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Recent Development

RECENT DEVELOPMENTS IN COPYRIGHT LAW

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***154 I. Introduction**

This article summarizes significant and interesting cases in copyright law reported in the United States Patent Quarterly, Second Series between March, 1998 and August, 1998. The most significant case is the Supreme Court's decision affirming the right to trial by jury in a copyright infringement action when statutory damages are the only remedy sought.¹ Also, a split among the circuits may be developing concerning congressional abrogation of sovereign immunity in the Patent, Trademark, and Copyright Acts.² Finally, in a decision that received national press coverage, Martin Luther King's *I Have A Dream* speech was held to be in the public domain for publication without notice.³

II. Copyrightability and Originality

The Second Circuit affirmed the holding that the lyric, "You've got to stand for something, or you'll fall for anything," lacked sufficient originality and was not protected by the plaintiff's copyright in the song.⁴ Noting that originality does not imply novelty in the patent sense,⁵ the court cited numerous prior uses of the phrase in the public domain before it was

appropriated as the title of the song.⁶ Thus, there was sufficient evidence for the district court to conclude that the song title was not an *155 independent creation of the authors and not subject to copyright protection.⁷ The Second Circuit also approved of the use of the “summary bench trial”⁸ as long as the parties clearly waive their right to a full trial on the merits.⁹

III. Infringement and Exclusive Rights

A. Computer Software

In *Stenograph L.L.C. v. Bossard Associates, Inc.*,¹⁰ the District of Columbia Circuit joined the Fifth and Ninth Circuits¹¹ in holding that loading software into the random access memory (RAM) of a computer constitutes copying prohibited by Section 106 of the Copyright Act.¹² The defendant, a court reporting service, obtained unauthorized copies of computer stenography software and “keys” from a terminated distributor of the plaintiff.¹³ The district court found the defendant liable for copyright infringement and assessed more than \$3,000,000 in damages.¹⁴

On appeal, defendants challenged the sufficiency of the evidence of copying in that there was insufficient proof of copying of the principal elements of the copyrighted work.¹⁵ The D.C. Circuit affirmed, noting that when a program is installed and used for its intended purpose, protectable elements of the work may be assumed to have been copied¹⁶ or, in the alternative, that there was sufficient evidence that the computer program was loaded into RAM.¹⁷

***156 B. Product Configurations and Useful Articles**

In *Ann Howard Designs, L.P. v. Southern Frills, Inc.*,¹⁸ the plaintiff sued the defendant under its copyright registrations for picture frames with miniature objects (jigsaw puzzle pieces, cowboy hats, marine items, etc.).¹⁹ On the defendant’s motion for summary judgment, the Southern District of New York held that “picture frames decorated with three-dimensional pieces—be they rhinestones, puzzle pieces, or miniatures available from stock houses” simply are not copyrightable and, apart from similarity in their choice and arrangement, could not support a claim of substantial similarity.²⁰

As can be expected, the copyright infringement claims were joined with trade dress claims under the Lanham Act. Despite noting a potential for confusion, the court held that the Lanham Act does not reach all similarity, but only confusing similarity in features “likely to serve *primarily* as a designator of origin of the product.”²¹

C. Gray Market Goods

In *Enesco Corp. v. Jan Bell Marketing, Inc.*,²² the court found that the defendant did not violate the importation provision of Section 602 of the Copyright Act²³ by reselling or distributing *Precious Moments* figurines manufactured abroad.²⁴ In granting summary judgment in favor of the defendant, the court read Section 602 literally and found that the defendant had not brought the goods in from a foreign country.²⁵ In so holding, the court recognized contrary decisions²⁶ but felt itself governed by the plain meaning of the statute.²⁷

***157 D. De Minimis Copying**

In *Sandoval v. New Line Cinema Corp.*,²⁸ the Second Circuit affirmed a judgment that 35.6 seconds of obscured, unfocused film footage of an artist’s unpublished photographs is de minimis copying that does not subject the user to liability.²⁹ The defendant very briefly used several reproductions of Jorge Sandoval’s photographic self-portraits in the film *Seven*.³⁰ Stating that the accused infringer must show that the copying is “so trivial as to fall below the quantitative threshold of substantial similarity,”³¹ the court found the photographs to be shown at a distance, in poor lighting, out of focus, and without sufficient detail to permit the lay observer to identify even the subject matter of the photographs.³² Accordingly, the court found this use to be de minimis and not actionable.³³

The Second Circuit reached the opposite conclusion with respect to a *Seinfeld* trivia book in *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*³⁴ Finding that the defendants crossed the de minimis line, the court looked at the 634 fragments (each of 634 trivia questions) from 84 episodes of *Seinfeld* and the fact that the questions focused on creative

(character traits and idiosyncrasies) rather than factual (identity of the actors) features of the works.³⁵ The court treated the 84 episodes as a discrete work rather than individually, relying on *Twin Peaks Productions, Inc. v. Publications International, Ltd.*,³⁶ although noting that the Copyright Act speaks of a single work.³⁷ The court also found the trivia test not to constitute a fair use because it was commercial in nature, copied creative material, was more than necessary to conjure the original work, and affected a market that should be left to the copyright owner, although the owner had yet to exploit it.³⁸

***158 E. Visual Artists' Rights Act (VARA)**

In *Martin v. City of Indianapolis*,³⁹ the District Court for the Southern District of Indiana awarded artist Jan Randolph Martin \$20,000 in statutory damages for the City of Indianapolis' removal and destruction of his sculpture *Symphony No. 1*.⁴⁰ The court declined to award the full \$100,000 in statutory damages, finding that the City was unaware of the provisions of the Visual Artists' Rights Act (VARA), Section 106(a) of the Copyright Act,⁴¹ and thus did not act with reckless disregard for the artist's rights.⁴² The court also awarded Martin his costs and full attorneys' fees, which were to be determined.⁴³

IV. Fair Use

A. Literary Works

In *Sundeman v. Seajay Society, Inc.*,⁴⁴ the representative of the estate of Marjorie Kinnan Rawlings Baskin, author of *The Yearling*, sued a non-profit organization that acquired and made copies of an unpublished writing of Baskin and published a "critical analysis" of the unpublished work.⁴⁵ The Fourth Circuit found the scholarly analysis to be a protected fair use.⁴⁶ On the character and purpose of the use, the court found it to be a straightforward, scholarly appraisal of the work from the biographical and literary perspectives and thus a "transformative" use.⁴⁷ The court noted that royalty income was at least a partial motivator for the author; however, it found this not to be dispositive as it was not "exploitative."⁴⁸

Because the copyrighted work was literary in nature and unpublished, the court was forced to conclude that the nature of the work is creative and thus weighed against *159 a finding of fair use.⁴⁹ As to the amount and quality of the work copied, the court declined to engage in the fallacy that, because it was copied, it was necessarily the heart of the work.⁵⁰ However, in this case, entire copies of the manuscript were copied for the purpose of writing the commentary.⁵¹ Although these copies were of the work in the entirety, the court noted the necessity of doing so in the case of old, unpublished manuscripts and that this did not make the copies of the manuscript presumptively unfair.⁵² The commentary itself quoted between four and sixteen percent of the manuscript, which the court found to be within the confines of fair use.⁵³

Finally, as to the effect on the market on the value of the copyrighted work, the court found that the duplicates of the work were maintained only by the author of the commentary and were not published or distributed, and that the commentary itself in no way supplanted the copyrighted work, thus indicating fair use.⁵⁴ The court also noted that there is no derivative market for criticism.⁵⁵ Thus, this factor favored fair use.⁵⁶ The aggregation of the four factors resulted in the finding of fair use and affirmance of the district court.⁵⁷

