

Copyright Analysis Synthesis

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This handout is intended to give you a generalized to-do list for approaching typical copyright problems – mostly concerning whether an infringement has occurred, but also adaptable to answer more particular questions, such as whether one person is an owner of the copyright in a particular work.

Important notes regarding how this document relates to our course:

First, note that **this document does not cover all the legal doctrine in the course**. Not even close. As one simple example, we learned a bit about patent and trademark, and those things aren't covered. And moral rights aren't addressed either. But even with copyright proper, there is a large amount of material covered in the course that is not embraced by this document.

Second, this document is not meant to be a source for helping you to understand the law. Rather, it is meant to be a road map for approaching problems in order to apply what you've learned.

Third, **do not try to make inferences about what will be on the exam from this document**. The amount of words devoted to a topic in this document reflects a judgment with regard to the amount of detail necessary to provide a comprehensible scheme for applying much of what you've learned. The amount of words devoted to topics in this document is not intended to correspond to the amount of time devoted to the topic in class or to correspond to the amount of emphasis a topic will receive on the exam. Thus, a topic might get some detailed coverage in this document with comparatively little emphasis on the exam.

This document comes out of the Spring 2023 course in Copyright at OU College of Law. Course webpage: http://www.ericejohnson.com/courses/copyright_23/

The course's open-access casebook, referenced as "F&S" below, is: Jeanne C. Fromer & Christopher Jon Sprigman, *Copyright Law: Cases and Materials*, v4.0 (2022), available at: <http://copyrightbook.org>

General approach / big concepts

Think about the cases you've read.

Much of federal copyright law under the Copyright Act of 1976 is essentially a common-law endeavor; therefore be mindful of the power of reasoning by analogy from the cases.

Think functionally: If you have a copyright, what does that allow you to do?

It allows you to use the coercive power of the state against private parties. Mostly that means suing people. So think of copyright in terms of its causes of action.

Causes of action:

infringement

- of the reproduction right
- of other rights

accounting

compelling registration

The principal cause of action for copyright is the action for infringement. And the exclusive right that is the most fundamental is the reproduction right.

Thus, this document focuses on infringement of the reproduction right.

Infringement of the reproduction right

Prima facie case for infringement by reproduction

An action for copyright infringement of the reproduction right under §106(1) of the Copyright Act of 1976 requires the plaintiff to prove that:

- (1) there is a work subject to copyright,
- (2) the copyright is owned by the plaintiff,
- (3) the defendant in fact copied from the work (i.e., “actual copying,” which F&S call “copying in fact”), and
- (4) there was substantial appropriation of the copyrighted work (which F&S call “copying in law”).

Element (1) is: there is a work subject to copyright.

Analyze:

Fixation — was the work fixed in a tangible medium of expression?

Often this is an easy question. Sometimes, however, it is a difficult issue; if so, reason from the cases we read. Those include *Williams Electronics* (Defender video game), *Cartoon Network* (cloud DVR), and *Kelley v. Chicago Park District* (garden).

Originality — is the work an original work of authorship?

Often this is an easy question. Sometimes it's hard. But often it is the case that *something* in the plaintiff's work is original authorship, but maybe not the portion the defendant is alleged to have copied. Thus, even when there is clearly some originality, you must carefully consider whether the aspects at issue in the case are original works of authorship.

Is the work a work of authorship?

- It has to be the work of a human author. Consider: *Alfred Bell v. Catalda Fine Arts* (mezzotints; “clap of thunder” theory); *Kelley v. Chicago Park District* (garden; “forces of nature”); monkey selfie case (p. 144).

To what extent is the plaintiff's work original?

- Consider the cases we read—*Burrow-Giles* (Oscar Wilde photo), *Bleistein v. Donaldson* (circus posters), *Alfred Bell v. Catalda Fine Arts* (mezzotints), *Feist v. Rural* (white pages), *Meshwerks v. Toyota* (3-D models), and *Kelley v. Chicago Park District* (garden). Use those to predict how concepts of originality might vindicate, narrow or eliminate the scope of the plaintiff's copyright interest.

Is the plaintiff's work a derivative work? If so, is there enough new, copyrightable content to meet the originality requirement? And if so, what is it?

- Consider *Batlin & Son* (toy bank case) and *Schrock v. Learning Curve* (Thomas the Tank Engine photos case) and how that might narrow or eliminate the scope of the plaintiff's copyright interest.

Is the plaintiff's work a compilation? If so, is there enough additional copyrightable content in the arrangement to meet the originality requirement? And if so, what is it?

- Consider *Feist* (white pages case) and how that might narrow or eliminate the scope of the plaintiff's copyright interest.

