
Cowan, Liebowitz & Latman

**Copyright Review
2021**

*“Recent Developments In Copyright”
Selected Annotated Cases*

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I. JURISDICTION AND PROCEDURAL ISSUES

A. Subject Matter Jurisdiction

Superama Corp., Inc. v. Tokyo Broad. Sys. TV, 830 F. App'x 821 (9th Cir. 2020)

Ninth Circuit affirmed dismissal of infringement claim for lack of subject matter jurisdiction. Superama, organizer of U.S. Sumo Open, discovered that defendant Tokyo Broadcasting System TV downloaded its copyrighted material off of YouTube, altered it, and rebroadcast it throughout Japan without obtaining license. Plaintiff sued for copyright infringement in Central District of California. District court dismissed suit due to lack of subject matter jurisdiction, citing *Subafilms* for proposition that U.S. copyrights laws do not have extraterritorial effect, and therefore, infringing actions that take place entirely outside U.S. are not actionable. On appeal Superama advanced “highly technical argument” that infringement occurred in U.S., and court had subject matter jurisdiction, because exact copy of footage was made on YouTube’s server before it was downloaded in Japan. Ninth Circuit found no relevant precedent established rule that infringement occurs when download abroad automatically creates copy of material on U.S. server, and no basis for finding jurisdiction where downloaded material is stored in U.S., but all infringing activity takes place in another country. District court’s dismissal of complaint for lack of subject matter jurisdiction was therefore proper.

Schwartz v. Paramount Pictures Corp., No. 20-11470, 2021 U.S. Dist. LEXIS 37650 (C.D. Cal. Feb. 26, 2021)

District court denied motion by estate of Truman Capote to remand to state court case regarding copyright ownership of “Breakfast at Tiffany’s” novella (“Work”), finding Copyright Act implicated despite no claims in action under Act. Plaintiff alleged that defendant Paramount, creator of 1961 film adaptation of Work, signed 1991 license agreement with plaintiff preventing Paramount from creating new film based on Work without plaintiff’s agreement; defendant argued that it had unlimited rights to produce films based on Work in perpetuity. Plaintiff filed claim in California state court for declaratory relief that plaintiff, not defendant, owned all rights in Work, and that new screenplay by defendant was derivative work. Defendant removed to federal court. Court agreed with defendant that plaintiff’s request for declaration that screenplay was derivative work implicated Copyright Act, as it required determination as to whether screenplay was substantially similar to Work in violation of Act. While plaintiff argued that case was based in contract, federal courts are without jurisdiction only where copyright ownership is sole question for consideration.

Infogroup Inc. v. Office Depot, No. 20-109, 2020 U.S. Dist. LEXIS 212227 (D. Neb. Nov. 13, 2020)

Business intelligence company plaintiff sold its copyrighted database to defendant Office Depot, and later alleged that defendant infringed by using plaintiff's database to supply business data for use in Office Depot software program without authorization. Plaintiff sought monetary damages, injunctive relief, and costs and attorneys' fees. Office Depot claimed plaintiff had granted express license for such use, and moved to dismiss for lack of subject matter jurisdiction, alleging that agreement required mediation as condition precedent to suit, and no federal question existed because complaint essentially referred to breach of license agreement, not copyright infringement. District court held that mediation clause applied to contractual disputes but claim at issue was properly pleaded as copyright claim, which established subject matter jurisdiction under Act. District court further held that scope of license agreement between plaintiff and defendant could not be resolved as matter of law on face of complaint, as factual issues remained. District court also noted that mediation clause did not appear to require mediation in connection with claim for injunctive relief, which plaintiff was clearly seeking in present case. District court therefore denied motion to dismiss for lack of subject matter jurisdiction.

B. Personal Jurisdiction and Venue

AMA Multimedia, LLC v. Wanat, 970 F.3d 1201 (9th Cir. 2020)

Ninth Circuit affirmed dismissal of infringement claim due to lack of personal jurisdiction. Plaintiff, producer and distributor of pornography, brought infringement claims against defendant, citizen and resident of Poland. After jurisdictional discovery, defendant renewed motion to dismiss for lack of personal jurisdiction, and court granted motion. Plaintiff argued that defendant was subject to jurisdiction in U.S. because "he expressly aimed tortious conduct at the forum." Ninth Circuit, however, agreed with trial court that defendant did not have sufficient minimum contacts with U.S. Specifically, court found that defendant did not expressly aim his actions towards U.S.; ePorne (entity defendant operated in partnership with another defendant) did not have "forum-specific focus"; geo-located advertisements failed to show that defendant expressly aimed his website to U.S. because third-party advertiser always geo-located ads; ePorne's terms of service did not provide evidence of express aiming because even if entity created contracts with U.S. residents by terms of service, there were no allegations of breach of terms; and plaintiff did not establish that defendant chose U.S. DNS in order to appeal to U.S. or generate more U.S.-based users. Ninth Circuit affirmed dismissal for lack of personal jurisdiction.

Color Switch LLC v. Fortafy Games DMCC, 818 Fed. App'x 694 (9th Cir. 2020)

Ninth Circuit affirmed grant of dismissal to defendant. Plaintiff created game app and entered agreement with Fortafy to update game as needed. Although game was successful, plaintiff terminated agreement and demanded return of game from Fortafy, which request Fortafy refused. Plaintiff sued for infringement and declaratory relief, and district court

dismissed claims on basis of forum selection clause requiring that “[a]ny dispute arising in connection with this Agreement” be brought in Dubai. Plaintiff appealed, alleging district court erred because infringement and related declaratory judgment counts fell outside scope of forum selection clause. Ninth Circuit found that “in connection with” means same as “relating to,” and clauses that contain “relating to” encompass “disputes that reference the agreement or have some logical or causal connection to the agreement.” Here, dispute “reference[s] agreement” because defendant claimed it had rights as owner based on parties’ agreement. Accordingly, court would need to interpret alleged ownership rights arising under agreement to resolve infringement dispute. Dispute therefore fell within forum selection clause. District court acted within its discretion when it found clause was not result of fraud or coercion; that Court of Dubai “would not deprive Color Switch of its day in court”; and that clause did not contravene public policy. Ninth Circuit accordingly affirmed dismissal.

Krisko v. Marvel Entm’t, LLC, 473 F. Supp. 3d 288 (S.D.N.Y. 2020)

Plaintiff, Florida individual, brought infringement action against various defendants associated with (a) production and distribution of television show *X-Men: The Animated Series*, including media entertainment giants Marvel, Disney, Amazon, Apple, NBCUniversal, and (b) creation and composition of *X-Men* theme song, namely Haim Saban, Shuki Levy, their entertainment company, as well as its successor, and their employee, Ronald Wasserman. Plaintiff alleged that *X-Men* theme song infringed his copyright in “primary melodic theme” featured in soundtrack for popular 1980s-era Hungarian television show titled *Linda*. All defendants moved to dismiss, and Wasserman, writer of *X-Men* theme song, also alleged lack of personal jurisdiction. District court granted Wasserman’s motion on jurisdictional grounds, holding that plaintiff failed to allege sufficient facts to support court’s exercise of jurisdiction over Wasserman pursuant to New York long-arm statute. In particular, under statute’s “transacting business” test, court held that any connections between Wasserman’s work on *X-Men* theme song and New York, namely, his employment with company that contracted with national entertainment companies to sell his compositions, were “random, fortuitous, and attenuated, and, thus, do not merit this Court’s exercise of jurisdiction over him.” Court also found that CPLR §§ 302(a)(2) and 302(a)(3)(ii) plainly did not confer jurisdiction over Wasserman, in light of fact that (a) Wasserman did not commit tort in New York, and none of media defendants acted as Wasserman’s agent in distributing his work in New York, and (b) plaintiff’s alleged injury, namely that *Linda* theme song was copied and *X-Men* theme song was distributed all over world, was not “non-speculative and direct New York-based injury” to plaintiff’s intellectual property rights other than pure economic loss. Court also declined to transfer plaintiff’s claims against Wasserman to California, holding that it was not in “interest of justice” to do so, given plaintiff’s lack of diligence in choosing proper forum for case and failure to provide court with information that would permit it to determine whether California would be appropriate venue. However, court denied defendants’ motions to dismiss on infringement grounds, finding that plaintiff sufficiently pleaded that *Linda* and *X-Men* theme songs were plausibly strikingly similar, and denied Saban and Levy’s motions to dismiss regarding

contributory and vicarious liability, but granted remaining defendants' motions to dismiss as to secondary liability.

Hudson Furniture, Inc. v. Mizrahi, No. 20-4891, 2020 U.S. Dist. LEXIS 159288 (S.D.N.Y. Sept. 1, 2020)

Court denied defendant's motion to dismiss under Rule 12(b)(2) for lack of personal service, holding that court-ordered alternative service of process was proper. Plaintiff lighting and furniture designer and retailer sued Mizrahi, individual operating namesake companies and websites, and related corporate entity. On June 25, 2020, plaintiff filed suit alleging that Mizrahi committed copyright infringement by posting on his websites, without authorization, plaintiff's copyrighted images of plaintiff's lighting designs. On June 29, 2020, Mizrahi's U.S. counsel, in response to plaintiff's request that he accept service on Mizrahi's behalf, informed plaintiff he was not authorized to accept service. On July 1, 2020, plaintiff filed *ex parte* motion for leave to effect alternative service on Mizrahi, believed to be Austrian resident, via RPost email and by serving Mizrahi's U.S. counsel by mail. On July 7, 2020, court authorized alternative service on Mizrahi. After receiving court-approved extension of time to respond, Mizrahi moved to dismiss complaint for lack of personal jurisdiction on ground that alternative service was improper. Court noted that, under Rule 4(f)(3), as long as alternative service on individual in foreign country is court-ordered, it is permissible as long as not prohibited by international agreement and comports with constitutional due process. Because Austria not party to Hague Convention when court authorized alternative service, Mizrahi failed to identify any international agreement that prohibited email service on him. Further, email service on Mizrahi comported with due process because Mizrahi engaged in business via email and provided service emails as contact points on websites. Plaintiff also confirmed, via RPost receipts, that Mizrahi received and downloaded service papers sent to emails. Additionally, plaintiff sought to serve Mizrahi's U.S. counsel prior to seeking leave for alternative service. Finally, Mizrahi's U.S. counsel confirmed receipt of mailed service papers.

Prokos v. Haute Living, Inc., No. 19-138, 2020 U.S. Dist. LEXIS 144511 (S.D.N.Y. Aug. 11, 2020)

District court denied defendant's motion to dismiss or transfer for lack of personal jurisdiction. Plaintiff alleged that defendant, Florida corporation, published plaintiff's photograph of Harlem brownstone without permission. Defendant moved for dismissal or alternatively transfer of action to Southern District of Florida. To establish specific jurisdiction under N.Y. C.P.L.R. § 302(a)(3)(ii), plaintiff is required to demonstrate that (1) defendant's tortious act was committed outside New York, (2) cause of action arose from that act, (3) tortious act caused injury to person or property in New York, (4) defendant expected or should reasonably have expected that action would have consequences in New York, and (5) defendant derives substantial revenue from interstate or international commerce. Court did not accept defendant's argument that affiliated company, Haute Residence, which operated real estate website, was not involved in uploading content because it did not address alleged infringing acts by Haute Living, Inc itself. Accordingly,

court found tortious act was committed outside New York. Additionally, court found plaintiff's website demonstrated plaintiff's principal place of business was in New York, which was also situs of infringement claim. Further, court found defendant hosted content about New York, and thus defendant should have expected such content to have consequences in New York, especially in light of affiliate Haute Residence having contract with New York real estate brokers. Court also found that declaration submitted by defendant demonstrated revenue derived from interstate commerce, defendant possessed advertising office in New York and partnership with development company that owned Harlem brownstone featured in plaintiff's photograph, all of which showed defendant availed itself of New York forum. Thus, exercise of personal jurisdiction in New York was consistent with due process.

Four Jays Music Co. v. Apple, Inc., No. 19-7952, 2020 U.S. Dist. LEXIS 245896 (C.D. Cal. Dec. 1, 2020)

Central District of California district court transferred action to Southern District of New York based on convenience of parties and witnesses, local interest, and judicial efficiency. Plaintiff sued defendants Orchard entities for copyright infringement in C.D. Cal. Orchard moved to dismiss for lack of personal jurisdiction or, in alternative, to transfer case to S.D.N.Y. Court held that action could have been brought in S.D.N.Y. because S.D.N.Y. had original subject matter jurisdiction, as plaintiff's claims arose under Copyright Act, and as defendants maintained their principal place of business in New York City, venue would have been proper. Moreover, convenience of parties and witnesses as well as interests of justice served by transfer. Although plaintiff resided in California, deference to its choice of forum diminished because key operative facts regarding Orchard's involvement emanated from its alleged distribution of plaintiff's musical works in New York, as defendants' employees who negotiated licenses with other defendants were in New York. Further, convenience of parties and witnesses weighed in favor of transfer because defendants' witnesses and other relevant parties found in New York, action had stronger ties to New York, and judicial efficiency would be served by transfer because defendants would not contest personal jurisdiction in S.D.N.Y. Although other factors were neutral, court exercised broad discretion and transferred case.

Mahon v. Mainsail LLC, No. 20-1523, 2020 U.S. Dist. LEXIS 215028 (N.D. Cal. Nov. 17, 2020)

Plaintiff, independent Irish filmmaker and creator of screenplay and film *Strength and Honor*, entered into 2009 agreement with defendant Mainsail to distribute film. As part of agreement, Mahon sent master copies of film to third party based in Burbank, California. Later, film was released with unauthorized covers and trailers that plaintiff believed to be violation of agreement with Mainsail. Film continued to be distributed without authorization, and after service of demand correspondence on platforms displaying film, platforms identified Entertainment One as party that provided copy of film. Entertainment One, for its part, claimed it had received right to distribute film from Mainsail on behalf of plaintiff. Plaintiff brought infringement actions alleging that all defendants infringed

plaintiff's work. Defendant platforms renewed their motions to dismiss. Court previously dismissed claims against YouTube because they alleged extraterritorial infringement. In response, plaintiff amended to allege infringement from YouTube's headquarters in California, and further alleged that YouTube commingled U.S. and Irish operations, such that film copy could be stored on U.S. server. Because only YouTube would know location of servers, and it was plausible copy resided on U.S. server, court denied motion to dismiss direct infringement claim against YouTube.

Stross v. Netease, Inc., No. 20-861, 2020 U.S. Dist. LEXIS 183540 (C.D. Cal. Aug. 20, 2020)

Plaintiff photographers brought claims against defendant, Chinese internet technology company, for direct and vicarious or contributory infringement based on use of works on for-profit website. Defendant was incorporated in Cayman Islands and maintained principal place of business in China. Plaintiffs alleged defendant accessed works with assistance of NetEase Information Technology, defendant's California-based subsidiary, via "online search-and-copy campaign." Plaintiffs further alleged defendant directed activities toward U.S. by setting up California-based subsidiary, having New York investor relations contact, listing itself on New York-based stock exchange, regularly filing SEC reports, and contracting with California-based non-party Quantil Networks to make content available to Chinese-speaking viewers in U.S. by means of U.S.-based servers. Defendant moved to dismiss on *forum non conveniens* grounds. Court found defendants failed to show that China was adequate forum because it did not establish how China would give plaintiffs relief for copyright claims, or even that Chinese laws would allow sufficient remedy for plaintiffs' claims. Court also found private and public interest factors weighed against dismissal. Court denied motion to dismiss on *forum non conveniens* grounds.

Luminence, LLC v. Leach, No. 20-89, 2020 U.S. Dist. LEXIS 112392 (S.D. Cal. June 26, 2020)

Plaintiff, creator and seller of fiber optic hair accessories, brought action against defendant, seller of competing product, alleging that defendant repeatedly used plaintiff's images of its products on defendant's website without authorization. Defendant moved to dismiss for lack of personal jurisdiction and improper venue, or alternatively, to transfer venue. Plaintiff filed no opposition. Court granted defendant's motion to dismiss, finding lack of personal jurisdiction and improper venue, namely because plaintiff did not show that defendant purposefully directed its actions at California or Southern District of California. Court found that general personal jurisdiction was lacking over defendant, given that defendant operated exclusively in Texas and had no office or employees in California, noting that "while [d]efendant's internet sales may give it a presence in the domestic and international market, it is not automatically subject to general jurisdiction in every large market." As to specific personal jurisdiction, court applied "purposeful direction" analysis, determining that although defendant "arguably 'committed an intentional act' by utilizing plaintiff's copyrighted images" to sell competing product on its website, plaintiff "failed to establish that this act was 'expressly aimed' at the Southern District of California or that Defendant

anticipated that its act would cause harm in the Southern District of California.” Court also dismissed plaintiff’s arguments relating to “unsettled” stream-of-commerce theory of personal jurisdiction. Citing to Ninth Circuit case law, court noted that plaintiff’s conclusory allegation that defendant was “doing business in California” was insufficient to demonstrate that “something more” required by earlier precedent because defendant’s conduct was related to sale, marketing, or distribution in California and defendant only offered its products for sale on its website. Court also dismissed case in lieu of transferring it to Southern District of Texas, given that deficiencies in plaintiff’s complaint, together with plaintiff’s failure to file opposition, demonstrated that any transfer of case would only “delay the inevitable.”

Incredible Features v. BackChina, No. 20-943, 2020 U.S. Dist. LEXIS 148151 (C.D. Cal. Aug. 3, 2020)

Plaintiff filed infringement action against defendant BackChina, LLC, alleging that defendant, without authorization, posted several photographs to its website. Defendant moved to dismiss or transfer, alleging that venue was either improper or inconvenient. Because venue is proper in district where court could exercise personal jurisdiction if district were distinct state, court analyzed defendant’s contacts with forum. In Ninth Circuit, personal jurisdiction can be established when defendant operates website containing infringements, and defendant targets conduct directly at forum. Here, defendant expressly aimed its infringing conduct at district by featuring advertisements on its website for business located within district. As such, defendant purposefully directed its actions to district, and was subject to court’s jurisdiction and venue was proper. Court denied motion to dismiss for improper venue.

Martino v. Orchard Enters., No. 20-2267, 2020 U.S. Dist. LEXIS 199687 (N.D. Ill. Oct. 27, 2020)

District court granted defendants’ motions to transfer, finding it lacked personal jurisdiction over defendants. Plaintiff, self-funded recording artist, professional singer/songwriter and Illinois resident, sued three entities for copyright infringement: (1) music distributor Orchard Enterprises, Delaware corporation with principal place of business in New York; (2) digital distribution company for music community IODA, California corporation with principal place of business in New York; and (3) business-to-business licensor of music catalog rights MediaNet, Delaware corporation with principal place of business in Washington. Plaintiff, sole owner of all copyrights in 11 songs on two albums, alleged that Orchard and IODA distributed one of plaintiff’s albums to MediaNet and other third parties, while MediaNet distributed both albums to at least 53 brick-and-mortar stores, including two in Illinois. Plaintiff alleged that all defendants conducted business in Illinois by selling plaintiff’s albums at Illinois stores, and that Orchard and IODA also advertised employment opportunities to Illinois residents and entered into distribution contracts with Illinois-based people and entities. Defendants moved to dismiss for lack of personal jurisdiction or, alternatively, to transfer venue. Court held that it lacked general jurisdiction over defendants because they were neither incorporated, headquartered nor otherwise at home in Illinois. Further, court lacked specific jurisdiction over defendants because plaintiff failed to

sufficiently allege that they purposefully directed their activities at Illinois. MediaNet did not itself operate interactive website targeting Illinois residents, and mere fact that two of MediaNet's 53 retailers were physically based in Illinois was insufficient to show that MediaNet purposefully availed itself of business in Illinois. Orchard's and IODA's Illinois employee advertisement and distribution contracts were unrelated to plaintiff's copyright claims and therefore insufficient to create jurisdictional link. Instead of dismissing plaintiff's suit, court transferred to Southern District of New York, where defendants consented to suit.

Reiffer v. AET Limo, LLC, No. 20-979, 2020 U.S. Dist. LEXIS 138659 (D.D.C. Aug. 4, 2020)

London photographer Paul Reiffer sued California limousine company for infringement, alleging he owned copyright in photograph of Golden Gate Bridge used without authorization by defendant. When defendant failed to appear, plaintiff moved for entry of default, which clerk granted. District court then issued order to show cause as to why case should not be dismissed for lack of personal jurisdiction or transferred to Central District of California. Noting that plaintiff bears burden of establishing personal jurisdiction, district court concluded that plaintiff had made only conclusory statements as to personal jurisdiction and had not alleged any facts to support such allegations. Plaintiff failed to include factual allegations that defendant conducted business, caused any injury, or engaged in persistent conduct in district. District court concluded that personal jurisdiction was lacking and dismissed complaint without prejudice.

AMA Multimedia LLC v. Sagan Ltd., No. 16-1269, 2020 U.S. Dist. LEXIS 188394 (D. Ariz. Oct. 9, 2020)

Court denied motion to dismiss for lack of personal jurisdiction. Plaintiff, producer of pornography, brought infringement claims against entities and individual associated with Porn.com based on unauthorized display of 64 registered works over 110 URLs affiliated with Porn.com. Plaintiff asserted jurisdiction was proper under Fed. R. Civ. P. 4(k)(2); inquiry focused on whether exercise of jurisdiction did not offend due process. Although individual defendant was Canadian resident with no bank accounts, office, employees, leased or owned property, or personal property in U.S., court considered whether defendant's activities made him "guiding spirit behind the wrongful conduct or the central figure in the challenged corporate activity," whereby jurisdiction would be proper. Specifically, court considered individual defendant's relationship to entity defendants Cyberweb and Netmedia. Court disagreed with individual defendant that jurisdiction would be improper because he was not corporate officer of Cyberweb, finding individual could not escape exercise of personal jurisdiction if he/she was not officer but was driving force behind infringement. For purposes of motion, court accepted that Netmedia was operator that uploaded infringing works to Porn.com, and court also found that individual defendant, president of Netmedia, was "'moving, active, conscious force' behind Netmedia's activity." Because Netmedia consented to jurisdiction, court found that it had personal jurisdiction over individual defendant.

Belaustegui v. KC Media LLC, No. 20-531, 2020 U.S. Dist. LEXIS 147840 (E.D. Mo. Aug. 17, 2020)

District court granted defendant's motion to dismiss for improper venue because plaintiff failed to allege any relevant connections to venue; filing of lawsuit was improper and in reckless disregard of plaintiff's counsel's duties. Plaintiff, professional photographer who resided and operated business in Florida, licensed his photographs to online and print media for fee. Defendant was marketing and media group organized under laws of Missouri with principal place of business in Kansas City, Missouri, located in Western District of Missouri. Plaintiff, represented by Richard Liebowitz, sued defendant in Eastern District of Missouri, alleging that defendant published his copyrighted photographs to its website without permission. Defendant moved to dismiss action for improper venue, or alternatively, to transfer venue to Western District, and moved for award of costs and fees. Plaintiff did not respond to motion. Court granted defendant's motion to dismiss and requests for costs and fees. Court applied 28 U.S.C. § 1400(a), holding that venue was improper because defendant had no relevant contacts, and plaintiff failed to sustain any injury due to defendant's conduct, in Eastern District. Court agreed with defendant that any alleged conduct giving rise to plaintiff's claim occurred only in Western District. Court rejected plaintiff's arguments that it would have been more convenient for action to be heard in Eastern District. Court also held that, because venue was both wrong and improper, dismissal was more appropriate than transfer. Based on Liebowitz's history of improperly filing copyright cases in wrong venue to avoid additional costs, court found that it would not be in interest of justice for defendant and court to do Liebowitz's work for him and transfer action to only venue where case could have been brought. Court denied as moot defendant's motion to extent it sought to transfer venue.

Infogroup Inc. v. Office Depot, No. 20-109, 2020 U.S. Dist. LEXIS 212227 (D. Neb. Nov. 13, 2020)

Business intelligence company plaintiff sold its copyrighted database to defendant Office Depot, and later alleged that defendant infringed by using plaintiff's database to supply business data for use in Office Depot software program, without authorization. Office Depot claimed plaintiff had granted express license for such use, and moved to dismiss for lack of personal jurisdiction, alleging plaintiff lacked sufficient minimum contacts with forum state. After reviewing record, court held that Office Depot consented to suit in Nebraska by virtue of conducting business in state and maintaining registered agent for service of process, which therefore precluded need to conduct due process inquiry. However, district court noted that even under due process inquiry, Office Depot's contacts with forum state were extensive enough that exercise of jurisdiction would not offend notions of fair play and substantial justice, because complaint alleged that Office Depot had numerous retail stores in Nebraska and negotiated contract at issue with executives located in state. Furthermore, plaintiff's claim involved intentional tort whose effects would be felt in forum state. District court therefore held that Office Depot could reasonably anticipate being hauled into Nebraska court, and denied motion to dismiss for lack of personal jurisdiction.

Sensory Path Inc. v. Fit & Fun Playscapes LLC, No. 19-219, 2020 U.S. Dist. LEXIS 161665 (N.D. Miss. Sept. 3, 2020)

District court dismissed plaintiff's action for declaratory judgment of non-infringement due to lack of personal jurisdiction over defendants. Plaintiff Mississippi corporation created and sold adhesive stickers to allow users to create paths for children's sensory integrated movement. Defendant was New York company that designed and sold adhesive stickers and roll-out games, some of which were advertised with term "sensory path." Fit & Fun's website was accessible to Mississippi residents and promoted grants through which defendant's products could be purchased, including grant expressly targeting Mississippi residents. Fit & Fun sent two cease-and-desist letters to plaintiff, alleging that plaintiff was violating defendants' copyrights. Plaintiff brought suit against Fit & Fun and its principal for declaratory judgment of non-infringement. Court granted defendants' motion to dismiss for lack of personal jurisdiction because relevant question whether defendants infringed plaintiff's copyrights (rather than used their own copyrights) in Mississippi. Defendants' two cease-and-desist letters were defendants' only contacts with Mississippi in connection with plaintiff's copyright non-infringement action, and such letters were insufficient to serve as basis for personal jurisdiction.

C. Pleadings

Masterson v. Walt Disney Co., No. 19-55650, 2020 U.S. App. LEXIS 24394 (9th Cir. Aug. 3, 2020)

Ninth Circuit affirmed district court's dismissal of plaintiff author's infringement claim against defendant Walt Disney Co. Plaintiff alleged that Disney's animated film *Inside Out* violated copyrights in her book of poetry and movie script that features character who introduces four children to "various anthropomorphic doors that are associated with a different feeling." Disney's *Inside Out* tells story of child and anthropomorphized emotions that live inside of her. District court granted defendant's motion to dismiss on grounds that works were not substantially similar. Plaintiff appealed, arguing that substantial similarity between literary works cannot be resolved in motion to dismiss. Ninth Circuit affirmed district court's decision and rejected plaintiff's argument, finding that "motion to dismiss is proper when nothing disclosed during discovery could alter the fact that the allegedly infringing works are as a matter of law not substantially similar." Court explained that "there will be times when the court finds it plausible that two works are substantially similar and that expert testimony could be helpful," but there will also be times where court's experience "shows that the claims are not plausible and that a comparison of two works creates no more than a mere possibility of misconduct." Here Ninth Circuit found that district court did not err by considering substantial similarity on motion to dismiss, despite fact that works at issue were literary works, and held that plaintiff failed to plausibly allege that her book and Disney's *Inside Out* were substantially similar. Ninth Circuit also determined that plaintiff waived any claim of infringement of her movie script because she did not address district court's determination that she had failed to allege access in appeal.

Beom Su Lee v. Karaoke City, No. 18-3895, 2020 U.S. Dist. LEXIS 157834 (S.D.N.Y. Aug. 31, 2020)

District court denied defendant's motion to dismiss complaint for failure to state claim. Plaintiff owned copyrights of his deceased father, popular Korean musician Jae Ho Lee, and alleged that multiple karaoke clubs willfully infringed plaintiff's protected works by publicly performing them without license or authorization. Defendants argued that plaintiff failed to allege ownership of valid copyright and infringing conduct by each defendant, but district court concluded that plaintiff had met his obligations under *Iqbal* pleading standards. Defendants further argued that songs at issue were in public domain because they "must have been" published prior to 1978, but district court held that plaintiff adequately alleged publication in 1996. Defendants additionally alleged that private karaoke rooms are analogous to hotel rooms, and thus no public performance occurred, but district court found this to be issue of fact and therefore not proper for Rule 12(b)(6) motion to dismiss. Defendants also argued that use of plaintiff's copyrighted songs constituted fair use because karaoke performances can be used as teaching aides for improving one's voice or as parody of song, but district court concluded that face of complaint did not establish fair use defense for purposes of motion to dismiss, noting that fact development over course of lawsuit could potentially support such defense. Defendants further maintained that plaintiff did not adequately allege willful infringement. Although factual allegations of willful infringement were sparse, district court concluded that plaintiff adequately pleaded claim for statutory damages, because of allegations that defendants (a) acted with reckless disregard for plaintiff's rights due to works at issue being widely known in Korea; (b) did not obtain license to include such works on their karaoke machines; and (c) did not affirmatively ascertain whether such works were protected by copyright.

Ino, Inc. v. Needle & Threads of West Palm Beach, Inc., No. 19-4078, 2020 U.S. Dist. LEXIS 234595 (E.D.N.Y. Dec. 14, 2020)

Court granted in part and denied in part motion to dismiss. Plaintiff owned rights to copyrighted designs, and produced, distributed and sold goods bearing designs to fashion industry. Plaintiff alleged that defendants made and distributed garments with identical or substantially similar designs and brought claims for direct and indirect infringement. Defendant argued that complaint did not specifically identify act of infringement, but court found argument "unavailing," because plaintiff did not need to describe each infringing act or time of infringement; plaintiff only needed to show how defendant infringed. On indirect infringement claim, however, court found allegations vague and conclusory and insufficient to withstand motion. Court denied motion to dismiss direct infringement claim and granted motion to dismiss indirect infringement claim with leave to replead.

Stross v. Netease, Inc., No. 20-861, 2020 U.S. Dist. LEXIS 183540 (C.D. Cal. Aug. 20, 2020)

Plaintiff photographers brought claims against defendant, Chinese internet technology company, for direct and vicarious or contributory infringement based on use of works on for-

profit website. Plaintiffs alleged defendant accessed works with assistance of NetEase Information Technology, defendant's California-based subsidiary, via "online search-and-copy campaign." Plaintiffs further alleged defendant directed activities toward U.S. by setting up California-based subsidiary, having New York investor relations contact, listing itself on New York-based stock exchange, regularly filing SEC reports, and contracting with California-based non-party Quantil Networks to make content available to Chinese-speaking viewers in U.S. by means of U.S.-based servers. Defendant moved to dismiss for failure to state claim as against one plaintiff, arguing that plaintiff could not make out direct infringement or secondary liability claim against it. After finding plaintiff had made out sufficient direct infringement claim, court found vicarious liability claim properly stated because plaintiff alleged facts showing that defendant received financial benefit from affiliates' infringement and defendant had right and ability to supervise affiliate. Court found plaintiff also sufficiently stated contributory infringement claim because complaint alleged facts showing that defendant knew about infringement and plausibly induced, caused, or materially contributed to affiliates' infringement. Court denied motion to dismiss.

Davis v. Pinterest, Inc., No. 19-7650, 2020 U.S. Dist. LEXIS 202077 (N.D. Cal. Oct. 29, 2020)

District court denied plaintiff's motion to amend first amended complaint to add new cause of action where parties engaged in two rounds of pleadings-based motion practice over course of year. Plaintiff digital artist and photographer sued Pinterest for direct and contributory infringement, alleging Pinterest copied and displayed his copyrighted works, which bore his name and copyright notice. Pinterest moved to dismiss contributory infringement claim and, rather than opposing, plaintiff filed first amended complaint adding additional allegedly infringed works. Pinterest again moved to dismiss contributory infringement claim, and court granted motion with leave to replead, but cautioned plaintiff to not add further claims or defendants. Nevertheless, plaintiff moved for leave to amend FAC to add DMCA claim, arguing that claim was viable and Pinterest would not be prejudiced because case schedule not yet set. Court denied motion because plaintiff failed to allege any newly-discovered facts or provide any reasonable justification for not bringing DMCA claim in his initial complaint or FAC, and allowing plaintiff to do so now (after two rounds of motions to dismiss) would cause undue delay.

Fishbaugh v. Bulgadarian, No. 20-1135, 2020 U.S. Dist. LEXIS 153326 (C.D. Cal. July 27, 2020)

District court denied defendants' motion to dismiss but ordered parties to exchange copies of respective works at issue. Plaintiff, developer of software for testing "bellows" for use in spaceflight, sued defendants for infringement, alleging that they incorporated his copyrighted source code into software used to test bellows for Space X rockets. On motion to dismiss, defendants argued that plaintiff's operative complaint (which included copy of registration certificates for source code) failed to state claim because complaint did not include actual source code allegedly copied. District court found allegations in complaint, with attached registration certificates, sufficient to survive motion to dismiss. Court rejected defendants'

theory that copy of source code necessary at pleading stage to show infringement, and posited that such theory would bar infringement claim in situation where party steals source code from creator and leaves him without copy. Court denied motion to dismiss but ordered plaintiff to provide defendant with deposit copies for its copyrighted source code, and defendants to provide plaintiff with copy of accused source code used in its bellows testing.

Backgrid USA, Inc. v. Euphoric Supply, No. 20-914, 2020 U.S. Dist. LEXIS 154225 (S.D. Cal. Aug. 24, 2020)

Plaintiff, celebrity photography agency that owned copyright in photo of Kanye West, alleged that packaging for defendants' \$75 Kanye West action figure contained cropped version of its copyrighted work in front of gradient background, and that action figure itself was unauthorized derivative work of photo. Defendants moved to dismiss on basis that defendants did not copy any protectible elements of plaintiff's work, and that use amounted to fair use. Defendants argued photo was "bereft of creativity" and "essentially factual in nature." Court found that defendants' argument was inappropriate on motion to dismiss and that plaintiff properly pleaded claim of infringement. Similarly, court found that fair use defense was not properly raised on motion to dismiss because there were material facts in dispute, and defendants' argument relied on facts outside complaint. Court denied motion to dismiss.

Cianelli v. Nourison Indus., No. 19-19147, 2020 U.S. Dist. LEXIS 150817 (D.N.J. 2020)

District court granted defendants' motion to dismiss because original complaint did not state plausible claim of copyright infringement, amended complaint was untimely, and further amendment would be futile. Plaintiff, artist, alleged defendant copied his paintings into rugs and distributed to other stores without consent. Defendants moved to dismiss original complaint. Plaintiff did not oppose and instead filed amended complaint. Defendants filed motion to dismiss, arguing that amended complaint was untimely and that leave to further amend should be denied as futile because plaintiff failed to (1) state claim for copyright infringement or to (2) properly allege personal jurisdiction over defendants. Court found personal jurisdiction defense waived because defendants did not object until they moved to dismiss amended complaint. Court deemed amended complaint untimely because plaintiff missed deadline to amend as of right, and instead filed amended complaint without court's leave. On copyright infringement claim, court found no similarity between protected aspects of artwork and rugs. Court noted nothing particular in works showed defendants must have copied plaintiff and further, there were dissimilarities between two, such as colors, shapes, and orientation. Court found amended complaint failed to state plausible claim of copyright infringement.

Kobi Karp Architecture & Interior Design v. O'Donnell Dannwolf and Partners Architects, Inc., No. 19-24588, 2020 U.S. Dist. LEXIS 131909 (S.D. Fla. July 27, 2020)

District court denied defendant's motions to dismiss infringement action for failure to state claim, based on fair use and nonexclusive license defenses, and for failure to state claim for violation of DMCA. Plaintiff entered into agreement with defendant to design apartment complex, whereby plaintiff prepared drawings and registered copyright. Defendant replaced plaintiff architect, and plaintiff claimed defendant proceeded to use copyrighted drawings without consent. Court found plaintiff successfully stated claim because it provided copyright registration certificate and alleged that defendants had access to copyrighted works and submitted substantially similar designs. Court denied fair use defense because complaint did not clearly show that submission of drawings was fair use. Court denied nonexclusive license defense because complaint did not clearly show that plaintiff granted nonexclusive irrevocable license. Last, court denied defendants' argument that plaintiff failed to state claim for violation of DMCA because DMCA only applies to "electronic commerce." Court considered plain meaning of statute and declined to adopt that limitation.

Doerr v. Quickcall.com, LLC, No. 19-10774, 2020 U.S. Dist. LEXIS 135068 (E.D. Mich. July 30, 2020)

District court denied motion to dismiss for failure to state claim. Detroit-based photographer sued Romanian-American Network, Inc. (RAN) and Quickcall.com, LLC for copying and using photo without permission. RAN allegedly ran website where photo was posted without authorization, but plaintiff alleged that Quickcall retained copyright ownership over entire RAN website. Defendant Quickcall moved to dismiss, arguing that plaintiff failed to distinguish between actions of Quickcall and other defendant, and failed to link Quickcall to alleged copyright infringement. District court observed that Quickcall did not challenge plaintiff's copyright in photo at issue and did not argue that original elements of photograph were not copied; sole issue to be decided was whether plaintiff adequately pleaded that Quickcall copied photograph at issue. Analyzing complaint in light most favorable to plaintiff, district court concluded that plaintiff had adequately linked Quickcall to copying of photograph, by including records that established link between alias of Quickcall and management of website at issue. Furthermore, court held that plaintiff's failure to distinguish between actions of Quickcall and RAN did not automatically warrant dismissal, as plaintiff's complaint contained sufficient allegations to put Quickcall on notice of its alleged connection to copying of photograph. Although Quickcall raised question of whether another entity actually owned or managed website at issue, district court found that further factual development was required before such issue could be decided. For all such reasons, district court denied motion to dismiss.