B. Pamela Anderson Lee

In *Michaels v. Internet Entertainment Group, Inc.*,⁵⁸ the District Court for the Central District of California found an Internet entertainment site's use of unauthorized copies of a video of former *Baywatch* starlet Pamela Anderson Lee *in flagrante delicto* copyright infringement and not fair use.⁵⁹ The plaintiff, Bret Michaels, a singer for the band *Poison* and Ms. Lee's partner in the video, sued for copyright infringement and a preliminary injunction against reproduction on the Internet of a video tape of the *160 intimate moments of himself and Ms. Lee.⁶⁰ The defendants countered that the reproduction of the video was protected fair use.⁶¹

In granting the preliminary injunction, the court found the purpose and character of the use to be purely commercial,⁶² the nature of the copyrighted work to be unpublished,⁶³ the use of stills and segments of the tape to be use of relatively important portions of the work,⁶⁴ and the effect on the market of the use of segments on the tape sufficient to saturate the potential market for the work.⁶⁵ Finding all of these factors mitigating against fair use, the court granted Michaels' preliminary injunction.⁶⁶ In so holding, the court also dispensed with the defendant's argument that it received an implied, non-exclusive

license to use the work from an unknown and unnamed “agent” of Michaels, who allegedly received the tape as a gift.⁶⁷ The court found no evidence to support a grant of transferability of the license from the agent to the defendant, even assuming the agent was the recipient of an implied license from Michaels.⁶⁸

C. “Rebroadcasting”

The Second Circuit reversed a holding of fair use for a defendant who operated a “dial-up” service that permits subscribers to listen to radio broadcasts over the telephone for a variety of purposes, including talent audition and advertising verification.⁶⁹ The defendant operated his service by connecting a radio receiver to a telephone transceiver, permitting clients to dial into the transceiver and listen to radio broadcasts.⁷⁰ As to the character of the use, the court was not persuaded by the defendant’s arguments of transformation of the work for factual purposes. At root, the service is commercial in nature and subsists with verbatim duplication of the original *161 broadcasts, although the subscriber may make a “transformative” use of the material.⁷¹ The court agreed with the district court’s finding that the broadcasts were, as a whole, creative and deserving of protection.⁷² Because it was factually unclear how much of the copyrighted broadcasts was “heard” by subscribers, the amount and substantiality of the copying was difficult to evaluate; however, the potential existed for a subscriber to listen 24 hours a day, seven days a week.⁷³ As to the effect on the potential market for the copyrighted work, the court noted that the plaintiff, a broadcasting company, offered some advertisers “listen lines” not unlike defendants, but that the economic benefit from the listen lines was dubious.⁷⁴ Considering that it is the defendant’s burden to show a lack of effect or harm, the court decided the fourth factor favored the plaintiff and that the totality of the factors indicated infringement rather than fair use.⁷⁵

V. Registration

A. Prerequisite to Suit

In *Noble v. Town Sports International, Inc.*,⁷⁶ the Southern District of New York dismissed a copyright infringement action for lack of subject matter jurisdiction where the plaintiff had applied for, but had not obtained, a copyright registration certificate.⁷⁷

Similarly, in *Diaz v. Mandeville*,⁷⁸ the Eastern District of Michigan joined the majority of courts in holding that an application for copyright registration, without the registration itself, is not sufficient to invoke the jurisdiction of a federal court in a copyright infringement action.⁷⁹ The court intimated that its conclusion may have been different had the plaintiff received a return receipt on its application.⁸⁰ On the defendant’s motion under Fed. R. Civ. P. 12 to dismiss for lack of subject matter jurisdiction, the action was dismissed without prejudice to its refiling upon proof of registration or refusal of registration.⁸¹

*162 The alleged author of the characters *Beavis* and *Butthead* lost his copyright registration as a result of deposit of “reconstructions” rather than “bona fide copies” along with his registration, according to the Ninth Circuit in *Kodadek v. MTV Networks, Inc.*⁸² As the alleged author of the characters, the plaintiff claimed to have drawn them and given them to Mike Judge, the creator of the infamous MTV cartoon, in 1991.⁸³ After the show aired in 1993, the plaintiff filed for registration of the characters with new sketches drawn from memory.⁸⁴ Citing Section 408 of the Copyright Act⁸⁵ for the necessity of copies of the original work to accompany the registration application, as well as its prior holding in *Seiler v. Lucasfilm, Ltd.*,⁸⁶ the court affirmed the grant of summary judgment against the plaintiff.⁸⁷ Because the sketches were not copies in any mechanical sense and had not been made by referring to the originals, the court held the registration void *ab initio* and the infringement action precluded under Section 411 of the Copyright Act.⁸⁸

B. Effect of Canceled Registration

In *Gucci Timepieces America Inc. v. Yidah Watch Company*,⁸⁹ the Central District of California declined, on motion for reconsideration, to dissolve a preliminary injunction based on copyright and trade dress infringement claims after the Register of Copyrights canceled the registration for the watch design in question as a “useful article.”⁹⁰

The court analogized the situation to one in which a suit for infringement is pursued under Section 411(a) of the Copyright Act even though the Copyright Office has refused registration.⁹¹ In so holding, the court found that the cancellation removed the presumption of copyrightability, but did not preclude the court from making its own findings as to originality, authorship,

and the like.⁹²

*163 On the merits, the court dismissed the argument that the “G” design of the wristwatch in question was a useful article because it conveyed information about the product, i.e., its origin, and thus fell outside the definition of useful article in Section 101 of the Copyright Act.⁹³ Similarly, the court found unpersuasive the defendant’s argument that the “G” design lacked originality because of its prior use on handbags and other accessories, noting that the right to prepare derivative works lies exclusively with the owner of the copyright.⁹⁴

C. Publication Without Notice (1909 Act)

Martin Luther King’s *I Have A Dream* speech was held to be in the public domain for failure to provide notice upon publication under the 1909 Copyright Act in *Estate of Martin Luther King Jr. Inc. v. CBS Inc.*⁹⁵ Acknowledging the rule that public performance of a work does not ordinarily constitute publication, the court found that Dr. King not only publicly performed the speech, but invited the press and disseminated advance text of the speech.⁹⁶ No limitations were imposed on dissemination of the speech by Dr. King or by his associates; “it was made available to … the public at large without regard to who they were or what they proposed to do with it.”⁹⁷ Accordingly, the speech was a general publication, published without the requisite copyright notice and thus was injected into the public domain, subsequent registration notwithstanding.⁹⁸

VI. Preemption

In a bizarre case, the Southern District of New York held that New York trust law was not preempted by the Copyright Act.⁹⁹ The plaintiff copyright owner assigned a copyright to its exclusive United States distributor for the purposes of litigation, apparently with the unwritten understanding that the copyright would be re-assigned to the original owner at the conclusion of litigation.¹⁰⁰ The re-assignment never took place and the original assignee eventually assigned the copyright to the defendant in *164 this case.¹⁰¹ The plaintiff in the case, the new exclusive United States distributor, sued to recover the copyright on both oral contract and trust theories.¹⁰² The court, on cross-motions for summary judgment, found the oral contract ground insufficient because, under New York law, even if the original owner had an enforceable agreement to reassign the copyright, the subsequent assignee was not bound to do so under the terms of its assignment.¹⁰³ On the trust theory, the court noted that New York trust law requires a relationship of trust that quantitatively distinguished the claim from one under the Copyright Act.¹⁰⁴ However, noting that a trust may be created orally under New York law, the court considered the effect of Section 204 of the Copyright Act, which requires a transfer be in writing.¹⁰⁵ Dubiously, the court found that a declaration prepared for litigation satisfied the writing requirement of Section 204,¹⁰⁶ noting the line of cases that permits such a writing to follow the transfer, even when the writing is prepared during litigation.¹⁰⁷ Accordingly, the plaintiff’s trust claims survived summary judgment.¹⁰⁸

