaintiff and defendant were co-owners of copyrights, and since co-owners cannot be liable to each other for copyright infringement, claim was dismissed.

*Yellowcake, Inc. v. Hyphy Music, Inc.*, No. 20-988, 2021 U.S. LEXIS 135269 (E.D. Cal. July 20, 2021)

District court granted counter-defendant Yellowcake Inc.'s motion to dismiss counter-plaintiff's claim alleging infringing use of musical albums created by counter-plaintiff Hyphy Music, and counter-defendant Jesus Chavez. Chavez entered into oral agreement with music label, Hyphy, to provide recording artist services, and collectively produced four music albums. Chavez agreed Hyphy would own all right, title and interest in album masters. Nonetheless, Chavez purportedly sold his rights in albums to counter-defendant music label, Yellowcake. Yellowcake subsequently brought infringement claim against Hyphy, and Hyphy filed counterclaim alleging same and alleged co-authorship of four albums. Court noted that contract defining co-author relationship is dispositive. In absence of contract, courts consider whether "(1) a purported author 'superintends' the work by exercising control; (2) the putative co-authors make objective manifestations of a shared intent to be co-authors; and (3) the audience appeal of the work turns on both contributions and the share of each in its success cannot be appraised." Court stated accepting Hyphy's claim of joint ownership would defeat Hyphy's claim of infringement because as joint owner Chavez would be permitted to transfer non-exclusive rights to albums, which would make Hyphy joint owner with Yellowcake. Since joint owner cannot sue another joint owner for infringement, Hyphy's theory of joint ownership defeated its claim of infringement.

*Miller v. French Pastry Sch. LLC*, No. 18-4738, 2021 U.S. Dist. LEXIS 225836 (N.D. Ill. Nov. 23, 2021)

Court denied plaintiff's motion for summary judgment. Defendants, The French Pastry School, LLC and The Butter Book, LLC, entered into agreement with plaintiff for her to prepare content for defendants' website aimed at "confectionary arts enthusiasts" in exchange for compensation. Parties disputed whether plaintiff would write by herself set of glossary terms for website or would edit defendants' content; plaintiff contended that she provided "voice" for website and that defendants' edits were merely "technical," while defendants contended that they provided feedback and instruction during project. At certain point, defendants requested that plaintiff give back all works they had provided her and any edits she had already finished or was otherwise working on. Plaintiff refused but sent defendants license agreement related to her edits. When defendants refused to sign license agreement, plaintiff registered copyrights for edits. Plaintiff moved for summary judgment on her claim that she solely owned works. Court found genuine issue of fact as to whether defendants' contributions to works were sufficiently copyrightable and whether defendants were joint authors with plaintiff.

*Ross v. Dejarnetti*, No. 18-11277, 2021 U.S. Dist. LEXIS 143608 (E.D. La. July 30, 2021)

Court denied plaintiffs' motion for summary judgment on defendant's counterclaims for declaratory judgment of co-ownership of musical and choreographic works, but granted motion as to music videos due to lack of justiciable controversy. Defendant directed and

filmed music videos for plaintiff, and parties allegedly collaborated to create choreography for plaintiff's songs. Defendant also attended and provided input during recording sessions for plaintiff's musical works. After plaintiff sued for declaratory judgment concerning his rights in choreographic and musical works, defendant interposed counterclaim seeking declaratory judgment as to his co-authorship and co-ownership of music videos as well as musical and choreographic works. Court granted plaintiffs' motion for summary judgment as to music videos because plaintiffs never contested that defendant was joint author thereof, thus no justiciable controversy existed as required for declaratory judgment. However, court denied motion as to musical and choreographic works. With regard to musical works, evidence suggested that defendant's contributions may be independently copyrightable, and further that parties intended that defendant would be co-author. As to choreographic works, disputed facts existed as to whether they were fixed in tangible medium of expression (namely, video recording), as some of these works may have been recorded in music videos.

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

*Yellow Pages Photos, Inc. v. YP, LLC*, 856 Fed. App'x 846 (11th Cir. 2021)

Eleventh Circuit affirmed district court's summary judgment holding in part. Plaintiff owned copyright in stock image collections and licensed use of images to other companies, including for use in phone directories and advertisements. Plaintiff had entered into separate license agreements with AT&T Advertising and L.M. Berry, which allowed use of images by those entities and certain of their "affiliates." On summary judgment, defendants argued that, through series of mergers and name changes over 15-year period, they were "affiliates" under respective license agreements, and thus were authorized to use images pursuant to licenses. Eleventh Circuit, analyzing chain of mergers and name changes and language of license agreements, affirmed district court's findings that defendants were "affiliates" under agreements and thus were authorized to use images pursuant to licenses. Court similarly found that alleged breaches of license agreements involving use of independent contractors and exceeding number of users permitted to access database of images constituted breach of covenant under agreements and not failure to satisfy condition to establish agreement. Accordingly, alleged breach of these terms would constitute breach of contract and not copyright infringement, as defendants were permitted users of images pursuant to licenses. Court affirmed summary judgment for defendants on their status as permitted licensees under agreements, but found question of fact remained on whether licenses covered all images allegedly used by defendants, so summary judgment denied on that question.

*Perea v. Editorial Cultural, Inc.*, 13 F.4th 43 (1st Cir. 2021)

First Circuit vacated, in part, district court's judgment and remanded for transfer of damages from one set of plaintiffs to other plaintiff. Publishing company Editorial Cultural, Inc. ("Editorial") was sued for infringement after printing and selling 20,000 copies of theatrical adaptations of novels *La Llamarada* (published 1935) and *La Resaca* (published 1949) written by Puerto Rican author Enrique Laguerre and adapted by Roberto Ramos Perea ("Ramos"). Laguerre signed agreements with production company that authorized Ramos to create

adaptations, with Ramos to retain moral rights. Ramos was not signatory to agreements, but registered copyrights in his adaptations. Laguerre later granted Editorial right to print dramatic adaptations of *La Llamarada* and *La Resaca*. In 2015, Laguerre's heir and Ramos sued Editorial, alleging that Ramos owned copyright in adaptations, and infringement occurred when Editorial printed and sold publications of works to Puerto Rico Department of Education. At summary judgment, district court held that Laguerre had retained right to adaptation and to Ramos' theatrical representation. Plaintiffs eventually filed new complaint, and jury found Editorial had infringed Laguerre's rights and awarded damages. On review, First Circuit held that novels at issue were in public domain long before Ramos set out to work on adaptation; Ramos thus became owner of his derivative works, with exclusive power to authorize printing and sale of them. Court further held that agreements between production company and Laguerre had no legal effect on Ramos's status as copyright owner, as contracts were clear that Ramos had not authorized either party to agree to terms on his behalf. District court had erroneously concluded Laguerre retained right to print adaptations. Court thus substituted Ramos as prevailing plaintiff instead of Laguerre's heirs. As Ramos did not dispute amount of damages found by jury, First Circuit remanded case to district court with instructions to transfer award of damages from Laguerre to Ramos.

*McGucken v. Newsweek LLC*, No. 19-9617, 2022 U.S. Dist. LEXIS 50231 (S.D.N.Y. Mar. 21, 2022)

District court denied cross-motions for summary judgment on plaintiff's infringement claim. Plaintiff took photo of ephemeral Death Valley lake and posted it on his Instagram account. Defendant embedded Instagram post into article about ephemeral lake on defendant's site. Plaintiff sued for infringement. District court, rejecting Ninth Circuit's "server test," held that appearance of work on defendant's website constituted display of work by defendant, even though work itself was hosted on Instagram's server. Defendant argued that Instagram's terms of use granted express sublicense to defendant. Although terms of use unequivocally granted Instagram license to sublicense plaintiff's work, district court held that terms of use were not reasonably clear as to whether user of Instagram has sublicense to other user's content. Defendant also argued that Instagram granted defendant implied sublicense, because defendant clicked on "Embed" button on plaintiff's Instagram post, which manifested Instagram's intent that code pertaining to work at issue would be copied and distributed. District court held that reasonable factfinder could conclude that Instagram did or did not grant implied sublicense. District court therefore denied cross-motions for summary judgment.

*Elohim EPF USA, Inc. v. 162 D&Y Corp.*, No. 19-2431, 2022 U.S. Dist. LEXIS 45114 (S.D.N.Y. Mar. 12, 2022)

District court denied plaintiff's summary judgment motion. Plaintiff brought copyright action against defendants, owners and operators of various karaoke establishments, alleging that defendants willfully infringed its copyrights by publicly performing and displaying its musical compositions without authorization. Plaintiff subsequently filed partial motion for summary judgment, claiming ownership of exclusive rights to perform its compositions

through sub-publishing agreements with certain Korean music publishers, who had obtained rights from original songwriters. Defendant filed cross-motion. Court denied plaintiff's motion, holding that there were genuine issues of material fact as to infringement, as well as defendant's cross-motion. Court rejected defendant's arguments disputing validity of sub-publishing and songwriter agreements as well as contention that records from Korean Music Copyright Association ("KOMCA") showed that plaintiff did not have exclusive rights in compositions. Court found that defendant failed to provide any support for its contention that KOMCA records demonstrated that Korean publishing companies were not registered domestic publishers, nor exclusive rights holders, of compositions, and therefore could not have properly transferred rights to plaintiff. Court also rejected defendant's arguments that court should not consider sub-publishing agreements. Instead, court found that plaintiff had presented sufficient evidence that publishing companies were holders of exclusive rights, such that no consent from original authors of compositions was required, and that, even though plaintiff did not submit original agreements in Korean, defendants failed to adduce evidence suggesting that Korean versions of agreements would undermine plaintiff's ownership claims. Finally, court found that defendant's arguments regarding validity of plaintiff's registrations – including that certain registration certificates insufficiently identified which version of composition plaintiff registered and included information that plaintiff knew was inaccurate – raised issues of fact that could not be resolved on summary judgment. Court also dismissed defendant's arguments regarding contributory and vicarious liability, finding that genuine issues of material fact existed as to liability of karaoke establishments.

*Baker v. Weber*, No. 19-1093, 2021 U.S. Dist. LEXIS 188544 (S.D.N.Y. Sept. 30, 2021)

District court denied plaintiff's motion for summary judgment on infringement claims and plaintiff's motion for default. Plaintiff Tanisia Baker wrote books *Sheisty* and *Still Sheisty* and held copyright registrations for both. Plaintiff later signed publishing agreement with publisher that granted exclusive right to print, publish and sell in exchange for 10% royalties. Agreement allowed for assignment, termination of agreement if books were out of print after five years, and termination of agreement if publisher filed for bankruptcy or if order of liquidation were issued. Six years after agreement, publisher was dissolved and plaintiff requested reversion of rights per agreement. Publisher's owner claimed that publisher had not been liquidated and instead had assigned rights in works to other entities. Four years later, publisher licensed distribution rights to another entity (Urban Books). Plaintiff sent several messages stating she had questions and concerns over deal, but never told defendants they could not publish her works. Plaintiff later sued defendants for infringement and declaratory judgment that licensing agreements were terminated or void. Defendants asserted several affirmative defenses, including that actual license from plaintiff to publisher precluded plaintiff's claims. Court looked to objective language of license agreement and held that factual issues remained because multiple plausible interpretations of termination clause could exist. Defendants also argued that implied license existed from plaintiff to publisher. Court declined to impose rigid test for implied license, finding that to do so would preclude finding of implied license in all fact patterns except for work-for-hire situations.

Instead, district court looked to totality of parties' conduct, and found that genuine factual issues existed, including whether plaintiff knew defendants would use her copyright and whether her relative silence after license to Urban Books occurred indicated plaintiff's consent to license of her books. District court therefore denied summary judgment.

*Michael Grecco Productions, Inc. v. Time USA, LLC*, No. 20-4875, 2021 U.S. Dist. LEXIS 140274 (S.D.N.Y. Jul. 27, 2021)

Court granted defendants' motion to dismiss. Plaintiff, owner of works of Michael Grecco, photographer working primarily in entertainment and fashion industries, sued defendants Time USA, LLC and Pixels.com, LLC, alleging copyright infringement by exceeding scope of licenses. Defendants moved to dismiss. Plaintiff had signed two agreements with Time, which granted Time right to use three of Grecco's photographs on its covers. Agreements further stated that Time could reproduce covers, as they appeared, "in any media" without further payment. Time began working with Pixels to facilitate sale of print-on-demand products which featured decades of Time covers. In analyzing contract, court found "in any media" unambiguous and determined that it included print-on-demand products. Court further found that Time, as licensee, could rely on Pixels, as its agent, to carry out its licensed uses. Finding defendants did not exceed scope of licenses, court granted motion to dismiss.

*Reynolds v. Google LLC*, No. 21-3029, 2022 U.S. Dist. LEXIS 19248 (N.D. Cal. Feb. 2, 2022)

District court granted summary judgment to defendant in sound recording infringement dispute. Plaintiff sued Google for infringement, arguing that Google did not file with him or Copyright Office Notice of Intent to reproduce musical recordings and that Google did not pay royalties owed to him. Google moved for summary judgment. Court found that Google obtained licenses for both sound recording and mechanical license, and plaintiff did not provide evidence for his statement that declarations and exhibits filed by Google in support of its motion were untrue.

*Reynolds v. Apple Inc.*, No. 19-5440, 2021 U.S. Dist. LEXIS 167958 (N.D. Cal. Sept. 3, 2021)

District court granted defendant's motion for summary judgment. Plaintiff *pro se* alleged that defendant Apple infringed when it made his songs available for streaming and downloading. Reynolds submitted asserted works to CD Baby (online distributor of independent music) and executed CD Baby's standard artist agreement, which granted host of rights to CD Baby and its "Licensees." Apple obtained sound recording and mechanical licenses from CD Baby and Harry Fox Agency to distribute works, and paid all royalties due under licenses. Court held that, by signing CD Baby and HFA contracts, plaintiff provided Apple with authorization to distribute his music. Court concluded that Apple properly licensed works and did not infringe. Court also rejected assertion that plaintiff was not paid, or was underpaid royalties, because plaintiff failed to provide evidence showing that any royalties were incorrectly calculated or unlawfully withheld.

*Miller v. French Pastry Sch. LLC*, No. 18-4738, 2021 U.S. Dist. LEXIS 225836 (N.D. Ill. Nov. 23, 2021)

Court denied parties' cross-motions for summary judgment. Defendants, The French Pastry School, LLC and The Butter Book, LLC, entered into agreement with plaintiff for her to prepare content for defendants' website aimed at "confectionary arts enthusiasts" in exchange for compensation. Parties disputed whether plaintiff would write set of glossary terms for website by herself or would edit defendants' content; plaintiff contended she provided "voice" for website and that defendants' edits were merely "technical," while defendants contended they provided feedback and instruction during project. At certain point, defendants requested that plaintiff give back all works they had provided her and any edits she had already finished or was otherwise working on. Plaintiff refused but sent defendants license agreement related to her edits. When defendants refused to sign license agreement, plaintiff registered copyrights for edits. Parties cross moved for summary judgment on claim that plaintiff owned copyright and did not impliedly license work. On implied license affirmative defense, court found genuine questions of fact as to existence of implied license because, for example, plaintiff refused to provide final version of edits, and found question of fact as to whether plaintiff delivered final works to defendants or only drafts. On plaintiff's claim that even if there was implied license, she later revoked it, court also found question of fact as to whether license was revocable or irrevocable.

*Stross v. Centerra Homes of Tex.*, No. 17-676, 2021 U.S. Dist. LEXIS 219239 (W.D. Tex. Sept. 27, 2021)

District court denied parties' cross-motions for summary judgment. Plaintiff was architectural photographer and real estate broker; defendant Centerra was home builder founded by two other defendants; and third-party defendant Murphy was former Centerra employee as well as plaintiff's ex-wife and former business partner in separate company. In 2014, Murphy asked Stross to take photographs of homes for use in Centerra's marketing, which plaintiff agreed to do in exchange for \$1,000 per home if houses sold. Plaintiff alleged that, after photos were uploaded to MLS, Centerra downloaded works and used them for other commercial purposes without authorization. Plaintiff brought claim for infringement and violation of DMCA for cropping works and removing watermark. Plaintiff and Centerra cross-moved for summary judgment on plaintiff's infringement claim, with Centerra arguing summary judgment was appropriate on implied license and equitable estoppel defenses. Court found genuine issue of fact with respect to intent prevented grant of summary judgment on implied license and estoppel defenses.

*Martin v. Pure Spectrum CBD, LLC*, No. 20-910, 2022 U.S. Dist. LEXIS 404 (D. Colo. Jan. 3, 2022)

District court granted defendants' motion for summary judgment on infringement claim, finding defendants had implied license to use works. Plaintiff, graphic designer, worked with defendants to create branding and advertising for defendants' products. Plaintiff sued defendants for copyright infringement, alleging that defendants used works without

permission. Defendants argued they had non-exclusive license to use works. Court found plaintiff created and delivered works to defendants, and intended for defendants to copy and distribute works, because plaintiff created multiple designs for defendants' products, so it was reasonable that defendants would use and distribute products for business. Court therefore found implied license existed. Plaintiff argued even if implied license existed, she revoked it because she was owed more than money she received, but court found no dispute that defendants paid consideration, so implied license was irrevocable.

#### **IV. FORMALITIES**

##### **A. Registration**

*Unicolors, Inc. v. H&M Hennes & Mauritz*, 142 S. Ct. 941 (2022)

Supreme Court vacated Ninth Circuit decision and held safe harbor provision of § 411(b) of Act does not distinguish between mistake of law and mistake of fact; lack of either factual or legal knowledge can excuse inaccuracy in copyright registration. Plaintiff, fabric designer, sued retail clothing store H&M for copyright infringement, alleging H&M sold clothing with copyrighted designs. H&M argued that plaintiff's registration certificate was invalid because it contained "inaccurate information," relying on Copyright Office regulation that provided that single registration can cover multiple works only if works were included in same "unit of publication." H&M contended that fabric designs covered by single registration were not published as single unit of publication because plaintiff made some designs available for sale exclusively to certain customers, while other designs available to general public. Ninth Circuit held statute excused only good faith mistakes of fact, not law, and plaintiff knew facts. Supreme Court followed text of statute and determined language makes no distinction between lack of legal knowledge or lack of factual knowledge. Supreme Court looked at nearby statutory provisions and noted distinctions made between lack of legal knowledge and lack of factual knowledge, thereby confirming safe harbor provision's use of knowledge refers to knowledge of law as well as facts. Supreme Court stated that other provisions of Act suggested that Congress did not intend to impose scienter standard other than actual knowledge. Additionally, Supreme Court found legislative history suggested Congress enacted § 411(b) safe harbor provision to make it easier, not more difficult, for nonlawyers to obtain valid copyright registrations. Supreme Court dismissed contention that interpretation would make it too easy for copyright holders to claim lack of knowledge to avoid consequences of inaccurate application because in civil cases, willful blindness, through circumstantial evidence, may support finding of actual knowledge. Supreme Court vacated Ninth Circuit decision and remanded for further proceedings.

*Lieb v. Korangy Publ'g, Inc.*, No. 15-40, 2022 U.S. Dist. LEXIS 69510 (E.D.N.Y. Apr. 14, 2022)

Plaintiff wrote real estate law article for website called Dan's Papers and did not apply to register copyright. One week later, plaintiff made edits and submitted revised article as blog

post on Huffington Post. HuffPost article expressly noted that it was adapted from Dan's Papers article. Defendant, operator of Real Deal website, published summary of HuffPost article. Eleven days later, plaintiff filed application to register copyright in HuffPost article, making no mention of Dan's Papers article. Plaintiff brought infringement claim against defendant. Defendant in response claimed that plaintiff knowingly misled Copyright Office by not disclosing that HuffPost article was derivative work and improperly obtaining registration for original literary work. Court reviewed application forms and found them to clearly require applicant to disclose if work is changed version of earlier published work. Though § 411(b) is safe harbor provision, safe harbor provision has its limits. Specifically, certificate containing inaccurate information will not satisfy registration requirement if: (1) inaccurate information was included on application for copyright registration with knowledge that it was inaccurate, and (2) inaccuracy of information, if known, would have caused Register of Copyrights to refuse registration. Court accordingly granted defendant's motion for summary judgment to extent that registration for HuffPost article was referred to Copyright Office to advise court whether it would have refused plaintiff's registration had it known of information that he knowingly failed to disclose to Office.

*Neman Bros. & Assoc. v. Interfocus, Inc.*, No. 20-11181, 2022 U.S. Dist. LEXIS 17971 (C.D. Cal. Jan. 11, 2022)

District court reserved judgment on defendant's summary judgment motion pending inquiry to Register pursuant to 17 U.S.C. § 411(b) regarding validity of plaintiff's copyright registrations. Plaintiff, fabric designer, filed copyright infringement claim against defendant, garment seller, alleging defendant sold garments using unauthorized designs. Defendant moved for summary judgment, claiming copyright registrations were invalid. Defendant argued that registrations stated plaintiff was sole author of works, but plaintiff admitted some works were authored by third-party design studios. Defendant contended registrations should be invalidated based on factual inaccuracies, including failure to include statement that subgroup of included works were made for hire and failure to identify preexisting works incorporated into designs. Court agreed with defendant that plaintiff was required to identify all authors who created or co-created designs included in group registration, and did not do so. Therefore, court requested Register of Copyrights to advise whether knowledge of third-party authorship of works would have caused Register to refuse registration. If inaccurate information would have caused Copyright Office to refuse registration, then court may declare registration invalid. Court also reserved judgment on plaintiff's summary judgment motion on copyright infringement, vicarious copyright infringement, and contributory copyright infringement claims pending inquiry to Register regarding validity of plaintiff's copyright registrations.

*Kifle v. YouTube LLC*, No. 21-1752, 2022 U.S. Dist. LEXIS 20014 (N.D. Cal. Feb. 3, 2022)

District court granted defendant's motion to dismiss based on plaintiff's failure to comply with registration requirement and found that exception for simultaneous transmissions did not apply. *Pro se* plaintiff owned website which broadcast video news segments in Amharic.

Plaintiff sued YouTube for contributory infringement, arguing that YouTube allowed his copyrighted videos to be posted and simultaneously livestreamed on YouTube by various users without plaintiff's permission, and failed to respond to plaintiff's requests to remove infringing materials from platform. District court denied plaintiff's claim with prejudice because plaintiff failed to register his works under § 411. Court found that § 411(c) exception for simultaneous transmissions did not apply, since plaintiff failed to comply with requirements to serve notice on infringer not less than 48 hours before fixation. Even though plaintiff had sent emails to YouTube within 48 hours of transmission, notice was not served upon YouTube users who were responsible for direct infringement.

*Dr. Seuss Enters., LP v. ComicMix LLC*, 553 F. Supp. 3d 803 (S.D. Cal. 2021)

Court denied defendant's motion for reconsideration of earlier order denying defendant's motion to issue request to Register pursuant to § 411(b). Plaintiff brought infringement suit based on defendant's use of various elements of plaintiff's works, including *Oh, the Places You'll Go* and *The Sneetches and Other Stories* in defendant's Star Trek-themed work *Oh, the Places You'll Boldly Go!* Court denied defendant's motion for referral to Register, which argued that copyright registration applications for *Go* and *Sneetches* were knowingly and materially inaccurate and incomplete. Parties subsequently appealed cross-motions for summary judgment and Ninth Circuit reversed and remanded. On remand, defendant moved for reconsideration of referral motion, arguing that Ninth Circuit's decision in *Unicolors v. H&M* changed controlling law. In *Unicolors*, Ninth Circuit clarified that intent to defraud Copyright Office not prerequisite for registration invalidation and further held that single unit registration of multiple works (as at issue in *Unicolors*) requires publication of all works in one collection. Court denied defendant's motion for reconsideration because *Unicolors* merely confirmed existing law as to intent-to-defraud requirement, while change in single unit of publication registration law inapplicable to instant matter.

*Muhammad v. HBO, Inc.*, No. 21-1168, 2021 U.S. Dist. LEXIS 143854 (C.D. Ill. Aug. 2, 2021)

District court dismissed plaintiffs' complaint alleging defendant's television show "HBO/The Shop-with LeBron James" infringed plaintiffs' copyright. Plaintiffs claimed they published their reality show trailer entitled "Barbershops" where one of plaintiffs would appear at barbershop discussing various topics, and that defendant debuted similar show also using barbershop as theme. Court held plaintiffs' complaint failed to sufficiently allege registration, as it merely stated that "copyrights have been in effect since the date they were created" and that "body of work are copyrighted under United States copyright law." Court accordingly granted defendant's motion to dismiss.

*Heard v. Trax Records, Inc.*, No. 20-3678, 2021 U.S. Dist. LEXIS 135849 (N.D. Ill. July 21, 2021)

District court denied defendant's motion to dismiss. Plaintiffs, house music artists, sued defendant record labels and associated persons for claims including fraud on Copyright Office, direct infringement and contributory infringement. Plaintiffs alleged that defendants

“took advantage of unsophisticated music artists and songwriters” by inducing them to “sign away their copyrights to their musical works for paltry amounts of money up front” and promises of future royalties that were never paid. Plaintiffs alleged that they executed documents in December 1986 purporting to assign copyright in certain musical composition to defendants and granting defendants mechanical license to record and release those compositions on phonographic records. Plaintiffs alleged that those documents did not actually assign copyright in works to defendants, but that defendants falsely relied on these documents in applying for copyright registration for certain compositions. Plaintiffs alleged that defendants “knowingly and with intent to defraud” falsely claimed on their Form SR applications for certain works that they owned rights to works, and that Copyright Office would not have issued registrations had it known that defendants did not actually own copyright in compositions. Defendants moved to dismiss fraud claim on basis that it was not pleaded with “particularity and fails to identify the who, what, when, where, and how of the fraud.” District court denied motion to dismiss fraud on Copyright Office claim, finding it sufficiently pleaded. Since defendant’s motions to dismiss direct and contributory infringement claims relied on dismissal of fraud claim, motion to dismiss infringement claims also denied.

*Pyrotechnics Mgmt. v. XFX Pyrotechnics LLC*, No. 19-893, 2021 U.S. Dist. LEXIS 131697 (W.D. Pa. July 15, 2021)

District court denied defendant’s motion to issue request to Copyright Office. Defendant moved court to issue request to Copyright Office pursuant to § 411(b), to advise whether Office would have refused registration if it knew that certain information included in plaintiff’s registration application for computer program was inaccurate. Defendant contended that plaintiff’s copyright was invalid because it was registered as literary work and deposit copy was in English text, as opposed to machine readable text. While § 411(b)(2) requires court to request Office to advise whether inaccurate information, had it been known, would have caused refusal of registration, it does not require court to do so on allegations by one party. There was no evidence before court that registrant knowingly included inaccuracy in submission to Copyright Office; thus court denied motion.

*Valancourt Books, LLC v. Perlmutter*, 554 F. Supp. 3d 26 (D.D.C. 2021)

Court granted defendant’s motion for summary judgment. Plaintiff independent book publisher sued Register of Copyrights alleging that § 407 deposit requirement constitutes unconstitutional taking of private property in violation of Fifth Amendment, and burden on freedom of speech in violation of First Amendment. After Copyright Office served demand on plaintiff for copies of all 341 books in plaintiff’s catalog, which plaintiff partially fulfilled, plaintiff offered to sell remaining books in catalog to Copyright Office “at cost with no markup,” and Copyright Office informed plaintiff that electronic copies would satisfy request. Plaintiff declined to provide electronic copies and instead filed complaint seeking “declaration that the deposit requirement is unconstitutional and an injunction blocking enforcement of” deposit requirement. After determining that Copyright Office’s offer to accept electronic copies in lieu of physical copies did not moot dispute, court considered

plaintiff's constitutional claims. Plaintiff's claim that deposit requirement constitutes unconstitutional taking was analyzed under Supreme Court precedent holding that "statute that confers a 'benefit' on a citizen may condition the receipt of that benefit on the submission of private property in exchange without running afoul of the Taking Clause." *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986 (1984). In *Monsanto*, Supreme Court found that EPA requirement that chemical companies disclose certain information, including proprietary information, as condition of receipt of license to market certain chemical products was not violation of Takings Clause; proprietary information was exchanged for benefit of receiving license to sell chemicals. Plaintiff urged reliance on *Horne v. Dep't of Agric.*, 576 U.S. 351 (2015), which distinguished *Monsanto* by finding that statute requiring physical surrender of actual property (raisins) to participate in market for that commodity did not convey "governmental benefit" and was thus unconstitutional taking. District court found deposit requirement in Section 407 more akin to *Monsanto* because "[p]ublishers are not required to make the deposit in order to print books or to sell them; the obligation is a condition of the receipt of the governmental benefit of copyright protection." On First Amendment claim, plaintiff alleged that deposit requirement constitutes "content-based restriction on speech" and should be subject to strict scrutiny. Alternatively, plaintiff alleged that even if requirement is content neutral, requirement is still unconstitutional "because it imposes burdens on speech that are wildly disproportionate to any benefit derived by the government." District court found that deposit requirement is on its face not content based because "all publications in the United States must comply, regardless of the subject matter, author or publisher involved." On plaintiff's claim that requirement constitutes unconstitutional burden on speech, district court found that burden of complying with requirement is minimal and benefit conveyed to general public by creating public repository to promote arts and sciences outweighs any burden on plaintiff in complying with requirement. Summary judgment granted for defendant Register of Copyrights.

*Parker v. Hinton*, No. 19-214, 2022 U.S. Dist. LEXIS 40624 (M.D. Tenn. Mar. 8, 2022)

District court granted defendant's motion for summary judgment, holding plaintiff's infringement suit barred for failure to deposit copies of work with Copyright Office. Plaintiffs, songwriters, sued defendant for infringement, alleging song defendant authored incorporated riff from plaintiff's song "Ain't That A Lot of Love," which was created and registered as unpublished work prior to effective date of 1976 Act. Defendant argued plaintiff's copyright was invalid because of its failure to submit deposit copies of work to Copyright Office, as required under Copyright Act of 1909 § 11. Plaintiffs conceded that there was no evidence copies were deposited with Copyright Office but argued that its copyright was valid notwithstanding noncompliance with requirement and that its failure to file deposit copies did not bar suit for infringement. Court found that plain language of statute requires deposit copies for both published and unpublished works. Court found requisite deposit not made and certificate of registration was not evidence that copies were deposited. Because there was no evidence plaintiff or anyone else submitted deposit copies of work, plaintiff's infringement suit was barred.

*Emmerich Newspapers, Inc. v. Particle Media, Inc.*, No. 21-32, 2022 U.S. Dist. LEXIS 49376 (S.D. Miss. Mar. 21, 2022)

Plaintiff sued defendant, developer of “NewsBreak” news aggregation web application, alleging that defendant republished its news stories and articles through NewsBreak application. Defendant moved to dismiss infringement claims as to unregistered works. District court dismissed infringement claims as to unregistered works, pointing to Supreme Court’s *Fourth Estate* decision which “requires owners to await action by the Register before filing suit for infringement.” Although infringement claims for unregistered works were dismissed, infringement claims as to registered works were retained, and district court noted that it could grant injunctive relief prospectively restraining defendant from infringement of plaintiff’s “unregistered and future copyrights.”

*Hong v. Rec. Equip.*, No. 19-435, 2022 U.S. Dist. LEXIS 19367 (D. Idaho Feb. 1, 2022)

Court reaffirmed its denial of parties’ summary judgment cross-motions. Plaintiff, creator of illustration called “Tree Rings,” sued defendants for infringement and moved for summary judgment. Plaintiff had registered work with Copyright Office, but registration application contained inaccurate information regarding date of first publication. Court previously ruled on parties’ cross motions for summary judgment, and only remaining inquiry was whether plaintiff held valid copyright in work, which was question court could not answer because registration included inaccurate first publication date. Court submitted inquiry to Copyright Office under § 411(b). Register stated that if Office knew of inaccurate publication date, it would have allowed applicant to correct it, and if applicant did not timely do so, it would have refused to register without prejudice to new application with correct publication date. After receiving response from Register and supplemental briefs from parties, court reaffirmed denial of summary judgment motion on issue of whether plaintiff held valid copyright in work. Plaintiff argued that presumption of validity should still apply under § 410(c) since registration of work was made within five years of first publication. However, if copyright had registered using correct publication date, more than five years would have passed, and presumption of validity would not apply. Court found that even though inaccuracy did not automatically invalidate copyright registration as matter of law, there was still issue of material fact as to whether inaccuracy was included in application with knowledge of inaccuracy, and whether, if given opportunity, applicant would have corrected information as part of application process.

*TD Ameritrade, Inc. v. Matthews*, No. 16-136, 2021 U.S. Dist. LEXIS 160362 (D. Alaska Aug. 25, 2021)

Court granted defendant’s motion to dismiss infringement and DMCA counterclaims. Plaintiffs, owners of unregistered thinkScript User Manual, moved to dismiss defendant’s counterclaims for infringement and violation of DMCA on basis he did not own valid copyright because defendant’s works were derivative of plaintiffs’ work. Defendant acknowledged that he included plaintiff’s work in his copyright application, duplicated

plaintiff's code lines and block structure, and modified plaintiff's work in creating his own, but defendant argued that plaintiff lacked copyright in its work because it did not have evidence of its own registration. Court found defendant conflated registration and ownership. Because plaintiff did not bring infringement action for which registration is required, but instead brought suit challenging defendant's ownership of copyright, and because plaintiff's copyright in manual endowed it with right to create derivative works and client agreement prohibited creation of derivative works based on plaintiff's software, defendant did not own valid copyright in his works. Court also dismissed defendant's argument that plaintiff's work was not copyrightable because it was utilitarian.

## V. INFRINGEMENT

### A. Access

*Gayle v. Villamarin*, No. 18-6025, 2021 U.S. Dist. LEXIS 126836 (S.D.N.Y. July 7, 2021)

Court granted defendant's motion for summary judgment. Plaintiff, New York City visual artist, brought infringement claim against defendant, another artist, for use of stylized phrase "Art We All." Defendant moved for summary judgment, arguing that plaintiff's work was not sufficiently creative and that plaintiff failed to show access to work at issue. On creativity point, court found that plaintiff's work was more than just phrase "Art We All" because work was artwork as whole, including design and stylized words, and that it therefore was sufficiently creative to be copyrightable. On access point, however, court found plaintiff failed to provide any evidence that specific work at issue was widely disseminated. In light of absence of relevant access evidence, court found that no reasonable jury could find plaintiff's work widely disseminated.

*Segal v. Segel*, No. 20-1382, 2022 U.S. Dist. LEXIS 11832 (S.D. Cal. Jan. 21, 2022)

Court denied motion to dismiss copyright claim, finding that plaintiff sending screenplay to defendants' talent agency was sufficient to plead that defendants had access to screenplay. *Pro se* plaintiff brought infringement claim alleging that defendant Jason Segel's book titled *Otherworld* infringed plaintiff's screenplay, also titled *Otherworld*. Plaintiff had submitted her screenplay to agents at same agency that represented defendants and both stories involved virtual world called "Otherworld." On motion to dismiss, court found that, while plaintiff's submission of screenplay to several third-party agents and screenplay-hosting website The Black List were not sufficient to sustain wide-dissemination theory of access, receipt of screenplay by agents in contact with defendants was sufficient to plead chain-of-events theory of access.

