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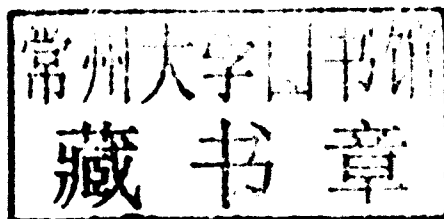
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Library of Congress Card Number 64-1725

ISBN 978-0-8205-1465-9

Cite this publication as:

[Vol. no.] Melville B. Nimmer and David Nimmer, Nimmer on Copyright § [sec. no.] (Matthew Bender, Rev. Ed.)

Example:

2 Melville B. Nimmer and David Nimmer, Nimmer on Copyright § 7.21[B][2] (Matthew Bender, Rev. Ed.)

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<i>Reference</i>	<i>Identification</i>
BCIA	Berne Convention Implementation Act of 1988 (see Overview) (see also Appendix 2A <i>infra</i>)
Commerce Rep. (DMCA)	H.R. Rep. No. 105-551, Part 2, 105th Cong., 2d Sess. (1998) (see Appendix 53 <i>infra</i>)
Conf. Rep.	H.R. Rep. No. 94-1733, 94th Cong., 2d Sess. (1976) (see Appendix 5 <i>infra</i>)
Conf. Rep. (DMCA)	Joint Explanatory Statement of the Committee of Conference, H.R. Rep. No. 105-796, 105th Cong., 2d Sess. (1998) (see Appendix 57 <i>infra</i>)
Current Act (1976 Act)	17 U.S.C. § 101 <i>et seq.</i> (Pub. L. 94-553, 90 Stat. 2541) (see Appendix 2 <i>infra</i>)
Decennial	January 1, 1978 — March 1, 1989 (see Overview <i>infra</i>)
DPRA	Digital Performance Rights in Sound Recordings Act of 1995 (see Appendix 2H)
Hearings on GATT Intellectual Property Provisions	<i>General Agreement on Tariffs and Trade (GATT): Intellectual Property Provisions</i> , Joint Hearings Before the Subcommittee on Intellectual Property and Judicial Administration of the House Committee on the Judiciary and the Subcommittee on Patents, Copyrights, and Trademarks of the Senate Committee on the Judiciary, 103d Cong., 2d Sess. (August 12, 1994)
H. Rep.	H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. (1976) (see Appendix 4 <i>infra</i>)
H. Rep. (AHRA)	H.R. Rep. No. 102-873 Part 1, 102d Cong., 2d Sess. (1992). (see Appendix 37 <i>infra</i>)
H. Rep. (BCIA)	H.R. Rep. No. 100-609, 100th Cong., 2d Sess. (1988) (see Appendix 32 <i>infra</i>)

*Reference**Identification*

H. Rep. (DMCA)

H.R. Rep. No. 105-551, Part 1, 105th Cong.,
2d Sess. (1998) (see Appendix 52 *infra*)

H. Rep. (DPRA)

H.R. Rep. No. 104-274, 104th Cong., 1st
Sess. (1995) (see Appendix 45 *infra*)

H. Rep. (FECA)

H.R. Rep. No. 109-33(1),
109th Cong., 1st Sess. (2005)

H. Rep. (PRO IP)

H. R. Rep. No. 110-617,
110th Cong., 2d Sess. (2008)

H. Rep. (SCPA)

H.R. Rep. No. 98-781,
98th Cong., 2d Sess. (1984) (see Appendix
30 *infra*)

H. Rep. (SHVA)

H.R. Rep. No.100-887(1),
100th Cong., 2d Sess. (1988),
reprinted in 1988 U.S. Code Cong. & Ad-
min. News 5611

OCILLA

Online Copyright Infringement Liability
Limitation Act (see § 12B.01[C] *infra*)

Reg. Rep.

Report of the Register of Copyrights on the
General Revision of the U.S. Copyright Law,
87th Cong., 1st Sess., Copyright Law
Revision
(House Comm. Print 1961)
(see Appendix 14 *infra*)

Reg. Supp. Rep.