Edwards v. Take Fo' Records, Inc., No. 19-12130, 2020 U.S. Dist. LEXIS 119246 (E.D. La. July 8, 2020)

Plaintiff, New Orleans disc jockey. filed suit against several record labels for infringement of plaintiff's sound recording entitled "Choppa Style." As DJ, plaintiff developed instrumental sound recording, "Choppa Style Instrumental," for which New Orleans rapper, known professionally as "Choppa," recorded lyrics with plaintiff's consent to create work at issue. Defendant Take Fo' Records contracted with plaintiff to use work on Choppa's album in exchange for flat fee, royalties, and bonus if Take Fo' Records secured national distribution deal. After song became popular on radio, Take Fo' Records failed to pay plaintiff agreed-upon royalties, and hired other musicians to "recreate" song in studio, without plaintiff's permission. Recreated song allegedly misappropriated many key protected elements of original work, and, although defendant later secured national distribution deal for Choppa, it did not tender royalties or bonus payment to plaintiff. Plaintiff further alleged that other high-profile artists, such as French Montana and Cardi B, additionally misappropriated protected elements of plaintiff's work, including lyrics, melody, arrangement, combination horn riff, and drum sequence. After determining plaintiff's copyright claims were not time-barred, court denied defendants' 12(b)(6) motion to dismiss for failure to state claim, finding that plaintiff successfully alleged ownership of valid copyright in work, and that defendants copied protected aspects of work in unauthorized derivatives.

Oppenheimer v. Scarafile, No. 19-3590, 2020 U.S. Dist. LEXIS 213742 (D.S.C. Nov. 16, 2020)

Plaintiff, professional photographer, brought suit against defendants, alleging infringement of his original photographs of Toler's Cover Marina in Mount Pleasant, South Carolina. Plaintiff alleged that defendants copied and distributed images on more than 100 different websites of 34 realtors, agents, and brokers for advertising boat slip at Toler's Cover Marina. Plaintiff alleged claims for non-willful, reckless/willful, vicarious, and contributory infringement, as well as DMCA violation. Defendants moved to dismiss. Court found allegations sufficient to withstand motion: reckless/willful infringement plausibly alleged because of copyright notice on plaintiff's website; non-willful infringement plausible because defendants removed some images upon receipt of demand letter; vicarious and contributory claims plausible because of connection between defendants and Carolina One Real Estate; and DMCA claim properly pleaded and plaintiff did not allege, and defendants did not show, that they were "service provider" under § 512(k)(1). Court denied motion to dismiss.

Johnson v. Amazon.com, Inc., No. 20-223, 2021 U.S. Dist. LEXIS 8338 (W.D. Okla. Jan. 15, 2021)

District court denied defendant's motion to dismiss, holding that plaintiff sufficiently alleged willful infringement claims. Plaintiff's first amended complaint alleged that he owned copyright in visual work "RUN OKC" and provided both registration number and certificate. Plaintiff further alleged that Amazon directly, contributorily and vicariously infringed

plaintiff's registered copyright by listing and selling products online that replicated his work, as well as that Amazon infringed "knowingly and willfully" by copying and preparing derivative works and "directly profited" from its infringement. Court held that plaintiff's allegations as to ownership, copying and willfulness were sufficient to provide Amazon with fair notice and allow it to respond, thereby meeting minimum pleading standards.

D. Standing

Crafty Prods. v. Fuqing Sanxing Crafts Co., 839 F. App'x 95 (9th Cir. 2020)

Ninth Circuit affirmed dismissal based on lack of standing. Court affirmed that only legal or beneficial owner of exclusive right under copyright is entitled to sue for copyright infringement; and owner must register copyright prior to suing. Contribution Agreement and Operating Agreement clearly transferred all assets of plaintiff Crafty Productions, Inc. ("CPI"), including copyrights, to co-plaintiff Crafty Productions, LLC ("CPL"). CPI did not retain ownership of copyrights or any exclusive right by reserving right to sue for intellectual property infringement. CPL never registered copyrights. Therefore neither CPI nor CPL had standing to bring copyright infringement claim.

Lanard Toys v. Anker Play Prods., No. 19-4350, 2020 U.S. Dist. LEXIS 221783 (C.D. Cal. Nov. 12, 2020)

Plaintiff toy manufacturer sued defendant, competing manufacturer and distributor of children's activity play products, alleging that defendant infringed plaintiff's copyrights in its "Chalk Bomb!" product – toy ball comprised of chalk powder, and its related packaging – by selling and promoting similar product bearing mark "Chalk Blast." In response, defendant raised various affirmative defenses, including fair use, standing, invalidity of copyright, and *de minimis* use. Both parties moved for summary judgment; plaintiff sought summary judgment as to all its claims and on all of defendants' affirmative defenses, and defendants moved for partial summary judgment as to plaintiff's claims for design patent and copyright infringement. Court denied both parties' motions as to copyright infringement, concluding that there was genuine dispute of material fact as to striking and substantial similarity between plaintiff and defendant's product packaging. Court granted summary judgment for some of defendant's affirmative defenses and denied summary judgment as to others. Plaintiff argued that defendant's "affirmative defense for standing" was improper because plaintiff had burden of proving standing, and defendants' contention that plaintiff lacked standing was not supported by evidence. Court agreed with plaintiff, holding that plaintiff had standing to pursue its copyright infringement claims based on its copyright ownership.

First Am. Cinema v. Chicken Soup for the Soul Entm't, No. 19-9577, 2020 U.S. Dist. LEXIS 186480 (C.D. Cal. July 2, 2020)

Court denied defendant's motions to dismiss. Plaintiff owned copyright in film *The Amazing Wizard of Paws* and entered into agreement with Screen Media Ventures, LLC ("SMV") to license film for distribution for 10 years worldwide. SMV then licensed film to wholly-

owned subsidiary that offered film free to viewers and placed film on YouTube channel for free viewing, despite agreement that defendant would maximize profits of film. Separate defendant also offered free stream of film on its own website. Plaintiff brought claim for infringement. Defendant moved to dismiss on grounds that plaintiff lacked standing because it assigned and transferred rights to SMV. Although SMV received exclusive distribution rights from plaintiff, plaintiff maintained right to receive royalties from SMV and therefore was beneficial owner of film copyright. As beneficial owner, plaintiff had standing to sue for unauthorized distribution. Court was unable to determine at motion to dismiss stage whether license granted right to sue exclusively to SMV, to exclusion of plaintiff. Court denied defendant's motion to dismiss.

Bell v. Carmen Commer. Real Estate Servs., No. 16-1174, 2020 U.S. Dist. LEXIS 154013 (S.D. Ind. Aug. 25, 2020)

Plaintiff Bell had previously filed “dozens of copyright infringement suits” based on use of his photo of Indianapolis skyline, but in current suit jury found that plaintiff did not prove that he authored photo, owned photo, and registered photo with Copyright Office, and judgment was entered for defendant. Plaintiff moved for new trial and defendant moved for attorneys' fees and costs. First, plaintiff argued that trial court erroneously provided work for hire instruction even though defendant lacked standing to raise such argument; evidence at trial was not sufficient to include language in instruction; and instruction incorrectly put burden of proof on him on work for hire issue. When work made for hire instruction was provided to jury, plaintiff did not object, so court found that plaintiff did not preserve objection to instruction. Court also found that it was not erroneous to deny plaintiff's earlier filed motion *in limine* to preclude work for hire affirmative defense because defendant had standing to challenge plaintiff's ownership of work under § 101 and § 201(b).

E. Miscellaneous

Christ Ctr. of Divine Philosophy v. Elam, 831 F. App'x 903 (10th Cir. 2020)

Tenth Circuit affirmed district court's denial of defendant's Rule 60(b) motion seeking to set aside default judgment. Plaintiff brought copyright infringement action against defendant for infringement of religious books and sound recordings. District court granted plaintiff's motion for default judgment for failure to answer, awarded statutory damages, and granted injunctive relief. Defendant filed Rule 60(b) motion on grounds that default judgment was brought into doubt by Supreme Court's *Fourth Estate* decision, which held that issued copyright registration is precondition to filing claim, and that plaintiffs did not make sufficient allegations to confer jurisdiction. District court denied motion, noting relief may be granted only in “exceptional circumstances,” and that defendant offered no authority to support argument that filing motion during time period for seeking *certiorari* would keep case open. District court further rejected jurisdictional argument because decision did not implicate court's subject-matter jurisdiction. Tenth Circuit saw no abuse of discretion in district court's decision and affirmed.

D.C. Circuit affirmed dismissal of copyright claim. Plaintiff, operator of “&pizza” pizza chain in U.S., brought suit against At Pizza, operator of pizza chain in Scotland. In creating “copycat” version of plaintiff’s restaurants in Scotland, owners of defendant pizza chain downloaded photos of plaintiff’s restaurants from websites using U.S. servers, and also took photos of plaintiff’s restaurants in U.S. District court found plaintiff did not allege domestic violation of copyright as required under Act. On allegation that defendant owners downloaded material from U.S. servers, circuit court held that plaintiff did not sufficiently allege unauthorized copies of works were fixed in U.S., and found unsupported plaintiff’s argument that downloading work from U.S. server creates copy of work in U.S. in addition to copy located in country where receiving device exists. On allegation that taking photos in plaintiff’s restaurants as part of plan to create lookalike establishment amounted to domestic infringement, court found that plaintiff did not make out cognizable claim because § 120 does not prevent taking of photos of publicly visible architectural works, and in making “copycat restaurant,” act of infringement took place where building was located, U.K. Finally, plaintiff argued that even if downloading from U.S. servers or taking photographs of U.S. restaurants did not amount to domestic infringement, Act applies if “essential steps” toward infringement occur in U.S. Circuit court, however, found that plaintiff’s argument conflated “predicate act” test applied in certain circuits with plaintiff’s own novel “partial-act” theory. Without domestic act of infringement, predicate act theory did not apply. In sum, plaintiff failed to state claim under Copyright Act because it did not allege act of infringement in U.S. Circuit court affirmed dismissal.

Hello I Am Elliot, Inc. v. Sine, No. 19-6905, 2020 U.S. Dist. LEXIS 116681 (S.D.N.Y. July 2, 2020)

District court granted defendants’ motion to dismiss plaintiffs’ action for declaratory judgment declaring plaintiff sole owner of proprietary e-commerce software. Plaintiff startup company owned e-commerce platform called “Elliot.” Plaintiff’s founder, Villasenor, created, coded and operated Elliot platform. Defendant Sine represented to Villasenor that he was Managing Director of another e-commerce company, Vander Group. Villasenor and Sine eventually incorporated Vander International Corp. Plaintiff and Vander Group’s referral affiliate agreement stated that Vander Group would help market Elliot, but did not provide Sine or Vander Group access to Elliot software code. However, Sine’s online post advertising Elliot implied partial ownership of Elliot. Court denied plaintiffs’ motion, holding that plaintiffs’ complaint did not plead “actual controversy.” Court noted there must be “real and substantial prospect” that defendants’ claim of ownership will impact plaintiffs’ rights, which court noted would be especially difficult because plaintiffs alleged that defendants had no access to Elliot software code. There was thus no actual controversy over which court could assert its jurisdiction under Declaratory Judgment Act.

District court denied defendants' motion to dismiss infringement claim based on plaintiff's copyright registration, and granted defendants' motion to dismiss infringement claim based on plaintiff's application. Plaintiff's business was designing, selling, and installing lockers for sports. Plaintiff claimed it submitted confidential bid, which led to alleged infringement of its copyrights. Court addressed defendants', competitor for project and interior design company, motions to dismiss collectively because substantial overlap between arguments. Defendants made three arguments in motion to dismiss copyright infringement claim based on registration. Defendants argued none of protected features were copied, plaintiff failed to identify derivative works, and plaintiff failed to plausibly plead direct or indirect infringement. Court denied motion because identification and determination of protected elements of copyrighted work not appropriately resolved at motion to dismiss stage; plaintiff properly pleaded sufficient plausible facts to put defendants on notice as to works that infringed registered copyright, including those that were derivative works; and plaintiff alleged sufficient facts with respect to defendants' involvement to support alleged infringement. In motion to dismiss infringement claim based on application, defendants argued mere filing of application did not provide rights of enforcement. Court agreed, and granted motion. However, court granted plaintiff's motion to leave to amend complaint because plaintiff would have right to bring claims once copyright was registered or registration was refused.

II. COPYRIGHTABILITY

A. Originality

Desire, LLC v. Manna Textiles, Inc., 986 F.3d 1253 (9th Cir. 2021)

Ninth Circuit affirmed district court's holding that plaintiff's textile design was original and entitled to broad protection. Plaintiff fabric supplier purchased two-dimensional stylized floral print textile design ("Subject Design") from Cake Studios, Inc., then registered it with Copyright Office. Cake designer created Subject Design using their own imagery in Adobe Photoshop, without use of pre-existing artwork. Plaintiff sued various defendants for copying Subject Design and/or selling garments with Subject Design. On summary judgment, district court held that Subject Design was original and entitled to broad protection because it contained artistic arrangement of stylized, non-lifelike floral elements. On appeal, defendants argued that Subject Design not original based on expert report that concluded that Subject Design's floral motif was similar to numerous others in prior art materials in public domain. Ninth Circuit affirmed district court's holding because similarity of Subject Design to another had no bearing on whether plaintiff "independently created" Subject Design. Because undisputed evidence showed that Cake designer created Subject Design using own imagery, both independent creation and minimal degree of creativity prongs of originality test satisfied. District court also properly determined that Subject Design was entitled to

broad, rather than thin, copyright protection because of stylized, non-lifelike nature of design, and therefore correctly concluded that accused design had to be only substantially similar, rather than virtually identical, to infringe Subject Design.

Hiller, LLC v. Success Grp. Int'l Learning All., LLC, 976 F.3d 620 (6th Cir. 2020)

Sixth Circuit affirmed district court's denial of intervenor's motion for judgment as matter of law, holding that reasonable jury could have found that plaintiff had contributed enough material to work at issue to gain copyright protection. In 1999, plaintiff, home service provider, was member of training course organization Success Group, then owned by Clockwork Home Services, and had access to its copyrighted manuals ("Manuals"). In 2014, Clockwork sold Success Group to Aquila Investment Group but retained ownership of copyrights in Manuals, granting Aquila perpetual license to use them. In 2015, plaintiff hired Bob Pike Group to create new guide ("Guide") with intent of using Guide in lieu of manual in training plaintiff's technicians. Plaintiff conducted educational workshop with Pike in which Manuals were referenced. Pike subcontractor created Guide based on content from workshop and asked plaintiff to fill in gaps, which plaintiff did with both original text and with word-for-word text from Manuals. In January 2016, Success conducted class using workbook that closely resembled Guide ("Workbook") and, in July, plaintiff's attorneys demanded that Success cease use of Workbook. Plaintiff registered copyright in Guide in March 2017 and sued Success in April. In December 2017, Clockwork intervened, claiming it was owner of intellectual property that plaintiff alleged was infringed by Success. Jury rejected Clockwork's request for declaratory relief invalidating plaintiff's copyright in Guide. Clockwork moved for judgment as matter of law, arguing no reasonable juror could have found plaintiff owned copyright, because Guide lacked independently created material and contained content taken from Clockwork's Manuals. District court denied Clockwork's motion and it appealed. Sixth Circuit held that jury reasonably concluded plaintiff owned valid copyright because Guide contained original material, and plaintiff's selection and organization choices met originality threshold for copyright protection. Although Guide contained content taken from Manuals, jury correctly concluded that plaintiff held valid copyright in parts of Guide that were not copied.

N.Y.C. Image Int'l v. RS USA Inc., No. 19-10355, 2020 U.S. Dist. LEXIS 193016 (S.D.N.Y. Oct. 16, 2020)

Plaintiff designed and sold apparel to retail shops in New York City, including "Vintage American Flag Design" ("Vintage Design") at issue, which had been featured on apparel since 2014. Plaintiff alleged that defendants infringed Vintage Design when they included it on apparel that they sold wholesale to retail shops in New York City. Defendants filed motion to dismiss, alleging that Vintage Design was not copyrightable because it was composed primarily of American Flag, which is in public domain, and, as such, did not demonstrate originality required for copyright protection. Court found elements of Vintage Design arranged together original: design showed distressed American flag and employed "unique" coloring, shading, highlighting, and tattered edge pattern. Court denied motion to dismiss.

Capstone Logistics Holdings, Inc. v. Navarrete, No. 17-4819, 2020 U.S. Dist. LEXIS 110304 (S.D.N.Y. June 23, 2020)

Court granted plaintiffs' motion for summary judgment on infringement claim. Over several years, one of plaintiffs and its predecessor developed MobilTrak, "workforce logistics data processing platform." One of defendants, with help of employees who were previously employed by one of plaintiffs, built similar platform, Genesis, in months. Court found that defendants used MobilTrak documents to create Genesis, citing, among other evidence, fact that side-by-side comparison of source codes showed examples of same lines of code and same errors throughout code. Defendants argued that plaintiffs' work was not original and that merger doctrine applied. Court, however, found that evidence in record supported finding that MobilTrak was original. Plaintiffs described in detail "creative choices" made throughout development of MobilTrak, as well as fact that program was written "from scratch." Plaintiffs further relied upon testimony and expert opinions to support argument that MobilTrak was original and incorporated creative choices by its builders. Court also found defendants' argument that merger doctrine applied unsupported and unavailing.

LA Gem & Jewelry Design, Inc. v. Groupon, Inc., No. 19-35, 2020 U.S. Dist LEXIS 165918 (C.D. Cal. Sept. 10, 2020)

District court granted plaintiff's motion for summary judgment on issues including validity of copyright and copying, and denied motion as to unlawful appropriation, secondary infringement and willfulness. Plaintiff jewelry company alleged defendants infringed two of its registered jewelry designs, which contained crescent moon and circle along with phrase "I love you to the moon and back." Defendants argued copyright registration was invalid because plaintiff failed to identify that its catchphrase and portions of its designs originated from book and pre-existing jewelry, respectively. District court found that defendants failed to provide any evidence that plaintiff had access to such materials. Defendants further asserted that plaintiff's registered copyrights were invalid for lack of originality, allegedly combining "common and trite elements" that could not be properly distinguished from prior works. However, defendants did not dispute plaintiffs' authorship of works at issue; thus sole issue to be decided regarding originality was whether designs at issue possessed minimal degree of creativity. District court held that designs at issue were original because they presented common phrase in unique font, with particularly arranged, darkened text in distinct manner.

B. Pictorial, Graphic and Sculptural Works

Zahourek Sys. v. Balanced Body Univ., LLC, 965 F.3d 1141 (10th Cir. 2020)

Circuit court found genuine issue of material fact existed as to whether work was useful article. Plaintiffs were creators of sculptural work called "Maniken," large human skeleton on which anatomy students can place clay to mimic tissues in body. Defendant purchased Manikens and used them to advertise and teach students about human anatomy. District court granted defendant's motion for summary judgment on infringement claim, finding

Maniken was useful article because it had “intrinsic utilitarian function that is merely to portray the appearance of a life-like form.” Plaintiffs appealed. Court found that “like a toy airplane or nose mask, the Maniken has utility only because it portrays the appearance of something (the human body).” Because Maniken accurately depicted human body, Maniken helped students learn human anatomy. Without accuracy, Maniken could be devoid of utilitarian function. Defendant erroneously assumed that Maniken must be useful article because it can serve as educational tool; however, “countless items” may be copyrightable despite their utility as educational tools. Court found issue of fact as to whether Maniken was useful article under statute and remanded case to district court for further proceedings.

Alper Automotive, Inc. v. Day to Day Imps., No. 18-81753, 2020 U.S. Dist. LEXIS 170628 (S.D. Fla. July 13, 2020)

District court granted plaintiff’s motion for partial summary judgment. Plaintiff manufactured and sold dash button sticker repair kits on Amazon.com. Defendant reported to Amazon that plaintiff’s stickers were infringing dash sticker designs owned by non-party Walters and licensed to Defendant. Plaintiff filed instant lawsuit seeking declaratory judgment that Walters’ copyright rights were not infringed and not valid. Defendant filed infringement counterclaim based on Walters’ representation that he owned copyright registrations for his dash sticker designs. At some point it became apparent that Walters registered wrong sticker sheet. Subsequently, new expedited application for correct sticker design was filed, which application was rejected by Copyright Office because design “lack[ed] the authorship necessary to support a copyright claim.” Court found that record evidence viewed in light most favorable to defendant established that design was uncopyrightable as useful article and was not expression of creativity and therefore not original. Truck recirculation icon on dash sticker was familiar automobile symbol depicted in basic form and not copyrightable. Moreover, court noted, icon and arrangement were “part and parcel with a utilitarian function and are not sufficiently ‘separable’ from its utilitarian purpose to be eligible for copyright protection.” Accordingly, court held truck icon and overall arrangement of sticker not copyrightable, and copying them cannot be infringement as matter of law.

C. Compilations and Derivative Works

VHT, Inc. v. Zillow Grp., Inc., No. 15-1096, 2021 U.S. Dist. LEXIS 45171 (W.D. Wash. Mar. 10, 2021)

Court denied defendant’s motion for judgment as matter of law following jury trial because plaintiff’s registration of works as compilation did not preclude damages award based on individual works within compilation. Jury held that defendant online real estate marketplace Zillow infringed plaintiff professional real estate photography studio’s copyrights and awarded statutory damages, finding that 19,312 of plaintiff’s images had independent economic value and that 3,373 of those images were infringed willfully. District court granted defendant’s motion for judgment notwithstanding verdict on 673 of willfully infringed images. On cross-appeals from various pre- and post-trial motions, Ninth Circuit

reversed district court's affirmation of jury's verdict on 2,700 of willfully infringed images and remanded for consideration of whether plaintiff's images were individual works or compilation under Copyright Act. On remand, district court held plaintiff's images, although group-registered as compilations with Copyright Office, did not comprise single "work" for statutory damages calculation because manner in which plaintiff issued its images (per-image basis) and independent economic value outweighed form of registration. Defendant moved for judgment as matter of law in its favor on ground that court's holding that plaintiff's images not compilation implicitly invalidated plaintiff's copyright registrations, in which plaintiff argued its images met compilation requirements. Court denied defendant's motion because status of each infringed image as "work" allowing separate statutory damages award did not affect status of plaintiff's database as whole and did not place plaintiff's copyright registrations at issue.

D. Miscellaneous

RJ Control Consultants, Inc. v. Multiject, LLC, 981 F.3d 446 (6th Cir. 2020)

Sixth Circuit affirmed district court's grant of defendant's motion for summary judgment on copyright infringement claim related to technical drawings, but reversed with respect to claim related to software code. Defendant, principal and sole shareholder of industrial control systems company, sought assistance from plaintiff, owner of engineering business, in developing control system for injection molding machine. Parties entered into oral agreement whereby plaintiff would develop control system for defendant, after which plaintiff completed and gave copies of diagrams and software source code to defendant. Defendant then hired different company for assembly and wiring of plaintiff's control systems. Plaintiff obtained two copyright registrations, one for technical drawings and one for software code, then brought copyright infringement claim against defendant for using copyrights without permission. District court granted defendant's motion for summary judgment without reliance on expert testimony, and plaintiff appealed. Sixth Circuit agreed with district court's assessment that manufacture of control system from technical drawing was not infringement because copyright protection extends to drawing itself, affording plaintiff exclusive right to prepare derivative works, distribute copies, and display drawings, but does not extend to use of those drawings to create useful article. Patent law, with its stricter standards requiring novelty, governs use protection. Accordingly, court affirmed lower court's determination that there was no infringement of technical drawings. However, lower court failed to analyze software code, and looked solely at copyrightability of technical drawings. In software context, analysis of doctrines of merger and *scènes à faire* requires technical expertise, making expert testimony desirable, if not required. In particular, understanding whether idea and expression have been merged requires line-by-line understanding of code, including what specific lines are functional and whether those are intertwined with expressive lines. Likewise, technical expertise needed to determine whether certain elements of program dictated by practical realities such as hardware or software standards, making such expression commonplace and uncopyrightable. Accordingly, court reversed district court's grant of defendant's motion for summary judgment regarding infringement of software and remanded for taking of additional evidence.

SAS Inst. Inc. v. World Programming Ltd., 496 F. Supp. 3d 1019 (E.D. Tex. 2020)

District court conducted copyrightability hearing and dismissed plaintiff's copyright claims because works asserted not shown to be copyrightable. Plaintiff offered software products for data management. Software allowed users to write commands in programming language developed by plaintiff. Defendant created software product that competed with plaintiff's. Plaintiff claimed copyright infringement because defendant used plaintiff's programming language to produce equivalent data output and similar graphical output. Because plaintiff alleged defendant copied non-literal elements, court determined adaption-filtration comparison test should be used to assess infringement. Defendant had burden to prove work unprotectible. Defendant successfully established that at least some asserted works were unprotectible because they were in public domain. Burden then shifted back to plaintiff to prove parts of work entitled to protection. Court concluded that plaintiff had not done filtration and thus, did not attempt to prove what defendant pointed to as unprotectible is entitled to protection. Court held that "copyright claims of SAS ... have not been shown to be copyrightable," and claims were dismissed.

III. OWNERSHIP

A. Works Made for Hire

Hubay v. Mendez, No. 19-1327, 2020 U.S. Dist. LEXIS 212251 (W.D. Pa. Nov. 13, 2020)

Plaintiff, Robert Losieniecki, photographed trip to DC to promote defendants' nonprofit group, Military Sexual Trauma Movement ("MSTM"). Parties disputed ownership of works; plaintiff Losieniecki argued that he owned photographs because he authored them, and defendants argued that photographs were owned by MSTM because Losieniecki served as office volunteer, and therefore works were made for hire. Parties filed cross-motions for preliminary injunctions, which were converted into cross-motions for declaratory judgment. Court found that because there was no writing designating photographs as "works made for hire," works could qualify as works made for hire only if created by employee within scope of employment. Unpaid volunteers for nonprofit organization, such as Losieniecki, were not employees because they were not "hired parties" under traditional agency-law principles. And even if *Reid* factors applied, Losieniecki was not employee. Accordingly, there was no legal basis for court to attribute authorship of works to MSTM, and court granted declaratory judgment in favor of Losieniecki.

Clancy v. Jack Ryan Enters., No. 17-3371, 2021 U.S. Dist. LEXIS 26553 (D. Md. Feb. 10, 2021)

District court denied defendants' summary judgment motion because issue of fact existed as to whether famous author was employee, such that his books were works for hire for entities he owned. Novelist Tom Clancy first introduced Jack Ryan character in book *Hunt for Red*

October in 1984. Under publishing agreement, Clancy assigned all rights to U.S. Naval Institute (“USNI”), which obtained copyright registration for *Hunt*. In 1985, Clancy and first wife Wanda King, with whom he had four children, formed Jack Ryan Enterprises Ltd. (“JREL”). JREL signed publishing agreements with Putnam representing that JREL was sole author of new Ryan works and appended guaranties signed by Clancy personally that foregoing works made for hire. Copyright registrations for JREL works listed JREL as author. In 1987, following dispute with USNI regarding ownership of Ryan character, USNI reassigned copyright to *Hunt* to Clancy; USNI thereafter assigned rights to *Hunt* to JREL. In 1992, Clancy and King formed Jack Ryan L.P. (“JRLP” and, with JREL, “JR Entities”) and signed further publishing agreements and guaranties with Putnam for subsequent Ryan works. Copyright registrations for JRLP works listed JRLP as author. In 1992 and 1994, Clancy entered into employment agreements with JR Entities confirming Clancy’s continued assignment to respective JR Entities of all rights in his works for each entity in exchange for compensation. In 1995, Clancy, as sole owner, formed Rubicon Inc. and entered into publishing agreements with Putnam for further works. In 1996, Clancy and King signed separation agreement that appended as Schedules A and B lists of literary works identified as respective assets of JR Entities. Separation agreement also provided that Clancy would assign to JR Entities any agreements relating to story lines or characters from respective JR Entities works but would otherwise be free to use characters from JR Entities’ works in subsequent works. Following Clancy’s death in 2013, Putnam proposed two posthumous works with Ryan and other characters, which would require agreement among JR Entities, Rubicon and Clancy’s Estate re proceeds distribution. In February 2014, Estate’s representative sent letter to Clancy counsel and counsel for King and her children, copying plaintiff Clancy’s second wife/surviving spouse, asserting that Ryan character owned by JREL and other characters owned by Rubicon. Plaintiff retained her own counsel and approved publication of first book proposed by Putnam. However, plaintiff subsequently requested documentation supporting conclusion that JREL owned Ryan character, in response to which Estate’s representative, in January 2015, provided plaintiff with, *inter alia*, USNI-related agreements. In March 2016, plaintiff served § 203(a) termination notice recapturing rights to *Hunt*, including all character rights. In August 2017, plaintiff filed declaratory judgment action against Estate’s representative, JR Entities and Rubicon seeking, *inter alia*, declaration of plaintiff’s ownership of Ryan and other characters as well as of Estate’s ownership of JR Entities works on ground that they were not works for hire and were not validly assigned to JR Entities (or, alternately, if works were validly assigned, that such assignments are terminable). JR Entities moved for summary judgment on ground that books at issue created by Clancy as works for hire for JR Entities because Clancy was employee of JR Entities. District court held that genuine factual dispute existed as to existence of employment relationship. On one hand, Clancy signed employment agreements with JR Entities so parties believed they were creating employment relationship. Moreover, JR Entities’ publishing agreements with Putnam represented that JR Entities were authors of works and were accompanied by Clancy’s personally signed guaranties that works were made for hire, while all copyright registrations for books stated that they were works for hire. Further, JREL paid for computer that Clancy used to write books, Clancy worked for both JR Entities for extended time, Clancy’s work was part of JR Entities’ regular business and Clancy received health benefits. On other hand, neither of JR Entities attempted to control

manner and means by which Clancy's books written and Clancy had complete autonomy as to what books to write and when to write them. Additionally, Clancy was co-owner of both JR Entities and there is no evidence that Clancy received regular salary or tax treatment of employee. However, even if works not for hire, Clancy clearly intended to transfer copyright ownership to JR Entities, given: publishing agreements' provision that each of JR Entities is "the" author and sole and exclusive owner; guaranties' confirmation of each JR Entity's ownership and work for hire status; separation agreement's lists of literary works as "assets" of JR Entities; and employment agreements with assignment provisions. Because parties agreed that, with exception of Ryan character as developed in *Hunt*, owner of copyrights in books would also own rights to characters developed within books, Clancy assigned rights in characters alongside those in books. However, because language in three USNI agreements ambiguous, issue of fact existed as to whether rights to Clancy character assigned to USNI or JREL alongside rights to *Hunt*, precluding decision on summary judgment.

B. Termination of Transfers

Waite v. UMG Recordings, Inc., 477 F. Supp. 3d 265 (S.D.N.Y. 2020)

District court denied plaintiffs' motion to amend complaint to add allegations regarding termination of agreements signed by defendants and plaintiffs' third-party representatives, but granted as to allegations regarding termination of "gap" grants (for works created after, but pursuant to agreements made before, January 1, 1978). In 1979, defendants record labels entered into agreements with third-party loan-out companies relating to assignment of plaintiffs' sound recordings ("Third-Party Agreements"), while plaintiffs signed accompanying inducement letters or declarations whereby plaintiffs agreed to give defendants same rights and/or assign copyrights if defendants ceased to be entitled to plaintiffs' sound recordings under main agreements. Plaintiff Ely also entered into 1976 agreement with defendants relating to three sound recordings ultimately recorded in in 1977, "after December 31, 1977," and 1980 ("Ely Agreement"). Ely sent termination notice to defendants regarding Ely Agreement that failed include execution date or otherwise indicate date on which works at issue were created. Plaintiffs brought suit alleging, in relevant part, that defendants ignored plaintiffs' valid termination notices as to Third-Party Agreements and Ely Agreement, thereby continuing to infringe plaintiffs' sound recordings after effective dates of termination. After court partially granted defendants' motion to dismiss, plaintiffs sought leave to amend to add allegations that, *inter alia*, plaintiffs could terminate Third-Party Agreements and Ely Agreement. Court held that, under § 203, only transfer executed by author (and not by author's loan-out company or other third party) was subject to termination, so plaintiffs could not terminate Third-Party Agreements. Inducement letters and declarations signed by plaintiffs alongside Third-Party Agreements were not independent transfers to defendants, but at best "a promise of future actions if certain contingencies came to pass." Therefore, adding allegations regarding these agreements to complaint would be futile. With regard to Ely Agreement, court held it was subject to termination under § 203 despite being "gap" grant, meaning it was grant "executed" prior to January 1, 1978 that related to works created after January 1, 1978. Specifically, court held that "executed," as used in § 203, meant "put into effect" because if work does not exist when parties enter into

grant agreement, there is no copyright that artists can transfer, assign or “put into effect.” Accordingly, “gap” grants like Ely Agreement terminable under § 203. Court also held that Ely’s failure to include execution or creation date in termination notice was “harmless” because not done with bad faith or intent to deceive or conceal, and defendants possessed information needed to identify relevant grant and works. However, Ely could amend complaint only as to two sound recordings created after January 1, 1978 because § 203 termination notice was clearly invalid as to 1977 sound recording

C. Joint Works and Co-Ownership

Moi v. Chihuly Studio, Inc., No. 19-35852, 2021 U.S. App. LEXIS 5921 (9th Cir. Mar. 1, 2021)

Ninth Circuit affirmed summary judgment for defendants and award of attorneys’ fees. Plaintiff, as assistant to defendant artist, along with other assistants occasionally added “dots and maybe some circles” to defendant’s art. Plaintiff alleged that he was co-author of 285 paintings, but could not identify specific contributions he made to them. Failure to identify independently copyrightable contribution defeated plaintiff’s claim. Additionally, even if plaintiff had identified contributions, he would not be co-author because (1) defendant controlled entire work, including plaintiff’s contributions, (2) there was no manifestation of shared intent to be co-authors between plaintiff and defendant, and (3) no evidence was presented that his elements contributed to market appeal of works. Ninth Circuit also affirmed grant of attorneys’ fees, agreeing that plaintiff’s paucity of supporting evidence and need for deterrence of baseless copyright claims justified award.

Williams v. Atlantic Recording Corp., No. 20-316, 2020 U.S. Dist. LEXIS 177556 (D. Del. Sept. 28, 2020)

Court granted defendant’s motion to dismiss because plaintiff failed to state claim for copyright infringement where defendant’s use of copyrighted works was authorized. *Pro se* plaintiff brought infringement action against various record labels, including Atlantic, Elektra, and Warner Music, alleging unauthorized licensing and/or sale of musical works jointly owned by plaintiff and another individual, Melissa Arnette Elliot. Defendants filed motion to dismiss, and plaintiff filed motion for leave to file second amended complaint. Court granted defendant’s motion without prejudice, finding that plaintiff’s argument that defendants infringed his copyrights when Elliot, co-owner of plaintiff’s copyrights, sold or licensed copyrights to defendants without plaintiff’s consent failed to state claim for infringement. Court determined that defendant’s exploitation of musical works under Elliot’s instruction was authorized use because, as co-owner, Elliot had unilateral right to permit license and/or sale of her joint interest without plaintiff’s consent. Licensee or assignee of Elliot’s joint interest would have been incapable of infringing plaintiff’s copyright. Court also determined that, although plaintiff could be eligible for profits generated by copyrights from other co-owner, any such accounting was “not cognizable in copyright infringement” because co-owner of plaintiff’s copyright may use works without

consent from plaintiff. In view of above, court granted defendants' motion to dismiss and denied plaintiff's motion to file second amended complaint.

D. Contracts and Licenses

Zuma Press v. Getty Images (US), 845 F. App'x 54 (2d Cir. 2021)

Second circuit affirmed summary judgment for defendant on infringement claim based on existence of valid license. Plaintiffs sued Getty alleging that Getty posted more than 47,000 of Zuma's images onto its website without authorization. Plaintiff Zuma had agreement with NewSport Photography whereby NewSport would upload images to Corbis photo licensing agency, and NewSport would redirect its royalty payments from Corbis (which were more favorable than Zuma's arrangement with Corbis) to Zuma. NewSport's agreement with Corbis provided for Corbis to assign its license to images, which Corbis invoked by selling its image portfolio, by way of intermediary transaction, to Getty. Reviewing this "unbroken chain of authorization" from Zuma to Getty, Second Circuit found that there was no reasonable dispute that Getty held valid license to use images.