VII. Compulsory License and Royalties

In *National Association of Broadcasters v. Librarian of Congress*,¹⁰⁹ the District of Columbia Circuit held the standard of review applicable to cable television royalty divisions set by the Librarian of Congress, acting under the Copyright Royalty Tribunal Reform Act of 1993,¹¹⁰ is narrower than the arbitrary and capricious standard applied under the Administrative Procedure Act.¹¹¹ In a detailed and exhaustive opinion, the court found that Congress intended to vest broad decision-making power in the Librarian of Congress and to circumscribe the review of its decisions.¹¹² Accordingly, the Librarian’s decision will be upheld if evidence does not compel a *165 different award, i.e., the award is rationally related to the evidence, and the Librarian offers a facially plausible explanation for its decision in view of the evidence.¹¹³

VIII. Ownership, Transfer, and Licensing

A. Joint Authorship

In *Thomson v. Larson*,¹¹⁴ the Second Circuit considered the claims of a dramaturg¹¹⁵ to be a coauthor of the blockbuster Broadway musical *Rent*.¹¹⁶ The plaintiff was hired by the now-deceased author (Jonathan Larson) to assist in clarifying the story line of the musical.¹¹⁷ After negotiations with the author’s family and the producers of the show for credit and a share of

the royalties broke down, the dramaturg sued to be named a coauthor of the play.¹¹⁸ The district court found no coauthorship under *Childress v. Taylor*,¹¹⁹ finding no mutual intent that the dramaturg be a joint author and no separately copyrightable contribution.¹²⁰ The Second Circuit affirmed, noting that all decision-making authority resided with Larson at all times,¹²¹ that the billing solely credited Larson from the earliest script,¹²² that no agreements with third parties mentioned the dramaturg as an author,¹²³ and that no other evidence supported joint authorship.¹²⁴ Finding no intent for joint authorship, neither the district court nor the Second Circuit reached the claims of independently copyrightable contribution.¹²⁵ The dramaturg sought confirmation that she had independent copyright in her *166 contributions in the absence of joint authorship, but the Second Circuit held the issue not preserved for appeal.¹²⁶

B. Work Made For Hire

In *Quintanilla v. Texas Television, Inc.*,¹²⁷ the Fifth Circuit affirmed summary judgment against the father of Tejano superstar Selena, finding that he acquired no rights in a videotape of one of her concerts filmed by a television station.¹²⁸ Quintanilla claimed that the agreement by which the television station recorded the concert granted only a limited license to use the footage and that his supervision of the concert caused the tape to be a work for hire.¹²⁹ The defendants prevailed on summary judgment in the district court.¹³⁰

The court rapidly disposed of Quintanilla's claims that the videotape footage was a work for hire, noting that no written agreement existed and that the cameramen and director were never employees of Quintanilla; at most, he made helpful suggestions during the taping.¹³¹

The court also rejected Quintanilla's claims of joint authorship because the complaint did not expressly plead such claims (indeed, pled exclusive ownership throughout), and the district court did not abuse its discretion in denying leave to amend to assert the claims because of the assertions of exclusive rights in the copyright (in both pleadings and orally to the court) until the eleventh hour.¹³²

Finally, Quintanilla had joined songwriters, claiming that the defendant created an unauthorized derivative work based on the songs performed during the concert.¹³³ Because no evidence of copyright registration for the songs was offered, these claims, too, were properly dismissed on summary judgment.¹³⁴

*167 C. Implied or Oral License

In *Graham v. James*,¹³⁵ the author had written a program for providing a table of contents of a CD-ROM, as well as decompressing and extracting shareware programs stored on the CD-ROM.¹³⁶ The author prevailed against the CD-ROM vendor on a breach of an oral license agreement under which he was to be paid \$1,000 per CD-ROM and \$1 per disk sold.¹³⁷ The CD-ROM vendor claimed that the program was a work made for hire and that the district court erred in awarding damages for copyright infringement, failure to name the author, and breach of contract damages.¹³⁸

The Second Circuit affirmed the finding that the program was not a work for hire (and that the oral license was breached) because there was essentially no evidence that the author was an employee of the CD-ROM vendor.¹³⁹ However, the court did reverse the award of copyright infringement damages, citing the principle that a licensor waives his right to copyright infringement damages.¹⁴⁰ In so holding, the court dispensed with the author's arguments that the license was rescinded or revoked under New York law.¹⁴¹

The district court awarded damages for failing to attribute authorship under the rubric of copyright infringement damages, and the Second Circuit noted that there was authority for awarding such damages as "actual damages" under the Copyright Act.¹⁴² However, the \$25,000 awarded for this failure by the district court was reversed as being arbitrary and without support.¹⁴³

The Sixth Circuit affirmed a finding of no implied license where an architect was fired from a job for which he prepared original drawings in *Johnson v. Jones*.¹⁴⁴ The plaintiff was an architect hired by one of the defendants to design and build a dream home for her.¹⁴⁵ When relations between the builder and buyer deteriorated, the buyer hired a new builder and architect who obtained the plaintiff's drawings from the buyer *168 and the city building inspector and used them to build the defendant's home.¹⁴⁶ The plaintiff sued and the defendants claimed an implied license to use the drawings,¹⁴⁷ citing *Effects*

*Associates, Inc. v. Cohen*¹⁴⁸ and *I.A.E., Inc. v. Shaver*.¹⁴⁹ The Sixth Circuit distinguished these two cases on the ground that the plaintiff-author in both cases voluntarily delivered the copyrighted material pursuant to the contract, and an implied license to use it, to the defendants.¹⁵⁰ Here, because the plaintiff never intended the works to be used by any of the defendants after his contract was terminated, and the defendants acquired the drawings through means other than a contract with the plaintiff, no implied license accompanied the drawings.¹⁵¹

D. New Uses

In *Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co.*,¹⁵² the Second Circuit considered whether the grant clause of a 1939 motion picture license agreement conveyed the right to use a musical composition in video (tape and laser disc) formats.¹⁵³ The license in question conveyed the right to “record in any manner, medium or form” Stravinsky’s *Rites of Spring* for use in a “motion picture” or portions thereof (the motion picture in this case being *Fantasia*).¹⁵⁴ The license contained a reservation clause reserving all rights not specifically granted to the licensor.¹⁵⁵ Further, the license contained an “ASCAP condition” allegedly requiring performance of the licensed composition in ASCAP or similarly licensed venues.¹⁵⁶

In a thorough and well-considered opinion by Judge Pierre Leval, the court held the license to encompass video release of the composition, citing its prior ruling in *Bartcsh v. Metro-Goldwyn -Mayer, Inc.*¹⁵⁷ to the effect that a license extends to any *169 uses reasonably falling within the medium as described in the license.¹⁵⁸ The court thus found that motion picture generally includes video formats.¹⁵⁹ The court went on to discuss the competing considerations and differences in judicial opinion (primarily in the Ninth Circuit), but held that the reasonable meaning of the contract was the most neutral and consistent way to resolve such “new use” disputes.¹⁶⁰

The plaintiff maintained in the district court that the reservation clause and ASCAP conditions mandated finding that the grant clause did not encompass video formats.¹⁶¹ The Second Circuit dismissed the reservation clause argument by noting that a reservation clause is merely a truism; that which the licensor does not grant, it reserves.¹⁶² The court interpreted the ASCAP condition as merely requiring that the motion picture be performed in two or more ASCAP or similarly licensed theaters, and went on to discuss the history of such clauses and of ASCAP generally.¹⁶³ Finally, the court disposed of extrinsic evidence allegedly contradicting the scope given the license by the court and by Disney.¹⁶⁴

E. Renewal Rights and the Derivative Works Exception

In *Fred Ahlert Music Corp. v. Warner/Chappell Music Inc.*,¹⁶⁵ the Second Circuit explored the subtleties of the “derivative works exception” of Section 304(c)(6)(A) of the Copyright Act.¹⁶⁶ The plaintiff purchased, from the heirs of the author, renewal rights to the song *Bye Bye Blackbird*, which had been licensed to the defendants for preparation of a derivative work prior to the 1976 Copyright Act and the derivative works exception.¹⁶⁷ The defendants used the derivative work in the soundtrack for the movie *Sleepless in Seattle* and contended that this was authorized by the derivative works exception.¹⁶⁸ The court found this to be a question of first impression that hinged on whether use of the derivative work in the movie was authorized under the *170 pre-termination grant of the right to prepare derivative works.¹⁶⁹ Finding that the original grant was very narrow, permitting Joe Cocker to record the song for a particular album, the court found that the derivative works exception did not permit the pre-termination licensee to prepare yet another derivative work by using the song in a motion picture soundtrack.¹⁷⁰

