

Detail Table of Contents

PREFACE	v
SUMMARY TABLE OF CONTENTS	vii
CHAPTER 1: JURISDICTION AND PROCEDURE	1
I. Jurisdiction and Procedure	1
A. Subject Matter Jurisdiction	1
1. “Arising Under” Jurisdiction	1
2. Foreign Acts	6
3. The Role of Registration	9
B. Personal Jurisdiction	14
1. Intentional Acts Directed at the Forum	14
a. Sales in Forum	15
b. Other Intentional Acts Directed at Forum	16
c. Interactive Internet Presence in Forum	17
2. Acts of Principals, Agents, and Affiliates	18
3. Contract Clauses	19
C. Standing	19
1. Standing for Infringement Claims	20
2. Assigning the Right to Sue	22
3. Standing for Copyright Claims Other than Infringement	24
D. Pleadings	24
E. Jury Trial	27
F. Declaratory Judgment	29
CHAPTER 2: COPYRIGHTABILITY	35
I. Originality of Authorship	36
A. Statute	36
B. The <i>Feist</i> Standard	37

1. Independent Creation	38
2. Modicum of Creativity	38
a. Specific Works	38
C. Limiting Doctrines	40
1. Merger Doctrine/Idea-Expression Dichotomy	41
2. Scenes à Faire	42
3. Government Works	44
4. “Common Property”/Public Domain	46
5. Facts	46
6. Forms, Instructions, Methods, and Procedures	48
a. Blank Forms	48
b. Instructions	50
c. Other Methods and Procedures	51
7. Functionality/Separability Doctrine	52
8. Software	52
9. Religious Works	59
II. Compilations	60
A. Statute	60
B. The <i>Feist</i> Standard	61
1. Unprotectable Compilations	63
2. Protectable Compilations	66
a. Yellow Pages Listings	66
b. State Telephone Tariffs	66
c. Baseball Statistics	67
d. Used Car Prices	67
e. Control and Diagnostic Codes	68
f. Graphic Design Elements	69
g. Musical Revue	69
h. Literary Works in an Anthology	70
i. Graphs and Tables	70
j. Film Pitches	71
k. Software Programs as Compilations	71
l. News	71
m. Food: Recipes and Menus as Compilations	72
n. Religious Works as Compilations	72
C. Limiting Doctrines	73
1. Merger Doctrine/Idea-Expression Dichotomy	73
2. Industry Standards	74
3. Functionality	74
III. Pictorial, Graphic, and Sculptural Works	74
A. Statute	74
B. Specific Works Under the <i>Feist</i> Standard	75
C. Limiting Doctrines	75
1. Useful Articles/Separability	75
a. Conceptual Separability in the Second Circuit	76
b. <i>Pivot Point</i>	78
c. More Recent Cases	79
d. Clothing	79

<i>Detail Table of Contents</i>	xi
e. Jewelry	80
f. Toys	81
g. Blueprints	82
2. Merger Doctrine/Idea-Expression Dichotomy	82
3. Depictions of Nature	83
4. Typography/Familiar Symbols	84
IV. Derivative Works	87
A. Statute	87
B. “More Than Merely Trivial” Variation Standard	88
1. Specific Applications	88
a. Art and Design	88
b. Art Reproductions	93
c. Music	94
d. Computer and Software Cases	97
e. Characters	98
f. Literary Works	98
C. Permission Requirement	98
V. Architectural Works	101
A. In General	101
B. Section 120	103
C. Architectural and Government Works	104
CHAPTER 3: OWNERSHIP	105
Introduction	107
I. Works Made for Hire	107
A. The 1909 Act and the “Instance and Expense” Test	108
1. Defining “Instance”	110
a. Actual Control	111
2. Defining “Expense”	112
3. Preemployment Work Made for Hire	112
4. Intermediate Employer Doctrine	114
B. The 1976 Act	114
1. Type 1 Works	115
a. Defining “Employee” and “Employer”	115
i. <i>Pre-Reid</i>	115
ii. <i>Reid</i>	116
iii. <i>Post-Reid</i>	117
(1) Work Made for Hire Found	118
(2) Work Made for Hire Not Found	119
b. Defining “Within the Scope of Employment”	120
i. Job Description	122
ii. Within Job’s Time and Space Limits	123
iii. Serving Employer’s Interests	123
c. Effect of a Signed Writing	124
2. Type 2 Works	125
a. Defining “Specially Ordered or Commissioned” ...	126
b. Defining Signed Writing	126