MidlevelU, Inc. v. ACI Info. Grp., 989 F.3d 1205 (11th Cir. 2021)

Eleventh Circuit affirmed district court's holding that defendant could not succeed on implied license defense as matter of law. Plaintiff provided resources for midlevel healthcare providers, generating revenue through various resources and publishing free blog to attract potential customers. Plaintiff made full text (rather than only headlines and summaries) of its blog articles available in RSS feed and coded its website to allow search engines to copy and archive every webpage. Defendant wholesale aggregator of news publications created curated index of abstracts and full-text articles for thousands of academic blogs ("Index"). Defendant subscribed to plaintiff's blog's RSS feed and included, for each article in Index, bibliographic information, computer-generated summary, link to original, and (for subscribers only) link that opened original webpage with full-text content within Index website. Although defendant removed plaintiff's content from Index upon plaintiff's demand, plaintiff's content was still available through certain of defendant's subscribers, so plaintiff sued for copyright infringement. District court granted plaintiff's motion for summary judgment on defendant's implied license defense because defendant could not show that it created Index at plaintiff's request. On appeal, Eleven Circuit affirmed despite lower court's reliance on too-narrow test for implied license that addressed only work-for-hire situation. Essence of implied license is not creation of material at another's request, but owner's permission to use material in manner that would otherwise be unlawful. However, defendant failed to present evidence of industry practice that dissemination of content via RSS feed without restrictions implied permission to copy and publish that content on another website, nor did defendant show that plaintiff knew about such practice and permitted it. Plaintiff's permission to read its blog content through RSS feed for personal purposes (proverbial entry through shop's front door for business) did not imply permission to sell computer-generated summaries and embed full-text content on another website (proverbial entry through shop's back door to throw party inside).

On appeal from Court of Federal Claims, Federal Circuit agreed with court below that U.S. Navy had implied license to use copyrighted software, but found that Navy violated terms of implied license and thus committed copyright infringement. Plaintiff, producer of “software for rendering three-dimensional graphics,” between 2006 and 2012 entered into several contracts to license its software to Navy for use on its intranet system. At Navy’s request, plaintiff modified its software to avoid need for license key, and parties entered into series of agreements granting licenses for certain number of Navy users to use software. Although not memorialized in any contract, parties discussed using Navy’s “FlexWrap” software to allow Bitmanagement’s software to be installed (and thus, copied) on its entire network comprising “all 350,000+” Navy computers, but to limit number of simultaneous users of software to that permitted by license agreement (no more than 119 simultaneous users). FlexWrap monitoring software was not completely implemented, and thus Navy was not monitoring whether number of users exceeded license parameters. Plaintiff sued for infringement in Court of Federal Claims, which found that although plaintiff made out *prima facie* case of infringement and Navy’s use of software violated parties’ express agreements, there was nevertheless implied license that authorized Navy to copy software to its entire network. On appeal, Federal Circuit agreed with court below that plaintiff established *prima facie* infringement claim and that Navy possessed implied license, but found that Navy violated condition precedent of license by failing to implement FlexWrap monitoring software. Federal Circuit held that use of FlexWrap software was condition precedent of implied license, reasoning that use of monitoring software “rendered reasonable the otherwise objectively unreasonable decision of Bitmanagement to allow Navy to make unlimited copies of its commercial product.” Federal Circuit held that because use of FlexWrap software was condition precedent (and not covenant) of implied license, Navy’s failure to satisfy condition rendered plaintiff’s claim copyright infringement, and not breach of contract. In concurring opinion, Circuit Judge Newman agreed with Federal Circuit’s finding of infringement, but disagreed that Navy held implied license. Judgment vacated and remanded to Court of Federal Claims for determination of damages.

Elliott v. Cartagena, No. 19-1998, 2020 U.S. Dist. LEXIS 137088 (S.D.N.Y. July 31, 2020)

District court denied defendants’ motion for summary judgment, finding that no admissible evidence established that plaintiff contractually gave up all rights to work at issue. Plaintiff rapper p/k/a “Fly Havana” sued group of defendants including rappers Fat Joe, French Montana and Remy Ma, alleging that their co-authored hit song “All the Way Up” was also authored by plaintiff, who was not named as author of song. Shortly following song’s release, plaintiff and Fat Joe met in IHOP restaurant, where Fat Joe gave plaintiff check for \$5,000 (with word “write” in memo line) and plaintiff signed “piece of paper” which defendants alleged transferred copyright to defendants. Plaintiff contended, and defendants disputed, that “piece of paper” provided for plaintiff to receive royalties. Plaintiff sued for infringement, but no party could produce signed copy of “piece of paper.” Fat Joe’s attorney produced document alleged to be draft version of agreement, which Fat Joe allegedly printed

without changes and had plaintiff sign. Defendants argued that draft copy should be admitted under “best evidence” rule for purposes of summary judgment motion. Finding that defendants bore burden under best evidence rule to prove loss or destruction of “piece of paper,” court denied motion for summary judgment pending further efforts to obtain sworn statement from document’s potential custodian, but gave defendants leave to renew motion after securing admissible testimony from potential custodian concerning document.

Bass v. Syracuse Univ., No. 19-566, 2020 U.S. Dist. LEXIS 152607 (N.D.N.Y. Aug. 24, 2020)

Court granted in part and denied in part motion for partial summary judgment. Plaintiff photographer alleged that defendant Syracuse University infringed his copyright in photographs he took of University’s men’s basketball players, including Oshae Brissett and Tyus Battle, when it exceeded scope of oral license plaintiff granted defendant when defendant used photos of Brissett and Battle on billboard in November 2018 and used photos in “third-party cross-promotional materials.” Plaintiff alleged that license only covered University’s social media accounts and did not include “commercial billboards” or other commercial purposes, while defendant claimed license was unrestricted. Plaintiff moved for summary judgment on infringement and defendant’s affirmative defenses. Court found infringement claim could not be decided on summary judgment as there were material issues of fact as to scope of license granted to University. University representative disputed plaintiff’s claim that license was only for social media, and argued that even if plaintiff did place restrictions on use of photos, failure to object to use until months after he saw billboard was part of pattern of conduct that could be interpreted as implied license. Lack of objection from plaintiff, even after he was aware of billboard, also caused court to deny motion for summary judgment on defendant’s affirmative defenses of waiver, equitable estoppel, and ratification. Court found that reasonable juror could conclude that plaintiff’s conduct implied that he had granted permission for use of photographs on billboard. Motion for summary judgment therefore denied.

Yellowpages Photos, Inc. v. YP, LLC, No. 17-764, 2020 U.S. Dist. LEXIS 108293 (M.D. Fla. June 19, 2020)

Court granted summary judgment in favor of defendant Print Media LLC. Plaintiff, who licensed images to publishers of yellow-pages directories, entered into 2006 license agreement with Print Media’s predecessor, which granted predecessor and all affiliates right to use plaintiff’s stock images in yellow-pages directories and advertising materials. Agreement specifically authorized use of images in renewals, republications, and reprints of advertisements, if such image was “used in an end-client’s directory advertisement prior to termination.” After series of ownership changes, defendant Print Media took over publishing functions of “The Real Yellow Pages” from YP. Plaintiff subsequently brought infringement claims against defendants YP and Print Media, alleging that defendants’ use of copyrighted images in “The Real Yellow Pages” was unauthorized. In response, Print Media moved for summary judgment, arguing that (a) copyrighted images were encompassed by original license agreement, which “authorizes use of an image in renewal, republication, and reprint

of an advertisement,” and (b) “all disputed advertisements containing [p]laintiff’s copyrighted images were renewals, republications, or reprints of authorized advertisements.” Plaintiff argued that defendant’s advertisements were not authorized renewals, reprints, or republications because (a) “YP did not publish the directories containing the advertisements prior to Print Media taking over the publication of directories,” and (b) “many of the advertisements contain differences from the prior publications that prevent them from qualifying as renewals, reprints, or republications.” Court found plaintiff’s arguments were without merit. Court determined that YP published advertisements containing disputed images prior to Print Media publication, and because license allowed YP to use images, images could also be in renewals, republications, and reprints of original advertisement. Court also acknowledged small differences in ads. Court determined that each use qualifies as renewal, reprint, or publication because “only reasonable reading” of license agreement “allows minor formatting and size changes in reprints, renewals, and republications as long as the reprint, or renewal, or republication is the same advertisement for the same client.” Accordingly, court held that Print Media was entitled to summary judgment on plaintiff’s infringement claim, as Print Media’s use fell within scope of license between plaintiff and defendants’ predecessor.

Panda Paws Rescue v. Walters, No. 20-5700, 2021 U.S. Dist. LEXIS 1615 (W.D. Wash. Jan. 4, 2021)

Court granted in part and denied in part defendant’s amended motion to dismiss. Plaintiffs were non-profit animal rescue organization, Panda Paws, and entity’s president, and defendant was former director and chairman of plaintiff entity. Defendant filmed and photographed content for Panda Paws’s social media sites and, with individual plaintiff, collaborated on content for Panda Paws’s YouTube channel and logo. Defendant was removed from Panda Paws by board, which also requested control over Panda Paws’s websites. Plaintiff later learned that defendant had removed its logo from YouTube channel and replaced with defendant’s brand. Defendant alleged that he was author and owner of YouTube channel and its content, and that he had revoked implied nonexclusive license for Panda Paws to use YouTube channel, its content, and logo. In alternative claim for relief, Panda Paws sought declaratory judgment that license provided by defendant for plaintiff’s use was irrevocable. Court found that license granted by defendant was irrevocable because consideration was provided by plaintiff to defendant; specifically, defendant’s provision of services to Panda Paws as officer, Panda Paws’s occasional provision of camera equipment, and Panda Paws’s use of defendant’s company’s technology services constituted consideration. Court denied motion to dismiss Panda Paws’s declaratory judgment claim that defendant granted plaintiff irrevocable implied license.

E. Miscellaneous

Russell v. Walmart Inc., No. 19-5495, 2020 U.S. Dist. LEXIS 163430 (C.D. Cal. Aug. 17, 2020)

Plaintiff, sculptural artist who designed and sold pendant lights that resembled jellyfish, alleged that copyrighted images of her lamps appeared on Walmart Marketplace and that copies of her lamps were sold and shipped by Walmart. Plaintiff moved for summary judgment. Defendant claimed plaintiff was not author of images, but court disagreed, as plaintiff marshaled evidence of ownership: photographer testified that plaintiff was sole author, and plaintiff submitted supplemental declarations wherein she stated she exercised control, edited, and made all creative decisions regarding photos. Summary judgment granted to extent that plaintiff was determined to be author and owner of copyrighted photographs. However, court determined defendant raised genuine dispute of material fact regarding responsibility for posting photographs, and summary judgment was denied in that regard.

IV. FORMALITIES

A. Registration

Foss v. Marvic Inc., 994 F.3d 57 (1st Cir. 2021)

Plaintiff graphic designer in 2006 created brochure for defendant to use in marketing its sunrooms, for which she was paid \$3,000. Plaintiff claimed that in 2016 defendant began using modified version of brochure without requesting or receiving her permission. In 2017 plaintiff sent letter to defendant demanding “payment for lost wages and copyright infringement,” and invoice for \$264,000 in compensation for defendant’s alleged copyright infringement over 11-year period, and in 2018 filed suit for copyright infringement. Defendant moved to dismiss on ground that plaintiff failed to establish that she had registered copyright, as required under § 411(a). District court stayed case pending Supreme Court’s decision in *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, in which Court held that registration occurs “not when an application for registration is filed, but when the Register has registered a copyright after examining a properly filed application.” District court lifted stay and entered order dismissing copyright claim. First Circuit affirmed dismissal. Plaintiff argued on appeal that district court, instead of dismissing copyright claim, should have stayed claim pending Copyright Office’s registration decision. However, plaintiff “never asked the district court for any such stay and so has waived this argument.” Plaintiff argued further that failure to register copyright before filing suit could be and later was cured, making dismissal improper. However, plaintiff did present argument in district court, or move for relief from district court’s judgment, instead filing appeal. Because there was no evidence in record that plaintiff had registered copyright when district court issued its order of dismissal, there was no error in its ruling.

Feingold v. RageOn, Inc., 472 F. Supp. 3d 94 (S.D.N.Y. 2020)

Plaintiff photographer was author of two photographs, one of Madonna holding red lollipop against her tongue, which appeared in plaintiff's 2008 unpublished book, and other of Keanu Reeves, which appeared in 1989 issue of *Rolling Stone*. In 2018, plaintiff learned that RageOn.com, site that allowed individuals to design merchandise and sell wares through RageOn marketplace, was displaying works online without authorization. Parties disputed plaintiffs' ownership of valid copyrights, and cross-moved for summary judgment. On Madonna photograph, defendant argued that work was not protected because, although registered as part of unpublished collection, work was previously published and therefore fell outside scope of registration. Court, however, found that defendant presented no evidence photograph appeared in 1982 magazine, and that mere display of work on 2006 fan blog did not constitute publication. On Reeves photograph, defendant argued that because plaintiff lacked certificate of registration, she was unable to show that registration number correlated with work. Court, however, found that plaintiff established that she owned valid copyright for photo because Public Records Catalog showed registration protected "photoprint" owned by plaintiff titled "Keanu Reeves," which appeared in *Rolling Stone* on March 9, 1989 on page 31, and corresponding issue of magazine contained work at issue. Moreover, plaintiff obtained certified copy of deposit copy of work, and it was Reeves photo. Finding no genuine dispute with respect to defendant's actual copying and appropriation, court granted plaintiff's motion for summary judgment and denied defendant's motion for summary judgment.

Phillies v. Harrison/Erickson, Inc., No. 19-7239, 2020 U.S. Dist. LEXIS 206749 (S.D.N.Y. Nov. 4, 2020)

Defendant Harrison/Erickson requested that court submit § 411(b)(2) letter to Copyright Office to answer if images of Phanatic were submitted with Plaintiff's copyright application, if Phanatic should have been classified as "artistic sculpture," and whether referring to Phanatic as "artistic sculpture" was in line with Office practices at time. As requirement to making referral, litigant must show that "registration application included inaccurate information." Parties disagreed whether application contained "inaccurate information," and accordingly court dismissed request for § 411(b)(2) letter because statutory conditions for request to Office had not been satisfied.

Boesen v. Dimoro Enters., LLC, No. 20-354, 2020 U.S. Dist. LEXIS 183927 (N.D.N.Y. Oct. 5, 2020)

District court denied plaintiff's motion for default judgment stemming from allegedly infringing use of plaintiff's photograph on defendant's website. Plaintiff took photograph of tennis player Caroline Wozniacki, which was allegedly used by defendant on its website without permission. Plaintiff initiated action for infringement and sought default judgment. Plaintiff asserted that photograph was registered, and indicated registration number in complaint, but failed to produce copyright registration certificate. Court found that plaintiff

thereby failed to satisfy first element of copyright infringement claim, i.e., ownership of valid copyright. Court denied motion for default judgment with leave to renew.

UAB “Planner5D” v. Facebook, Inc., No. 19-3132, 2020 U.S. Dist. LEXIS 133542 (N.D. Cal. July 24, 2020)

Plaintiff operated home design website that allowed users to create virtual interior design scenes using library of virtual objects to populate scenes. Plaintiff claimed that it owned copyrights in three-dimensional objects and scenes, and in compilation of objects and scenes, that works were “authored in Europe or Russia,” and “neither Planner 5D nor any individual object modelers are nationals, domiciliaries, or habitual residents of the U.S., or legal entities with headquarters in the U.S.” Plaintiff alleged that defendants scraped over 48,000 files from its servers, and sued alleging copyright infringement. Court granted defendants’ previous motion to dismiss because plaintiff failed to meet threshold requirement of § 411(a) to plausibly allege that works were either registered as “United States works” or exempted from registration as “non-United States works.” Court accordingly granted motion to dismiss with leave for plaintiff to amend. Plaintiff filed applications and Copyright Office issued two registration certificates, for objects and scenes, and filed amended complaint. Defendants filed second motion to dismiss, arguing that plaintiff did not register works it alleged were infringed. Complaint alleged that downloading of works occurred in 2016, but registration certificates stated that works were completed and first published in 2019. Plaintiff argued that record showed that registrations covered objects created from 2011 through 2019 and scenes created from 2012 to 2019, and accordingly covered all of objects and scene compilations scraped from its website in 2016. Court “suspect[ed] that is what Planner 5D intended to do with its application but [could] not conclude that is what the Copyright Office granted when it issued the registration certificates, which clearly state that the year of completion is 2019.” Defendants’ motion to dismiss was granted, with leave for plaintiff to file new applications for all works at issue with correct publication and completion dates.

NRA v. Ackerman McQueen, Inc., No. 19-2074, 2020 U.S. Dist. LEXIS 168141 (N.D. Tex. Sept. 14, 2020)

District court granted in part and denied in part defendant’s motion to dismiss plaintiff’s copyright infringement claim because plaintiff did not obtain copyright registrations before filing suit. Plaintiff used defendants as its advertising and public relations agency for more than 30 years. Parties terminated services agreement and plaintiff alleged that defendant continued to prominently feature plaintiff’s photos on its website. Plaintiff asserted eight claims for relief, among them copyright infringement. Defendants moved to dismiss claims, and court granted motion to dismiss copyright claim because plaintiff conceded it did not comply with requirement under Supreme Court’s holding in *Fourth Estate* to register copyrights in any copyrightable material relevant to lawsuit prior to filing suit.

Goode Time Prods., L.L.C. v. Just, No. 19-58, 2020 U.S. Dist. LEXIS 167956 (E.D. Tex. Sept. 14, 2020)

Plaintiff Goode Time Productions, Christmas caroling company, alleged that defendant, founder and owner of competitor caroling company, copied and performed plaintiff's show consisting of sound recordings, compilation of songs, and script. Plaintiff moved for summary judgment. Defendant argued that plaintiff's suit was prohibited under § 411(b)(1) due to alleged inaccuracies on registration. However, court found defendant did not support argument that plaintiff knowingly made false representations on registration, and therefore declined to refer question of materiality to Register of Copyrights; specifically, there was no record evidence that registering script as unpublished, despite being published, indicated plaintiff knowingly misled Copyright Office. Additionally, although court found no genuine issue of material fact as to ownership and copying of sound recordings, because script was published more than five years prior to registering script with Copyright Office, registration was not *prima facie* evidence of ownership of valid copyright. While plaintiff contended that its founders authored script and conveyed copyright to plaintiff, record evidence was insufficient to prove authorship. Court granted in part and denied in part plaintiff's motion for summary judgment.

V. INFRINGEMENT

A. Access

Batiste v. Lewis, No. 19-30400, 2020 U.S. App. LEXIS 30346 (5th Cir. Sept. 22, 2020)

Fifth Circuit affirmed district court's grant of summary judgment dismissing infringement claim based on lack of evidence of access. Plaintiff New Orleans jazz musician sued hip-hop duo Macklemore and Ryan Lewis, claiming several of their songs, including hit "Thrift Shop," included samples of his recorded songs. Plaintiff tried to prove access through alternative "widespread dissemination" and "chain of events" theories. To support widespread dissemination theory, plaintiff must show that work has enjoyed considerable success or publicity, typically demonstrated through frequent airplay, record sales, awards, royalty revenue and success on billboard charts. Here, plaintiff's evidence only showed meager sales in handful of local New Orleans stores, and minimal online streaming of songs (most of which occurred after several allegedly infringing songs had been released by defendants). On "chain-of-events" theory, plaintiff argued that defendants once performed in New Orleans venue located "not too far" from record store that sold plaintiff's music. In view of weak evidence of access and sworn testimony by defendants that they did not visit record stores in New Orleans or listen to plaintiff's music, Fifth Circuit affirmed summary judgment for defendants on lack of access.

Carlini v. Paramount Pictures Corp., No 19-8306, 2021 U.S. Dist. LEXIS 46481 (C.D. Cal. Feb. 2, 2021)

District court dismissed copyright infringement claim, finding plaintiff failed to plead access. Plaintiff claimed that Paramount movie *What Men Want*, sequel to *What Women Want*, infringed plaintiff's unproduced script for *What the F Is He Thinking?*, both of which involved woman gaining power to hear men's thoughts. Court found that plaintiff failed to allege access through chain of events, in form of evidence that third party with whom both plaintiff and defendant were dealing had possession of plaintiff's work, and failed to allege sufficient facts to show that script was widely disseminated – in this case, facts showing that material sufficiently “saturated” relevant local market for period of time and that defendant “routinely participated” in market during that period.

Washington v. ViacomCBS, Inc., No. 20-435, 2020 U.S. Dist. LEXIS 188005 (C.D. Cal. Aug. 20, 2020)

Court granted motion to dismiss. Plaintiff was author of screenplay *#SquadGoals*. Defendant aired episode *Her Own Two Feet* as part of television series *Bull* and disseminated press release describing proposed television remake of *Clueless*. Plaintiff alleged defendant's *Bull* episode and proposed *Clueless* remake infringed plaintiff's copyright *#SquadGoals*. Defendant moved to dismiss. Court found plaintiff failed to allege access to her work. Plaintiff alleged she submitted treatment to third party, Imagine, who worked with ViacomCBS. However, plaintiff did not allege that ViacomCBS received work. Court also found that plaintiff failed to allege substantial similarity between *#SquadGoals* and *Bull* Episode. While protagonists of both works had similar names, occupations, and backgrounds, there were major differences in plot, theme and style between works. Court granted defendants' motion to dismiss.

Love v. Nuclear Blast Am., No. 20-124, 2020 U.S. Dist. LEXIS 187765 (C.D. Cal. Aug. 19, 2020)

District court denied defendant's motion to dismiss copyright infringement claim because complaint sufficiently alleged that defendant had access to plaintiff's works. In 2013, plaintiff songwriter for heavy metal band We Are The End shared demo versions of two songs (“Songs”) with then-bandmate defendant. In summer 2019, defendant new band Rings of Saturn released recordings containing “complex melodic sequence” and “dominant musical phrase” directly copied from plaintiff's Songs. In October 2019, plaintiff registered copyrights in Songs, listing 2014 as year of completion. Defendant moved to dismiss infringement claim, arguing that he could not have accessed Songs because defendant had no contact with plaintiff between 2013 and 2019. After taking judicial notice of registration certificates, court held that, although certificates list 2014 as year of completion, complaint alleged that plaintiff demo recordings shared in 2013 were identical to registered Songs; therefore plaintiff sufficiently alleged access by defendant. Moreover, even if plaintiff committed “honest oversight” in preparing copyright applications, this would not render certificates invalid.

Smith v. Weeknd, No. 19-2507, 2020 U.S. Dist LEXIS 130549 (C.D. Cal. July 22, 2020)

Plaintiffs brought suit against performer known as The Weeknd and others who contributed to creation, publication, and distribution of composition “A Lonely Night,” alleging that it infringed plaintiffs’ work “I Need to Love.” In 2005, plaintiffs transferred rights in composition to Big Life Music Limited, and work was uploaded to database where executives in music industry could search Big Life Music’s catalogue by keyword and genre. In 2008, Universal Music Publishing Limited acquired Big Life Music, which in 2016 relinquished rights in “I Need to Love” back to plaintiffs. Plaintiffs argued that one of writers of “A Lonely Night” was producer for Universal and had access to plaintiffs’ works. Writer was not present when defendants’ work was composed, recorded, or mixed, but was credited as writer because “A Lonely Night” included portion of vocal melody and lyrics from earlier unfinished work he wrote with The Weeknd. Writer also was not affiliated with Universal Music Corp. until after collaboration with The Weeknd on unfinished work. Defendants moved for summary judgment on grounds that defendants lacked access to plaintiffs’ work and that works were not substantially similar. On access, court found plaintiffs did not put forth evidence that anyone who created “A Lonely Night” accessed plaintiffs’ work from database; moreover, database was searchable by lyrics, and lyrics of two works were not similar. In sum, plaintiffs did not establish anything more than possibility of “bare corporate receipt” of plaintiffs’ work, which was insufficient to prove access. Court granted defendants’ motion for summary judgment on direct infringement and, consequentially, on theories of secondary liability.

B. Copying and Substantial Similarity

Abdin v. CBS Broad., Inc., 971 F.3d 57 (2d Cir. 2020)

Second Circuit affirmed district court’s dismissal of complaint. Plaintiff filed suit against Defendant alleging that Defendant’s television show *Star Trek: Discovery* infringed its 2014 videogame *Tardigrades*. Plaintiff’s videogame, set in 20,000 B.C.E., featured tardigrades, based on real microscopic eight-legged animals that can survive in space, and that are commonly used in science fiction. Defendant’s 2017 *Star Trek: Discovery* was successful TV series that followed U.S.S. Enterprise as it traveled through space in 2200 C.E. Plaintiff alleged that defendants copied videogame, specifically tardigrades, plot, mood, and overall feel. Court found no substantial similarity between protectible features of plaintiff’s videogame and defendant’s show. Of 15 episodes of show, only three included tardigrades. Court affirmed lower court’s decision to dismiss complaint for failing to plausibly allege substantial similarity between plaintiff’s videogame and defendant’s show.

Montgomery v. NBC TV, 833 F. App’x 361 (2d Cir. 2020)

Second Circuit affirmed dismissal of plaintiff’s suit alleging that *Rosemary’s Baby* miniseries infringed her two short stories based on failure to state claim. Court held that total concept and overall feel of miniseries was very different from plaintiff’s two short stories.

Plaintiff's stories were (1) naturalistic character sketch closing with disappearance of narrator's friend after moving in with pair of elderly Nazis, and (2) opening portion of Nazi-hunting thriller. Miniseries was horror story in which group of Satanists used supernatural powers to commit murders and rape. Any similarities – such as interracial friendship, investigation, disappearances in 1980s, strange photograph, and use of common phrases – were merely random similarities scattered throughout works. Such common concepts and phrases were not original to plaintiff, and not copyrightable.

Amanze v. Adeyemi, 824 F. App'x 86 (2d Cir. 2020)

Second Circuit affirmed dismissal of complaint in summary order. *Pro se* plaintiff, author of self-published novel *Banished*, alleged that Tomi Adeyemi's best-selling *Children of Blood and Bone* infringed her work by copying characters, plots, and themes. District court examined works, found that "at anything but the most abstract levels of generality, the two works are nothing alike, let alone substantially similar," and granted defendants' motion to dismiss. Plaintiff appealed. Second Circuit's *de novo* review of works confirmed that works were not substantially similar as matter of law: books had different plots, characters, themes, and settings, and differed in terms of "overall concept and feel." Similarities between works, "such as the existence of magic, love, royalty, and evil" were *scènes à faire* and not protectible. Plaintiff similarly failed to satisfy fragmented literal similarity test because she did not point to any "direct quotations or close rephrasing." Because amendment would be futile, Second Circuit affirmed dismissal of complaint with prejudice.

Corbello v. Valli, 974 F.3d 965 (9th Cir. 2020)

Ninth Circuit affirmed district court's post-trial order granting judgment as matter of law for defendants, finding that *Jersey Boys*, musical play depicting history of popular music quartet Four Seasons, did not infringe Four Seasons band-member Tommy DeVito's autobiography, co-written by plaintiff's deceased husband. Plaintiff sued band members and individual involved in production of play for infringement, arguing that DeVito shared unpublished autobiography with people involved in play and, consequently, parts of play were taken directly from autobiography. District court concluded that no similarities identified between play and autobiography were actionable because each similarity involved only non-protectable, historical elements and, therefore, failed extrinsic test for substantial similarity. Ninth Circuit agreed, reasoning that, "although books generally contain the author's creative expression, protectable by copyright, a nonfiction biography like the work in this case is necessarily structured around historical facts and events, not themselves copyrightable." Further, Ninth Circuit found that copyright estoppel, which "we will refer to ... as the 'asserted truths' doctrine," applied to several identified similarities. Under doctrine, elements of work presented as factual are treated as fact, even if party claiming infringement contends that elements are actually fictional. Because text of work explicitly represented its account as historically accurate, not historical fiction, plaintiff could not then claim in litigation that parts of work were fictional and, as such, entitled to full copyright protection. Ninth Circuit emphasized that doctrine applied to any elements held out as factual, regardless

of whether or not elements were actually factual; “even dubious assertions of truthfulness can prevent an author from later claiming that part of a work is fiction.”

Astor-White v. Strong, 817 Fed. App’x 502 (9th Cir. 2020)

Ninth Circuit affirmed district court’s Rule 12(b)(6) dismissal of amended complaint for copyright infringement. Plaintiff claimed Fox television series *Empire* infringed plaintiff’s copyrighted treatment for television series *King Solomon*. District court concluded that plaintiff’s amended complaint failed to allege that defendant actually copied and unlawfully appropriated plaintiff’s work. Plaintiff appealed. Ninth Circuit held that plaintiff had failed to allege actual copying, noting that plaintiff’s work had been shared with only three people and was not widely disseminated. Plaintiff had thus not established that defendant had reasonable opportunity or possibility of viewing plaintiff’s work. Plaintiff also did not plead similarities that would have been probative of copying. Ninth Circuit further held that plaintiff failed to allege unlawful appropriation because works shared forms of literary expression not protectible as matter of law but did not share similarities of protectible expression. Ninth Circuit therefore affirmed district court’s dismissal of amended complaint, concluding that plaintiff’s and defendant’s works shared only unprotectible “ideas and concepts, material in the public domain, and *scènes à faire*.”

Zindel v. Fox Searchlight Pictures, Inc., 815 F. App’x 158 (9th Cir. 2020)

Ninth Circuit reversed district court’s grant of motion to dismiss. Plaintiff, son of Paul Zindel, author of play *Let Me Hear You Whisper*, brought suit alleging that defendant’s film and book *The Shape of Water* infringed father’s work. District court granted motion to dismiss, holding that works were not substantially similar as matter of law. Court found reasonable minds could differ on whether there was substantial similarity between *Let Me Hear You Whisper* and *The Shape of Water* and that additional evidence and objective literary analysis were needed to determine extent and qualitative importance of similarities. Accordingly, grant of motion to dismiss was premature.

Masterson v. Walt Disney Co., No. 19-55650, 2020 U.S. App. LEXIS 24394 (9th Cir. Aug. 3, 2020)

Ninth Circuit affirmed district court’s dismissal of plaintiff author’s infringement claim against defendant Walt Disney Co. Plaintiff alleged that Disney’s animated film *Inside Out* violated her copyrights in her book of poetry and movie script that features cloud-like character named Mr. Positively, who introduces four children to “various anthropomorphic doors that are associated with a different feelings.” Disney’s *Inside Out* tells story of child and anthropomorphized emotions that live inside of her. District court granted defendant’s motion to dismiss on grounds that works were not substantially similar. Plaintiff appealed. Ninth Circuit affirmed district court’s decision, rejecting plaintiff’s argument that substantial similarity between literary works cannot be resolved in motion to dismiss. Ninth Circuit held that plaintiff failed to plausibly allege that her book and Disney’s *Inside Out* were substantially similar. In applying “extrinsic test,” court determined that alleged similarities between works were unprotectible, namely (1) shared theme of “every feeling hav[ing] a

reason,” (2) fact that works both involved journey through childhood emotions, and (3) presence of anthropomorphized emotion characters. Court also found that combination of “unprotectable elements fail[ed] to show any cognizable similarity,” noting that, although such combination can sustain claim of substantial similarity if author creates “new arrangement of unprotectable elements and the allegedly infringing work [shares] substantial amounts of that same combination,” here similarities between works were “more like random similarities scattered throughout the works, of which this court has been particularly cautious.” Accordingly, plaintiff failed to allege substantial similarity. Ninth Circuit also determined that plaintiff waived any claim of copyright infringement of her movie script because she failed to address district court’s determination that she failed to allege access in appeal.

Alfred v. Walt Disney Co., No. 19-55669, 2020 U.S. App. LEXIS 22865 (9th Cir. July 22, 2020)

Ninth Circuit reversed district court’s dismissal of complaint and remanded for further proceedings. Plaintiffs alleged that defendant’s film *Pirates of the Caribbean: Curse of the Black Pearl* was substantially similar to their screenplay. District court noted some similarities between films but dismissed complaint primarily because it concluded that many elements in common between plaintiffs’ and defendants’ works were “unprotected generic pirate-movie tropes.” Noting that at pleading stage district courts should apply only extrinsic test for similarity, Ninth Circuit held that works at issue contained sufficient similarities to overcome motion, including prologue that takes place 10 years prior to main story, skeleton crews, focus on redemption of young rogue pirate, and other similarities. Ninth Circuit further held that district court had erred by failing to compare original selection and arrangement of unprotectible elements between works at issue, and by concluding that elements in common were unprotectible. Ninth Circuit suggested that expert testimony would aid in determining whether plaintiffs’ alleged similarities between works at issue were qualitatively significant, and reversed dismissal.

Dig. Drilling Data Sys., L.L.C. v. Petrolink Servs., 965 F.3d 365 (5th Cir. 2020)

On appeal from summary judgment motion, Fifth Circuit affirmed district court’s holding that defendant’s database was not substantially similar to, albeit in part directly copied from, plaintiff’s. Plaintiff and defendant both provided software used by oil and gas operators to collect, filter (and, in plaintiff’s case, correct), log and visualize data from downhole drills. Plaintiff’s software program, which was designed to run only on laptops with USB security dongle inserted, logged corrected data into open source database program in which plaintiff created its own schema (i.e., relational structure) consisting of 27 interrelated tables and accessible via database program’s default, publicly available credentials. After obtaining laptop running plaintiff’s program and associated security dongle and accessing plaintiff’s database using default credentials without plaintiff’s authorization, defendant developed scraping program to copy some corrected data from plaintiff’s database for use in defendant’s visualization program. Plaintiff sued defendant for infringement. District court granted defendant’s summary judgment motion because, although plaintiff’s ownership of

valid copyright in its database schema and defendant's factual copying of five percent of that schema were undisputed, plaintiff failed to show substantial similarity between parties' respective works. Fifth Circuit affirmed, holding plaintiff's argument that copied portion was "qualitatively important" to its overall program was waived because plaintiff initially raised it in reconsideration motion, but anyway failed on merits because plaintiff failed to point to evidence establishing that copied portion was more than arbitrary, let alone important. Though corrected data in plaintiff's database was important to plaintiff's program, it was not copyrightable, and thus irrelevant to analysis.

Batiste v. Lewis, No. 19-30400, 2020 U.S. App. LEXIS 30346 (5th Cir. Sep. 22, 2020)

Fifth Circuit affirmed district court's grant of summary judgment based on lack evidence of copying or substantial similarity. Plaintiff New Orleans jazz musician sued hip-hop duo Macklemore and Ryan Lewis claiming several of their songs, including hit "Thrift Shop," included samples of his recorded songs. Since plaintiff was unable to demonstrate that defendants accessed his songs, claims were subject to elevated standard of "striking similarity." Plaintiff's evidence of similarity consisted of expert report (which district court excluded because it was not written by expert, but rather ghost-written by plaintiff) and sound recordings themselves, which court found dissimilar after listening to respective recordings. Rather than supporting theory of striking similarity, plaintiff argued that "overwhelming evidence of access" meant he needn't show any similarity, and that copying should be presumed. Plaintiff relied on Sixth Circuit decision *Bridgeport Music, Inc., v. Dimension Films*, "which adopted a bright-line rule that any unauthorized sampling of a sound recording, no matter how trivial, is infringement." Fifth Circuit here criticized Sixth Circuit's reasoning in *Bridgeport*, but held that even were *Bridgeport* rule to apply, award of summary judgment in favor of defendant was still proper. In *Bridgeport*, defendants admitted that they sampled sound recordings, whereas in this case defendants denied copying/sampling, and plaintiff's evidence of copying was weak. In view of lack of proof of copying (either factual or actionable), summary judgment for defendants affirmed.

Dubay v. King, 844 F. App'x 257 (11th Cir. 2021)

Eleventh Circuit affirmed district court's grant of summary judgment for defendant, finding no substantial similarity as matter of law. Plaintiff, nephew of author of comic book series *The Rook*, brought infringement suit against Steven King and his corporate partners, alleging that protagonist of *The Dark Tower* novel and media series, Roland Deschain, was copy of *Rook* protagonist Restin Dane. Court found that character names do not enjoy copyright protection, and that character elements such as Western attire, time travel, and knightly heritage are *scènes à faire*. Remaining potentially protectible elements in common between characters (bird companion, relationship to tower, saving young boy from different time) are only similar in abstract, and are portrayed in different ways. For example, Dane's tower is his home and time machine, but Deschain's tower is goal of his quest, and not time machine. Dane themes his clothing after birds (he is "the Rook"), but Deschain allies with, sacrifices, and symbolically becomes bird. Dane saves his great-grandfather in past when great-

grandfather was young boy, while Deschain saves, but later betrays and sacrifices, unrelated young boy. Taking broader look at characters as opposed to individual elements, Dane is traditional comic book hero who always does right thing, and Deschain is troubled anti-hero seeking redemption. District court, accordingly, did not err by granting King's motion for summary judgment.

Vallejo v. Narcos Prods. LLC, 833 F. App'x 250 (11th Cir. 2020)

Circuit court affirmed trial court's grant of summary judgment in favor of defendants. Plaintiff, Colombian journalist, had affair with drug trafficker Pablo Escobar, and wrote memoir, *Amando a Pablo, Odiando a Escobar*, about relationship and rise of drug cartels. Memoir contained chapter entitled "The Caress of a Revolver," which recounted intimate scene between plaintiff and Escobar involving gun. Memoir also contained chapter entitled "That Palace in Flames," which detailed meeting between plaintiff, Escobar, and one of heads of Colombia guerilla organization, M-19. Defendants were associated with production and distribution of television series, *Narcos*. District court granted summary judgment for defendants, finding scenes in series not substantially similar to chapters in plaintiff's memoir. In analyzing scenes, court found that some similarities to plaintiff's work involved unprotected facts. Court also found differences between scenes and series: bedroom scenes in works differed in terms of plot, setting, mood, and character exchanges, and meeting scenes differed in terms of plot, theme, dialogue, and tone. Court also rejected plaintiff's argument that trial court erred in not applying "modified substantial similarity standard" test from 1941 Ninth Circuit case, when assessing whether substantial similarity exists between works in two different types of media. Finally, court rejected plaintiff's theory that non-historical, personal facts, as opposed to historical facts, were protectible by copyright, finding no basis for such theory in fact or law.