IX. Litigation and Remedies

A. Pleading and Procedure

In *QTL Corp. v. Kaplan*,¹⁷¹ the defendant counterclaimed for infringement of the copyright in two of its catalogs without specifying which pages of the catalog were infringed or accusing particular publications of the plaintiff of infringement.¹⁷² The plaintiff moved for a more definite statement under Fed. R. Civ. P. 12(e) on the ground that it could not determine which product catalogs were accused of infringement and that it should not be forced to use its limited number of interrogatories to find out.¹⁷³

The court held that Fed. R. Civ. P. 8, and thus the standard applied to a motion for a more definite statement, only requires

that the defendant be able to frame a responsive pleading and that the infringement claim met this standard.¹⁷⁴ The court was not persuaded by the “limited discovery” argument of the counterclaim defendant.¹⁷⁵

B. Statute of Limitations

In *Margo v. Weiss*,¹⁷⁶ the Southern District of New York held claims for coauthorship barred by the three-year statute of limitations of Section 507 of the Copyright Act.¹⁷⁷ Plaintiffs, members of the musical group, *The Tokens*, ceded their rights in the work *When the Lion Sleeps Tonight* to a third party as a result of *171 infringement allegations in 1961.¹⁷⁸ In 1989, when the original term expired, defendants, the lyricists and named authors of the work, applied for renewal registration and became embroiled in litigation with the third party over renewal rights.¹⁷⁹

In 1996, the plaintiffs filed suit against the defendants, alleging co-authorship of the work and co-ownership of the renewal rights and asserting causes of action for fraud, breach of fiduciary duty, and false designation of origin under Section 43(a) of the Lanham Act (for misrepresentation of authorship).¹⁸⁰

Finding that the plaintiffs knew, or should have known, of the injury arising from not being named co-authors prior to 1989-1990,¹⁸¹ the court granted summary judgment in favor of defendants that all claims were barred by applicable statutes of limitations.¹⁸² The court found no difficulty in applying the three-year limitations period of Section 507(b)¹⁸³ to the plaintiffs’ authorship claims, and found that the New York six-year statute of limitations for fraud barred the fraud and breach of fiduciary duty claims.¹⁸⁴ The false designation of origin claim was barred by the presumption of laches arising when an analogous state-law statute of limitations passes.¹⁸⁵

B. Choice of Law

In a curious international copyright case,¹⁸⁶ the Second Circuit addressed choice of law under the Berne Convention and Copyright Act.¹⁸⁷ The plaintiffs, the well-known TASS Russian news agency and several Russian newspaper publishers, sued the publishers of a United States circulation Russian-language newspaper, the *Kurier*.¹⁸⁸ The *Kurier* literally cut, pasted and reproduced selected individual articles *172 from Russian newspapers, copyrighted in the compilation sense by TASS, without permission.¹⁸⁹

The court first perceived a conflict-of-law issue as to the applicability of Russian or United States law generally and as to which issues the two laws might apply.¹⁹⁰ On the conflict issue the court found little guidance in either the Copyright Act or the Berne Convention.¹⁹¹ On the issue of ownership, the court decided that Russian law applied based on the language of Article 5(4) of the Berne Convention¹⁹² (referring to “country of origin”) and the basic agreement of the parties and *amicus curiae* Professor William F. Patry.¹⁹³ On the issue of infringement, the court chose United States law based on the tort principle of *lex loci delicti* and the interest of the United States and a United States defendant in applying United States law.¹⁹⁴

The court then found that Russian law excludes newspapers from its work for hire doctrine and gives newspaper publishers rights only to the compilation and not to the articles themselves.¹⁹⁵ The authors of the articles, of course, retained the right to sue for infringement.¹⁹⁶ Similarly, TASS, as a news agency and not a publisher, did fall within Russian work for hire doctrine and therefore had the right to sue for copying of individual articles.¹⁹⁷ Furthermore, because the copying included headlines and graphic materials as originally published (giving the publishers a cause of action as well), the court remanded for further proceedings consistent with the opinion.¹⁹⁸

C. Statutory Damages

In the only United States Supreme Court decision on copyright law handed down during the reporting period, *Feltner v. Columbia Pictures Television, Inc.*,¹⁹⁹ the Court found a right to jury trial under the Seventh Amendment even when the only damages *173 sought were statutory damages under Section 504(c) of the Copyright Act.²⁰⁰ Feltner owned several television stations having financial difficulties.²⁰¹ Included in the difficulties was the termination of the stations’ license to broadcast several television series.²⁰² Columbia Pictures, the owner of the copyrights, sued and was awarded statutory damages of \$20,000 per work infringed, multiplied by 440 episodes broadcast, for an award of \$8,800,000.²⁰³ The district court denied Feltner’s request for a jury trial and the Ninth Circuit affirmed, holding that there was no right for a jury to determine the

amount of statutory damages.²⁰⁴

Justice Clarence Thomas gave the opinion for the unanimous Court.²⁰⁵ First, the Court analyzed the use of the term “court” in the Copyright Act to determine if Section 504 could be construed to grant a right to jury trial.²⁰⁶ Construing court, as used in the Act, to mean only the bench, the Court found no right to jury trial implicit in the statute and moved on to the Seventh Amendment analysis.²⁰⁷

Under what has come to be called the *Granfinanciera*²⁰⁸ analysis, the Court reviewed the nature of the statutory action and remedy sought to determine whether an identical or analogous cause of action existed in 18th century England.²⁰⁹ Unsurprisingly, the Court found that the copyright cause of action was well known to be triable to jury in the courts of law of England as of the middle of the 17th century.²¹⁰ Perhaps slightly more surprising is that the Statute of Anne, recognized as the first modern copyright statute, provided damages of one penny per sheet copied.²¹¹

Similarly, the pre-1790 state (or colonial) copyright statutes included similar “statutory” damages, as did the Copyright Acts of 1790 and 1831 (fifty cents per sheet *174 and \$1 per sheet, respectively).²¹² There is no evidence that these statutes changed the common-law jury trial tradition of copyright cases.²¹³

In response to Columbia Pictures’ argument that statutory damages are “clearly equitable in nature,” the Court disagreed, stating the general rule that monetary relief is legal, as opposed to equitable, in nature.²¹⁴ Specifically, the Court focused on the right to have a jury determine the amount of statutory damages to be awarded (between \$500 and \$20,000, and up to \$100,000 if the infringement is willful).²¹⁵ Thus, the Court found that Section 504 of the Copyright Act is unconstitutional, at least insofar as it purports to deprive a litigant of the right to jury trial on the amount of statutory damages.²¹⁶

Justice Antonin Scalia filed a separate concurring opinion criticizing the majority for reaching the constitutional question when the language of the statute fairly easily is interpreted to grant the right to trial by jury, citing the statutory history of Section 504 and its predecessors.²¹⁷ Justice Scalia acknowledged that this was not the best interpretation of Section 504, but was preferable inasmuch as it avoided reaching the constitutional question.²¹⁸

In an Internet copying case,²¹⁹ Playboy was awarded \$500 in statutory damages under Section 504 of the Copyright Act for unauthorized copying by a web site operator of each for 7,475 images for a damage award of \$3,737,500.²²⁰ In so holding, the court declined the plaintiff’s invitation to make \$100,000 awards for 1,699 allegedly willfully infringed images and dismissed the web site operator’s argument that the images were properly considered as a group because each image was itself a part of a compilation.²²¹