*Muhammad v. HBO, Inc.*, No. 21-1168, 2021 U.S. Dist. LEXIS 143854 (C.D. Ill. Aug. 2, 2021)

District court dismissed plaintiffs' complaint alleging defendant's television show "HBO/The Shop-with Lebron James" infringed plaintiffs' copyright. Plaintiffs claimed they published reality show trailer entitled "Barbershops" in which one of plaintiffs would appear at barbershop discussing various topics. Plaintiffs further claimed that defendant debuted similar show also using barbershop as theme. To establish infringement plaintiff must prove ownership of valid copyright and copying of original portions of plaintiff's work. Copying can be proven by showing that defendant had opportunity to access plaintiff's work and that respective works are similar, permitting inference that copying occurred. Court found that plaintiff's complaint contained mere surface allegations without adequate factual support. Additionally, court held plaintiffs did not plead sufficient facts to demonstrate that defendant would have ever viewed plaintiffs' trailer and would have reasonably known, or had access to, plaintiffs' idea. Accordingly, court granted defendant's motion to dismiss.

*Johnston v. Kroeger*, No. 20-497, 2021 U.S. Dist. LEXIS 150587 (W.D. Tex. Aug. 11, 2021)

District court denied defendants' motion to dismiss plaintiff's infringement claim. Plaintiff wrote original music composition, "Rock Star," while member of band Snowblind Revival. For marketing campaign, Snowblind sent copies of master recording of "Rock Star" to multiple record labels, including Universal Music Group and Warner Music Group, whose wholly owned subsidiary, Roadrunner Records, was record label for band Nickelback. Years later, Nickelback released album "All the Right Reasons" featuring song "Rockstar." Plaintiff sued Nickelback for infringement, alleging that tempo, song form, melodic structure, harmonic structures and lyrical themes were all copied from plaintiff's original composition, and that Nickelback had direct access to plaintiff's song through Roadrunner Records. To establish that defendant had access, plaintiff must show that "third party with possession of the copyrighted work was concurrently dealing with the copyright owner and alleged infringer." Court found plaintiff's allegations that Nickelback had reasonable opportunity to hear copyrighted work through Roadrunner Records was sufficient to "raise his right to relief above the speculative level, which is all that is required in the pleadings stage." Court further found that, after listening to works at issue, it was possible for reasonable juror to determine that works shared protectable elements and, therefore, plaintiff had sufficiently plead substantial similarity, as well. Court added that whether plaintiff will be able to produce evidence that similarities rise to level of "substantial" in view of Nickelback's level of access is yet to be determined. However, given that plaintiff sufficiently stated claim for infringement, court denied motion to dismiss.

*Walker v. Kemp*, No. 21-528, 2022 U.S. Dist. LEXIS 35373 (E.D. Pa. Feb. 28, 2022)

District court dismissed copyright infringement claims with prejudice because plaintiff failed to establish access or substantial similarity. Plaintiff authored then registered copyright in

novel *Blinded by Love* as well as accompanying encyclopedic “bible.” In *Blinded*, Philadelphia drug dealer/real estate entrepreneur Andre decides to start larger drug trafficking operation with lifelong best friend/business partner, then begins romantic relationship with district attorney who does not know about his illicit dealings. Andre’s friend disapproves of relationship and tries to extort money with threat of revealing dealer’s identity. Ultimately, DA learns of Andre’s criminal involvement, and he is sentenced to death for his crimes. In defendants’ TV show *Power*, drug dealer/laundromat entrepreneur Ghost opens nightclub in attempt to get out of drug empire he runs with his childhood best friend/business partner, then reignites romantic relationship with high school sweetheart, who, unbeknownst to him, is prosecutor. Over six seasons, *Power* had many storylines, including Ghost’s wrongful conviction and temporary incarceration for murder he did not commit, his increasingly tumultuous relationship with his son and his political aspirations. Plaintiff claimed that *Power* infringed his works, alleging that defendants could be presumed to have reviewed his novel because it was posted for sale on Amazon and because plaintiff promoted novel at trade shows. Court found plaintiff’s conclusory allegations that his novel and unpublished bible made its way into defendants’ possession too threadbare to withstand motion to dismiss. Plaintiff failed to allege that anyone he shared novel with at trade shows or elsewhere had any dealings with any defendants. Moreover, plaintiff failed to allege that he shared bible with anyone at all. Because plaintiff failed to establish that parties’ works were substantially similar, he was unable to make higher striking similarity showing required to allow presumption of access.

*Tolbert v. Discovery, Inc.*, No. 18-680, 2021 U.S. Dist. LEXIS 161742 (N.D. Ala. Aug. 26, 2021)

District court granted defendant’s motion for summary judgment because plaintiff failed to raise genuine issue of material fact as to whether defendant had access to her work. Plaintiff actress and stunt double alleged she created concept for mother-daughter home renovation show titled *Like Mother, Like Daughter*, and pitched show concept, along with “teaser” trailer to various television producers. Upon viewing HGTV program *Good Bones* which also featured mother-daughter home renovation concept, plaintiff sued for infringement alleging Discovery, through its channel HGTV, copied her concept and/or teaser in creating *Good Bones*. Plaintiff alleged she produced teaser and distributed it to “at least 21” producers with “undeniable business ties with Discovery,” and that that such producers must have shared trailer with Discovery because “it is standard practice in the television entertainment industry” for such information to be shared and it is “incredulous to believe” that none of producers shared trailer or “expression of concept” with Discovery. Discovery contended that plaintiff produced no actual evidence that any employee of Discovery or related production company viewed her trailer or received her pitch, and that plaintiff’s allegations were “speculation stacked upon conjecture.” District court found no admissible evidence showing that Discovery had access to plaintiff’s teaser, and that plaintiff’s arguments that certain producers “could have” provided Discovery with teaser were insufficient to demonstrate access. Finding plaintiff’s allegations reliant on “too many assumptions,” district court granted summary judgment for Discovery on access question.

## B. Copying and Substantial Similarity

*Shull v. TBTF Prods.*, No. 20-3529, 2021 U.S. App. LEXIS 21220 (2d Cir. 2021)

Second Circuit affirmed lower court's decision dismissing plaintiffs' complaint alleging defendants' show *Billions* infringed plaintiffs' copyright in book *Market Mind Games: A Radical Psychology of Investing, Trading, and Risk*. Plaintiff alleged character Dr. Wendy Rhoades in *Billions* was substantially similar to fictional therapist character in plaintiffs' book. In analyzing substantial similarity, court concluded under "more discerning observer" test that plot in both works were dissimilar and similarity between Dr. Rhoades and fictional therapist character in book were generalized and non-protectible. Thus, concept and feel in totality were different between respective works, in that plaintiff's book as academic in nature and defendants' *Billions* was fictional television drama. Additionally, court concluded works were not similar under "quantitative and qualitative" approach. Further, counseling session in both works resulted from different traumas. Thus, plaintiff failed to show quantitatively there was more than *de minimis* copying and failed to show qualitatively defendants copied protectible expression, rather than ideas, facts, works in public domain, or other non-protectible elements.

*Carlini v. Paramount Pictures Corp.*, No. 21-55213, 2022 U.S. App. LEXIS 5480 (9th Cir. Mar. 2, 2022)

Ninth Circuit affirmed lower court's dismissal because plaintiff failed to sufficiently allege substantial similarity between two works at issue. Works at issue were plaintiff's movie *What Men Want* and defendant's unpublished screen play *What the F is He Thinking*. While both works follow women who can hear men's thoughts, plots diverge substantially since defendant's movie focused on career struggles, whereas plaintiff's screenplay focused on relationship struggles. Accordingly, court found plaintiff failed to sufficiently allege substantial similarity between protectible elements of two works, and affirmed dismissal.

*Gregorini v. Apple Inc.*, Nos. 20-55664, 20-55846, 2022 U.S. App. LEXIS 4640 (9th Cir. Feb. 22, 2022)

Ninth Circuit reversed dismissal of complaint and remanded for further proceedings. Plaintiff Francesca Gregorini wrote, directed, and produced film *The Truth About Emanuel*. Plaintiff alleged that Apple and other defendants infringed her copyright via television series *Servant*. District court granted motion to dismiss for failure to state claim, applying extrinsic test. On appeal, court held that dismissal was improper because reasonable minds could differ on whether works at issue were substantially similar. Court further noted that discovery – including expert testimony – would be helpful in adjudicating outcome-determinative issues, such as distinguishing creative elements of works from *scènes à faire*.

*Johannsongs-Publishing, Ltd. v. Lovland*, Nos. 20-55552, 20-55759, 2021 U.S. App. LEXIS 35135 (9th Cir. Nov. 29, 2021)

Ninth Circuit affirmed grant of summary judgment for defendants. Plaintiff brought suit alleging that song “You Raise Me Up,” composed by defendant in 2001 and popularized by Josh Groban in 2003, infringed copyright in plaintiff’s 1977 Icelandic song “Söknuður.” Applying Ninth Circuit’s two-part extrinsic/intrinsic test for substantial similarity, district court excluded plaintiff’s expert’s reports because they failed to filter out similarities attributable to prior art as required by extrinsic test. Court therefore granted summary judgment in defendants’ favor, holding that parties’ songs were not substantially similar based on admissible evidence. Parties cross-appealed, with plaintiff arguing that appellate panel should instead apply Second Circuit’s “ordinary observer” test for substantial similarity. Ninth Circuit affirmed lower court’s holding because panel could depart from Ninth Circuit precedent only if subsequent U.S. Supreme Court decision undercut same, but no such decision existed in this case.

*Design Basics, LLC v. Kerstiens Homes & Designs, Inc.*, 1 F.4th 502 (7th Cir. 2021)

Seventh Circuit affirmed district court’s granted of summary judgment for defendants. Plaintiff Design Basics owned copyrights in thousands of floor plans and had brought more than 100 infringement suits against builders. Plaintiffs Plan Pros, Inc. and Prime Designs, Inc. licensed their floor plans through Design Basics. Plaintiffs alleged that defendants, companies that built homes, infringed seven floor plans. District court granted summary judgment for defendants, finding plaintiffs could not show substantial similarity between works, and awarded defendants more than \$500,000 in costs and fees. Plaintiffs appealed. Court, applying Seventh Circuit precedent on substantial similarity standard for floorplans, for which copyright was “thin,” found that plaintiff was unable to show that plans at issue were “virtually identical.” Instead, similarities between works went to standard features that were not protectable. Court affirmed grant of summary judgment to defendants, and additionally found no abuse of discretion in district court’s analysis of *Fogerty* factors and award of costs and attorneys’ fees to “discourage Design Basics from manipulating the copyright laws to extract quick settlements.”

*Cat & Dogma, LLC v. Target Corp.*, No. 20-50674, 2021 U.S. App. LEXIS 30282 (5th Cir. Oct. 8, 2021)

Fifth Circuit reversed district court judgment, finding plaintiff sufficiently alleged originality in its selection and arrangement of unprotectable elements that comprised its design, and remanded case for further proceedings. Plaintiff, children’s clothing company, sued Target, alleging Target infringed design of children’s pajama garment by reproducing, distributing, and publicly displaying it without authorization. District court granted Target’s motion to dismiss and plaintiff appealed. Circuit court found plaintiff adequately alleged ownership and factual copying when it alleged Target had access to design before it began selling pajamas. Circuit court further held plaintiff sufficiently alleged originality in selection and

arrangement of unprotectable elements, and that reasonable jury could find designs substantially similar based solely upon similarity of selection and arrangement of underlying elements. Fifth Circuit reversed district court's dismissal decision and remanded for further proceedings.

*Berry Hill Dev. Corp. v. Scott*, No. 20-1874, 2021 U.S. Dist. LEXIS 165494 (E.D.N.Y. Aug. 31, 2021)

Magistrate judge recommended denial of defendants' motion to dismiss plaintiff's infringement claims. Plaintiff, high end residential property designer and builder, contracted with architect to create architectural plans for defendants Billy and Alexa Joel via their LLC, defendant F. Scott. Plaintiff registered copyrights in main house and garage plans, then sued Joels, F. Scott, their management firm, and replacement architect Neil-James Stufano for, *inter alia*, copyright infringement. Defendants moved to dismiss, arguing that plaintiff failed to sufficiently allege how defendants' plans were substantially similar to plaintiff's. Magistrate found that plaintiff's allegations, coupled with annexed copies of plaintiff's and Stufano's plans, allowed comparison of their respective total concept and overall feel. Although Stufano's plans differed from plaintiff's in some respects, without benefit of developed record as to overall design, features existing at renovation start, and timeline of renovations, it was impossible to conclude that parties' works not substantially similar.

*Bmaddox Enters. LLC v. Oskouie*, No. 17-1889, 2021 U.S. Dist. LEXIS 157010 (S.D.N.Y. Aug. 18, 2021)

District court granted plaintiff's motion for summary judgment in part. Plaintiff and defendants created and sold educational materials related to firearms licensing over Internet. Plaintiff alleged that defendants infringed its copyright in guidebook, look and feel of website, and website code, and also asserted claim for violation of DMCA. Plaintiff moved for summary judgment. Court found that record established substantial similarity between parties' works, except in case of website code. For code, court determined that supporting evidence of substantial similarity amounted to assertions of legal conclusions, which were not credited on summary judgment. Without computer programming expert, court could not determine whether code from websites was substantially similar. Court granted summary judgment on infringement claim as to guidebook and look and feel of website but denied claim of infringement of website code.

*Clanton v. UMG Recordings, Inc.*, 556 F. Supp. 3d 322 (S.D.N.Y. 2021)

District court granted motion to dismiss infringement claim alleging that hip-hop artist 2 Chainz copied plaintiff's song, finding no actionable similarities as matter of law. Plaintiff, hip-hop artist known as Slugga, released song called "Proud," with prominent lyric "Proud, I'm just tryin' to make my mama proud." 2 Chainz and collaborators later released song also called "Proud" with recurring lyric "Yeah, I'm just try-na make my mama proud." Court found plaintiff failed to plausibly allege that defendants had access to plaintiff's song; allegations that plaintiff posted song to several hip-hop websites and YouTube were insufficient, and further allegations about how many times song was accessed or details

about popularity hip-hop sites would be needed to meet burden of alleging considerable commercial success. Court also found no substantial similarity between songs, with only one lyric in common, and lyric was cliché phrase commonly used as expression of familial love or pride. There is no simpler way in English language to express that thought, which is not protectible. Other similarities between songs, including call-and-response element, 2/4 time signature, and beginning with sustained chord played by organ, are common to music and have been found insufficient to support infringement claims in previous cases. Neither did those unprotectible elements combine with similar main lyric to create infringement, when those elements are unrelated to lyric. That songs had same title was also insufficient to show substantial similarity as matter of law.

*Fioranelli v. CBS Broad. Inc.*, 551 F. Supp. 3d 199 (S.D.N.Y. 2021)

District court denied defendant's motion for summary judgment. Plaintiff, professional photojournalist, took video footage from World Trade Center site following attacks of September 11, 2001, and compiled footage into photographic work. Plaintiff provided defendant CBS with copies of footage and, in exchange, CBS agreed to pay plaintiff \$1,000 per use of any portion of material, which was just under 2 hours and 45 minutes in length. In 2014, plaintiff recognized portions of material in documentary and learned that CBS had sub-licensed material to be used in documentary without plaintiff receiving payment. Plaintiff sued CBS for infringement and CBS moved for summary judgment, seeking dismissal of plaintiff's claims on grounds that use was *de minimis*. As actual copying was not in dispute, CBS focused on whether copying met threshold of substantial similarity, arguing that copied work was displayed for at most approximately 43 seconds and in many instances only few seconds, as part of longer film or episode. CBS reasoned that "when the portion of the work used is miniscule, as are the uses in this case, that alone can decide the issue." Court disagreed, finding that brevity of footage did not defeat fact that material was prominently featured, was in clear focus and occupied entirety of screen, such that use satisfied both qualitative and quantitative components of *de minimis* test. Motion for summary judgment on *de minimis* use grounds denied.

*NSI Int'l, Inc. v. Horizon Grp. USA, Inc.*, No 20-8389, 2021 U.S. Dist. LEXIS 132995 (S.D.N.Y. July 16, 2021)

District court granted defendant's motion to dismiss plaintiff's claim alleging infringement of plaintiff's science kit packaging. Plaintiff NSI manufactured educational science kits for children in conjunction with Smithsonian Institute. NSI alleged that defendant Horizon copied four elements of NSI's copyrighted packaging design. Court stated that, to prove copying element of claim, NSI must demonstrate substantial similarity between allegedly infringing work and protectible elements of copyrighted work. Court further discussed ordinary observer test. under which court considers themes, plots, characters, settings, and total concept and feel of two disputed works. Small quantitative and qualitative similarities are insufficient to find liability for infringement. Accordingly, court found circular logos appearing on parties' respective packaging were similar in shape but graphically different and thus not substantially similar. Additionally, circular graphics appearing in both works

were not similar because they differed in order of appearance, color, scientific matter depicted and placement of descriptive text, and only element shared was idea of depicting microscope's magnification. Further, display of microscope and accessories on packaging differed in placement and number shown. Lastly, court found overall concept and feel differed, as NSI's package contained simple white background with gray, blue, and black components conveying educational feel, whereas Horizon's packaging comprised teal and black background with orange circle in center, conveying playful feel. Accordingly, court held no reasonable jury could find protectible elements to be substantially similar.

*Hines v. W Chappell Music Corp.*, No. 20-3535, 2021 U.S. Dist. LEXIS 107398 (S.D.N.Y. Jun. 8, 2021)

District court denied motion to dismiss infringement claim. In 1960s, plaintiff singer co-authored "Help Me Put Out The Flame (In My Heart)," which opens with three-bar guitar riff. After hearing songs "Paper Chase" and "Toe 2 Toe," plaintiff sued composers and publishers for infringement of guitar riff and musical crescendo. "Paper Chase" was composed by Shawn Carter ("Jay-Z") and Timothy Mosley ("Timbaland"). "Toe 2 Toe" was also composed by Timbaland. Defendants moved to dismiss complaint, asserting that plaintiff failed to state claim for infringement because he failed to (1) "identify what musical content is allegedly contained in the guitar riff" or how it was protectable, (2) explain how defendants allegedly copied riff, and (3) establish "how the alleged copying – from a three-measure guitar riff – is substantial enough to constitute infringement." On first point, court found plaintiff sufficiently alleged protectability of guitar riff because copyright protects song's "notes and rhythm," referencing findings of plaintiff's expert musicologist's report in its analysis. On second point, court, citing expert report, found guitar riff could be heard throughout majority of defendants' songs, and court concluded facts could support inference of copying. On third point, court noted that defendants' argument implicated "fragmented literal similarity" test, which required qualitative and quantitative analysis. Court, however, found that discovery was necessary to make final determination as to qualitative component of inquiry and thus denied motion to dismiss.

*Cates v. Schlemovitz*, No. 21-805, 2022 U.S. Dist. LEXIS 76241 (N.D.N.Y. Apr. 27, 2022)

District court dismissed plaintiff's complaint without prejudice. *Pro se* plaintiff songwriter Cameron Cates alleged that Febreze commercials and related music albums contained five note "la, la, la, la, la" phrase that was substantially similar to plaintiff's registered work. On motion to dismiss, district court held that plaintiff's complaint contained conclusory allegations and failed to allege direct evidence that defendants actually copied plaintiff's composition. Regarding circumstantial evidence, district court held that (1) plaintiff failed to allege chain of events whereby defendants would have had opportunity to see composition; and (2) plaintiff failed to allege that composition was publicly posted on forum or website, played over television or radio, or otherwise made available to public. District court therefore concluded that plaintiff failed to state claim for infringement. However, due to

plaintiff's *pro se* status, district court dismissed complaint without prejudice and with leave to amend.

*Kahn v. CJE&M Am., Inc.*, No. 21-3230, 2022 U.S. Dist. LEXIS 58044 (C.D. Cal. Mar. 28, 2022)

Court granted defendants' motions to dismiss complaint without leave to amend. In 2013, plaintiff developed television show concept called "Island Hip Hopping," which plaintiff described as travel show focused on hip-hop music with elements of audience competition. Each episode would showcase local talent in new location, focusing on that location's unique art, music and culture. Several years later, defendants produced "I-Land," reality television streaming series in which 23 young men compete to debut as K-pop idols while living and training together in "a futuristic egg-shaped building called the I-Land," and contestants are eliminated by judges or other contestants in each episode. Plaintiff sued, claiming "I-Land" infringed plaintiff's copyright in treatment for "Island Hip Hopping." Court considered only substantial similarity, examining "articulable similarities between the plot, themes, dialogue, mood, setting, pace, character, and sequence of events of the two works." Court found no substantial similarity in plot, setting, mood, pace, or characters. Only potential similarities between works were themes – both shows involved music and element of competition – and episode runtimes which, according to court, was not enough to support finding of substantial similarity, especially given that music and competition themes are too broad to be protectable and given that both shows engaged with these themes in entirely different ways, including covering different music genres and different formats of competition. Plaintiff therefore failed to state claim against defendants, and defendants' motions to dismiss were granted.

*Kev & Cooper, LLC v. Furnish My Place, LLC*, No. 20-1509, 2022 U.S. Dist. LEXIS 54445 (C.D. Cal. Mar. 15, 2022)

District court denied motion to dismiss amended complaint. Plaintiff designed, made, and sold children's educational rugs. Defendant allegedly made and sold rugs or carpets bearing designs that were similar to plaintiff's. Plaintiff alleged two counts of direct infringement and one count of vicarious or contributory infringement. After determining that plaintiff alleged sufficient facts to infer that plaintiff owned copyright in designs at issue, district court examined whether plaintiff plausibly alleged copying of original constituent elements of works. District court held that plaintiff alleged sufficient similarity in arrangement, selection, and other protectable elements of plaintiff's and defendant's designs to survive motion to dismiss with respect to direct infringement claims.

*Segal v. Segel*, No. 20-1382, 2022 U.S. Dist. LEXIS 11832 (S.D. Cal. Jan. 21, 2022)

Court denied motion to dismiss infringement claim as premature, with record not developed enough for extrinsic analysis of substantial similarity. *Pro se* plaintiff brought infringement claims, alleging that defendant Jason Segel's book called *Otherworld* infringed plaintiff's screenplay, also entitled *Otherworld*. Plaintiff had submitted her screenplay to agents at same agency that represented defendants, and both stories involved virtual world called

“Otherworld.” Court denied motion to dismiss, finding that record was not yet sufficiently developed for court to apply extrinsic analysis to determine whether there was substantial similarity between works.

*Dr. Seuss Enters., LP v. ComicMix LLC*, 553 F. Supp. 3d 803 (S.D. Cal. 2021)

Court denied plaintiff’s renewed motion for summary judgment on willful infringement claim. Plaintiff brought infringement suit based on defendant’s use of various elements of plaintiff’s works, including *Oh, the Places You’ll Go*, in defendant’s Star Trek-themed work *Oh, the Places You’ll Boldly Go!* Parties subsequently appealed cross-motions for summary judgment and Ninth Circuit reversed and remanded. On remand, plaintiff renewed its summary judgment motion. Court held that plaintiff’s copyright registrations were *prima facie* evidence of copyright validity that defendant failed to rebut. Moreover, plaintiff introduced evidence of copying that defendant did not dispute. Relying heavily on Ninth Circuit’s decision holding that *Boldly* overlaps with concrete elements in plaintiff’s works, court found that parties’ works were extrinsically similar. However, because parties’ works were not so similar that there was no triable issue as to their intrinsic substantial similarity, court declined to grant summary judgment as to infringement or willfulness.

*Alfred v. Walt Disney Pictures*, No. 18-8074, 2021 U.S. Dist. LEXIS 253308 (C.D. Cal. Dec. 16, 2021)

Court denied motion for summary judgment on substantial similarity. Plaintiffs, authors of *Pirates of the Caribbean* screenplay, brought infringement action against Disney based on its creation and distribution of five *Pirates of the Caribbean* movies. Court previously granted motion to dismiss, finding works not substantially similar as matter of law, but Ninth Circuit reversed, noting that additional evidence, including expert testimony, could aid in substantial similarity determination, and remanded to district court. After remand, defendant moved for summary judgment on substantial similarity. Court found unpersuasive defendant’s argument that plaintiff’s expert did not preclude summary judgment in its favor because (1) his testimony needed to be limited to pirate tropes according to Ninth Circuit opinion; and (2) he testified that he had not heard of substantial similarity extrinsic test. On first point, court found Ninth Circuit’s opinion did not limit expert testimony to pirate tropes and on second point, court found that argument went to weight of report, which could not be assessed on summary judgment. Court additionally found dueling reports raised genuine issue of material fact regarding substantial similarity.

*Compulife Software v. Rutstein*, No. 16-80808, 2021 U.S. Dist. LEXIS 160881 (S.D. Fla. July 12, 2021)

Following bench trial, district court held that significant portions of plaintiff’s software code were unprotectable and that defendant failed to show qualitative significance of portion of copied code that was protectable. Plaintiff and defendants were competitors who generated online life insurance quotes. Plaintiff registered source code with Copyright Office, and later became aware that defendants copied plaintiff’s source code without permission to provide life insurance quotes to consumers. After plaintiff shut down defendant’s access to

plaintiff's software, plaintiffs discovered its life insurance quotes reappeared on defendant's website again. Later, another defendant engaged in scraping attack, sending over 800,000 quote requests to plaintiff's server. Plaintiff subsequently sued defendants for copyright infringement. At trial, plaintiff alleged that its sales declined due to defendants' activities. Court first noted that factual copying of plaintiff's copyrighted material was not disputed. Although at first it appeared that defendants copied quantitatively significant portion of code, much of plaintiff's source code was not protectable under merger doctrine. Regarding small remainder of code that was potentially protectable, court held that potentially protectable code that was copied amounted to 27 code lines, and that plaintiff had failed to establish that 24 of 27 lines were substantially similar to its own code. Therefore, qualitatively, defendants did not copy significant portion of code. Furthermore, court held that formatting of names and variables within plaintiff's code was based on common sense and logic and did not involve original or creative expression. Court also found that defendant assigned values and names to insurance policies in its code that differed from values and names assigned by plaintiff within its code. District court accordingly concluded that plaintiff failed to meet its burden with respect to its copyright claims.

*Digit. Dream Labs, LLC v. Living Tech. (Shenzhen) Co.*, No. 20-1500, 2022  
U.S. Dist. LEXIS 35045 (W.D. Pa. Feb. 28, 2022)

District court granted motion to dismiss infringement claims as to three-dimensional sculptural composition of desktop robot figures, but denied same as to audiovisual features of robots. Plaintiff sold robots, including VECTOR and COZMO robots, and owned copyright registrations for robots covering "three-dimensional sculptural and audiovisual work" of each robot. Defendant also sold desktop robot with audiovisual features displayed on robot's "eye" screens. Plaintiff sued for infringement. On motion to dismiss, district court first concluded that sculptural element of each of plaintiff's robots was copyrightable work separate from robots' audiovisual features, and therefore conducted separate substantial similarity analyses as to these works. In comparing protectable elements of sculptural features of robots, district court conducted side-by-side analysis and noted that parties' respective robots differed in shape, size, appendages (plaintiff's having tractor treads and defendant's having leg-like appendages), ratio of screen size to head size, and other features. Based on such comparison, district court concluded no substantial similarity as to sculptural works and granted motion to dismiss that claim. As to substantial similarity of audiovisual works, district court compared how respective robots displayed "specific animations and graphics in response to different external stimuli on a screen that is located on the front plane of their heads ... typically accompanied by a related sound." District court did not accept defendant's arguments that such works are *scènes à faire*, finding that although mere idea of, e.g., robot responding to questions or providing information about weather, is unprotectable, robot "could show that it is raining in different ways," and such expression is not unprotectable under *scènes à faire* doctrine. District court similarly was not persuaded by defendant's argument that face displays were unprotectable because "there is only a limited range of expression possible for robot eyes displaying emotion." Rather, district court found that only minimal amount of creativity is required, and expressions of such emotions through plaintiff's robots "particularized eyes" creates protectable expression. District court thus

concluded that reasonable jury could find substantial similarity and declined to dismiss infringement claim as to audiovisual works.

*Walker v. Kemp*, No. 21-528, 2022 U.S. Dist. LEXIS 35373 (E.D. Pa. Feb. 28, 2022)

District court dismissed copyright infringement claims with prejudice because plaintiff failed to establish access or substantial similarity. Plaintiff authored then registered copyright in novel *Blinded by Love* as well as accompanying encyclopedic “bible.” In *Blinded*, Philadelphia drug dealer/real estate entrepreneur Andre decides to start larger drug trafficking operation with lifelong best friend/business partner, then begins romantic relationship with (and ultimately marries) district attorney who does not know about his illicit dealings. Andre’s friend disapproves of relationship and tries to extort money with threat of revealing dealer’s identity. Ultimately, DA learns of Andre’s criminal involvement, and he is sentenced to death for his crimes. In defendants’ TV show *Power*, married Manhattan drug dealer/laundromat entrepreneur Ghost opens nightclub in attempt to get out of drug empire he runs with his childhood best friend/business partner, then has affair with high school sweetheart, who, unbeknownst to him, is prosecutor. Over six seasons, *Power* had many storylines, including prosecutor-mistress protecting Ghost after learning he is in drug trade, Ghost’s wrongful conviction and temporary incarceration for murder he did not commit, his increasingly tumultuous relationship with his son and his political aspirations. Plaintiff claimed that *Power* infringed his works, but court held that only similarities between parties’ works (including characters, plot, mood and even dialogue) were too commonplace, generic or random to be protectable. Andre and Ghost shared no similarities except being Black and drug dealers, but “drug dealer” is unprotectable prototype. Similarly, Andre and Ghost’s love interests, though both prosecutors, have different types of relationship with protagonist (eventual wife in *Blinded* vs. mistress in *Power*) and narrative arcs (turning in drug dealer in *Blinded* vs. protecting drug dealer in *Power*). Further, Andre’s relationship with his friend/partner ends in enmity, but Ghost’s friend/partner remains loyal. Plot-wise, Andre is getting deeper into drug trade while Ghost is trying to get out. Moreover, several major plotlines from *Blinded* (e.g., theft by friend/partner, wife’s betrayal) are absent from *Power* while, conversely, many plotlines from *Power* (wrongful arrest/incarceration, political ambitions, and murder by son) do not appear in *Blinded*. Court granted motion to dismiss with prejudice because parties’ works so different that no amount of artful pleading could result in viable copyright infringement claim.

*Advanta-STAR Auto. Research Corp. of Am. v. DealerCMO, Inc.*, No. 20-1150, 2022 U.S. Dist. LEXIS 10343 (E.D. La. Jan. 20, 2022)

Court granted defendant’s motion for summary judgment. Plaintiff created vehicle comparisons favorable to particular makes and models by highlighting favorable features of that car and maintained copyrighted database containing hundreds of thousands of vehicle comparisons. Plaintiff periodically searched internet for infringement and found three allegedly infringing comparisons of Hyundai models that included entire paragraphs that were identical to plaintiff’s copyrighted comparisons and were placed on defendant’s

website. Court found that defendants took largely unprotected factual information from plaintiff's comparisons, such as highway fuel milage, warranty options, and length of brake rotors. Plaintiff argued that defendants copied names of warranties, but court found that technical terms were not protectable. Court found that any similarities between works were based almost exclusively on unprotectable elements of plaintiff's copyrighted database.

*Hudson Homes & Designs, LLC v. Kennedy*, No. 20-720, 2022 U.S. Dist. LEXIS 3862 (E.D. Ark. Jan. 7, 2022)

Court denied cross-motions for summary judgment. Plaintiff was home design company that marketed and sold "Willowbrook Plan" home plan through third-party website. Defendant Kennedy hired individual, Michael Moore, to create house plan. Kennedy viewed modified version of Willowbrook Plan online and sent link to Moore with design. Defendant Kennedy hired Defendant CNC, to whom it also sent link of modified version of Willowbrook Plan to build house using Moore's plan. Parties cross-moved for summary judgment. Court denied defendants' motion for summary judgment and plaintiffs' motion for partial summary judgment because issue of fact remained as to substantial similarity.

*Tolbert v. Discovery, Inc.*, No. 18-680, 2021 U.S. Dist. LEXIS 161742 (N.D. Ala. Aug. 26, 2021)

District court granted defendant's motion for summary judgment, finding lack of substantial similarity between plaintiff's trailer and defendant's television show. Plaintiff actress and stunt double alleged she created concept for mother-daughter home renovation show titled *Like Mother, Like Daughter*, and pitched show concept, along with "teaser" trailer, to various television producers. Upon viewing HGTV program *Good Bones*, which also featured mother-daughter home renovation concept, plaintiff sued for infringement, alleging Discovery, through its channel HGTV, copied her concept and/or teaser in creating *Good Bones*. Plaintiff argued that *Good Bones* was substantially similar to her teaser in several respects; defendant Discovery argued that concept of mother-daughter home renovation show was unprotectable, and many similarities relied on by plaintiff were stock elements and *scènes à faire*. District court considered protectable elements of respective works including: characters, theme/concept and hook; plot; setting; and pace. On each element, court found works not substantially similar and not "strikingly similar," and therefore granted Discovery's motion for summary judgment on substantial similarity.

### **C. Contributory/Vicarious Infringement**

*Can. Hockey, L.L.C. v. Tex. A&M Univ. Ath. Dep't*, No. 20-20503, 2022 U.S. App. LEXIS 3976 (5th Cir. Feb. 14, 2022)

Fifth Circuit affirmed lower court dismissal of copyright and takings claims against Texas A&M University Athletic Department (TAMU) based on state sovereign immunity grounds, and copyright claims against two TAMU employees for failure to state claim. Plaintiff sportswriter and publishing company owner hired writer to create book titled *12th Man*,

regarding legendary TAMU athlete E. King Gill, who suited up at halftime during 1922 game due to concern that injured TAMU team would run out of reserve players. Plaintiff interviewed defendant – associate director of media relations at TAMU – regarding Gill and sent defendant draft copy of book. TAMU employee Marquardt later retyped selected portions of draft from plaintiff and removed references to plaintiff, to create article for university fundraising purposes; two other employees (Cannon and Stephenson) then published article. Plaintiff asserted direct and contributory claims of infringement against all defendants, and state and federal takings clause violations against TAMU. Court looked to whether allegations supported direct infringement claim against Cannon and concluded that dismissal was warranted because Marquardt engaged in actual copying; Cannon never received original work and had no actual constructive knowledge of infringement. Court then examined whether allegations supported contributory infringement claim against Cannon and Stephenson. Cannon had no knowledge of underlying infringement and no intent to infringe, and Stephenson also lacked requisite knowledge or intent, as he received retyped article from Marquardt and reasonably assumed article was not infringing. Court accordingly affirmed dismissal of contributory claims against Cannon and Stephenson.