Craft Smith, LLC v. EC Design, LLC, 969 F.3d 1092 (10th Cir. 2020)

Tenth Circuit affirmed district court's grant of summary judgment in favor of defendants. Plaintiff, creator and seller of popular personal organizer LifePlanner, brought action against competing seller, as well as its retailer, Michaels Stores, alleging that defendants' product infringed plaintiff's registered compilation in LifePlanner. District court granted summary judgment to defendants on both issues, holding that plaintiff did not own valid copyright in LifePlanner compilation. Although Tenth Circuit disagreed with lower court's framing of copyright issue, they affirmed grant of summary judgment in holding that "no reasonable juror could conclude that the allegedly infringing aspects of [defendants'] organizer are substantially similar to the protected expression in the LifePlanner compilation." Tenth Circuit found that district court misapplied first element of infringement test as to validity of plaintiff's copyright. Accordingly, Circuit Court rejected district court's conclusion that registration certificate was invalid "because [plaintiff's] asserted compilation seeks much broader protection than the scope outlined on the LifePlanner registration certificate," and instead, citing to earlier precedent, determined that first prong of infringement analysis was satisfied because "analysis concerns only existence of a valid copyright in the allegedly infringed work." In applying second prong of analysis, court addressed "protectible

expression” contained in LifePlanner compilation. In particular, court found LifePlanner’s protectible expression consisted of “selection, coordination, and arrangement of the specific literary and graphic components, including the specific text selected” and “specific two-dimensional artworks and graphics contained therein, that make up the LifePlanner as a whole” and specifically excluded “format and layout itself.” Court next analyzed substantial similarity between LifePlanner’s protectible expression and defendants’ work. Court found that, despite various similarities identified by plaintiff, including that defendants used same calendar forms with same sections and arranged in same order, plaintiff did not claim that defendants copied any of planner’s artwork or text – “the two most significant portions of protected expression in the LifePlanner compilation.” Court further noted that, when defendants used entirely different artwork and text, even if arranged similarly, “it did not copy the LifePlanner’s protected expression” and instead such differences “eliminate the possibility that a reasonable juror could conclude that the protected elements of the LifePlanner are substantially similar to the defendants’ planner.” Circuit Court affirmed summary judgment.

Dutcher v. Bold Films LP, 822 F. App’x 858 (10th Cir. 2020)

Tenth Circuit affirmed district court’s grant of summary judgment for defendants on copyright infringement claim. Plaintiff, copyright owner of 2007 film *Falling*, which involved murderers’ search for stringer (freelance videographer) covering crimes and accidents, brought copyright infringement suit against defendant owners of 2014 film *Nightcrawler*, which involved stringer’s search for murderers. District court awarded defendants summary judgment, holding no reasonable jury could conclude two films substantially similar because of obvious differences in plots. Plaintiff appealed, arguing substantial similarity was jury question, that district court erred in applying abstraction-filtration-comparison test in substantial similarity analysis, and that *scènes à faire* doctrine was erroneously applied because there was no established genre for films at issue. Tenth Circuit held that, in proper circumstances, court may enter summary judgment on substantial-similarity grounds. Further, court disagreed because it had previously held abstraction-filtration-comparison legitimate test for determining substantial similarity. Third, there is no requirement that there actually be genre of films for *scènes à faire* doctrine to apply.

Gayle v. Allee, No. 18-3774, 2021 U.S. Dist. LEXIS 6756 (S.D.N.Y. Jan. 13, 2021)

District court dismissed amended complaint for copyright infringement. *Pro se* graffiti artist plaintiff alleged that defendant photographer infringed plaintiff’s copyright by offering for sale photograph that mostly contained image of two buildings. Corner of photo depicted small construction barrier tagged with graffiti reading “ART WE ALL ONE.” Plaintiff claimed copyright in visual material containing words ARTWEALL and ART WE ALL. District court dismissed complaint because plaintiff had failed to allege what images were covered by his purported copyright, and how alleged copying was anything more than *de minimis*. Plaintiff then filed amended complaint, but district court held that it failed to state copyright claim for similar reasons. Although plaintiff alleged that he owned valid and registered copyrights, he failed to allege which specific works were infringed by defendant’s

photographs and how they were infringed, and seemed to be arguing that phrases ART WE ALL or ARTWEALL were copyrightable in and of themselves. District court found that graffiti in defendant's photograph and plaintiff's copyrighted work were not substantially similar, since phrase ART WE ALL is non-copyrightable slogan or phrase. Court also considered whether such words were presented in original protectible manner, but found no protected elements existed that were infringed. Though some similarity existed between writing style used in graffiti in photograph and one of plaintiff's many images attached to amended complaint, district court noted that copyright law does not protect typographic ornamentation, lettering, or coloring. Finally, district court held that even if defendant copied plaintiff's work, such work appeared in small print at bottom of photograph in such manner as to render it *de minimis* copying. District court therefore dismissed copyright claim with prejudice.

Krisko v. Marvel Entm't, LLC, 473 F. Supp. 3d 288 (S.D.N.Y. 2020)

Plaintiff, Florida individual, brought infringement action against various defendants associated with (a) production and distribution of television show *X-Men: The Animated Series*, including media entertainment giants Marvel, Disney, Amazon, Apple, NBCUniversal, and (b) creation and composition of *X-Men* theme song, namely Haim Saban, Shuki Levy, their entertainment company, as well as its successor, and their employee, Ronald Wasserman. Plaintiff alleged that *X-Men* theme song infringed his copyright in "primary melodic theme" featured in soundtrack for popular 1980s-era Hungarian television show *Linda*. All defendants moved to dismiss and Wasserman, writer of *X-Men* theme song, also alleged lack of personal jurisdiction. District court granted Wasserman's motion on jurisdictional grounds. As to remaining defendants, court denied their motions to dismiss on infringement grounds, finding that plaintiff sufficiently pleaded that *Linda* and *X-Men* theme songs were plausibly strikingly similar. Court agreed that plaintiff's "laundry list of similarities" sufficiently supported plaintiff's claim that "subject" of themes were strikingly similar, namely that subject of song is "'exactly the same,' 'note by note,' with one exception" and that harmonization, key, and tempo between two works were identical. Court disagreed with defendant's counterarguments that plaintiff's concession that songs feature minor alterations undermined any allegations of striking similarity. Instead, court found that "mere existence of differences does not preclude two works from otherwise being strikingly similar," particularly where, as here, plaintiff alleges number of similarities between songs. Additionally, although court acknowledged merit of defendant's argument that any similarities between songs were not probative of copying because plaintiff's alleged similarities related to common musical elements between works, court held that plaintiff's claims regarding striking similarity in two melodies, among other similarities, were sufficient to survive motion to dismiss. As to plaintiff's claims of secondary liability, court denied Saban and Levy's motions to dismiss, but granted remaining defendants' motions, finding plaintiff failed to allege sufficient facts to support any claims of contributory infringement and vicarious liability.

Witt v. Sollecito, No. 19-676, 2020 U.S. Dist. LEXIS 200488 (N.D.N.Y. Oct. 28, 2020)

Plaintiff, home design and construction company, brought infringement action against defendants Larry and Joanne Sollecito, its former clients, and home design company, architect, and contractor engaged by defendants Sollecitos to construct defendants' new home. In June 2014, plaintiff and Sollecitos entered into agreement pursuant to which plaintiff was to design and plan construction of Sollecitos' new home. Plaintiff provided Sollecitos with preliminary drawings and designs, but Sollecitos did not contract with plaintiff for home's construction. Two years later, in June 2016, plaintiff discovered that Sollecitos' home was "nearly identical" to plaintiff's design and plans. Plaintiff brought claims of direct, contributory and vicarious infringement against defendants, alleging that Sollecitos hired defendant design company, architect, and contractor to build Sollecitos' new home using plaintiff's designs. Defendants filed motions for judgment on pleadings as to plaintiff's copyright claims and plaintiff filed cross-motion to amend. As to plaintiff's infringement claim, defendants argued that plaintiffs' drawings were not substantially similar, or nearly identical, to defendants' drawings. Court denied defendants' motions and granted plaintiff's cross-motion to amend. As to lack of substantial similarity, court rejected defendant's contentions that they did not copy designs and plans because, when compared, drawings showed differences between one another. Instead, court held that it could not determine, at this early stage, whether designs were substantially similar or not. In applying "ordinary observer" test, court indicated that, after comparing plaintiff's and defendant's works, it was satisfied that ordinary observer could find that parties' interior and exterior designs had similar "total concept and feel" even though there were some differences between two.

Carlini v. Paramount Pictures Corp., No 19-8306, 2021 U.S. Dist. LEXIS 46481 (C.D. Cal. Feb. 2, 2021)

District court dismissed copyright infringement claim, finding defendant's motion picture not substantially similar to plaintiff's script. Plaintiff claimed that Paramount movie *What Men Want*, sequel to *What Women Want*, infringed plaintiff's unproduced script for *What the F Is He Thinking?*, both of which involved woman gaining power to hear men's thoughts. Court found that plaintiff had not shown substantial similarity between works in terms of plot, sequence of events, characters, mood and pace, setting, theme, or dialogue. Device of reading minds of opposite gender was not protectible, and any plot similarities (including waking up with powers in hospital and hearing doctor's thoughts following knock to head; setting up gay best friend with boyfriend using powers; discovering cheating partner; falling in love with bartender) were *scènes à faire* of R-rated romantic comedy based on mindreading opposite gender. Applying extrinsic test, court concluded that works were not substantially similar as matter of law, and dismissed copyright claim.

Irish Rover Entm't, LLC v. Sims, No. 20-6293-2021 U.S. Dist. LEXIS 25201 (C.D. Cal. Jan. 21, 2021)

District court denied motion to dismiss plaintiff's first amended complaint alleging copyright infringement arising from defendants' alleged unauthorized use of plaintiff's copyrighted screenplays in connection with television series *Stranger Things*. Defendants, streaming service and creators of *Stranger Things*, moved to dismiss all plaintiff's claims on ground that no substantial similarity existed between plaintiff's works and *Stranger Things*. Court determined that comparison of works at this stage in proceedings was not warranted because additional evidence, such as expert testimony, might help inform question of substantial similarity. Defendants also argued various elements of plaintiff's works were unprotectible, but court found too difficult to know whether such elements are unprotectible at this stage of litigation.

Lanard Toys v. Anker Play Prods., No. 19-4350, 2020 U.S. Dist. LEXIS 221783 (C.D. Cal. Nov. 12, 2020)

Court denied plaintiff's and defendant's cross-motions for summary judgment, finding genuine issue of material fact existed as to striking and substantial similarity between plaintiff's and defendant's product packaging. Plaintiff toy manufacturer sued defendant, competing manufacturer and distributor of children's activity play products, for copyright infringement, as well as various other claims, including unfair competition and trademark and patent infringement. Plaintiff alleged that defendant infringed plaintiff's copyrights in its "Chalk Bomb!" product – toy ball comprised of chalk powder, and its related packaging – by selling and promoting similar product bearing mark "Chalk Blast." In response, defendant raised various affirmative defenses, including fair use, standing, invalidity of copyright, and *de minimis* use. Both parties moved for summary judgment; plaintiff sought summary judgment as to all of its claims and on all of defendants' affirmative defenses, and defendants moved for partial summary judgment as to plaintiff's claims for copyright infringement. Court denied both parties' motions as to copyright infringement. Court assessed only second element of infringement analysis, finding that plaintiff failed to meet its burden of demonstrating direct or circumstantial evidence of access. Court dismissed plaintiff's argument that defendant's use of "Chalk Bomb" to describe its product demonstrated access, and instead held that plaintiff provided no proof as to direct access and failed to establish that its work was widely disseminated. Court also held that genuine dispute of material fact existed as to striking and substantial similarity. Court found that similarities between phrases used in both parties' packaging, and corresponding placement of those phrases on parties' packaging, might not be sufficient to prove substantial, or striking, similarity because there are only limited number of ways to express methods of operating such simple toys.

LA Gem & Jewelry Design, Inc. v. Groupon, Inc., No. 19-35, 2020 U.S. Dist LEXIS 165918 (C.D. Cal. Sept. 10, 2020)

District court granted plaintiff's motion for summary judgment on issues including validity of copyright and copying, and denied motion as to unlawful appropriation, secondary infringement and willfulness. Plaintiff jewelry company alleged defendants infringed two of its registered jewelry designs, which contained crescent moon and circle along with phrase "I love you to the moon and back." Plaintiff proffered undisputed circumstantial evidence that defendant had visited trade shows where plaintiff displayed designs at issue, providing defendants with reasonable possibility to access plaintiff's copyrighted designs. District court concluded that defendant's access, plus similarity of designs, was enough to establish that copying had indeed occurred. However, district court ultimately denied summary judgment as to unlawful appropriation, noting that Ninth Circuit applies two-part extrinsic (objective) and intrinsic (subjective) test to determine substantial similarity. Under extrinsic test, district court concluded that similarities in unique font, placement of font, combination of shapes, darkening of text, and capitalized letters all appeared to create substantial similarities between designs of plaintiff and defendants. Under intrinsic test, district court concluded that reasonable juror could find that defendant's works had different look and feel from those of plaintiff. Finding genuine issue of material fact, district court denied summary judgment on question of unlawful appropriation.

Kirk Kara Corp. v. Western Stone & Metal Corp., No. 20-1931, 2020 U.S. Dist. LEXIS 189425 (C.D. Cal. Aug. 14, 2020)

Plaintiff, owner of three registrations for jewelry designs, brought claims for direct, contributory, and vicarious infringement and violation of DMCA, alleging that defendant distributed and/or sold four substantially similar engagement rings. Defendant moved to dismiss direct infringement claim on basis that, after filtering out unprotectible elements, plaintiff's designs were only afforded thin protection and, as a result, should be able to form basis of copyright infringement action only if infringing works are "virtually identical" to them. Court, however, distinguished defendant's authority and found that, at motion to dismiss stage, plaintiff's allegations were sufficient for court to infer that there were "gazillions of ways to assemble and express engagement rings." Court also found substantial similarity sufficiently pleaded. Court denied motion to dismiss.

Smith v. Weeknd, No. 19-2507, 2020 U.S. Dist LEXIS 130549 (C.D. Cal. July 22, 2020)

Plaintiffs brought suit against performer known as The Weeknd and others who contributed to creation, publication, and distribution of composition "A Lonely Night," alleging infringement of plaintiffs' work "I Need to Love." Defendants moved for summary judgment on grounds that defendants lacked access to plaintiffs' work and that works were not substantially similar. On substantial similarity, court discredited plaintiffs' expert report because it did not filter out unprotectible elements in comparing works. Defendants' expert report found that once prior art was filtered out of work, similarity between plaintiffs' and

defendants' compositions amounted to three notes, which were insufficient as matter of law to establish substantial similarity even if notes were important to works. Plaintiffs additionally argued for infringement on basis of selection and arrangement theory, but court found plaintiffs' asserted selection and arrangement of unprotectible elements was neither original nor shared "in substantial amount." Plaintiffs additionally did not establish striking similarity. Court granted defendants' motion for summary judgment on direct infringement and, consequentially, theories of secondary liability.

Alexander v. Take-Two Interactive Software, Inc., No. 18-966, 2020 U.S. Dist. LEXIS 177130 (S.D. Ill. Sept. 26, 2020)

District court granted partial summary judgment for plaintiff on issue of copying. Plaintiff tattoo artist inked five copyrighted tattoo designs onto WWE professional wrestler Randy Orton. Defendant created *WWE 2K* video game series, which contained realistic depictions of WWE professional wrestlers, including depiction of Orton's tattoos inked by plaintiff. Defendants admitted to copying copyrighted tattoo artworks, but citing Second and Fifth Circuit decisions, argued that plaintiff must also establish that copying was unauthorized, i.e., "legally actionable." District court rejected this standard, holding that in Seventh Circuit plaintiff need only show that defendants copied work, and that "burden of proving the use was authorized falls squarely on [d]efendants." Because there was no dispute that plaintiff held valid copyright for five tattoos and defendants copied works, summary judgment for plaintiff on copying element.

Cat & Dogma v. Target Corp., No. 19-1002, 2020 U.S. Dist. LEXIS 152762 (W.D. Tex. July 23, 2020)

District court granted defendant's motion to dismiss plaintiff's infringement claim stemming from parties' apparel designs incorporating phrase "i love you" in cursive form repeated three to five times horizontally and 25 times vertically across garment. Plaintiff conceded short phrases such as "i love you" are not subject to copyright protection but argued formatting short phrases into original design may be protectible, and requested that court show deference to plaintiff's copyright registration and Copyright Office determination that design met threshold for creativity and originality. Target did not contest validity of plaintiff's registration but argued there was no substantial similarity between designs at issue. Court, noting that unprotectible elements must be excluded from works when determining substantial similarity found "no similarity" between respective designs; once "i love you" and cursive typeface is excluded from plaintiff's design, "level of creativity is trivial and thus not subject to copyright protection."

Cortes v. Universal Music Latino, 477 F. Supp. 3d 1290 (S.D. Fla. 2020)

District court granted defendants' motion for summary judgment stemming from infringement claim in connection with defendants' hit song "Despacito." Plaintiff alleged that in 2006 he gave music producer CD compilation containing song titled "Despacito," which eventually was given to defendants, who released hit song "Despacito" in 2017. Plaintiff filed infringement claim against defendants, who moved to dismiss claim, which

court treated as motion for summary judgment. To establish infringement in Eleventh Circuit ownership and copying of original elements of work must be proven. As plaintiff could not establish copying with direct evidence, plaintiff must establish that defendants had access to “Despacito,” and that works are substantially similar at level of protected expression; non-protectible elements must be filtered out and plaintiff must prove substantial similarity between remaining, unfiltered elements and alleged infringing work. Accordingly, court engaged in side-by-side analysis and found title of respective works, which translates to “slowly,” to be similar but too generic to qualify for protection. Additionally, word “Despacito” appeared less frequently in plaintiff’s work. Court further found both works comprised non-protectible common words and short phrases, with plaintiff using such words to describe his relationship with multiple women, whereas defendants used similar words to describe single love interest. Further, parties’ shared use of common non-protectible expressions such as “let me tell you things to the ear” and female courtship theme appeared differently in respective works and were narrated from different perspectives. Accordingly, court found works not to be substantially similar, as verses in works contained different lyrical content and employed different styles. Court noted plaintiff did not submit any expert reports or other probative evidence to raise issue of material fact as to substantial similarity.

Bassett v. Jensen, No. 18-10576, 2020 U.S. Dist. LEXIS 140615 (D. Mass. Aug. 6, 2020)

Plaintiff rented Martha’s Vineyard home to one defendant, but, unknown to plaintiff, property was used as set for adult films and photographs. Plaintiff registered unpublished collections of works – drawings, paintings and photographs; handsewn slipcovers, pillows, wall hangings, and collages; and hand-painted works, such as tabletops, fireplace, and pottery – with Office after learning that home was used for adult films. In earlier order, court lacked sufficient record to rule on whether defendants’ use of plaintiff’s work was *de minimis*, and deferred ruling on copyright claim. Plaintiff then submitted hundreds of pages of screenshots from defendants’ ten films. At least one of plaintiff’s works appears in each film. Court found that defendants’ use was greater than *de minimis*, especially since one work was visible in defendants’ films for at least 30 seconds (at once or in total) in each film. Court granted plaintiff’s motion for summary judgment on liability and defendants’ cross motion was denied.

High Five Threads, Inc. v. Mich. Farm Bureau, No. 20-604, 2021 U.S. Dist. LEXIS 86770 (W.D. Mich. May 6, 2021)

District court granted defendants’ motion to dismiss for failure to state claim. Plaintiff retailer owned registered copyright in “Hand Map”: line drawing of two hands juxtaposed to one another at right angle, with pinky of one hand folded and index finger on that hand overlapping middle finger. Court noted that “[s]ome Michiganders would recognize that drawing as a representation of the State of Michigan.” Plaintiff launched campaign in March 2020 to “give back” to businesses and individuals financially impacted by stay-at-home orders during COVID-19 pandemic, committing to donating net proceeds from sale of t-shirts designed to promote strength of Northern Michigan economy. Defendant insurance

companies launched similar campaign in April 2020, focused on restaurants impacted by stay-at-home orders, using similar simple two-hands design. Plaintiff alleged that defendants' design infringed its copyright in Hand Map. Defendants argued that Hand Map was not original enough to be protected by copyright. Court found plaintiff's copyright to be "thin at best," encompassing only its original contribution to unprotectible "popular idea of using one's hands to indicate the shape of Michigan"; folded pinky and overlapping index finger were arguably protected elements. However, those elements were not present in defendants' design. To extent plaintiff possessed thin copyright protection in Hand Map, plaintiff did not state claim because it did not show "virtually identical copying." Differences between Hand Map and defendants' designs showed that any copying was not virtually identical. Plaintiff thus did not allege facts to plausibly show that defendants copied protected elements of its copyrighted design.

Reilly v. Wozniak, No. 18-3775, 2021 U.S. Dist. LEXIS 39091 (D. Ariz. Mar. 2, 2021)

Plaintiff, business school professor, emailed defendant Wozniak, co-founder of Apple, saying "I want to start a high tech university." In reply, defendant stated "Great idea," and provided advice to plaintiff, although he stated he could not provide anything more than that advice because he was busy. Plaintiff followed up email asking if defendant would endorse "WOZ Institute of Technology," and defendant said he would. Plaintiff alleged that he and defendant developed idea of school over years, and two entered into deal. Plaintiff created website and received copyright for "graphic images, photographs, and tangible expressions." Years later, defendant entered into arrangement with defendant Southern Careers Institute to create "Woz U." Plaintiff alleged that graphic design, course design, and course outline were substantially similar to those plaintiff developed and previously disclosed to defendant Wozniak. Defendants moved for summary judgment on infringement claim, arguing that there was "no direct evidence" that they copied plaintiff's materials. Court stated, however, that such direct evidence is not required for copyright infringement claim, and indeed is not available in most cases. Upon review of relevant materials, court found that defendants were not entitled to summary judgment on extrinsic test for substantial similarity. Because plaintiff raised genuine issue of material fact as to substantial similarity, court denied defendants' motion for summary judgment.

C. Contributory/Vicarious Infringement

Bandha Yoga Publ'ns, LLC v. Dorset, No. 20-15036, 2021 U.S. App. LEXIS 12095 (9th Cir. Apr. 23, 2021)

Ninth Circuit affirmed district court's dismissal of plaintiff's direct, vicarious and contributory infringement claims for failure to plead that Facebook engaged in volitional conduct, derived direct financial benefit from direct infringement or had actual knowledge that specific infringing material available via its system. Plaintiff physician and yoga practitioner owned copyrights to yoga-related books and scientific illustrations, which were posted on plaintiff's Facebook page. Unknown third-party hacker illicitly gained

administrator access to plaintiff's page, then posted links that displayed plaintiff's copyrighted works and directed users to third-party website, which displayed further copies of plaintiff's copyrighted works and installed virus on users' computers. Plaintiff contacted defendant Facebook and, after eight days of email communications, Facebook revoked hacker's administrator access, automatically deleting all infringing posts. Plaintiff sued Facebook, alleging that its failure to timely remove infringing content made it directly, contributorily and vicariously liable for infringement of his copyrights. District court dismissed all claims, and Ninth Circuit affirmed. As to direct infringement, plaintiff failed to allege "volitional conduct" by Facebook because Facebook did not exercise control or cause any copying, which was caused by hacker only. Facebook's alleged "failure to act" also insufficient because it took "affirmative action" to address plaintiff's claims upon being informed of potential infringement. As to vicarious infringement, plaintiff failed to allege that Facebook derived direct financial benefit from infringement, because fact that plaintiff paid Facebook to post advertisements for his business page on newsfeeds did not suffice to show that Facebook made money specifically from hacker's posts on plaintiff's page. As to contributory infringement, plaintiff failed to allege that Facebook had "actual knowledge that specific infringing material" was available using its system, despite plaintiff's allegations that he emailed Facebook screenshots of hacker's infringing posts; however, plaintiff could cure defect if he pleaded facts describing different communication to Facebook that "clearly identified" set of specific infringing images on Facebook and "clearly indicated" plaintiff's ownership of specific images.

ALS Scan, Inc. v. Steadfast Networks, Ltd. Liab. Co., 819 F. App'x 522 (9th Cir. 2020)

Ninth Circuit affirmed district court's grant of summary judgment in favor of defendant because it took sufficient simple measures to avoid contributory copyright infringement liability. Defendant data-center service provider hosted Imagebam.com, website with user-uploaded content that allegedly became unauthorized hub of copyrighted adult material, including some of plaintiff's images. Plaintiff sent numerous copyright infringement notices regarding Imagebam to defendant, who forwarded them to Imagebam's designated agent. Imagebam removed every copyrighted image at issue. Plaintiff sued defendant on contributory infringement theory but court granted summary judgment for defendant because defendant's forwarding of notices constituted "simple measures" sufficient to prevent further damage to plaintiff's works, even without further follow-up by defendant, in part because Imagebam removed all infringing materials. Ninth Circuit affirmed, further holding that number of notices previously received by defendant was legally irrelevant because such notices give defendant at most generalized knowledge that infringement will likely occur in future, rather than notice of specific and actual infringing acts, and accordingly was insufficient to establish contributory infringement liability.

Krisko v. Marvel Entm't, LLC, 473 F. Supp. 3d 288 (S.D.N.Y. 2020)

Plaintiff, Florida individual, brought infringement action against various defendants associated with (a) production and distribution of television show *X-Men: The Animated*

Series, including media entertainment giants Marvel, Disney, Amazon, Apple, NBCUniversal, and (b) creation and composition of *X-Men* theme song, namely Haim Saban, Shuki Levy, their entertainment company, as well as its successor, and their employee, Ronald Wasserman. Plaintiff alleged that *X-Men* theme song infringed his copyright in “primary melodic theme” featured in soundtrack for popular 1980s-era Hungarian television show *Linda*, and also claimed that various defendants were secondarily liable under theories of contributory and vicarious liability. All moved to dismiss. Court granted Wasserman’s motion, finding lack of personal jurisdiction, but denied remaining defendants’ motions to dismiss on infringement grounds. As to plaintiff’s claims of secondary liability, court held that only plaintiff’s claims for contributory infringement and vicarious liability against Saban and Levy survived motion to dismiss. Regarding contributory infringement, court reasoned that both Levy and Saban “are alleged to have copied *Linda*’s theme song while composing the *X-Men* song” and then, “distributed it to Marvel” such that they “might be” secondarily liable under theory of contributory infringement. However, court found no factual support in complaint for claim that Saban and Levy’s entertainment company, its successor, or copyright claimant, knew or had reason to know of infringement at issue and held that plaintiff’s allegations that defendant owned copyright in *X-Men* theme song, or distributed *X-Men* television show, were plainly insufficient to plead contributory infringement. As to vicarious liability, court similarly found that, with exception of plaintiff’s claims as to Saban and Levy, plaintiff failed to plead enough facts to support claim of vicarious liability against defendants, namely because “nothing in the complaint adduces any facts” that any of parties had “any right or ability to supervise any infringing activity.” Court further explained that mere fact that defendants profited from their licensing of theme song did not render them vicariously liable. However, court determined that plaintiff’s claims against Saban and Levy withstood motion to dismiss because court inferred that, as owners of their entertainment company and Wasserman’s employers, they had supervisory capabilities as to Wasserman’s infringing composition and infringing sale of theme song to Marvel, and thus could be subject to vicarious liability.

Witt v. Sollecito, No. 19-676, 2020 U.S. Dist. LEXIS 200488 (N.D.N.Y. Oct. 28, 2020)

Plaintiff, home design and construction company, brought infringement action against defendants Larry and Joanne Sollecito, its former clients, and home design company, architect, and contractor engaged by defendants Sollecitos to construct defendants’ new home. In June 2014, plaintiff and Sollecitos entered into agreement pursuant to which plaintiff was to design and plan construction of Sollecitos’ new home. Plaintiff provided Sollecitos with preliminary drawings and designs, but Sollecitos did not contract with plaintiff for home’s construction. Two years later, in June 2016, plaintiff found that Sollecitos’ home was “nearly identical” to design and plans plaintiff created. Plaintiff brought claims of direct, contributory and vicarious copyright infringement against defendants, alleging that Sollecitos hired defendant design company, architect, and contractor to build Sollecitos’ new home using plaintiff’s designs. Defendants filed motions for judgment on pleadings as to plaintiff’s copyright claims, and plaintiff filed cross-motion to amend. Court rejected defendant Sollecitos’ argument that, because they were entitled to

judgment as to plaintiff's copyright infringement claim, they were necessarily entitled to judgment as to plaintiff's contributory and vicarious copyright infringement claims as well. As to remaining defendants, court determined that, at this early stage, complaint sufficiently alleged contributory and vicarious infringement, particularly because complaint established that defendants "had access to the copyrighted works, induced direct infringement, and derived financial benefit from copying such works, if only just barely."

Davis v. Pinterest, Inc., No. 19-7650, 2021 U.S. Dist. LEXIS 44173 (N.D. Cal. Mar. 9, 2021)

Plaintiff digital artist and photographer sued Pinterest for direct and contributory infringement, alleging Pinterest copied and displayed his copyrighted works, which bore his name and copyright notice, and which contained copyright management information ("CMI") in metadata. After district court twice granted defendant's motions to dismiss contributory infringement claim, plaintiff submitted second amended complaint, and Pinterest again moved to dismiss claim. Pinterest argued that complaint failed to allege defendant's "actual knowledge of specific acts of direct third-party infringement." Plaintiff contended that, at least at motion to dismiss stage, allegation of "constructive knowledge and willful blindness" of direct infringement was sufficient, and that its amended complaint alleged such knowledge. Considering Ninth Circuit precedent on knowledge requirement, district court concluded that though constructive knowledge or willful blindness can be sufficient in some circumstances, defendant must still have "actual knowledge of specific acts of infringement" or knowledge of "specific infringing material." However, plaintiff here only alleged that Pinterest had (or should have had) generalized knowledge of infringing material, and failed to point to any specific infringing material or specific acts of infringement. Considering that neither complaint nor plaintiff's prior emails with Pinterest identified specific infringing material, district court held that Pinterest did not have knowledge of direct infringement, and thus could not be liable for contributory infringement. Motion to dismiss contributory infringement claim granted, and considering that plaintiff "had ample opportunity to allege a contributory infringement claim, but has failed to do so," leave to amend denied.

Atari Interactive, Inc. v. Redbubble, Inc., No. 18-3451, 2021 U.S. Dist. LEXIS 35976 (N.D. Cal. Jan. 28, 2021)

Video game company Atari sued "print-on-demand" retailer Redbubble for infringement, alleging Redbubble displayed, offered for sale and sold products bearing Atari's copyrighted designs. On cross-motions for summary judgment, district court granted summary judgment to defendant Redbubble on contributory and vicarious infringement claims. Redbubble operates online marketplace wherein artists can upload various designs, which Redbubble then offers for sale to consumers printed onto various physical products (apparel, etc.) by projecting images of uploaded artwork onto stock images of such products. When user purchases product, Redbubble processes payment and arranges for third-party manufacturer to print and ship product to consumer. On contributory infringement claim, district court found that plaintiff Atari failed to allege that Redbubble had knowledge of and failed to act

on any specific infringing material. District court dismissed Atari's argument that "widespread infringement" of its works on Redbubble's site supported Redbubble's "willful blindness" to infringement, noting that generalized knowledge of infringement only supports contributory infringement claim if defendant failed to take reasonable steps to prevent infringement. In view of Redbubble's evidence that it promptly removed any infringing materials identified by Atari upon notice, judgment issued for Redbubble on contributory infringement claim. On vicarious infringement claim, Atari argued that Redbubble had "right and ability to supervise the infringing conduct" on its platform, and had direct financial interest in such infringing activity. District court considered whether Redbubble had practical ability to supervise its platform for infringement, and agreed with Redbubble that it had no practical ability to do so; identifying infringing content required cooperation from content owner to determine whether particular content infringed. For example, were Redbubble to search "Atari," such search would yield results including variety of non-copyrighted or fair use content, in addition to potentially infringing content. Finding that such searches would be "like 'searching for a needle in a haystack' (where Redbubble lacks knowledge of needles' appearance)," court granted summary judgment to defendant Redbubble on vicarious infringement claim.

Dish Network, L.L.C. v. Jadoo TV, Inc., No. 20-1891, 2020 U.S. Dist. LEXIS 181255 (N.D. Cal. Sept. 30, 2020)

District court denied individual defendant's motion to dismiss infringement claim because plaintiff sufficiently pleaded facts showing defendant personally liable for infringement. Plaintiff, television provider, sued defendants, company selling set-top boxes and mobile applications consumers use to receive television channels and its founder and CEO, for copyright infringement for transmitting channels and content that plaintiff exclusively licensed. Court applied well-established rule that corporate officers can be held liable for corporation's infringement if they personally participated in infringing acts. Court found plaintiff adequately pleaded direct infringement because defendant made "conscious decision" not to remove channels. Court found plaintiff adequately pleaded contributory infringement under both material contribution and inducement of infringement theories. Material contribution theory satisfied because defendant had actual knowledge of channels and could have taken simple measures to avoid infringement. Inducement theory satisfied because defendant had ability to filter out channels but did not do so. Court found plaintiff adequately pleaded vicarious infringement because defendant received direct financial benefit from infringement while having legal right and practical ability to control infringing activity.

Music Force v. Sony Music Holdings, No. 19-6430, 2020 U.S. Dist. LEXIS 183285 (C.D. Cal. Aug. 12, 2020)

Plaintiff Music Force, owner of composition "Carry On," written by artist Bobby Caldwell, alleged singer Lil Nas X, appropriated parts of "Carry On" in creation of his new song "Carry On" and that defendant Sony Music was vicariously liable. Sony Music moved to dismiss. Plaintiffs argued Sony Music could control Lil Nas X because it had right to end

infringement by threatening to terminate Lil Nas X's contract. But terminated contract did not amount to right and ability to control infringement. Court granted Sony Music's motion to dismiss without leave to amend.

UMG Recordings, Inc. v. RCN Telecom Servs., LLC, No. 19-17272, 2020 U.S. Dist. LEXIS 158269 (D.N.J. Aug. 31, 2020)

District court denied internet service provider's motion to dismiss contributory and vicarious infringement claims but granted ISP management services firm's motion to dismiss same. On behalf of plaintiff record companies, third party Rightscorp (independent copyright enforcement company) detected BitTorrent-based infringement of plaintiffs' sound recordings by defendant ISP RCN's users. Rightscorp sent RCN more than five million infringement notices detailing infringing activity and users and requested that RCN forward same to infringing RCN account holders. Rightscorp also repeatedly obtained copies of infringing sound recording files from RCN subscribers' infringing host computers. Alleging that RCN did not discourage infringement and neither adopted nor enforced anti-piracy policy providing for termination of repeat infringers, plaintiffs sued RCN and Patriot, management services firm that made and implemented RCN's policy decisions, for contributory and vicarious infringement. RCN and Patriot moved to dismiss. Court held that plaintiffs sufficiently alleged direct infringement by third parties (RCN subscribers) because plaintiffs attached partial list of sound recordings owned by plaintiffs and plausibly alleged both that Rightscorp repeatedly obtained copies of infringing files from RCN subscribers and that RCN subscribers used RCN's service to illegally download and distribute plaintiffs' copyrighted works. Contributory infringement adequately pleaded as to RCN because plaintiffs alleged that (1) RCN received, from Rightscorp, five million infringement notices, which gave RCN knowledge or at least reason to know of widespread infringement; and (2) RCN's continued provision of services to, and failure to take remedial action against, repeat infringers constituted material contribution to or inducement of infringement. However, no contributory infringement established as to Patriot because plaintiffs failed to allege either that Patriot had actual knowledge of either Rightscorp's infringement notices or RCN subscribers' infringement, or that such knowledge should be imputed to Patriot, and failed to allege that Patriot induced, encouraged or materially contributed to infringement. Vicarious infringement adequately pleaded as to RCN because plaintiffs alleged that (1) RCN had right and ability to supervise infringing activity since RCN able to control, supervise or terminate subscriber accounts; and (2) RCN failed to prove that it did not derive financial benefit from infringement, since ability to download infringing music may have been one draw for RCN's subscribers. However, no vicarious infringement established as to Patriot because plaintiffs failed to plausibly allege that Patriot had right or ability to control infringement, or directly profited from infringement.