Supplementary Report of the Register of
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(House Comm. Print 1965)
(see Appendix 15 *infra*)

SAA

Statement of Administrative Action (see
§ 18.06 [C][2][c] *infra*)

S. Rep.

S. Rep. No. 94-473,
94th Cong., 1st Sess. (1975) (see Appendix
4A *infra*)

S. Rep. (AHRA)

S. Rep. No. 102-294,
102d Cong., 2d Sess. (1992) (see Appendix
36 *infra*)

S. Rep. (BCIA)

S. Rep. No. 100-352,
100th Cong., 2d Sess. (1988) (see Appendix
35 *infra*)

S. Rep. (DMCA)

S. Rep. No. 105-190, 105th Cong., 2d Sess.
(1998) (see Appendix 54 *infra*)

<i>Reference</i>	<i>Identification</i>
S. Rep. (DPRA)	S. Rep. No. 104-128, 104th Cong., 1st Sess. (1995) (see Appendix 46 <i>infra</i>)
Trans. Supp. Prov.	Transitional and Supplementary Provisions (see Appendix 2 <i>infra</i>)
TRIPs	Trade-Related Aspects of Intellectual Property Rights (see § 18.06[A] <i>infra</i>)
U.C.C.	Universal Copyright Convention (see Appendices 24 and 25 <i>infra</i>)
U.S.P.Q.	United States Patent Quarterly
1909 Act	Act of March 4, 1909, ch. 320, 35 Stat. 1075, as thereafter codified in 17 U.S.C. § 1 <i>et seq.</i> , and as amended (see Appendix 6 <i>infra</i>)
1997 Hearings, Serial No. 33	<i>The WIPO Copyright Treaties Implementation Act and Online Copyright Liability Limitation Act</i> , Hearing Before the Subcommittee on Courts and Intellectual Property, Serial No. 33 (Sept. 16-17, 1997)
2000 Hearings, Serial No. 145	<i>United States Copyright Office and Sound Recordings as Work Made for Hire</i> , Hearing Before the Subcommittee on Courts and Intellectual Property, Serial No. 145 (May 25, 2000)

CHAPTER 13

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§ 13.01 The Elements That the Plaintiff Must Prove in an Infringement Action

Reduced to most fundamental terms, there are only two elements necessary to the plaintiff's case in an infringement action:¹ ownership of the copyright by the plaintiff² and³ copying⁴ by the defendant.⁵ To use the Supreme Court's recent terminology from

¹ In that limited area of common law copyright that has survived pre-emption (see § 2.02 *supra*), essentially the same elements are applicable. *Smith v. Little, Brown & Co.*, 245 F. Supp. 451 (S.D.N.Y. 1965) (Treatise cited), *aff'd*, 360 F.2d 928 (2d Cir. 1966); *Lapsley v. American Inst. of Certified Public Accountants*, 147 U.S.P.Q. 439 (D.D.C. 1965). See *Twentieth Century-Fox Film Corp. v. Dieckhaus*, 153 F.2d 893 (8th Cir. 1946); *Schwarz v. Universal Pictures Co.*, 85 F. Supp. 270 (S.D. Cal. 1949). Of course, publication may divest a work of common law copyright, even if federal pre-emption does not apply. See § 4.01[B] *supra*. Moreover, statutory formalities are not applicable to works in common law copyright. See Chap. 7 *supra*.

As to the category of pre-1972 sound recordings, common law copyright may endure even after publication. *Capitol Records, Inc. v. Naxos of Am., Inc.*, 372 F.3d 471, 479 (2d Cir. 2004). Under New York law, the only elements for a copyright infringement cause of action, as under federal law, are "(1) the existence of a valid copyright; and (2) unauthorized reproduction of the work protected by the copyright." *Capitol Records, Inc. v. Naxos of Am., Inc.*, 4 N.Y.3d 540, 563 & n.10, 797 N.Y.S.2d 352, 830 N.E.2d 250 (2005) (Treatise cited). As to the ingredient of being "unauthorized," see the discussion in the text *infra*.

² See *Video Trip Corp. v. Lightning Video, Inc.*, 866 F.2d 50, 52 (2d Cir. 1989) (Treatise cited).

³ There are conflicting views as to whether a court should first consider the issue of ownership or the issue of copying. *Tralins v. Kaiser Aluminum & Chem. Corp.*, 160 F. Supp. 511 (D. Md. 1958), suggests that the order is of no importance.

⁴ "Copying" is here used in the broad sense referred to in § 8.02[A] *supra*. Even then, it may be more accurate to speak of "copying or public distribution or public display." One court, under the 1909 Act, described this element as "copying *or* vending." *American Int'l Pictures, Inc. v. Foreman*, 400 F. Supp. 928 (S.D. Ala. 1975) (Treatise cited) (emphasis added), *rev'd*, 576 F.2d 661 (5th Cir. 1978). Cf. the statement of the "essential elements of a cause of action for copyright infringement" in *Shapiro, Bernstein & Co. v. Log Cabin Club Ass'n*, 365 F. Supp. 325, 328 n.4 (N.D. W. Va. 1973).