*Bus. Casual Holdings, LLC v. YouTube, LLC*, No. 21-3610, 2022 U.S. Dist. LEXIS 50166 (S.D.N.Y. Mar. 21, 2022)

Plaintiff Business Casual Holdings created original documentary content, including videos that turn two-dimensional images into three-dimensional models through “parallax” process, which “requires myriad creative choices,” and uploaded videos to channel on defendant YouTube’s platform. Unrelated third party, TV-Novosti, posted several videos to its own YouTube channel, including videos with clips allegedly copied from plaintiff’s videos. Defendant allegedly doctored these clips slightly, including replacing watermark, to circumvent YouTube’s automatic safeguards. Plaintiff filed DMCA takedowns to remove videos and, in response, YouTube removed videos within three to 23 days of receiving each DMCA complaint. Plaintiff filed lawsuit claiming YouTube directly infringed copyrights, as well as contributed to and was vicariously liable for TV-Novosti’s infringement, arguing YouTube failed to promptly remove allegedly infringing videos and to terminate TV-Novosti’s channels. Court found no evidence that YouTube had actively participated in infringement or that condensed timeline for removal was needed. Further, irrespective of direct infringement, court found YouTube’s service agreement created broad license that explicitly allowed YouTube to reproduce, distribute, prepare derivative works, display and perform videos, which freed YouTube from any liability for infringing materials uploaded to its platform. Court also found that, given no plausible claim of direct infringement, DMCA “safe harbor” defense was not applicable. Finally, court found YouTube did not contribute to, and was not vicariously liable for, TV-Novosti’s alleged infringement, given lack of evidence YouTube knew of any infringement prior to DMCA complaints, and given that YouTube promptly and permanently took down videos, such that all relevant content hosted on YouTube that infringed plaintiff’s copyrights had been removed at time lawsuit was filed. Accordingly, court granted YouTube’s motion to dismiss plaintiff’s claims of direct, contributory and vicarious copyright infringement.

*Elohim EPF USA, Inc. v. 162 D&Y Corp.*, No. 19-2431, 2022 U.S. Dist. LEXIS 45114 (S.D.N.Y. Mar. 12, 2022)

District court denied parties' cross-motions for summary judgment. Plaintiff brought copyright action against defendants, owners and operators of karaoke establishments, alleging that defendants willfully infringed its copyrights by publicly performing and displaying its musical compositions without authorization. Court denied plaintiff's partial motion for summary judgment, holding that whether performances occurring in private karaoke rooms are considered public or private was question of fact to be resolved by jury. Court also denied defendant's cross-motion, finding that there were genuine issues of material fact regarding plaintiff's ownership of compositions, as well as contributory and vicarious liability of individual defendants. As to contributory liability, court determined that if karaoke performances were found to be public, then jury could also hold that certain defendants contributed to infringement by making karaoke machines available to their consumers. Court also found that evidence submitted by plaintiff supported claim that defendants were aware of infringement. As to vicarious liability, court held that there were issues of fact regarding defendants' right to supervise customers' activities and that karaoke establishment's repertoire of songs is "at least a draw" for potential customers such that it could constitute financial interest. Thus, court denied defendant's cross-motion as to individual defendants.

*Hartmann v. Google LLC*, No. 20-5778, 2022 U.S. Dist. LEXIS 41129 (S.D.N.Y. Mar. 8, 2022)

Court denied motion to dismiss direct infringement claim and granted motion to dismiss contributory and vicarious infringement claims. Plaintiff, owner of copyrights in five motion pictures, alleged that defendants Google and YouTube infringed works by distributing films on Google Play Store and YouTube Movies without authorization. On motion to dismiss direct infringement claim, defendants contested plaintiff's ownership of works because plaintiff's name did not appear on registration; however, court found argument not persuasive because assignee, and not just initial registrant, may assert infringement claim. On contributory infringement claim, plaintiff alleged that defendants should have known from metadata in five films and their industry experience that plaintiff owned works. However, court found plaintiff's claim insufficiently supported beyond conclusory statements. As to its vicarious infringement claim, court found that plaintiff merely recited elements of vicarious liability and alleged that YouTube is Google's subsidiary, which was insufficient to state claim. Finally, plaintiff asserted claim for infringement in foreign jurisdictions. However, plaintiff failed to allege which foreign jurisdictions' laws were violated, which did not provide defendants with sufficient notice. Court granted in part and denied in part motion to dismiss.

*Hartmann v. Amazon.com, Inc.*, No. 20-4928, 2021 U.S. Dist. LEXIS 157035  
(S.D.N.Y. Aug. 19, 2021)

District court granted in part and denied in part defendant's motion to dismiss. Plaintiff, copyright owner of multiple films, sued defendant, owner of Amazon Prime, for distributing films on Amazon Prime without authorization or license. Defendant made films available for digital distribution in United States and foreign countries. Plaintiff pleaded five counts of copyright infringement: (1) direct infringement of copyrights; (2) direct infringement in United States causing further infringement abroad; (3) contributory infringement within United States; (4) vicarious infringement; and (5) direct infringement in violation of foreign laws. Defendant moved to dismiss all claims. In pertinent part, court granted motion to dismiss claims (2) and (3) because plaintiff failed to plausibly plead defendant had actual or constructive knowledge of infringement, and allegation lacked any reference to any specific act of infringement or any infringer and was too unspecific to sustain claim that infringement abroad occurred, abetted by infringement at home. Court granted motion to dismiss claim (4) because claim did not allege how defendant controlled subsidiary entity "Amazon Digital" or means by which defendant derived profit from it. Claim relied solely on Amazon Digital's subsidiary status, and therefore was inadequate to claim vicarious infringement.

*Kev & Cooper, LLC v. Furnish My Place, LLC*, No. 20-1509, 2022 U.S. Dist. LEXIS 54445 (C.D. Cal. Mar. 15, 2022)

District court denied motion to dismiss amended complaint, but struck secondary liability claim *sua sponte*. Plaintiff designed, made, and sold children's educational rugs. Defendant allegedly made and sold rugs or carpets bearing designs that were similar to plaintiff's. Plaintiff alleged two counts of direct infringement and one count of vicarious or contributory infringement. Defendant argued that vicarious or contributory claim must be dismissed because plaintiff failed to plead proper claim of direct infringement. District court disagreed, finding that underlying claims of direct infringement were properly pleaded. However, district court *sua sponte* struck secondary liability claim, finding that plaintiff had not pleaded vicarious or contributory liability in original complaint, and court's order granting leave to amend explicitly stated that new claims could only be sought via separate, properly noticed motion. Plaintiff failed to file such motion, and district court therefore struck contributory/vicarious liability claim from amended complaint.

*Harrington v. Pinterest, Inc.*, No. 20-5290, 2021 U.S. Dist. LEXIS 167983  
(N.D. Cal. Sept. 3, 2021)

District court granted defendant's motion to dismiss contributory infringement claim without prejudice. Plaintiff was professional travel photographer and, for each of his photographic works, he added metadata including copyright notice, credit line source, contact information and use terms. Plaintiff also assigned each of his works JPEG file names containing unique identifying information. Plaintiff sued Pinterest for contributory infringement, alleging that Pinterest materially contributed to infringement of his works uploaded to and/or downloaded from Pinterest without his authorization. Pinterest moved to dismiss contributory

infringement claim, arguing plaintiff failed to plead “actual knowledge of specific acts” of direct infringement. Plaintiff contended that at pleadings stage, allegations of “constructive knowledge” or “willful blindness” suffice. District court, considering Ninth Circuit precedent, rejected plaintiff’s contention that there is “reason to know” or “should have known” standard for contributory infringement, even at pleadings stage. Although plaintiff alleged that certain photographers “contacted senior management at Pinterest regarding improper copying of photographs generally,” he failed to allege that Pinterest had knowledge (actual or constructive) of specific examples of his works being infringed. On willful blindness claim, district court found that plaintiff failed to allege that Pinterest subjectively believed his works were being likely infringed and then took “deliberate action to avoid learning” about such infringement. Finding plaintiff’s generalized allegations insufficient to satisfy knowledge requirement for pleading claim for contributory infringement, court dismissed claim with leave to amend.

*YZ Prods. v. Redbubble, Inc.*, 545 F. Supp. 3d 756 (N.D. Cal. 2021)

Court granted defendant’s motion to dismiss. Plaintiff, author of several original works of art and photographs sued defendant, owner of e-commerce storefront, for contributory infringement. Defendant moved to dismiss for failure to state claim because plaintiff failed to adequately allege that defendant had actual knowledge of specific acts of infringement. While plaintiff alleged that it informed defendant of general infringement, plaintiff failed to allege that it notified defendant of specific acts of infringement, namely specific infringing products. Thus, plaintiff’s notice was “generalized notification of infringement occurring” and not sufficient for establishing contributory copyright infringement.

*Warner Bros. Entm’t v. Tusa*, No. 21-5456, 2021 U.S. Dist. LEXIS 206716 (C.D. Cal. Oct. 25, 2021)

District court found plaintiffs entitled to default judgment on direct and contributory infringement claims. Plaintiffs, movie producers, sued defendant for infringement for use of copyrighted works in unauthorized digital streaming service. Defendant’s subscribers accessed infringing content through digital streaming service that downloaded directly onto TVs, computers, and mobile devices. Court found plaintiffs were likely successful on direct copyright claim because plaintiffs provided certificates of registration and defendant likely violated exclusive right by streaming copyrighted works without authorization. Court found plaintiffs were likely successful on contributory infringement claim because direct infringement was established, defendant had actual knowledge of third-party infringement, and defendant materially contributed to third party infringement by operating streaming website and supplying service. Court also found plaintiffs were likely successful on claim under inducement theory because defendant distributed and sold subscriptions to streaming service and induced direct infringement by creating demand for unauthorized reproduction of copyrighted works; defendant knowingly distributed and promoted streaming service with object of promoting use to infringe and infringing conduct predictably followed, satisfying causation requirement. Court concluded statutory damages for direct and secondary copyright infringement sufficient to compensate plaintiffs and deter defendant from future

infringement. Court granted permanent injunction enjoining defendant from distributing infringing material because plaintiffs would be irreparably harmed by further infringement, monetary damages were inadequate to compensate plaintiffs, balance of hardships weighed in plaintiffs' favor, and public interest weighed in favor of injunction. Court also concluded award of attorneys' fees was proper.

*Millennium Funding, Inc. v. 1701 Mgmt. LLC*, No. 21-20862, 2021 U.S. Dist. LEXIS 237925 (S.D. Fla. Dec. 13, 2021)

District court held that plaintiffs had established personal jurisdiction over defendants, but ultimately granted defendants' motion to dismiss due to failure to state claim. Plaintiffs asserted claims against defendants, including contributory and vicarious infringement, based on defendants' alleged publishing of false WhoIs records, which prevented plaintiffs from contacting end users and VPN companies regarding their infringing activities. Defendants moved to dismiss, alleging in part that plaintiffs had filed shotgun pleading. Considering plaintiff's incorporation of prior counts into successive counts, court found plaintiff's convoluted pleading to be worthy of dismissal. However, due to plaintiffs' seeking leave to amend complaint, district court also evaluated defendant's motion to dismiss for failure to state claim. Plaintiffs had alleged that defendants were liable for contributory copyright infringement. Defendants argued plaintiffs failed to allege that defendants' services were not used for substantial non-infringing uses, but district court held such allegation was not required. Defendants also argued that contributory infringement claim should be dismissed for failing to allege defendants acted with culpable intent. District court rejected such argument because defendants were operators who provided servers to VPN companies that encrypt end users' data. Defendants were thus not aware of end users' content. Defendants also moved to dismiss vicarious infringement claim that alleged defendants failed to update their WhoIs records; defendants claimed that complaint did not allege that defendants profited directly from infringement or that they had ability to control or stop infringing activity. District court agreed, finding that plaintiff had alleged defendants were paid by VPN companies, not end users, and alleged that defendants control IP addresses used by subscribers, but did not allege that defendants had ability to terminate accounts of end users. District court therefore dismissed infringement claims against defendants.

*Kobi Karp Architecture & Interior Design, Inc. v. RG Mich. 2014 LLC*, No. 18-21079, 2021 U.S. Dist. LEXIS 198691 (S.D. Fla. Oct. 14, 2021)

District court granted summary judgment for plaintiff on contributory and vicarious infringement claims. Plaintiff architecture firm sued hotel developer for infringement of architectural design plans, alleging defendant developer retained second architecture firm Castellanos to "revise ... and reconfigure" plans created by plaintiff, when in fact, plans were simply copied. On plaintiff's motion for summary judgment on contributory and vicarious infringement claims, district court quickly held that Castellanos directly infringed works, and then considered whether defendant induced or contributed to this direct infringement. On knowledge prong of contributory infringement claim, district court rejected defendant's unsupported claims that he believed plaintiff and Castellanos "were working together" and

found that defendant “knew or had reason to know” that Castellanos infringed works because defendant authorized Castellanos to submit reconfiguration of plans created by plaintiff. District court also found that defendant (through its principal) “materially contributed to the infringing conduct” by retaining Castellanos as architect and instructing him to submit new plans which he knew were mere revisions of plaintiff’s original work. On vicarious infringement claim, district court considered whether defendant had “ability to supervise infringing activity and ha[d] a financial interest in that activity or ... personally participate[d] in that activity.” Because defendant retained and compensated Castellanos in connection with infringing activity, it “had the ability to supervise” Castellanos and “had a financial interest in the infringing activity”; district court thus found vicarious liability standard met.

*Johnston v. Kroeger*, No. 20-497, 2021 U.S. Dist. LEXIS 150587 (W.D. Tex. Aug. 11, 2021)

District court granted defendant Live Nation’s motion to dismiss plaintiff’s infringement claim. Plaintiff wrote original music composition, “Rock Star,” while member of band Snowblind Revival. For marketing campaign, Snowblind sent copies of master recording of “Rock Star” to multiple record labels, including Universal Music Group and Warner Music Group, whose wholly-owned subsidiary Roadrunner Records was record label for Nickelback. Years later, Nickelback released album “All the Right Reasons” featuring song “Rockstar.” Plaintiff sued Live Nation for infringement, based on Live Nation’s promotion of Nickelback concerts at which song “Rockstar” was performed. Court granted Live Nation’s motion to dismiss, reasoning that plaintiff failed to state claim for direct or secondary copyright infringement. Specifically, plaintiff failed to allege that Live Nation copied or had access to plaintiff’s song and, therefore, failed to state claim for direct infringement. Plaintiff also failed to allege facts showing that Live Nation (1) knew or had reason to know of Nickelback’s allegedly infringing activity and (2) induced, caused or materially contributed to Nickelback’s allegedly infringing conduct, which are required to establish contributory infringement. Plaintiff similarly failed to allege that Live Nation had right and ability to supervise or control Nickelback’s performance of “Rockstar,” which is required to establish vicarious liability against Live Nation. Accordingly, court granted Live Nation’s motion to dismiss.

*Brittney Gobble Photography, LLC v. Sinclair Broad. Grp.*, No. 18-3403, 2021 U.S. Dist. LEXIS 222009 (D. Md. Nov. 17, 2021)

District court denied defendants’ summary judgment motion on contributory infringement and granted defendants’ motion for summary judgment on vicarious infringement. Plaintiff, photographer, sued defendants for infringement based on unauthorized use of images. Parties cross-moved for summary judgment on infringement and DMCA claims. Court denied defendants’ motion for summary judgment on issue of contributory infringement because factual dispute related to defendants’ knowledge of infringing activity. Court granted defendants’ motion for summary judgment on vicarious infringement because purpose of website was to provide news, not to display infringing materials. Plaintiff

presented no evidence to contrary or to connect defendants' alleged infringement to viewers' interest in articles.

#### **D. Miscellaneous**

*Bell v. Wilmott Storage Servs., LLC*, 12 F.4th 1065 (9th Cir. 2021)

Ninth Circuit reversed district court's grant of summary judgment and remanded. Plaintiff, photographer of Indianapolis skyline, found, through reverse image search, unauthorized display of his picture on website associated with defendant. Image was not accessible to general public and was only available to those who reverse searched or knew exact URL where photograph was shown. Prior to plaintiff notifying defendant that it was displaying photo without authorization, defendant was not aware photo existed on its server. Although defendant took photo down from URL, image was still available at later time at slightly different URL due to technical issue. District court assumed infringement for purposes of deciding motion but granted summary judgment for defendant on *de minimis* use defense without reaching other defenses. Plaintiff appealed and Ninth Circuit reversed, applying *Perfect 10* to fact pattern and determining that, because photo was available on defendant's server, defendant infringed plaintiff's display right in work. Under Ninth Circuit law *de minimis* use was not defense to infringement; instead, *de minimis* doctrine refers to question whether defendant's work is substantially similar to plaintiff's work. Because defendant took plaintiff's work in full, it could not be *de minimis* under interpretation of doctrine. Court also dismissed defendant's argument that his conduct was not volitional, because defendant managed and updated its own website which sufficed to show volitional conduct or proximate cause. Ninth Circuit reversed and remanded.

*Elohim EPF USA, Inc. v. 162 D&Y Corp.*, No. 19-2431, 2022 U.S. Dist. LEXIS 45114 (S.D.N.Y. Mar. 12, 2022)

District court denied parties' cross-motions for summary judgment. Plaintiff brought copyright action against defendants, owners and operators of karaoke establishments, alleging that defendants willfully infringed its copyrights by publicly performing and displaying its musical compositions without authorization. Plaintiff filed motion for partial summary judgment with respect to musical compositions it had registered within five years of publication. Plaintiff alleged that it owned exclusive rights to display and perform such compositions through sub-publishing agreements with Korean music publishers, who had obtained rights from original songwriters. Defendant disputed plaintiff's ownership of valid copyright in compositions and asserted that plaintiff could not establish infringement because any performances of compositions occurred in private rooms. Court denied plaintiff's motion, finding genuine issues of material fact as to infringement. Court determined that whether performances occurring in private karaoke rooms are considered public, e.g., similar to "private movie-viewing room in a public establishment," or private, e.g., similar to "movies presented in hotel guests' individual rooms," was question of fact to be resolved by jury. Court also denied defendant's cross-motion, rejecting argument that they were entitled to summary judgment because plaintiff could not establish ownership as

matter of law, and dismissed defendant's contentions regarding contributory and vicarious liability, finding that genuine issues of material fact existed as to liability of karaoke establishments.

*Thomas v. Carter*, No. 21-8682, 2022 U.S. Dist. LEXIS 13346 (S.D.N.Y. Jan. 25, 2022)

District court dismissed *pro se* plaintiff's conspiratorial copyright claims against famous musicians as wholly incredible and fanciful and denied leave to amend. *Pro se* plaintiff filed copyright infringement suit against well-known rap and R&B artists including Jay-Z, Meek Mill, H.E.R., and Young Thug, after contacting non-defendants Beyonce Knowles-Carter, Will Smith, and Timbaland and asking for their opinions on music beats he had written. Plaintiff then decided to make his own music with beats and accused defendants of using his beats in their music, which he alleged were sent to defendants by Beyonce and Smith. Court dismissed plaintiff's claims as frivolous and fanciful, presenting no basis for plaintiff's conspiratorial allegations that Beyonce and Smith sent plaintiff's beats to 15 other music artists in retribution for plaintiff's internet posts about Beyonce's personal life. Moreover, plaintiff's "notice of copyright registration" attached to complaint pertained to songs not mentioned in allegations of infringement. Complaint also did not demonstrate how defendants' songs were similar to plaintiff's songs. Court denied leave to amend complaint despite plaintiff's *pro se* status, as claims were wholly incredible and fanciful, making amendment futile.

*Coscarelli v. ESquared Hosp. LLC*, No. 18-5943, 2021 U.S. Dist. LEXIS 226738 (S.D.N.Y. Nov. 24, 2021)

District court granted defendants' summary judgment motion. In dispute between plaintiff celebrity chef Chloe Coscarelli and former business partners over "By Chloe" chain of fast casual vegan restaurants, plaintiff alleged that defendants infringed recipes in her copyrighted cookbooks by online publication of recipes "identical or nearly identical" to recipes in those cookbooks. On cross-motions for summary judgment, district court noted that "fact/expression dichotomy" typically renders "lists of required ingredients and the directions for combining them to achieve the final products" (i.e., recipes) not eligible for copyright protection. Finding that elements copied from plaintiff's cookbook were merely lists of ingredients and directions for combining them, district court held that defendants did not copy any protectable elements of cookbook and granted summary judgment for defendants on infringement claim.

*Evox Prods. v. Verizon Media*, 556 F. Supp. 3d 1139 (C.D. Cal. 2021)

District court granted defendants' motion to dismiss. On prior motion to dismiss, court found infringement claim prohibited by *VHT, Inc. v. Zillow Group, Inc.*, 918 F.3d 723 (9th Cir. 2019), because it based liability on nothing more than defendants making works available on website. Plaintiff asserted amended complaint, alleging that defendants continued to display photographs on Yahoo's Auto and Tumblr websites after termination of licensing agreement, allowing members of public to view, download, and copy works.

Court, however, found claims to state nothing other than “making available” theory, which was insufficient to state claim under Act’s display right. Court also found remainder of allegations did not suffice to show volitional conduct on part of defendants, as opposed to actions of third parties, which is required for infringement claim. Court granted motion to dismiss with prejudice.

*Canadian Standards Ass’n v. P.S. Knight Co.*, No. 20-1160, 2022 U.S. Dist. LEXIS 22970 (W.D. Tex. Feb. 9, 2022)

Magistrate judge recommended denial of defendants’ motion to dismiss. Plaintiff was Canadian non-profit that developed and published voluntary standards and codes in various fields, including electrical work, propane storage, and oil and gas pipelines. Plaintiff registered copyrights in Canada regarding works at issue. Defendants published and distributed identical copies of plaintiff’s works in Canada. When plaintiff obtained injunction against defendants in Canada, defendants formed U.S. corporation, registered U.S. copyright claims in works at issue, and began distributing works in United States. Plaintiff alleged it was entitled to copyright protection in United States under Berne Convention, and that defendants had infringed its works. Defendants argued that plaintiff could not state claim for infringement under “government edicts doctrine,” because works at issue were model code adopted by Canadian government, and U.S. copyright protection does not exist for works created by government officials in course of official duties or works adopted as law by U.S. jurisdictions. However, district court observed that copyright ownership is determined under law of country in which work was created and concluded that defendants provided no authority that Canada has analogous government edicts doctrine. Magistrate therefore held that plaintiff properly alleged claim for direct infringement and recommended denial of defendants’ motion to dismiss.

*Brittney Gobble Photography, LLC v. Sinclair Broad. Grp.*, No. 18-3403, 2021 U.S. Dist. LEXIS 222009 (D. Md. Nov. 17, 2021)

District court granted defendants’ motion for summary judgment. Plaintiff, photographer, sued defendants for infringement based on unauthorized use of images. Parties cross-moved for summary judgment on infringement and DMCA claims. Court determined defendants functioned as independent website that stored and displayed copyrighted works. As to volitional conduct requirement, fact that defendants assumed responsibility for content on website said nothing about whether content posted or maintained was by virtue of volitional acts. Because plaintiff presented no evidence to demonstrate that defendants engaged in volitional conduct in connection with alleged infringement, court granted defendants’ motion for summary judgment.

## VI. DEFENSES/EXEMPTIONS

### A. Fair Use

*Yang v. Mic Network Inc.*, Nos. 20-4097, 20-4201, 2022 U.S. App. LEXIS 8195 (2d Cir. Mar. 29, 2022)

Second Circuit affirmed dismissal of complaint on fair use grounds. Plaintiff took photo of Dan Rochkind and licensed it to New York Post in connection with article *Why I Won't Date Hot Women Anymore*. Plaintiff alleged that defendant used digital screenshot of Post article without authorization – including portion of photograph at issue – as banner image for its article *Twitter Is Skewering the 'New York Post' for a Piece on Why a Man 'Won't Date Hot Women.'* Court reviewed fair use factors, focusing particularly on first and fourth. Under first factor, court noted that Mic used banner image as part of its criticism of Post article, weighing in favor of fair use finding. Regarding fourth factor, court concluded that due to cropping of photograph at issue and inclusion of Post headline, audience for banner image would be very different than audience for original work. Plaintiff also failed to allege market exists for photographs that happen to be featured in news articles criticizing original article. Court therefore held that district court properly dismissed plaintiff's complaint on fair use grounds.

*Frye v. Lagerstrom*, No. 20-3134, 2021 U.S. App. LEXIS 26646 (2d Cir. Sept. 3, 2021)

Second Circuit affirmed grant of summary judgment to plaintiff on infringement claim, finding defendant failed to produce evidence contradicting plaintiff's *prima facie* case of copyright infringement. Plaintiff wrote and directed short film called *Homeless: A Love Story* and related script. Defendant, owner of production company, worked on film and published video on YouTube that included “nearly six minutes” of plaintiff's film, prior to completion of film and without plaintiff's permission. Court found defendant presented no evidence in support of fair use defense, as defendant's video was “approximately half of the intended length” of plaintiff's completed film; record did not establish effect of defendant's use on potential market for plaintiff's completed film; and no evidence that plaintiff was engaged in newsworthy conspiracy against defendant. Finally, court declined to review videos that defendant believed would support claims because materials were submitted as part of amended answer, and according to court, “answers are not the appropriate vehicle for a party to set out all of its evidence.” Accordingly, Second Circuit affirmed grant of summary judgment for plaintiff.

*Monsarrat v. Newman*, 28 F.4th 314 (1st Cir. 2022)

First Circuit affirmed district court's dismissal of plaintiff's complaint. Defendant, moderator of neighborhood online forum, copied forum's discussion threads and reposted to new platform. Reposted threads included post written by plaintiff threatening users that were harassing him, for which plaintiff had obtained copyright registration. Defendant's copying

of content prompted plaintiff to bring claim for infringement. Defendant moved to dismiss for failure to state claim. District court granted motion, holding that defendant's reproduction of plaintiff's post constituted fair use. First Circuit affirmed. Court determined that defendant's purpose was noncommercial and "at least minimally" transformative because defendant had reproduced work for fundamentally different reason than that which led to its creation. Plaintiff's goal in authoring his work was plainly to encourage users in 2010 to immediately stop harassing him. Defendant's copying – seven years later and on different platform – could not reasonably be found to be aimed at same purpose. Court also found that plaintiff's post lay closer to factual and informational side of line than near "core" copyright protection, given that post was comprised of only verbatim quote from new forum's harassment policy and "brief workaday prose" threatening users. Additionally, court found fact that defendant copied plaintiff's post in its entirety to be insubstantial as it would have made "scant sense" for defendant to reproduce only portion of post. Lastly, court held that there was no reason to believe that work had any value and dismissed plaintiff's claim that defendant's use diminished his property interest in post.

*Bell v. Eagle Mt. Saginaw Indep. Sch. Dist.*, 27 F.4th 313 (5th Cir. 2022)

Fifth Circuit affirmed district court's grant of defendant's motion to dismiss on fair use grounds. Plaintiff sports psychologist sued Texas school district after Twitter account of school softball team and color guard posted excerpt of inspirational quote from plaintiff's copyrighted work *Winning Isn't Normal*. District court granted motion to dismiss, finding conduct by defendant alleged in pleadings constituted fair use, and plaintiff appealed. Analyzing first fair use factor on face of complaint, Fifth Circuit found school's use of inspirational quote noncommercial, noting it was "hard to believe how the school could derive a commercial benefit from that use" and finding "no logical theory" to support plaintiff's contention that post would "enhance the reputation" of school's programs. Fifth Circuit found second factor favored plaintiff because work was not "purely factual" and was "somewhat creative," but given minimal weight attributed to second factor found that this granted plaintiff "a meager victory." On third factor, Fifth Circuit found that even though passage tweeted by school was one page out of 78-page copyrighted work, passage might be "heart of the work." However, given that passage was freely accessible before school tweeted it, third factor found neutral. On fourth factor, Fifth Circuit noted that pleadings did not allege any actual lost revenue, and merely asserted that defendant's post "could reduce the incentive to purchase" merchandise bearing passage. Plaintiff's argument that post "might impact his ability to license" passage was similarly rejected, with Fifth Circuit noting that plaintiff was unable to allege "that anyone has ever purchased a license before posting" passage on social media. Fifth Circuit rejected plaintiff's reliance on his filing of copyright infringement lawsuits and extraction of settlements from alleged infringers, finding these did not constitute "traditional or reasonable" markets for licensing work. Finding that successful fair use defense appeared on face of complaint, Fifth Circuit affirmed dismissal.

*McGucken v. Newsweek LLC*, No. 19-9617, 2022 U.S. Dist. LEXIS 50231 (S.D.N.Y. Mar. 21, 2022)

District court denied cross-motions for summary judgment on plaintiff's infringement claim. Plaintiff took photo of ephemeral Death Valley lake and posted on his Instagram account. Defendant embedded Instagram post into article on defendant's site regarding ephemeral lake. Plaintiff sued for infringement. District court, rejecting Ninth Circuit's "server test," held that appearance of work on defendant's website constituted display of work by defendant, even though work itself was hosted on Instagram's server. Defendant argued that fair use doctrine applied, but district court held that it was unable to determine as matter of law whether defendant's use of photograph did or did not constitute fair use. Plaintiff and defendant disagreed whether defendant's publication of work was transformative, whether defendant's use was commercial in nature, and whether defendant acted in bad faith, all of which would require fact intensive inquiry. Furthermore, although plaintiff's work was creative, district court noted that reasonable factfinder could conclude defendant used work for transformative purpose, which required fact intensive inquiry. In addition, even though defendant copied entire photo, district court concluded that it would have been difficult for defendant to copy anything less for purposes for which defendant intended to use photo – i.e., reporting appearance of ephemeral lake in Death Valley – which also required factfinder to examine evidence. Finally, district court held that extent to which defendant's activities affected market for plaintiff's photograph could not be determined as matter of law. District court therefore denied motion for summary judgment.

*Bus. Casual Holdings, LLC v. TV-Novosti*, No. 21-2007, 2022 U.S. Dist. LEXIS 45283 (S.D.N.Y. Mar. 14, 2022)

District court denied defendant's motion to dismiss copyright infringement claims based on fair use. Plaintiff Business Casual Holdings created original documentary content, including videos that turn two-dimensional images into three-dimensional models through "parallax" process, which "requires myriad creative choices." Plaintiff posted videos, including videos entitled "How Rockefeller Built His Trillion Dollar Oil Empire" and another entitled "J.P. Morgan Documentary: How One Man Financed America," on its YouTube channel. Defendant, Russian non-profit organization, posted several videos on its YouTube channel that included excerpts of plaintiff's videos. Defendant allegedly doctored plaintiff's clips slightly, including replacing watermark, to circumvent YouTube's automatic safeguards. Plaintiff filed DMCA takedowns to remove videos from YouTube, and, in response, defendant filed DMCA counter notifications. To prevent videos from being reinstated, plaintiff filed lawsuit claiming infringement. Defendant filed motion to dismiss on basis of fair use. In its analysis, court found first, second and third factors weighed against fair use. Court reasoned that plaintiff's video depictions were not transformed in any meaningful way; there was plausible inference of bad faith as watermark appeared to have been replaced; defendant could have used public domain photos rather than plaintiff's modified clips; and, while clips used by defendant were short, they were not so trivial to warrant dismissal under *de minimis* doctrine. However, court found fourth factor could not be determined without further factual development, as it was unclear whether effect of use of plaintiff's clips would

usurp market for plaintiff's videos, given that defendant's videos were not in English and had broader focus than plaintiff's documentaries. Accordingly, court denied defendant's motion to dismiss copyright infringement claims on basis of fair use.

*In re DMCA Section 512(h) Subpoena to YouTube (Google, Inc.)*, No. 18-268, 2022 U.S. Dist. LEXIS 9029 (S.D.N.Y. Jan. 18, 2022)

District court granted motion to quash DMCA subpoena. Watch Tower, organization that publishes religious materials for Jehovah's Witnesses, created four creative, non-factual videos that it registered. Watch Tower requested that court issue DMCA subpoena to identify owner of pseudonymous Kevin McFree YouTube account, which published videos of stop-frame Lego animations set in fictional village of Dubtown that satirized and criticized practices of Jehovah's Witnesses. One specific video depicted Lego characters watching excerpts from Watch Tower's copyrighted videos, over which parodic commentary was interjected ("Dubtown Video"). Anonymous YouTube channel owner moved to quash subpoena, arguing that use of Watch Tower's materials was fair. First, Dubtown Video was used to criticize, satirize and comment on Jehovah's Witnesses practices in manner at odds with original purpose of Watch Tower's videos, therefore use was transformative even though excerpts from Watch Tower's videos displayed in original and unaltered forms. Although movant created Dubtown Video for commercial purposes and obtained Watch Tower's videos from another YouTube user who leaked them, because movant's use was transformative and Watch Tower makes its works freely available online for download and distribution, nature and purpose of use weighed in favor of fair use. Second, expressive and creative nature of Watch Tower's videos weighed slightly against fair use, though this factor of limited usefulness where Dubtown Video was used for transformative purpose. Third, Dubtown Video used only small excerpts from Watch Tower's videos and solely to parody and criticize. Finally, due to Dubtown Video's satirical, transformative nature, it would not usurp market for Watch Tower's videos. Because movant's use of Watch Tower's works was, on balance, fair, court found no copyright infringement by movant and thus no basis to compel YouTube's disclosure of movant's identity.

*Hunley v. BuzzFeed, Inc.*, No. 20-8844, 2021 U.S. Dist. LEXIS 189420 (S.D.N.Y. Sept. 30, 2021)

District court denied defendant's motion to dismiss based on fair use defense. Plaintiffs, Black photographers, took frontline photographs of May and June 2020 protests in major cities following death of George Floyd, and registered photographs with Copyright Office. Defendant embedded and displayed, without license or modifications, at least one of each plaintiff's Instagram photos in online post collating photographs. Defendant moved to dismiss, arguing that its use of photos was transformative because article introduced two photojournalists and requested that defendant's readers follow photographers on Instagram. District court held that defendant's use not transformative because its post failed to alter photographs with new expression, meaning or meaning. Further, defendant failed to address remaining three fair use factors.

*Walsh v. Townsquare Media, Inc.*, No. 19-4958, 2021 U.S. Dist. LEXIS 188466 (S.D.N.Y. Sept. 30, 2021)

District court denied plaintiff's motion for reconsideration of court's holding that plaintiff's infringement claim was barred by fair use doctrine. Defendant photographer took photograph of rapper Cardi B at Tom Ford fashion show. Cardi B published Instagram post that displayed plaintiff's photograph as well as image of lipstick created by Cardi B in collaboration with Tom Ford, alongside comment about how lipstick had already sold out. Defendant published article about how Cardi B had partnered with Tom Ford on new lipstick and embedded Cardi B's post in same. Plaintiff sued defendant for infringement, but district court granted defendant's motion for judgment on pleadings on fair use grounds, holding that defendant's use of photograph was transformative because it was incidental to article's purpose, which was to report on Cardi B's post (which in turn contained plaintiff's photograph). Court also held that defendant's use did not affect market value of photograph because article displayed photograph within context of post (i.e., accompanied by text and another image). Plaintiff moved for reconsideration on ground that court misapplied fair use law. First, plaintiff argued defendant's use could not be transformative because article offered no commentary on photograph itself (as opposed to post). However, plaintiff's argument was improper because she never advanced it in opposition to defendant's motion. In any case, plaintiff's argument that fair use should not be found where defendant uses work that happens to contain copyrighted part unless defendant also comments on said part was not persuasive or supported by case law. Further, plaintiff's argument that article's use of photograph could be deemed to be in same market as photograph itself inappropriate for reconsideration because plaintiff did not previously bring it to court's attention.