Capitani v. World of Miniature Bears, Inc., No. 19-120, 2020 U.S. Dist. LEXIS 148968 (M.D. Tenn. Aug. 18, 2020)

District court denied parties' respective motions for summary judgment stemming from alleged infringing use of plaintiff's illustrations on wall clocks. Defendant World of

Miniature Bears, Inc. (“WMB”) moved for summary judgment claiming it had no connection to sale of infringing wall clocks. Court noted there was dispute of material fact as to whether WMB conducted business as MiniBearGems (“MBG”), which sold clocks on Amazon, or assisted MBG in selling clocks. Notably, MBG and WMB shared same owner; WMB’s website referred public to “MiniBearsGems.com” for retail purchases; and manager shared by WMB and MBG testified that MBG used WMB’s name in marketing to instill trust in public. Court noted that both manufacturer of infringing products and company involved in advertising such products can be held liable as contributory infringers. Court stated credibility of manager must be weighed at trial, as well as whether WMB had causal connection to alleged infringement. Accordingly, court denied WMB’s motion for summary judgment.

Hunter Killer Prods. v. AKA Wireless, No. 19-323, 2020 U.S. Dist. LEXIS 126677 (D. Hawaii July 17, 2020)

Plaintiff, owner of copyright in film *Hunter Killer*, asserted claims of intentional inducement and contributory infringement on basis that defendants’ employees promoted piracy apps to customers at Victra stores to induce them to infringe plaintiff’s work. Defendants moved to dismiss. Court first found that plaintiff failed to sufficiently allege that defendants had actual knowledge of infringement. But even if knowledge was sufficiently pleaded, court found claims insufficient. As initial matter, court found intentional inducement claim was not separate from contributory liability claim, and instead was theory of contributory infringement. On contributory infringement claim, plaintiff alleged that employees installed piracy apps on devices sold to consumers, but did not adequately plead that defendants intended, based on their conduct, that devices would be used to infringe plaintiff’s copyright in film. To extent contributory infringement claim was founded on material contribution, court found allegations insufficient because they did not go beyond threadbare recital of elements of claim. Court dismissed secondary liability claims with leave to amend.

D. Miscellaneous

Oracle Am., Inc. v. Hewlett Packard Enter. Co., 971 F.3d 1042 (9th Cir. 2020)

Ninth Circuit affirmed in part and reversed in part district court’s grant of summary judgment in favor of defendant, Hewlett Packard Enterprise Co. (HPE) in infringement action brought by plaintiffs, Oracle America, Inc., and Oracle International Co. Oracle owned proprietary Solaris software operating system and granted customers limited use license, and required customers to have support contract to receive server patches. HPE provided support for all its customers’ servers, including servers running Solaris software, and subcontracted indirect support to third party, Terix Computer Co. Terix arranged for HPE-Terix customers to have Oracle support for all servers via single-server support contract by downloading Solaris software patches to make copies for servers unsupported by contract. In 2013, Oracle sued Terix for copyright infringement, and court granted Oracle summary judgment. Oracle and HPE agreed to toll statute of limitations for any claims that Oracle would assert against HPE, effective May 2015. In 2016, Oracle filed suit alleging that HPE “improperly accessed,

downloaded, copied, and installed Solaris patches on servers not under an Oracle support contract,” asserting (a) direct infringement claims concerning HPE’s direct support customers, and (b) indirect infringement claims concerning joint HPE-Terix customers. District court granted summary judgment to HPE. Ninth Circuit affirmed partial summary judgment for HPE on infringement claims based upon statute of limitations. As to remaining infringement claims, Ninth Circuit (1) affirmed summary judgment on indirect infringement claims for patch installations by Terix, and (2) reversed summary judgment on all infringement claims for pre-installation conduct, and on direct infringement claims for unauthorized patch installations by HPE. As to direct infringement, Ninth Circuit, citing to “insurmountable ambiguity” in testimony by HPE witness, determined that triable issues remained as to whether Oracle’s evidence showed that HPE performed installation of patches on unsupported servers for its direct customers. For certain customers, referred to as “non-Symantec customers,” court found that, based on its evidence, Oracle could possibly prove that HPE installed patch on server unsupported by Oracle support contact and that patch was released and downloaded while that server was not on contract. Court disagreed with district court’s conclusion that evidence was ambiguous as to when patches were installed and that, drawing reasonable inferences in favor of non-movant Oracle, jury could find that evidence demonstrated at least one actual patch installation. Court also determined that HPE’s arguments third party could have installed patches for customers receiving direct support was foreclosed by evidence demonstrating that HPE installed patches. For direct infringement claims concerning Symantec, Ninth Circuit found that summary judgment was improper, concluding that HPE employee testimony allowed reasonable inference that HPE installed server patch on unsupported server. Ninth Circuit reversed summary judgment on infringement claims and remanded to district court to revisit issue.

Dubay v. King, 844 F. App’x 257 (11th Cir. 2021)

Eleventh Circuit affirmed district court’s grant of summary judgment for defendant, finding experts’ testimony summarizing works and opining on similarity to be admissible. Plaintiff, nephew of author of comic book series *The Rook*, brought infringement suit against Steven King and his corporate partners, alleging that protagonist of *The Dark Tower* novel and media series, Roland Deschain, was copy of Rook protagonist Restin Dane. Plaintiff challenged summaries of King’s lengthy works prepared by expert who had financial interest in proceedings, alleging reports were inaccurate. Plaintiff also challenged report by second expert arguing no substantial similarity. Court found that summaries were independently admissible under Rule 1006 as summary testimony to prove content, and not susceptible to *Daubert* challenge, and question of summary expert’s bias went to weight, not admissibility. Court noted that *Daubert* is intended to keep unreliable experts from jury, but here case was decided on summary judgment. Plaintiff’s challenge to similarity expert hinged on expert allegedly conceding that his report would be unreliable; expert, however, made no such concession. Plaintiff’s counsel asked hypothetical question “If Roland Deschain is a time traveler in the traditional sense, then wouldn’t that undermine the entire basis of your opinion?” Expert never entertained hypothetical and repeatedly insisted that Deschain was not “traditional time traveler.” Eleventh Circuit held that court did not abuse its discretion by declining to exclude expert report.

Gayle v. Hearst Communs., Inc., No. 19-4699, 2021 U.S. Dist. LEXIS 16451 (S.D.N.Y. Jan. 28, 2021)

District court dismissed complaint alleging copyright infringement. *Pro se* plaintiff alleged that defendant Hearst infringed plaintiff's copyright by publishing in ELLE magazine photograph of model Lameka Fox posing on rock displaying graffitied phrase "Art We All One." Plaintiff claimed that photo at issue violated his registered copyright in certain original works of art, but did not proffer specific original works used to register his copyrights. In evaluating defendant's motion to dismiss for failure to state claim, district court held that plaintiff's infringement claim failed to meet threshold requirement of identifying specific original works that were subject of copyright claim, as well as specific elements of such copyrighted work that defendant copied or incorporated into photo. District court held that mere identification of copyright registration numbers was insufficient to meet pleading burden in plaintiff's copyright claim, and failure to disclose visual images allegedly protected by copyright registration was also fatal to claim. In addition, district court concluded that phrase "Art We All" and its variations are too short to be subject to copyright. District court therefore dismissed plaintiff's copyright claim.

Capstone Logistics Holdings, Inc. v. Navarrete, No. 17-4819, 2020 U.S. Dist. LEXIS 110304 (S.D.N.Y. June 23, 2020)

Plaintiffs moved for summary judgment on infringement claims. Over several years, one of plaintiffs and its predecessor developed MobilTrak, "workforce logistics data processing platform." One of defendants, with help of employees who were previously employed by one of plaintiffs, built similar platform, Genesis, in months. Court found that defendants used MobilTrak documents to create Genesis, citing, among other evidence, fact that side-by-side comparison of source codes showed examples of same lines of code and same errors throughout code. Defendants argued they could not be liable due to their limited role in Genesis's creation, and that they did not receive financial benefit from creation and use of Genesis. Court found volitional act requirement satisfied. Defendant told one of its employees who used to be employed by one of plaintiffs to create similar platform, and defendants knew that those building platform had ability to infringe; it was unreasonable for defendants to rely on employee's representations that program was built anew because, among other facts, employee put significant work into building MobilTrak and Genesis was built in fraction of time. On financial benefit question, court found no genuine dispute of fact because one of defendants used platform to keep and acquire clients, including customers from one of plaintiffs. Court granted plaintiffs' motion for summary judgment on infringement claim.

Atari Interactive, Inc. v. Redbubble, Inc., No. 18-3451, 2021 U.S. Dist. LEXIS 35976 (N.D. Cal. Jan. 28, 2021)

Video game company Atari sued "print-on-demand" retailer Redbubble for infringement, alleging Redbubble displayed, offered for sale and sold products bearing Atari's copyrighted designs. On cross-motions for summary judgment on direct infringement claim, parties

disputed whether Redbubble's copying of Atari's copyrighted works was "volitional." Redbubble operated online marketplace wherein artists could upload various designs, which Redbubble then offered for sale to consumers printed onto various physical products (apparel, etc.) by projecting images of uploaded artwork onto stock images of such products. When user purchased product, Redbubble processed payment and arranged for third-party manufacturer to print and ship product to consumer. On direct infringement claim, district court considered whether Redbubble's conduct in hosting online marketplace and facilitating sale and manufacture of infringing items constituted direct infringement. District court concluded that Redbubble's conduct in displaying images was not volitional, because display is conducted automatically without Redbubble's affirmative intervention; Redbubble system is programmed to display images uploaded by artists, and to project said images onto stock photos of physical goods such as apparel. Because Redbubble website was designed in "copyright protective" way, with rules to address infringement by user, district court found Redbubble's display of Atari's copyright images not volitional, and accordingly granted summary judgment to Redbubble on direct infringement of display right claim. However, district court found genuine dispute of material fact on direct infringement of distribution right claim. Because Redbubble designed its system to sell, deliver and manufacture products that may bear infringing works (and because it derives financial benefits from such sales), Redbubble found to "exercise control" over such sales, such that reasonable jury could find direct infringement of distribution right. Parties' cross-motions for summary judgment on direct infringement of distribution right denied.

Williams-Sonoma, Inc. v. Amazon.com, Inc., No. 18-7548, 2020 U.S. Dist. LEXIS 163066 (N.D. Cal. Aug. 17, 2020)

District court denied defendant's motion to dismiss. Plaintiff national retailer sued Amazon for reproducing plaintiff's copyrighted photo of peppermint bark without authorization in connection with Amazon resellers' listings of plaintiff's peppermint bark for sale. Plaintiff initially sent Digital Millennium Copyright Act (DMCA) notices to Amazon resellers and sued Amazon for non-copyright claims, until learning in discovery that Amazon itself chose product image via algorithm based on different photos submitted by resellers. On motion to dismiss, Amazon argued that plaintiff had not properly alleged that Amazon engaged in volitional conduct necessary to state claim for direct copyright infringement. Noting that Ninth Circuit *Zillow* court held that automatic copying, storage and transmission of copyrighted materials, when instigated by others, does not meet direct infringement threshold, district court distinguished facts of *Zillow*. First, *Zillow* was decided at summary judgment stage, whereas at motion to dismiss stage district court must draw all reasonable inferences in favor of plaintiff. In addition, plaintiff's allegations indicated that Amazon's image-selection algorithm selected image it deemed most likely to support sale, thus amounting to Amazon's editorial, qualitative decision. Further, Amazon's system picked most attractive photos for use with product, irrespective of rights. Moreover, Amazon not only selected images to be searched by consumers, but also published such images in its sole discretion. District court accordingly held that plaintiff had properly alleged volitional conduct by Amazon to state claim for direct infringement, and therefore denied motion to dismiss.

SA Music, LLC v. Amazon.com, Inc., No. 20-105, 2020 U.S. Dist. LEXIS 103373 (W.D. Wash. June 12, 2020)

District court granted Amazon's motion to dismiss infringement claims to extent based on Amazon "making available" downloads through its online music store, because violation of distribution rights requires actual dissemination of copyrighted works from one computer to another. Plaintiffs, heirs to American composers Harold Arlen, Ray Henderson and Harry Warren, sued Amazon alleging that, after other defendants made unauthorized recordings of plaintiffs' copyrighted compositions, Amazon made recordings available for sale at lower price than legitimate recordings. Amazon moved to dismiss copyright infringement claim to extent based on allegation that Amazon's "making available for sale" constituted infringement of exclusive distribution right under § 106(3). Court held that mere offering of copyrighted work in digital music store, absent allegation of sale, insufficient to constitute dissemination (that is, transfer from one computer to another) required for violation of distribution right. Although making recordings available on filing sharing networks constitutes infringement, Amazon's music store requires that purchase be made before copy of recording is distributed. Likewise, although "making available" by lending library constitutes infringement, again because libraries do not require customer to pay for work before download can occur. District court concluded that distribution claim requires "actual dissemination" of copyrighted work and that no such dissemination occurred where recordings not sold and downloaded.

Tom Hussey Photography, LLC v. BDG Media, Inc., No. 20-404, 2020 U.S. Dist. LEXIS 238433 (D. Del. Dec. 18, 2020)

District court granted motion to dismiss due to plaintiff's failure to allege volitional conduct. Plaintiff photographer owned copyright in "Reflections" photo series that depicted elderly subjects looking into mirror at younger version of themselves. Defendant media holding company purchased website Flavorwire that years prior to website's purchase began hosting article in which plaintiff's photo series was discussed and displayed. Plaintiff discovered article on Flavorwire website after defendant had purchased site. Plaintiff repeatedly requested that defendant take down plaintiff's photographs from site. After defendant failed to respond, plaintiff filed suit for infringement. Defendant moved to dismiss for failure to state claim. District court analyzed volitional conduct alleged within complaint, noting that volitional conduct inquiry looks to whether defendant *caused* copyrighted material to be infringed. Plaintiff's complaint contained only one volitional act ascribed to defendant: its purchase of website containing allegedly infringing copies of plaintiff's works. Plaintiff argued that defendant was liable for declining to take down copyrighted works. However, district court found that such passive display of copyrighted work was not enough to state claim for infringement. Defendant did not commit initial act of making copyrighted work visible, as it had merely purchased website after work had already been posted onto site. District court therefore concluded that plaintiff failed to state claim for direct infringement.

VI. DEFENSES/EXEMPTIONS

A. Fair Use

Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183 (2021)

Supreme Court held that Google's unauthorized copying of around 11,500 lines of Oracle's computer code was fair use. Java SE is computer program that uses popular Java computer programming language originally developed by Sun Microsystems (Oracle's predecessor). Google acquired startup Android Inc. in 2005, when many software developers understood and wrote programs in Java, particularly using Sun's Java SE platform, which allowed them to write programs that would run on any desktop or laptop computer. To enable its roughly 100 programmers to create Google's Android software platform for smartphones, Google copied verbatim roughly 11,500 lines of code from Java SE program that are part of tool called Application Programming Interface or API, which is tool that allows programmers to use prewritten code to build certain functions, rather than writing their own code from scratch. Specifically, programmer enters string of code called "method call," which invokes particular task, located within particular class, in turn located within particular package. Lines of code that name methods, classes and packages are "declaring code," which was at issue. Declaring code both constitutes set of shortcuts for programmers and reflects precise way in which Java's creators concretely set out particular tasks. Each method's declaring code is associated with particular lines of "implementing code," which actually instructs computer in programmer's application. Google copied Java SE declaring code for tasks most likely to be useful to Android programmers but wrote its own implementing code. Android was released in 2007 and Android-based devices were very successful, producing more than \$42 billion in revenue as of 2015. In 2010, Oracle purchased Sun and soon thereafter sued Google for copyright infringement. After Federal Circuit overturned jury verdict that Google's use of declaring code was fair, Google appealed on grounds that declaring code not copyrightable and, even if it is, Google's use was fair. Supreme Court expressly declined to decide whether Oracle's declaring code was copyrightable, accepting that it fell within definition of what can be copyrightable "purely for argument's sake." Court then found that all four fair use factors weighed in favor of Google. First, although Java API declaring code was part of computer program (which is generally copyrightable), it differed from other kinds of copyrightable code because it was inextricably bound together with: (1) uncopyrightable general system of dividing computing tasks; (2) uncopyrightable idea of organizing tasks; (3) use of specific commands (method calls), which were not claimed by be copyrighted; and (4) copyrightable implementing code, which was all created by Google. Moreover, Java's creators intentionally tried to write declaring code that would be intuitively easy to remember to attract programmers. Accordingly, declaring code, "if copyrightable at all," was further from core of copyright than most computer programs (e.g., implementing code), such that "nature of the copyrighted work" supported fair use. Second, "purpose and character" of Google's use was transformative because it reimplemented Java API in new environment, namely, smartphones. Even though Google used Java declaring code for same purpose for which Sun created it (to enable programmers to call up implementing programs to accomplish specific tasks), Google's use was transformative because it sought to create

“new products” and made it easier for programmers to use previously acquired skills. Third, despite Google’s verbatim copying of 11,500 lines of declaring code, “amount and substantiality” factor weighed in favor of fair use because it was “tethered” to Google’s transformative purposes. Moreover, copied declaring code was inseparably bound to implementing code that actually carried out necessary tasks, and which was independently created by Google. Finally, because Oracle failed to meaningfully compete in smartphone market, and because allowing Oracle to enforce its copyright would cause damage to public (including computer programmers who had invested in learning Java), “market effect” of Google’s copying weighed in favor of fair use.

Brown v. Netflix, Inc., No. 20-2007, 2021 U.S. App. LEXIS 14673 (2d Cir. May 18, 2021)

Plaintiffs, authors and copyright owners of song “Fish Sticks n’ Tater Tots,” sued Netflix *et al.* for infringement because song is played in scene in 2017 film entitled *Burlesque: Heart of Glitter Tribe*, available for viewing on defendants’ video streaming platforms. District court granted defendants’ motion to dismiss, finding use of song was fair use. Second Circuit, reviewing *de novo*, affirmed. Second Circuit cited its own precedent for proposition that when allegedly infringing work fits description of uses described in § 107 preamble, such as criticism, comment, or scholarship, there is “strong presumption” that first factor favors defendant. Documentary character of film fits within uses identified by § 107; film provides commentary on burlesque art form and its resurgence in Portland, Oregon, as well as exploration of artistic process of group of dancers on whom film centers. Incidental use of song was consistent with film’s nature as documentary, providing commentary and criticism. Accordingly, film was entitled to presumption in favor of fair use under factor one. Third factor also favored fair use. Only eight-second snippet of song (of 190 seconds total) is heard in film. Although refrain used may be “heart” of song, recognizable chorus can be used fairly when use is “reasonable in relation to purpose of copying,” here documentary providing commentary on and criticism of aspects of burlesque, as evident in certain dancers’ performances. On fourth factor, court found that as film contains only eight-second excerpt of song’s chorus embedded in documentary film, intended audience for song would be unlikely to purchase film “in preference to original.” Even crediting plaintiffs’ assertion that licensing market existed for song as dance music or background music in films – assertion not contained in complaint – film’s brief use of small portion of song as component of event recorded for documentary purposes did not plausibly fall within traditional or well-developed market for song. Judgment affirmed.

Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 992 F.3d 99 (2d Cir. 2021)

Second Circuit reversed district court’s holding that plaintiff’s creation of unauthorized derivative works of defendants’ work was fair use, in part because derivative works did not serve fundamentally different and new purposes, and therefore were not transformative. In 1981, photographer Lynn Goldsmith took series of photographs of singer-songwriter Prince and, in 1984, her agency licensed *Vanity Fair* to use one of her photographs (“Photograph”)

in illustration commissioned by another artist, Andy Warhol. Goldsmith did not learn until 2016 that artist in question was Any Warhol, and that he had made 15 other unauthorized works based on her Photograph (“Prince Series”), in which Warhol cropped and flattened Photograph, among other changes. In decades since, and unbeknownst to Goldsmith, The Andy Warhol Foundation for the Visual Arts (“Foundation”) had licensed Prince Series works to museums and publications for profit. Foundation sued Goldsmith and her agency for declaration that Prince Series was not infringing or else made fair use of Goldsmith’s Photograph. Defendants counterclaimed for copyright infringement. District court granted summary judgment for Foundation, finding it had made fair use of Goldsmith’s Photograph and, specifically, that Prince Series transformed Goldsmith’s work because “the Goldsmith Photograph portrays Prince as ‘not a comfortable person’ and a ‘vulnerable human being,’ [but] the Prince Series portrays Prince as an ‘iconic, larger-than-life figure.’” On appeal, Second Circuit reversed, resolving all fair use factors in defendants’ favor. With regard to first factor, it found that artist’s intent not determinative; instead, court must assess “how the works may reasonable be perceived.” Specifically, courts should review whether subsequent work’s use of predecessor work “is in service of a ‘fundamentally different and new’ artistic purpose and character, such that the secondary work stands apart from the ‘raw material’ used to create it,” and at minimum, subsequent work must “comprise something more than the imposition of another artist’s style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material.” Applying these standards, Second Circuit found that Prince Series was not transformative because purpose and function of parties’ respective works is same in that they are both portraits of Prince, and Warhol kept most “essential elements” of Goldsmith’s Photograph and did not augment or change elements meaningfully. Moreover, Photograph was both unpublished and creative work, weighing against fair use. Likewise, Prince Series borrowed significantly from Photograph both quantitatively and qualitatively, and cropping and flattening did not change fact that Prince Series works all readily identifiable as deriving from specific Photograph. Finally, although markets for Prince Series and Photograph did not “meaningfully” overlap, Foundation failed to put forth evidence that Prince Series posed no threat to Goldsmith’s actual or potential revenue from print magazine licensing market, and further potential harm to Goldsmith’s derivative market was substantial.

Dr. Seuss Enters., Ltd. P’ship v. ComicMix LLC, 983 F.3d 443 (9th Cir. 2020)

Ninth Circuit reversed district court’s decision and held that Star Trek-themed sendup of Dr. Seuss work was infringement rather than fair use. Plaintiff, owner of copyrights in Dr. Seuss works, including perennial graduation favorite *Oh, the Places You’ll Go!* (“*Go*”), regularly licensed such works to third parties. In 2016, defendant ComicMix decided to create *Oh, the Places You’ll Boldly Go!* (“*Boldly*”), mash-up recontextualizing Stark Trek crew in Seussian world. Defendant intentionally crafted *Boldly* to evoke, and sometimes slavishly copy, *Go* and two other Seuss works, with intent to publish for graduation season. After defendant began crowdfunding for *Boldly*, plaintiff sent cease-and-desist letter and, when defendant did not comply, sued for copyright infringement. District court sided with defendant, holding that (still-unpublished) *Boldly* was transformative parody of *Go* that would not affect plaintiff’s sales. On plaintiff’s appeal, Ninth Circuit decisively reversed

district court, finding that all four fair use factors weighed in plaintiff's favor. First, *Boldly* neither critiqued nor commented on *Go*, and only mimicked *Go*'s expressive elements "to get attention or to avoid the drudgery in working up something fresh." Second, because *Go* was creative, expressive work, this weighed against fair use finding. Third, *Boldly* used both quantitatively and qualitatively significant amount of *Go*, copying as closely as possible nearly 60% of *Go* in addition to significant illustrations from other Seuss works, collectively comprising "heart" of said works. Finally, defendant intended for *Boldly* to capitalize on same graduation market as *Go* and, moreover, plaintiff already extensively licensed works to and collaborated with other creators, such that *Boldly* and similar unlicensed works would entail market harm to plaintiff. Also, defendant's "unrestricted and widespread conduct" could create incentives to pirate copyrights and disincentivize creation of illustrated books such as *Go*. Defendant, accordingly, could not sustain fair use defense.

MidlevelU, Inc. v. ACI Info. Grp., 989 F.3d 1205 (11th Cir. 2021)

Eleventh Circuit denied defendant's motion for judgment as matter of law despite jury's finding that defendant's use of plaintiff's copyrighted blog posts was not fair. Plaintiff provided resources for midlevel healthcare providers, generating revenue through various resources and publishing free blog to attract potential customers. Plaintiff made full text (rather than only headlines and summaries) of its blog articles available in RSS feed and coded its website to allow search engines to copy and archive every webpage. Defendant wholesale aggregator of news publications created curated index of abstracts and full-text articles for thousands of academic blogs ("Index"). Defendant subscribed to plaintiff's blog's RSS feed and included, for each article in Index, bibliographic information, computer-generated summary, link to original, and (for subscribers only) link that opened original webpage with full-text content within Index website. Although defendant removed plaintiff's content from Index upon plaintiff's demand, plaintiff's content was still available through certain of defendant's subscribers, so plaintiff sued for copyright infringement. Jury held that defendant's use was not fair, and defendant appealed. Eleventh Circuit held that reasonable jury could have found in plaintiff's favor on fair use. Although Index had some search engine features, making copyrighted material searchable does not automatically change material's original purpose. Jury could have reasonably found that Index's purpose was commercial and not transformative because Index included full-text content of plaintiff's articles. Further, plaintiff's articles were not bare factual compilations, so jury could have found them sufficiently creative to constitute core creative works for fair use purposes. Defendant also copied entirety of some articles to provide full-text access to subscribers and jury could have held that defendant's computer-generated summaries also copied substantial portion of plaintiff's works. Although it was unclear whether defendant's Index impacted market for plaintiff's articles, jury could have reasonably found that Index's inclusion of full-text articles could serve as market substitute.

Marano v. Metropolitan Museum of Art, 844 F. App'x 436 (2d Cir. 2021)

Second Circuit affirmed district court's holding that museum website's display of photograph of musician playing guitar was fair use because museum highlighted guitar itself

rather than musician. In 1982, plaintiff photographer took photograph of Eddie Van Halen playing his “Frankenstein” guitar (“Photograph”), which defendant Metropolitan Museum of Art (“Met”) included in website exhibition of rock n’ roll instruments. District court ordered plaintiff to show cause why his claim should not be dismissed on ground that Met’s use of Photograph was transformative, therefore fair, and, when plaintiff failed, dismissed complaint. On appeal, Second Circuit affirmed, holding that Met had transformed plaintiff’s work “by foregrounding the instrument rather than the performer,” and, while plaintiff claimed that he created Photograph “to show what Van Halen looks like in performance,” Met instead highlighted “unique design” of Frankenstein guitar and “its significance in the development of rock n’ roll instruments.” Moreover, Met showcased Photograph next to other photographs displaying “physical composition of the guitar, which are collectively accompanied by text discussing the guitar’s genesis, specifications, and impact on rock n’ roll music, not Van Halen’s biography or discography.” Finding that remainder of factors weighed in favor of fair use, court affirmed district court’s dismissal of plaintiff’s complaint.

Marano v. Metropolitan Museum of Art, 472 F. Supp. 3d 76 (S.D.N.Y. 2020)

District court dismissed plaintiff’s copyright infringement action because defendant’s use constituted fair use. Plaintiff, photographer, sued defendant Met for copyright infringement for posting his photo of guitarist Eddie Van Halen to museum’s website without his authority. Met included photo in its online catalogue for “Play It Loud: Instruments of Rock & Roll” exhibition. Court ordered plaintiff to show cause why case should not be dismissed under fair use doctrine. Court then dismissed plaintiff’s claim and held that Met’s use of photo was fair use, as it was transformative in nature. On first fair use factor, court found that use was transformative because plaintiff and Met used photo for entirely different purposes and in different contexts. Court also relied on fact that photo constituted “inconsequential portion” of Met’s online catalogue. While photo was “indisputably creative and published,” court found second fair use factor had minimal weight because transformative purpose of Met’s use was to emphasize photo’s historical rather than creative value. On third factor, court found that while photo was shown in its entirety, it was reasonable considering purpose and character of use. On fourth factor, court rejected plaintiff’s argument that museums are potential market for his work. Court found it unlikely that markets for photo’s original purpose would be affected. In sum, balance of fair use factors strongly favored Met’s use.

Schwartzwald v. Oath Inc., No. 19-9938, 2020 U.S. Dist. LEXIS 165641 (S.D.N.Y. Sept. 10, 2020)

District court dismissed plaintiff’s complaint for copyright infringement, finding that defendant’s use of photo constituted fair use. Photographer plaintiff alleged that defendant, owner of HuffPost.com, reproduced plaintiff’s photo of actor Jon Hamm without permission. Plaintiff alleged that original photograph showed Jon Hamm wearing pants in public, ostensibly without any underwear. Defendant published cropped version of photograph in article entitled *25 Things You Wish You Hadn’t Learned in 2013 and Must Forget in 2014*, with text box over Hamm’s groin area that read “Image Loading,” and caption that made fun

of Hamm, and public's fascination with photo. Defendant asserted fair use defense. District court found that defendant's use of photo was transformative, in part because purpose of photo was to mock rather than to "expose" Hamm, and to mock virality of photo. In addition, use of text box transformed photo, making it no longer illustrative of Hamm without underwear. District court also found that plaintiff properly alleged photo was used for commercial purposes, but had not pleaded bad faith. With respect to remainder of fair use factors, district court held original photo was more factual than creative and was published, and thus entitled to greater leeway for fair use. Regarding substantiality, district court found that cropping of photo and placement of superimposed text – which obscured portion of photo that allegedly made it noteworthy in first instance – was reasonable use of photo to identify object of controversy and satirize Hamm. District court also held that effect of use upon potential market for or value of copyrighted work weighed in favor of fair use, because it was unlikely that potential purchasers of photo would choose defendant's transformative version over original, as defendant had obscured central feature of original photo. Reviewing totality of factors, district court held that all factors pointed in favor of fair use, other than that defendant's use of photo was for commercial purposes, but such factor was of less significance in light of transformative nature of defendant's use of photo. District court therefore concluded that defendant's use of photo was fair as matter of law, and granted motion to dismiss.

Boesen v. United Sports Publ'ns, Ltd., No. 20-1552, 2020 U.S. Dist. LEXIS 203682 (E.D.N.Y. Nov. 2, 2020)

District court held that online publication's embedding of Instagram post featuring plaintiff's photograph protected by fair use where post was subject of article. Professional tennis player Caroline Wozniacki announced her retirement in Instagram post ("Post") that included cropped, low-resolution version of photograph taken by plaintiff ("Photograph"). Defendant sports news publisher ran online article about Wozniacki's retirement, embedding and commenting on her Post. Plaintiff sued defendant for infringement based on defendant's use of Photograph. Court found that all fair use factors weighed in defendant's favor. First, defendant's embedding of Post into news article to report on Post and content thereof, rather than to use Post as "generic image" of Wozniacki, rendered defendant's use transformative. Defendant's status as for-profit publisher irrelevant where plaintiff failed to allege that defendant derived commercial benefit specifically from embedding Post. Second, because Photograph was of famous athlete playing sports, it was informational as well as expressive in nature. Third, defendant's embedding reasonable in relation to purpose of copying because defendant had no control over presentation of Photograph when embedding Post, embedded Post retained all Instagram markings and reproduction of entire Post was necessary where article about Post itself. Finally, because Photograph appeared as lower-resolution, cropped version alongside Wozniacki's text, Post would be poor substitute for Photograph in market.

Lanard Toys v. Anker Play Prods., No. 19-4350, 2020 U.S. Dist. LEXIS 221783 (C.D. Cal. Nov. 12, 2020)

Court granted plaintiff's motion for summary judgment on defendant's affirmative defense of fair use where defendant provided no evidence of fair use of plaintiff's work and defendant's intended use was for commercial gain. Plaintiff toy manufacturer sued defendant, competing manufacturer and distributor of children's activity play products, alleging that defendant infringed plaintiff's copyrights in its "Chalk Bomb!" product – toy ball comprised of chalk powder, and its related packaging – by selling and promoting similar product bearing mark "Chalk Blast." In response, defendant raised various affirmative defenses, including fair use. Both parties moved for summary judgment. Court denied both parties' motions as to copyright infringement, concluding that genuine issue of material fact existed as to striking and substantial similarity between plaintiff's and defendant's product packaging. Court granted summary judgment on defendant's fair use defense, acknowledging that defendants provided no evidence to support defense. Court held that balance of fair use factors overwhelmingly favored plaintiff because (1) defendants used plaintiff's works commercially and derived financial benefit from that use, (2) plaintiff's copyrights protected original artwork for its packaging, and (3) there was presumption of likelihood of market harm where defendants' intended use was for commercial gain.

Bain v. Film Indep., Inc., No. 18-4126, 2020 U.S. Dist. LEXIS 141859 (C.D. Cal. Aug. 6, 2020)

Plaintiff Robin Bain was author, producer, director, and actress in film *Nowhereland*, distributed as *Girl Lost*. Defendant Jessica Cesaro p/k/a Jessica Haid appeared in film. Plaintiff alleged that Haid asked plaintiff to allow her to add scenes from film to personal acting reel, which request plaintiff denied for fear of unauthorized release. In 2017, after film had been exhibited in 2016 film festivals but before wider release, Haid procured watermarked copy of film and retained defendant LA Media Works to edit scenes from film to create personal acting reel she could submit for further acting roles. To create reel, Haid shared film with LA Media via Google Drive, and LA Media removed watermark from scenes in which Haid appeared when creating reel. LA Media created at least two versions of reel, longer of which was three minutes 39 seconds and included 40 clips from 95-minute film. All but two of 40 clips were less than 10 seconds. Plaintiff brought suit for direct, vicarious, and/or contributory infringement, as well as violations of DMCA. Defendant moved for summary judgment based on fair use defense. On first fair use factor, court found acting reel transformative because film told story of female sexual exploitation, whereas reel had no story, and its purpose was to showcase Haid's acting abilities. Further, reel largely showed brief portions of scenes that provided little information about plot. On second factor, court noted that by time Haid created reel, film had been seen at six festivals, but not commercially released; accordingly, factor two weighed in plaintiff's favor. On third factor, court noted that even longer reel amounted to less than 4% of film's 95 minutes, with most clips lasting less than 10 seconds. Even in taking relatively large portion of two-minute, 37-second "pivotal" scene, court found that amount taken served purpose of showing Haid's range in manner that might not have been conveyed in shorter scene, and found factor

weighed in favor of Haid. On final factor, court found no evidence that Haid required payment for reel or distributed film to anyone but LA Media, and there existed “no reasonable probability” that distribution of Haid’s reel to directors would interfere with profitability or market for film; each had different functions. Accordingly, fourth factor also weighed in Haid’s favor. Weighing factors together, court found defendant made fair use of film, and granted summary judgment on plaintiff’s infringement claims.

Alexander v. Take-Two Interactive Software, Inc., No. 18-966, 2020 U.S. Dist. LEXIS 177130 (S.D. Ill. Sept. 26, 2020)

District court denied defendants’ motion for summary judgment on fair use defense. Plaintiff tattoo artist inked five copyrighted tattoo designs onto WWE professional wrestler Randy Orton; defendant created *WWE 2K* video game series which contained realistic depictions of WWE professional wrestlers, including depiction of Orton’s tattoos inked by plaintiff. On first fair use factor, defendants argued that use of copyrighted tattoos was transformative because purpose of original tattoos was to “reflect [Orton’s] personal expression,” whereas defendant’s use was meant to “depict Orton realistically.” Given material dispute, court found first factor could not be resolved on summary judgment. On second factor, court rejected defendant’s argument that tattoo artworks were insufficiently creative, pointing to artistry involved in works and plaintiff’s ownership of copyright for tattoo images. On third factor, court agreed with plaintiff that defendant’s wholesale copying of tattoo images (without effort to only copy elements sufficient to create realism in defendant’s video game) militated against finding of fair use. Court discounted importance of fourth factor (market harm) and held that other factors did not support fair use as matter of law. Motion for summary judgment on fair use defense denied.

Reilly v. Louder With Crowder, LLC, No. 20-395, 2020 U.S. Dist. LEXIS 125725 (N.D. Tex. July 16, 2020)

District court denied motion to dismiss. Plaintiff photographer owned copyright in photograph depicting People for the Ethical Treatment of Animals (PETA) rally. Defendant published article on its website regarding PETA and seafood restaurant, with photo of restaurant next to cropped PETA rally photo taken by plaintiff. Plaintiff sued for infringement and defendant moved to dismiss, asserting fair use defense. Finding that fourth factor – i.e., value of or effect of use upon potential market for copyrighted work – could not be evaluated from face of complaint, district court concluded it was inappropriate to conduct fact-intensive fair use analysis at motion to dismiss stage, and denied motion.

Monsarrat v. Newman, No. 20-10810, 2021 U.S. Dist. LEXIS 10858 (D. Mass. Jan. 21, 2021)

District court granted motion to dismiss infringement claim, finding fair use as matter of law. In 2010, plaintiff authored and posted written material to LiveJournal online message board community dedicated to discussion of Davis Square, in Somerville, Massachusetts. In 2017, after LiveJournal announced revisions to its terms of service to comply with Russian law (and which defendant feared would lead to censorship of material on LiveJournal), defendant

copied entire content of Davis Square LiveJournal community onto different online message board. Plaintiff sued, alleging that defendant's reproduction of plaintiff's 2010 LiveJournal post (which concerned apparent harassment occurring in LiveJournal community) constituted infringement. Defendant moved to dismiss infringement claim, asserting fair use defense. District court found that first factor favored defendant, given that defendant's reproduction of plaintiff's post was for different purpose and of different character than plaintiff's original use; plaintiff's original post was meant to highlight LiveJournal's harassment policy, but defendant's reproduction "was created solely for historical and preservationist purposes." District court found second factor favored defendant, noting that plaintiff's original post concerned LiveJournal's harassment policy, which was "factual matter" and thus not sufficiently creative to enjoy broad scope of copyright protection. Third factor found neutral, considering that even though entirety of work was copied, "a full reproduction is consistent with historical and preservationist purposes." Fourth factor favored defendant, given that there was "no plausible market" for plaintiff's work, and thus "no likelihood" that defendant's reproduction could have harmful market consequences. Motion to dismiss infringement claim granted.

