Copyright Law
A Practitioner’s Guide
Second Edition
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In this release, the authors update and expand your book with discussion of the following topics, among others:

Trade secrets: The Defend Trade Secrets Act of 2016 (DTSA) permits an owner of a trade secret bring a civil action in federal court if a trade secret related to a product or service used in interstate or foreign commerce is misappropriated. See § 1:1.5, at note 42.1.

Copyright protection for utilitarian works: In a case to be heard by the Supreme Court, Varsity Brands, Inc. v. Star Athletica, LLC, the Sixth Circuit found that the “arrangement of stripes, chevrons, zigzags, and color-blocking” on a cheerleading uniform was separable from the uniform’s utilitarian function, as the design did “not ‘enhance the [cheerleading uniform’s] functionality qua clothing.’” The court found that the graphic features of the uniform designs were more like fabric designs, which are protectable, than dress designs, which cannot be copyrighted. See § 2:5.5[B], at notes 180.1 and 188.1.

Implied license: The Fifth Circuit has held that an architectural design firm owning copyrights in draft plans for four homes created an implied, nonexclusive license for a client to use the plans when it delivered them to the client without any written or orally communicated restrictions (Hunn v. Dan Wilson Homes, Inc.). See § 3:6.1[A], at note 224.

Sound recordings—sampling: Strongly disagreeing with the Sixth Circuit’s Bridgeport Music, the Ninth Circuit asserted that sampling could be a de minimis case; sampling of a sound recording of a single horn hit in Madonna’s “Vogue” was de minimis and not infringement. “[T]he de minimis exception applies to infringement actions concerning copyrighted sound recordings, just as it applies to all other copyright infringement actions” (VMG Salsoul LLC v. Ciccone). See § 4:1.1[A], at note 45.

Notice of termination: Where it is uncertain whether a termination notice is effective (for example, it is uncertain who has the right to send the notice), an action for declaratory judgment may be brought; however, the Eleventh Circuit has held that such an action must be brought during the statutory termination window (Smith v. Casey). See § 7:5.3[D], at note 156.
**Fair use—transformative use:** The Second Circuit has ruled that the use of the famed Abbott and Costello “Who’s on First” routine in a play for the same comedic purpose as the original, “mimicking the original timing, tone, and delivery” and without any significant “dramatic” purpose, was not transformative *(TCA Television Corp. v. McCollum).* See § 8:4.2[A], at note 86.1.

**Fair use—space-shifting:** The Supreme Court’s 1984 *Sony Corp.* case upheld the use of a VCR to copy a television show for later viewing (time-shifting), but what about space-shifting, or medium-shifting—copying from, say, a DVD to a non-television device accessible remotely? In a case involving copying from a DVR to a tablet or smartphone, one federal district court has concluded that time- and space-shifting are “paradigmatic fair uses,” at least where subscribers validly possess recordings of television programs that they have made *(Fox Broadcasting Co. v. Dish Network LLC).* See § 8:5.3, at note 198.1.

**Fair use—search engines:** In *Authors Guild v. Google, Inc.* and *Authors Guild, Inc. v. HathiTrust*, the Second Circuit concluded that mass digitization to facilitate searching is justified by the fair use doctrine. In both cases, the court found that there is substantial public benefit and the search function is “highly transformative,” because it is for a different purpose than the original; moreover, there was no evidence that the display of search results competitively harms the copyright owners. See § 8:5.5, at note 223.1.

**Preemption of state law claims:** According to the Ninth Circuit in *Ryan v. Editions Limited West, Inc.*, an artist’s claims for attorneys’ fees under the fee-shifting provision of a publishing contract were not preempted; California law permitting enforcement of that provision “has little, if anything, to do with the exclusive rights or subject matter of copyright” and the statute does not “conflict with the purpose of the Copyright Act.” See § 11:3.3[G], at note 102.1.

**Miscellaneous defenses:** In addition to the more familiar defenses, copyright defendants may employ such defenses as licensee estoppel and collateral estoppel. See new § 11:7.8.

**Attorneys’ fees—prevailing party:** In *Kirtsaeng v. John Wiley & Sons, Inc.*, the Supreme Court provided additional guidance with respect to awarding attorneys’ fees under section 505. It held that courts should give substantial weight to the objective reasonableness of a losing party’s litigating position, but they should also take into account other circumstances relevant to awarding such fees, and that they retain discretion to make such an award even when a losing party advances a reasonable claim or defense. See § 12:8.2, at note 211.

**Remedies—forfeiture:** Forfeiture and destruction are appropriate where the defendant retains infringing items and the court seeks to prevent infringing conduct. Conversely, as noted in the magistrate judge’s report in *Hounddog Productions, L.L.C. v. Empire Film Group, Inc.*, destruction may not be granted if the defendant has a “legitimate use of the items in question or where it is clear that the defendant will abide by the court’s order to cease infringing activity.” See § 12:11.4, at note 319.1.

**Copyright management information:** In *Friedman v. Live Nation Merchandise*, the Ninth Circuit reversed the grant of summary judgment where there was a triable issue of fact as to whether defendant distributed plaintiff’s photographs with the requisite knowledge that CMI had been removed; there is no need to show that defendant itself had intentionally removed the CMI. See § 14:2.3, at note 76.

**Criminal infringement:** The Eighth Circuit has ruled that section 506(a)(1)(A), covering “traditional” copyright infringement, is not unconstitutionally vague *(United States v. Frison).* See § 15:2.2, at note 10.

The *Table of Authorities* and the *Index* have been updated for this release.
FILING INSTRUCTIONS

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