***175 D. Extraterritorial Damages**

In *Los Angeles News Service v. Reuters Television International, Ltd.*,²²² the Ninth Circuit agreed with the Second Circuit in holding proper damages based on profits made abroad from infringement occurring domestically.²²³ Reuters made copies, in New York City, of Los Angeles News Service’s footage of the Rodney King riots, which were sold to and rebroadcasted by subscribers in Europe and Africa.²²⁴ Reversing the district court’s ruling barring actual damages based on these acts, the Ninth Circuit approved the Second Circuit’s reasoning in *Metro-Goldwyn Pictures Corp. v. Sheldon*.²²⁵ Although the financial damages accrued abroad, the unauthorized duplication, a complete act of infringement, occurred in the United States.²²⁶

The Southern District of New York reached a similar result with respect to an order impounding copies of films made domestically but located abroad in *Richard Feiner & Co. v. Turner Entertainment Co.*²²⁷

E. Attorney’s Fees

On remand from the Supreme Court, the Ninth Circuit, in *Columbia Pictures Television v. Krypton Broadcasting of Birmingham, Inc.*,²²⁸ denied the defendant’s application for attorneys’ fees under Section 505 of the Copyright Act.²²⁹ Although the defendant prevailed on the issue of the right to jury trial, it was found liable for infringement and could not be the prevailing party for purposes of Section 505.²³⁰

The epic spreadsheet struggle between Lotus and Borland concluded (one would think) with the First Circuit’s affirmance of

the district court's order denying Borland's application for attorneys' fees.²³¹ The First Circuit relied on the novelty and difficulty of the questions presented to deny Borland, as prevailing defendant, its attorneys' fees.²³² Despite some evidence that Lotus used its financial power and asserted some *176 unreasonable claims in an effort to perform a "casectomy" on Borland, the court found both parties financially able to litigate the action and that the action as a whole was neither frivolous nor objectively unreasonable.²³³ Thus, the district court did not abuse its discretion and complied with the mandate of *Fogerty v. Fantasy, Inc.*²³⁴ that prevailing plaintiffs and defendants be treated evenhandedly.²³⁵

A veritable catalog of cases for and against the award of attorneys' fees (pre- and post-*Fogerty*) is found in *FASA Corp. v. Playmates Toys, Inc.*²³⁶ There, the Northern District of Illinois denied an award of fees to a prevailing defendant in what appears to be a hotly contested copyright and trademark case.²³⁷ In finding that the plaintiff's case was not frivolous,²³⁸ objectively unreasonable,²³⁹ or improperly motivated,²⁴⁰ the court discussed, interpreted, and applied numerous attorneys' fees cases supporting and denying an award of fees.²⁴¹

The District of Columbia District Court joined the majority of courts in holding that Section 412 of the Copyright Act²⁴² bars claims for attorneys' fees for infringement commencing before registration.²⁴³ Holding that acts of infringement occurring after registration are not separate, new acts of infringement subject to an award of attorneys' fees, the court granted the defendant's motion to strike that portion of the complaint.²⁴⁴

*177 F. Sovereign Immunity

In *Chavez v. Arte Publico Press*,²⁴⁵ the Fifth Circuit reconsidered its earlier decision in the same case²⁴⁶ regarding Congress' abrogation of sovereign immunity in copyright and trademark cases.²⁴⁷ The opportunity for reconsideration arose on the Supreme Court's remand for reconsideration²⁴⁸ in light of its decision in *Seminole Tribe of Florida v. Florida*.²⁴⁹

On remand, the issues before the court were whether Congress possessed the power to abrogate sovereign immunity under its Article I powers or its power to remedy takings under Section 5 of the Fourteenth Amendment to the Constitution.²⁵⁰ The Fifth Circuit read *Seminole* to hold that, even though the Constitution vests in Congress complete lawmaking authority in an area (here, trademarks and copyrights), the Eleventh Amendment prevents states from being sued by private parties in federal court when the state does not consent.²⁵¹ Thus, Congress' abrogation of sovereign immunity pursuant to its Article I powers is unconstitutional.²⁵²

Chavez also contended that Congress validly acted pursuant to the takings provision of Section 5 of the Fourteenth Amendment to the Constitution when it abrogated sovereign immunity.²⁵³ The Fifth Circuit dispensed with the Lanham Act claim, holding that the "reputational" interest *Chavez* claimed to be protected by the Lanham Act did not rise to a constitutional tort or property interest protected by the Fourteenth Amendment.²⁵⁴ Thus Congress did not validly act under the Fourteenth Amendment in abrogating sovereign immunity in cases arising under the Lanham Act, at least for reputational torts if not trademark infringement generally.²⁵⁵

The Fifth Circuit had more difficulty dispensing with the copyright issue because the rights conferred by the Copyright Act are of the sort protected from taking by the *178 Fourteenth Amendment.²⁵⁶ The court noted that almost no copyright cases considered sovereign immunity of the states, but that an interest in copyright had been acknowledged as protected by the due process clause of the Fourteenth Amendment in *Roth v. Pritikin*.²⁵⁷ Even so, the court noted that copyright infringement actions such as *Chavez*'s arise in the context of a license and that the copyright owner is free to choose between the remedies under the Copyright Act or those under state contract law.²⁵⁸

Thus, under these facts, *Chavez* had an adequate remedy against the state for breach of contract in state court.²⁵⁹ Disingenuously, perhaps, the Fifth Circuit noted that *Chavez* was not utterly without remedy and that Congress could give concurrent jurisdiction to state courts to hear copyright and trademark infringement suits.²⁶⁰ Perhaps most revealing, the court pointed to the doctrine of *Ex parte Young*²⁶¹ to point out that suits against state officials for violating federal law are permitted and do not raise the sovereign immunity issue.²⁶²

The Federal Circuit recently ruled on a similar issue in *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*.²⁶³ In that case, the Federal Circuit held that Congress validly exercised its power in the Patent Law Remedy Clarification Act²⁶⁴ in abrogating sovereign immunity of states and, thus, allowing suits against them for patent infringement.²⁶⁵ Given this holding, it appears that *Chavez* or a similar case may return to the Supreme Court for disposition.

Footnotes

¹ Feltner v. Columbia Pictures Television, Inc., 118 S. Ct. 1279, 46 U.S.P.Q.2d (BNA) 1161 (1998). *See* discussion *infra* section IX. C.

² *See* Chavez v. Arte Publico Press, 139 F.3d 504, 46 U.S.P.Q.2d (BNA) 1541 (5th Cir. 1998). *See* discussion *infra* section IX. F.

³ Estate of Martin Luther King Jr. Inc. v. CBS Inc., 47 U.S.P.Q.2d (BNA) 1611 (N.D. Ga. 1998). *See* discussion *infra* section V. C.

⁴ Acuff-Rose Music, Inc. v. Jostens, Inc., 47 U.S.P.Q.2d (BNA) 1953 (2d Cir. 1998).

⁵ *Id.* at 1955.

⁶ *Id.* at 1955-56.

⁷ *Id.* at 1956.

⁸ Essentially, a bench trial on summary judgment evidence.

⁹ *Acuff-Rose*, 47 U.S.P.Q.2d at 1955.

¹⁰ 144 F.3d 96, 46 U.S.P.Q.2d (BNA) 1936 (D.C. Cir. 1998).

¹¹ *See, e.g.*, Vault Corp. v. Quaid Software Ltd., 847 F.2d 255, 7 U.S.P.Q.2d (BNA) 1281 (5th Cir. 1988); MAI Sys. Corp. v. Peak Computer, Inc., 991 F.2d 511, 26 U.S.P.Q.2d (BNA) 1458 (9th Cir. 1993).

¹² *Stenograph*, 144 F.3d at 100-02, 46 U.S.P.Q.2d at 1939-41.

¹³ *Id.* at 98, 46 U.S.P.Q.2d at 1936.

¹⁴ *Id.* at 99, 46 U.S.P.Q.2d at 1938.

¹⁵ *Id.* at 97, 99, 46 U.S.P.Q.2d at 1938.