Rimini St. v. Oracle Int'l Corp., 473 F. Supp. 3d 1158 (D. Nev. 2020)

Oracle created, manufactured, and licensed software, specifically Enterprise Software Programs, which was continuously updated to enhance use and performance, correct bugs, and for security purposes. For additional fee, Oracle provided support to licensees, or licensees could seek third-party providers, such as Rimini, to provide support. Prior dispute between parties concerned Rimini's practice of copying customers' enterprise software to provide support to other customers. Subsequently, Rimini claimed it changed its practices, so they were no longer infringing, and brought declaratory judgment action seeking declaration that its new actions were not infringing. Oracle counterclaimed for infringement. Oracle moved for summary judgment on Rimini's fair use affirmative defense. Court found first factor weighed against fair use because Rimini's purpose in using Oracle's software was commercial. Court also could not find Rimini's new use was transformative because update in question was implemented in plaintiff's original work. On second factor, court found nature of work also weighed against fair use. On third factor, court found use was quantitatively and qualitatively significant. On final factor, court found that Rimini's use did have effect on software market, as Rimini and Oracle were competitors for software support. Finding that factors militated against finding fair use, court granted Oracle summary judgment on Rimini's fair use defense.

B. Statute of Limitations

Michael Grecco Prods. v. BDG Media, Inc., 834 F. App'x 353 (9th Cir. 2021)

Ninth Circuit reversed in part dismissal of copyright action on statute-of-limitations grounds. District court held that plaintiff should have discovered defendant's alleged infringements of plaintiff's photograph more than three years before it filed complaint, because plaintiff invested in in-house infringement detection using Google image search, as well as third-party

reverse image search software. District court also dismissed as time-barred two claims first raised in amended complaint, one relating to new upload of original photograph at issue, and one about unrelated photograph. Both were uploaded within three years before complaint was filed, but over three years before amended complaint was filed. Ninth Circuit held that whether software should have discovered infringement was question of fact that could not be determined on motion to dismiss, reversing dismissal of that claim. Ninth Circuit also reversed dismissal of claim relating to new upload of subject photo, finding it related back to original complaint, and photo was uploaded within three years of original complaint. Ninth Circuit affirmed dismissal of claim about unrelated photograph, which was uploaded more than three years before amended complaint was filed, and did not relate back to original complaint.

Oracle Am., Inc. v. Hewlett Packard Enter. Co., 971 F.3d 1042 (9th Cir. 2020)

Ninth Circuit affirmed in part and reversed in part district court's grant of summary judgment in favor of defendant, Hewlett Packard Enterprise Co. (HPE) in infringement action brought by plaintiffs Oracle America, Inc. and Oracle International Co. Oracle owned proprietary Solaris software operating system and granted customers limited license, and required customers prepay for yearly support contract for access to server patches. HPE provided support for all its customers' servers, including servers running Solaris software, and subcontracted indirect support to third party, Terix Computer Co. Terix arranged for HPE-Terix customers to have Oracle support for all servers via single-server support contract by downloading Solaris software patches to make copies for servers unsupported by contract. In 2013, Oracle sued Terix for infringement and court granted Oracle summary judgment. Oracle and HPE agreed to toll statute of limitations for any claims that Oracle would assert against HPE, effective May 2015. In 2016, Oracle filed suit alleging that HPE "improperly accessed, downloaded, copied, and installed Solaris patches on servers not under an Oracle support contract," asserting direct copyright infringement claims concerning HPE's direct support customers, and indirect infringement claims concerning joint HPE-Terix customers. District court granted summary judgment to HPE. Ninth Circuit affirmed on statute of limitations grounds, determining that, under Act's three-year statute of limitations, HPE was entitled to summary judgment on infringement claims for pre-May 2012 conduct. Court explained that Oracle (a) had constructive knowledge of wrongdoing by HPE and Terix, given that it concededly looked into Terix and HPE after it received information regarding potential infringement in 2008 and 2011, and thus had duty to investigate; and (b) failed to conduct reasonable investigation into suspected infringement because Oracle failed to use its contractual right to audit customers. Court dismissed Oracle's argument that limitations should be tolled because HPE used fraudulent means to keep Oracle unaware of its actions, and therefore, it had no duty to inquire.

WB Music Corp. v. Stolz, No. 18-55835, 2020 U.S. App. LEXIS 22036 (9th Cir. July 15, 2020)

Plaintiffs alleged defendants infringed plaintiffs' copyrights through radio broadcasts of 11 songs in November and December 2014. Defendant appealed trial court's grant of summary

judgment, denial of defendant's motion for judgment on pleadings, and award of fees and costs to plaintiffs. Ninth Circuit found that district court properly granted partial summary judgment on vicarious liability claim – broadcast was unauthorized because ASCAP had revoked defendants' relevant licenses, and defendants' licensing fee dispute with ASCAP was not relevant to unclean hands affirmative defense, because defense would require misconduct by plaintiffs rather than ASCAP. Circuit court found further that district court correctly denied defendants' motion for judgment on pleadings because statute of limitations and laches defenses were inapplicable. Defendant argued that relevant date was August 21, 2012, when ASCAP gave notice of termination of radio stations' licenses, because plaintiffs had knowledge of infringement as of that date. Argument failed to acknowledge separate accrual rule; regardless of any earlier infringing broadcasts, statute of limitations ran separately from each of 2014 broadcasts. Ninth Circuit affirmed district court's grant of partial summary judgment, denial of defendant's motion for judgment on pleadings, and award of fees and costs to plaintiffs.

Stross v. Hearst Communs., Inc., No. 18-1039, 2020 U.S. Dist. LEXIS 161293 (W.D. Tex. Sept. 3, 2020)

Plaintiff photographer brought suit against publishers for unauthorized use of plaintiff's photos of "tiny houses" on Llano River, alleging defendants exceeded scope of limited license and asserting claims for direct and contributory infringement. Plaintiff moved for partial summary judgment on direct infringement claims and against defendants' multiple affirmative defenses. On statute of limitations defense, defendants failed to establish that infringement claims accrued outside of applicable limitations period, whether determined based on actual or constructive discovery of infringement. Applying discovery rule to case, district court found that although defendants failed to satisfy their burden regarding when plaintiff discovered infringement, plaintiff did not present indisputable evidence regarding when accrual of direct infringement occurred. District court therefore denied plaintiff's motion for summary judgment with respect to defendant's statute of limitations defense, finding issues of fact as to when plaintiff did or should have discovered infringement and whether he exercised due diligence.

Woodson v. Atlantic City Bd. of Educ., No. 19-14572, 2020 U.S. Dist. LEXIS 238373 (D.N.J. Dec. 18, 2020)

District court granted plaintiff's second motion to amend to allege statute of limitations on copyright claim was tolled by discovery rule. Plaintiff, teacher at defendants' school, claimed copyright infringement based on article she prepared that defendants later published without giving credit. Court found first amended complaint plausibly alleged facts supporting copyright ownership, but failed to plausibly allege that statute of limitations period on copyright claim was tolled by discovery rule. Plaintiff moved to amend first complaint to include details of when she first learned of publication. Court found second amended complaint provided facts sufficient to satisfy discovery rule, so as to toll statute of limitations on copyright claim. Defendants did not meet burden to show plaintiff should have discovered infringement earlier than when she claimed to have first learned of it.

Defendants contended plaintiff *could* have discovered alleged infringement, but court determined limitations clock starts when plaintiff *should* have discovered infringement. Thus, second amendment not futile.

Clancy v. Jack Ryan Enters., No. 17-3371, 2021 U.S. Dist. LEXIS 26553 (D. Md. Feb. 10, 2021)

On defendants' summary judgment motion, district court held that plaintiff's ownership and work for hire claims not barred by statute of limitations as matter of law. Famous novelist Tom Clancy first introduced Jack Ryan character in book *Hunt for Red October* in 1984. Under publishing agreement, Clancy assigned all rights and copyright to U.S. Naval Institute ("USNI"), which obtained copyright registration for *Hunt*. In 1985, Clancy and first wife Wanda King, with whom he had four children, formed Jack Ryan Enterprises Ltd. ("JREL"). JREL signed publishing agreements with Putnam representing that JREL was sole author of new Ryan works and appended guaranties signed by Clancy personally that foregoing works made for hire. Copyright registrations for JREL works listed JREL as author. In 1987, following dispute with USNI regarding ownership of Ryan character, USNI reassigned copyright to *Hunt* to Clancy; USNI thereafter assigned rights to *Hunt* to JREL. In 1992, Clancy and King formed Jack Ryan L.P. ("JRLP" and, with JREL, "JR Entities") and signed further publishing agreements and guaranties with Putnam for subsequent Ryan works. Copyright registrations for JRLP works listed JRLP as author. In 1992 and 1994, Clancy entered into employment agreements with JR Entities confirming Clancy's continued assignment to respective JR Entities of all rights in his works for each entity in exchange for compensation. In 1995, Clancy, as sole owner, formed Rubicon Inc. and entered into publishing agreements with Putnam for further works. In 1996, Clancy and King signed separation agreement that appended as Schedules A and B lists of literary works identified as respective assets of JR Entities. Separation agreement also provided that Clancy would assign to JR Entities any agreements relating to story lines or characters from respective JR Entities works but would otherwise be free to use characters from JR Entities works in subsequent works. Following Clancy's death in 2013, Putnam proposed two posthumous works with Ryan and other characters, which would require agreement among JR Entities, Rubicon and Clancy's Estate re proceeds distribution. In February 2014, Estate's representative sent letter to Clancy's counsel and counsel for King and her children, copying plaintiff Clancy's second wife/surviving spouse, asserting that Ryan character owned by JREL and other characters owned by Rubicon. Plaintiff retained her own counsel and approved publication of first book proposed by Putnam. However, plaintiff subsequently requested documentation supporting conclusion that JREL owned Ryan character, in response to which Estate's representative, in January 2015, provided plaintiff with, inter alia, USNI-related agreements. In March 2016, plaintiff served § 203(a) termination notice recapturing rights to *Hunt*, including all character rights. In August 2017, plaintiff filed declaratory judgment action against Estate's representative, JR Entities and Rubicon seeking, inter alia, declaration of plaintiff's ownership of Ryan and other characters as well as of Estate's ownership of JR Entities works on ground that they were not works for hire and were not validly assigned to JR Entities (or, alternately, if works were validly assigned, that such assignments are terminable). JR Entities moved for summary judgment on plaintiff's

ownership claims as time-barred, arguing that February 2014 letter constituted express repudiation of Estate's ownership of Ryan character so claim accrued then, while Estate's ownership claims against JR Entities accrued each time Clancy executed agreement with these entities relating to his alleged works for hire. Plaintiff countered that ownership claim did not accrue until January 2015, when plaintiff received USNI agreements that undercut JREL's claim to owning Ryan character, while claims relating to works for hire did not accrue before Clancy's death because JR Entities were his alter egos, so could not repudiate his ownership. District court held that material issue of fact existed as to whether February 2014 letter was express repudiation of all ownership rights or merely opinion tied only to posthumous book deal. Further, Clancy had no ownership claim against JR Entities during his lifetime because he continued to be credited as author, received profits, and was entitled to use and develop all characters in his discretion. Accordingly, court denied summary judgment on statute of limitations grounds as to all plaintiff's claims.

Rimini St. v. Oracle Int'l Corp., 473 F. Supp. 3d 1158 (D. Nev. 2020)

Oracle created, manufactured, and licensed software, specifically Enterprise Software Programs, which was continuously updated to enhance use and performance, correct bugs, and for security purposes. For additional fee, Oracle provided support to licensees, or licensees could seek third-party providers, such as Rimini, to provide support. Prior dispute between parties concerned Rimini's practice of copying customer's enterprise software to provide support to other customers. Subsequently, Rimini claimed it changed its practices, so they were no longer infringing, and brought declaratory judgment action seeking declaration that its new actions were not infringing. Oracle counterclaimed for infringement. Oracle moved for summary judgment on Rimini affirmative defenses. On Rimini's statute of limitations defense, court found disputed issues of fact as to whether it would have been reasonable for Oracle, upon hearing that Rimini had begun offering support services for EBS software, to investigate whether Rimini was utilizing same infringing practices with that software as Oracle suspected Rimini was with others. Court additionally found issues of fact as to whether Oracle gained knowledge or could be charged with knowledge about possible infringements outside three-year period. Court denied motion for summary judgment on Rimini's statute of limitations defense.

Live Face on Web, LLC v. Rockford Map Gallery, LLC, No. 17-539, 2020 U.S. Dist. LEXIS 182208 (D. Del. Sept. 30, 2020)

District court granted summary judgment for defendant, holding that plaintiff's claims were time-barred. Defendants' websites used third-party software that caused video overlay of virtual greeter to appear on website. Plaintiff alleged that such product infringed plaintiff's copyrighted JavaScript code. Plaintiff conducted initial pre-suit investigation in December 2013 and January 2014, including visiting one of defendants' sites, and downloading thousands of videos of virtual greeters from third-party's website, among which were videos made for defendants' websites. Plaintiff claimed it did not view such "greeter" videos made for defendants' websites until 2015, and it did not file suit until May 2017. District court found that defendants met burden of establishing adequate storm warnings, as plaintiff (a)

knew in late 2013 that third-party and its customers were allegedly violating plaintiff's copyright; (b) possessed allegedly infringing videos linked to defendants' sites by January 2014, with knowledge that each video was linked to alleged infringers; and (c) had visited one of defendants' sites in December 2013. District court analyzed plaintiff's pre-suit due diligence, noting that plaintiff was sophisticated litigant that often pursued alleged infringers. Plaintiff claimed it lacked enough staff to review thousands of videos connected to potential infringers, but district court found such argument unavailing, and concluded that plaintiff identified some of defendants' allegedly infringing activities as early as December 2013. District court therefore held that no reasonable jury could find plaintiff met its burden of showing that it exercised reasonable due diligence but was still not able to uncover alleged infringement until 2015. Summary judgment was entered for defendant.

C. Res Judicata/Collateral Estoppel

Brandon v. NPG Records, Inc., 840 F. App'x 605 (2d Cir. 2020)

In 2015, plaintiff filed suit in Florida against several defendants, including Prince and Spike Lee, averring that song "Girl 6," written and performed by Prince in Spike Lee film of same name, infringed plaintiff's song "Phone Sex." Although plaintiff's registration covered only lyrics of song, plaintiff alleged works were substantially similar in terms of "two-word, two-pitch hook[s], the same trumpet hit arrangement, and a similar layout using an echo-sound reverberation effect." District court in Florida granted motion to dismiss by defendants not named in subsequent action, finding short phrases or common or ordinary words such as "phone sex" not protectible by copyright. Florida court did not analyze alleged infringement of melody, arrangement, or performance because plaintiff's registration only covered lyrics, and court rejected argument that elements were protected because plaintiff filed additional application during litigation pendency. Prince, Lee, and others received dismissal without prejudice due to insufficient service. Plaintiff subsequently instituted action in S.D.N.Y. against, *inter alia*, Prince and Lee for same infringement claim. District court granted motion to dismiss on collateral estoppel grounds. Plaintiff appealed. Court found that case involved identical issue raised in Florida litigation; infringement issue was litigated and determined in Florida litigation; and resolution of infringement issue was necessary for judgment in Florida litigation. Court also found plaintiff had full and fair opportunity to litigate infringement issue in Florida litigation, rejecting plaintiff's argument that if he had appealed Florida judgment to Eleventh Circuit, it would have deferentially reviewed judgment for clear error. Eleventh Circuit reviews grant of motion to dismiss *de novo*, and Second Circuit agreed Florida district court did not resolve factual issue. Moreover, failure to appeal to Eleventh Circuit did not bar application of preclusion. Second Circuit affirmed district court judgment.

Stross v. Netease, Inc., No. 20-861, 2020 U.S. Dist. LEXIS 183540 (C.D. Cal. Aug. 20, 2020)

Plaintiff photographers brought claims against defendant, Chinese internet technology company, for direct and vicarious or contributory infringement based on use of works on for-

profit website. Plaintiffs alleged defendant accessed works with assistance of NetEase Information Technology, defendant's California-based subsidiary, via "online search-and-copy campaign." Plaintiffs further alleged defendant directed activities to U.S. by setting up California-based subsidiary, having New York investor relations contact, listing itself on New York-based stock exchange, regularly filing SEC reports, and contracting with California-based non-party Quantil Networks to make content available to Chinese-speaking viewers in U.S. by means of U.S.-based servers. Defendant moved to dismiss based on lack of personal jurisdiction. Court found defendant collaterally estopped from asserting jurisdictional defense because another court found defendant was subject to personal jurisdiction under Fed. R. (4)(k)(2): issues in both cases were identical; jurisdictional issue was actually litigated in previous case; defendant had full and fair opportunity to litigate jurisdictional issue in previous case; and jurisdictional issue was necessary to decide on merits. Court denied motion to dismiss on lack of personal jurisdiction.

New Day Worldwide Inc. v. Swift, No. 19-9948, 2020 U.S. Dist. LEXIS 196525 (C.D. Cal. July 21, 2020)

Court granted motion to dismiss with prejudice. Plaintiffs alleged that Taylor Swift composition "Shake It" Off infringed plaintiff Jesse Graham's "Haters Gonna Hate." Swift moved to dismiss on grounds of failure to allege registration, and *res judicata* based on earlier suits. Court granted motion to dismiss on grounds that plaintiff failed to allege registration, as opposed to application for registration, and found that failure could not be cured by amendment. Court found that plaintiffs' claims were also barred by *res judicata*. Graham had previously filed same claims against Swift in three prior actions, some of which included other defendants named in current suit, and all three were dismissed, one with prejudice. Action was therefore dismissed as barred by *res judicata*, bar that cannot be overcome by amendment.

Rimini St. v. Oracle Int'l Corp., 473 F. Supp. 3d 1158 (D. Nev. 2020)

Oracle created, manufactured, and licensed software, specifically Enterprise Software Programs, which was continuously updated to enhance use and performance, correct bugs, and for security purposes. For additional fee, Oracle provided support to licensees, or licensees could seek third-party providers, such as Rimini, to provide support. Prior dispute between parties concerned Rimini's practice of copying customer's enterprise software to provide support to other customers. Subsequently, Rimini claimed it changed its practices so they were no longer infringing, and brought declaratory judgment action seeking declaration that its new actions were not infringing. Oracle counterclaimed for infringement. Oracle moved for partial summary judgment on infringement counterclaim and Rimini's license defense. First, Rimini claimed that claim preclusion prevented Oracle from receiving damages between September 28, 2011 through July 31, 2014 because Oracle chose not to bring these claims as part of its first suit, even though it could have. Court found that because damages accrued after filing of second amended complaint, Oracle was not precluded from seeking damages for time period in question. Second, Oracle claimed that Rimini was estopped from contesting liability on infringements because it had committed

same acts during earlier time period. Court found parties were same as in first lawsuit; court granted summary judgment to Oracle on issue of infringement based on same circumstances; and court found issues in suits were identical because evidence, arguments, discovery, and pretrial preparation would be same as in first case, and issues in both cases were “closely related.” Court granted partial summary judgment on Oracle’s counterclaim for infringement.

D. First Sale Doctrine

Capitani v. World of Miniature Bears, Inc., No. 19-120, 2020 U.S. Dist. LEXIS 148968 (M.D. Tenn. Aug. 18, 2020)

District court denied parties’ respective motions for summary judgment stemming from alleged infringing use of plaintiff’s illustrations on wall clocks. Defendant MiniBears Gems & Gifts, Inc. (“MBG”) moved for summary judgment, claiming first sale doctrine provided defense to plaintiff’s infringement claim. First sale doctrine, codified in § 109, provides that once copyright owner releases copyrighted item “lawfully made under this title” by sale, gift, or otherwise, copyright owner relinquishes all rights to that particular copy. Other district courts have held that defendant bears burden of proving product at issue was lawfully purchased before defendant may invoke first sale defense. As parties disagreed as to whether clocks at issue were manufactured before or after relevant licensing agreement with plaintiff expired, and whether \$800 royalty payment to plaintiff constituted sale, court denied MBG’s motion for summary judgment.

E. Misuse

Dolores Press v. Robinson, No. 15-2562, 2020 U.S. Dist. LEXIS 156200 (C.D. Cal. July 1, 2020)

Court denied defendants’ summary judgment motion because evidence did not as matter of law establish that plaintiffs engaged in copyright misuse. Dr. Eugene Scott, minister and originator of first 24-hour religious TV network, was author and copyright owner of certain audiovisual recordings of his religious teachings (“Works”), which he licensed plaintiff Dolores Press to distribute publicly in 1995. Starting in late 1990s, Scott distributed Works for free on his website and encouraged download, reproduction and redistribution of Works, but requested that users attribute Works to him and not use Works for commercial gain. Scott’s websites all contained notices expressing reservations of rights and Works displayed similar notices identifying Scott as copyright owner. Scott, upon his 2005 death, conveyed his copyright interests in Works to plaintiff Melissa Scott, who deactivated websites’ video on demand function. In 2014, defendant Robinson sought permission to share Scott’s Works with his students online and, when Melissa Scott refused, launched website sharing Works “to stick it to the devil.” Defendants moved for summary judgment on affirmative defense of copyright misuse, arguing that plaintiffs viewed defendants as potential competitors in use of Works and attempted to eliminate competition by using Copyright Act to deny defendants their First Amendment rights to free speech rather than to seek infringement damages.

Defendants did not allege that plaintiffs used Works to prevent development of competing products, but to prevent defendants from using Works themselves, which was purpose of copyright law.

Philips N. Am., LLC v. Summit Imaging Inc., No. 19-1745, 2020 U.S. Dist. LEXIS 214693 (W.D. Wash. Nov. 16, 2020)

Plaintiff, ultrasound machine manufacturer, alleged defendant servicing company had hacked into plaintiff's ultrasound systems, using program developed by defendant, in order to enable features in ultrasound systems for which certain of plaintiff's customers had not paid, causing violation of defendant's copyrighted software. Defendant counterclaimed that it had created its own proprietary software to enable it to service plaintiff's machines, and that such software did not circumvent plaintiff's software or infringe its copyrights. Defendant also sought declaratory judgment that plaintiff's copyright claims were misuse of copyright, because plaintiff allegedly moved to enforce its copyrights to exclude market competition. Plaintiff argued claim for copyright misuse was barred by *Noerr-Pennington* doctrine, which provides party immunity from antitrust liability for petitioning government for redress. District court found plaintiff had sufficiently stated counterclaim for copyright misuse, and that *Noerr-Pennington* doctrine did not apply to copyright misuse claim.

F. Miscellaneous

Hall v. Swift, No. 17-6882, 2020 U.S. Dist. LEXIS 165214 (C.D. Cal. Sept. 2, 2020)

On remand, district court denied defendants' motion to dismiss plaintiffs' copyright infringement claim because plaintiffs' claim did not fail on merger or *scènes à faire* grounds, and plaintiffs sufficiently pleaded protectible selection and arrangement and similarity. Plaintiffs, co-authors and copyright owners of song, asserted copyright infringement against defendants, co-authors, because of lyrical similarities of songs. Defendants argued plaintiffs' claims were precluded because unprotected ideas underlying alleged copied words merged with those words, rendering them unprotectible. Court found inconclusive whether merger applied, as defendants failed to offer authority on idea that plaintiffs' lyrics can only be expressed in one way, and court was unaware of any authority where plaintiff plausibly alleged originality but failed on merger grounds. Court rejected defendants' argument that plaintiffs' selection and arrangement were not sufficiently creative to warrant copyright protection. Court relied on Ninth Circuit's determination that complaint plausibly alleged originality, and determined that plaintiffs plausibly argued at least two, and as many as nine, creative choices that defendants copied. Last, court rejected defendants' argument that uses of public domain elements were not virtually identical. Court could not determine lyrics were not substantially similar, and thus, plaintiffs sufficiently alleged substantial similarity.

Dolores Press v. Robinson, No. 15-2562, 2020 U.S. Dist. LEXIS 156200 (C.D. Cal. July 1, 2020)

Court denied defendants' summary judgment motion because evidence did not establish as matter of law that works' author abandoned copyright interest with respect to internet distribution and triable issue of fact existed as to whether some works were published on internet. Dr. Eugene Scott, minister and originator of first 24-hour religious TV network, was author and copyright owner of certain audiovisual recordings of his religious teachings ("Works"), which he licensed plaintiff Dolores Press to distribute publicly in 1995. Starting in late 1990s, Scott distributed Works for free on his website and encouraged download, reproduction and redistribution of Works, but requested that users attribute Works to him and not use Works for commercial gain. Scott's websites all contained notices expressing reservations of rights and Works displayed similar notices identifying Scott as copyright owner. Scott, upon his 2005 death, conveyed his copyright interests in Works to plaintiff Melissa Scott, who deactivated websites' video on demand function. In 2014, defendant Robinson sought permission to share Works with his students online and, when Melissa Scott refused, launched website sharing Works "to stick it to the devil." On earlier summary judgment, court found against defendant Doc's Dream and held Scott did not abandon "entirety" of his copyright interest in Works by posting same online and encouraging reproduction. Defendants then moved for summary judgment on ground that Scott had partially abandoned his copyright interest in Works with respect to non-commercial reproduction, distribution and display on internet. Plaintiffs countered that Scott affixed copyright notices to all Works and on each webpage, and further that many Works at issue were never posted online. Court denied defendants' motion because, although copyright owner can abandon some but not all rights, it could not conclude as matter of law that Scott's posting of Works for free on his website was overt act evidencing his intent to partially surrender right to prevent others from posting his Works on their websites. Additionally, triable issue of fact existed as to whether some Works were never published for free on Scott's websites.

Alexander v. Take-Two Interactive Software, Inc., No. 18-966, 2020 U.S. Dist. LEXIS 177130 (S.D. Ill. Sept. 26, 2020)

District court denied defendants' motion for summary judgment on defenses of implied license and *de minimis* use. Plaintiff tattoo artist inked five copyrighted tattoo designs onto WWE professional wrestler Randy Orton. Defendant created *WWE 2K* video game series which contained realistic depictions of WWE professional wrestlers, including depiction of Orton's tattoos inked by plaintiff. Defendants argued that plaintiff tattoo artist impliedly licensed Orton to disseminate and display tattoo images as part of his likeness; because Orton then licensed WWE right to license his likeness to third parties and WWE sublicensed such right to defendant video game developer, defendants argue that implied license extends to plaintiff. But because dispute remained whether plaintiff tattoo artist discussed permissible forms of copying and distribution of tattoo works or whether any such implied license included sublicense rights, implied license defense denied on summary judgment. Defendants also argued that plaintiff's claims failed because use of tattoos was *de minimis*

because tattoos were difficult to see in *WWE 2K* video game and constituted small percentage of videogame data. District court questioned whether Seventh Circuit recognized *de minimis* defense to infringement, but nevertheless found defense unavailing. Court held that successful *de minimis* defense may allow copying of small and insignificant portion of copyright works, not “wholesale copying” of work in its entirety. Defendants’ motions for summary judgment denied.

Stross v. Hearst Communs., Inc., No. 18-1039, 2020 U.S. Dist. LEXIS 161293 (W.D. Tex. Sept. 3, 2020)

Plaintiff photographer brought suit against publishers for unauthorized use of plaintiff’s photos of “tiny houses” on Llano River, alleging defendants exceeded scope of limited license and asserting claims for direct and contributory infringement. Plaintiff moved for partial summary judgment on direct infringement claims and against defendants’ multiple affirmative defenses. Plaintiff and defendants disputed whether parties’ email exchange granted permission for use of photographs only in single article, and whether such use was conditioned upon placement of credit and link to plaintiff’s website. Although allegations of ownership and copying were not in dispute, district court also looked for volitional conduct under Fifth Circuit standard, and concluded that genuine issue of material fact existed regarding extent of plaintiff’s authorization previously provided to defendant for use of photographs, whether use of photographs exceeded scope of authorization given, and whether defendants acted with volitional conduct. District court denied summary judgment due to such factual disputes.

Panda Paws Rescue v. Walters, No. 20-5700, 2021 U.S. Dist. LEXIS 1615 (W.D. Wash. Jan. 4, 2021)

Court granted in part and denied in part defendant’s amended motion to dismiss. Plaintiffs were non-profit animal rescue organization, Panda Paws, and entity’s president, and defendant was former director and chairman of plaintiff entity. Defendant filmed and photographed content for Panda Paws’s social media sites and, with individual plaintiff, collaborated on content for Panda Paws’s YouTube channel and logo. Defendant was removed from Panda Paws by board, which also requested control over Panda Paws’s websites. Plaintiff later learned that defendant had removed its logo from YouTube channel and replaced it with defendant’s brand. Defendant alleged that he was author and owner of YouTube channel and its content, and that he had revoked implied nonexclusive license for Panda Paws to use YouTube Channel, its content, and logo. Panda Paws sought declaratory judgment that defendant abandoned copyright interest in logo. Court dismissed abandonment claim, finding encouragement of Panda Paws’s use of logo and facilitating display of logo did not amount to “overt act” that would manifest defendant’s intent to abandon his copyright.

VII. REMEDIES

A. Damages and Profits

Fischer v. Forrest, 968 F.3d 216 (2d Cir. 2020)

Second circuit affirmed district court's grant of summary judgment for defendants on copyright claim stemming from allegedly infringing use of promotional text in connection with plaintiff's honey harvesting product. Plaintiff sold non-toxic honey harvesting aid, which was featured in defendants' bee-keeping mail order catalogue beginning in 2002. Plaintiff also sold its product on its own website, and obtained copyright registration for website with February 7, 2011 effective date. In 2010, defendant stopped offering plaintiff's product and began selling its own honey harvesting aid using advertising text similar to that used on plaintiff's website. Plaintiff initiated suit, claiming defendants' use of similar text constituted infringement because it only interchanged plaintiff's product name with defendants' product name. Evidence showed that defendant's catalogues were first shipped, and first infringing act occurred, on January 21, 2011, prior to plaintiff's effective date of registration. Accordingly, statutory damages were barred.

Desire, LLC v. Manna Textiles, Inc., 986 F.3d 1253 (9th Cir. 2021)

Ninth Circuit affirmed district court's reasoning in apportioning joint and several liability among defendants, but vacated multiple statutory damages awards because plaintiff was entitled to only one such award where one work was infringed. Plaintiff fabric supplier purchased two-dimensional floral print textile design ("Subject Design"), then registered it with Copyright Office. Defendant Top Fashion purchased fabric with Subject Design from plaintiff and, after parties were unable to agree on pricing, shared Subject Design with defendant fabric supplier Manna, which in turn sent Subject Design to Chinese company with instructions to modify it. Manna registered modified design ("Accused Design") and sold fabric with Accused Design to defendant women's clothing manufacturers ("Manufacturer Defendants"), which then created garments using fabric and sold them to defendant women's clothing retailers ("Retail Defendants"). Plaintiff sued defendants, alleging that Manna infringed plaintiff's copyright by selling fabric with Accused Design to Manufacturer Defendants, which in turn infringed by selling garments to Retail Defendants, which in turn infringed by selling garments to consumers. Plaintiff did not allege that any defendants acted in concert. On summary judgment, district court concluded that upstream infringers could be jointly and severally liable for downstream infringers' infringement, but that not all defendants could be jointly and severally liable with all other defendants and, on that ground, awarded plaintiff multiple statutory damages awards. Ninth Circuit upheld district court's reasoning but reversed award because plaintiff entitled to only one statutory damages award, reasoning that number of such awards available under § 504(c)(1) depends on number of works and of separate infringers and, in this case, it was undisputed that only one work was infringed. Statutory language provides for "an award" for all infringements of single work for which "any two or more infringers are liable jointly and severally," so when plaintiff joins both common primary source infringer (Manna) and downstream infringers as

defendants, only one award of statutory damages is permissible even if downstream infringers not jointly and severally liable with each other. Requiring complete joint and several liability among all defendants in order to limit plaintiff to one award per work would lead to disparate treatment depending on relationship between downstream infringers and would illogically result in downstream defendants that collude in infringement facing lesser liability. Moreover, district court's approach could lead to astronomical statutory damages contrary to § 504(c)(1)'s purpose. Lastly, Congress specifically limited plaintiff to single award regardless of number of infringements and it is not court's place to weigh relative merits of other possible approaches.

ABKCO Music, Inc. v. Sagan, No. 15-4025, 2020 U.S. Dist. LEXIS 212684 (S.D.N.Y. Nov. 13, 2020)

District court denied plaintiffs' motion for new trial on damages because jury's award of lower-than-expected statutory damages was not miscarriage of justice. Defendants acquired archives of late concert promoter Bill Graham, which contained audiovisual recordings from many top-selling musical artists and which defendants made available for streaming online for fee. Music publisher plaintiffs sued alleging that defendants infringed their copyrights in 197 musical works by making them available for downloading and streaming on their websites without plaintiffs' consent. Although defendants made some attempts to secure mechanical licenses after making recordings public, court held, on summary judgment, that defendants failed to show they held valid licenses, but found that triable issue of fact existed as to whether defendants' infringement was willful. After nine-day trial commencing in New York on March 2, 2020, jury returned statutory damages award of either \$750 or \$1,000 per work. During course of trial, New York governments declared states of emergency and began imposing restrictions on gathering. On morning of March 12, last day of trial, one juror expressed concern that trial was placing jurors and their families at risk of contracting virus. Jury began deliberations that afternoon and rendered its verdict in under one hour. Plaintiffs moved for new damages trial, arguing that jury's deliberation was rushed due to worsening COVID-19 (coronavirus) pandemic, which rendered trial fundamentally unfair. Court rejected this argument, finding that jurors were not rushed by court, while statutory damages award (although less than plaintiffs had demanded) was within permitted statutory range and not unreasonable.

Harvey v. PBH Networks, No. 20-948, 2020 U.S. Dist. LEXIS 186421 (E.D.N.Y. Oct. 6, 2020)

Plaintiff, UK-based photographer, whose work depicting English serial killer Peter Sutcliffe aka "The Yorkshire Ripper," alleged that defendant displayed work on its website without plaintiff's authorization or consent. In addition to infringement, plaintiff filed suit for DMCA violation because defendant allegedly altered copyright management information (CMI) in form of metadata from work and distributed work with knowledge that CMI had been removed/altered. Defendant failed to respond to complaint. Magistrate judge overseeing case recommended that court grant plaintiff's motion for default judgment, finding that plaintiff registered work with U.S. Copyright Office and that defendant

published work on its website without license or authorization. Plaintiff sought maximum statutory damages for infringement under Act, but magistrate recommended that court instead award plaintiff statutory damages of \$7,000, or sum minimally over five times plaintiff's licensing fee (approximately \$1,230); maximum statutory damages greatly exceeded customary award of damages in matter of this type, and no support existed for maximum amount sought. Magistrate judge further recommended that plaintiff be awarded \$4,590 in attorneys' fees and \$460 in costs pursuant to Act.

Pasatieri v. Starline Prods., No. 18-4688, 2020 U.S. Dist. LEXIS 185364 (E.D.N.Y. Oct. 6, 2020)

District court denied plaintiff's motion for damages and costs stemming from infringement claim in connection with photograph depicting person in Star Wars gear. Plaintiff sent registered photo of person wearing Star Wars gear to Lucasfilm's costuming groups for promotional use. Defendant allegedly published plaintiff's photo without permission in print magazine *Cosplay Culture*. Plaintiff commenced lawsuit against defendant and moved for default judgment, damages, and costs. Motion was denied, and plaintiff renewed motion seeking \$2,500 in actual damages and \$440 in costs. In determining actual damages fair market value, which reflects reasonable license fee, must be considered, court reasoned. Court further noted that difficulty in quantifying damages should not bar recovery; however, there must be reasonable basis for computation. In support of motion plaintiff submitted own declaration estimating fair market value of use made by defendant to be \$2,500, attaching screenshot of price calculator from Getty website. Court rejected such evidence stating plaintiff's calculation was based on unreasonable parameters because plaintiff's calculation estimated fee for use for up to five years in print magazine with circulation of up to five million, although he alleged only one use of photo by defendant. Additionally, plaintiff provided no evidence of defendant's alleged circulation of five million. Based on evidence submitted, court denied motion with leave to renew and noted fair market license fee would appear to be approximately \$840 for publication with circulation of 100,000.

Erickson Prods. v. Kast, No. 13-5472, 2021 U.S. Dist. LEXIS 27540 (N.D. Cal. Feb. 12, 2021)

On remand from Ninth Circuit, district court awarded \$450,000 in statutory damages after finding defendant had committed willful infringement. Defendant, owner of real estate management company, hired website developer Only Websites to redevelop defendant's website. Defendant instructed developer to incorporate certain elements of competitor Wells Fargo's website. Developer then copied three photos from Wells Fargo website onto defendant's redeveloped website. When plaintiff sent takedown demand, defendant promptly requested developer remove photos at issue, and claimed that images at issue were not authorized to be published. Jury found that defendant vicariously and contributorily infringed plaintiff's copyrights, and did so willfully. On appeal, Ninth Circuit vacated finding of willfulness because district court judge instructed jury in part that infringement is willful when defendant knew "or should have known" that such acts infringed plaintiff's copyright. "Should have known" amounts to negligence standard, rather than willfulness.