c. Nine Statutory Categories	128
3. Effect of Registration	129
II. Transfer of Ownership	129
A. Fundamentals	130
1. Exceptions to the Writing Requirement.....	132
2. The 1909 Act	133
B. Time, Term, and Renewal	133
C. Wills and Intestate Succession	133
D. Licensees and Assignments	134
E. New Technologies	135
III. Joint Works and Co-Ownership	135
A. Copyrightable Contribution	136
1. <i>Gaiman</i> Exception	138
B. Intent	138
1. <i>Childress v. Taylor</i>	139
2. <i>Larson</i> Indicia	140
a. Control	140
b. Credit	141
c. Written Agreements	142
d. Sharing of Proceeds	142
3. Implied Intent	142
C. Joint Authorship vs. Joint Ownership	143
D. Distinguishing Joint Works from Collective Works and Derivative Works	143
1. Collective Works	143
2. Derivative Works	143
E. Statute of Limitations	144
IV. Contracts and Licenses	145
A. Exclusive vs. Nonexclusive Licenses	145
1. Exclusive Licenses	145
a. Transferability	146
2. Nonexclusive Licenses	147
a. Terminability	147
b. Nonexclusive Implied License Doctrine	147
i. Issues of Fact	151
B. General Principles of Construction for Copyright Agreements	151
1. Scope of Licenses	151
2. Who Is Bound?	152
3. Defects in Formation of the Contract.....	152
4. Licensee Estoppel	153
5. Tacit or Ambiguous Terms by Type of Work.....	153
a. New Technologies	153
b. Music and Video	155
c. Software	156
d. Architecture	157
e. Photography	158
f. Government Works	158

<i>Detail Table of Contents</i>	xiii
6. Software Contracts	159
a. Shrink-Wrap Contracts	159
b. Derivative Works	160
c. First Sale Doctrine	162
d. Section 117 Defense	165
7. Oral Agreements and Statute of Frauds	166
C. Breach	166
1. Failure to Pay Royalties	167
2. Breach of Other Conditions or Covenants	167
3. Anticipatory Breach	168
E. Compulsory Statutory Licenses	168
CHAPTER 4. FORMALITIES	171
I. Notice and Publication	172
A. Notice	173
1. 1976 Act	173
2. 1909 Act	173
3. Correcting Omission of Notice	174
4. Notice for Sound Recordings	174
5. Omission of Notice on Pre-1989 Works: Special Circumstances	175
B. Publication	176
1. What Is “Distribution of Copies”?	177
2. Who Is “the Public”?	177
3. Derivative Works, Embedded Works, and Compilations	179
4. Publication of Phonorecords and Underlying Compositions	182
5. International Publication	183
II. Registration	185
A. Errors in Description of Work	186
B. Errors in Deposit	187
C. Errors as to Date and Publication Status	188
D. Errors as to Ownership	189
E. Deliberate Misrepresentations and Fraud	190
F. <i>Whimsicality</i> and the Fraud Defense	192
G. Collective Works	194
H. Derivative Works	195
III. Recordation	197
IV. Duration and Renewal	199
A. Durational Provisions of the 1976 Act	200
B. The Effect of the Renewal and Term-Extension Amendments on Duration for Pre-1978 Works	201
C. Duration of Copyright Term After Copyright Renewal Act of 1992 and the Sonny Bono Act	202
1. Hypothetical No. 1—Information Needed	202
2. Hypothetical No. 2—Applying the Statutory Dates ...	204