¹⁶ *Id.* at 100-01, 46 U.S.P.Q.2d at 1939-40.

¹⁷ *Id.* at 100-02, 46 U.S.P.Q.2d at 1940-41.

¹⁸ 992 F. Supp. 688, 46 U.S.P.Q.2d (BNA) 1784 (S.D.N.Y. 1998).

¹⁹ *Id.* at 688-89, 46 U.S.P.Q.2d at 1784-85.

²⁰ *Id.* at 690, 46 U.S.P.Q.2d at 1785-86.

²¹ *Id.* at 691, 46 U.S.P.Q.2d at 1786 (quoting *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 36 U.S.P.Q.2d (BNA) 1737 (2d Cir. 1995)).

²² 992 F. Supp. 1021, 46 U.S.P.Q.2d (BNA) 1158 (N.D. Ill. 1998).

²³ 17 U.S.C. § 602 (1994).

²⁴ *Enesco*, 992 F. Supp. at 1022-23, 46 U.S.P.Q.2d at 1159.

²⁵ *Id.*

²⁶ *E.g.*, *Parfums Givenchy, Inc. v Drug Emporium, Inc.*, 38 F.3d 477, 32 U.S.P.Q.2d (BNA) 1512 (9th Cir. 1994); *Columbia Broadcasting System, Inc. v. Scorpio Music Dist., Inc.*, 569 F. Supp. 47, 222 U.S.P.Q.2d (BNA) 975 (E.D. Pa. 1983).

²⁷ *Enesco*, 992 F. Supp. at 1023, 46 U.S.P.Q.2d at 1160.

²⁸ 147 F.3d 215, 47 U.S.P.Q.2d (BNA) 1215 (2d Cir. 1998).

²⁹ *Id.* at 218, 47 U.S.P.Q.2d at 1218.

³⁰ *Id.* at 216, 47 U.S.P.Q.2d at 1216.

³¹ *Id.* at 217, 47 U.S.P.Q.2d at 1217 (citing *Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 44 U.S.P.Q.2d (BNA) 1001 (2d Cir. 1997)).

³² *Id.* at 218, 47 U.S.P.Q.2d at 1217.

³³ *Id.*, 47 U.S.P.Q.2d at 1218.

³⁴ 150 F.3d 132, 47 U.S.P.Q.2d (BNA) 1321 (2d Cir. 1998).

³⁵ *Id.* at 138, 47 U.S.P.Q.2d at 1324-25.

³⁶ 996 F.2d 1366, 27 U.S.P.Q.2d (BNA) 1001 (2d Cir. 1993).

³⁷ *Castle Rock Entertainment*, 150 F.3d at 138, 47 U.S.P.Q.2d at 1325.

³⁸ *Id.* at 141-46, 47 U.S.P.Q.2d at 1327-31.

³⁹ 4 F. Supp.2d 808, 46 U.S.P.Q.2d (BNA) 1953 (S.D. Ind. 1998).

⁴⁰ *Id.* at 809-12, 46 U.S.P.Q.2d at 1954-56.

⁴¹ 17 U.S.C. § 106(a) (1994).

⁴² *Martin*, 4 F. Supp.2d at 811, 46 U.S.P.Q.2d at 1955-56.

⁴³ *Id.* at 812-13, 46 U.S.P.Q.2d at 1956-57.

⁴⁴ 142 F.3d 194, 46 U.S.P.Q.2d (BNA) 1521 (4th Cir. 1998).

⁴⁵ *Id.* at 199, 46 U.S.P.Q.2d at 1523-24.

⁴⁶ *Id.* at 208, 46 U.S.P.Q.2d at 1531.

⁴⁷ *Id.* at 202-03, 46 U.S.P.Q.2d at 1527.

⁴⁸ *Id.* at 203, 46 U.S.P.Q.2d at 1527-28.

⁴⁹ *Id.* at 204-05, 46 U.S.P.Q.2d at 1528-29.

⁵⁰ *Id.* at 205, 46 U.S.P.Q.2d at 1529.

⁵¹ *Id.* at 206, 46 U.S.P.Q.2d at 1529.

⁵² *Id.*, 46 U.S.P.Q.2d at 1529-30.

⁵³ *Id.*, 46 U.S.P.Q.2d at 1530.

⁵⁴ *Id.* at 207, 46 U.S.P.Q.2d at 1530-31.

⁵⁵ *Id.*, 46 U.S.P.Q.2d at 1531.

⁵⁶ *Id.* at 208, 46 U.S.P.Q.2d at 1531.

⁵⁷ *Id.*

58 5 F. Supp.2d 823, 46 U.S.P.Q.2d (BNA) 1892 (C.D. Cal. 1998).

59 *Id.* at 836, 46 U.S.P.Q.2d at 1900.

60 *Id.* at 828-29, 46 U.S.P.Q.2d at 1894.

61 *Id.* at 834, 46 U.S.P.Q.2d at 1898.

62 *Id.* at 834-35, 46 U.S.P.Q.2d at 1899.

63 *Id.* at 835, 46 U.S.P.Q.2d at 1899-1900.

64 *Id.* at 835-36, 46 U.S.P.Q.2d at 1900.

65 *Id.* at 836, 46 U.S.P.Q.2d at 1900.

66 *Id.*

67 *Id.* at 832-33, 46 U.S.P.Q.2d at 1897-98.

68 *Id.* at 833-34, 46 U.S.P.Q.2d at 1898.

69 Infinity Broadcast Corp. v. Kirkwood, 150 F.3d 104, 47 U.S.P.Q.2d (BNA) 1295 (2d Cir. 1998).

70 *Id.* at 106, 47 U.S.P.Q.2d at 1295-96.

71 *Id.* at 108-09, 47 U.S.P.Q.2d at 1297-98.

72 *Id.* at 109, 47 U.S.P.Q.2d at 1298.

73 *Id.* at 109-10, 47 U.S.P.Q.2d at 1298.

74 *Id.* at 111, 47 U.S.P.Q.2d at 1299.

75 *Id.* at 111-12, 47 U.S.P.Q.2d at 1300.

76 46 U.S.P.Q.2d (BNA) 1382 (S.D.N.Y. 1998).

77 *Id.* at 1384.

78 46 U.S.P.Q.2d (BNA) 1862 (E.D. Mich. 1997).

79 *Id.*

80 *Id.* at 1863.

81 *Id.*

82 152 F.3d 1209, 47 U.S.P.Q.2d (BNA) 1956 (9th Cir. 1998).

83 *Id.* at 1210, 47 U.S.P.Q.2d at 1957.

84 *Id.*

85 17 U.S.C. § 408 (1994).

86 808 F.2d 1316, 1 U.S.P.Q.2d (BNA) 1789 (9th Cir. 1987).

87 *Kodadek*, 152 F.3d at 1213, 47 U.S.P.Q.2d at 1959.

88 *Id.* at 1211, 47 U.S.P.Q.2d at 1957; 17 U.S.C.A. § 411 (1996 & Supp. 1998).

89 47 U.S.P.Q.2d (BNA) 1938 (C.D. Cal. 1998).

90 *Id.* at 1941.

91 *Id.* at 1940; 17 U.S.C.A. § 411(a) (1996 & Supp. 1998).

92 *Gucci*, 47 U.S.P.Q.2d at 1940.

93 *Id.*; 17 U.S.C.A. § 101 (1996 & Supp. 1998).

94 *Gucci*, 47 U.S.P.Q.2d at 1940.

95 47 U.S.P.Q.2d (BNA) 1611, 1613-17 (N.D. Ga. 1998).

96 *Id.* at 1614-15.

97 *Id.* at 1616.

⁹⁸ *Id.* at 1617.

⁹⁹ *A. Brod, Inc. v. SK & I Co., L.L.C.*, 998 F. Supp. 314, 321-24, 47 U.S.P.Q.2d (BNA) 1008, 1013-16 (S.D.N.Y. 1998).