*Grant v. Trump*, No. 20-7103, 2021 U.S. Dist. LEXIS 185674 (S.D.N.Y. Sept. 28, 2021)

Court denied defendant, former president Donald Trump's, motion to dismiss plaintiff's infringement claims. Plaintiff wrote, recorded and produced popular song "Electric Avenue." Without permission or license, Trump and his campaign team used song in connection with animated video promoting Trump's presidential campaign and criticizing President Biden. Song can be heard beginning at around fifteen-second mark of video and continues through duration of fifty-five second video. Trump published tweet from his personal Twitter account containing animated video at issue. Court reasoned that several factors weighed against finding incorporation of "Electric Avenue" in video to be fair use, including: (1) purpose and character (court found nothing about song was integral to video's political message, nor was video parodying copyrighted song or using song for purposes of commentary, and, at minimum, Trump failed to show that use was noncommercial as matter of law); (2) amount and substantiality of portion used (i.e., song plays for majority of animation; excerpt includes chorus, which is of central importance to original work); and (3) effect of use on market for original (while animation video does not serve as satisfactory substitute for song itself, it may threaten plaintiff's licensing markets; denying motion to dismiss should not chill legitimate political satire, as Trump could just obtain license for song). Court denied Trump's motion to dismiss, finding that Trump failed to demonstrate

fair use as matter of law. Court advised that Trump could reassert fair use defense at summary judgment stage once factual record had been further developed.

*Nat'l Academy of Television Arts & Sciences v. Multimedia Sys. Design, Inc.*,  
551 F. Supp. 3d 408 (S.D.N.Y. 2021)

District court denied defendant's motion to dismiss. On June 12, 2020, defendant posted nine-minute video on YouTube featuring mock award show honoring countries that minimized severity of COVID. Video displayed image of "Crony Award" which consisted of Emmy statuette holding image of COVID virus. Statuette appeared for first 10 seconds of video and was used as thumbnail image; Crony Award was also used by defendant on social media. Plaintiff Academy served DMCA takedown notice on YouTube and sued defendant for infringement. Defendant moved to dismiss, arguing that use of Crony Award statuette was *de minimis* and qualified as fair use. Court rejected *de minimis* argument based on fact that image of statuette was used as thumbnail for video and image of Crony Award was prominent for portion of video. On fair use argument, court found: on first factor, that defendant's use of Crony Award was not transformative because no significant changes were made to Emmy statuette and award did not have different purpose or character when compared to Emmy statuette. Defendant's use was also commercial because defendant included links in video where consumers could pay for content. Court also rejected argument that Crony Award was parody because defendant's video did not mention Emmy Award show or statuette. On second factor, defendant conceded plaintiff's work could be considered creative. On third factor, court noted that Crony Award was almost exact replica of Emmy Award, which weighed in plaintiff's favor. On fourth factor, court noted that defendant failed to provide factual evidence to support assertion that use of Crony Award had no impact on market value of Emmy statuette. Court denied motion to dismiss.

*Fioranelli v. CBS Broad. Inc.*, 551 F. Supp. 3d 199 (S.D.N.Y. 2021)

District court granted defendant's summary judgment motion in part. Plaintiff, professional photojournalist, took video footage from World Trade Center site following attacks of September 11, 2001, and compiled footage into photographic work. Plaintiff provided defendant, CBS, with copies of footage and, in exchange, CBS agreed to pay plaintiff \$1,000 per use of any portion of material, which was just under two hours and 45 minutes in length. In 2014, plaintiff recognized portions of material in documentary and learned that CBS had sub-licensed material to be used in documentary without plaintiff receiving payment. Plaintiff sued CBS for infringement and CBS moved for summary judgment, seeking dismissal of plaintiff's claims and arguing that infringement was excusable as fair use. Court granted motion in part for some uses – for example, court found that works that included plaintiff's materials in background, such as depiction of characters watching news to learn about attacks, should be considered fair use, given transformative nature of use and fact that only small amount of plaintiff's material was used. For remaining works, court denied motion to dismiss. For some, court found issues of fact relating to purpose of incorporation of plaintiff's work – for example, some films posed conspiracy theories regarding attacks and used plaintiff's work to illustrate theories. For others, such as documentaries and news reels,

court found use was neither *de minimis* nor fair use, given that plaintiff's material was copied with no alteration for same commercial purpose that plaintiff originally intended, and thereby undermined market for plaintiff's work. Accordingly, for these works, court granted plaintiff's motion for summary judgment on infringement.

*Wood v. Observer Holdings, LLC*, No. 20-7878, 2021 U.S. Dist. LEXIS 127484 (S.D.N.Y. July 8, 2021)

District court denied defendants' motion to dismiss based on fair use. Plaintiff professional photographer brought claims for direct infringement and for violations of DMCA against defendants involved in operation and publication of digital media publication *Observer*. In 2016, plaintiff was engaged by Compass, licensed real estate broker, to create photographs of estate in East Hampton, New York. Plaintiff agreed to license photographs to Compass for purpose of marketing house to potential buyers. Before providing Compass with copies of photographs, plaintiff embedded her CMI in photographs' metadata, which included copyright notice. Compass subsequently displayed photos on its website. In 2017, estate was sold to celebrity couple Beyonce Knowles-Carter and Jay-Z. Following purchase, defendants used plaintiff's photos of estate in article titled "Peek Inside Beyonce and Jay-Z's Palatial New Georgica Pond Abode" and credited "Compass" under each of photos. Plaintiff alleged that defendants infringed her copyright by reproducing and distributing photographs without authorization. Defendant brought motion to dismiss on grounds of fair use. Court denied motion to dismiss. As to first fair use factor, court held that defendants' use of photograph was not transformative because photos failed to communicate anything new or different from their use in original real estate marketing materials; namely, to show house. Defendants did not imbue photographs with new meaning by transforming them from their original intent into subject of news story. Court further determined that fact that publication was commercial weighed against finding of fair use. Court found that second fair use factor weighed slightly in favor of defendants, given that photographs were published only to prospective buyers and on publicly accessible website. Regarding third fair use factor, court agreed with plaintiff's argument that there was no justification for use of photographs, as defendants' purpose could have been effectuated by using no photographs or any number of public domain photos. As to fourth fair use factor, court applied presumption of market harm, given that defendants' use of photograph was arguably commercial and entirely duplicative. Based on these factors, court denied defendants' motion to dismiss based on fair use.

*O'Neil v. Ratajowski*, No. 19-9769, 2021 U.S. Dist. LEXIS 185675 (S.D.N.Y. Sept. 28, 2021)

Court granted in part and denied in part parties' cross-motions for summary judgment. Plaintiff "paparazzi photographer" captured photo of model Emily Ratajowski at New York flower shop and later uploaded photograph to his agency, Splash News, where plaintiff's works were shown to subscribers in exchange for licensing fee. Later, Ratajowski posted plaintiff's photo to her Instagram Stories, which are automatically deleted within 24 hours, with superimposed words "mood forever" over bottom of photograph, and plaintiff brought

suit for infringement. Finding plaintiff established that he owned valid copyright and that Ratajkowski copied work, court granted plaintiff's motion for summary judgment on infringement. Parties cross-moved for summary judgment on defendant's fair use defense. On transformative inquiry on first fair use factor, court found genuine issue of fact as to whether defendant's addition of caption "mood forever" was transformative because it constituted commentary on paparazzi's constant pursuit or was not transformative and had same purpose as original. On commerciality inquiry under first factor, court highlighted fact that Ratajkowski had link to her commercial store on Instagram feed and had made money by posting sponsored content, but also noted that she wasn't paid for post in question and that infringing work was not placed directly next to advertisements. Therefore, court found that even though use was "slightly commercial," it gave factor little weight and would be given even less weight if jury found use transformative. Court found bad faith inquiry of first factor to not weigh significantly in either party's favor. On second factor, court found factor weighed "marginally" in favor of plaintiff because it was "essentially factual" because plaintiff took photo of defendant in public as she was, without much direction, and work was published. On third fair use factor, court found that because work was taken as whole, factor weighed slightly in plaintiff's favor, but because defendant posted it on Instagram Stories which would delete in 24 hours, weight in plaintiff's favor decreased. On fourth factor, court found relevant market was people licensing paparazzi photos for use on social media and that record was undeveloped at current time, preventing it from fully assessing it. In sum, court found genuine issues of fact prevented it from ruling on fair use defense. Court denied motions for summary judgment.

*Easter Unlimited, Inc. v. Rozier*, No. 18-6637, 2021 U.S. Dist. LEXIS 184636 (E.D.N.Y. Sept. 27, 2021)

District court denied plaintiff's motion for summary judgment on claims for contributory and vicarious infringement and granted defendant's cross-motion for summary judgment on all claims. Plaintiff, designer, manufacturer and supplier of costumes, alleged defendant, basketball player, used, without authorization, its ghost face mask on defendant's clothing line. Court found defendant's use of ghost face mask constituted fair use. First, court found use transformative because ghost face mask used in films and instilled with meaning beyond Halloween ghost costume and defendant's use of ghost face mask was humorous embodiment of basketball player known as killer scorer. Defendant's humorous reimagination of ghost face mask at least in part commented on plaintiff or work, as required for protection as parody. Defendant's use of ghost face mask may also properly be characterized as satire because defendant established justification for act of borrowing. Thus, court found defendant's use transformative and qualified as both parody and satire. Court concluded defendant's commercialization of ghost face mask without license was of decreased importance, and purpose and character factor favored fair use. Court found second factor, involving "creative and published nature of Defendant's work," favored plaintiff. Third, court found amount and substantiality factor neutral, weighing neither for nor against fair use. Fourth, court found defendant identified distinct and relevant market for merchandise and further found it unlikely merchandise would usurp primary market of holiday and party consumers for ghost face mask, weighing in favor of fair use. As result,

court granted summary judgment in favor of defendant and denied plaintiff's summary judgment motion.

*In re DMCA § 512(h) Subpoena to Twitter, Inc.*, No. 20-80214, 2021 U.S. Dist. LEXIS 247680 (N.D. Cal. Dec. 29, 2021)

District court denied motion to quash and granted motion to compel. Anonymous Twitter user @CallMeMoneyBags posted six tweets depicting photographs of woman's body coupled with references to Brian Sheth, prominent private equity figure. Bayside Advisory LLC, which claimed to have no affiliation with Sheth, registered photographs then requested that Twitter remove posts before serving DMCA subpoena on Twitter to disclose identity of @CallMeMoneyBags user. Court issued order stating that it lacked information to assess possibility of fair use and required Twitter to serve same on anonymous user, who never appeared. Presently, court considered whether to use fair use as proxy for First Amendment analysis in copyright infringement case involving anonymous speaker, or whether to instead use heightened *Highfields* standard (which requires party seeking to unmask speaker to adduce competent evidence to support all inferences necessary to prevail on at least one claim), but ultimately concluded result was same under either test. First, because tweets combined photos with statements lacking obvious meaning and anonymous user did not augment record, court could not say that use was transformative. Then, absence of evidence from anonymous user about relevant market or lack of market harm precluded fair use finding. Because anonymous user did not establish fair use for purposes of quashing subpoena, court granted motion to compel Twitter to disclose user identity.

*Incredible Features v. Backchina*, No. 20-943, 2021 U.S. Dist. LEXIS 250121 (C.D. Cal. Dec. 16, 2021)

Court granted in part and denied in part motion for summary judgment. Individual plaintiffs, Jeffrey Werner and Brian Wolff, were photographers and entity plaintiff Incredible Features was licensor for works at issue. Defendant operated Chinese-language website and published plaintiffs' works without authorization on site. Publication of works on defendants' sites was accomplished by link, so that works were not located on defendant's servers. Plaintiff moved for summary judgment on infringement claim and defendant's affirmative defenses. Defendant opposition centered on its affirmative defenses of fair use, *scènes à faire*, *de minimis* use, and safe harbor under § 512(d). Defendant argued that use qualified under fair use doctrine because it was news reporting and was for "teaching purposes" because it was translated into Chinese in order to be read by Chinese speakers. On first fair use factor, court found that despite defendant's characterization as being for news reporting, works were merely used to illustrate articles, and noted that website was commercial publication. On second factor, court found photos to be creative, and fact that they were published did not militate in favor of fair use. On third factor, court noted that defendants used entire works in articles, which weighed against fair use. On fourth factor, court noted that plaintiffs lost opportunity to license works to defendant and that continued use would harm plaintiffs on greater scale, and accordingly found factor "weigh[ed] heavily against fair use." Court found subject matter of photos, including "70-year old retired real

estate agent ... wearing a custom rubber bodysuit,” was not such that *scènes à faire* would be implicated. It also found inapplicable *de minimis* use defense when defendant used entire works. Court granted summary judgment for plaintiffs on liability and on defendant’s fair use, *scènes à faire*, and *de minimis* use affirmative defenses.

*Moonbug Entm’t Ltd. v. Babybus (Fujian) Network Tech. Co.*, No. 21-6536, 2022 U.S. Dist. LEXIS 33613 (N.D. Cal. Feb. 25, 2022)

District court granted plaintiff’s motion to strike defendant’s fair use defense as implausible. Plaintiff operated CoComelon kids’ channel on YouTube, featuring child character JJ and his family. Plaintiff owned copyrights in 3-D characters, as well as videos, songs, and images. Defendant operated competitor channels, featuring character named Super Jojo and his family. Plaintiff alleged that defendant’s videos infringed its works. Plaintiff filed takedown requests and infringement action concerning at least 70 videos. Plaintiff moved to strike defendant’s fair use defense as not plausible. On first factor, court found fact that works were educational to be inapposite when defendant admitted videos were commercial. Defendant did not make any supporting allegations in support of fair use under second factor. On third factor, court found defendant’s arguments – that plaintiff’s works were not protectable and that similarities between works were *de minimis* – to relate to the merits of plaintiff’s infringement claim and not to fair use defense, and otherwise found defendant not to address allegations of frame-by-frame copying, as well as other forms of copying. On fourth factor, court found conclusory and unpersuasive defendant’s assertion that there was no marketplace harm. Finding no factors in defendant’s favor, court granted motion to strike fair use defense as implausible.

*Greenspan v. Qazi*, No. 20-3426, 2021 U.S. Dist. LEXIS 117332 (N.D. Cal. June 23, 2021)

District court granted motion to dismiss, finding that defendant’s use of copyrighted work constituted fair use. *Pro se* plaintiff, Tesla short seller and entrepreneur, posted negative allegations about Tesla and Elon Musk on plaintiff’s website. Defendant Qazi, Tesla enthusiast and shareholder, began criticizing plaintiff online for his attacks against Tesla and Musk. Defendant Musk also criticized plaintiff and referred to him as “ten cards short of a full deck,” among other alleged taunts. Plaintiff sued certain defendants for defamation, DMCA violations, and copyright infringement, claiming that defendants had copied large portions of plaintiff’s autobiography and placed them online. In reviewing motion to dismiss, district court evaluated copyright infringement claims and concluded fair use doctrine foreclosed possibility of copyright infringement. Taking complaint’s allegations as true for purposes of motion, district court found no allegations that indicated plaintiff’s autobiography was copied for commercial use. Furthermore, autobiography was non-fictional work, and plaintiff did not allege copying had demonstrable effect on potential market for or value of plaintiff’s work; these factors all weighed in favor of fair use. Although plaintiff did allege more than 10% of book was copied, court concluded that complaint did not allege enough facts regarding what defendant did with material to determine whether amount copied was more than reasonably necessary. District court

therefore concluded plaintiff's copyright infringement claims were foreclosed by fair use doctrine and dismissed complaint without prejudice.

*Am. Soc'y for Testing & Materials v. Public.Resource.Org, Inc.*, No. 13-1215, 2022 U.S. Dist. LEXIS 60922 (D.D.C. Mar. 31, 2022)

District court granted in part and denied in part parties' motions for summary judgment. Plaintiffs were comprised of three non-profits that developed and published industry standards to assist commercial trade industry, which standards are sometimes incorporated into federal, state, and local laws. Plaintiffs alleged that defendant, non-profit that published legal information, infringed by copying and republishing plaintiffs' works online. Court previously granted summary judgment to plaintiffs, but D.C. Circuit reversed and remanded for further factual development. After supplementation of record, parties cross moved for summary judgment. Defendant argued that its copying and republishing was protected by fair use. On first factor, court found that little record evidence indicated that defendant would profit from reproducing works in question. As to transformativeness, court conducted inquiry on "standard-by-standard basis" in lengthy appendix. On second factor, court distinguished between works that were incorporated into law in way that was like copying all of work into law and text that was incorporated "in a more nuanced way," whereby text in plaintiff's work was not substitute for what was incorporated into law; former would militate in favor of fair use and latter would be less likely to do so. On third factor, court assessed each standard and determined that if defendant only copied what was necessary to publish legal import of work, then it would favor fair use. On fourth factor, court noted that because defendant made noncommercial use, plaintiff had burden to show "by a preponderance of the evidence that *some* meaningful likelihood of future harm exists," and that it failed to meet that burden. Factor favored fair use as to 217 standards that were subject of case. Court granted plaintiffs' motion for summary judgment and denied defendant's motion for summary judgment as to 32 standards not incorporated by reference into law and prohibited defendant from copying, reproducing or distributing those standards. As to 184 standards that were incorporated into law, court denied plaintiffs' motion for summary judgment and granted defendant's motion for summary judgment, and as to one standard defendant partially reproduced, court granted in part and denied in part both parties' motions.

*Viacom Int'l v. Pixi Universal, LLC*, No. 21-2612, 2022 U.S. Dist. LEXIS 57400 (S.D. Tex. Mar. 25, 2022)

District court granted plaintiff's motion for preliminary injunction because plaintiff demonstrated likelihood that evidence would not support fair use, as well as substantial likelihood of prevailing on merits of infringement claim. Plaintiff, media company that owned television series "SpongeBob SquarePants," sued defendant, owner of themed pop-up restaurant "The Rusty Krab" for copyright infringement for alleged copying of various copyrighted works to recreate iconic scenes from series. Defendant raised fair use defense. On first factor, court determined that defendant's use was wholly commercial and not transformative because there was no "parodic character." Court found defendant sought to embrace, replicate, and profit from plaintiff's copyrighted work, weighing against fair use.

On second factor, fictional nature of copyrighted works weighed against fair use. On third factor, court found defendant's use substantial, weighing against fair use. On fourth factor, court found The Rusty Krab affected potential market for plaintiff's possible venture into derivative immersive works, weighing against fair use. Court found absent injunctive relief, plaintiff was likely to suffer irreparable harm, equities weighed in plaintiff's favor, and granting of injunction served public interest.

*Farrington v. BackChina, LLC*, No. 19-3546, 2021 U.S. Dist. LEXIS 117464 (S.D. Tex. Jun. 23, 2021)

District court held defendant liable for copyright infringement. Plaintiff photographer sued defendant media company after learning that some of his photographs had been published on defendant's websites without authorization. Defendant operated Chinese news websites that published both original articles and translated articles from other sources. Defendant claimed right to edit, to refuse to post, or to remove any information or materials from its websites. It could also restrict, suspend, or terminate users' access to its websites. Plaintiff claimed that defendant was vicariously liable for unauthorized publication of his photographs on defendant's websites. Defendant did not contest vicarious liability factors but asserted fair use defense. On first factor, court rejected defendant's argument that plaintiff's photographs merely added "context" to stories, and looked at commercial nature of defendant's use, as defendant profited from plaintiff's images when it used images on two banner advertisements. On second factor, court found that plaintiff made creative decisions, such as choosing location of shoot and composition of work. On third factor, court highlighted fact that defendant not only used portions of plaintiff's works but duplicates of works, and sometimes two times in single article. On fourth factor, court found that plaintiff lost licensing fee to defendant and also noted that plaintiff's images were available on defendant's sites for years before taken down at plaintiff's request. Finding all factors weighed against fair use, court held defendant liable for copyright infringement.

*Philpot v. MyArea Network, Inc.*, No. 20-1239, 2021 U.S. Dist. LEXIS 119423 (M.D. Fla. June 28, 2021)

District court denied defendant's motion for summary judgment and granted in part and denied in part plaintiff's motion for partial summary judgment. Defendant, public social media platform, allowed users to independently post information, commentary, and news about community. Plaintiff, freelance photographer, asserted infringement claim against defendant for displaying his photographs without consent. Defendant moved for summary judgment on affirmative defense of fair use. Court denied defendant's motion because reasonable jury could find fair use did not apply. First factor weighed against fair use because court found defendant's use of photographs not transformative and commercial. Second factor weighed against fair use because court found photographs minimally creative. Third factor weighed against fair use because court found defendant copied one of plaintiff's photographs in its entirety and used most important portion of other photograph. Fourth factor weighed in favor of fair use because court found plaintiff did not demonstrate market

existed for photographs or revenue stream from licensing works, and fact that photographs were offered for free with attribution undermined finding of damage to potential market.

*Whyte Monkee Prods., LLC v. Netflix, Inc.*, No. 20-933, 2022 U.S. Dist. LEXIS 76440 (W.D. Okla. Apr. 27, 2022)

District court granted defendants' motion for summary judgment on fair use grounds. Defendant Netflix released *Tiger King: Murder, Mayhem and Madness*, featuring story of Joe Exotic, produced by defendant Royal Goode Productions. Plaintiff Timothy Sepi filmed eight videos, which were allegedly produced by plaintiff Whyte Monkee Productions, LLC, while Sepi was working at Exotic's Gerald Wayne Interactive Zoological Park. After release of *Tiger King*, Sepi registered works and brought suit for infringement. Defendants moved for summary judgment on grounds that one video was not sufficiently original or, alternatively, that defendants' use of video was fair use. Video in question captured funeral of Exotic's husband, Travis Maldonado, which, in full, ran nearly 24 minutes long and was originally livestreamed on YouTube where it remained posted. Defendants used one minute and six seconds of work, and spliced it with other footage, including critical commentary from Maldonado's mother about Exotic. As initial matter, court rejected argument that video was too unoriginal to warrant protection. Although video was filmed on tripod and not edited, Sepi determined where to place camera and video indicated that Sepi made decisions on where to focus film, thus raising at least factual question as to whether video was sufficiently original for purposes of copyright protection. Court found fair use analysis, however, to tip in defendants' favor. On first factor, court found that it was undisputed that defendants' use of video served different purpose, as Sepi created film to remember friend, while defendants used small part of video and spliced it with critical comments about Exotic and placed it into greater context. Different character of use was not undermined by fact that *Tiger King* was commercial series and clips themselves were not exploited for gain. On second factor, court found video "more factual than creative," and placed particular emphasis on fact that video had previously been published on YouTube. On third factor, court noted that quantitatively small amount of Sepi's video was used in series. On fourth factor, court found that series was not substitute for Sepi's video, and to extent Sepi wanted to license video, clips in series were too short to undercut Sepi's market. Finding all factors weighed in favor of fair use, court granted defendants' motion for summary judgment.

*Brittney Gobble Photography, LLC v. Sinclair Broad. Grp.*, No. 18-3403, 2021 U.S. Dist. LEXIS 222009 (D. Md. Nov. 17, 2021)

District court denied parties' cross-motions for summary judgment. Plaintiff, photographer, sued defendants for infringement based on unauthorized use of images. Parties cross-moved for summary judgment on infringement and DMCA claims. Defendants argued that, even if they infringed copyrights, use should be considered fair. Court found use transformative, weighing in favor of fair use, because defendants used photographs to accompany newsworthy story documenting creation of new, visually-distinctive breed of cats. Because articles focused primarily on cats' distinctive look, photographs were critical piece of story. Court found nature of photos weighed against fair use, because of creative choices made

when taking photographs. Court found defendants published photographs at issue in entirety, without making changes in any way, weighing against fair use. Court needed additional factual development to evaluate extent of market harm caused by defendants' conduct. In sum, court found factual dispute exists on fair use and summary judgment not appropriate at current stage.

## **B. Statute of Limitations**

*Baron A. Wolman Archives Trust v. BuzzFeed, Inc.*, No. 19-9461, 2022 U.S. Dist. LEXIS 43095 (S.D.N.Y. Mar. 10, 2022)

District court denied parties' cross-motions for summary judgment. Plaintiff, trust that owned copyrights in photographs created by photographer Baron Wolman, brought infringement action against defendant BuzzFeed, online entertainment website, alleging that BuzzFeed published one of plaintiff's copyrighted photographs in 2013 article without authorization. BuzzFeed moved for summary judgment, arguing that plaintiff's claim was barred by statute of limitations. Plaintiff opposed motion and cross-moved, contending that it filed its complaint less than three years after discovering infringing article and that record sufficiently established infringement. District court denied both motions as premature. As to defendant's motion, court dismissed defendant's argument that plaintiff was unable to establish when Wolman discovered infringement because Wolman was now deceased, and that complaint itself was inadmissible hearsay. Court determined that such argument was untimely, and that plaintiff was entitled to establish what due diligence would have been reasonable as to whether Wolman was placed on inquiry notice. Court also rejected defendant's position that recent Supreme Court case law barred application of discovery rule in copyright cases, and held that defendant was responsible for producing evidence disputing date on which claims accrued, which defendant had not done. As to plaintiff's motion, court found that it could not afford plaintiff's copyright registration *prima facie* weight at this stage, given plaintiff's inconsistent identification of its registration, and that defendant should have opportunity to develop its fair use and statute of limitations defenses through discovery before summary judgment could be granted in favor of plaintiff.

*Baron Alan Wolman Archives Trust v. Complex Media, Inc.*, No. 20-152, 2022 U.S. Dist. LEXIS 31079 (S.D.N.Y. Feb. 22, 2022)

District court denied summary judgment for defendant on statute of limitations grounds, finding that copyright claims can be tolled under discovery rule. Baron Wolman brought copyright infringement suit over photograph he took of musician Jimi Hendrix, and trust continued suit after his death. On September 20, 2012, Complex Media published article titled "A Detailed History of Celebrity Sex Tapes," which included image of Hendrix photograph, on its website. Parties cross-moved for summary judgment prior to discovery, and court denied both motions. Defendant argued statute of limitations applied and that discovery rule did not apply to copyright cases, but court ruled that equitable tolling applies to copyright claims and claim only needed to be brought within three years of discovery of claim by Wolman. Defendant alleged plaintiff should have discovered claim earlier, but

defendant had not yet met its burden to establish that fact. Nor had plaintiff met its burden to show that it could not have discovered alleged infringement sooner. Thus, neither party established basis for summary judgment on this point. Plaintiff also did not meet burden for summary judgment on merits, as defendant raised several affirmative defenses that could not be dismissed as matter of law pre-discovery.

*Baker v. Weber*, No. 19-1093, 2021 U.S. Dist. LEXIS 188544 (S.D.N.Y. Sept. 30, 2021)

District court denied plaintiff's motion for summary judgment on infringement claims and motion for default due to genuine issue of material fact. Plaintiff Baker wrote books *Sheisty* and *Still Sheisty* and held copyright registrations for both. Plaintiff later signed publishing agreement with publisher that granted exclusive right to print, publish and sell in exchange for 10% royalties. Agreement allowed for assignments, termination of agreement if books were out of print after five years, and termination of agreement if publisher filed for bankruptcy or order of liquidation was issued. Six years after agreement, publisher was dissolved and plaintiff requested reversion of rights per agreement. Publisher's owner claimed that publisher had not been liquidated and instead assigned rights in works to other entities. Four years later, in 2014, publisher licensed distribution rights to another entity (Urban Books). Plaintiff sent multiple requests stating she had questions and concerns over deal, but received no response, then sued defendants for infringement, declaratory judgment, and fraud. Defendants asserted several affirmative defenses, including that laches precluded plaintiff's infringement claims. District court noted that laches cannot be used to defeat claim filed within Act's three-year limitations period, and that limitations period begins to run when copyright holder discovers or with due diligence should have discovered infringement. Citing *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663 (2014), district court concluded that separate statute of limitations exists for each alleged infringement. Court thus held that laches could not bar any claims involving publication after February 5, 2016 – three years before plaintiff sued defendants. Regarding publication before February 5, 2016, genuine issues of material fact existed as to whether 2014 license agreement should have put plaintiff on notice of infringement. If it did, then plaintiff's claims started to accrue as soon as defendants published her works.

*Parisienne v. Scripps Media, Inc.*, No. 19-8612, 2021 U.S. Dist. LEXIS 154960 (S.D.N.Y. Aug. 17, 2021)

District court denied motion to dismiss, finding plaintiff's claims were not clearly untimely as alleged on face of complaint. Plaintiff, professional photographer, took photo of person on Brooklyn Bridge and licensed photos to New York Daily News. In March 2016, defendant Scripps Media published online article entitled "6 Famous Places that A-Holes Have Made Intolerable To Visit," and included plaintiff's photographs without authorization. In September 2018, plaintiff's attorneys alerted plaintiff to reproduction of his photos, and plaintiff promptly filed copyright registration in same month, then filed infringement suit against defendant in September 2019. Plaintiff claimed he was unaware of copying until his law firm informed him. Defendant argued that plaintiff's claims were barred by Act's three-

year statute of limitations, and plaintiff should have discovered infringing acts more than three years prior to filing of lawsuit, because defendant's article gave credit to plaintiff and was publicly available and searchable since March 2016. However, district court concluded that defendant failed to identify any inquiry notice or storm warning that should have prompted plaintiff to conduct investigation more than three years prior to suit. Defendant claimed that discovery rule should not apply, because plaintiff was serial litigator and he retained law firm to search for infringements of his photographs. District court rejected such argument, as plaintiff retained law firm less than three years prior to bringing suit, plaintiff did not have general duty to police internet, and defendant did not provide sufficient evidence as to how plaintiff should have been put on inquiry notice. District court therefore denied motion to dismiss.

*Gaffney v. Muhammad Ali Enters.*, No. 20-7113, 2021 U.S. Dist. LEXIS 151090 (S.D.N.Y. Aug. 10, 2021)

District court denied defendants' motion to dismiss. In original lawsuit, prior to securing registrations for works, plaintiff, Muhammad Ali's former personal photographer, alleged infringement stemming from defendants' use of photographs after expiration of license. Plaintiff amended initial complaint after securing registrations and removed photographic works at issue. Plaintiff subsequently filed second suit concerning works that had been removed from complaint in original lawsuit. Defendants moved to dismiss on grounds that claims were barred by *res judicata* and statute of limitations. As to *res judicata* defense, court found claim not precluded because plaintiff removed claim regarding subject works by amending complaint before defendant responded and therefore no prejudice attached to removal of claims. On statute of limitations defense, court found no evidence that plaintiff knew of or should have known of infringement before March 2018, and court noted that copyright owners do not need to police their works. Court also found no reason why separate accrual rule should not apply. Because defendant did not carry burden to show that plaintiffs should have discovered infringing conduct earlier, court denied motion to dismiss on statute of limitations grounds.

*Fioranelli v. CBS Broad. Inc.*, 551 F. Supp. 3d 199 (S.D.N.Y. 2021)

District court denied defendant's summary judgment motion. Plaintiff, professional photojournalist, took video footage from World Trade Center site following attacks of September 11, 2001, and compiled footage into photographic work. Plaintiff provided defendant CBS with copies of footage, and in exchange, CBS agreed to pay plaintiff \$1,000 per use of any portion of material, which was just under two hours and 45 minutes in length. In 2014, plaintiff recognized portions of material in documentary and learned that CBS had sub-licensed material to be used in documentary without plaintiff receiving payment. Plaintiff sued CBS for infringement and CBS moved for summary judgment, seeking dismissal of plaintiff's claims on ground that claims were barred by statute of limitations. CBS argued that plaintiff was on inquiry notice since 2002, when plaintiff entered into agreement with CBS, and that all challenged uses were openly published more than three years prior to plaintiff initiating case. Court disagreed, finding no evidence in record that

plaintiff had actual knowledge of infringement until plaintiff saw 9/11 footage in documentary. Court emphasized that CBS also did not appear to know that material, which was sublicensed, had been included on news reels and distributed until plaintiff brought to their attention in 2014. Accordingly, court found that CBS failed to establish as matter of law that plaintiff knew or should have known that his copyright was being infringed prior to 2012 (i.e., three years before plaintiff filed suit).

*Broecker v. Widows Sons Grand Chapter The King's Guard Inc.*, No. 21-6309, 2021 U.S. Dist. LEXIS 220254 (W.D.N.Y. Nov. 15, 2021)

District court denied motion to dismiss copyright dispute over identifying insignia used by competing motorcycle associations. Plaintiffs had copyright registration for Wings Work, artwork comprising winged pyramid with sun and all-seeing eye. Plaintiff alleged that defendants reproduced, displayed, and created derivative works of Wings Work without authorization. Defendants moved to dismiss on statute of limitations grounds, arguing that claim accrued in 2013 when defendant filed trademark application with USPTO. Court, however, disagreed with defendants' contention that "ownership is the essential issue" in plaintiffs' copyright claims. Defendants acknowledges that plaintiff registered work with Copyright Office in 2007 but suggested that their registration of Wings Work as trademark put question of ownership of Wings Work copyright at issue. Court reaffirmed that trademark laws cannot be used to circumvent protections afforded by valid copyrights. Given fact heavy analysis, court could not conclude as matter of law that defendants' registration of its trademark with USPTO constituted challenge to plaintiffs' ownership of Wings Work. Accordingly, court denied motion to dismiss.

*Yamashita v. McGraw-Hill Glob. Educ. Holdings, LLC*, No. 16-3934, 2022 U.S. Dist. LEXIS 73757 (D.N.J. Apr. 21, 2022)

District court denied plaintiff's motion for summary judgment. Plaintiff photographer sued defendant textbook publisher alleging defendant infringed copyright in photographic works by publishing them outside scope of license agreements with stock photography agency/licensing agent. On plaintiff's motion for summary judgment of infringement, defendant argued that questions of fact remained as to whether plaintiff's claims were time-barred. Applying Third Circuit's "discovery rule" to three-year statute of limitations, district court considered whether defendant demonstrated that "storm warnings of culpable activity" existed, such that plaintiff knew or should have known about infringement, thus triggering statute of limitations clock. Defendants pointed to email received by plaintiff in 2012 (over three years before filing of complaint) from attorney soliciting photographer clients to bring infringement claims against textbook publishers. Although plaintiff argued that this email was not "storm warning" triggering duty to investigate, district court found that email created genuine issue of material fact on plaintiff's discovery of claims and whether they were time-barred, and denied motion for summary judgment on infringement.

*Athos Overseas, Ltd. v. YouTube, Inc.*, No. 21-21698, 2022 U.S. Dist. LEXIS 57302 (S.D. Fla. Mar. 29, 2022)

District court dismissed plaintiff's claims that accrued more than three years prior to complaint's filing as time barred. Plaintiff was wholly owned company of producer Vasallo, who owned world's largest collection of Mexican and Latin American movies. Around 2015, Vasallo learned that films in his collection were being pirated on YouTube after one of his buyers refused to pay licensing fees for film freely available on YouTube. YouTube told Vasallo that YouTube could very easily detect and discontinue piracy using its Content ID system, but only if Vasallo monetized his content on YouTube in some way. Vasallo declined and, instead, Vasallo and plaintiff sent YouTube more than 10,000 DMCA takedown notices over course of six years, though directly infringing videos were still available on YouTube. On May 3, 2021, plaintiff filed complaint against defendants alleging, *inter alia*, copyright infringement. District court granted defendants' motion to dismiss any claims that accrued prior to May 3, 2018 because plaintiff knew or should have known of alleged infringement on YouTube as early as 2015 and Act only allows for claims that have accrued within three years of plaintiff bringing suit.