V. Restoration of Foreign Works	205
A. Description of Statutory Structure and Operation	205
B. Specific Issues	208
1. What Works Are Entitled to Protection?	208
2. Who Is a Reliance Party?	208
3. Is Section 104A Constitutional?	211
C. Statute	215
VI. Termination	220
A. Section 203 and Post-1978 Grants: State Law Governs Until (At Least) 2013	222
B. Section 304 and Pre-1978 Grants: Federal Law Governs	224
1. Section 304 and Derivative Works	224
2. Section 304 and New Grants	226
C. Statute	233
CHAPTER 5. INFRINGEMENT	239
Introduction	242
I. Access	242
A. Standards of Evidence	243
B. Widespread Dissemination	245
1. Findings of No Access	245
2. Triable Issues of Fact	247
3. Findings of Access	248
C. Third Parties	250
1. Findings of No Access	250
a. Creation Before Access	251
2. Triable Issues of Fact	252
3. Findings of Access	253
D. Direct Submission	254
1. Corporate Receipt and “Bare Corporate Receipt”	255
a. Findings of Access	256
b. Findings of No Access	256
E. Striking Similarity	258
II. Copying and Substantial Similarity	259
A. Evidentiary Issues	260
1. More Than <i>de Minimis</i> Copying	261
2. Vicarious Liability	262
3. Other Similarity Issues	262
B. Extrinsic/Intrinsic Analysis	263
1. Motion Pictures and Literary Works	264
2. Music	266
3. Design	268
4. Three-Dimensional Objects	270
5. Video Games	272
C. Total Concept and Feel Test	272

Detail Table of Contents

D. Ordinary Observer Test	276
1. Small Changes Doctrine	280
2. Discerning Ordinary Observer Test	282
E. Scenes à Faire, Stock Themes, and Merger Doctrine	284
1. Movies, Stories, and Characters	285
a. No Substantial Similarity	285
b. Substantial Similarity Found	288
2. Visual Works	290
a. No Substantial Similarity	290
b. Substantial Similarity Found	292
3. Toys	292
4. Music	294
5. Arrangement of Unprotectable Works	294
a. Arrangement Is Protectable	294
b. Arrangement Not Protectable	295
6. Derivative Works	296
F. Literary Works (Other Than Software)	297
1. Abstraction-Filtration-Comparison Test	297
2. Copying “Heart” or “Fundamental Essence” of Non-Fiction Work	299
a. Substantial Similarity Found	299
b. No Substantial Similarity	300
3. Words and Phrases	301
4. Fact-Based Works	302
a. Substantial Similarity Found	303
b. No Substantial Similarity	305
G. Unique Issues Due To Nature of Medium	305
1. Visual Works	305
2. Music	312
3. Three-Dimensional Works	313
4. Games	314
H. Copying and Technology	314
1. Internet Issues	314
2. Broadcast Issues	315
I. Substantial Similarity and the Jury	316
III. Computer Works	317
A. Standards of Similarity	317
1. Identical	318
2. Virtually Identical	318
3. Striking Similarity	320
4. Trivial Difference	321
B. Abstraction-Filtration-Comparison Test	321
1. Experts and the AFC Test	324
2. Literal and Nonliteral Elements	325
3. Industry Conventions/Scenes à Faire	326
C. Functionality	326
1. <i>Lotus v. Borland</i>	326
2. Functionality and the AFC Test	328

D.	Section 117	329
1.	Adaptation Exception	330
2.	Maintenance Exception	332
E.	Inline Linking/Pop-Ups.....	333
1.	Derivative Works	333
2.	Right of Display	334
F.	Software Rental	335
IV.	Importation	336
A.	First Sale in the United States.....	337
B.	First Sale Outside the United States.....	340
V.	Secondary Liability	341
A.	Contributory Infringement.....	342
1.	Defining Knowledge	342
2.	Defining Substantial Participation.....	345
B.	Vicarious Liability	348
1.	Defining Control	349
a.	Right and Ability to Supervise	349
b.	Actual Control	350
c.	Intra-Corporate Vicarious Liability	352
2.	Defining Financial Interest	354
a.	Intra-Corporate Vicarious Liability	356
3.	Mixed Claims	356
C.	Inducement	358
1.	Background: <i>Sony</i> and its Progeny	359
2.	The Unanimous <i>Grokster</i> Court	360
3.	Justice Breyer’s Concurrence	361
4.	Justice Ginsburg’s Concurrence.....	362
5.	<i>Grokster</i> Remand	363
D.	Sale of Products and Secondary Liability	367
E.	International Issues.....	368
F.	Pleadings	369
VI.	Public Performance and Public Display	369
A.	Defining “Performance”	369
B.	Defining “Display”	370
1.	Limitations.....	372
C.	Defining “Public”	372
1.	Limitations.....	374
a.	Section 110.....	374
b.	Section 111	375
D.	Public Performances of Sound Recordings	376
E.	International	378
VII.	Derivative Works	378
A.	Is Defendant’s Work Substantially Similar?	378
B.	Must Defendant’s Work Be Reproduced to Violate the Derivative Work Right?	381
1.	Derivative Works and First Sale	382
2.	Derivative Works and Fixation	382