¹⁰⁰ *Id.* at 318-19, 47 U.S.P.Q.2d at 1010-11.

¹⁰¹ *Id.*

¹⁰² *Id.* at 319-21, 47 U.S.P.Q.2d at 1011-13.

¹⁰³ *Id.* at 320-21, 47 U.S.P.Q.2d at 1012.

¹⁰⁴ *Id.* at 323, 47 U.S.P.Q.2d at 1014.

¹⁰⁵ *Id.* at 323-24, 47 U.S.P.Q.2d at 1015-16; 17 U.S.C. § 204 (1994).

¹⁰⁶ *A. Brod*, 998 F. Supp. at 323-24, 47 U.S.P.Q.2d at 1015-16.

¹⁰⁷ *See, e.g.*, *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.* 697 F.2d 27, 36, 217 U.S.P.Q. (BNA) 201, 207-08 (2d Cir. 1982).

¹⁰⁸ *A. Brod*, 998 F. Supp. at 326, 47 U.S.P.Q.2d at 1016.

¹⁰⁹ 146 F.3d 907, 47 U.S.P.Q.2d (BNA) 1385 (D.C. Cir. 1998).

¹¹⁰ 17 U.S.C.A. §§ 801-803 (1996 & Supp. 1998).

¹¹¹ *National Ass'n of Broadcasters*, 146 F.3d. at 933, 47 U.S.P.Q.2d at 1406; 5 U.S.C. § 706 (1994).

¹¹² *National Ass'n of Broadcasters*, 146 F.3d at 917-24, 47 U.S.P.Q.2d at 1393-99.

¹¹³ *Id.* at 918, 47 U.S.P.Q.2d at 1393.

¹¹⁴ 147 F.3d 195, 47 U.S.P.Q.2d (BNA) 1065 (2d Cir. 1998).

¹¹⁵ A dramaturg is an assistant to a playwright that provides a number of services to the playwright and/or director of a play during its production and development.

¹¹⁶ *Thomson*, 147 F.3d at 195-96, 47 U.S.P.Q.2d at 1065.

¹¹⁷ *Id.* at 197-98, 47 U.S.P.Q.2d at 1066-67.

¹¹⁸ *Id.* at 198, 47 U.S.P.Q.2d at 1067.

¹¹⁹ 945 F.2d 500, 20 U.S.P.Q.2d (BNA) 1191 (2d Cir. 1991).

¹²⁰ *Thomson*, 147 F.3d at 199, 47 U.S.P.Q.2d at 1067-69.

¹²¹ *Id.* at 203, 47 U.S.P.Q.2d at 1071.

¹²² *Id.*, 47 U.S.P.Q.2d at 1071-72.

¹²³ *Id.* at 204, 47 U.S.P.Q.2d at 1072.

¹²⁴ *Id.* at 204-05, 47 U.S.P.Q.2d at 1072-73.

¹²⁵ *Id.* at 200-01, 47 U.S.P.Q.2d at 1069.

¹²⁶ *Id.* at 206, 47 U.S.P.Q.2d at 1074.

¹²⁷ 139 F.3d 494, 46 U.S.P.Q.2d (BNA) 1707 (5th Cir. 1998).

¹²⁸ *Id.* at 494-95, 46 U.S.P.Q.2d at 1707-08.

¹²⁹ *Id.* at 496, 46 U.S.P.Q.2d at 1708-09.

¹³⁰ *Id.* at 495-496, 46 U.S.P.Q.2d at 1709.

¹³¹ *Id.* at 497-98, 46 U.S.P.Q.2d at 1710.

¹³² *Id.* at 498-99, 46 U.S.P.Q.2d at 1711.

¹³³ *Id.* at 500, 46 U.S.P.Q.2d at 1712-13.

¹³⁴ *Id.*

¹³⁵ 144 F.3d 229, 46 U.S.P.Q.2d (BNA) 1760 (2d Cir. 1998).

¹³⁶ *Id.* at 232-34, 46 U.S.P.Q.2d at 1761-63.

¹³⁷ *Id.*, 46 U.S.P.Q.2d at 1762-63.

¹³⁸ *Id.* at 234-35, 46 U.S.P.Q.2d at 1764.

¹³⁹ *Id.* at 236-38, 46 U.S.P.Q.2d at 1765.

¹⁴⁰ *Id.*, 46 U.S.P.Q.2d at 1765-66.

¹⁴¹ *Id.* at 238-39, 46 U.S.P.Q.2d at 1767.

¹⁴² *Id.* at 239, 46 U.S.P.Q.2d at 1767.

¹⁴³ *Id.*

¹⁴⁴ 47 U.S.P.Q.2d (BNA) 1481 (6th Cir. 1998).

¹⁴⁵ *Id.* at 1483.

¹⁴⁶ *Id.* at 1483-85.

¹⁴⁷ *Id.* at 1485.

¹⁴⁸ 908 F.2d 555, 15 U.S.P.Q.2d (BNA) 1559 (9th Cir. 1990).

¹⁴⁹ 74 F.3d 768, 37 U.S.P.Q.2d (BNA) 1436 (7th Cir. 1996).

¹⁵⁰ *Johnson*, 47 U.S.P.Q.2d at 1485-86.

¹⁵¹ *Id.* at 1486-87.

¹⁵² 145 F.3d 481, 46 U.S.P.Q.2d (BNA) 1577 (2d Cir. 1998).

¹⁵³ *Id.* at 485, 46 U.S.P.Q.2d at 1580.

¹⁵⁴ *Id.* at 484, 46 U.S.P.Q.2d at 1578-79.

¹⁵⁵ *Id.*, 46 U.S.P.Q.2d at 1579.

¹⁵⁶ *Id.*

¹⁵⁷ 391 F.2d 150, 157 U.S.P.Q. (BNA) 65 (2d. Cir. 1968).

¹⁵⁸ *Boosey & Hawkes*, 145 F.3d at 486, 46 U.S.P.Q.2d at 1580.

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at 485-88, 46 U.S.P.Q.2d at 1580-82.

¹⁶¹ *Id.* at 488-91, 46 U.S.P.Q.2d at 1582-84.

¹⁶² *Id.* at 488, 46 U.S.P.Q.2d at 1582.

¹⁶³ *Id.* at 488-91, 46 U.S.P.Q.2d at 1582-84.

¹⁶⁴ *Id.*

¹⁶⁵ 47 U.S.P.Q.2d (BNA) 1356 (2d Cir. 1998).

¹⁶⁶ 17 U.S.C.A. § 304 (1996 & Supp. 1998).

¹⁶⁷ *Fred Ahlert*, 47 U.S.P.Q.2d at 1358-60.

¹⁶⁸ *Id.* at 1358.

¹⁶⁹ *Id.* at 1361-62.

¹⁷⁰ *Id.* at 1362-63.

¹⁷¹ 46 U.S.P.Q.2d (BNA) 1794 (N.D. Cal. 1998).

¹⁷² *Id.* at 1796.

¹⁷³ *Id.*

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ 46 U.S.P.Q.2d (BNA) 1066 (S.D.N.Y. 1998).

¹⁷⁷ *Id.*; 17 U.S.C.A. § 507 (1996 & Supp. 1998).

¹⁷⁸ *Margo*, 46 U.S.P.Q.2d at 1068.

¹⁷⁹ *Id.* at 1069-70.

¹⁸⁰ *Id.* at 1069; 15 U.S.C. § 1125(a) (1994 & Supp. 1997).

¹⁸¹ *Margo*, 46 U.S.P.Q.2d at 1070-71.

¹⁸² *Id.* at 1073-74.

¹⁸³ 17 U.S.C.A. § 507 (1996 & Supp. 1998).

¹⁸⁴ *Margo*, 46 U.S.P.Q.2d at 1072.

¹⁸⁵ *Id.* at 1073.

¹⁸⁶ *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 47 U.S.P.Q.2d (BNA) 1810 (2d Cir. 1998).

