

Protecting Against Copyright Infringement

- Defining Infringement
- Defining Fair Use
- Participating In Infringement Litigation

A Litigator's Role In Dealing With Infringement Issues

- Clearance Work / Pre-Publication Review
- Bringing / Defending Infringement Actions

Originality

- A work is original if not copied
 - ◆ No novelty required
 - ◆ Low standard
- If work is based on prior “public domain work,” original if there is “distinguishable variation” from the earlier work

Authorship

- Modicum of creativity
- Mere ideas, procedures, methods, systems, processes, principles, discoveries or devices are not protectible
- “Research” is not protectible
- Also not protectible: titles, names, short phrases and slogans; familiar symbols or designs (e.g., basic geometric shapes); or mere listings of ingredients or contents

Who Gets Copyright Protection?

- The *author* owns the copyright
- Issues:
 - ◆ Joint Authorship
 - ◆ Works made for hire

Joint Authorship

- “Joint work”: prepared by two or more authors with the intention that contributions be merged into inseparable or interdependent parts of a unitary whole
 - ◆ Intention
 - ◆ Contribution of expression by both
 - ◆ Right to control or supervise creation
- Joint authors both own copyright and can exploit copyright only with duty to account to other

Works Made For Hire

- An *employer* is considered to be the author of a work created by its *employee* in the course of his or her job duty (called a “work made for hire”)
 - ◆ General employer/employee relationship (e.g., not a mere independent contractor)
- Specially commissioned works, Section 101
 - ◆ Prior written agreement
 - ◆ Only enumerated works

Transfers of Ownership

- Transfer of *exclusive right* must be in writing
 - ◆ Not merely equivalent to common law statute of frauds
- Nonexclusive licenses need not be in writing

What Does the Copyright Owner Get?

- Copyright owner has five basic exclusive rights:
 - ◆ right to reproduce (copy) the work
 - ◆ right to make derivative works (adapt) based on the original;
 - ◆ right to distribute (by sale, license, rental, etc.) to the public copies of the work
 - ◆ right to perform the work publicly
 - ◆ right to display the work publicly

When Does Copyright Begin?

- Copyright protection subsists from the time the work is created in a fixed form
- No need to register or take action

How Long Does Copyright Last?

- For works created after January 1, 1978, the term is life of the author plus 70 years (an individual); or
- In case of, *e.g.*, works made for hire, 95 years from first publication or 120 years from date of creation, whichever is shorter

How Long Does Copyright Last?

- Generally, for works published between 1923 and December 31, 1977, the term is 28 years initial term, plus 67 year renewal term, for a total of 95 years
 - ◆ Note: key was *publication*
- Caveat: because of various legislative enactments, renewal and duration issues can be complex. See materials.

Formalities

- *Notice* no longer required since the U.S. adopted the Berne Convention as of March 1, 1989.
 - ◆ However, notice precludes defendant from asserting innocent infringement
- *Registration* is *not* a prerequisite for copyright
 - ◆ Jurisdictional prerequisite to infringement suit (for U.S. work)
 - ◆ Prima facie evidence of copyright validity
 - ◆ Prerequisite for statutory damages and attorneys' fees

Infringement

- Violation of one or more of the exclusive rights

Jurisdiction

- Exclusive to federal courts
- Equivalent state claims pre-empted
 - ◆ Subject matter of copyright
 - ◆ Rights under state law equivalent to copyright

Proving Infringement

- Copying of Plaintiff' s work
- Copying of *protected expression*

Copying

- Direct evidence of copying *or*
- Access + Probative similarity
 - ◆ Access: *reasonable* opportunity to view work
 - ✦ Public dissemination
 - ✦ Submission chain
 - ◆ Probative similarity: similarity indicative of copying

Misappropriation of Protectible Expression

- Even where copying is shown, no liability unless Defendant copies “protectible expression”
- Test: *Substantial similarity*
- Ideas are not protected
- *Scenes a faire* are not protected

Substantial Similarity (9th Cir test)

- Extrinsic (objective) test
 - ◆ Analytic dissection
 - ◆ Expert analysis
 - ◆ Summary judgment appropriate
- Intrinsic (subjective) test
 - ◆ Total concept and feel
 - ◆ Audience response
 - ◆ No summary judgment

Defense of Independent Creation

- Because copyright law only precludes “copying,” independent creation is a defense
- Note: “prior creation” is often basis of summary judgment for defense

Secondary Liability

- Vicarious liability
 - ◆ a direct financial benefit to the defendant,
 - ◆ the right and ability to supervise the infringers.
- Contributory infringement
 - ◆ Knowledge of the infringement
 - ✦ Actual knowledge of specific infringement?
 - ✦ Constructive knowledge?
 - Substantial noninfringing use?
 - ◆ Material contribution to the infringement
 - ◆ Active inducement

Defense of Fair Use: Sec 107 Factors

- (1) the purpose and character of the accused use;
- (2) the nature of the copyrighted work;
- (3) the importance of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the accused use on the potential market for or value of the copyrighted work."

Fair Use

- *Illustrative* uses that are *possibly* fair:
- criticism
- comment
- news reporting
- teaching (including multiple copies for classroom use)
- scholarship
- research

Fair Use

- Purpose and character of defts' use
 - ◆ Commercial or not?
 - ◆ Transformative?

Fair Use

- Nature of the copyrighted (plaintiff' s) work
 - ◆ creative vs. factual
 - ◆ published vs. unpublished

Fair Use

- Amount & substantiality of portion used in relation to copyrighted work as a whole
 - ◆ E.g., did defendant take more than enough to “conjure up” original?
 - ◆ Qualitative and quantitative assessment

Fair Use

- Effect of use on potential market or value of copyrighted work
 - ◆ effect on market or potential market
 - ◆ does defendant's work serve as a substitute?

Remedies

- actual damages plus defendant's profits attributable infringement; *or*
- statutory damages of not less than \$750 or more than \$30,000, and up to \$150,000 in the case of willful infringement;
- costs and attorneys' fees to the prevailing party, in court's discretion;
- injunction