Detail Table of Contents xvii

- C. Is Defendant’s Work Creative Enough to Be a Derivative Work? 383
- VIII. Criminal Infringement 385
 - A. Section 506 385
 - B. Other Statutes 386
 - 1. Wire Fraud Statute 386
 - 2. Anti-Bootlegging Statute 387
 - 3. RICO and the Anticounterfeiting Consumer Protection Act 389
 - 4. Wiretap Act 390
 - 5. False Statements 392
 - C. Evidentiary Issues 392
 - D. Sentencing 393
- CHAPTER 6. FAIR USE 395
 - I. Types of Defenses 396
 - A. Fair Use 396
 - 1. Statute 396
 - a. Statutory Language 396
 - b. General Principles 397
 - i. Precedent 397
 - ii. Scope of Defense 397
 - iii. Favored Purposes 398
 - iv. Burdens and Presumptions 399
 - v. The Role of Equity 401
 - 2. The Four Factors 402
 - a. First Factor: Purpose and Character of Use 402
 - i. Commercial Use 402
 - ii. Educational Use 404
 - iii. Criticism, Comment, News Reporting, Scholarship, and Research 406
 - iv. Nonexploitive Use 406
 - b. Second Factor: Nature of Work 407
 - i. Published or Unpublished? 408
 - ii. Factual or Creative? 410
 - iii. Available or Out of Print? 410
 - c. Third Factor: Amount of Use 411
 - d. Fourth Factor: Market Effect 413
 - i. Plaintiff’s Presence in Relevant Market 414
 - ii. Lost License Fees 416
 - 3. Transformative Use—The “Fifth Factor” 418
 - a. General Principles 418
 - b. Specific Examples of Transformative Use 419
 - i. Parody 419
 - (1) Parody or Not? 419
 - (2) Parody and Market Harm 423
 - ii. Transformative Non-Parody Uses 425

(1) Transformative Authorship	425
(2) Transformative Reproductions	426
4. Fair Use—Specific Applications	431
a. Movie Clips	432
i. Clips in Documentaries	432
ii. Non-Documentary Uses of Clips	435
b. Photographs, Stills, and Illustrations	437
c. Use in Politics/Government	439
i. Court Proceedings	439
ii. Other Political and Governmental Uses	441
d. Religious Works	441
e. News (Other than Film Clips)	442
i. File Sharing	444
ii. Advertising	444
iii. Reverse-engineering and Intermediate Copies	445
iv. Trivia Books, Guides, and Plot Summaries	448
CHAPTER 7. OTHER DEFENSES	451
I. Types of Defenses	452
A. Statute of Limitations, Laches, Estoppel, and Delay	453
1. Statute of Limitations	453
a. Rolling Infringement	453
b. Rolling Infringement and Ownership Claims	454
2. The Role of Plaintiff’s Knowledge— The “Discovery Rule”	456
3. The Discovery Rule and Ownership Claims	457
a. What Is Notice?	459
i. Notice Found	459
ii. No Notice Found	460
b. Issues of Fact	461
4. Tolling the Statute	462
a. Continuing Tort	466
b. Interplay of Section 507(b) with Contracts and Other Statutes	467
5. Statute of Limitations: Pleadings and Procedure	469
6. Estoppel; Laches and Delay	470
a. Estoppel	470
i. Defendant’s Reliance	471
ii. Plaintiff’s Reliance	472
b. Laches and Delay	473
i. Infringement Claims	474
ii. Ownership Claims	475
iii. Evidentiary Prejudice	476
iv. Reliance and Expectation Prejudice	477
v. Delay and Preliminary Injunctions	478