On remand, district court found it undisputed that defendant was aware that his website displayed plaintiff's photos at issue, specifically referenced Wells Fargo's website and photos in his directions to site developer, and encouraged site developer to leverage content from competitor sites. District court found unconvincing defendant's testimony that he assumed developer had obtained licenses to plaintiff's photos, and held that defendant's failure to make any inquiry to check whether photos at issue were subject to copyright amounted to reckless disregard. In addition, although defendant claimed plaintiff's photos were merely used as placeholders, district court noted that defendant explicitly authorized site to go live while still displaying plaintiff's photos. District court therefore found that defendant's vicarious and contributory infringement was willful and awarded \$450,000 in statutory damages.

Sanrio Co. v. MyLocker.com, LLC, No. 19-6475, 2020 U.S. Dist. LEXIS 134497 (C.D. Cal. July 28, 2020)

District court entered default judgment against defendants and granted plaintiff's request for statutory damages and preliminary injunction. Plaintiff owned copyrights in 27 visual artworks, including Hello Kitty. Defendant sold products bearing plaintiff's character artwork without permission through various websites. Plaintiff initiated instant action and moved for default judgment and statutory damages of \$810,000. Court stated that pursuant to Act, plaintiff may recover statutory damages of not less than \$750 or more than \$30,000 for any one work, and up to \$150,000 per work if plaintiff can prove willful infringement. Statutory damages must bear plausible relationship to plaintiff's actual damages. Court noted that "plaintiffs did not present any information or estimate the number of infringing products sold by defendants, plaintiffs' lost profits, the retail price of one of plaintiffs' products, or the amount of money spent in the course of identifying defendants, to demonstrate that the amount sought is reasonable." Court further noted that statutory damages are intended to serve as deterrent, but not to grant windfall to plaintiff. Court in its wide discretion determined that \$10,000 per work infringed, totaling \$270,000, was proper amount to award plaintiff.

Energy Intelligence Grp., Inc. v. Kayne Anderson Cap. Advisors, No. 14-1903, 2020 U.S. Dist. LEXIS 236220 (S.D. Tex. Dec. 16, 2020)

After remand, court denied cross-motions for entry of judgment and granted defendants' request for new trial on damages. Plaintiffs brought claims for infringement and DMCA violations, alleging that defendants copied and distributed plaintiff's publication *Oil Daily* outside terms of subscription agreement. On appeal, Fifth Circuit held that failure to mitigate was not total defense to statutory damages under Act or DMCA. Fifth Circuit remanded to determine whether, if jury had been properly instructed that recovery could be had regardless of efforts to mitigate, they intended to award plaintiffs \$15,000 per work. After remand, plaintiffs moved for court to enter judgment for \$15,000 for each of 1,646 infringed works, and defendants moved for entry of judgment for \$15,000 for each of 39 works for which plaintiff did not mitigate their damages and \$750 for each of 1,607 other works infringed. Alternatively, defendants moved for new trial on damages. Court found that defendants'

position that court could enter minimum amount of statutory damages for 1,607 works was unsupported by case law; court was not persuaded that it could “usurp[] the jury’s role” in that manner, and accordingly denied defendants’ motion. Court found that because its instructions on mitigation were erroneous and jury note indicated jury relied on court’s erroneous instruction in awarding \$15,000 for each infringement, that award of \$15,000 per work infringed was based on mistake of law. Because award was based on mistake of law and Seventh Amendment allows plaintiff right to jury trial on all relevant issues on statutory damages, court held that new trial on statutory damages was required.

Goode Time Prods., L.L.C. v. Just, No. 19-58, 2020 U.S. Dist. LEXIS 167956 (E.D. Tex. Sept. 14, 2020)

Plaintiff Goode Time Productions, Christmas caroling company, alleged that defendant, founder and owner of competitor caroling company, copied and performed plaintiff’s show consisting of sound recordings, compilation of songs, and script. Plaintiff moved for summary judgment. As measure of damages, plaintiff sought disgorgement of defendant’s profits, which it claimed were \$124,200.50 for past three years based on tax returns. However, plaintiff did not establish connection between measure of damages and infringing use of plaintiff’s sound recordings. Accordingly, court denied summary judgment on request for defendant’s profits.

Werner v. BN Media, 477 F. Supp. 3d 452 (E.D. Va. 2020)

Plaintiff, photographer, discovered defendant, operator of website that published articles, used his photographs in its articles without permission, and brought copyright infringement suit. Defendant brought motion to dismiss, arguing claim was time-barred, and even if not time-barred, no recovery because plaintiff can only gain retrospective relief for three years back from time of suit, and there had been no infringing acts in past three years. District court denied motion to dismiss claim as time-barred because whether plaintiff acted with reasonable diligence to discover violations should be addressed at summary judgment stage. Court denied motion to dismiss for “valueless” claim because plaintiff alleged damages incurred in three years prior to filing suit. Defendant misunderstood Supreme Court’s holding in *Petrella* when arguing that plaintiff can recover only for *infringements* occurring in previous three years, court stated. Court rejected notion that this was intent in *Petrella* retrospective relief rule because then, claim would have to be discovered at exact moment of infringement for plaintiff to fully recover. Instead, court determined plaintiff can recover for *damages* incurred in past three years, which plaintiff adequately alleged.

HB Prods. v. Faizan, No. 19-487, 2020 U.S. Dist. LEXIS 113950 (D. Hawaii June 29, 2020)

Plaintiff alleged defendant directly and contributorily infringed plaintiff’s film *Hellboy*, by operating interactive website that allowed users to download and reproduce torrent files, including plaintiff’s work. Plaintiff further alleged defendant copied plaintiff’s work by ripping copies from Blu-ray or streaming services. Clerk entered default against defendant and plaintiff filed second motion for entry of default judgment, seeking \$270,902.58 in

damages based on calculation of number of infringements multiplied by alleged cost of Blu-ray copy of work available in location Kailua-Kona, Hawaii, \$15.95. Magistrate ordered plaintiff to file supplemental brief showing why it used \$15.95 as basis for value of damages based on cost of Blu-ray disc in one store in Kailua-Kona Hawaii when plaintiff was Nevada corporation and defendant was resident of Pakistan. Magistrate found plaintiff did not establish default judgment was appropriate under Fed. R. Civ. P. 55(b)(1). Plaintiff objected to magistrate's findings and recommendations denying second motion for default. Court found that plaintiff's damages claim was not claim for sum certain or sum that could be made certain under Fed. R. Civ. P. 55(b)(1) because plaintiff's argument that damages could be determined by multiplying infringements by price of disc of plaintiff's work sold in Walmart in Kailua Kona, Hawaii relied on extrinsic evidence of counsel's affidavit regarding appropriate disc price for damage calculation purposes. Court adopted magistrate's findings and recommendations denying second motion for default.

B. Attorneys' Fees

Lanard Toys v. Dimple Child LLC, 843 F. App'x 894 (9th Cir. 2021)

Ninth Circuit affirmed denial of defendant's motion for judgment as matter of law and new trial, and grant of attorneys' fees to plaintiff, as well as statutory and actual damages and defendant's profits. On trial, jury determined that defendant infringed plaintiff's copyright by selling similar toys. Plaintiff, though successful on main infringement claim, brought additional claims, for trade dress infringement and intentional interference with prospective economic infringement, that did not succeed, leading defendant to argue on appeal that plaintiff was not prevailing party and was not entitled to attorneys' fees even on its successful copyright claim. Defendant further argued that *it* was entitled to attorneys' fees for two claims that were dismissed, asserting that it was prevailing party on those claims. Ninth Circuit rejected these arguments as lacking any supporting authority. District court granted fees to plaintiff for advancing purposes of Copyright Act in discouraging infringement, and because defendant presented weak defense. Ninth Circuit affirmed; district court, which enjoys wide latitude in making fee award determinations, was in best position to evaluate strength of defendant's trial defense.

Unicolors, Inc. v. H&M Hennes & Mauritz, L.P., No. 18-56253, 2020 U.S. App. LEXIS 29135 (9th Cir. Sept. 14, 2020)

Ninth Circuit denied defendant's motion for attorneys' fees and costs. Circuit court previously reversed trial court judgment and fee award in plaintiff's favor and remanded for further proceedings. Because plaintiff could assert arguments on remand, defendant was not yet prevailing party. Additionally, defendant's request for costs beyond those allowed by 28 U.S.C. §§ 1821, 1920 and Ninth Circuit Rules was improper; Ninth Circuit did not have authority to award costs beyond those provided in rules. Ninth Circuit denied motion.

Timothy B. O'Brien LLC v. Knott, 962 F.3d 348 (7th Cir. 2020)

Seventh Circuit affirmed denial of defendant's attorneys' fees motion. Plaintiff operated wellness store; defendant was former employee who created competing store with allegedly similar design features and products. Plaintiff sued for copyright infringement, but later moved to dismiss its claims without prejudice. District court denied defendant's motion for attorneys' fees on copyright claim, finding that totality of circumstances did not warrant fees. On appeal, defendant argued district court committed abuse of discretion. Seventh Circuit noted that Supreme Court's *Fogerty* factors of frivolousness, motivation, objective unreasonableness, and need to advance considerations of compensation and deterrence are relevant, but not determinative, of motion for attorneys' fees. Seventh Circuit further noted its strong presumption in favor of attorneys' fees for defendant who prevails against copyright claim. However, Seventh Circuit reasoned that here copyright claims were voluntarily dismissed before substantial briefing or discovery occurred, and determined that district court had therefore reached reasonable conclusion and did not abuse its discretion in denying attorneys' fees.

Batiste v. Lewis, No. 19-30400, 2020 U.S. App. LEXIS 30346 (5th Cir. Sep. 22, 2020)

Fifth circuit affirmed district court's grant of attorneys' fees to defendants and holding plaintiff's attorney jointly and severally liable for fee award. Plaintiff New Orleans jazz musician sued hip-hop duo Macklemore and Ryan Lewis claiming several of their songs, including hit "Thrift Shop," included samples of his recorded songs. Plaintiff did not challenge amount of fee award, but rather argued that award of any fee was error because there was no evidence of "frivolous" or "bad faith" claims. Applying *Fogerty* factors, Fifth Circuit found that district court did not abuse discretion, and that district court properly considered objective unreasonableness of plaintiff's claims along with plaintiff's litigation misconduct. Fifth Circuit pointed to magistrate's report, which identified numerous instances of plaintiff's litigation misconduct, including submission of "expert report" which was actually ghost-written by plaintiff, attempts to resubmit expert report under his own name, practice of repeatedly amending complaint in response to defendants' motions to dismiss, and related discovery abuses. Fifth Circuit also noted that plaintiff was very litigious and had filed at least five other copyright infringement actions based on similarly weak claims. Given objective unreasonableness of plaintiff's claims, plaintiff's history of litigation misconduct, and pattern of overaggressive copyright lawsuits, Fifth Circuit affirmed district court's award of attorneys' fees.

Morning Sun Books, Inc. v. Div. Point Models, Inc., 826 F. App'x 167, 169 (3d Cir. 2020)

Plaintiff Morning Sun Books brought action against defendant, Uncle Dave's, seller of brass model trains, and others, alleging that defendants infringed plaintiff's books by posting photographs from books on their websites. Morning Sun and Uncle Dave's filed stipulation of dismissal, but defendant reserved right to seek attorneys' fees. Defendant later moved for

attorneys' fees and costs, and district court denied motion. Defendant appealed. Assuming, without deciding, that defendant was prevailing party, Third Circuit found district court did not abuse discretion in denying request for attorneys' fees because it properly considered *Fogerty* factors and found that complaint was neither frivolous nor objectively unreasonable and that copyright owner had not acted in bad faith. Court affirmed denial of defendant's motion for attorneys' fees.

Charles v. Seinfeld, No. 18-1196, 2021 U.S. Dist. LEXIS 36461 (S.D.N.Y. Feb. 26, 2021)

District court granted defendant's motion for award of attorneys' fees because plaintiff's claims objectively unreasonable. Plaintiff, producer and director Christian Charles, brought copyright infringement claim against Jerry Seinfeld and companies associated with production and distribution based on plaintiff's claimed authorship of series *Comedians in Cars Getting Coffee*. Second Circuit affirmed district court's dismissal of copyright infringement claim as time-barred under Copyright Act's three-year statute of limitations because plaintiff did not bring suit until February 2018 despite distribution of show without credit to plaintiff since at least 2012. Defendants moved for award of fees incurred in defending action. Plaintiff relied on Sixth Circuit's decision in *Everly v. Everly*, which held claim asserting author's termination-of-transfers right does not accrue until another person repudiates claimant's status as author. However, cases involving termination rights are different from ownership cases, where defendant must raise statute of limitations defense based on defendant's repudiation of plaintiff's authorship. Even under *Everly*'s reasoning, plaintiff's claims clearly untimely and therefore, plaintiff lacked reasonable legal basis for claims. Court found plaintiff's suit to be opportunistic, as suit only brought years later, after Seinfeld signed lucrative deal with Netflix. Plaintiff knew claims were time-barred yet persisted in litigation that created unusually high costs despite Seinfeld's "repeated" warnings. Thus, court awarded defendants' attorneys' fees to promote purposes of Copyright Act by deterring time-barred claims.

Mourabit v. Klein, No. 18-8313, 2020 U.S. Dist. LEXIS 159022 (S.D.N.Y. Sep. 1, 2020)

District court denied defendants' motion for attorneys' fees because such award would not promote Copyright Act's purposes. Plaintiff did "makeup artistry" for photoshoot by defendant photographer Klein. Klein and other defendants, famous makeup artist and beauty company, used image taken during photoshoot to promote new makeup line without crediting plaintiff. Plaintiff received copyright registration for drawing depicting photoshoot makeup ("Drawing") and brought suit alleging, *inter alia*, copyright infringement and various state law claims. Plaintiff repeatedly admitted that his infringement claim was meritless, and offered to voluntarily dismiss it, arguing that makeup artistry is not copyrightable. For same reasons, however, plaintiff contended Act did not preempt his state law claims. Defendants did not consent to voluntary dismissal and moved to dismiss instead. Court granted motion to dismiss, holding that plaintiff had abandoned his infringement claim and that remaining state law claims were preempted or court lacked personal jurisdiction

over them. After defendants moved for attorneys' fees, plaintiff again acknowledged his copyright claim was meritless but explained that he had sought copyright registration for Drawing with intent of it being rejected, so as to build record to counter defendants' anticipated preemption defense. When registration unexpectedly approved, plaintiff felt forced to strategically include copyright claim. Court held that, though plaintiff received bad lawyering, penalizing plaintiff when he admitted copyright claim's failing early in litigation would run counter to Copyright Act's aims by eliminating plaintiff's incentive to concede hopeless claim, and incentivizing defendant to force judicial determination despite plaintiff's concession. Court noted that such reasoning might not apply where copyright trolls involved, but there was no evidence of such conduct here. Further, court had dismissed plaintiff's claim based on his abandonment thereof, rather than merits. Passing on attorneys' fees motion would therefore require second major litigation, which is counter to Copyright Act's intent.

ABKCO Music, Inc. v. Sagan, No. 15-4025, 2020 U.S. Dist. LEXIS 212684 (S.D.N.Y. Nov. 13, 2020)

District court granted plaintiffs' motion for attorneys' fees, subject to 60% reduction, based on balancing between defendants' objectively unreasonable factual argument and willful infringement, on one hand, and disparity between parties' respective financial situations and requested fees vs. damages awarded, on other hand. Defendants acquired archives of late concert promoter Bill Graham, which contained audiovisual recordings from many top-selling musical artists, which defendants distributed for streaming online for fee. Defendants subsequently sought to obtain mechanical licenses to audiovisual recordings and served Notice of Intent to Obtain Compulsory License with regard to some recordings. At summary judgment, court rejected defendants' argument that they held mechanical licenses for some works because (1) audiovisual recordings not eligible for mechanical license; (2) defendants could provide no evidence showing that balance of recordings fixed with performers' consent as required; and (3) any mechanical licenses not filed prior to distribution independently invalid. After trial, jury found willful infringement of certain works and awarded statutory damages, and plaintiffs moved for attorneys' fees. Finding that plaintiffs were prevailing party, court held that plaintiffs were entitled to "some" fees due to limited unreasonable behavior by defendants and large number of works willfully infringed. Although court had previously warned defendants that they may have "losing argument" on mechanical license issue, argument was not "so devoid of merit that it necessarily suggests bad faith." However, defendants' claim that "numerous" artists had consented to recording and exploitation of their concert performances was objectively unreasonable, because defendants failed to produce any evidence that artists had consented and admitted lack of awareness of such consents. Absent such consent, there could be no valid mechanical license, so defendants' pursuit of this line of argument was objectively unreasonable. Because large number of infringed works were found to be willfully infringed, attorneys' fees award would provide deterrence. However, given disparity in parties' financial resources (plaintiffs being multi-million dollar companies and defendants in "financial ruin" due to COVID-19) and modest statutory damages awarded by jury, fee award was reduced by 60%.

Hughes v. Benjamin, No. 17-6493, 2020 U.S. Dist. LEXIS 139698 (S.D.N.Y. Aug. 4, 2020)

District court granted defendant's motion for attorneys' fees after dismissal of infringement claims based on fair use defense. Plaintiff internet commentator and filmmaker posted video titled *We Thought She Would Win*, featuring footage of Hillary Clinton's 2016 election-night campaign party and commentary concerning Clinton's defeat by Donald Trump. Defendant YouTuber posted video titled *SJW [Social Justice Warrior] Levels of Awareness*, consisting entirely of portions of *We Thought She Would Win*, and containing no overt commentary or other new material. Plaintiff sued for infringement, and court granted defendant's motion to dismiss based on fair use defense. Considering defendant's motion for attorneys' fees and costs, court considered *Fogerty* factors, focusing on "frivolousness, motivation, objective unreasonableness, and ... considerations of compensation and deterrence." Court held that plaintiff's claim was objectively unreasonable because even plaintiff's own complaint described defendant's video as effort to mock and discredit defendant, "two strong indicators that the work constitutes fair use as criticism." Court held that plaintiff brought and prosecuted litigation with improper motivation "to silence her political opponents and critics and to generate publicity for herself," which revealed her "intent to abuse the legal system in order to further a personal agenda that had little to do with the Copyright Act." On compensation factor, plaintiff argued that defendant raised over \$120,000 for his defense through fundraising campaign on GoFundMe, more than approximately \$40,000 defendant expended in defending case. But court was unmoved by existence of fundraising campaign, reasoning that defendant's "good luck in having financial wherewithal to defend against a frivolous suit" does not immunize plaintiff from consequences for pursuing unreasonable litigation. On deterrence factor, court noted that plaintiff does not owe any damages to defendant, so fee award "is the only financial consequence that the Court may impose on [plaintiff] to deter this conduct going forward." Court found defendant's counsel's fees reasonable and awarded \$38,911.89 in fees and costs.

Greg Young Publ'g, Inc. v. Zazzle, Inc., No. 16-4587, 2020 U.S. Dist. LEXIS 120877 (C.D. Cal. July 9, 2020)

On remand from Ninth Circuit, district court reconsidered and again denied plaintiff's motion for attorneys' fees. Plaintiff publisher of visual artworks sued defendant Zazzle, which operated website allowing users to upload images of artwork and to purchase products bearing images of said artwork. Plaintiff sued for infringement of 41 different images, and jury trial resulted in finding of infringement of each work, with damage awards ranging from \$200 to \$66,8000. District court found that infringement was not willful and reduced damage awards to maximum of \$30,000 per work; court also denied plaintiff's motion for attorneys' fees. On appeal, Ninth Circuit found infringement was willful, directing district court to reinstate original jury award. Ninth Circuit affirmed district court's denial of attorneys' fees, but allowed motion to be raised again on remand, based on finding of willful infringement and reinstatement of jury award. On remand, district court considered request for attorneys' fees under *Fogerty* factors, finding (1) plaintiff did not achieve complete success because although it prevailed on its infringement claims, plaintiff only recovered

21% of its original requested relief; (2) defendant's conduct was neither frivolous nor objectively unreasonable and court's analysis of defendant's litigation behavior was unchanged by Ninth Circuit's finding of willful infringement on appeal; (3) plaintiff's motivation in pursuing litigation was consistent with goals of Act and not in bad faith; (4) although infringement was willful, \$460,800 in damages awarded to plaintiff were "not small," and there was no substantial likelihood that defendant would continue to infringe plaintiff's work. Weighing factors (with weight given to objective reasonableness of defendant's position), district court denied plaintiff's motion for attorneys' fees.

Johannsongs-Publishing, Ltd. v. Loviand, No. 18-10009, 2020 U.S. Dist. LEXIS 158205 (C.D. Cal. July 6, 2020)

District court denied defendant's motion for award of attorneys' fees because, on weighing totality of circumstances and Copyright Act's essential goals, court concluded fee award not warranted. Plaintiffs sued defendants for infringement, alleging defendants' song "You Raise Me Up" infringed plaintiffs' song "Soknudur." Court granted defendants' motion for summary judgment because plaintiff could not satisfy extrinsic test for substantial similarity. Defendants moved for award of attorneys' fees. Court declined to award fees because action was not frivolous, and court could not conclude that action was objectively unreasonable. Mere fact that party's position is unsuccessful is insufficient to render it frivolous or objectively unreasonable. Moreover, court found motivation factor neutral, there was no finding of bad faith, and considerations of compensation and deterrence weighed only slightly in favor of awarding fees.

Anderson v. Seliger, No. 19-5630, 2020 U.S. Dist. LEXIS 155927 (N.D. Cal. Aug. 26, 2020)

Plaintiff was former owner of AwardsWatch.com, which contained plaintiff's content about films, award competitions, and forum in which members could discuss these issues. Within forum someone posted comments which included deeplinks to three photographs taken by defendants. Plaintiff filed declaratory judgment action seeking declaration of non-infringement. After denial of defendants' motion to dismiss, defendants issued irrevocable licenses to plaintiff, and plaintiff filed voluntary dismissal of action. Plaintiff moved for attorneys' fees. Here, plaintiff filed voluntary dismissal without prejudice, which is not judicially sanctioned material alteration of legal relationship of parties. Therefore, plaintiff was not prevailing party, and motion for attorneys' fees was denied.

Vallejo v. Narcos Prods., LLC, No. 18-23462, 2020 U.S. Dist. LEXIS 153872 (S.D. Fla. 2020)

Plaintiff, Colombian journalist, had affair with drug trafficker, Pablo Escobar, and wrote memoir, *Amando a Pablo, Odiando a Escobar*. Defendants were associated with production and distribution of television series *Narcos*. After court granted in part and denied in part defendant's motion to dismiss, plaintiff filed amended complaint alleging defendants infringed work in creation of intimate scene between plaintiff and Escobar involving revolver, and meeting scene involving Escobar and man named Ivan. Court granted

defendants' motion for summary judgment, and defendants subsequently moved for attorneys' fees and costs. Magistrate judge assessed *Fogerty* factors and recommended granting defendants' fees motion. On reasonableness, court found that fact plaintiff pleaded claim that survived motion to dismiss did not mean claim was objectively reasonable, and that plaintiff should have found claims unreasonable when court noted in its motion to dismiss decision that factual information was not protectible. Court further found unreasonable fact that meeting scene was dismissed as containing unprotectible facts, and plaintiff repleaded nearly identical claim in amended complaint. Court found that awarding fees would further Act's purposes, and that defendants achieved high degree of success. Accordingly, court found defendants could recover reasonable attorneys' fees under Act. Court next analyzed amount of fees to award by calculating lodestar. In considering reasonableness of requested hourly rates, court considered experience and reputation of counsel and found requested attorney rate reasonable, but found requested paralegal rate to be unreasonable and adjusted rate downwards to \$100 per hour. Court found number of hours spent on certain tasks was unreasonable, and that time records showed redundant entries without sufficient explanation for redundant charges. Accordingly, court found reduction of hours warranted, and found 60% "across-the-board reduction" appropriate for attorney, but not paralegal, hours. Finally, defendants sought recovery of non-taxable expenses for translating portions of plaintiff's work and translation services of interpreter at plaintiff's deposition. Court recommended recovery of costs for interpreter but did not recommend recovery of fees for translating plaintiff's work because Supreme Court held that interpreter in 28 U.S.C. § 1920 was someone who orally translated languages and therefore recovery for interpreter services under statute did not refer to document translation. Court otherwise found defendants did not support request for translation services to extent they argued services fell outside § 1920. Court recommended award of \$242,263 in attorneys' fees and \$715 in interpreter costs.

Bell v. Carmen Commer. Real Estate Servs., No. 16-1174, 2020 U.S. Dist. LEXIS 154013 (S.D. Ind. Aug. 25, 2020)

Plaintiff Bell had previously filed "dozens of copyright infringement suits" based on use of his photo of Indianapolis skyline, but in current suit jury found that plaintiff did not show that he authored photo, owned photo, and registered photo with Copyright Office, and judgment was entered for defendant. Plaintiff moved for new trial and defendant moved for attorneys' fees and costs. Court found Bell's position on ownership of copyright was not unreasonable, but position on damages was; trial evidence showed that licenses for similar photos usually sold for between \$5 to \$20 and that Bell typically licensed work for \$200. Additionally, in different suit in which Bell was meritorious at trial, he received \$200 in statutory damages, and Bell also testified actual damages were probably \$200. Defendant also offered to settle matter for \$1,000 before plaintiff filed suit. Despite these facts, plaintiff sought \$150,000 on thin record of willful infringement. Court also noted high number of suits plaintiff filed over lawsuits and that other judges found that to be indicative of "improper motive"; indeed, plaintiff threatened litigation against plaintiff if matter was not settled for \$5,000. Therefore, court found that awarding fees to defendant would advance goals of compensation and deterrence. Defendant sought over \$169,000 in attorneys' fees

and over \$3,000 in costs, which were supported by counsel's declaration, time sheets, expenses, and invoices. Fee amount requested represented 455 hours billed by law office personnel, and court found hourly rate of counsel, associates, and paralegals to be reasonable for Indianapolis given counsel's experience. Although defendant argued that defendant's counsel billed excessive time at high rate, given time and rate of his attorney, court found argument did not contradict reasonableness of defendant's fee because there was large experience difference between plaintiff's and defendant's counsel, and number of hours recorded by plaintiff was not helpful because plaintiff, lawyer himself, served as co-counsel and was extremely involved in litigation.

Parker v. Winwood, No. 16-684, 2021 U.S. Dist. LEXIS 48448 (M.D. Tenn. Mar. 16, 2021)

Magistrate recommended that defendants' motion for attorneys' fees be denied because plaintiffs' claims were not objectively unreasonable or improperly motivated. Plaintiffs brought copyright infringement suit claiming that Spencer Davis Group's ("SDG") 1966 hit song "Gimme Some Lovin'," written by Spencer Davis and Steve and Mervyn "Muff" Winwood in London, England, copied bass line from 1965 record "Ain't That a Lot of Love," cowritten by plaintiff Willa Dean "Deanie" Parker and plaintiff Rose Banks' late husband Homer Banks in Memphis, Tennessee. On summary judgment, defendants Steve and his publishing company Kobalt argued that *Gimme* could not infringe because it was recorded before *Ain't* was promotionally released in UK, and submitted sworn declarations from SDG that they had not heard *Ain't* when they wrote *Gimme*. In response, plaintiffs submitted book excerpt stating that *Ain't* "morphed into" *Gimme* and magazine articles quoting Davis and others that Muff's bass line taken from *Ain't*. After summary judgment briefing closed but prior to court's decision, Muff moved to dismiss for lack of personal jurisdiction because he lacked sufficient contacts with Tennessee. In response, plaintiffs submitted musicologist expert report arguing that SDG likely had access to *Ain't* before writing *Gimme* and that songs were substantially similar. District court granted Steve and Kobalt's summary judgment motion because book and magazine excerpts were inadmissible hearsay, expert report submitted too late to be considered on summary judgment, and no other record evidence contradicted SDG's declarations; Muff's motion to dismiss also granted. Plaintiffs appealed but Sixth Circuit affirmed summary judgment holding. Winwoods and Kobalt moved for attorneys' fees under § 505 on grounds that plaintiff's infringement claims were objectively unreasonable because unsupported by admissible evidence; plaintiffs' motives were "questionable" as evidenced by plaintiffs' filing of frivolous motion to compel responses to requests for admission that had already been provided and plaintiffs' submission of inadmissible hearsay evidence (magazine and book excerpts) on summary judgment; and Copyright Act's policy goals would be served by award. Magistrate concluded that plaintiffs' claims were reasonable because they were supported by excerpts and expert report; although these materials were ultimately deemed inadmissible on summary judgment, they were relied upon by plaintiffs and therefore relevant to assessing reasonableness of plaintiffs' claims. Moreover, plaintiffs' motion to compel not frivolous because responses to requests for admission provided only after motion was filed, while submission of inadmissible excerpts defensible because plaintiffs' counsel

believed they were admissible based on legal research and professional judgment. Finally, because case resolved based on Federal Rules of Evidence and personal jurisdiction doctrine, awarding fees would do little to advance Copyright Act's goals of compensation and deterrence.

Belaustegui v. KC Media LLC, No. 20-531, 2020 U.S. Dist. LEXIS 147840 (E.D. Mo. Aug. 17, 2020)

Court granted defendant's motion to dismiss for improper venue and request for costs and fees under § 1927 because plaintiff failed to allege any relevant connections to venue and filing of lawsuit was improper and in reckless disregard of plaintiff's counsel's duties. Plaintiff, professional photographer who resided and operated business in Florida, licensed his photographs to online and print media for fee. Defendant was marketing and media group organized under laws of Missouri with principal place of business in Kansas City, Missouri, located in Western District of Missouri. Plaintiff, represented by Richard Liebowitz, sued defendant in Eastern District of Missouri alleging that defendant published his copyrighted photographs to its website without permission. Defendant moved to dismiss action for improper venue, or alternatively, to transfer venue to Western District, and moved for award of costs and attorney's fees. Plaintiff did not respond to motion. Court granted defendant's motion to dismiss and requests for costs and fees. Court applied 28 U.S.C. § 1400(a), finding that venue was improper because defendant had no relevant contacts in Eastern District. Court also granted defendant's request for fees and costs under § 1927. Record demonstrated that Liebowitz's filing of action in Eastern District was unreasonable and in reckless disregard of counsel's duties, particularly because Liebowitz should have known Eastern District was improper venue, given his extensive history in copyright litigation. Defendant was forced to incur costs and fees to appear and defend motion, which would not have been necessary if Liebowitz had acted properly. Therefore, court granted defendant's request.

C. Injunction/Impoundment

Bayoh v. Afropunk LLC, No. 18-5820, 2020 U.S. Dist. LEXIS 233488 (S.D.N.Y. Dec. 11, 2020)

Plaintiff Mambu Bayoh was hired by defendant in 2015 to provide photographs for 2015 Afropunk Music Festival in Brooklyn, NY. Bayoh was paid \$1,200 and provided 28 photographs. Plaintiff sought copyright registrations for works in June 2017 and July 2018 and brought suit against defendant in June 2018. Due to delay, Plaintiff could not seek statutory damages or attorneys' fees for infringement, but plaintiff sought and received preliminary injunction in July 2018. In October 2018, plaintiff requested permanent injunction. Court assessed four-factor test for permanent injunction and found plaintiff failed to carry burden because plaintiff failed to provide any evidence of irreparable harm. Plaintiff was unable to show any evidence that photographs continue to be used after August 2018 preliminary injunction and plaintiff's delay in seeking permanent injunction weighed against

finding that he was irreparably harmed. Court denied plaintiff's request for permanent injunction.

Hudson Furniture, Inc. v. Mizrahi, No. 20-4891, 2020 U.S. Dist. LEXIS 159288 (S.D.N.Y. Sept. 1, 2020)

Court granted plaintiff's motion for preliminary injunction. Plaintiff lighting and furniture designer and retailer sued defendant online lighting retailer, alleging that defendant posted on his websites, without authorization, plaintiff's copyrighted images of plaintiff's lighting designs. Plaintiff represented that it lost sales as result of defendant's infringement. Court held that plaintiff established likely success on merits by submitting evidence that it owned or controlled valid copyrights in relevant images and that defendant posted and hosted copies of plaintiff's images on defendant's website without plaintiff's permission. Irreparable harm was established because plaintiff showed that defendant's continued sale of lighting fixtures caused plaintiff to lose sales and consumers to purchase unauthorized products due to defendant's unauthorized use of copyrighted images. Since nothing in record indicated that injunction would harm public, court granted plaintiff's motion for preliminary injunction.

Sanrio Co. v. MyLocker.com, LLC, No. 19-6475, 2020 U.S. Dist. LEXIS 134497 (C.D. Cal. July 28, 2020)

District court entered judgment against defendants and granted plaintiff's request for preliminary injunction stemming from infringement of plaintiff's Hello Kitty and other character design copyrights. Plaintiff owned copyrights in various character artwork including Hello Kitty. Defendants sold products bearing plaintiff's character artwork without permission through various websites. In addition to securing default judgment, plaintiff move for permanent injunction. Court stated that plaintiff must demonstrate (1) it has suffered irreparable injury; (2) remedies available at law are inadequate to compensate for injury; (3) considering balance of hardships between plaintiff and defendant, remedy in equity is warranted; and (4) public interest would not be disserved by permanent injunction. Court granted injunction, stating plaintiff would be irreparably harmed by defendants' continued deliberate infringement. Additionally, monetary damages were insufficient as defendants' failure to participate in action indicated infringement would continue, and made it difficult for plaintiff to determine defendants' actual profits and plaintiff's lost income. Lastly, balance of hardships tipped in plaintiffs' favor because defendants faced no cognizable hardship in refraining from future infringement, and public has interest in protection of copyrights and prevention of willful infringement.

Greg Young Publ'g, Inc. v. Zazzle, Inc., No. 16-4587, 2020 U.S. Dist. LEXIS 120877 (C.D. Cal. July 9, 2020)

On remand from Ninth Circuit, district court reconsidered and again denied plaintiff's motion for permanent injunction. Plaintiff publisher of visual artworks sued defendant Zazzle, which operated website allowing users to upload images of artwork and purchase products bearing images of said artwork. Plaintiff sued for infringement of 41 different images, and jury trial resulted in finding of infringement and damages award for images that

were printed onto products and sold, but not images that were merely displayed on website. District court denied plaintiff's motion for permanent injunction after trial, which denial plaintiff appealed to Ninth Circuit; Ninth Circuit found denial of injunction "well-reasoned," but allowed motion to be raised again on remand based on new evidence. On remand, Plaintiff argued that permanent injunction was warranted because defendant continued to infringe on four of its copyrighted images by displaying them on Zazzle and third-party websites affiliated with Zazzle. In considering permanent injunction factors, district court placed greatest weight on whether plaintiff suffered irreparable harm, and whether plaintiff has adequate remedy available at law. Court rejected plaintiff's claims of irreparable harm from this display, noting that mere display of images on website (as opposed to sale of items bearing images) did not constitute infringement at trial; multiplicity of suits would not be required to remedy harm because only four images were alleged to be infringed after trial; and any monetary damages suffered by plaintiff for such infringement could be addressed at law. Court also held that plaintiff had adequate remedy at law for any continued infringement, noting lack of evidence that defendant was unable to pay monetary damages awarded at trial. Motion for permanent injunction denied.

Acad. of TV Arts & Scis. v. Julien's Auctions LLC, No. 20-6272, 2020 U.S. Dist. LEXIS 167839 (C.D. Cal. July 16, 2020)

Plaintiff Academy of Television Arts & Sciences moved for temporary restraining order against Defendant auctioneer to stop scheduled auction of four Emmy Award statuettes awarded to actress Valerie Harper. Court granted application for TRO, finding that there were serious questions regarding merits of plaintiff's infringement and conversion claims, that balance of hardships tipped in favor of plaintiff given likelihood of irreparable injury to plaintiff, and that TRO would be in public interest. Court found that plaintiff submitted evidence of registration for Emmy statuette, as well as evidence of plaintiff's longstanding policy prohibiting sale and transfer of statuettes. Court rejected defendant's argument under first sale doctrine that Harper's ownership of statuettes as gifts authorized her or her estate to consequently convey them. Court further found that auction of Harper statuettes would result in irreparable harm to plaintiff and would severely damage plaintiff's integrity and reputation because it would be unlikely to recover statuettes from third-party purchaser after auction. Court concluded by noting that public had interest in upholding copyright protections.

Versah v. UI Amin Indus., No. 20-12657, 2020 U.S. Dist. LEXIS 230761 (E.D. Mich. Dec. 9, 2020)

District court granted preliminary injunction prohibiting defendants from using plaintiff's copyrights. Plaintiff owned copyright registrations in connection with Densah Bur Kit, which is used in connection with medical tools that help dentists prepare bone for insertion of dental implants during oral surgery. Plaintiff alleged that defendants' kit contained diagram "strikingly similar" to plaintiff's copyrighted artwork, and that defendants' website included description of product nearly identical to plaintiff's copyrighted text in its instructions for use contained within Densah Bur Kit. District court performed four-part

analysis to determine whether to grant preliminary injunction. Observing in part that defendants' diagram of its product showed same measurements as plaintiff's product, and defendants' product description included verbatim lifting of entire sentences of plaintiff's product description, district court held that plaintiff had shown likelihood of success on merits of copyright claims. District court then found ample evidence to indicate irreparable injury would occur absent injunction: defendants' product was allegedly of inferior quality and would cause confusion among customers of bur kits. Next, court found that preliminary injunction would cause only limited financial harm to defendants because it would not require them to cease all business operations, whereas continued selling of allegedly infringing products would cause significant harm to plaintiff's brand. Finally, district court considered public interest, finding that public interest in preventing counterfeit defective devices from being brought to market weighed in favor of granting preliminary injunction. All four factors thus pointed in favor of plaintiff, causing district court to grant preliminary injunction.