¹⁸⁷ *Id.* at 89-91, 47 U.S.P.Q.2d at 1816-18.

¹⁸⁸ *Id.* at 84, 47 U.S.P.Q.2d at 1812.

¹⁸⁹ *Id.* at 84-85, 47 U.S.P.Q.2d at 1812.

¹⁹⁰ *Id.* at 88, 47 U.S.P.Q.2d at 1815.

¹⁹¹ *Id.* at 90-91, 47 U.S.P.Q.2d at 1817-18.

¹⁹² Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, art. 5(4), 25 U.S.T. 1341, 828 U.N.T.S. 221.

¹⁹³ *Itar-Tass*, 153 F.3d at 90-91, 47 U.S.P.Q.2d at 1817.

¹⁹⁴ *Id.* at 91, 47 U.S.P.Q.2d at 1818.

¹⁹⁵ *Id.* at 92, 47 U.S.P.Q.2d at 1819.

¹⁹⁶ *Id.*

197 *Id.* at 93, 47 U.S.P.Q.2d at 1820.

198 *Id.* at 93-94, 47 U.S.P.Q.2d at 1820-21.

199 118 S.Ct. 1279, 46 U.S.P.Q.2d (BNA) 1161 (1998).

200 *Id.* at 1281-82, 46 U.S.P.Q.2d at 1162; 17 U.S.C.A. § 504(c) (1996 & Supp. 1998).

201 *Feltner*, 118 S.Ct. at 1282, 46 U.S.P.Q.2d at 1162.

202 *Id.*

203 *Id.* at 1282-83, 46 U.S.P.Q.2d at 1163.

204 *Id.* at 1283, 46 U.S.P.Q.2d at 1163 (citing *Columbia Pictures Television v. Krypton Broad. of Birmingham, Inc.*, 106 F.3d 284, 41 U.S.P.Q.2d (BNA) 1664 (9th Cir. 1997)).

205 *Id.* at 1281.

206 *Id.* at 1283-84, 46 U.S.P.Q.2d at 1163-64.

207 *Id.*

208 See *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33 (1989).

209 *Feltner*, 118 S.Ct. 1284, 46 U.S.P.Q.2d at 1164-65.

210 *Id.* at 1285, 46 U.S.P.Q.2d at 1165.

211 *Id.* (citing 8 Anne ch. 19 (1710)).

212 *Id.* at 1286, 46 U.S.P.Q.2d at 1166.

213 *Id.*

214 *Id.* at 1287, 46 U.S.P.Q.2d at 1166-67.

215 *Id.*, 46 U.S.P.Q.2d at 1167.

216 *Id.* at 1288, 46 U.S.P.Q.2d at 1168.

²¹⁷ *Id.* at 1288-90, 46 U.S.P.Q.2d at 1168-69.

²¹⁸ *Id.* at 1288, 46 U.S.P.Q.2d at 1168.

²¹⁹ Playboy Enters. Inc. v. Sanfilippo, 46 U.S.P.Q.2d (BNA) 1350 (S.D. Cal. 1998).

²²⁰ *Id.* at 1356.

²²¹ *Id.* at 1355.

²²² 149 F.3d 987, 47 U.S.P.Q.2d (BNA) 1349 (9th Cir. 1998).

²²³ 149 F.3d at 992, 47 U.S.P.Q.2d at 1352.

²²⁴ *Id.* at 990, 47 U.S.P.Q.2d at 1350.

²²⁵ *Id.* at 991-92, 47 U.S.P.Q.2d at 1351-52 (citing 106 F.2d 45, 42 U.S.P.Q. (BNA) 540 (2d Cir. 1939), *aff'd* 309 U.S. 390, 44 U.S.P.Q. (BNA) 607 (1940)).

²²⁶ *Id.* at 992, 47 U.S.P.Q.2d at 1352.

²²⁷ 47 U.S.P.Q.2d (BNA) 1539 (S.D.N.Y. 1998).

²²⁸ 152 F.3d 1171, 47 U.S.P.Q.2d (BNA) 1863 (9th Cir. 1998).

²²⁹ *Id.* at 1172, 47 U.S.P.Q.2d at 1864; 17 U.S.C. 505 (1994).

²³⁰ *Columbia Pictures*, 152 F.3d at 1171-72, 47 U.S.P.Q.2d at 1864.

²³¹ Lotus Dev. Corp. v. Borland Int'l, Inc., 140 F.3d 70, 76, 46 U.S.P.Q.2d (BNA) 1774, 1779 (1st Cir. 1998).

²³² *Id.* at 75, 46 U.S.P.Q.2d at 1778.

²³³ *Id.* at 74-75, 46 U.S.P.Q.2d at 1777-78.

²³⁴ 510 U.S. 517, 29 U.S.P.Q.2d (BNA) 1881 (1994).

²³⁵ *Lotus*, 140 F.3d at 75, 46 U.S.P.Q.2d at 1778.

²³⁶ 1 F. Supp.2d 859, 47 U.S.P.Q.2d (BNA) 1034 (N.D. Ill. 1998).

²³⁷ *Id.* at 862, 867, 47 U.S.P.Q.2d at 1036, 1040.

²³⁸ *Id.* at 862-63, 47 U.S.P.Q.2d at 1036-37.

²³⁹ *Id.* at 863-65, 47 U.S.P.Q.2d at 1037-38.

²⁴⁰ *Id.* at 865-66, 47 U.S.P.Q.2d at 1039.

²⁴¹ *Id.* at 862-66, 47 U.S.P.Q.2d at 1036-40.

²⁴² 17 U.S.C. § 412 (1994).

²⁴³ Cook v. Jane Lyons Adver., Inc., 47 U.S.P.Q.2d (BNA) 1147 (D.D.C. 1998).

²⁴⁴ *Id.* at 1150.

²⁴⁵ 139 F.3d 504, 46 U.S.P.Q.2d (BNA) 1541 (5th Cir. 1998).

²⁴⁶ 59 F.3d 539, 35 U.S.P.Q.2d (BNA) 1609 (5th Cir. 1995).

²⁴⁷ See 15 U.S.C. § 1122 (1994), 15 U.S.C. § 1125 (1994 & Supp. 1997), 17 U.S.C. § 501(a) (1994), 17 U.S.C. § 511 (1994).

²⁴⁸ University of Houston, Texas v. Chavez, 517 U.S. 1184 (1996).

²⁴⁹ 517 U.S. 44 (1996).

²⁵⁰ *Chavez*, 139 F.3d at 506, 46 U.S.P.Q.2d at 1542-43.

²⁵¹ *Id.* at 508, 46 U.S.P.Q.2d at 1544.

²⁵² *Id.*

²⁵³ *Id.*, 46 U.S.P.Q.2d at 1545. Curiously, Congress did not expressly refer to the Fourteenth Amendment in enacting the Copyright Remedy Clarification Act. See *id.* at 509, 46 U.S.P.Q.2d at 1545.

²⁵⁴ *Id.* at 509, 46 U.S.P.Q.2d at 1545.

²⁵⁵ *Id.*

²⁵⁶ *Id.*, 46 U.S.P.Q.2d at 1546.

²⁵⁷ *Id.* at 510, 46 U.S.P.Q.2d at 1546 (citing 710 F.2d 934, 219 U.S.P.Q. (BNA) 204 (2d. Cir. 1983)).

²⁵⁸ *Id.*

²⁵⁹ *Id.*

²⁶⁰ *Id.* at 512, 46 U.S.P.Q.2d at 1548.

²⁶¹ 209 U.S. 123 (1908).

²⁶² *Chavez*, 139 F.3d at 512, 46 U.S.P.Q.2d at 1548.

²⁶³ 148 F.3d 1343, 47 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 1998).

²⁶⁴ See 35 U.S.C.A. §§ 271(h), 296 (1984 & Supp. 1998).

²⁶⁵ *College Savings*, 148 F.3d at 1355, 47 U.S.P.Q.2d at 1170.