*Capitani v. World of Miniature Bears, Inc.*, 552 F. Supp. 3d 781 (M.D. Tenn. 2021)

Plaintiff, artist who created illustrations of various dog breeds, in July 2011 entered into license agreement with Geoffrey Roebuck and his wife Cathy Roebuck permitting them to sell wall clocks bearing plaintiff's illustrations. In August 2011, plaintiff registered dog breed illustrations with Copyright Office. In 2014, plaintiff terminated license agreement with Roebucks for failure to pay royalties, and in 2016, plaintiff sued Roebucks for infringement and breach of contract and obtained default judgment. In 2019, plaintiff brought second lawsuit against defendants MiniBears Gems & Gifts ("MBG") and World of Miniature Bears ("WMB"). In 2014, MBG had accepted several shipments of wall clocks from Roebucks on consignment, which George Roebuck had assured MBG were legal and licensed to sell. In 2019, MBG purchased additional wall clocks bearing plaintiff's illustrations from third-party source, who had acquired many of these wall clocks from U.S. Customs. MBG advertised and sold wall clocks on its website, and on online retail platforms such as Amazon and eBay. On February 6, 2019, plaintiff sued defendants for infringement. Defendants presented various affirmative defenses, including statute of limitations. Court rejected defense, holding that plaintiff had proven by preponderance of evidence that MBG advertised or sold wall clocks bearing her illustrations after February 6, 2016, beginning of statute of limitations period. Court rejected MBG's argument that statute of limitations period began in 2014, when plaintiff's images were first published online. Instead, court determined that regardless of when plaintiff's images were published and offered for sale, each actual sale constituted new act of infringement on plaintiff's distribution rights. Therefore, court concluded that although plaintiff could not sue MBG for infringement that occurred prior to February 6, 2016, plaintiff's claims for sales made after that date were not barred by statute of limitations.

### C. Res Judicata/Collateral Estoppel

*Foss v. E. States Exposition*, No. 20-12167, 2022 U.S. Dist. LEXIS 51812 (D. Mass. Mar. 23, 2022)

District court dismissed amended complaint as barred by *res judicata*. Graphic artist plaintiff created large photo-realistic prints of St. Joseph's Abbey's Spencer Brewery for display at annual fair entitled Big E, run by defendant Eastern States Exposition. Defendant created video interview with representative of St. Joseph's, which displayed plaintiff's work and was viewable on Facebook and YouTube. Plaintiff filed multiple prior lawsuits for infringement and other claims. Copyright claims were dismissed with prejudice. Here, plaintiff asserted claims of infringement and violation of VARA. District court held that plaintiff's current copyright claims were substantially similar to those asserted in her prior complaints, which were eventually dismissed with prejudice, and therefore barred by *res judicata*. Although plaintiff also asserted violation of VARA, district court concluded that such claim arose under same common nucleus of operative facts that formed basis of plaintiff's prior complaints, and should have been brought in plaintiff's prior actions. District court therefore dismissed VARA claim as well due to claim preclusion.

*Capitani v. World of Miniature Bears, Inc.*, 552 F. Supp. 3d 781 (M.D. Tenn. 2021)

Plaintiff, artist who created illustrations of various dog breeds, in July 2011 entered into license agreement with Geoffrey Roebuck and his wife Cathy Roebuck permitting them to sell wall clocks bearing plaintiff's illustrations. In August 2011, plaintiff registered dog breed illustrations with Copyright Office. In 2014, plaintiff terminated license agreement with Roebucks for failure to pay her royalties, and in 2016, plaintiff sued Roebucks for infringement and breach of contract and obtained default judgment. In 2019, plaintiff brought second lawsuit against defendants MiniBears Gems & Gifts ("MBG") and World of Miniature Bears ("WMB"). In 2014, MBG had accepted several shipments of wall clocks from Roebucks on consignment, which George Roebuck had assured MBG were legal and licensed to sell. In 2019, MBG purchased additional wall clocks bearing plaintiff's illustrations from third-party source, who had acquired many of these wall clocks from U.S. Customs. MBG advertised and sold wall clocks on its website and on online retail platforms such as Amazon and eBay. Plaintiff sued defendants for infringement. Defendants presented various affirmative defenses, including that *res judicata* barred plaintiff's claims. Court rejected this defense, finding that defendants had waived argument by not timely raising it in their responsive pleadings. Court explained that defendants were on notice of plaintiff's first lawsuit against Roebucks because plaintiff had attached default judgment order to complaint. Instead of raising affirmative defense in their answers, defendants waited to assert defense in their pre-trial brief, one week before trial. Therefore, court held that it would not consider such defense.

*Am. Clothing Express, Inc. v. Cloudflare, Inc.*, No. 20-2007, 2022 U.S. Dist. LEXIS 14050 (W.D. Tenn. Jan. 27, 2022)

District court granted plaintiff's motion for default judgment. Plaintiff, wedding dress maker that displayed photos of models wearing dresses on its website, sued 94 defendants for direct infringement for displaying identical or very similar copies of plaintiff's images on their sites, and selling knockoffs. Plaintiff also sued Cloudflare for contributory infringement since Cloudflare provided content delivery network ("CDN") domain name systems ("DNS"), and related security services for infringing websites. Plaintiff moved for default judgment on liability against 94 defendants. Cloudflare argued that default judgment against 94 website defendants would be improper under *Frow*, venerable Supreme Court precedent holding that default judgment against one defendant that is inconsistent with judgment on merits against other defendants is "unseemly and absurd, as well as unauthorized by law." While courts are split in their interpretation of this precedent, court decided in accordance with Sixth Circuit precedent and limited Supreme Court's holding to cases of joint liability but not to claims of joint and several liability. Court granted default judgment against 94 defendants without reaching damages and stated that plaintiff's motion for default judgment had no preclusive effect against non-defaulting defendants.

#### **D. First Sale Doctrine**

*Zorikova v. Kineticflix, LLC*, No. 19-4214, 2022 U.S. Dist. LEXIS 77788 (C.D. Cal. Apr. 28, 2022)

District court granted defendant's motion for summary judgment. Plaintiff, owner of audiovisual work titled *Ballet Class Viktor Kabaniaev*, sued defendant for offering plaintiff's DVD as part of rental service for fitness and dance DVDs. Defendant, which bought single DVD from Amazon and never copied DVD, asserted first sale doctrine defense. Court confirmed that first sale doctrine covered right to rent lawfully made copies of copyrighted works, finding unpersuasive plaintiff's arguments that work was computer program. While there is narrow exception to first sale doctrine for computer programs, it does not apply to computer programs that are embedded in machine or product.

#### **E. Misuse**

*Philips N. Am. LLC v. Advanced Imaging Servs.*, No. 21-876, 2022 U.S. Dist. LEXIS 71283 (E.D. Cal. April 15, 2022)

District court denied plaintiff's motion to dismiss defendant's copyright misuse counterclaim. Plaintiff, manufacturer of medical equipment, brought action against defendant, business that contracted with hospitals to repair and maintain their medical equipment, after discovering that defendant allegedly acquired unauthorized login information to continue servicing plaintiff's equipment's systems after plaintiff updated its software to require login credentials to access its equipment's systems. Defendant asserted counterclaims including claim for declaratory relief for copyright misuse, on grounds that

plaintiff prevented defendant and other service providers from accessing its system to prevent competition in servicing market “under the guise of protecting their copyrighted material.” Plaintiff moved to dismiss counterclaims. Court denied plaintiff’s motion to dismiss, holding that plaintiff misconstrued defendant’s claim. Court noted that defendant did not allege that plaintiff failed to issue it license to its software or place conditions on its licenses such that defendant was prevented from developing or using software that competes with plaintiff. Instead, defendant claimed that plaintiff leveraged its limited monopoly on its diagnostic software to control area outside of its limited monopoly, i.e., ability to service plaintiff’s machines. Because this practice would prevent service providers from developing their own competing servicing software, as such software would be useless without access to Philips systems, court held that defendant’s allegations were sufficient to state claim of copyright misuse.

*Moonbug Entm’t Ltd. v. Babybus (Fujian) Network Tech. Co.*, No. 21-6536, 2022 U.S. Dist. LEXIS 33613 (N.D. Cal. Feb. 25, 2022)

District court granted plaintiff’s motion to strike copyright misuse defense. Plaintiff operated CoComelon kids’ channel on YouTube, featuring child character JJ and his family. Plaintiff owned copyrights in 3-D characters, as well as videos, songs, and images. Defendant operated competitor channels featuring character named Super Jojo and his family. Plaintiff alleged that defendant’s videos infringed its works. Plaintiff filed takedown requests and infringement action concerning at least 70 videos. Defendant asserted affirmative defense of copyright misuse. Plaintiff moved to strike misuse defense as not plausible. Defendant based defense on plaintiff’s alleged motive in bringing suit. But defendant conceded that misuse defense is separate from plaintiff legitimately invoking copyright, even when also “prompted by ulterior motives.” Relevant allegation concerning defense was allegation that plaintiff was trying to use copyrights to gain monopoly outside of works, such as unprotectable broad concepts. But court found allegation not plausible because broad concepts were invoked by plaintiff as part of “extensive and detailed chain of allegations” plaintiff put forward in takedown notices.

## **F. Sovereign Immunity**

*Can. Hockey, L.L.C. v. Tex. A&M Univ. Ath. Dep’t*, No. 20-20503, 2022 U.S. App. LEXIS 3976 (5th Cir. Feb. 14, 2022)

Fifth Circuit affirmed lower court’s dismissal of copyright and takings claims against Texas A&M University Athletic Department (TAMU) based on state sovereign immunity grounds, and copyright claims against two TAMU employees for failure to state claim. Plaintiff sportswriter and publishing company owner hired writer to create book titled *12th Man*, regarding TAMU athlete E. King Gill, who suited up at halftime during 1922 game due to concern that injured TAMU team would run out of reserve players. Plaintiff interviewed defendant – associate director of media relations at TAMU – regarding Gill and sent defendant draft copy of book. TAMU employee Marquardt later retyped selected portions of draft from plaintiff and removed references to plaintiff, to create article for university

fundraising purposes; two other employees then published article. After TAMU posted article online, plaintiff asserted direct and contributory infringement claims against TAMU and two employees, and state and federal takings clause violations against TAMU. After determining that TAMU Athletic Department is inarguably arm of state and enjoys state sovereign immunity, court of appeals held that plaintiffs failed to allege that TAMU's alleged copyright infringement constituted actual violation of Fourteenth Amendment, which could have abrogated state's sovereign immunity. In addition, copyright claim based on federal takings allegation failed because court held that copyrights are not form of property protected by U.S. Constitution's Takings Clause. However, court held that Texas constitution's takings clause is much broader than federal clause and plaintiffs did have viable state constitution regulatory takings claim, but states are entitled to sovereign immunity from state takings claims brought in federal court. Accordingly, sovereign immunity barred state takings claim as well.

### **G. Miscellaneous**

*Designworks Homes, Inc. v. Columbia House of Brokers Realty, Inc.*, 9 F.4th 803 (8th Cir. 2021)

Eighth Circuit reversed district court's grant of summary judgment to defendants. Plaintiff built homes with particular atrium and stairs, and owners of homes hired defendants to help sell properties. As part of sales process, defendants created floorplan sketches of homes, and plaintiff sued for infringement. Defendant moved for summary judgment, claiming that § 120(a) provided defense to liability, and district court granted motion, finding that floorplans amounted to "pictorial representations" under statute. Plaintiff appealed. Eighth Circuit found on basis of statutory language and legislative history that floor plans were not exempt from liability under § 120(a) as either "pictures" or "pictorial representations." Court noted that decision did not preclude finding other defense, such as fair use, applicable to infringement claim and therefore reversed district court's grant of summary judgment for defendants.

*ABC v. Goodfriend*, 557 F. Supp. 3d 409 (S.D.N.Y. 2021)

District court granted plaintiffs' motion for summary judgment and struck defendants' affirmative defense under § 111(a)(5). Defendant Sports Fans Coalition NY, Inc., non-profit, operated Locast, service that received over-the-air broadcast signals and retransmitted them over internet to users so they could stream on chosen connected device. Although broadcast signals included copyrighted material from plaintiffs' stations, Locast did not license such content from plaintiffs or otherwise receive consent for retransmission. Locast users could purchase "preferred" access for \$5 per month to receive uninterrupted programming, but users who did not pay for full preferred access would have programming interrupted with videos seeking donations. Parties cross-moved for summary judgment on defendants' affirmative defense that they were immune from liability under § 111(a)(5), which shields governments and non-profits from liability for retransmissions if retransmission is made "without any purpose of direct or indirect commercial advantage, and without charge to the

recipients of the secondary transmission other than assessments necessary to defray the actual and reasonable costs of maintaining and operating the secondary transmission service.” Court found defendants had not offered Locast “without charge to the recipients ... other than assessments necessary to defray the actual and reasonable costs of maintaining and operating the secondary transmission service.” In 2020, cost for Locast amounted to \$2.436 million, while service generated \$4.519 million in revenue, indicating that service generated significantly more from charges than was “necessary to defray the actual and reasonable costs of maintaining and operating [Locast].” Court rejected defendants’ argument that user payments were used for “maintaining and operating an expanding system,” and that expansion costs were part of Locast’s operation, holding that § 111(a)(5) allowed for exemption only if costs were used “to defray the actual and reasonable costs of maintaining and operating the service, not of expanding it into new markets.” Without more, court could not infer from text that Congress intended exemption for costs collected for service expansion.

## VII. REMEDIES

### A. Damages and Profits

*Boesen v. United Sports Publ’ns, Ltd.*, No. 21-1029, 2022 U.S. App. LEXIS 4079 (2d Cir. Feb. 15, 2022)

Second Circuit affirmed district court’s denial of attorneys’ fees to prevailing defendant. District court held that defendant’s embedding of Instagram post that contained portion of plaintiff’s photograph was fair use, noting that case required application of traditional fair use analysis in novel factual context. However, district court declined to award attorneys’ fees to defendant because plaintiff’s claims were objectively reasonable. Defendant appealed. Second Circuit affirmed district court’s determination, finding no abuse of discretion where plaintiff’s case, though unsuccessful, had reasonable basis in law. Although district court had expressed some concerns about plaintiff’s motivation and plaintiff’s counsel’s “broader approach to copyright litigation,” it ultimately concluded that plaintiff’s claims in instant action were objectively reasonable and non-frivolous.

*Brooks v. Dash*, 852 F. App’x 40 (2d Cir. 2021)

Second Circuit affirmed district court’s ruling that defendant infringed plaintiff’s copyright because parties were not co-authors. Prior to meeting defendant, plaintiff wrote book series as well as film script based thereon. Parties’ unsigned agreements provided that plaintiff would make all final decisions regarding film, while defendant would provide directing and marketing services for film on work-for-hire basis in exchange for 50% royalty. Defendant made substantial contributions to film, including some cast and crew selection, shooting and directing film, and making certain creative decisions. Defendant claimed that parties had orally agreed to 50/50 split of ownership in film copyright, and therefore film was joint work of which he was co-author, or else that he was dominant author and therefore copyright

owner. After bench trial, district court held that testimony and documentary evidence supported conclusion that parties did not intend to be co-authors, permanently enjoined defendant from marketing or copying film, and awarded plaintiff actual damages of \$300,000. On appeal, defendant argued that damages award was unduly speculative and/or clearly erroneous because it exceeded cost of producing film and profits attributable to infringement. Second Circuit, finding no clear error in district court's holdings, affirmed, holding that actual damages include lost profits and damage to copyright value; thus, district court properly considered indirect evidence of profits that plaintiff might have earned if not for defendant's infringement. As for defendant's argument that damages improperly reflected loss of gross revenue (rather than income or lost profit), defendant failed to raise this argument before district court, and further to demonstrate that award was clearly erroneous.

*Yellow Pages Photos, Inc. v. YP, LLC*, 856 Fed. App'x 846 (11th Cir. 2021)

Eleventh Circuit affirmed district court's grant of summary judgment for defendants on claim for profits. Plaintiff Yellow Pages Photos owned copyright in stock image collections and licensed use of images to other companies, including for use in phone directories and advertisements. Plaintiff had entered into separate license agreements with AT&T Advertising and L.M. Berry, which allowed use of images by those entities and certain of their "affiliates." Plaintiff sued for infringement and sought profits on basis that defendants were not authorized to use images pursuant to license, and that such use constituted infringement. On defendant's motion for summary judgment on claim for profits, district court considered whether plaintiffs showed "causal relationship" between defendants' profits and any alleged infringement. Defendants submitted un rebutted evidence that their profits were not affected by use of plaintiff's images, and that although images were vital in its advertisements, there was no specific connection between use of plaintiff's images (as contrasted with images from other sources) and its profits. On appeal, Eleventh Circuit affirmed.

*Bmaddox Enters. LLC v. Oskouie*, No. 17-1889, 2022 U.S. Dist. LEXIS 4786 (S.D.N.Y. Jan. 10, 2022)

Magistrate judge recommended damages award to plaintiff. Plaintiff brought action for infringement, alleging that defendants copied its educational materials, including website, which provided individuals with information on federal firearms licensing. District judge previously granted plaintiff's motion for default judgment against two defendants and referred damages inquest to magistrate. Plaintiff sought damages (1) in excess of \$80,000 for amounts defaulting defendants received through their website; and (2) over \$200,000, which was amount plaintiff estimated it spent to create and maintain its website during first five years of existence. Magistrate found request for \$83,568.68, amount defendants earned due to infringement, was reasonable and recommended that plaintiff be awarded that amount. As to plaintiff's request for actual damages of more than \$200,000, court found unsupported relationship between plaintiff's expenditures on its website and effect of defendants'

infringement on value of plaintiff's website, which was evidence requested by district judge. Finding plaintiff's request speculative, magistrate recommended denial of these damages.

*Roethlisberger v. Oxido Corp.*, No. 20-1909, 2021 U.S. Dist. LEXIS 235942  
(S.D.N.Y. Dec. 6, 2021)

Magistrate ordered plaintiff to supplement its damages submission. Plaintiff photographer sued defendant for infringement of 202 copyrighted photographs of male models and later obtained default judgment. In support of damages inquest, plaintiff's former counsel (Richard Liebowitz) had submitted single computer screenshot of license fee quote from Getty Images in connection with one photo of male model Eric Nies. After reviewing evidence in support of damages, court found such evidence lacking, in part, because plaintiff's counsel did not provide sufficient evidence to allow court to evaluate whether models in plaintiff's photographs had achieved similar success to model in Getty Images photograph, and whether counsel's chosen parameters for potential license on Getty Images site were appropriate benchmark for determining licensing fee for all of plaintiff's 202 images. Court indicated plaintiff's request for damages would be better supported by invoices of past licensing fees for photographs at issue, copies of licensing agreements, or sworn affidavit/declaration from plaintiff attesting to licensing fees charged for photographs at issue. Magistrate therefore ordered plaintiff to supplement damages submission in support of actual damages claim.

*Tabak v. LifeDaily, LLC*, No. 21-4291, 2021 U.S. Dist. LEXIS 217755  
(S.D.N.Y. Nov. 9, 2021)

District court granted default judgment on infringement claim and awarded statutory damages. Plaintiff professional photographer photographed Verran Madhavan, then registered two photographs with Copyright Office and licensed them to online media source that published them with "gutter credit" identifying plaintiff as creator. Later, defendant ran article on its website featuring photographs without license from plaintiff and removed gutter credit. District court granted plaintiff's default judgment motion because plaintiff sufficiently alleged that he timely registered copyright in photographs and showed defendant's use of identical photographs on its website. Court awarded \$2,500 in statutory damages, finding that defendant (which operated in publishing industry and was presumed to have knowledge of copyright law) acted willfully and further refused to cooperate in litigation.

*Shepard v. Wo Hop City, Inc.*, No. 18-9634, 2021 U.S. Dist. LEXIS 178861  
(S.D.N.Y. Sept. 20, 2021)

District court denied plaintiff's summary judgment motion as to damages. Plaintiffs, mother-daughter team of artists, operated design business. In 1993, Frankie, manager of Chinese restaurant called Wo Hop City, ordered 1,000 t-shirts bearing custom dragon design from plaintiffs. Plaintiffs researched history and significance of dragon iconography and created design that met Frankie's approval. However, Frankie did not place any additional orders with plaintiffs. In 2008, Wo Hop 17 purchased restaurant and, in 2017, plaintiffs discovered

that Wo Hop 17 was selling t-shirts that were identical to those created by plaintiffs in 1993. Plaintiffs sued both entities and court granted summary judgment to defendant, Wo Hop City, given lack of evidence linking defendant to infringement. However, Wo Hop 17 admitted to selling t-shirts with exact copy of plaintiffs' dragon from 2008 through 2017. Wo Hop 17 argued that infringement was not willful; however, as intent and knowledge are not elements of infringement, court granted plaintiff's motion for summary judgment as to infringement, but not for damages, given number of serious factual issues that needed to be fleshed out due to Wo Hop 17's failure to produce sufficient documentation. For example, plaintiffs were not entitled to recover damages for conduct predating October 19, 2015, which is three years prior to filing of suit. However, it was not clear when or whether Wo Hop 17 stopped selling infringing shirts. In addition, plaintiffs were entitled to recover actual damages. However, there were genuine factual disputes as to number of infringing shirts sold by Wo Hop 17, as well as to amount of profit Wo Hop 17 made on each shirt, and whether shirts were given away for free, as claimed by Wo Hop 17. Accordingly, court ordered amount of damages to be determined at trial.

*Bmaddox Enters. LLC v. Oskouie*, No. 17-1889, 2021 U.S. Dist. LEXIS 157010 (S.D.N.Y. Aug. 18, 2021)

District court denied plaintiff's summary judgment motion as to damages. Plaintiff and defendants created and sold educational materials related to firearms licensing over internet at websites. Plaintiff alleged that defendants infringed its copyright in guidebook, look and feel of website, and website code, and also asserted claim for violation of DMCA. Plaintiff moved for summary judgment. Court granted plaintiff summary judgment on claims for infringement of guidebook and look and feel of its website, and assessed proper quantum of damages. On guidebook, court found evidence, including evidence that one of defendants accessed plaintiff's work by hacking into plaintiff's accounts, established that defendants willfully infringed plaintiff's copyright, and awarded plaintiff's \$100,000 in statutory damages. On claim regarding look and feel of website, however, court rejected plaintiff's request of \$202,500 in damages, representing approximate cost of maintaining plaintiff's site during course of defendants' infringement. Court held that proper quantum of damages referred to injury in market value of work, and because plaintiff did not establish that infringement affected market value of plaintiff's website, it could not award damages on count at current stage and instead found inquest or trial on damages appropriate.

*Lievano v. Cointelegraph Media United States*, No. 21-3255, 2021 U.S. Dist. LEXIS 211933 (S.D.N.Y. Nov. 2, 2021)

District court awarded actual damages under Act, statutory damages under DMCA, and attorneys' fees. Plaintiff, photographer, sued defendant, news company, for infringement due to unauthorized use of copyrighted image on website. Plaintiff established ownership of copyright in image and defendant's infringement. Plaintiff submitted proof of actual damages with sworn declaration and chart showing middle range of comparable single-use website licensing fee for copyrighted image and related images. Court found amount plaintiff sought was reflective of actual damages and awarded such damages for defendant's

infringement. Plaintiff established violation of DMCA, but court found plaintiff did not provide sufficient justification for award sought. However, court considered defendant's willfulness in placing own name on image and found statutory damages appropriate. When combined with infringement award, damages provided adequate deterrence. Court awarded attorneys' fees because of defendant's willful misconduct and failure to offer defense to plaintiff's claims. Plaintiff provided reasonable rate and hours expended so requested costs were not objectionable.

*Farrington v. Jewish Voice Inc.*, No. 21-1575, 2022 U.S. Dist. LEXIS 21812 (E.D.N.Y. Feb. 7, 2022)

Magistrate judge recommended entry of judgment of \$6,900 in damages as default judgment against defendant. Plaintiff photographer sued operator of website jewishvoice.com after defendant allegedly published plaintiff's photo of former Congressman Anthony Weiner in article on defendant's website and did not include photo credit. Plaintiff alleged infringement under Act and violation of integrity of copyright management information under DMCA. Following defendant's failure to respond to complaint, plaintiff sought default judgment for \$2,500 in statutory damages for willful infringement, \$5,000 in statutory damages for violation of DMCA, \$595 in attorney's fees, and \$440 in costs. To determine proper damages amount, magistrate evaluated six factors under Second Circuit case law, including state of mind, expenses saved and profits earned by infringer, plaintiff's lost revenue, deterrent effect, infringer's cooperation in providing evidence, and conduct of parties. Despite finding significant evidence of willfulness, magistrate determined that plaintiff had not presented any evidence of lost revenue or defendant's profit, or that defendant had awareness of infringement prior to filing of suit. However, defendant had removed gutter credit from photo. In light of such aggravating and mitigating factors, magistrate recommended award of \$1,500 under Act. Regarding DMCA claim, magistrate considered difficulty of proving actual damages, circumstances of violation, state of mind, and deterrence. Although defendant admitted to willful infringement by failing to answer complaint, plaintiff had not established direct harm or evidence of difficulty in proving actual damages. Magistrate therefore concluded statutory damages award of \$5,000 was appropriate under DMCA.

*Rearden LLC v. Walt Disney Co.*, No. 17-4191, 2021 U.S. Dist. LEXIS 172679 (N.D. Cal. Aug. 16, 2021)

District court granted in part and denied in part defendants' motion for summary judgment. Plaintiffs, owners of program capturing motion of human face to create images used in motion pictures, brought copyright infringement claim based on alleged use of program in production of major motion picture films, including *Terminator: Genisys*, *Avengers: Age of Ultron* and *Fantastic Four*. Court found plaintiff met evidentiary burden at summary judgment stage to demonstrate alleged copyright infringement causally linked to film profits. Court granted defendants' summary judgment motion on issue of causal nexus to indirect profits only for certain films but not for others. Court found defendants' argument – that audience does not see copyrighted software so plaintiff cannot make necessary causal

showing between infringement and profits – incorrect because fact that use is not visible to consumers presents no barrier to finding causal nexus.

*Nintendo of Am. Inc. v. Storman*, No. 19-7818, 2021 U.S. Dist. LEXIS 148119  
(C.D. Cal. Aug. 5, 2021)

District court awarded \$35,000 in statutory damages for each of 49 video games infringed by defendant, for total \$1,715,000. Defendant found liable for copyright infringement for uploading read-only memory (“ROM”) files of Nintendo games to his website [www.romuniverse.com](http://www.romuniverse.com) for download by users and selling subscriptions for site to users seeking increased downloading ability. Plaintiff alleged losses of \$1 to \$3 million based on price of games infringed and copies downloaded. Though unemployed defendant’s 2019 income from site was approximately \$30,000-\$36,000 and defendant only earned approximately \$800 per month from site before he took it offline, court awarded statutory damages of \$35,000 per game for \$1,715,000 total, to compensate plaintiff for lost revenue and to deter defendant from resuming infringing activity.

*UMG Recordings v. Kurbanov*, No. 18-957, 2021 U.S. Dist. LEXIS 250844  
(E.D. Va. Dec. 16, 2021)

Magistrate recommended statutory damages award for copyright and DMCA violations in total amount of \$82,922,500. Plaintiff group of record companies sued defendant operator of “stream ripping” websites “FLVTO.biz” and “www.2.conv.com,” alleging that websites were “designed to convert URLs from streaming sites like Youtube into free downloadable and distributable MP3s” and that such activities constituted direct, contributory and vicarious infringement, inducement of infringement and circumvention of technological anti-copying measures. After defendant refused to comply with discovery and other court orders, magistrate judge recommended default judgment as sanction against defendant. In report and recommendation on default judgment, magistrate found plaintiffs’ claims for direct and contributory infringement and DMCA circumvention well pleaded. Plaintiffs moved for statutory damages for infringement, requesting \$50,000 for each of its 1,618 alleged instances of infringement (totaling \$80,900,000). Magistrate recommended award of plaintiff’s requested relief, given plaintiffs’ lost profits, defendant’s wrongful profits reaped from websites, defendant’s “storied history of infringement” as found by “multiple courts” and defendant’s “knowledge of United States copyright law” as evidenced by citations to DMCA on defendant’s websites and registration of websites in DMCA agent database. On DMCA violation claim, plaintiff requested \$1,250 in statutory damages for each of 1,618 acts of circumvention, totaling \$2,022,500. Magistrate recommended award of plaintiff’s requested relief, finding defendant websites operated “for the purpose of circumventing YouTube’s technological” protections, with knowledge that such circumvention is prohibited by YouTube Terms of Service. Magistrate found circumvention willful, and recommended award of plaintiff’s requested relief.

*Wareka v. Faces*, No. 20-62466, 2021 U.S. Dist. LEXIS 201546 (S.D. Fla. Oct. 19, 2021)

Magistrate judge recommended granting default judgment. Plaintiff, owner of copyright in photo of left side of woman's face, alleges that defendant copied image and uploaded it as Yelp profile picture without authorization. After court found that plaintiff sufficiently alleged infringement claim, it reviewed available remedies. Plaintiff requested \$32,500 in statutory damages, but court instead recommended \$22,500, which was three times plaintiff's average comparable licensing fee, and it also recommended granting permanent injunctive relief. Plaintiff also seeks \$2,100 in attorney's fees and \$187.50 in paralegal fees. Using lodestar method, court found reasonable plaintiff's attorney's requested rate of \$350 per hour and 6 hours of calculated time, but court recommended that requested paralegal fees be denied because tasks were more clerical in nature for which fees could not be recovered. Finally, plaintiff seeks \$457 in costs, which court recommended as costs were those items enumerated in § 1920.

*Reiffer v. Active Certification Servs. LLC*, No. 21-20177, 2021 U.S. Dist. LEXIS 215729 (S.D. Fla. Nov. 8, 2021)

Magistrate recommended award of statutory damages, costs and attorneys' fees to plaintiff. Plaintiff professional photographer filed suit against defendant for using photograph of Dubai skyline taken by plaintiff without license or authorization. Default was entered in favor of plaintiff. Magistrate judge recommended granting in part and denying in part motion for damages, injunctive relief and attorney's fees and costs. Statutory damages were granted in amount of \$45,000 because defendant willfully infringed. Fair market value of photograph was evaluated at \$3,000 for one year license, which court raised to \$15,000, applying scarcity multiplier of five, due to technical attributes of work. It further tripled fair market value to \$45,000 due to willful nature of infringement. Court further awarded permanent injunction against defendant as default judgment was entered, satisfying success on merits. Lastly, attorneys' fees were granted at requested hourly rate for lawyers, with modification for one billing attorney. Court recommended that requested rate for paralegals, legal assistants and investigators be denied and instead adjusted downwards because affidavit did not provide support for amounts. Finally, court recommended that costs also be awarded to plaintiff.

*Yamashita v. McGraw-Hill Glob. Educ. Holdings, LLC*, No. 16-3934, 2022 U.S. Dist. LEXIS 73757 (D.N.J. Apr. 21, 2022)

District court denied defendant's motion for summary judgment requesting that plaintiff be limited to one award per registered compilation. Plaintiff photographer sued defendant textbook publisher alleging defendant infringed copyright in photographs by publishing them outside scope of license agreements with stock photography agency/licensing agent. On defendant's motion for summary judgment, district court considered whether plaintiff may seek individual statutory damage awards for each allegedly infringed photograph, or whether he should be limited to one award per registered copyright. Copyright in plaintiff's works

were registered by licensing agent as “compilation,” and defendant argued that such compilation constitutes one “work” for purposes of calculating damages under Act. Plaintiff contended that group registration was arranged by licensing agent and that he “never issued the compilations and had no hand in their arrangement or composition.” District court found that even though works were registered as compilation, this was not done at plaintiff’s direction and “each of his photographs were licensed individually and could be used separately by” defendant. District court distinguished cases wherein plaintiff was limited to single statutory damages award, noting that in those cases works were intended to be released as compilation, and not individually.

*Capitani v. World of Miniature Bears, Inc.*, 552 F. Supp. 3d 781 (M.D. Tenn. 2021)

Plaintiff, artist who created illustrations of various dog breeds, in July 2011 entered into license agreement with Geoffrey Roebuck and his wife Cathy Roebuck permitting them to sell wall clocks bearing plaintiff’s illustrations. In August 2011, plaintiff registered dog breed illustrations with Copyright Office. In 2014, plaintiff terminated license agreement with Roebucks for failure to pay royalties, and in 2016 sued Roebucks for infringement and breach of contract and obtained default judgment (“*Capitani I*”). In 2019, plaintiff brought second lawsuit against defendants MiniBears Gems & Gifts (“MBG”) and World of Miniature Bears (“WMB”). In 2014, MBG had accepted several shipments of wall clocks from Roebucks on consignment, which George Roebuck had assured MBG were legal and licensed to sell. In 2019, MBG purchased additional wall clocks bearing plaintiff’s illustrations from third-party source, who had acquired many of these wall clocks from US Customs. MBG advertised and sold wall clocks on its website, and on online retail platforms such as Amazon and eBay. On February 6, 2019, plaintiff sued defendants for infringement. Plaintiff requested relief of statutory damages, injunctive relief, and attorney’s fees and costs. Court concluded that MBG was liable for infringement and awarded statutory damages in amount of \$15,000, representing 20 separate \$750 statutory awards for each of 20 dog breed images that defendant infringed. In applying test articulated by Seventh Circuit, court found that each dog breed image illustrated by plaintiff was separate work with distinct value, as evidenced by fact that Roebucks entered into license agreement to license each separate image. Court also held that plaintiff was jointly and severally liable with Roebucks for \$13,500, based on infringement of 18 dog breed images that were subject to present lawsuit and *Capitani I*, and individually liable for infringement of two other dog breed illustrations. Court did not award heightened statutory damages for willful infringement. Court explained that although MBG may have acted negligently because MBG did nothing to verify whether Roebuck had license and never inquired why clocks did not contain logo, such facts did not show willful infringement.