	<i>Detail Table of Contents</i>	xix
B. Misuse		479
1. Origins in Patent and Antitrust Law		480
a. <i>Lasercomb v. Reynolds</i>		481
b. Immediate Aftermath of <i>Lasercomb</i>		483
2. Misuse and Antitrust		485
3. Misuse and Public Policy		487
a. Software/Restrictive Licensing		487
b. Non-Software/Selective Licensing		489
C. Section 117		490
1. Statute		490
2. The <i>MAI</i> Cases		491
3. Ownership vs. Licensing		492
4. Maintenance Exception: Section 117(c)		494
D. Innocent Infringement		496
1. Section 504—Damage Reduction for Reasonable Belief of Innocence		496
2. Section 406—Error in Notice		497
3. Section 405—Notice and Omission of Notice		498
E. <i>Res Judicata</i> /Collateral Estoppel		500
1. <i>Res Judicata</i>		500
2. Collateral Estoppel (Issue Preclusion)		503
3. International Application		505
F. First Sale		506
1. Statutory Overview		506
2. Statutory Text and Legislative History		506
3. Burden of Proof in Infringement Actions		510
4. Ownership of Lawfully Made Copy		510
5. First Sale and Importation		512
6. First Sale and Derivative Works		518
G. Section 201(c)		520
1. <i>Tasini</i> : Facts and Prior History		521
2. Supreme Court: Majority Decision		522
3. Supreme Court: Dissent		524
4. Post- <i>Tasini</i> Developments		525
H. Section 110		528
1. Statute		528
2. Section 110(5)		533
3. Caselaw Interpreting Section 110(5)		535
CHAPTER 8. REMEDIES		537
I. Damages and Profits		538
A. Actual Damages and Lost Profits		538
1. Calculating Defendant’s Profits		539
a. Indirect Profits—Causal Nexus Needed		539
b. Direct Profits—Defendant’s Deductions		540
i. Overhead		540
ii. Apportionment		541

c. International Profits	542
2. Actual Damages	543
B. Statutory damages	544
1. How Many Statutory Awards?	545
2. How Much to Award?	546
3. Awarded Against Whom?	547
a. “Substantial and Continuous Connection”	548
b. “Joint Action”	549
4. Willful infringement.....	550
a. Proving Willfulness.....	550
b. Calculating Statutory Damages—Willful Infringement	551
5. Non-Willful Infringement	552
6. Attorney’s Fees	553
a. Registration and “Commencement”	554
b. Prevailing Party	554
c. Merits—the Fogerty Standard	555
i. Reasonableness	556
(1) Claims of Non-Prevailing Party Found Reasonable	557
(2) Claims of Non-Prevailing Party Found Unreasonable	557
ii. Bad Faith, Willfulness, Frivolousness	558
iii. Standards for Plaintiff vs. Standards for Defendant	559
d. Types of Claims	560
e. Determining the Amount of the Fee	561
f. Fed. R. Civ. P. Rule 68	562
g. Equitable Reductions: Parties’ Relative Financial Strength	565
II. Injunction/Impoundment	566
A. Standard for Imposing an Injunction	566
1. Likelihood of Irreparable Harm to Plaintiff	567
a. Delay	568
2. Adequacy of Money Damages	569
3. Balance of Hardships Analysis	570
4. Public Harm	571
B. Permanent Injunctions	572
C. Temporary Restraining Orders	573
D. Scope of Injunctions	573
1. Manufacture and Sale	573
2. Relation of Works Covered by Permanent Injunction to Works at Issue in Suit	574
3. Third-Party Infringers	575
4. Temporal Breadth	575
5. Territorial Breadth	576
E. Seizure/Impoundment	576

	<i>Detail Table of Contents</i>	xxi
	1. Standards	576
	2. Scope	577
III.	Sanctions	578
	A. Failure to Investigate	579
	B. Discovery and Evidence	580
	1. Lack of Cooperation	581
	2. False Evidence	581
	C. Confidentiality Issues.....	582
	D. Violation of Court Orders/Contempt.....	582
	1. Calculating Amount of Fines for Contempt	583
	a. Coercive Fines.....	583
	b. Compensatory Damages	583
IV.	Punitive Damages	583
CHAPTER 9.	PREEMPTION	587
	I. Introduction.....	588
	A. Statutes	589
	B. Pleadings	590
II.	The Subject Matter Requirement of Section 301(a)	592
	A. In General.....	592
	B. Right of Publicity Claims	594
	C. Pre-1972 Sound Recordings	595
	D. International Issues.....	596
	E. Merger Doctrine	597
	F. Ownership.....	597
III.	Equivalent State Rights.....	597
	A. Contract Claims.....	598
	1. Extra Elements.....	598
	a. Expectation of Payment or Benefit.....	599
	b. Software Contracts	602
	c. Confidentiality	604
	d. Contract Termination	605
	2. Per Se Rule	606
	B. Right of Publicity Claims—Equivalent or Not?	608
	1. Derivative Works	608
	2. Voice Imitations	610
	C. Unjust Enrichment	611
	1. Derivative Works and Adaptations.....	612
	2. Music Cases	613
	D. Unfair Competition/Deceptive Trade Practices	613
	1. Deception	614
	2. Passing Off/Reverse Passing Off	616
	E. Misrepresentation/Fraud	617
	F. Misappropriation	619
	G. Conversion	622
	H. Trespass to Chattels	624