Expression — is the work that is claimed actually expression?

Again, this can be a question that's both easy and hard. It may be easy to say there's expressive content. But drawing the line between what is expression and what is not can be a hard question. Thus, even when there is clearly some expressive content, you must carefully consider whether the aspects at issue in the case are expression or something non-copyrightable—such as ideas, processes, methods, or facts.

To what extent does the plaintiff's work comprise an idea, process, method, fact, or set of facts? If so, is there enough expressive, copyrightable content beyond that to meet the originality requirement? And if so, what is it?

- Consider *Baker v. Selden* (bookkeeping ledger case), *ATC Distribution* (auto transmission parts catalog case), *Hoehling v. Universal Studios* (Hindenburg book-and-movie case) and how that might narrow or eliminate the scope of the plaintiff's copyright interest.

Excluded subject matter — is the subject matter excluded from copyright eligibility?

Some things are outside the bounds of copyright protection even if they are original, fixed expression.

Is the plaintiff's work a useful article? If so, how does that narrow the plaintiff's protectible interest?

- Consider *Mazer* (lamp base case), *Star Athletica* (cheerleading uniform case), *Silvertop* (banana costume case).

Is the plaintiff's work software? If so, what aspects are protectible against copying by the defendant?

- Software is copyrightable. But because software is by its nature so functional, much of software can be copied without invading the copyright interest.

Consider *Computer Associates v. Altai* (re-written program with same structure but different source code) and *Lotus v. Borland* (competitor spreadsheet with copied menu hierarchies) in understanding where the line is likely to be drawn.

Is the plaintiff's work an architectural work? If so, what aspects are protectible against copying by the defendant?

- Architectural works are copyrightable. But because works of architecture are by nature functional, the scope of what is protectible through copyright can be narrow. And courts may apply ideas of originality and scenes-a-faire to narrow the scope of the protectible interest. Consider the *Zaleski* case (colonial-style residential houses) in predicting where courts are likely to draw the line.

Is the plaintiff's work uncopyrightable as an unauthorized derivative work?

- Under §103(a), copyright doesn't extend to "any part of the work in which such material has been used unlawfully" (discussion in F&S pp. 299-301).

Is the plaintiff's work uncopyrightable under the government edicts doctrine?

- Consider the teachings of the note cases discussed in the book (pp. 77-79).

Public domain status — is the work not subject to copyright because it is in the public domain? Some works constitute copyrightable subject matter yet nonetheless not be subject to copyright because they are in the public domain. There are various ways that a work can enter the public domain; or a work can be born in the public domain.

Is the work a work of the federal government?

- Consider §105. (Nearly all works of the U.S. government—meaning prepared by an officer/employee within scope of employment / official duties—are born in the public domain because of §105.)

Has the work entered the public domain because of the passage of time?

- For instance, if publication was with the authorization of the author, the work was first published in the U.S., and the work isn't a sound recording, ***then***
 - if it was first published in 1927 or prior, then, as of January 1, 2023, it must be in the public domain because of term expiration.

Has the work entered the public domain because of non-compliance with formalities?

- For instance, if publication was with the authorization of the author, the work was first published in the U.S., and the work isn't a sound recording, ***then***
 - if it was first published from 1928 through 1977 without a proper copyright notice, it is in the public domain for non-compliance with required formalities.

Has the work entered the public domain because of non-renewal?

- For instance, if publication was with the authorization of the author, the work was first published in the U.S., and the work isn't a sound recording, **then**
 - if it was first published from 1928 through 1963 with notice, but the copyright was not renewed, then the work will be in the public domain because of term expiration.

Element (2) is: the copyright is **owned by the plaintiff**.

The default is that the author is the initial owner of the copyright—or, if it's a joint work, then the coauthors are co-owners. So consider:

Authorship—Is the plaintiff an author?

In litigation, cases that tackle this dispute may involve one person claiming to be “the” author instead of another, or they may involve one person claiming to be “an” author alongside another. Cases we read were presented as being in one context or the other, but all can be used to illuminate questions of whether a plaintiff rightfully has authorship over a work. So consider *Lindsay v. R.M.S. Titanic*, *Garcia v. Google*, *Erickson v. Trinity Theatre*, and *Aalmuhammed v. Lee*.

Among the things that courts cared about that were favorable for finding authorship were who had the original intellectual conception, had control of the work (what stayed in, what was out), did or authorized the fixation, made contributions of copyrightable subject matter, had the manifested intent to be an author, had an agreement to be an author.

Things that courts cared about in not finding a claimant to be an author included contributions that were noncopyrightable in nature (e.g., ideas, facts) and policy considerations (e.g., what chaos might result if persons were held to be authors in such circumstances).