*VHT, Inc. v. Zillow Grp., Inc.*, No. 15-1096, 2022 U.S. Dist. LEXIS 14453 (W.D. Wash. Jan. 26, 2022)

District court awarded over \$1.9 million in statutory damages to plaintiff. Defendant Zillow operated online real estate marketplace that included Digs, part of Zillow that featured photos

of artfully designed rooms in certain properties. Plaintiff professional real estate photography studio took photographs of new listings for marketing purposes pursuant to license agreements with real estate brokers, agents and listing services (“feed providers”), who then provided photos to Zillow pursuant to separate agreement. In agreements with Zillow, feed providers represented that they had all necessary rights and authority to enter into agreement relating to feed data, and that Zillow’s exercise of rights granted by feed providers would not violate any third party’s rights. Shortly after February 2013 launch of Digs, plaintiff and Zillow began discussions regarding licensing plaintiff’s images for Digs. Plaintiff did not ask Zillow to remove photos or accuse Zillow of infringement until July 10, 2014, when plaintiff sent letter notifying Zillow that its use of plaintiff’s images was unauthorized and outside scope of plaintiff’s license to feed providers. Plaintiff ultimately sued Zillow for copyright infringement, including, *inter alia*, of 2,700 images on Digs (2,312 of which were added after plaintiff’s cease-and-desist letter sent). In determining whether to award statutory damages, court held that Zillow’s infringement prior to receipt of plaintiff’s letter was innocent but, after July 10, 2014, Zillow had reason to believe its use of plaintiff’s images was infringing. To start, because jury had previously held that plaintiff was entitled to \$2.84 in actual damages per infringed image, this weighed in favor of awarding damages at or near statutory minimum. Although Zillow’s conduct with respect to 388 images it innocently infringed was not “severe,” its conduct with respect to remaining 2,312 images supported award slightly above statutory minimum to deter companies from using works in new product without first confirming they had correct licenses. Further, law of case was that Zillow’s infringement not willful, and Zillow’s actions even after receiving plaintiff’s letter were not in bad faith. Accordingly, court awarded statutory damages of \$200 per work for 388 innocently infringed images and \$800 per work for 2,312 images where infringement was not innocent, for total of \$1,927,200.

## **B. Attorneys’ Fees**

*Yang v. Mic Network Inc.*, Nos. 20-4097, 20-4201, 2022 U.S. App. LEXIS 8195 (2d Cir. Mar. 29, 2022)

Second Circuit affirmed district court’s denial of defendant’s motion for attorneys’ fees and sanctions. Plaintiff took photo of Dan Rochkind and licensed it to New York Post in connection with article *Why I Won’t Date Hot Women Anymore*. Plaintiff alleged that defendant used digital screenshot of Post article without authorization – including portion of photograph at issue – as banner image for its article *Twitter Is Skewering the ‘New York Post’ for a Piece on Why a Man ‘Won’t Date Hot Women.’* District court dismissed complaint based on fair use defense, which Second Circuit affirmed. Defendant then moved for attorneys’ fees and sanctions. Second Circuit noted that district court had reviewed objective reasonableness of plaintiff’s claims, but did not improperly treat such factor as dispositive. District court also considered plaintiff’s counsel’s history of sanctions, and concluded case was not frivolous or improperly motivated. Second Circuit affirmed, finding no abuse of discretion. District court also concluded that no evidence existed that would support finding that plaintiff or his counsel acted in bad faith. District court therefore denied defendant’s motion for fees, and Second Circuit affirmed.

*Latin Am. Music Co. v. Spanish Broad. Sys.*, No. 20-2332, 2021 U.S. App. LEXIS 29866 (2d Cir. Oct. 5, 2021)

Second Circuit affirmed district court's award of attorneys' fees to defendant. Plaintiff sued for infringement, alleging defendant played its copyrighted songs on its radio stations without valid license. At bench trial, plaintiff relied solely on testimony of its principal, whom court found not credible and concluded "he was 'basically making up his testimony as he went along.'" After district court ruled for defendants on infringement claims, defendants moved for attorneys' fees and costs, which motion was granted by district court. Plaintiff appealed award of attorneys' fees and costs, arguing that claims were objectively reasonable and that any litigation misconduct was attributable to plaintiff's attorneys rather than plaintiffs themselves. Second Circuit rejected this reasoning, finding that district court "properly assessed the reasonableness of Plaintiffs' action based on the record before it, rather than the hypothetical record that might have existed, constructed in retrospect." Since district court warned plaintiff in ruling on summary judgment that "it is doubtful that a finder of fact will credit" plaintiff's principal's testimony unless he "demonstrates savant-like abilities of recall," Second Circuit found that district court did not abuse discretion in finding that plaintiff proceeded with unreasonable claim. On plaintiff's assertion that misconduct was attributable to attorneys (who, during litigation, were ordered to show cause why they should not be sanctioned for misconduct), Second Circuit noted that district court warned plaintiff that "ultimate responsibility for the proceeding remained with the plaintiff" and that that plaintiff had engaged in "litigation strategy designed to extract settlements by imposing costs and litigation risks on defendants." Second Circuit therefore found that district court did not abuse its discretion and affirmed award of attorneys' fees and costs.

*Greg Young Publ'g, Inc. v. Zazzle, Inc.*, No. 20-55812, 2021 U.S. App. LEXIS 24931 (9th Cir. Aug. 20, 2021)

Ninth Circuit affirmed district court's denial of plaintiff's motions for permanent injunctive relief and attorneys' fees. Court found district court did not abuse discretion in denial of motion for permanent injunction because plaintiff failed to demonstrate likelihood of irreparable harm. For example, plaintiff presented evidence of one instance of alleged infringement involving single purchase of copyrighted work, but irreparable harm not automatically established by single finding of infringement. Court also found district court did not abuse discretion in denial of motion for attorneys' fees because balance of factors for fee award did not weigh in plaintiff's favor. District court was correct insofar as reinstatement of jury award raised percentage of damages plaintiff obtained but increase based on reinstatement of willfulness findings did not outweigh defendant's success. Court found no authority supporting plaintiff's view "degree of success" factor refers only to liability findings.

*Baker v. Baker*, 860 F. App'x 502 (9th Cir. 2021)

Ninth Circuit affirmed district court's grant of attorneys' fees to defendant but remanded for recalculation without taking into account defendant's fees incurred in connection with her

counterclaim. Plaintiff sued defendant alleging copyright infringement and state law fraud, asserting that defendant's false representations regarding authorship in copyright applications for certain sound recordings and compositions resulted in inaccurate registrations. Defendant counterclaimed for declaration that registered authorship splits were true and correct. On summary judgment, district court dismissed plaintiff's copyright infringement claim as to defendant on grounds that plaintiff failed to register his copyrights as to one set of songs prior to bringing suit, and that plaintiff had already obtained judgment against defendant as to another set of songs. District court also dismissed plaintiff's fraud claim but not defendant's declaratory judgment claim, which court decided in defendant's favor. Holding that plaintiff's copyright claim was objectively unreasonable in light of plaintiff's failure to comply with pre-filing registration requirements and further that plaintiff pursued his claim in bad faith, district court awarded defendant her attorneys' fees. On appeal, Ninth Circuit held that defendant's declaratory counterclaim sought mere declaration of ownership rights and therefore district court lacked federal subject matter jurisdiction over counterclaim even though it incidentally involved copyright. Further, district court abused its discretion by retaining jurisdiction over defendant's counterclaim while dismissing plaintiff's closely related fraud claim. Accordingly, Ninth Circuit affirmed district court's award of attorneys' fees to defendant as to plaintiff's copyright claim but remanded to district court to recalculate award without taking defendant's fees incurred in connection with her counterclaim.

*Abbas v. Vertical Entm't, LLC*, 854 F. App'x 816 (9th Cir. 2021)

Ninth Circuit reversed district court's denial of attorneys' fees to defendants and remanded for reconsideration under proper standard. Plaintiff filed suit for infringement based on animated film *Bilal: A New Breed of Hero*. Plaintiff appealed district court's dismissal of claim, denial of leave to amend, and imposition of sanctions against plaintiff and its counsel. Defendants cross appealed denial of motion for attorneys' fees and costs. As to dismissal of claim, Ninth Circuit found district court properly granted foreign defendant's motion to dismiss for lack of personal jurisdiction as plaintiff failed to show any contact with forum state. As to district court's imposition of sanctions, Ninth Circuit found district court did not abuse discretion when issuing sanctions and awarding attorneys' fees relating to jurisdiction after finding that jurisdictional allegations were false. As to defendants' cross-appeal regarding sanctions, Ninth Circuit found no abuse of discretion in imposing sanctions only against plaintiff's counsel or in limiting sanctions to fees spent in defending against false jurisdictional averments. As to plaintiff's appeal regarding district court's grant of judgment on pleadings based on statute of limitations, Ninth Circuit found that complaint sounded in ownership, rather than infringement, and that complaint was time barred under three-year statute of limitations period. Court also found district court did not abuse discretion by denying leave to amend, as amendment would have been futile. Finally, court found district court abused discretion in denying motion for fees and costs under § 505. District court found that awarding fees would not further purposes of Act, but correct question is "whether a successful *defense* of the action further[s] the purposes of the Act, not whether a *fee award* would do so." Court, therefore, found that district court applied incorrect standard and reversed and remanded matter to district court to consider fees motion under proper standard.

*Bell v. Eagle Mt. Saginaw Indep. Sch. Dist.*, 27 F.4th 313 (5th Cir. 2022)

Fifth Circuit affirmed award of attorneys' fees to defendant. Plaintiff sports psychologist sued Texas school district after Twitter account of school softball team and color guard posted excerpt of inspirational quote from plaintiff's copyrighted work "Winning Isn't Normal." District court granted motion to dismiss, finding conduct by defendant alleged in pleadings constituted fair use, and granted defendant attorney's fees. Plaintiff appealed to Fifth Circuit. Fifth Circuit held district court did not abuse discretion by "following the normal rule" and granting fees. Rather, Fifth Circuit focused on plaintiff's "long history of suing public institutions and nonprofit organizations over *de minimis* uses" of his works and characterized plaintiff as "serial litigant, who makes exorbitant demands for damages in hopes of extracting disproportionate settlements." Fifth Circuit concluded attorneys' fees were "appropriate deterrent" both to plaintiff and to other copyright holders "who might consider a similar business model of litigation." Award of attorney's fees affirmed.

*Miller v. Hurst*, No. 21-5506, 2022 U.S. App. LEXIS 2494 (6th Cir. Jan. 26, 2022)

Sixth Circuit affirmed district court's award of attorneys' fees to defendants. *Pro se* plaintiff sued defendants for infringement of original musical works. Defendants moved district court several times to dismiss because plaintiff had not registered copyrights before lawsuit, as required under § 411. Each time, district court refused to dismiss case and instead granted plaintiff's motions to amend to add new claims. Eventually, defendants filed motion to stay consideration of claims pending resolution of parallel state court lawsuit. State case resulted in declaratory judgment against plaintiff and, defendants once again requested dismissal due to plaintiff's failure to comply with § 411. District court then granted defendants' motion to dismiss without prejudice and granted defendants' motions for attorneys' fees. On appeal, plaintiff argued that district court erred as matter of law in awarding fees because defendants did not meet definition of "prevailing party" under Act, as claim was dismissed without prejudice and no determination was made on merits. Sixth Circuit held that because defendants successfully rebuffed plaintiff's challenge to legal relationship between parties, defendants were considered "prevailing party" under Act. After analyzing facts under *Fogerty* factors, Sixth Circuit found that awarding fees was proper due to frivolousness and objective unreasonableness of claims and behavior of plaintiff that prolonged case.

*Designworks Homes, Inc. v. Thomson Sailors Homes, L.L.C.*, 9 F.4th 961 (8th Cir. 2021)

Eighth Circuit affirmed district court's award of attorneys' fees to defendant. Plaintiff brought suit against defendants for infringement of its home design. District court granted summary judgment for defendant and awarded more than \$400,000 in attorneys' fees and costs to defendants because it found plaintiff's "litigating position was unreasonable and ... [its] pursuit of the case was, at best, frivolous in nature and, at worst, done in bad faith." Plaintiff appealed. After comparing floor plans, Eighth Circuit found works not substantially similar in terms of expression, finding that works were similar only in that both plans had

two-story “triangular atrium” with great windows and stairs, but otherwise differed. Court also found total concept and feel of works was not substantially similar. As to fee and cost award, Eighth Circuit noted that district court erred when it stated that fees “are the rule rather than the exception,” but otherwise found that court appropriately exercised its discretion in reviewing applicable factors supporting award.

*Walsh v. Townsquare Media, Inc.*, No. 19-4958, 2022 U.S. Dist. LEXIS 79444 (S.D.N.Y. May 2, 2022)

District court granted defendant’s motion for attorneys’ fees after granting its motion to dismiss. Plaintiff photographer sued defendant for infringing copyright in plaintiff’s photograph of rapper Cardi B based on defendant’s embedding, in online XXL Mag article about Cardi B’s lipstick collaboration with Tom Ford, Cardi B’s Instagram post that contained plaintiff’s photograph and addressed collaboration. In settlement discussions, plaintiff made unreasonable settlement demands, seeking payment of \$25,000. District court granted defendant’s motion to dismiss on fair use grounds, holding that defendant’s use of photograph was transformative because defendant merely embedded post (which incidentally contained plaintiff’s photograph) in article discussing post itself. Defendant then moved for attorneys’ fees, which court awarded. Court held that plaintiff’s legal position was contrary to well-established case law that use of copyrighted work in news reporting about work itself is fair. Plaintiff also repeatedly disregarded readily-apparent facts, including by pretending that defendant used photograph to illustrate news report about Cardi B (which court found “manifestly untrue”). Moreover, plaintiff’s settlement tactics involved baselessly inflated settlement demand of \$25,000, which was far beyond the \$1,000-\$5,000 that plaintiff could reasonably have hoped to recover. Finally, not only was this specific case objectively unreasonable and pursued under circumstances indicating improper motivations, but plaintiff’s counsel (Richard Liebowitz) repeatedly brings “questionable copyright cases in this district,” which fact many judges have found relevant in granting attorneys’ fees to plaintiff’s counsel’s adversaries. Accordingly, attorneys’ fees award supported by plaintiff’s unreasonable litigation positions, her apparent bad faith in pursuing litigation and settlement, as well as need to deter similarly baseless claims (including by plaintiff’s specific counsel).

*Capitol Records, LLC v. ReDigi Inc.*, No. 12-95, 2022 U.S. Dist. LEXIS 65110 (S.D.N.Y. Apr. 7, 2022)

District court granted in part and denied in part plaintiffs’ motion for attorneys’ fees following judgment and appeal decided in plaintiffs’ favor. In October 2011, defendant ReDigi launched online marketplace for “used” music files, allowing users to upload previously purchased iTunes files from their hard drives to ReDigi’s online server, at which point original files were deleted from users’ computers and made available for purchase to other ReDigi users. In January 2012, plaintiff Capitol Records sued ReDigi for direct, contributory and vicarious infringement of Capitol’s distribution and reproduction rights for numerous digital music files. Parties subsequently cross-moved for summary judgment. When opposing Capitol’s summary judgment motion, ReDigi – despite previously conceding in litigation and patent application that its service involved copying of music files – for first

time insisted its technology did not “copy” but instead “migrated” single existing file between users’ computers and ReDigi’s database. In granting summary judgment in Capitol’s favor in March 2013, district court held that ReDigi directly and secondarily infringed Capitol’s reproduction rights (because ReDigi’s service necessarily required act of infringing copying regardless of whether one copy of file existed at end of file transfer) and distribution rights, and further that neither fair use nor first sale doctrines shielded ReDigi from liability. In August 2013, court allowed Capitol to file First Amended Complaint adding ReDigi’s founding owners as individual defendants (“Individual Defendants” and, collectively with ReDigi, “Defendants”), following conference in which both parties’ counsel represented that amendment would require no additional discovery. In ReDigi’s September 2013 answer to FAC, it asserted 21 affirmative defenses, many of which were either not raised in ReDigi’s original answer, rejected in court’s summary judgment opinion, or previously asserted and abandoned by ReDigi. In October 2014, court allowed Capitol to file Second Amended Complaint adding two additional plaintiffs (collectively with Capitol, “Plaintiffs”); in answering, ReDigi reasserted all affirmative defenses raised in its September 2013 answer, while Individual Defendants filed answer asserting 30 affirmative defenses, 21 of which mirrored ReDigi’s. Also, notwithstanding counsel’s representations to court, Individual Defendants served discovery requests on Plaintiffs. In August 2015, court issued order precluding Individual Defendants from asserting affirmative defenses that ReDigi failed to timely raise or otherwise waive, noting that Individual Defendants had effectively controlled ReDigi’s prior litigation. In 2015 and 2016, court approved various stipulations narrowing issues on appeal and allowing Plaintiffs to move for attorneys’ fees (but not costs) of up to \$500,000 in connection with district court proceedings. In December 2018, Second Circuit affirmed district court’s determinations that ReDigi had infringed Plaintiffs’ reproduction rights (without addressing distribution rights) and that ReDigi’s conduct was not protected by fair use or first sale doctrines. Plaintiffs moved for attorneys’ fees of \$500,000 for district court proceedings plus additional ~\$98,000 incurred on appeal. District court held that, under *Kirtsaeng* factors, Plaintiffs were entitled to attorneys’ fees for Defendants’ pre- and post-summary judgment arguments and conduct. First, ReDigi’s factual contentions, in its summary judgment briefing, that its technological processes did not involve copying (only “migration”) were objectively unreasonable because they were at odds with record evidence and ReDigi’s prior admissions, thereby requiring Capitol to expend substantial resources in contesting ReDigi’s last-minute recharacterization. Although ReDigi’s legal arguments prior to summary judgment were reasonable because case involved novel questions of law and technology, Defendants’ legal arguments and affirmative defenses following summary judgment were objectively unreasonable because they had been rejected by court and/or waived or abandoned by ReDigi (and, by extension, by Individual Defendants, who were in privity with ReDigi). Second, Defendants engaged in litigation misconduct by engineering last-minute change in technology description during summary judgment, serving discovery requests despite committing to not doing so, and filing meritless pleadings. Further, court found that awarding fees would encourage copyright holders to vindicate meritorious claims regardless of willfulness of infringer’s conduct and would deter not only infringement but also wrongful litigation tactics. Finally, Defendants’ motivation for infringement did not weigh in favor of or against awarding attorneys’ fees despite Second Circuit’s determination in dicta that Defendants attempted in good faith to

legally circumvent Copyright Act's constraints. In light of foregoing, district court awarded Plaintiffs varying percentages of fees incurred with expenses incurred at different stages of litigation, directing Plaintiffs to submit fee records for such stages to allow reasonableness determination.

*Roethlisberger v. Oxido Corp.*, No. 20-1909, 2021 U.S. Dist. LEXIS 235942 (S.D.N.Y. Dec. 6, 2021)

Magistrate judge ordered plaintiff's counsel to provide sworn declaration regarding accuracy of billing records. Plaintiff photographer sued defendant for infringement of 202 copyrighted photographs of male models, and later obtained default judgment. Magistrate judge ordered plaintiff's current counsel to confirm that time entries of former counsel accurately reflected time records contemporaneously made. In connection with damages inquest, former attorney had submitted declaration stating total of 1.6 hours were spent on case, with chart providing services by description, date, and hours of tasks performed. However, former counsel did not confirm that his time was contemporaneously recorded and provided no back-up time records to support fee request. Magistrate judge thus ordered plaintiff's current counsel to confirm via sworn affidavit or declaration that time entries on chart provided by former counsel accurately reflected time records that were made contemporaneously.

*Farrington v. Jewish Voice Inc.*, No. 21-1575, 2022 U.S. Dist. LEXIS 21812 (E.D.N.Y. Feb. 7, 2022)

Magistrate judge recommended award of attorneys' fees following default judgment against defendant. Plaintiff photographer sued operator of website jewishvoice.com after defendant allegedly published plaintiff's photo of former Congressman Anthony Weiner in article on defendant's website and did not include photo credit. Plaintiff alleged infringement under Act, and violation of integrity of copyright management information under DMCA. Following defendant's failure to respond to complaint, plaintiff sought default judgment for \$2,500 in statutory damages for willful infringement, \$5,000 in statutory damages for violation of DMCA, \$595 in attorney's fees, and \$440 in costs. After granting total of \$6,500 in statutory damages under Act and DMCA, magistrate reviewed reasonableness of attorney's requested fee. Noting that courts in Eastern District of New York have approved rates in copyright cases between \$350 and \$500, magistrate concluded that attorney's hourly rate of \$350 was reasonable. However, plaintiff had failed to submit evidence to support finding that attorney's summary of fees was based on contemporaneously-made time records. Magistrate therefore recommended no award of attorneys' fees. Regarding costs, magistrate concluded that plaintiff had failed to submit documentation supporting its requested costs, but took judicial notice of plaintiff's filing fee of \$400, and recommended award of same.

*Big Run Studios Inc. v. Aviagames Inc.*, No. 21-4656, 2022 U.S. Dist. LEXIS 7115 (N.D. Cal. Jan. 13, 2022)

Plaintiffs were unable to recover statutory damages or attorneys' fees where infringement of works began before works were registered, even where later versions of works were

registered within three months of their publication. Plaintiff Skillz created mobile gaming platform that hosted games developed by third-party game developers, monetized through prizes and competitions instead of advertisements or purchases. Developers ran games on platform by integrating plaintiff's Software Development Kit into their games. Plaintiff Big Run created most popular game on platform. Defendant launched unpopular game on platform, then used what it learned to create rival platform with game similar to Big Run's game. Plaintiffs filed infringement suit, including claim for statutory damages and attorneys' fees. Defendant moved to dismiss statutory damages and attorneys' fees claims on basis that works were registered after infringement began, and only three of 23 copyrights in works were registered within three months of publication, for revised versions of works released after infringement began. Court found that infringement commenced when first act in series of acts constituting infringement occurred, so revised works created after start of infringement could not create independent basis for statutory damages or attorneys' fees when plaintiffs failed to register earlier version of works before infringement commenced. Further, plaintiffs did not allege infringement of new elements of revised versions in particular, but only alleged broad infringement of all works.

*Erickson Prods. Inc. v. Kast*, No. 13-5472, 2021 U.S. Dist. LEXIS 165127  
(N.D. Cal. Aug. 31, 2021)

Court granted in part and denied in part plaintiff's motion for attorneys' fees. In 2013, Plaintiff sued defendant for direct, vicarious, and contributory infringement based on defendant's unauthorized use of three photos. In 2015, jury found defendant liable for infringement and awarded plaintiff maximum statutory damages of \$450,000. Plaintiff moved for attorneys' fees and defendant appealed judgment ("first appeal"). During pendency of first appeal, trial court denied plaintiff's motion for fees and costs without prejudice on ground that plaintiff did not present sufficient evidence on reasonableness of hourly rates. After additional submissions, court issued second order, granting in part and denying in part motion for nearly \$183,000 in fees and over \$3,000 in costs. Court also granted in part plaintiff's motion to amend judgment to add debtors, and amended judgment added fee and cost award to jury award; defendant again appealed ("second appeal"). On first appeal, Ninth Circuit affirmed in part, reversed in part, and remanded on willfulness, stating that "[e]ach party to bear its own costs." On second appeal, Ninth Circuit affirmed trial court's amendment of judgment and awarded attorneys' fees. After remand, parties briefed issues of willfulness and court found infringement willful and awarded plaintiff \$450,000 in statutory damages. Plaintiff now moved for attorneys' fees and costs for first appeal, willfulness proceedings post-remand, and collection efforts post-judgment. As initial matter, court rejected defendant's argument that fees were not available because on first appeal Ninth Circuit said that each side would "bear its own costs." Court's prior determination that fee award was appropriate was not appealed and Ninth Circuit's statement did not prevent plaintiff from receiving fee award. However, court found plaintiff could not receive fees from first appeal because it did not apply for same to Ninth Circuit. In assessing Ninth Circuit factors to determine whether attorney fee award for willfulness proceedings post-remand and collection efforts post-judgment was appropriate, court noted plaintiff's substantial success in litigation, weighing in favor of supplemental fee award, and, also noted

that plaintiff prevailed on willfulness, which Ninth Circuit has stated is important in determining fees. While court found that additional fee award would not advance deterrence due to original fee award, it also found that award would compensate plaintiff for enforcing its copyrights. Court also found defendant's position was unreasonable, plaintiff's suit was not frivolous, and plaintiff was not improperly motivated in bringing suit. In assessing totality of circumstances, court found supplemental fee award appropriate, but found it could not make ruling on same on current record because plaintiff did not categorize time such that court could disaggregate time spent on first appeal, which it found not recoverable. It also did not set forth supporting evidence on one attorney's hourly rate. Court ordered plaintiff to resubmit evidence in support of fee and cost request. Court granted in part and denied in part motion for supplemental attorneys' fees and costs award.

*Live Face On Web, LLC v. Cremation Soc'y of Ill., Inc.*, No. 16-8608, 2022 U.S. Dist. LEXIS 48439 (N.D. Ill. Mar. 18, 2022)

District court denied defendants' motion for attorneys' fees. Plaintiff sued defendants alleging infringement of plaintiff's copyrighted source code. Five years later, after several rounds of motions, plaintiff sought voluntary dismissal of case due to outcome of Supreme Court decision in *Google v. Oracle*, which expanded application of fair use and weakened plaintiff's initial position. Court dismissed case with prejudice and defendants moved for attorneys' fees as "prevailing party." District court considered *Fogerty* factors and held that awarding attorneys' fees was not warranted. Specifically, district court found that complaint was neither frivolous nor objectively unreasonable and that plaintiff had not engaged in vexatious litigation any more so than defendants had. Additionally, district court held that awarding attorneys' fees would not serve to deter future bad conduct and would have opposite effect. Parties might hesitate to raise changes in law over fear of attorneys' fees being awarded; therefore, in balancing factors and to encourage parties to promptly raise changes in law, court denied motion for attorneys' fees.

*Philpot v. Indep. Journal Review*, No. 20-590, 2021 U.S. Dist. LEXIS 239011 (E.D. Va. Nov. 30, 2021)

Court granted defendant's motion for costs and reasonable attorneys' fees after dismissing plaintiff's infringement claim on summary judgment. Plaintiff sued defendant based on publication of photograph taken by plaintiff of entertainer Ted Nugent in concert, which defendant included in website article titled "15 Signs Your Daddy Was a Conservative." One sign listed in article of politically conservative parent was "He hearts 'The Nuge,'" which linked to plaintiff's photograph on Wiki Commons, where photograph was posted with attribution to plaintiff. Court awarded costs and attorney's fees requested by defendant based on plaintiff rejecting defendant's offers of settlement for \$5,000 in January and \$20,000 in March 2021 because, according to plaintiff, offers did not adequately cover plaintiff's attorneys' fees. Court reasoned that, even if plaintiff had been successful on merits, plaintiff's decision to pursue litigation in order to obtain legal fees was objectively unreasonable and indicated plaintiff was motivated by something other than obtaining adequate compensation for perceived violation of copyright, especially given defendant's

“strong grounds for resisting any attorney’s fee award to plaintiff under the applicable criteria,” as well as “plaintiff’s prospects of success on the merits of his claim.” Accordingly, court awarded full lodestar amount of \$80,000 in attorney’s fees and \$690 in costs.

*Seven Oaks Millwork v. Royal Foam US, LLC*, No. 20-28, 2021 U.S. Dist. LEXIS 171534 (M.D. Fla. Aug. 10, 2021)

District court awarded reduced attorneys’ fees award to defendant. Plaintiff brought infringement suit in Illinois over use of photographs in catalogue, but defendant moved to dismiss for lack of personal jurisdiction. Court granted motion and provided plaintiff “thirty days to file an amended complaint curing the jurisdictional defects.” Rather than amending complaint, plaintiff filed new complaint in district court in Florida. Illinois case was dismissed with prejudice. Eventually defendant also moved to dismiss Florida case and court granted motion. Defendant then moved for attorneys’ fees for *both* Illinois and Florida cases. Florida district court held that it did not have jurisdiction to grant attorneys’ fees for work done in Illinois case and that it would “be improper for the Court to award attorneys’ fees in connection with ... the Illinois case, in a different jurisdiction in a separate case.” With regards to attorneys’ fees for Florida case, district court considered *Fogerty* factors and held that awarding of attorneys’ fees was warranted. Specifically, court found that plaintiff’s copyright claims were brought frivolously and were objectionably unreasonable because plaintiff knew or should have known that its claims were premised on works that were not entitled to copyright protection. Additionally, there was evidence that plaintiff acted in bad faith and sued out of desire for vengeance and to hurt defendant. However, district court found that amount of fees defendant was seeking was unreasonable and instead granted lower amount. Because one attorney in case was not member of court and did not seek admission *pro hac vice*, it was only reasonable for him to charge at level of paralegal. Additionally, because other attorney in case did not indicate her experience level or expertise with copyright law, and because she used vague block billing entries for administrative tasks, court found that reduction of her rate and billed time was warranted.

*Imapizza v. At Pizza Ltd.*, No. 17-2327, 2021 U.S. Dist. LEXIS 112314 (D.D.C. June 8, 2021)

Magistrate recommended awarding certain attorneys’ fees to defendants. Plaintiff was Washington, D.C.-based pizza chain, and defendants were Scottish-based pizza restaurant and its owners. Plaintiff alleged that defendants infringed its copyrights in its restaurant design plans and look and feel of its locations by entering one of plaintiff’s locations and taking pictures in attempt to create similar pizza restaurant abroad. Plaintiff also alleged that defendants infringed its copyrighted photographs by downloading three photographs from websites that used U.S. servers. District court granted defendants’ motion to dismiss, finding that “Plaintiff’s theories for extraterritorial application of U.S. copyright law were ‘meritless’ and ‘ma[d] no sense’ because Plaintiff had failed to allege any actions that could ‘plausibly constitute[] infringement within the United States.’” D.C. Circuit affirmed dismissal, and defendant moved for \$463,000.12 in fees and costs. Magistrate judge first recommended that

court award defendants' fees under *Fogerty* factors, finding that objective unreasonableness of plaintiff's claims and compensation and deterrence militated in favor of fee award. Although court found that plaintiff's claims were not frivolous and that defendants did not evidence plaintiff's bad faith motivation in bringing suit, when weighing factors together, court found fee award appropriate. Magistrate next determined recommended fee award using lodestar approach, finding that billed amounts of \$575 and \$540 were reasonable for partners of their education and experience, as was requested \$150 rate for law clerk. In assessing reasonableness of hours expended, court adopted "claim-counting" apportionment method, where total fee amount would be reduced by number of relevant claims, which in current case would be 50%. While magistrate judge recommended against awarding fees for unsuccessful sanctions motion at D.C. Circuit, as well as fees expended in U.K. proceeding, court recommended awarding fees on earlier fee motion. Finally, defendants requested \$358.02 in costs incurred during appeal of matter, but court recommended denying such request because types of costs requested should have been timely requested at D.C. Circuit, pursuant to Rules of Appellate Procedure. In sum, court recommended awarding \$201,670.66 in attorneys' fees related to both Copyright Act and Lanham Act claims and denying request for \$358.02 in costs.

*Imapizza, LLC v. At Pizza Ltd.*, No. 17-2327, 2021 U.S. Dist. LEXIS 139234 (D.D.C. July 27, 2021)

District court awarded attorneys' fees to defendants after plaintiff's claims for copyright infringement were dismissed against defendants in Scotland. Plaintiff owner of popular "&pizza" chain based in District of Columbia sued owners of alleged copycat restaurant "@pizza," which existed only in Scotland, for copyright infringement. After district court granted defendants' motion to dismiss for failure to state claim, because conduct occurred overseas, defendants moved for attorneys' fees. District court awarded attorney's fees under Act, finding that while copyright claims were not frivolous, claims were objectively unreasonable and devoid of legal basis, considering that U.S. copyright law does not apply to actors and actions entirely abroad. Only alleged actions in U.S. were visits by defendants to plaintiff's restaurants where defendants took photographs, but Act does not prevent taking pictures of architectural work in public place. Court acknowledged that claims had been found reasonable even with tenuous footing in caselaw, but this case had no footing in caselaw at all, making award of attorneys' fees proper.

*Brownstein v. Lindsay*, No. 10-1581, 2021 U.S. Dist. LEXIS 187485 (D.N.J. Sept. 29, 2021)

District court granted defendants' motion for attorneys' fees. Plaintiff Brownstein filed suit against defendants Lindsay and Ethnic Technologies, seeking declaratory judgment of joint authorship of ethnic identification system that he allegedly created with defendant. Copyrighted matter at issue was computer program that predicts ethnicity of random list of names from mailing database called Lindsay Cultural Identification Determinate (LCID). Plaintiff filed lawsuit, which went to trial, and defendants prevailed. Plaintiff appealed to Third Circuit, which reversed. On remand court again found for defendants granting their

summary judgment motion. Plaintiff appealed again, filing third amended complaint, and Third Circuit exercised plenary review when affirming lower court's decision. Plaintiff then filed writ of *certiorari* with Supreme Court, which was denied. Defendants filed present motion for attorneys' fees. Court found that following remand plaintiffs' third amended complaint lacked merit, and as such attorney's fees should be awarded. Third Circuit expressly stated that plaintiff would need "additional factual development" to demonstrate that post-1997 versions of LCID continued to employ code created by plaintiff. Plaintiff failed to provide any evidence to make that showing, resulting in court granting summary judgment in favor of defendants. By filing third amendment complaint without any evidence that Third Circuit indicated would be required to overturn decision, plaintiff's complaint was frivolous.

*Capitani v. World of Miniature Bears, Inc.*, No. 19-9461, 2022 U.S. Dist. LEXIS 33412 (M.D. Tenn. Feb. 25, 2022)

District court held that co-defendant Minibeargems & Gifts, Inc. (MBG), online retailer, infringed plaintiff's copyright in her dog breed illustrations by advertising and selling products featuring plaintiff's images. Court further determined that co-defendant World of Miniature Bears Inc. (WMB) was not similarly liable for infringement. As prevailing party, WMB brought motion for attorneys' fees and costs. Court denied defendant's motion in part and granted in part, finding that defendant was entitled to award of costs, but not award of attorney's fees. As to attorneys' fees, court held that plaintiff's infringement claims against WMB were not objectively unreasonable or motivated by bad faith because there were facts suggesting that WMB was doing business as MBG or assisting MBG in selling infringing products. Court rejected defendant's argument that awarding fees would advance policy goals of Act, as court had already determined that it was not improper for plaintiff to pursue claim even though it was ultimately unsuccessful. As to costs, court found that defendant was entitled to all costs sought in award, except for parking and mediation costs, as these were only costs challenged by plaintiff.

*Collection v. Latham Cos.*, No. 20-217, 2022 U.S. Dist. LEXIS 71523 (E.D. Ky. Apr. 19, 2022)

District court adopted magistrate judge's report and recommendation granting defendant's motion for attorneys' fees as to infringement claim. Plaintiff, designer and seller of children's clothing and accessories, sued defendant, boutique, for infringement. Court dismissed plaintiff's copyright infringement claim. Defendant filed motion for attorneys' fees. Court referred matter to magistrate, and magistrate found defendant entitled to fees for prevailing on infringement claim. Plaintiff objected to award of fees. Court found plaintiff's claims not wholly frivolous but objectively weak enough to fail on motion to dismiss. In granting motion to dismiss, court explained many claims involved unprotectable elements and determined no reasonable observer could find defendant and plaintiff's designs substantially similar. Plaintiff was also on notice of deficiencies of claims prior to filing suit. Court found plaintiff's copyright claim was so weak no reasonable factfinder could hold in its favor, weighing slightly in favor of granting attorneys' fees. Court agreed with magistrate

that plaintiff may not have brought action solely to vindicate copyright claims. However, inference of underlying questionable motive for litigation weighed slightly in favor of granting attorneys' fees. Court found need for deterrence weighed slightly in favor of granting attorneys' fees. Court concluded attorneys' fees appropriate but disagreed with magistrate's calculation. Magistrate ordered defendant to file amended affidavits of attorneys' fees reflecting only fees related to copyright infringement claim, but defendant included time spent on issues unrelated to copyright, unreasonably vague entries, and commingled entries for time spent on copyright and trademark issues without cost reduction. Court recalculated reasonable value of attorneys' fees.