Eastpointe DWC, LLC v. Wing Snob Inc., No. 19-13768, 2020 U.S. Dist. LEXIS 108526 (E.D. Mich. June 22, 2020)

District court denied plaintiff restaurant's motion for preliminary injunction on basis of plaintiff's copyright infringement claim. Plaintiff had been operating restaurants, specializing in chicken wings, since 2015. Defendants approached plaintiff at various times asking whether it would consider selling franchises to defendants. Plaintiff repeatedly declined defendants' offer. Defendants subsequently opened chicken wing restaurant, and continued to rapidly expand, including opening locations in proximity to plaintiff's restaurants. Plaintiff sued for copyright infringement, arguing that defendants were intentionally copying plaintiff's business, including by using chicken logo similar to plaintiff's copyrighted logo. Plaintiff moved for preliminary injunction on infringement claim. Court declined to grant injunctive relief. As to likelihood of success on merits, defendants argued that (a) there was no evidence that they had copied or had access to plaintiff's copyrighted logo, (b) they were unaware of plaintiff's logo, and (c) their logo was designed by third party. However, court did not consider these factors in denying plaintiff's request for injunction. In fact, court held that, regardless of plaintiff's likelihood of success on its copyright claim, balance of harms weighed in favor of defendants because defendants' logo was no longer in use, as defendants had only used allegedly infringing chicken logo for one style of t-shirt that was on sale for few weeks. For this reason, court held plaintiff was not suffering irreparable harm, and declined to issue preliminary injunction on basis of plaintiff's copyright claim.

VIII. PREEMPTION

Jackson v. Roberts, 972 F.3d 25 (2d Cir. 2020)

Second Circuit affirmed district court's grant of summary judgment to defendant on plaintiff's right of publicity claim. Plaintiff Jackson, professionally known as 50 Cent, brought suit for violation of right of publicity against defendant Roberts, also known as Rick

Ross, over Ross's sampling 30 seconds of 50 Cent's song "In Da Club" in Ross's 2015 mixtape "Black Market." Court found plaintiff's cause of action impliedly preempted because it frustrated Act; it did not further substantial state interest separate from interests of Act; and claim amounted to attempt to control production of plaintiff's work. Court also found plaintiff's claim preempted by statute because claim's focus was defendant's use of work that fell within subject matter of copyright, and asserted rights were equivalent to those protected by copyright. Second Circuit affirmed dismissal of right of publicity claim.

Dig. Drilling Data Sys., L.L.C. v. Petrolink Servs., 965 F.3d 365 (5th Cir. 2020)

On appeal from post-trial motion for judgment as matter of law, Fifth Circuit affirmed district court's holding that plaintiff's unjust enrichment claim not preempted by copyright law because it required additional element of taking of undue advantage. Plaintiff and defendant both provided software used by oil and gas operators to collect, filter (and, in plaintiff's case, correct), log and visualize data from downhole drills. Plaintiff's software program, which was designed to run only on laptops with USB security dongle inserted, logged corrected data into open source database program in which plaintiff created its own schema (i.e., relational structure) consisting of 27 interrelated tables and accessible via database program's default, publicly available credentials. After obtaining laptop running plaintiff's program and associated security dongle and accessing plaintiff's database using default credentials without plaintiff's authorization, defendant developed scraping program to copy corrected drilling data from plaintiff's database for use in defendant's visualization program, then surreptitiously installed scraping program in 300+ of its customers' computers, which caused them to violate terms of license agreement. Plaintiff sued defendant for infringement, DMCA violation and unjust enrichment. After court dismissed copyright claims on summary judgment, jury found in plaintiff's favor on its unjust enrichment claim, which, under Texas law, required plaintiff to show defendant had benefited from taking undue advantage. Defendant moved for judgment as matter of law, arguing that unjust enrichment claim was preempted, and district court denied motion. Fifth Circuit affirmed because, though parties did not dispute that scraped drilling data fell with copyright's subject matter, plaintiff's claim was based on further element, namely, that defendant obtained benefit by taking undue advantage, in this case, by causing plaintiff's customers to violate their license terms.

Gogo Apparel, Inc. v. True Destiny, LLC, No. 19-5693, 2020 U.S. Dist. LEXIS 170616 (S.D.N.Y. Sept. 17, 2020)

Plaintiff, apparel wholesaler and supplier, owned exclusive rights to graphic artworks used on textiles and garments, and sold goods bearing designs. Plaintiff alleged that defendant, competitor wholesaler, manufactured and sold products with identical or substantially similar copyrighted design. Defendant moved to dismiss unfair competition claim as preempted. Court found fabric design fell within subject matter of copyright, and that unfair competition claim, based on facts of case, was "simply a repackaged copyright claim." Court granted motion to dismiss.

District court denied plaintiff's motion to remand to New York State court and instead dismissed complaint because all plaintiff's state law claims alleging defendants breached terms of service and unfairly competed with plaintiff were preempted. Plaintiff licensed song lyrics from music publishers and provided collaboratively annotated versions on its website under terms of service that prohibited unauthorized copying, modification, sale and transmission of plaintiff's content, including for commercial purposes. Although plaintiff's website often appeared as first organic search result for song lyrics, defendant Google displayed, above results, "Information Box" with full lyrics to searched-for song, which were provided by defendant LyricFind. After determining that defendants were misappropriating lyrics from its website, plaintiff brought suit in New York State court, alleging breach of contract (namely, terms of service), unjust enrichment and unfair competition. Defendants removed to federal court, arguing that plaintiff's claims were all essentially copyright infringement claims based on alleged copying of copyrighted lyrics, and therefore preempted. Court held that plaintiff's claims met subject matter requirement for preemption because transcribed song lyrics, which are fixed in writing, fall within type of works protected by Copyright Act. Further, general scope requirement for preemption met because plaintiff sought to vindicate rights exclusive provided and protected under Act. Court rejected plaintiff's argument that inclusion of express prohibition against commercial use in terms of service was "extra element" that precluded preemption; plaintiff failed to cite any authority that "commercial use" differentiated breach of contract claim from unauthorized reproduction claim barred by Act, and plaintiff failed to allege promise to pay or other extra element accepted by courts. Moreover, plaintiff licensed lyrics from copyright owners, rendering its annotation lyrics essentially derivative works, and plaintiff did not have assignment from copyright owners allowing it to enforce their exclusive right to prohibit defendants' allegedly unauthorized reproduction. Plaintiff's unjust enrichment claim also preempted, as plaintiff did not allege that defendants abused confidential or fiduciary relationship, and merely pleading deception insufficient to qualify as extra element avoiding preemption. Finally, plaintiff's unfair competition claim preempted because defendants allegedly misappropriated only copyrighted material (rather than trade secrets) without breach of fiduciary or confidential relationship, so conduct amounted to reverse passing off of plaintiff's derivative works, which was preempted.

Witt v. Sollecito, No. 19-676, 2020 U.S. Dist. LEXIS 200488 (N.D.N.Y. Oct. 28, 2020)

Plaintiff, home design and construction company, brought infringement action against defendants Larry and Joanne Sollecito, its former clients, and home design company, architect, and contractor engaged by defendants Sollecitos to construct defendants' new home. In June 2014, plaintiff and Sollecitos entered into agreement pursuant to which plaintiff was to design and plan construction of Sollecitos' new home. Plaintiff provided Sollecitos with preliminary drawings and designs, but Sollecitos did not contract with plaintiff for home's construction. Two years later, in June 2016, plaintiff asserted that

Sollecitos' home was "nearly identical" to plaintiff's created design and plans. Plaintiff brought claims of copyright infringement, contributory and vicarious copyright infringement, and various state law claims, including unjust enrichment and tortious interference against defendants, alleging that Sollecitos hired defendant design company, architect, and contractor to build Sollecitos' new home using plaintiff's designs. Defendants filed motions for judgment on pleadings as to plaintiff's copyright claims and plaintiff filed cross-motion to amend. As to plaintiff's state law unjust enrichment and tortious interference claims, court granted defendants' motions for judgment on pleadings on grounds that such claims were preempted. In dismissing claims, court rejected plaintiff's contentions that their claims were "qualitatively different" from their copyright claims, and determined that same conduct was alleged in support of tortious interference and infringement claims.

Flo & Eddie, Inc. v. Pandora Media, Inc., No. 14-7648, 2020 U.S. Dist. LEXIS 203332 (C.D. Cal. Oct. 22, 2020)

District court denied defendant's renewed anti-SLAPP motion to strike, holding that plaintiff sufficiently established probable success on merits. Plaintiff Flo & Eddie was controlled by two founding members of 1960s music group The Turtles, which recorded several hit songs between 1965-1969, including iconic track "Happy Together" (collectively, "pre-1972 recordings"). Plaintiff sued Pandora, streaming internet radio service, for copyright infringement on grounds that Pandora illegally copied and broadcast plaintiff's pre-1972 recordings. Pandora moved to strike plaintiff's allegedly "strategic lawsuit against public participation" (SLAPP) under California statute permitting dismissal of nonmeritorious litigation that challenges certain protected speech. District court denied Pandora's original anti-SLAPP motion and, while Pandora's Ninth Circuit appeal was pending, Congress passed Music Modernization Act ("MMA"), which brought pre-1972 sound recordings partially under federal copyright law's umbrella and mooted aspects of defendant's appeal. After Ninth Circuit vacated district court's anti-SLAPP denial, Pandora renewed its motion. District court held that, even if Pandora were able to show that plaintiff's claims are based on Pandora's protected speech (which it could not), it would deny Pandora's anti-SLAPP motion because plaintiff showed it was likely to prevail on merits. Although MMA preempts, in § 301(c), state law claims relating to "activities" (namely, digital uses of pre-1972 recordings) commenced *post*-MMA enactment and, in § 1401(e), "any claim" based on *pre*-MMA enactment digital use of pre-1972 recordings, court held that different language used in preemption sections indicated that MMA was not retroactively applicable and therefore did not preempt plaintiff's claims (which were based on pre-MMA enactment activities). Moreover, court found that, even if MMA was retroactively applicable, issue of fact remained as to whether Pandora had met MMA's prerequisites for preemption under § 1401, which required Pandora's pre-MMA compliance with statutory licensing requirements in §§ 114(d)(2) and 112(e)(1) as well as *either* notice of use and payment, within 270 days of MMA's enactment, for all activities for three years prior to MMA's enactment *or* settlement agreement waiving liability. Although Pandora argued that it had made all necessary payment via *both* near-\$9 million payment for all pre-1972 recordings transmitted within three years prior to MMA's enactment *and* two specific settlement agreements, plaintiff argued (and Pandora admitted) that dispute remained as to additional transmissions with

value of around \$6.00. Court held that this was sufficient to create issue of fact precluding resolution on summary judgment.

G&G Closed Circuit Events, LLC v. Parker, No. 20-1017, 2020 U.S. Dist. LEXIS 135439 (S.D. Cal. July 30, 2020)

Court denied motion to dismiss. Plaintiff held exclusive distribution rights to “Gennady Golovkin v. Steve Rolls Fight Program” telecast on June 8, 2019. Plaintiff sublicensed right to publicly perform show throughout country. Plaintiff alleged that defendants intercepted, received and publicly performed program at Chula Vista Brewery without authorization. Plaintiff brought various federal and state law claims, and defendants moved to dismiss state law claims as preempted. Although program fell within subject matter of copyright as motion picture, rights asserted were not equivalent to those under § 106. Plaintiff’s primary claims, incorporated by reference in its state law claims, arose under Federal Communications Act; claims did not allege that plaintiff was exclusive copyright owner but instead relied on contractual rights. Court denied motion to dismiss.

Trans-Radial Sols., LLC v. Burlington Med., LLC, No. 18-656, 2020 U.S. Dist. LEXIS 203254 (E.D. Va. Oct. 30, 2020)

On cross-motions for summary judgment, district court dismissed plaintiff’s common law passing off claim as preempted. Plaintiff developed two radiation protection products and entered into distribution agreement with defendants. Defendant Burlington Medical, (“Burlington”) subsequently began selling its own radiation protection equipment using advertising that was substantially similar to flyer used by plaintiff, which contained copyrighted photographs of plaintiff’s product. Plaintiff sued for common law passing off, alleging that Burlington removed or obliterated plaintiff’s trademark from photographs to create derivative marketing materials. Court noted that reverse passing off occurs when defendant removes source indicator on another party’s product and sells it under another name. Court found plaintiff’s claims involved alleged infringement of its photographs that were pictorial works within scope of copyright law, so claim met subject matter requirement for preemption. Court found plaintiff’s separate copyright claim alleging Burlington used plaintiff’s photographs to sell its products was same as plaintiff’s reverse passing off claim and failed to contain extra element or allege qualitatively different conduct from that governed by copyright law.

Poet Theatricals Marine, LLC v. Celebrity Cruises, Inc., No. 20-24619, 2021 U.S. Dist. LEXIS 17867 (S.D. Fla. Jan. 28, 2021)

District court denied motion to remand. Plaintiffs created, produced, and executed “live marketing and entertainment concepts, including shows aboard cruise lines.” Plaintiffs entered into agreements with defendant under which plaintiffs created, developed, pre-produced, and produced shows for Celebrity’s cruises until termination of last agreement in March 2016. Agreements granted Celebrity limited license to use, perform or display plaintiff’s shows on ship during terms of Agreements. Celebrity continued to use video recording and photographs of plaintiffs’ copyrighted work after termination of Agreements.

On discovering Celebrity’s wrongful use of intellectual property, plaintiffs sued in state court, asserting claims for conversion, unjust enrichment and vicarious liability for unjust enrichment. Defendants timely filed Notice of Removal. Plaintiffs contended removal improper because court lacked subject matter jurisdiction over claims, which plaintiffs argued were not preempted by Copyright Act. Court held that video recordings and photographs from plaintiffs’ shows fell within subject matter of copyright. Plaintiffs’ state law conversion claim was preempted because claim based on distribution or display sought to enforce rights equivalent to exclusive rights provided by Act and did not contain “extra element” to avoid preemption. However, unjust enrichment claim against Celebrity contained extra element, expectation and agreement of payment, that changed nature of claim, and claim was thus not preempted. Court, however, declined to exercise supplemental jurisdiction over remaining state law claim, and remanded claim to state court.

Health Indus. Bus. Communs. Council v. Animal Health Inst., 481 F. Supp. 3d 941 (D. Ariz. 2020)

Plaintiff developed and administered auto-identification and standards of transferring data in healthcare industry, including Health Industry Number (“HIN”) system database, whose users included drug manufacturers, hospitals, and clinics. Defendant Animal Health (“AHI”) was trade association of medical manufacturers in veterinary health industry. Defendant entered into agreement with plaintiff to license portion of HIN system relating to animal health trading partners. Defendant DXT was IT software company that was intermediary between plaintiff and defendant AHI. Plaintiff alleged that defendants used HIN database to create new “Animal Health Number” identification system. Plaintiff brought claims for copyright infringement, as well as state law claims. Defendants moved to dismiss breach of contract claim as preempted. Court found that subject matter of contract claim was within matter of copyright because agreement discussed unauthorized use, reproduction, and distribution of plaintiff’s copyrighted work. Court found, however, that contractual right was not equivalent to § 106 right. For example, DXC agreed to maintain confidentiality of information on HIN database, and plaintiff alleged breach of contract based on that clause. Allegations amounted to more than promise not to exploit copyrighted work, and contained extra element, and therefore claim was not preempted. Court denied motion to dismiss.

IX. DIGITAL MILLENNIUM COPYRIGHT ACT

Zuma Press v. Getty Images (US), 845 F. App’x 54 (2d Cir. 2021)

Second Circuit affirmed district court grant of summary judgment for defendant on claim of alteration of copyright management information (“CMI”). Plaintiffs sued Getty alleging that Getty posted more than 47,000 of Zuma’s images onto its website without authorization, and that Getty had removed CMI from said images. Plaintiff Zuma had (via arrangement with NewSport Photography) licensed its images to Corbis photo licensing agency, and defendant Getty ultimately acquired entirety of Corbis image portfolio. Plaintiffs alleged that as part of “migration” of Corbis images onto Getty server, CMI embedded into caption of certain images was removed in violation of § 1202(b)(3) of DMCA. District court found on

summary judgment that there was no evidence in record showing that Getty had “actual knowledge” that Zuma’s images were contained in portfolio of approximately 7,000,000 images it acquired from Corbis. Second Circuit explained that under recent precedent, CMI removal claim has “double scienter” requirement: plaintiff must prove that defendant both (1) knew that CMI had been removed or altered without authorization; and (2) knew (or had grounds to know) that such removal would “induce, enable, facilitate, or conceal an infringement.” Second Circuit agreed with district court that there was no genuine dispute of material fact as to whether Getty had actual knowledge that it altered Zuma’s CMI when it undertook migration process. Summary judgment for defendant on CMI removal claim affirmed.

Mango v. BuzzFeed, Inc., 970 F.3d 167 (2d Cir. 2020)

Second Circuit affirmed district court’s finding that plain language of § 1202(b)(3) does not require plaintiff to prove that defendant knew, or had reasonable grounds to know, that its conduct would lead to future, third-party infringements. Plaintiff, freelance photographer, took photograph of subject of discrimination lawsuit filed against New York City. Defendant BuzzFeed used photograph without authorization and, instead of listing plaintiff’s name in gutter credit, listed name of firm representing discrimination lawsuit plaintiff. District court found “double-scienter” requirement of § 1202(b)(3) satisfied and awarded plaintiff statutory damages. BuzzFeed appealed, arguing that it could not be liable under DMCA because it did not know its conduct would lead to future, third-party copyright infringement. Second Circuit found DMCA does not require such evidence. Court affirmed district court’s finding that BuzzFeed distributed photo (1) knowing that gutter credit had been removed or altered without plaintiff’s authorization; and (2) with gutter credit listing law firm despite knowing, or having reasonable grounds to know, that it would conceal fact that Buzzfeed did not have authorization to use work. Second Circuit affirmed district court judgment.

Fischer v. Forrest, 968 F.3d 216 (2d Cir. 2020)

Second circuit affirmed district court grant of summary judgment in favor of defendants on copyright claim stemming from alleged infringing use of promotional text in connection with plaintiff’s honey harvesting product. Plaintiff sold non-toxic honey harvesting aid, which was featured in defendants’ bee-keeping mail order catalogue beginning in 2002. Plaintiff also sold its product on its own website and obtained copyright registration for its website on February 7, 2011. Similar text to advertise plaintiff’s harvesting aid was used on plaintiff’s website and in defendants’ catalogue. In 2010, defendant stopped offering plaintiffs’ product and began selling its own honey harvesting aid using advertising text similar to text used on plaintiff’s website. Plaintiff asserted that defendants violated DMCA § 1202(c) when they removed plaintiff’s product name, “Fischer’s Bee-Quick,” from advertising copy on defendants’ website, arguing that product name constituted copyright management information (“CMI”). Court found that assertion “misunderstands what constitutes CMI.” While author’s name can constitute CMI, not every mention of name does. Here, “Fischer’s” was part of product name; it was not reference to “James H. Fischer” as owner of

copyrighted text. Nor was name “the title and other information identifying the work” or “the name of, and other identifying information about, the author of the work” as required by statute. Dismissal of § 1202(c) claim affirmed.

Dig. Drilling Data Sys., L.L.C. v. Petrolink Servs., 965 F.3d 365 (5th Cir. 2020)

Fifth Circuit affirmed district court’s holding on summary judgment that plaintiff’s technological measures did not effectively control access to its database, so defendant did not violate DMCA in accessing same. Plaintiff and defendant both provided software used by oil and gas operators to collect, filter (and, in plaintiff’s case, correct), log and visualize data from downhole drills. Plaintiff’s software program, which was designed to run only on laptops with USB security dongle inserted, logged corrected data into open source database program in which plaintiff created its own schema (i.e., relational structure), which had internal-facing password and could be accessed via plaintiff’s internal interface, but was also externally accessible via database program’s default, publicly available credentials. After obtaining laptop running plaintiff’s program and associated security dongle and accessing plaintiff’s database using default credentials without plaintiff’s authorization, defendant developed scraping program to copy corrected data from plaintiff’s database for use in defendant’s visualization program. Plaintiff sued defendant for, *inter alia*, DMCA violation. Fifth Circuit found that, though USB dongle and internal interface may have effectively restricted some unauthorized uses of plaintiff’s software (such as use in excess of license), these technological measures did not control access to plaintiff’s database schema, as required by DMCA.

Feingold v. RageOn, Inc., 472 F. Supp. 3d 94 (S.D.N.Y. 2020)

Plaintiff photographer was author of two photographs, one of Madonna holding red lollipop against her tongue, which appeared in plaintiff’s 2008 unpublished book, and other of Keanu Reeves, which appeared in 1989 issue of Rolling Stone. In 2018, plaintiff learned that RageOn.com, site that allowed individuals to design merchandise and sell wares through RageOn marketplace, was displaying works online without authorization. Parties cross-moved for summary judgment. Defendant claimed it was immune from liability due to DMCA safe harbor, but court found that defendant did not qualify for safe harbor for two reasons. First, defendant received financial benefit from infringement in that it received revenue share of sale of infringing merchandise, and defendant had right and ability to control infringement. Second, defendant did not expeditiously remove infringing materials. On January 8, 2018, plaintiff’s counsel sent defendant letter about infringing goods, and on January 11, 2018, defendant stated it would take down infringing goods within 24 hours. Despite this, it took defendants at least 18 days to take down infringing Reeves goods and 18-23 days to take down infringing Madonna goods. Court granted plaintiff’s motion for summary judgment and denied defendant’s motion for summary judgment.

Williams-Sonoma, Inc. v. Amazon.com, Inc., No. 18-7548, 2020 U.S. Dist. LEXIS 163066 (N.D. Cal. Aug. 17, 2020)

District court denied defendant's motion to dismiss. National retailer Williams-Sonoma sued Amazon for reproducing plaintiff's copyrighted photo of peppermint bark without authorization, in connection with Amazon resellers' listings of plaintiff's peppermint bark for sale. Plaintiff initially sent DMCA notices to Amazon resellers and sued Amazon for non-copyright claims, until learning in discovery that Amazon itself chose product images via algorithm based on different photos submitted by resellers. Plaintiff then amended complaint to add one claim for direct copyright infringement. In motion to dismiss, Amazon argued as affirmative defense that Amazon was shielded from direct liability by DMCA's safe harbor provision for material stored at direction of users. To evaluate safe harbor defense, district court examined whether facts on face of complaint indicated that infringing photograph was stored at direction of user. Complaint alleged that that Amazon – not third-party Amazon resellers – exercised sole discretion over which images were chosen for public display with products, and that Amazon takes active role in selection of such images. District court therefore concluded that plaintiff's allegations were sufficient to overcome motion to dismiss based on DMCA safe harbor defense.

Kirk Kara Corp. v. Western Stone & Metal Corp., No. 20-1931, 2020 U.S. Dist. LEXIS 189425 (C.D. Cal. Aug. 14, 2020)

Plaintiff, owner of three registrations for jewelry designs, brought claims for direct, contributory, and vicarious infringement and violation of DMCA, alleging that defendant distributed and/or sold four substantially similar engagement rings. DMCA claim was based on allegation that defendant omitted CMI consisting of plaintiff's engraved name, KIRK KARA, on ring. Defendant moved to dismiss DMCA claim. Court determined, based on review of side-by-side images included in complaint, that while works may be substantially similar, defendant did not make identical copies of plaintiff's works and then remove engraved CMI, and that no DMCA violation occurs where works are not identical. Court granted motion to dismiss DMCA claim.

Bain v. Film Indep., Inc., No. 18-4126, 2020 U.S. Dist. LEXIS 141859 (C.D. Cal. Aug. 6, 2020)

Plaintiff Robin Bain was author, producer, director, and actress in film *Nowhereland*, distributed as *Girl Lost*. Defendant Jessica Cesaro p/k/a Jessica Haid appeared in film. Plaintiff alleged that Haid asked plaintiff to allow her to add scenes from film to personal acting reel, which request plaintiff denied for fear of unauthorized release. In 2017, after film had been exhibited in 2016 film festivals but before wider release, Haid procured watermarked copy of film and retained defendant LA Media Works to edit scenes from film to create personal acting reel she could submit for further acting roles. To create reel, Haid shared film with LA Media via Google Drive, and LA Media removed watermark from scenes in which Haid appeared when creating reel. In August 2017, plaintiff found Haid's reel on LA Media site and requested destruction of all copies of film and removal of reel.

Haid, however, overlooked copy saved to Google Drive which listed Haid as owner of film. Plaintiff brought suit for direct, vicarious, and/or contributory infringement, as well as violations of DMCA. Defendant moved for summary judgment on DMCA count, arguing that plaintiff had no evidence to satisfy DMCA's intent requirement. Court found that Haid's provision of copy of film to LA Media via Google Drive did not establish material issue of fact as to whether Haid acted with "reasonable grounds to know, that it will induce, enable, facilitate or conceal an infringement," even if link indicated that Haid was owner of file. Copy of work provided to LA Media included watermark, which Haid did not remove, and there was no evidence Haid intentionally altered work's CMI by listing herself as owner on Google Drive, as opposed to Google automatically inputting information. Further, although Haid distributed film with deleted watermark there were no reasonable grounds for Haid to know that such distribution to directors could induce, enable, facilitate, or conceal infringement. Because plaintiff could not establish Haid acted with required knowledge, court granted summary judgment on 1202(b) claim.

Love v. Nuclear Blast Am., No. 20-124, 2020 U.S. Dist. LEXIS 187765 (C.D. Cal. Aug. 19, 2020)

District court denied defendant's motion to dismiss DMCA claim because plaintiff sufficiently alleged that defendant, in counter-notice to plaintiff's takedown notice, knowingly misrepresented that content was removed or disabled by mistake. In 2013, plaintiff songwriter for heavy metal band We Are The End shared demo versions of two songs ("Songs") with then-bandmate defendant. In summer 2019, defendant new band Rings of Saturn released recordings containing "complex melodic sequence" and "dominant musical phrase" directly copied from plaintiff's Songs. In October 2019, plaintiff registered copyrights in Songs, listing 2014 as year of completion. Plaintiff also issued DMCA takedown notices to YouTube, asking it to remove videos containing allegedly infringing songs. In response to one notice, defendant record label Nuclear Blast submitted DMCA counter-notice, asserting that plaintiff had submitted takedown as result of "mistake or misidentification." In email sent prior to counter-notice submission, band's label manager stated that label had "no idea" whether video was infringing. Plaintiff brought claim under § 512(f) of DMCA, alleging label liable in damages because counter-notice was knowing misrepresentation. On label's motion to dismiss DMCA claim, court found that, because label stated it "had no idea" whether DMCA notice was valid, its statement in counter-notice that it had "good faith belief" that notice was result of mistake or misidentification could plausibly constitute knowing misrepresentation, so plaintiff's DMCA claim sufficiently alleged.

Recif Res., LLC v. Juniper Capital Advisors, L.P., No. 19-2953, 2020 U.S. Dist. LEXIS 175431 (S.D. Tex. Sept. 24, 2020)

District court granted summary judgment on defendant's motion for its DMCA counterclaim where it was undisputed that plaintiff intentionally removed defendant's copyright management information from copyrighted works with reasonable grounds to know such removal was not authorized by defendant. In October 2017, plaintiff and defendant began

discussions of oil-and-gas development project in Mississippi. In February 2018, defendant created cross-section map and regional map poster (“Works”), copies of which it provided to plaintiff. In May 2018, after parties’ discussions ended, plaintiff asked defendant to cover expenses associated with land and legal work done in connection with parties’ proposed partnership. Defendant agreed to cover 50% of expenses and emailed that plaintiff will “still have access to this information” and “the ability to use that information to try to find new sources of funding.” Plaintiff used Works in presentations, removing defendant’s name and logo and inserting plaintiff’s own logo. After plaintiff sued defendant on state law claims, defendant interposed copyright and DMCA counterclaims and removed to federal court. Defendant moved for summary judgment on its DMCA claim because it was undisputed plaintiff had intentionally removed defendant’s copyright management information from Works without defendant’s permission. Plaintiff opposed, arguing that defendant’s email authorized plaintiff’s use of Works such that plaintiff did not know or have reasonable grounds to know its removal of CMI would enable, facilitate or conceal copyright infringement. Court held that, because defendant’s email sent in response to request for payment for “land and legal work” thus unrelated to Works or underlying geological analysis, plaintiff had reason to know removal of CMI would conceal plaintiff’s infringement.

RAZ Imps., Inc. v. Regency Int’l Bus. Corp., No. 19-1855, 2020 U.S. Dist. LEXIS 139406 (N.D. Tex. Aug. 5, 2020)

District court granted defendant’s motion to dismiss plaintiff’s DMCA claims because defendant’s copying and repackaging of plaintiff’s copyrighted work as new product was not removal or alteration of CMI. Plaintiff importer of seasonal merchandise developed Marshmallow Spray, which plaintiff labeled on its website as 24” Marshmallow Pick and registered with Copyright Office as sculptural work. Subsequently, plaintiff learned that defendant competitor was selling at least two products that were substantially similar to Marshmallow Spray, one of which defendant labeled on its website as 33” Sugared Marshmellow Spray. Plaintiff sued, alleging that defendant’s alteration of product’s title to “Marshmellow Spray” and removal of indication of plaintiff’s authorship of product violated DMCA’s prohibition against knowing and intentional misuse of copyright management information (CMI) to induce, enable, facilitate or conceal infringement. Plaintiff did not allege that any CMI was removed from or altered on plaintiff’s Marshmallow Spray, and instead complained of defendant’s failure to identify plaintiff as author of accused products on defendant’s website. Court held that defendant’s copying of plaintiff’s work and repackaging it as new work, while potentially infringement, did not constitute removal or alteration of CMI, so dismissed plaintiff’s DMCA claims with prejudice.

Dona’t v. Amazon.com/Kindle, 482 F. Supp. 3d 1137 (D. Colo. 2020)

Court granted defendant Amazon’s motion for summary judgment. *Pro se* plaintiff, federal prisoner, wrote and registered book manuscript and sent it to defendant Monique Hall and other publishers in 2008. Hall’s publishing company agreed that it would publish plaintiff’s book but did not do so for years, and did not respond to requests for manuscript’s return. In

2017, plaintiff learned book was sold as e-book on Amazon, but plaintiff alleged he had received no royalties or compensation. Plaintiff brought suit in 2019 alleging unauthorized sale and distribution of book. Amazon moved for summary judgment under DMCA § 512(c), on grounds that plaintiff never provided notice of infringement, and Amazon removed book listing two days after it was served with complaint, which Amazon claimed was first time it was aware of alleged infringement. Plaintiff claimed in opposition to motion that he wrote to Amazon about infringement before filing complaint, but failed to adduce any evidence of adequacy of notice under DMCA, or that Amazon received such notice; however, contention devoid of evidence was insufficient to raise material issue of fact. Plaintiff also contended that Amazon could not rely on DMCA safe harbor because it received direct financial benefit from infringing activity, but had not pointed to any evidence that Amazon had right and ability to control allegedly infringing activity. Court granted Amazon's motion for summary judgment.

Warner Records Inc. v. Charter Communs., Inc., No. 19-874, 2020 U.S. Dist. LEXIS 206702 (D. Colo. Nov. 5, 2020)

District court granted plaintiffs' motion to dismiss defendant's counterclaim because plaintiffs' deletion of some allegedly infringed works from amended complaint did not constitute knowing misrepresentation of infringement. Plaintiffs record labels and music publishers sued defendant internet service provider for vicarious and contributory infringement on grounds that defendant's customers used its services to repeatedly infringe plaintiffs' copyrighted works and, despite having right to terminate user accounts for piracy and plaintiffs serving hundreds of thousands of infringement notices, defendant did not take action against infringers to avoid losing revenue and to draw additional customers. Plaintiffs' original complaint alleged that defendant secondarily infringed 11,027 works, while first amended complaint identified 455 fewer works. Defendant brought counterclaim that it was entitled to damages under § 512(f) of DMCA because plaintiffs' dropping number of allegedly infringing works implied that original complaint contained knowing, material misrepresentations that damaged defendant. Court held that defendant provided only conclusory allegations that plaintiffs "had or should have had knowledge" of ownership or control of allegedly infringed works, therefore defendant failed to sufficiently allege facts that plaintiffs knowingly or materially misrepresented infringement claims. Further, dropped works represented less than 4% of total allegedly infringed works, so any misrepresentation would not be material, especially since plaintiffs dropped works to which they determined they did not have valid claim. Finally, defendant did not allege that it incurred damages as it did not cancel or disable access to any subscriptions.

Hong v. Rec. Equipment, Inc., No. 19-435, 2020 U.S. Dist. LEXIS 131393 (D. Idaho July 23, 2020)

Plaintiff artist was creator of illustration depicting inner rings of tree trunk. Defendant Krieg directly marketed and sold climbing bags, and sold bags to retailers such as defendant REI. Krieg's website contained 80 climbing bags, two of which bore tree-ring design without license or consent from plaintiff. Plaintiff further alleged that Krieg entered into agreement

with REI to sell bags with tree-ring designs, and accordingly REI had also reproduced, distributed, and created derivative works of plaintiff's design by posting photos of said bags to its website. Plaintiff asserted claims for infringement and violation of DMCA for removal of CMI. Defendants moved to dismiss claims on basis that they were not plausibly pleaded. Court found plausible claim that including design on bags, but excluding title and authorship of work, misled people as to who owner of design was, and exclusion of ownership information was defendants' attempt to cover up infringement. Plaintiff also alleged violation of § 1202(a), claiming that defendants falsified CMI; website indicated defendants were owners of design because titles included individual defendant's name – "Krieg Tree Rings Green Chalk Bag" and "Krieg Special K Chalk Bag – Bigfoot." Although defendants argued that titles of bags could not be CMI because they referred to unprotectible utilitarian items, argument ignored settled law that separable feature incorporated into design of useful article may be eligible for copyright protection, and glossed over fact that brand name "Krieg" was located within name of each infringing bag and appeared alongside each bag with infringing design, which, at motion to dismiss stage, was sufficient to state § 1202(a) claim. Court denied motion to dismiss.

Advanta-Star Auto. Research Corp. of Am. v. Reynolds Ford, Inc., No. 19-912, 2020 U.S. Dist. LEXIS 180538 (W.D. Okla. Sept. 30, 2020)

Plaintiff owned rights in automobile reviews and information that it sold or licensed to dealerships for educational and commercial purposes. Plaintiff alleged that defendant placed plaintiff's work on its website after intentionally modifying work to conceal source and replaced plaintiff's copyright notices with its own. Defendant moved to dismiss CMI claim. Defendant argued that copyright notice in footer of website rather than "near or next to" allegedly infringed content did not qualify as CMI under statute. Court disagreed, distinguishing cases that defendant cited in support of argument that "generic footer" on webpage did not amount to information "conveyed in connection with" work, because in current case, copyrighted work was text on webpages. Court also found § 1202(b) claim plausibly pleaded with requisite specificity. Court denied motion to dismiss CMI claims.

X. VISUAL ARTISTS RIGHTS ACT

Robar v. Vill. of Potsdam Bd. of Trs., 490 F. Supp. 3d 546 (N.D.N.Y. 2020)

Plaintiff, who installed "porcelain gardens," toilets repurposed as flower planters, in outdoor spaces on several properties he owned in Potsdam, New York, asserted claim under Visual Artists Rights Act seeking to enjoin enforcement action against him pursuant to ordinance mandating removal of "junk" from public view. Plaintiff installed earliest porcelain gardens in 2005 as expression of his philosophical disagreement with Village's purported authority to limit his right to use his private property as he pleased. Function of porcelain gardens evolved to encompass what plaintiff described as artistic ends: plaintiff "fell in love with the artistic and expressive value of the toilets as fun and funky porcelain planters." In 2018 Village Board adopted "Junk Storage Law" prohibiting "deposit, accumulation, display and/or outdoor storage of junk, junk appliances, junk furniture, junk mobile homes, junk

motor vehicles, garbage (collectively hereinafter ('junk')), regardless of quantity.” “Junk appliances” was defined to include “bathroom fixtures,” defined in turn as “any fixture reasonably found in a bathroom, including, but not limited to, toilets and toilet components.” Village served plaintiff with Notice to Comply. Plaintiff argued that defendants threatened destruction of porcelain gardens in violation of VARA. Court found, however, that defendants did not threaten to “destroy” porcelain gardens within meaning of statute. Defendants mandated, at most, that plaintiff remove porcelain gardens from properties; they did not order plaintiff to destroy them, nor did they threaten to do so themselves. “Destruction” under VARA entails, at minimum, irreparable damage. Whether relocation of covered work of visual art is illegal under any category of prohibited act (“destruction,” “distortion,” “mutilation,” or “modification”) depends entirely on consequences of relocation. Court had been given no reason to believe that relocation of porcelain gardens would cause them damage of any kind; indeed, plaintiff conceded that they could be relocated. Point of statute is not “to preserve a work of visual art *where* it is, but rather to preserve the work *as* it is.” Plaintiff thus had not demonstrated likelihood of success with respect to VARA claim.

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