Is the plaintiff the constructive author via works-made-for-hire doctrine?

There are two—and only two—paths to a hirer being the constructive author via works-made-for-hire doctrine: scope of employment and specially ordered or commissioned works. So consider:

Was the work prepared by an employee of the plaintiff within the scope of the preparer's employment?

- **Was there a bona fide employer/employee relationship (as opposed to a mere independent contractor relationship)?** Apply the teachings of *CCNV v. Reid* (homeless sculpture) and consider the empirical research by Ryan Vacca on factors that courts tend to find the most important.
- **If there was a bona fide employer/employee relationship, was the work actually within the scope of that employment?** Consider *Avtec Systems v. Peiffer* (orbital simulation software developed off-hours).

Does the work qualify as a work made for hire as a specially ordered or commissioned work?

Keep in mind that to qualify as a work made for hire under the provision for specially ordered or commissioned work, the writing requirement and the categories-of-work requirement must be met. So ask:

- **Is the written agreement requirement satisfied?**
 - Did the hirer and hiree agree in a written instrument that the work would be considered a work made for hire? **AND**
 - Was that written instrument signed by both the hirer and the hiree?
 - (For details, consult the notes on pages 161-162.)
- **Was the work for use (1) as a contribution to a collective work, (2) as a part of a motion picture or other audiovisual work, (3) as a translation, (4) as a supplementary work, (5) as a compilation, (6) as an instructional text, (7) as a test, (8) as answer material for a test, OR (9) as an atlas?** (For details, consult the notes on page 161.)

Was the copyright (or relevant exclusive rights) assigned to someone else?

A valid assignment requires a writing signed by the assignor with express words of assignment. (Recall that we discussed assignments along with work-made-for-hire, and there's coverage in those slides.) Keep in mind that an "exclusive license" is a transfer of less than the entire copyright, and validity of that transfer works the same way as an assignment of the entire copyright.

Did ownership of the copyright (or relevant exclusive rights) revert to the original author through a valid termination of transfer?

In some cases, transfers can be terminated through the use of 17 U.S.C. §304(c) for pre-1978 transfers (the '09 Act era) and 17 U.S.C. §203 for post-1977 transfers (the '76 Act era).

Element (3) is: there is **actual copying**.

The plaintiff must prove that the defendant's infringement involved actually copying from the plaintiff's work. Many (including EEJ) call this "actual copying." Your casebook authors F&S call this "copying in fact."

Analyze:

Is there direct evidence of actual copying?

The plaintiff can prove actual copying solely with direct evidence. Direct evidence would include such things as eyewitness testimony of having seen the copying take place, earwitness testimony of someone who heard the defendant admit to copying, or an admission in pleadings or testimony by the defendant that the defendant copied from the plaintiff's work.

Can actual copying be established inferentially by (1) access plus (2) probative substantial similarity?

Access plus substantial similarity (of the probative kind) can establish actual copying by inference. But there's a lot more to it than just that blackletter rule. There's a lot of fuzziness, elasticity, and various factors at play with regard to how and when courts allow the inference and when they don't, as illuminated by the cases we read. In particular, consider *Three Boys Music v. Michael Bolton* (Isley Brothers' "Love Is a Wonderful Thing" versus Bolton's "Love Is a Wonderful Thing"), *Ronald Selle v. Barry Gibb* ("Let It End" versus "How Deep Is Your Love"), and *Ty v. GMA* (Beanie Babies versus Floppy Friends).

Element (4) is: there is **substantial appropriation**.

In essence, this requirement is that the defendant must have taken enough of the plaintiff's work for the appropriation to count as infringing. EEJ likes to call this "substantial appropriation." Your casebook authors F&S call this "copying in law." It is also called "improper appropriation," "unlawful appropriation," and "wrongful copying." Perhaps the most common name in the reporter volumes for this element is "substantial similarity"—but you shouldn't call it that! (But it's okay to use the term "substantial similarity" for the test plaintiffs can use to establish this element.)

Is the copying *de minimis*?

If the copying is determined to be "de minimis," then it is not a substantial appropriation, and the plaintiff's case fails. Keep in mind copying can be exact ("literal") and can be of the whole work, and yet can still count as *de minimis*. Consider *Gayle v. HBO* (dumpster graffiti) and the note case *Ringgold v. BET* (church picnic quilt on sitcom set).

Is copy substantially similar?