*Reilly v. Wozniak*, No. 18-3775, 2021 U.S. Dist. LEXIS 223175 (D. Ariz. Nov. 18, 2021)

District court granted defendants' motion for attorneys' fees. Plaintiff worked with Steve Wozniak, Apple co-founder, to start "high tech" university, including by creating website and logo for which plaintiff obtained copyright protection. Wozniak later left plaintiff and started Woz U with other partners, offering courses and website that plaintiff claimed were similar to those he created. Plaintiff filed copyright infringement suit, and jury returned verdict for defendants. Defendants moved for attorneys' fees. Court granted fees, finding that plaintiff's claims were objectively unreasonable, with his time at trial spent more on proving that he had "great idea" than proving elements of copyright infringement. A "claim is objectively unreasonable if a Plaintiff should have known from the outset of the case that the chance of success in the case was slim."

*Markham Concepts, Inc. v. Hasbro, Inc.*, No. 15-419, 2021 U.S. Dist. LEXIS 214365 (D.R.I. Nov. 5, 2021)

District court denied defendant Hasbro's motion for attorney's fees and costs, despite fact that Hasbro was uncontested prevailing party as well as court's acknowledgment that motions presented "a close call." Plaintiff invented, designed and developed game prototype, which court determined was work made for hire. Hasbro submitted instant motion, arguing that plaintiff had advanced objectively unreasonable positions of law and fact, which reflected plaintiff's dubious motivations, thereby justifying payment of attorneys' fees and costs to Hasbro. Court disagreed, reasoning that both sides raised plausible arguments and that plaintiff's claim, though unsuccessful, was not so weak as to be objectively unreasonable to pursue. Court further reasoned that record did not establish that plaintiff had proceeded with improper motivation that would justify award, nor would award serve any meaningful deterrence effect.

### C. Injunction/Impoundment

*Bedford v. Trang Kien Nguyen*, No. 19-10524, 2021 U.S. Dist. LEXIS 200986 (S.D.N.Y. Oct. 14, 2021)

District court granted permanent injunction to plaintiffs. Plaintiffs textbook publishers filed infringement complaint and simultaneously moved for *ex parte* temporary restraining order against defendants for allegedly reproducing and/or distributing infringing digital copies of plaintiffs' books, and court previously granted that motion, issuing preliminary injunction. After expedited discovery, plaintiffs moved for default judgment and permanent injunction, which court granted, finding that defendants' ownership or operation of websites by which they infringed plaintiffs' copyrights was causing plaintiffs irreparable harm, and ordering transfer of domains to plaintiffs. Court entered final judgment and awarded plaintiffs statutory damages.

*Suzhou Angela Online Game Tech. Co., Ltd. v. Snail Games USA, Inc.*, No. 21-9552, 2022 U.S. Dist. LEXIS 20164 (C.D. Cal. Jan. 31, 2022)

District court denied plaintiff's motion for preliminary injunction. Plaintiff, developer of "Myth of Empires" videogame, sued defendant, developer of "Ark: Survival Evolved" videogame, for declaratory judgment of non-infringement and sought preliminary and permanent injunction after defendant sent demand letter to distributor of plaintiff's game alleging that plaintiff's game infringed source code of defendant's game. On motion for preliminary injunction, district court essentially analyzed whether defendant had likelihood of success on merits on infringement counterclaims. After determining that defendant owned copyright registration for its "Ark: Survival Evolved" work, district court considered evidence that plaintiff copied work. Defendants submitted substantial evidence showing copying, including indications that plaintiff's employees had access to and downloaded source code of defendant's game; evidence of "near-identical class, variable and function names" in source code; and strings of code in respective games that included identical misspellings, which suggest that code was copied from defendant's code. District court held that defendant offered "a plethora of circumstantial evidence relating to their counterclaims," including evidence of access and copying. Despite plaintiff's arguments that defendant only showed "scattered fragments" of copied source code, district court found that plaintiff did not have likelihood of success on non-infringement. On irreparable harm prong of injunction analysis, district court found that although plaintiff might suffer harm from losing revenue from its "Myth of Empires" game (its claimed sole revenue stream), "money damages would be sufficient to compensate them" for such harm, and preliminary injunction was therefore not necessary to avoid such harm. After further finding preliminary injunction not in public interest, district court denied motion for preliminary injunction and discharged order to show cause as to why preliminary injunction should not be issued.

*Talavera v. Global Payments, Inc.*, No. 21-1585, 2021 U.S. Dist. LEXIS 221365 (S.D. Cal. Nov. 16, 2021)

District court denied plaintiff's motion for temporary restraining order or preliminary injunction. Plaintiff created computer software program called "SunShop," which handled purchases and transactions done online. In 2008, plaintiff entered into limited license agreement with Blue Bear Software, which was subsequently acquired, along with its software licenses, by defendant Global Payments. Plaintiff discovered use of software by defendant and sued for infringement, requesting injunction and claiming that defendant reverse-engineered and used SunShop without right, license or authority, and had removed all attribution, license keys, and other technological measures to circumvent unlicensed use. Court found that plaintiff had shown likelihood of success on merits for both infringement and DMCA claims. Previously, successful showing on merits warranted presumption of irreparable injury. However, law now required movant to produce actual evidence supporting harm. Plaintiff described irreparable injuries as "harm to reputation; loss of customers; loss of goodwill; and dilution and complete diminution of value of its rights/confidential information" but did not produce any concrete, supporting evidence of resulting harm. Accordingly, court found that plaintiff failed to show irreparable injury and, therefore, injunction was not warranted.

*Am. Soc'y for Testing & Materials v. Public.Resource.Org, Inc.*, No. 13-1215, 2022 U.S. Dist. LEXIS 60922 (D.D.C. Mar. 31, 2022)

District court denied plaintiffs' request for permanent injunction. Plaintiffs were comprised of three non-profits that developed and published industry standards to assist commercial trade industry, which standards are sometimes incorporated into federal, state, and local laws. Plaintiffs alleged that defendant, non-profit that published legal information, infringed by copying and republishing plaintiffs' works online. Court previously granted summary judgment to plaintiffs, but D.C. Circuit reversed and remanded for further factual development. After supplementation of record, parties cross moved for summary judgment and plaintiff moved for permanent injunction. After finding that defendant did not make fair use by copying and reproducing 32 standards, court assessed whether permanent injunction was appropriate. On irreparable injury prong, plaintiff argued that it would face decline in revenue and loss of exclusivity under Act; however, court found plaintiff presented insufficient evidence of economic harm and found defendant presented evidence that it would comply without injunction because defendant stated that it only wanted to publish standards incorporated into law. As to adequacy of monetary damages, court found chance that defendant may be unable to pay damages weighed in favor of granting injunction. As to balance of hardships and public interest, court found that defendant did not identify significant harm it would face if injunction was granted and also found public interest served by granting injunction. In sum, court found that although it granted summary judgment to plaintiff on 32 standards, evidentiary record did not support permanent injunction due to insufficient evidence of irreparable harm and possibility that such standards could later be incorporated into law.

*Wicked Grips LLC v. Badaan*, No. 21-2131, 2021 U.S. Dist. LEXIS 195218 (M.D. Fla. Oct. 8, 2021)

District court denied plaintiff's motion for preliminary injunction. Plaintiff, company that specialized in firearms and hand drawn handgun grips, moved for preliminary injunction to prevent defendants from marketing or selling firearm grips that allegedly infringed plaintiff's copyrights. Court found that plaintiff failed to establish irreparable harm to warrant preliminary injunction and that its cited cases regarding presumption of irreparable harm all predated *eBay Inc. v. MercExchange*. Further, plaintiff's 18-month delay in seeking relief rebutted presumption and fatally undermined any attempt to show imminent irreparable harm. As such, court denied plaintiff's motion for preliminary injunction.

*Millennium Funding, Inc. v. 1701 Mgmt. LLC*, No. 21-20862, 2021 U.S. Dist. LEXIS 153554 (S.D. Fla. Aug. 13, 2021)

District court denied plaintiffs' motion for temporary restraining order to freeze assets owned by defendant owners of virtual private network (VPN) that allowed users to download plaintiffs' copyrighted content without authorization, finding insufficient showing of irreparable harm to justify *ex parte* temporary restraining order. Plaintiffs, streaming service and owners of content on service, brought copyright and trademark claims against VPN dedicated to hosting torrent downloads of plaintiffs' content. Plaintiffs then sought *ex parte* temporary restraining order preventing defendants from transferring assets and domain name to other entities and shell corporations. District court found that plaintiffs did not show sufficient risk of asset transfer to justify providing no notice to defendants of motion, particularly when plaintiffs brought complaint several months before filing motion, and sent demand letter several months before filing complaint, and no asset transfer took place in that time. Plaintiffs' awareness of defendants' site months before demand letter further weighed against finding of irreparable harm. Court noted that delay of as little as two months mitigates against finding of irreparable harm necessary for any temporary restraining order, let alone *ex parte* order.

*Optimistic Invs. LLC v. Kangaroo Mfg.*, No. 21-2212, 2022 U.S. Dist. LEXIS 74108 (D. Ariz. Apr. 22, 2022)

District court granted temporary restraining order requiring defendant to withdraw prior Amazon complaints and barring it from filing new ones. Defendants filed over 200 Amazon complaints regarding plaintiffs' use of copyrighted images and packaging of products, which defendants they claimed to own. Defendants' complaints impaired plaintiffs' ability to sell on Amazon. Plaintiffs asserted they owned copyrights and moved for temporary restraining order. Plaintiffs argued defendants were judicially estopped from arguing they owned copyrights because of representations made in bankruptcy court that all intellectual property was assigned to other parties. Plaintiffs also argued no copying occurred because Amazon automatically routes sellers of products to existing images previously posted by other sellers regarding products. Court agreed with plaintiffs' arguments and found plaintiffs demonstrated substantial likelihood of success on merits that they were rightful owners of

copyrights and that they raised serious questions on merits of case regarding ownership of copyrights. First, plaintiffs' contention there were no recorded [sic] copyrights for products where Amazon complaints were filed, even if true, did not show likelihood of success. Court found argument did not establish plaintiffs were rightful owners of copyrights because registration not required for party to own copyrights or file Amazon complaints. Court also found plaintiffs' implied license argument weak because when purchasing product from supplier, that does not mean buyer also bought copyrights. Court found plaintiffs' claims based on previous copyright assignment and transfer agreement raised serious questions on merits of case but did not show substantial likelihood of success on merits. Court found plaintiffs raised serious questions regarding authorship of creation and design of copyrighted packaging and pictures. Lastly, court found defendants did not contest that certain Amazon complaints filed were not warranted. Court determined balance of hardships tipped in plaintiffs' favor because if temporary restraining order not put in place, plaintiffs would lose businesses and livelihoods. Further, defendants were insolvent so if temporary restraining order not put in place and plaintiffs were later determined to be rightful copyright owners, plaintiffs would be unable to collect money damages. Court found allowing plaintiffs to continue businesses after posting bond would ensure defendants would be able to collect damages if victorious in court so if temporary restraining order filed, defendants would suffer almost no harm. Court found irreparable harm may be presumed because plaintiffs demonstrated likelihood of success on merits regarding judicial estoppel claim. Even if not presumed, court found plaintiffs demonstrated sufficient risk of irreparable harm to justify temporary restraining order because plaintiffs demonstrated loss of goodwill towards consumer bases on Amazon and loss of control over products' reputation irreparable. Court found public interest favored granting temporary restraining order because refusing to issue temporary restraining order would allow defendant's tactics to continue and would lead to inhibited and less competitive market, which would harm consumers. Allowing party to block temporary restraining order by claiming it made inaccurate representations in another proceeding would violate interests and injure public's trust in court system. Court found plaintiffs met burden for mandatory injunction because merits of case were not doubtful and facts and law favored plaintiffs due to judicial estoppel argument. Court determined it would not issue order to show cause why preliminary injunction should not be issued, but without prejudice to later filing motion for permanent injunction.

*Morisky v. MMAS Research LLC*, No. 21-1301, 2022 U.S. Dist. LEXIS 75136  
(W.D. Wash. Apr. 15, 2022)

District court denied plaintiff's motion for preliminary injunction. Plaintiff, creator of medication assessment tool, entered into licensing agreement with defendant to create electronic version of tool. Over time, relations between parties broke down and parties sued each other both in state and federal court for variety of claims including copyright infringement. Parties ultimately entered into settlement agreement. However, plaintiff believed that defendant was not adhering to settlement agreement and filed motion for preliminary injunction to prohibit defendant from using its shared IP. Defendant opposed motion and insisted that its use of IP was compliant with terms of agreement. Court denied

plaintiff's motion for preliminary injunction because plaintiff did not demonstrate that irreparable injury was likely unless injunctive relief was granted.

*LeSEA, Inc. v. LeSEA Broad. Corp.*, No. 18-914, 2022 U.S. Dist. LEXIS 37501 (N.D. Ind. Mar. 3, 2022)

Court denied preliminary injunction requested in counterclaim as defendant did not establish likelihood of success on merits of copyright claim. Litigation involved family dispute over control of LeSEA Christian ministries empire established by evangelist Dr. Sumrall, who passed away in 1996. Defendant sought preliminary injunction to enjoin plaintiff from moving or disposing of any assets. In analyzing likelihood of success, court was persuaded that copyright claims, sounding in ownership, were time barred by three-year statute of limitations. Defendant had notice of competing ownership claims since Dr. Sumrall's death via his will, and even if defendant was unaware of Dr. Sumrall's will, as alleged, alternative was that Dr. Sumrall died intestate, which should have also notified defendant of his inheritance rights. Court noted that central question in copyright ownership case appeared to be one of state law governing inheritance rather than question of federal copyright law. Further, plaintiff addressed fact that to extent plaintiff was not owner of copyright registrations at issue, plaintiff had been granted implied non-exclusive license because Dr. Sumrall created his work in furtherance of mission of evangelical Christian ministry. Finally, plaintiff also argued that defendant had no right to accounting because defendant did not acknowledge joint ownership of copyrights at issue. For reasons stated above, injunction was denied.

*Capitani v. World of Miniature Bears, Inc.*, 552 F. Supp. 3d 781 (M.D. Tenn. 2021)

Plaintiff was artist who created illustrations of various dog breeds. In July 2011, plaintiff entered into license agreement with Geoffrey Roebuck and his wife Cathy Roebuck permitting them to sell various products, including wall clocks bearing plaintiff's illustrations. In August 2011, plaintiff registered dog breed illustrations with Copyright Office. In 2014 plaintiff terminated license agreement with Roebucks for failure to pay royalties, and in 2016 plaintiff sued Roebucks for infringement and breach of contract and obtained default judgment. In 2019, plaintiff brought second lawsuit against defendants MiniBears Gems & Gifts ("MBG") and World of Miniature Bears ("WMB"). In 2014, MBG had accepted several shipments of wall clocks from Roebucks on consignment, which George Roebuck had assured MBG were legal and licensed to sell. In 2019, MBG purchased additional wall clocks bearing plaintiff's illustrations from third-party source, who had acquired many of these wall clocks from U.S. Customs. MBG advertised and sold wall clocks on its website, and on online retail platforms such as Amazon and eBay. On February 6, 2019, plaintiff sued defendants for copyright infringement. Plaintiff also requested statutory damages and injunctive relief. Court concluded that MBG was liable for infringement and awarded plaintiff statutory damages. As to injunctive relief, court issued status quo injunction to permanently enjoin MBG from infringing on plaintiff's images or selling any products with plaintiff's images without permission. Although court determined

that it would not be equitable to require MBG to destroy clocks or ship them to plaintiff at its own expense, given that MBG neither intended to commit infringement nor expressed willingness to selling infringing products in future, court also disagreed with MBG's argument that clocks it had purchased from third-party source were free of any copyright. Court held that, under terms of injunction, parties were permitted to do nothing with wall clocks, or to negotiate their own licensing agreement to sell them.

*Ass'n of Am. Publr., Inc. v. Frosh*, No. 21-3133, 2022 U.S. Dist. LEXIS 27892 (D. Md. Feb. 16, 2022)

Court granted plaintiff's motion for preliminary injunction. Plaintiff Association of American Publishers ("AAP") challenged constitutionality of Maryland law requiring that, if publisher offers to license electronic literary products to public, publisher must also offer to license same products to Maryland public libraries on "reasonable terms." AAP, on behalf of publishing houses, alleged that state act was preempted and requested preliminary injunction enjoining enforcement of state law pending final adjudication of state law's constitutionality. Court agreed, finding that state law likely would stand as obstacle to accomplishment of Act's objectives and that it was likely preempted under Supremacy Clause, given that, according to court, law's mandate that publishers offer to license their products to libraries interferes with copyright owners' exclusive right to distribute by dictating whether, when and to whom they must distribute their copyrighted works. As result, court reasoned, AAP members would be likely to suffer actual and imminent irreparable harm if state law were not enjoined, despite absence of any indication that law had been enforced since it took effect, given that damages may stem even from "a publisher's choice to comply" with law. Court also found that balance of equities tipped in favor of AAP's members, and public interest would be better served by enjoining act, given that, according to court, act would not necessarily accomplish state's goal of increasing access to publishers' products for library users over time. While court acknowledged that libraries face unique challenges in evolving society that is increasingly reliant on digital media, court also emphasized importance of balance between critical function of libraries and preservation of exclusive rights of copyright holders. Accordingly, court granted injunction.

*Tee Turtle, LLC v. Swartz*, No. 21-1771, 2021 U.S. Dist. LEXIS 107745 (S.D. Ohio June 9, 2021)

District court granted parties' joint motion for permanent injunction. Plaintiff owned copyright registration protecting work of authorship embodied in reversible octopus plush toy. Defendant sold, on Amazon.com and through her online business, reversible octopus plush toy that was nearly identical to plaintiff's without plaintiff's authorization. Plaintiff notified Amazon.com, pursuant to DMCA, of defendant's infringing sales. After Amazon.com delisted defendant's infringing goods, defendant submitted counter-notification in which she made number of materially false statements (including that plaintiff's toy was not copyrighted, that plaintiff did not own copyright in question, and that plaintiff failed to provide registration information or follow proper DMCA notice form). Plaintiff sued defendant for copyright infringement. Upon parties' joint motion, court ordered permanent

injunction against defendant's sale, production or advertisement of defendant's infringing goods and dismissed case with prejudice.

### **VIII. PREEMPTION**

*MLGenius Holdings LLC v. Google LLC*, No. 20-3113, 2022 U.S. App. LEXIS 6206 (2d Cir. Mar. 10, 2022)

Second Circuit affirmed dismissal of contract claim as preempted, where claim was based on unauthorized publication of lyric transcriptions. Plaintiff operated Genius, online platform where fans transcribed song lyrics. Defendant LyricFind copied those transcriptions and licensed them to Google, which displayed them in response to user searches, depriving Genius of traffic. Plaintiff sued in New York state court for breach of contract and unfair competition; defendants removed to federal court and plaintiff moved to remand. District court instead dismissed claims as preempted. Second Circuit agreed, finding that subject matter of plaintiff's claims was its lyrics transcriptions, which enjoy copyright protection as literary works. Plaintiff argued that its claims could not be brought under copyright law because its transcriptions are not copyrightable, as they lack requisite originality. This did not defeat preemption, as Act prevents states from protecting work if it fails to achieve federal copyright for lack of originality. Court rejected plaintiff's claim that it was only trying to protect its time, labor, systems and resources. Complaint repeatedly alleged misappropriation of "content," and content in question was lyrics transcriptions, putting this within scope of Act. Plaintiff failed to show any extra elements making its claims qualitatively different from infringement claim. Nor did claims fall within "hot news" exception to preemption, as transcriptions did not constitute time-sensitive information.

*CDK Global LLC v. Brnovich*, 16 F.4th 1266 (9th Cir. 2021)

Ninth Circuit affirmed district court order denying motion for preliminary injunction against enforcement of Arizona "Dealer Law," finding law not preempted. Dealer Law prevented database providers from limiting access to dealer data by dealer-authorized third parties and requires providers to create standardized framework to facilitate access. Plaintiff database provider sought injunction, arguing that statute was preempted. Court held that there was no conflict preemption because laws were not irreconcilable, and plaintiff could not establish that every possible application of statute would conflict with Act. Providers historically collected consumer data for car dealers, but locked dealers into long-term contracts where switching providers was too costly. Arizona passed Dealer Law to ensure dealers retained control over their data, including provision that providers must adopt standardized framework using API if reasonable. Providers argued that providing this access would require them to make and share copies of their databases of consumer data in violation of Act, but court found that for technical reasons this was inaccurate. Additionally, such copies, if made, would not infringe providers' reproduction right, as copies would still run on providers' servers and not elsewhere. Further, copies would be transitory and therefore permissible, as when software is temporarily loaded into computer memory to be used.

Dealers also failed to show that they would need to copy APIs as opposed to simply using them.

*Melendez v. Sirius XM Radio, Inc.*, No. 20-6620, 2021 U.S. Dist. LEXIS 118160 (S.D.N.Y. June 24, 2021)

District court dismissed plaintiff's claims for violation of right of publicity as preempted. Plaintiff, known professionally as "Stuttering John," was celebrity comic who previously worked on Howard Stern radio show as writer and interviewer. When Howard Stern Show licensed its archives to defendant Sirius XM Radio, plaintiff brought diversity action, alleging his identity, persona, name and image were used to advertise Sirius XM goods and services without his authorization, in violation of right of publicity under California statute and common law. Drawing reasonable inferences in favor of plaintiff, court assumed that sound recordings at issue were not copyrighted, but noted that they were copyrightable, and thus still possibly subject to statutory preemption. Court looked to whether focus of plaintiff's claim was to vindicate misuse of his likeness or identity, or to seek redress for advantage gained by defendant that flowed from reproduction of copyrightable work itself. Plaintiff had not pleaded any facts indicating that Sirius XM audience would conclude that defendant was using plaintiff's likeness to promote Sirius XM itself, rather than Howard Stern Show. In addition, district court held that plaintiff's claims were not qualitatively different from copyright infringement claims, as they were essentially claims for wrongful rebroadcasting of copyrightable sound recordings. District court therefore concluded that use of plaintiff's likeness was to promote work itself, rather than to exploit plaintiff's identity, and dismissed plaintiff's claims with prejudice due to federal preemption.

*Framework MI, Inc. v. CVS Health Corp.*, No. 20-907, 2021 U.S. Dist. LEXIS 110005 (S.D.N.Y. June 11, 2021)

District court held that plaintiff's breach of contract claim, even if had been properly stated, was preempted. Plaintiff was healthcare consulting and technology company and owner of Cleo Suite, which contained code for interfaces that let pharmacies manage patient information. Defendants were various entities related to CVS. In 2015, non-party pharmacy Encompass RX, LLC ("Encompass") licensed work from plaintiff and contracted to keep work confidential. In 2018, while still receiving license from plaintiff, CVS subsidiary purchased Encompass. At same time, plaintiff was in negotiations with CVS to license works, and parties entered NDA. Plaintiff alleged that CVS participated in negotiations in bad faith and improperly accessed and copied its works. Defendants moved to dismiss state law claims on preemption grounds. Court found that plaintiff failed to state breach of contract claim, and, even if it did, it was preempted. It further found that plaintiff's breach of implied covenant, misappropriation of trade secrets, and unjust enrichment claims were preempted because claims concerned matters falling within copyright's subject matter and scope.

*Harris v. Am. Accounting Ass'n*, No. 20-1057, 2021 U.S. Dist. LEXIS 226517  
(N.D.N.Y. Nov. 24, 2021)

District court held that plaintiff's claims not preempted. Plaintiff accounting professor authored working paper on "topic of how a firm employing its auditor for non-audit tax consulting services affected the quality of the firm's financial statements." Plaintiff alleged that defendants American Accounting Association (AAA) and certain authors published paper in AAA journal that plagiarized his work and ideas, and sued for several claims including infringement. Defendants moved to dismiss unfair competition claim as preempted, arguing that claim was "grounded solely in copying of Plaintiff's academic paper" and "an unfair competition claim based on a theory of reverse passing off contains no element to qualitatively differentiate it from those areas protected by copyright." District court found that plaintiff's claims did not meet subject matter requirement of preemption because plaintiff "not claiming that Defendants plagiarized the language" of his paper, but rather that they "copied the *ideas* contained in that paper, and then falsely represented that Defendant Authors were the first to explore those ideas." District court therefore did not reach question of whether claim met "general scope" requirement of claim preclusion, and held unfair competition claim not preempted by Act.

*Lew v. City of Los Angeles*, No. 20-10948, 2022 U.S. Dist. LEXIS 3196 (C.D. Cal. Jan. 6, 2022)

District court dismissed plaintiff's claim as preempted. Plaintiff artist and muralist "Shark Toof" created art exhibition entitled "Don't Believe the Hype: LA Asian Americans in Hip Hop," consisting of "art creations" displayed on "canvas bags, which were to be hung outside" grounds of defendant Chinese American Museum of Los Angeles. Plaintiff sued for claims including violation of VARA and California Art Preservation Act ("CAPA"). Defendants moved to dismiss CAPA claim on basis that claim was preempted by VARA. In considering whether CAPA claim falls within "subject matter" of federal copyright law, district court found that plaintiff sufficiently pleaded that his work was "work of visual art" and thus encompassed by VARA. In considering whether rights plaintiff asserted were equivalent to rights protected under VARA, district court found that CAPA, like VARA protects artists' moral rights, including "the right of integrity as well as the artist's reputation." District court therefore held that CAPA claim fell "squarely within the scope of VARA" and dismissed claim as preempted by VARA.

*Callahan v. PeopleConnect, Inc.*, No. 20-9203, 2021 U.S. Dist. LEXIS 210857  
(N.D. Cal. Nov. 1, 2021)

Court found right of publicity class action partially preempted in suit against website that scanned yearbooks to create searchable database of individuals. Defendant, owner of Classmates.com, scanned yearbooks and extracted information about individuals to put into database. Plaintiffs filed class action against defendant for misappropriation of plaintiffs' names and likenesses under California right of publicity statute. Court found that, although defendant had no interest in copyrights in photographs, defendant still had standing to assert

preemption, as preemption turns on rights asserted by plaintiff, not status of parties. Plaintiff asserted that claims were not preempted because photographs appeared in advertisements, taking claims outside of copyright law and into right of publicity law concerning likenesses used in advertisements. Court disagreed, as advertisements used images from copyrighted work ultimately at issue. Claims were thus preempted to extent based on use of plaintiffs' names and likenesses to advertise reprinted yearbooks. To extent claims based on use of names and likeness to advertise subscription membership, claims not preempted.

*Yoakam v. Warner Music Grp. Corp.*, No. 21-1165, 2021 U.S. Dist. LEXIS 164915 (C.D. Cal. July 12, 2021)

Court held that plaintiff, country singer Dwight Yoakam's, conversion claim concerning his musical works and sound recordings was preempted. Yoakam entered into recording agreement with defendant Warner Bros. Records in 1985. Agreement granted Yoakam's copyright interests in numerous sound recordings and music videos to defendant. In 2019, Yoakam served termination notices on defendant, effective 35 years from date of publication, pursuant to section 203 of Act. However, Yoakam miscalculated proper notice period by five days and, as result, defendants refused to acknowledge that Yoakam had validly terminated copyright grant for those songs. Yoakam sued, claiming infringement or, alternatively, conversion. Court found that Yoakam's conversion claim was preempted, given that (1) subject matter of Yoakam's conversion claim, namely musical works and sound recordings, overlapped with subject matter of infringement claim, and (2) rights asserted under state law were equivalent to rights contained in Act. Accordingly, court granted Yoakam leave to amend conversion claim.

*Best Carpet Values, Inc. v. Google LLC*, No. 20-4700, 2021 U.S. Dist. LEXIS 183693 (N.D. Cal. Sept. 24, 2021)

District court held that plaintiffs' claim to recover advertising fees was not preempted. Plaintiffs, owners of U.S.-based websites, initiated class action lawsuit against Google for implied-in-law contract and unjust enrichment claims based on Google superimposing pop-up banner ads over plaintiffs' websites appearing on Android phones, some of which ads promoted plaintiffs' competitors. In its motion to dismiss, Google claimed that plaintiffs' implied contract/unjust enrichment claim should be dismissed as preempted. Google contended that plaintiffs' claims depended on their ability to control how copies of their websites were displayed on different users' devices, and thus any right to control appearance of websites was grounded in copyright law. District court looked to first prong of preemption test, concluding that subject matter of plaintiffs' claim concerned both advertisements and plaintiffs' websites, and that websites fell within subject matter of copyright. Under second prong, district court held that plaintiffs were not asserting infringement of any right to reproduction, performance, distribution or display of their websites. Rather, plaintiffs wanted Google to display their websites, and acknowledged that Google had license to do so. Plaintiffs had alleged that Google unjustly enriched itself by saving on advertising costs and earning profits at plaintiffs' expense; plaintiffs did not rely on copyright protection in pleading claim, nor did they allege that Google improperly

benefited from using certain work. Instead, plaintiffs alleged Google allegedly covered up or obscured portion of plaintiffs' websites for financial benefit. District court therefore concluded that plaintiffs' claim to recover advertising fees was not preempted.

*Symbria, Inc. v. Callen*, No. 20-4084, 2022 U.S. Dist. LEXIS 2719 (N.D. Ill. Jan. 6, 2022)

Court denied defendant's motion to dismiss because plaintiff's claims not preempted. Plaintiff, parent company of businesses providing clinical health services for senior living and post-acute care providers, sued defendants, former corporate officers and employees of plaintiff, when defendants formed venture to compete against plaintiff in field of rehabilitation and wellness services to senior living and skilled nursing facilities. Plaintiff alleged that defendant infringed plaintiff's rights in its presentation slides relating to rehabilitation and wellness services, as well as disease management models, among other claims, including state-law claims for tortious interference and aiding and abetting. Defendant moved to dismiss claims, arguing that Act preempted plaintiff's state-law claims. Court found that state-law and common law claims were not preempted because they alleged wrongful conduct other than unauthorized copying prohibited under Act. For example, tortious interference concerns interference with contract prohibiting solicitation, which is qualitatively different from unauthorized copying. Accordingly, court denied defendant's motion to dismiss.

*Bonilla v. Ancestry.com Operations Inc.*, No. 20-7390, 2021 U.S. Dist. LEXIS 233870 (N.D. Ill. Dec. 7, 2021)

District court found plaintiff's claim that defendant violated Illinois Right of Publicity Act (IRPA) not preempted by Act because allegations qualitatively distinguish IPRA claim from rights protected by Act. Plaintiff's claims involved Ancestry.com's alleged use of plaintiff's name, identity, image, and likeness to advertise and solicit Ancestry's paid products and services without consent. Ancestry argued plaintiff's claims preempted because they arose solely from conduct governed by Act and did not involve allegations involving endorsement. Court determined endorsement not required for violation of IRPA. Fact that yearbook itself could be copyrighted did not preempt claim based on allegations that Ancestry used likeness for commercial advantage. Court found IRPA claim not subject to preemption.

*MultiTracks, LLC v. Palmer*, No. 21-645, 2022 U.S. Dist. LEXIS 35387 (W.D. Tex. Mar. 1, 2022)

District court denied defendant's motion to dismiss complaint for failure to state claim. Plaintiff, company that modified and enhanced original master recordings so that portions could be played by subscribers during live church meetings, sued defendant for fraud, fraudulent inducement, and breach of contract, alleging that defendant had violated plaintiff's Terms of Use and had used plaintiff's recordings to create video tutorials that it sold to customers. Plaintiff moved for preliminary injunction, which district court denied. Defendant then moved to dismiss plaintiff's complaint, arguing that Act preempted plaintiff's breach of contract claim. District court disagreed and concluded that contract

claim was not preempted because contract claim required more than mere determination of rights under Act, since factual findings and application of state law were necessary to resolve claim. Defendant argued that plaintiff's breach of contract claim was barred by copyright misuse doctrine, but court explained that no copyright claim had been asserted and copyright misuse "is not a defense to state law claims." District court denied defendant's motion to dismiss.

*InSync Training, LLC v. Am. Soc'y for Training & Dev., Inc.*, No. 21-594,  
2022 U.S. Dist. LEXIS 68604 (D.N.H. Apr. 13, 2022)

District law held that plaintiff's proposed unfair competition claim not preempted. Plaintiff developer of "virtual and online training courses" had entered into license agreement with defendant provider of "professional development training," granting defendant access to certain of its course materials. After defendant terminated license, defendant began offering its own courses, which plaintiff alleged were copied from its licensed materials, and plaintiff sued for infringement and various state law claims. Defendant opposed plaintiff's motion to amend pleadings to include New Hampshire unfair competition claim, on basis that claim was preempted. District court concluded that state law claim included additional elements other than unauthorized reproduction or similar conduct prohibited by Act. Specifically, plaintiff alleged that defendant entered into and remained in license agreement by using "unfair and or deceptive practices to maintain access to the copyrighted material." Since this claim included additional elements beyond those of infringement claim, motion to amend complaint to add unfair competition claim granted.

*Emmerich Newspapers, Inc. v. Particle Media, Inc.*, No. 21-32, 2022 U.S.  
Dist. LEXIS 49376 (S.D. Miss. Mar. 21, 2022)

District court held that plaintiff's claims preempted. Plaintiff sued defendant, developer of "NewsBreak" news aggregation web application, alleging that defendant republished its news stories and articles through NewsBreak application. Defendant moved to dismiss Mississippi state law claims, arguing that they were preempted. On tortious interference with business relationships claim, district court found that plaintiff's allegations that NewsBreak app "poach[ed] readers" and "syphon[ed] ad revenues" arose from defendant's unauthorized reproduction of plaintiff's works, and that claim was thus preempted. On unjust enrichment claim, district court found that only "property" defendant conceivably obtained unjustly is "money derived from unauthorized distribution" of copyrightable works, and that claim was thus preempted. On civil conspiracy claim, district court found that only "indecently tortious or wrongful action" plaintiff could assert against defendant was infringement; claim was therefore preempted. District court also dismissed prayer for punitive damages, because such claim could only rely on state law claims, all of which were dismissed.

*Control Tech. & Sols., LLC v. Omni Energy Partners, LLC*, No. 21-686, 2021 U.S. Dist. LEXIS 243084 (E.D. Mo. Dec. 21, 2021)

District court held that record insufficiently developed to determine whether plaintiff's claims preempted. Plaintiff, "company that provides ... solutions ... and system integration to help reduce energy and operational cost for its clients," sued former sales representative, who left to start competing company, for claims including tortious interference, trade secret violations and unfair competition. On motion to dismiss, defendants argued that all of plaintiff's claims were preempted. On tortious interference claim, district court found that claim alleging defendants' disparaging and false statements "is grounded in allegations beyond mere copying" and thus not preempted. On unfair competition claim, district court found that tort's "emphasis on deception and protection of the *public*" (emphasis in original) drastically differs from "purpose of protecting author's original works" of copyright claim, and found this claim not preempted. On claim for breach of duty of loyalty, district court found that claim involved several "extra elements" beyond copyright infringement, rendering claim "qualitatively different" from copyright claim, and found no preemption. On plaintiff's request for injunctive relief, district court found request for relief "based on several bases – ones that the Copyright Act does not preempt," and held this request not preempted. District court did not reach preemption question on trade secret misappropriation and unjust enrichment claims, finding record not sufficiently developed at motion to dismiss phase to determine as a matter of law whether all of such claims preempted.