⁵ *Reyher v. Children's Television Workshop*, 533 F.2d 87 (2d Cir. 1976) (Treatise cited), *cert. denied*, 429 U.S. 980, 97 S. Ct. 492, 50 L. Ed. 2d 588 (1976); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) (Treatise cited); *Sebastian Int'l, Inc. v. Russolillo*, 186 F. Supp. 2d 1055, 1070 (C.D. Cal. 2000) (Treatise cited); *Charles Garnier, Paris v. Andin Int'l, Inc.*, 844 F. Supp. 89, 93 (D.R.I. 1994) (Treatise quoted); *Reader's Digest Ass'n, Inc. v. Conservative Digest Ass'n, Inc.*, 821 F.2d 800, 805 (D.C. Cir. 1987); *Baxter v. MCA, Inc.*, 812 F.2d 421, 423 (9th Cir. 1987) (Treatise cited), *cert. denied*, 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987); *Radji v. Khakbaz*, 607 F. Supp. 1296, 1299 (D.D.C. 1985) (Treatise cited); *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148 (9th Cir. 1986) (Treatise cited); *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189, 192 (2d Cir. 1985) (Treatise cited); *Bell v. Combined Registry Co.*, 397 F. Supp. 1241 (N.D. Ill. 1975), *aff'd*, 536 F.2d 164 (7th Cir. 1976), *cert. denied*, 429 U.S. 1001, 97 S. Ct. 530, 50 L. Ed. 2d 612 (1976); *Arrow Novelty*

the now-governing case^{5.1} addressing the ingredients^{5.2} that the plaintiff must demonstrate to establish infringement,^{5.3} “two elements must be proven: (1) ownership of a valid copyright,^{5.4} and (2) copying of constituent elements of the work that are original.”^{5.5}

Courts sometimes add in other elements when reciting the elements of an infringement case. Frequently, for instance, ASCAP claims^{5.5a} are summarized as requiring proof “that the Defendants had not received permission from any of the Plaintiffs or their representatives for such performances.”^{5.5b} Nonetheless, as a matter of allocation of proof, that formulation would appear to be in error—authorization from the copyright owner is an affirmative defense rather than an element of plaintiff’s case.^{5.5c}

Notably absent from the plaintiff’s *prima facie* case is the need to demonstrate damage or any harm to plaintiff resulting from the infringement.^{5.6} Nonetheless, it has been held that the plaintiff’s inability to recover any form of monetary^{5.7} or equitable relief^{5.8} can warrant a defense summary judgment.^{5.9}

Co. v. Enco Nat’l Corp., 393 F. Supp. 157 (S.D.N.Y. 1974) (Treatise cited), *aff’d mem.*, 515 F.2d 504 (2d Cir. 1975). See § 12.04 *supra*.

^{5.1} *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). Prior to this 1991 case, the elements recited in the first sentence of the text above were probably the most oft-cited passage of this treatise. See, e.g., *In Design v. Lauren Knitwear Corp.*, 782 F. Supp. 824, 829 (S.D.N.Y. 1991); *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1356 (N.D. Ill. 1989). Since *Feist*, the subtly-altered language of the Supreme Court is, of course, to be preferred. See § 13.03[B][2][b] *infra*.

^{5.2} See § 13.03[E][1][b] *infra*.

^{5.3} The ruling in *Feist* was that a compilation of white pages in alphabetical order is not copyrightable. See § 3.04[B][2][a] *supra*. Nonetheless, because the plaintiff’s work as a whole was subject to copyright protection, the Court reached the issue of the scope of prohibited copying. 499 U.S. at 361.

^{5.4} That element was not at issue in *Feist*. 499 U.S. at 361.

^{5.5} *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), *citing* *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 548, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985). See *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992) (Treatise cited); *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1160 (1st Cir. 1994) (Treatise cited), *disapproved on other grounds*, *Reed Elsevier, Inc. v. Muchnick*, ___ U.S. ___, 130 S. Ct. 1237, 1243 n.2, 176 L. Ed. 2d 18 (2010). As will be shown below, the prepositional phrase following “copying,” which was *not* explicitly set forth in *Harper & Row v. Nation*, is highly significant. See § 13.03[E][1][b] N. 202.3 *infra*.

^{5.5a} See § 8.19[B] *supra*.