I. Misappropriation of Trade Secrets/Breach of Confidential Relationship	626
J. Tortious Interference	628
K. Breach of Fiduciary Duty/Breach of Trust	629
L. Negligence	629
M. Antitrust	630
N. Criminal Law	631
O. Marital Law	632
P. Bankruptcy	633
Q. Liens	634
R. Indemnity	634
S. Artist’s Rights	634
T. Public Records Acts	635
U. Gambling Regulation	636
IV. Constitutional Preemption	636
A. Supremacy Clause	636
1. Contracts Waiving Fair Use	638
2. Contracts Waiving First Sale	639
B. Before and After Dastar	641
C. Other Intra-Federal Conflicts	644
1. Sherman Act	644
2. RICO Act	645
3. Wire Fraud Statute	645
CHAPTER 10. THE DIGITAL MILLENNIUM COPYRIGHT ACT	647
I. Overview	647
II. Safe Harbors	649
A. Section 512 Exemptions From Secondary Liability for Online Service Providers: General Provisions	649
B. Terminating Repeat Infringers: Section 512(i)	651
C. Knowledge and Right To Control: Section 512(c)	652
D. Other Safe Harbor Requirements	654
E. Mere Conduits: 512(a) and <i>Religious Technology Center</i> <i>v. Netcom</i>	655
F. Notice Standards	657
G. Defensive Suits Against the Copyright Holder	661
H. Subpoenas	663
III. Anti-Circumvention	665
A. Introduction to the Statute	665
B. DVDs	667
C. Broadcast Systems (Satellite/Streaming Media Online) ...	669
D. Software	670
E. Interoperability	670
F. Copyright Notice	671
G. Sovereign Immunity	672
CHAPTER 11. INTERNATIONAL ISSUES	673

Detail Table of Contents xxiii

I. International Agreements: Berne and the U.C.C.	674
II. Choice of Law	676
A. Ownership	676
B. Contracts	680
C. Act of State Doctrine	683
III. Extraterritoriality: Infringement, Remedies, and Jurisdiction	684
A. Authorization or Origination in the U.S.	684
1. Authorization	685
B. Remedies	687
IV. Duration and Formalities	687
A. Duration	687
B. Formalities and Foreign Publications	688
V. Claim and Issue Preclusion	690
 CHAPTER 12. TAX, INSURANCE, ANTITRUST, AND BANKRUPTCY ISSUES	 693
I. Tax Issues	694
A. Ownership of Copyright Versus Ownership of Revenue	694
B. Intangible Rights Versus Tangible Property	696
C. Selected Cases	698
II. Insurance Issues	701
A. Infringement Policies	701
B. Advertising Policies	702
1. Did Defendant’s Loss Arise from “Advertising”?	702
2. What Is Advertising?	704
3. Other Reasons for Denial of Coverage	705
4. Preemption	706
C. Selected Cases	706
III. Antitrust Issues	715
A. Refusal to License	715
B. Bundling and Tying	716
C. Antitrust Counterclaims and the <i>Noerr-Pennington</i> Doctrine	718
D. Selected Cases	719
IV. Bankruptcy Issues	725
A. Property Schedules	725
B. Licenses Versus Transfer	725
C. Security Interests	726
D. Abandonment by Trustee	728
E. Non-Discharge for Willful Injury	729
F. Selected Cases	730
 APPENDIX: FORMS	 739
 TABLE OF CASES	 —
 INDEX	 —