*Sessa v. Ancestry.com Operations Inc.*, No. 20-2292, 2021 U.S. Dist. LEXIS 177337 (D. Nev. Sept. 16, 2021)

Court denied motion to dismiss in pertinent part because plaintiffs' claims not preempted. Case arose from defendant's alleged use of plaintiffs' names, images, and likenesses to market paid subscriptions to defendant's database of school yearbooks. To build database, defendant allegedly extracted personal information, such as names, photographs, and cities of residence, from school yearbooks and aggregated it into digital records to identify specific individuals. Defendant moved to dismiss, arguing that plaintiffs' right of publicity claim was preempted because it sought to remedy display of plaintiffs' photographs on defendant's database. Court found that defendant need not own copyright at issue for preemption to apply and instead issue was whether publicity-right claim is about misuse of individual's likeness or if it seeks to interfere with copyrighted work. Because plaintiffs' claims concerned defendant's use of plaintiffs' likenesses, not merely their publication of plaintiffs' photographs, claim was not preempted by Act.

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

*Can. Hockey, L.L.C. v. Marquardt*, No. 20-20530, 2022 U.S. App. LEXIS 2371 (5th Cir. Jan. 26, 2022)

Fifth Circuit dismissed defendant's interlocutory appeal of denial of summary judgment for lack of jurisdiction. Plaintiff sportswriter and publishing company owner hired writer to

create book titled *12th Man*, regarding athlete E. King Gill at Texas A&M University (TAMU), who suited up at halftime during 1922 game due to concern that injured TAMU team would run out of reserve players. Plaintiff interviewed defendant – associate director of media relations at TAMU – regarding Gill and later sent defendant draft copy of book. Defendant copied selected portions of draft from plaintiff and removed references to plaintiff, to create article for university fundraising purposes. After TAMU posted article online, plaintiff asserted direct and contributory claims of infringement under Copyright Remedy Clarification Act (CRCA) and claim under DMCA, alleging defendant removed CMI from biography of Gill. District court denied both parties’ motions for summary judgment due to genuine issues of material fact and rejected defendant’s qualified immunity defense to infringement claims. On appeal, defendant claimed he was entitled to qualified immunity in response to plaintiff’s DMCA claim, because statutory right was not “clearly established” at time of claimed violation. However, defendant had already made qualified immunity defense in prior motion to dismiss, but district court rejected it, and defendant did not appeal such ruling, or even include defense in his summary judgment motion. Fifth Circuit therefore held that defendant lost his right to challenge denial of qualified immunity against DMCA claim. Court accordingly dismissed DMCA-related portion of appeal for lack of jurisdiction.

*Sadowski v. Ng*, No. 18-10113, 2022 U.S. Dist. LEXIS 46315 (S.D.N.Y. Mar. 15, 2022)

District court granted summary judgment to defendants on plaintiff’s DMCA claim. Plaintiff, professional photographer, took photos that appeared in *New York Post* online, with plaintiff credited. Plaintiff registered copyrights in photos. Photos then appeared in connection with translation of *New York Post* article on Korean and Chinese news websites, KoreanNLH and NYChaoBao, without credit to plaintiff. Plaintiff brought suit against Admerasia, owner of KoreanNLH and NYChaoBao domains, and Ng, President and CEO of Admerasia for copyright infringement and falsification, removal or alteration of CMI under DMCA. After discovery, plaintiff moved for partial summary judgment, arguing that defendants were contributorily and vicariously liable for infringing activity. Defendants opposed plaintiff’s motions and cross-moved for summary judgment. On question of Admerasia’s direct liability, district court denied plaintiff summary judgment because there was question of material fact as to whether Admerasia owned domains and whether Admerasia, if involved, acted with necessary volition. However, court granted defendants’ summary judgment motion on issue of Ng’s direct liability because plaintiff did not show any evidence for its conclusory allegations. Court also denied plaintiff’s motion for summary judgment and granted defendant’s motion on question of contributory and secondary liability because plaintiff improperly raised theories for first time in motion for summary judgment without any evidence. Defendants’ motion for summary judgment was granted on plaintiff’s DMCA claim that defendants intentionally removed CMI because no reasonable juror could find that defendants acted with requisite intent.

*Bus. Casual Holdings, LLC v. TV-Novosti*, No. 21-2007, 2022 U.S. Dist. LEXIS 45283 (S.D.N.Y. Mar. 14, 2022)

District court granted defendant's motion to dismiss plaintiff's DMCA claim without prejudice. Plaintiff Business Casual Holdings created original documentary content, including videos that turn two-dimensional images into three-dimensional models through "parallax" process, which "requires myriad creative choices." Plaintiff posted videos, including videos entitled "How Rockefeller Built His Trillion Dollar Oil Empire" and another entitled "J.P. Morgan Documentary: How One Man Financed America," on its YouTube channel. Defendant, Russian non-profit organization, posted several videos on its YouTube channel that included excerpts of plaintiff's videos. Defendant allegedly doctored plaintiff's clips slightly, including replacing watermark, to circumvent YouTube's automatic safeguards. Plaintiff filed DMCA takedowns to remove videos from YouTube, and, in response, defendant filed DMCA counter notifications. To prevent videos from being reinstated, plaintiff filed lawsuit claiming violation of DMCA. Defendant filed motion to dismiss, arguing that plaintiff's claim was premature given that YouTube had not yet reinstated defendant's videos. Court agreed, finding that DMCA statute applied only when misrepresentation in counter notification successfully caused service provider to reinstate allegedly infringing material. Accordingly, defendant's motion to dismiss DMCA claim was granted. However, court invited both parties to amend pleadings to develop factual and legal record of whether there were remedies for filing unsuccessful bad-faith counter notifications.

*White v. UMG Recordings, Inc.*, No. 20-9971, 2021 U.S. Dist. LEXIS 243464 (S.D.N.Y. Dec. 21, 2021)

District court granted defendant's motion to dismiss plaintiff's DMCA claim. Plaintiff filed claims under DMCA alleging that defendants knowingly submitted improper takedown notices related to plaintiff's music. Plaintiff purchased rights to Beat, musical instrumental arrangement from defendant Jenks. Plaintiff incorporated Beat into new song called *Oi!*, which Plaintiff released on multiple platforms. Plaintiff allowed *Oi!* to be published on SoundCloud page of founding member of A\$AP MOB. Defendant Carter, who also belongs to A\$AP MOB, released song *Right Now*, which also incorporated Beat, which was provided by defendant Jenks. Plaintiff posted video to Twitter performing *Oi!* and alleged that one or all of defendants served takedown notices, and Twitter removed plaintiff's content. Plaintiff tried to repost videos two more times, but each attempt was taken down. Plaintiff also provided counter-notice to Twitter contesting takedowns, but Twitter refused to allow *Oi!* related content on its platform. Defendants Jenks and Carter filed motions to dismiss for failure to state claim. Defendant Jenks argued that plaintiff's allegations were insufficient because plaintiff failed to specify which defendant filed takedown, but court found plaintiff's statements were acceptably pleaded in alternative. Because plaintiff alleged, with sufficient allegations at pleadings stage, that Jenks filed takedowns, defendant Jenks's motion to dismiss was denied. However, court granted defendant Carter's motion to dismiss because plaintiff failed to sufficiently allege that defendant Carter knew plaintiff's Twitter posts were not infringing.

*Trombetta v. Novocin*, No. 18-993, 2021 U.S. Dist. LEXIS 244587 (S.D.N.Y. Dec. 21, 2021)

District court denied motion to dismiss plaintiff's DMCA claims. Defendant Worthpoint.com provided users with historical pricing data from artwork auctions and retail sales. Defendants Marie and Norb Novocin were operators of defendant Estate Auctions Inc. (EAI), which sold art and other collectibles on eBay. Plaintiff sued for infringement after discovering that worthpoint.com contained eBay listing of "shabby chic" painting that stated painting was painted by plaintiff and had sold on eBay for \$181.50. Plaintiff protested to Worthpoint and claimed she was not painter of work at issue. After dismissing contributory infringement claims against Worthpoint, district court reviewed DMCA claims against Worthpoint. Plaintiff alleged under § 1202(a) of DMCA that Worthpoint included false CMI by falsely attributing painting at issue to plaintiff, and falsely claiming her biography was licensed by Worthpoint. District court found that such allegations established claim, and plaintiff's prior protestations to defendant established scienter, especially in light of her *pro se* status. Plaintiff also alleged distribution of works with missing or altered CMI under §1203(b)(3). Complaint clearly alleged that CMI regarding plaintiff's biography existed on her website, and that Worthpoint distributed biography without CMI. District court thus held that plaintiff properly alleged DMCA claims.

*Tabak v. LifeDaily, LLC*, No. 21-4291, 2021 U.S. Dist. LEXIS 217755 (S.D.N.Y. Nov. 9, 2021)

District court denied default judgment on copyright infringement claim. Plaintiff professional photographer photographed Verran Madhavan, then registered two photographs with U.S. Copyright Office and licensed them to online media source that published them with "gutter credit" identifying plaintiff as creator. Later, defendant ran article on its website featuring photographs, without licensing same from plaintiff, and removed gutter credit. Plaintiff sufficiently alleged that defendant published photographs without gutter credit (i.e., copyright management information) that was featured in initially published works and that plaintiff knew that he did not grant authority to defendant to remove CMI, from which it could be inferred that defendant knew it did not have plaintiff's approval to do so. However, plaintiff failed to provide sufficient factual allegations that defendant knew that distribution without CMI would conceal infringement.

*Paul Rudolph Found. v. Paul Rudolph Heritage Found.*, No. 20-8180, 2021 U.S. Dist. LEXIS 188648 (S.D.N.Y. Sept. 30, 2021)

District court found case in controversy to exist for claims seeking declaration that photographs were in public domain and not owned by defendant, who brought DMCA notices against plaintiff over photographs and threatened litigation when plaintiff filed counternotices. Famed brutalist architect Paul Rudolph left photographs of works to Library of Congress, with will stating that he "dedicates" copyrights in those works to public. Plaintiff foundation for decedent understood works to be in public domain and used photographs. Defendant, rival foundation for decedent, filed copyright registrations for those

works. Defendant filed 36 DMCA takedown notices with Facebook and Instagram against plaintiff based on publication of images, causing plaintiff's Facebook account to be temporarily suspended. Plaintiff then filed complaint with Facebook accusing defendant of violating DMCA, and defendant threatened lawsuit. Plaintiff sought declaratory judgment that works were in public domain, could be used by plaintiff, and could not be copyrighted by defendant. Defendant moved to dismiss claims as non-justiciable in that there was no case in controversy. Court ruled that because defendant viably threatened litigation after filing DMCA notices, there was case in controversy justifying court deciding these claims under Declaratory Judgment Act. Plaintiff's DMCA claim based on notices being filed in bad faith was similarly not dismissed.

*Berry Hill Dev. Corp. v. Scott*, No. 20-1874, 2021 U.S. Dist. LEXIS 165494 (E.D.N.Y. Aug. 31, 2021)

Magistrate judge recommended denial of defendants' motion to dismiss plaintiff's DMCA claims based on removal of copyright management information. Plaintiff, high end residential property designer and builder, contracted with architect to create architectural plans for defendants Billy and Alexa Joel via their LLC, defendant F. Scott. Plaintiff's plans for main house were provided to defendants before being filed with building department, and plaintiff subsequently provided defendants with plans for garage. Defendants' replacement architect Neil-James Stufano requested and received full copies of plaintiff's on-file main house plans. Plaintiff sued Joels, F. Scott and Stufano for, *inter alia*, removal or alteration of copyright management information under DMCA, alleging that Stufano copied both main house and garage plans, created unauthorized derivative works, removed plaintiff's architect's name and instead inserted his own name, before filing Stufano's plans with building department. Defendants moved to dismiss CMI removal claim. Magistrate held that plaintiff sufficiently alleged existence of CMI and intentional removal or alteration of such CMI, such that dismissal of plaintiff's claim was unwarranted.

*Penske Media Corp. v. Shutterstock, Inc.*, 548 F. Supp. 3d 370 (S.D.N.Y. 2021)

District court denied motion to dismiss. Plaintiff, owner of archive of photographs taken for its magazines, including *Women's Wear Daily*, *Variety*, *Deadline Hollywood*, and *Rolling Stone*, filed complaint against defendant Shutterstock, licensing organization, for infringement and violation of DMCA after defendant failed to remove nearly 2,300 photographs from its website after it terminated parties' licensing agreement. Defendant moved to dismiss plaintiff's amended complaint. Plaintiff based DMCA claim on alleged falsification of CMI, pointing to fact that defendant kept infringing photos on its website, with watermarks of defendant's name, without explaining that plaintiff owned copyright. Court found plaintiff plausibly pleaded that defendant acted with knowledge and intent in placing watermarks on works to conceal copyright infringement and further found issue was appropriate for trier of fact.

*Wood v. Observer Holdings, LLC*, No. 20-7878, 2021 U.S. Dist. LEXIS 127484 (S.D.N.Y. July 8, 2021)

District court denied motion to dismiss DMCA claims. Plaintiff professional photographer brought claims for infringement and for violations of DMCA against defendants Observer Holdings LLC and The New York Observer, LLC, as well as various other entities involved in operation and publication of digital media publication *Observer*. In 2016, plaintiff was engaged by Compass, licensed real estate, to create photographs of estate in East Hampton, New York. Plaintiff agreed to license photographs to Compass for purpose of marketing house to potential buyers. Before providing Compass with copies of photographs, plaintiff embedded her CMI in photographs' metadata, which included copyright notice. Compass subsequently displayed photos on its website. In 2017, estate was sold to celebrity couple Beyonce Knowles-Carter and Jay-Z. Following purchase, defendants used plaintiff's photos of estate in article titled "Peek Inside Beyonce and Jay-Z's Palatial New Georgica Pond Abode" and credited "Compass" under each of photos. Plaintiff claimed that defendants violated §§ 1202(a) and 1202(c) of DMCA by featuring false CMI in photographs and terms of use on defendants' website, and by altering CMI in metadata of photographs. Regarding 1202(a) claim, court found that plaintiff adequately alleged that defendant's credit line attribution to Compass below photographs constitutes CMI and because Compass is neither author, nor copyright owner, defendants' CMI is false. Court did not find boilerplate website terms, which are accessed through webpage on separate website, nor copyright notice, to constitute CMI. Regarding 1202(b) claim, court found that plaintiff sufficiently alleged that information in metadata in photographs listing plaintiff as creator and providing copyright notice to plaintiff's entity was source of CMI, and that reasonable person could find that defendant's addition of "Compass" credit line altered pre-existing CMI in metadata identifying plaintiff as author and copyright holder. Court held that, although allegations did not show actual knowledge of falsity, such facts do not need to be alleged, where inference could be made, such that whether defendants acted with requisite scienter could be proven at later stage.

*Greenspan v. Qazi*, No. 20-3426, 2021 U.S. Dist. LEXIS 117332 (N.D. Cal. June 23, 2021)

District court granted motion to dismiss, finding that defendant did not allege valid DMCA claims. *Pro se* plaintiff, Tesla short seller and entrepreneur, posted negative allegations about Tesla and Elon Musk on plaintiff's website. Defendant Qazi, Tesla enthusiast and shareholder, began criticizing plaintiff online for his attacks against Tesla and Musk. Defendant Musk also criticized plaintiff and referred to him online as "ten cards short of a full deck," among other alleged taunts. Plaintiff sued certain defendants for defamation, copyright infringement, and DMCA violations, claiming in part that non-Tesla defendants had copied and published portions of plaintiff's autobiography, removed CMI from photo of plaintiff, and had made misrepresentations in DMCA notices and counter-notices. In reviewing motion to dismiss, court concluded that plaintiff had not alleged that defendants knew or had reasonable grounds to know that posting photo of plaintiff without CMI would induce, enable, facilitate or conceal copyright infringement. Furthermore, plaintiff did not

plausibly state that defendant knowingly made incorrect statements in DMCA notices and counter notices against plaintiff. For instance, defendant had claimed in DMCA counter notice that defendant’s copying of portions of plaintiff’s autobiography was protected under fair use doctrine. District court found that this was not unreasonable claim, and no inference of deception was warranted. District court accordingly dismissed DMCA claims without prejudice.

*Harrington v. Pinterest, Inc.*, No. 20-5290, 2021 U.S. Dist. LEXIS 167983  
(N.D. Cal. Sept. 3, 2021)

District court dismissed plaintiff’s DMCA claim, with leave to amend. Plaintiff was professional travel photographer, and for each of his works he added “EXIF/IPTC” metadata including copyright notice, credit line source, contact information and use terms. Plaintiff also assigned each of his works JPEG file name containing unique identifying information. Plaintiff sued Pinterest, alleging Pinterest “deliberately removes indicia of copyright ownership” from images submitted to its site, including renaming of images with new JPEG name and stripping EXIF/IPTC from images. Plaintiff alleged such changing of file name and metadata constituted removal of CMI in violation of DMCA. On motion to dismiss, Pinterest assumed truth of allegations of removal of CMI, but argued DMCA claim should be dismissed because plaintiff failed to allege that Pinterest knew or had reasonable grounds to know that removal of CMI would “induce, enable, facilitate, or conceal an infringement.” District court found that plaintiff failed to allege Pinterest had actual or constructive knowledge that removal of CMI “will aid” infringement, and that plaintiff’s “vague and conclusory allegations” that Pinterest is aware of “rampant” infringement on its platform were insufficient.

*Nintendo of Am. Inc. v. Storman*, No. 19-7818, 2021 U.S. Dist. LEXIS 148119  
(C.D. Cal. Aug. 5, 2021)

District court granted summary judgment for plaintiff on direct and contributory copyright infringement claims, finding no DMCA protection for defendant who hosted copies of plaintiff’s games. Plaintiff Nintendo sued owner of [www.romuniverse.com](http://www.romuniverse.com), site that hosted read-only memory (“ROM”) files of Nintendo games for download by users, and sold subscriptions to users for increased downloading ability. Without mentioning DMCA, *pro se* defendant claimed website had “service provider status,” claiming that immunized him. Court found no DMCA protection when defendant provided no evidence that ROMs were uploaded by users other than him, and defendant complied with no other requirements of DMCA.

*Moonbug Entm’t Ltd. v. Babybus (Fujian) Network Tech. Co.*, No. 21-6536,  
2022 U.S. Dist. LEXIS 33613 (N.D. Cal. Feb. 25, 2022)

District court granted plaintiff’s motion to dismiss defendant’s § 512(f) DMCA counterclaim. Plaintiff operated CoComelon kids’ channel on YouTube, featuring child character JJ and his family. Plaintiff owned copyrights in 3-D characters, as well as videos, songs, and images. Defendant operated competitor channels featuring character named Super

Jojo and his family. Plaintiff alleged that defendant's videos infringed its works. Plaintiff filed takedown requests and infringement action concerning at least 70 videos. Plaintiff moved to dismiss defendant's DMCA counterclaim under § 512(f), in which it argued that plaintiff knowingly misrepresented its works when making its takedown request to YouTube. Court found defendant failed to plausibly allege that plaintiff made material misrepresentations or that it submitted takedowns in bad faith. On material misrepresentation point, court found defendant's allegations undercut by detailed 17-page letter with exhibits plaintiff sent to YouTube along with takedown request. Court further found takedown request to comply with § 512, which allows claimant to provide "representative list" of infringed works. On subjective bad faith element, court found defendant failed to support such allegations with plausible facts. Additionally, even if court were to accept as true allegation that plaintiff wanted to exploit YouTube's "copyright strikes" policy so that it would disable defendant's non-infringing channels, such allegation might show bad-faith motive, but it did not show knowing misrepresentation.

*Incredible Features v. Backchina*, No. 20-943, 2021 U.S. Dist. LEXIS 250121 (C.D. Cal. Dec. 16, 2021)

Court granted in part and denied in part motion for summary judgment. Individual plaintiffs, Jeffrey Werner and Brian Wolff, were photographers and entity plaintiff Incredible Features was licensor for works at issue. Defendant operated Chinese-language website and published plaintiffs' works without authorization on site. Publication of works on defendants' sites was accomplished by link so that works were not located on defendant's servers. Plaintiff moved for summary judgment on infringement claim and defendant's affirmative defenses, including safe harbor under § 512(d). On defendant's § 512(d) defense, court highlighted fact that defendant caused images to be shown on its site and did not just direct users to third-party site with images. It further noted that it had right and ability to control its employees who published infringing works, and that it received benefit from infringing works by means of paid advertisements. Court therefore found defendant was not entitled to defense and granted summary judgment for plaintiff on liability and on defendant's affirmative defense.

*Kipp Flores Architects, LLC v. Pradera SFR, LLC*, No. 21-673, 2022 U.S. Dist. LEXIS 68040 (W.D. Tex. Apr. 13, 2022)

District court granted motion to dismiss DMCA claim brought by architect. Architectural firm brought DMCA claim against developers and architect of residential project, where developers initially obtained designs from plaintiff before showing designs to defendant architect and asking defendant architect to make similar designs. Plaintiff alleged that original plans had CMI, and defendants improperly failed to add that CMI to floorplans and 3-D renderings based on plans. Court held that DMCA only creates liability for removal of CMI from work where it was once present. Because plaintiff instead alleged that defendants failed to add CMI where it never existed, this did not constitute removal under DMCA, and claim failed.

*Alper Auto., Inc. v. Day to Day Imps., Inc.*, No. 18-81753, 2021 U.S. Dist. LEXIS 212715 (S.D. Fla. Nov. 2, 2021)

District court found defendant violated DMCA by filing repeated notices to Amazon to take down same listing despite Amazon's repeated reinstatement of listing. Prior to case, plaintiff, seller of stickers for use on car dashboards, accused defendant of infringing its copyright on sticker artwork. Dispute was resolved by defendant licensing work. Defendant, misunderstanding nature of copyrighted design it was licensing, believed that stickers later sold by plaintiff on Amazon infringed defendant's design, and filed series of DMCA takedown notices with Amazon, resulting in plaintiff's listing being taken down for brief periods. Plaintiff filed suit alleging that defendant knowingly misrepresented to Amazon that plaintiff was infringing defendant's copyright. Court found that though defendant's first several takedowns were filed with good faith belief that plaintiff was infringing, communications with plaintiff as result of those notices, and Amazon's repeated reinstatement of listing, should have caused defendant to realize listing was not infringing. Defendant's later DMCA notice for same listing was therefore result of willful blindness, despite defendant's subjective belief that listing was infringing. Court determined defendant's motivation to be that repeated DMCA notices were cheaper option than filing infringement litigation to test defendant's position. This use of DMCA as sword to suppress market competitor instead of shield to protect intellectual property was violation of § 512(f) of DMCA. Court awarded lost profits from time listing was down and costs of plaintiff's time spent trying to reactivate listing instead of performing other work.

*Design Basics, LLC v. Mitch Harris Bldg. Co.*, No. 16-14109, 2021 U.S. Dist. LEXIS 227529 (E.D. Mich. Nov. 29, 2021)

Court granted in part and denied in part defendant's motion for summary judgment. Plaintiff created, published, and licensed architectural plans, and alleged that defendants infringed two architectural plans, and that their display and marketing of infringing plans also violated DMCA. Defendants moved for summary judgment. Court found question of fact related to substantial similarity as to protectable elements in plaintiffs' plans, determined that substantial similarity would best be resolved by trier of fact, and accordingly denied summary judgment on infringement claim. As to DMCA claim, court found that plaintiff's allegations amounted to defendants removing and/or omitting CMI from infringements of plaintiff's work and not that defendants removed and/or omitted CMI from plaintiff's original works, as statute required. Court granted defendants' motion for summary judgment on DMCA claim.

*Gareaux v. Aronik LLC*, No. 21-529, 2021 U.S. Dist. LEXIS 225963 (D. Utah Nov. 22, 2021)

Court denied defendant's motion to dismiss claim that defendant removed copyright management information. Plaintiff Glenn Gareaux captured photograph "Luz Del Sol" and granted permission to Austin Smith to post photograph to Smith's Instagram page. In caption to Instagram post, Smith included camera emoji and link to Instagram page

“@anthonygareaux,” signifying that this was link to photographer’s Instagram account. One day later, without Gareaux’s permission or license, defendant posted photograph to his own Facebook and Instagram accounts, identifying Smith, but not Gareaux, in posts. Defendant argued that indication by third party as to identity of photographer cannot be CMI, and, further, that there was no copyright notice or other indication that photograph was copyrighted, and, instead, link resolved to Instagram page, which lacked such information. Defendant also argued that complaint identified plaintiff as Glenn Gareaux, plaintiff’s legal name, instead of Anthony Gareaux, which was used in Instagram account. Court agreed that allowing plaintiff to make out DMCA claim based on alleged CMI that does not link up in any way to copyrighted work would amount to invitation to unfair litigation. However, court found that photo credit in Smith’s post, which linked to Gareaux’s Instagram account, could arguably be sufficient to inform public that photo was copyrighted. Given that defendant failed to provide any binding or fully apposite case law, court relied on statutory language, which states that CMI may include “other information about author of work” and is not necessarily limited to owner’s full legal name. Accordingly, court found that Gareaux had plausibly alleged that post included CMI and found factual allegations were sufficient to defeat motion to dismiss.

*Brittney Gobble Photography, LLC v. Sinclair Broad. Grp.*, No. 18-3403,  
2021 U.S. Dist. LEXIS 222009 (D. Md. Nov. 17, 2021)

District court granted defendants’ motion for summary judgment on DMCA claim. Plaintiff, photographer, sued defendants for infringement and DMCA violation based on unauthorized use of images. Parties cross-moved for summary judgment on infringement and DMCA claims. On DMCA claim, plaintiff argued defendants violated DMCA because they falsified and distributed CMI attached to photographs by changing file names and credit information. Court granted defendants’ motion for summary judgment because there was no evidence that defendants were intentionally trying to conceal infringement and no evidence that they knew or had reasonable grounds to know such distribution would induce, enable, facilitate, or conceal infringement.

## **X. VISUAL ARTISTS RIGHTS ACT**

*Lew v. City of Los Angeles*, No. 20-10948, 2022 U.S. Dist. LEXIS 3196 (C.D.  
Cal. Jan. 6, 2022)

District court denied motion to dismiss plaintiff’s VARA claim. Plaintiff artist and muralist “Shark Toof” created art exhibition entitled “Don’t Believe the Hype: LA Asian Americans in Hip Hop,” consisting of “art creations” displayed on “canvas bags, which were to be hung outside” grounds of defendant Chinese American Museum of Los Angeles. Plaintiff sued for claims including violation of VARA, alleging that defendant “removed and unlawfully trashed the art without giving prior notice.” On motion to dismiss VARA claim, defendant alleged plaintiff’s works were not “works of visual art” under Act on basis that works fell into categories of works excluded under Act, namely: applied art, merchandising items and/or promotional materials. In analyzing whether works were “applied art,” district court

looked to Ninth Circuit precedent to evaluate whether object was “utilitarian” or “purely aesthetic” to degree that object’s formerly utilitarian function ceases. District court rejected defendant’s argument that works were utilitarian “tote bags,” and agreed with plaintiff that works were created using “canvases with handles” and that canvas bags were merely artist’s chosen medium, which “never served any utilitarian function as an actual tote bag.” District court similarly rejected defendant’s argument that works were merchandising or promotional items, which defendant based on fact that certain items were later to be sold through museum’s gift shop. Finding that agreement to sell works through gift shop did not transform works into “merchandising items” or “promotional materials,” motion to dismiss VARA claim denied.

*Lew v. City of Los Angeles*, No. 20-10948, 2021 U.S. Dist. LEXIS 166223 (C.D. Cal. Aug. 31, 2021)

District court granted defendants’ motion to dismiss plaintiff’s VARA claim but invited plaintiff to amend complaint. Plaintiff visual artist Shark Toof created art installation consisting of 88 hanging red tote bags featuring plaintiff’s art prints for exhibition at defendant Chinese American Museum of Los Angeles. Defendants removed and trashed plaintiff’s art without prior notice. Plaintiff sued defendants for VARA violation. Defendants moved to dismiss, arguing that plaintiff’s works were excluded from VARA as merchandising items and/or utilitarian applied art. Court held that, though plaintiff’s art works were subsequently to be sold through Museum’s gift shop, this did not automatically render them merchandising items. However, complaint, despite including photographs depicting plaintiff’s artwork, failed to sufficiently allege that tote bags were used as canvases and that they therefore never served, or at least ceased to serve, any utilitarian purpose. Because it was unclear from pleaded facts whether tote bags in fact continued to serve real utilitarian function, court granted defendants’ motion to dismiss but invited plaintiff to amend complaint in order to clarify substance of allegations.

*Estate of Martino v. Fountain Christian Bilingual Sch. Carolina, Inc.*, No. 18-1509, 2022 U.S. Dist. LEXIS 24843 (D.P.R. Feb. 10, 2022)

Court dismissed plaintiff’s VARA claim with prejudice and copyright claim without prejudice. Plaintiffs alleged that defendants mutilated and destroyed mural *Rio Grande de Loiza* by artist Torres-Martino. Court previously dismissed VARA claim because VARA does not apply to site-specific art such as murals. Plaintiffs moved for reconsideration arguing that evidentiary hearing was needed to determine if this was site-specific art. Plaintiff raised no new changes in law, nor newly discovered evidence, nor did it seek to correct manifest error of law. Further, mural at issue is site-specific artwork because it was created for school named after Poet Julia de Burgos and included references to her poem *Rio Grande de Loiza*. Additionally, it was part of school building which had cultural and educational significance for students and as such, site in question was integral element of mural. Court also ordered plaintiff to show cause as to why infringement claim should not be dismissed. In response plaintiff filed motion, claiming that it retained copyright in mural and it had not entered public domain because it was not yet published. Court noted

publication was irrelevant as plaintiffs failed to obtain copyright registration for mural from either Intellectual Property Registry in State Department of Puerto Rico or U.S. Copyright Office, which precluded copyright claim. Accordingly, court dismissed infringement claim without prejudice.

*Fields v. Baseline Props., LLC*, No. 19-864, 2021 U.S. Dist. LEXIS 117158  
(W.D. Okla. June 23, 2021)

District court denied defendants' motion for summary judgment because plaintiff's waiver of VARA rights was not in defendants' favor. Plaintiff, recognized muralist, painted mural on side of building. As part of city's permitting and approval process, plaintiff executed general VARA waiver in which he acknowledged that mural may be destroyed by weather or other necessity, which would require mural's removal from building. Defendants subsequently purchased building and then authorized mural to be painted over. Plaintiff sued defendants for statutory damages under VARA, and defendants moved for summary judgment arguing that plaintiff waived VARA rights by signing city waiver and that mural was subject to VARA's building exception. Court held that plaintiff waived his VARA rights exclusively in favor of city and, because waiver did not reference building owners, his waiver cannot be construed to extend to them. Further, though mural was not removable from building without destruction, distortion, mutilation, or other modification, VARA's building exception did not apply because plaintiff and building owner did not enter into written agreement in which plaintiff consented to installation subject to possible destruction, and plaintiff's city waiver did not extend to building owners.



**Cowan, Liebowitz & Latman Attorneys**

<b>Daniel Basov</b>	(212) 790-9278	<i>dyb@cll.com</i>
<b>Jeremy A. Berman</b>	(212) 790-9293	<i>jab@cll.com</i>
<b>William M. Borchard</b>	(212) 790-9290	<i>wmb@cll.com</i>
<b>Jeffrey Chery</b>	(212) 790-9263	<i>jyc@cll.com</i>
<b>Dasha Chestukhin</b>	(212) 790-9251	<i>dxs@cll.com</i>
<b>Richard Dannay</b>	(212) 790-9256	<i>rxs@cll.com</i>
<b>Mary A. Donovan</b>	(212) 790-9277	<i>mad@cll.com</i>
<b>Kieran G. Doyle</b>	(212) 790-9261	<i>kgd@cll.com</i>
<b>Robert J. English</b>	(212) 790-9215	<i>rje@cll.com</i>
<b>C.J. Erickson</b>	(212) 790-9274	<i>cje@cll.com</i>
<b>Lynn S. Fruchter</b>	(212) 790-9207	<i>lsf@cll.com</i>
<b>Allison R. Furnari</b>	(212) 790-9209	<i>arf@cll.com</i>
<b>Simon Gerson</b>	(212) 790-9206	<i>sxs@cll.com</i>
<b>Robert J. Giordanella</b>	(212) 790-9234	<i>rjg@cll.com</i>
<b>Kyle-Beth Hilfer</b>	(212) 790-9200	<i>kbh@cll.com</i>
<b>J. Christopher Jensen</b>	(212) 790-9204	<i>jcj@cll.com</i>
<b>Justin I. Karasick</b>	(212) 790-9272	<i>jik@cll.com</i>
<b>Mary L. Kevlin</b>	(212) 790-9216	<i>mlk@cll.com</i>
<b>Jonathan Z. King</b>	(212) 790-9238	<i>jzk@cll.com</i>
<b>Thomas Kjellberg</b>	(212) 790-9202	<i>txk@cll.com</i>
<b>Sarah Sue Landau</b>	(212) 790-9246	<i>ssl@cll.com</i>
<b>Maryann Licciardi</b>	(212) 790-9218	<i>mel@cll.com</i>
<b>Meichelle R. MacGregor</b>	(212) 790-9259	<i>mrn@cll.com</i>
<b>Richard S. Mandel</b>	(212) 790-9221	<i>rsm@cll.com</i>
<b>Brian Matross</b>	(212) 790-9231	<i>bsn@cll.com</i>
<b>Joelle A. Milov</b>	(212) 790-9247	<i>jam@cll.com</i>
<b>Mark Montague</b>	(212) 790-9252	<i>mxn@cll.com</i>
<b>Raphael Nemes</b>	(212) 790-9248	<i>rxn@cll.com</i>
<b>Reema Pangarkar</b>	(212) 790-9229	<i>rxp@cll.com</i>
<b>Joel K. Schmidt</b>	(212) 790-9244	<i>jks@cll.com</i>
<b>Eric J. Shimanoff</b>	(212) 790-9226	<i>ejs@cll.com</i>
<b>Adam D. Siegartel</b>	(212) 790-9224	<i>ads@cll.com</i>
<b>Deborah K. Squiers</b>	(212) 790-9211	<i>dks@cll.com</i>
<b>Emily F. Stein</b>	(212) 790-9271	<i>efs@cll.com</i>
<b>John J. Torrente</b>	(212) 790-9273	<i>jjt@cll.com</i>
<b>Brian R. Volk</b>	(212) 790-9282	<i>brv@cll.com</i>
<b>Lyndsey Waddington</b>	(212) 790-9214	<i>lxw@cll.com</i>
<b>Dorothy R. Whitney</b>	(212) 790-9212	<i>drw@cll.com</i>
<b>Fei Xing</b>	(212) 790-9254	<i>fxx@cll.com</i>
<b>Anastasia Zhadina</b>	(212) 790-9286	<i>axz@cll.com</i>