There is a lot to this. It's all in the cases—some of which seem to contradict one another. But it's a broad palette to work with. Consider the methods, concepts, tests, factors, doctrine, and implications of the cases we read: *Nichols v. Universal Pictures* (Learned Hand case; "Abie's Irish Rose" versus "The Cohens and the Kellys"); *Ira Arnstein v. Cole Porter* (claim that many Cole Porter hits were stolen from plaintiff in a multifaceted espionage operation); *Steinberg v. Columbia Pictures* (*New Yorker* magazine cover versus "Moscow on the Hudson" movie poster); *Boisson v. Banian* (ABC quilts); *Sid & Marty Krofft v. McDonalds* (H.R. Pufnstuf versus McDonaldland characters); *Cavalier v. Random House* ("Nicky Moonbeam" versus "Good Night Ernie" and "Good Night Elmo"); *Rentmeester v. Nike* (*Life* photographer's grand jeté Michael Jordan photo versus Nike's Jumpman photo of Michael Jordan).

Does the allegation of infringement regard a fictional character?

There are some wrinkles to how the courts have considered infringements regarding fictional characters. Consider the cases and notes we read on the subject: *Warner Bros. v. CBS* (Sam Spade and other “Maltese Falcon” characters); note case *DC Comics v. Towle* (Batmobile as a character); *Daniels v. Walt Disney* (Moodsters versus “Inside Out” characters).

Is the work alleged to have been infringed a sound recording?

If the work alleged to be infringed is a sound recording, then consider §114(b) (discussed on p. 374), which provides that the reproduction right for sound recordings “is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording.” In other words, soundalike recordings don’t infringe the “circle-P” copyright in sound recordings. (And there’s a similar provision for the derivative-works right for sound recordings.)

But keep in mind that a sound recording could be the medium for fixation of a literary work or a musical work. In that case, the limitation of §114(b) is not engaged.

Defenses

There are a number of defenses we studied. Those include: fair use, license, and statute of limitations. (And keep in mind that for the distribution right, we discussed first sale.)

Defense: Fair Use

For fair use, of course, you go through the famous fair use factors: (1) purpose and character of the use, (2) the nature of the copyrighted work, (3) amount and substantiality used in relation to the plaintiff’s work as a whole, (4) the effect on the market.

But don’t immediately head off into the factors! There are at least three other things you should be thinking about: the other statutory language from §107, analogy to the cases we read, and the notion of transformativeness. Thus, consider these questions:

Does the statutory language other than the factors provide a basis for argument for fair use?

Consider that 17 U.S.C. §107, in addition to listing the factors, says:

- “for purposes such as criticism, comment, [and] news reporting”
- “for purposes such as ... teaching (including multiple copies for classroom use), scholarship, or research”
- “The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all [four of the listed] factors.”

Do the cases we read provide a basis for argument?

Most of fair use law is in the caselaw. Consider the doctrines, methods, and teachings of the cases we read, and also consider whether the use at issue is close or at least analogous to the facts of a case we read. Keep in mind: *Sony v. Universal* (Betamax VCR and timeshifting); *Bill Graham Archives v. Dorling Kindersley* (scaled-down Grateful Dead posters in book); *Cambridge Univ. Press v. Patton* (academic publishers versus Georgia State University); *Google v. Oracle* (Java versus Android).

How do notions of transformativeness provide a basis for argument?

The more you can characterize the defendant's use as transformative, the more likely they are to win on fair use. The cases — and notes — develop this notion.

Apply the four fair use factors.

Keep in mind that the four fair use factors are not an algorithm for determining fair use. Nor are they exhaustive. Rather, they are a sort of obligatory checklist for ensuring the court's thorough consideration of the fair use issue.

What comes out of the fair use factors in any given analysis depend not only on straightforward common sense but also on the nuances that have been read into the factors by the courts.

The four factors are:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

Defense: License

Licenses can be formal or informal, expressed or implied, gratuitous, purchased, or promised by way of contract.

In a situation with co-owners of a copyright, recall that a license from any one owner is a defense against the other owners.

Defense: Statute of Limitations

Recall that there is a three-year statute of limitations on copyright actions.

But, as we learned, the devil is in the details of how that is calculated and applied — which is why — for instance — we see new lawsuits these days where the defendant's alleged copying took place in the 1970s.

Damages

In real life – and on an exam if it's within the call of the question – consider damages.

In any given case, the damages might be astronomical. Or, even with a very solid case of clear, willful infringement, there may be essentially zero dollars recoverable because of a lack of provable actual damages (plaintiff's lost revenue), a lack of provable attributable infringer's profits (defendant's wrongful gains), and the non-availability of statutory damages.

Issues other than infringement of the reproduction right

This document has focused on the question of infringement of the reproduction right. For other questions, much of the above analysis is useful, either directly, or as a kind of template.

But keep in mind that other exclusive rights have unique issues. As just one example: For infringement of the distribution right, the first sale defense is extremely important.