^{5.5b} See *EMI April Music Inc. v. Jet Rumeurs, Inc.*, 632 F. Supp. 2d 619, 622 (N.D. Tex. 2008); *Controversy Music v. Down Under Pub Tyler, Inc.*, 488 F. Supp. 2d 572, 576 (E.D. Tex. 2007).

^{5.5c} See Chap. 10 *supra*.

^{5.6} *Davis v. The Gap, Inc.*, 246 F.3d 152, 159 (2d Cir. 2001) (Treatise quoted). See *Davidov v. Tapemeasure Enters. Inc.*, 27 U.S.P.Q.2d (BNA) 1382, 1386 (S.D.N.Y. 1993).

^{5.7} Note that qualifying plaintiffs may elect to recover statutory damages in the absence of actual harm. *Id.* See § 14.04[A] *infra*.

^{5.8} See §§ 14.06–14.08 *infra* (injunctions, impounding, destruction).

[A] Ownership

Plaintiff's ownership, in turn, breaks down into the following constituent parts:^{5,10} (1) originality in the author;⁶ (2) copyrightability of the subject matter;⁷ (3) a national point of attachment of the work, such as to permit a claim of copyright;⁸ (4) compliance with applicable statutory formalities;⁹ and (5) (if the plaintiff is not the author) a transfer of rights¹⁰ or other relationship¹¹ between the author and the plaintiff so as to constitute the plaintiff as the valid copyright claimant.¹²

With respect to most of the above elements of ownership, the copyright registration certificate constitutes *prima facie* evidence in favor of the plaintiff.¹³ This is clearly true on the issue of originality,¹⁴ as well as in establishing the copyrightability of the subject matter¹⁵ and the citizenship status of the author.¹⁶ Satisfaction of the statutory formalities is likewise presumed by reason of the registration certificate,¹⁷ as is the plaintiff's chain of title from the author where the plaintiff obtained an assignment of rights prior to registration.¹⁸ By reason of the benefit of such presumption, the only evidence required of the plaintiff to establish *prima facie* ownership, in addition to the registration certificate, is evidence of plaintiff's chain of title from the original

^{5,9} Northwest Airlines, Inc. v. American Airlines, Inc., 870 F. Supp. 1504, 1512–1513 (D. Minn. 1994).

^{5,10} Custom Dynamics, LLC v. Radiantz LED Lighting, Inc., 535 F. Supp. 2d 542, 551 n.3 (E.D.N.C. 2008) (Treatise cited).

⁶ See § 2.01 *supra*.

⁷ See Chap. 2 *supra*.

⁸ See § 5.05 *supra*.

⁹ See Chap. 7 *supra*. The formal requirements for copyright subsistence (and hence, ownership) have lessened over time, and are basically inapplicable to works created during the Berne era. See § 7.01 *infra*.

¹⁰ See Chap. 10 *supra*.

¹¹ See § 5.03 *supra*, and Chaps. 9 and 11 *supra*.

¹² Tanya Creations, Inc. v. Talbots, Inc., 356 F. Supp. 2d 97, 100–101 (D.R.I. 2005) (Treatise cited); Bell v. Combined Registry Co., 397 F. Supp. 1241 (N.D. Ill. 1975), *aff'd*, 536 F.2d 164 (7th Cir. 1976) (Treatise cited), *cert. denied*, 429 U.S. 1001, 97 S. Ct. 530, 50 L. Ed. 2d 612 (1976). See § 12.02 *supra*. The entire paragraph of text is quoted in Atari, Inc. v. Amusement World, Inc., 547 F. Supp. 222 (D. Md. 1981); Carol Cable Co. v. Grand Auto Inc., 4 U.S.P.Q.2d 1056, 1061 (C.D. Cal. 1987).

¹³ 17 U.S.C. § 410(c). See Southern Bell Tel. & Tel. v. Associated Tel. Directory Publishers, 756 F.2d 801 (11th Cir. 1985) (Treatise cited); Microsoft Corp. v. PC Exp., 183 F. Supp. 2d 448, 453 (D.P.R. 2001) (Treatise cited); Arthur Rutenberg Corp. v. Dawney, 647 F. Supp. 1214, 1216 (M.D. Fla. 1986) (Treatise cited).

¹⁴ See § 12.11[B][1] *supra*.

¹⁵ See Donald Frederick Evans & Assoc. v. Continental Homes, Inc., 785 F.2d 897, 903 (11th Cir. 1986) (Treatise cited). See also § 12.11[B][3] *supra*.

¹⁶ The registration certificate expressly confirms satisfaction of these requirements.

¹⁷ See § 12.11[B][2] *supra*.

¹⁸ See § 12.11[C] *supra*.