

*Intellectual Property Library*

# **Copyright Litigation Handbook**

By Raymond J. Dowd  
Dunnington, Bartholow & Miller, LLP



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ISBN 978-0-314-62224-2

To Dan Marotta, the best lawyer I know.



## About the Author

**Raymond J. Dowd** is a partner in Dunnington Bartholow & Miller LLP, located in New York City. He is a member of DBM's corporate, intellectual property, litigation and arbitration, and art law practice groups. He has broad commercial litigation experience in both federal and state trial and appellate courts, representing both plaintiffs and defendants in copyright, trademark, domain name owners and content providers in litigation and arbitration. Representations include conducting bench and jury trials, arbitrations, and administrative proceedings, emergency applications for injunctive relief, quashing subpoenas, obtaining, enforcing, and collecting judgments. Trust and estates matters include contested probate proceedings through trial, disputes involving heirship and decedents' estates. International litigation includes conducting depositions in Canada, France and Switzerland, pursuing discovery through letters rogatory, obtaining service of process in foreign countries, obtaining and challenging foreign expert and legal opinions including cross-examination at trial.

Corporate counseling includes corporate and transactional work for entrepreneurial companies including international licensing. Counseling art owners and dealers includes transactional representation, UCC filings, tracking and recovering stolen art, handling disputes involving provenance, authenticity and theft. Trademark counseling includes registration, policing and enforcing rights of trademark owners and users. Counseling political candidates includes election day onsite monitoring, poll access challenges, signature challenges, and matters involving election law and political campaigns.

**Selected Lectures:** "Conflicts of Law in Art Disputes" Art Litigation and Dispute Resolution Institute, New York County Lawyers' Association (2008); "Murder, Mystery and Egon Schiele's Dead City: Swiss Laundering of Stolen Austrian Art" (Jewish Museum, Berlin Germany); "Fritz Grunbaum's Art Collection : Legal Obstacles to the Recovery of Stolen Art" (Prague Conference on Holocaust-Era Assets, Czech Republic); "U.S. Copyright Law for the Non-U.S.

Lawyer” (Montreal and Quebec City Canada and Berlin, Germany); “Copyright Litigation,” New York County Lawyers’ Association (2005) “International Copyright: Foreign Copyrights in U.S. Courts” New York County Lawyers’ Association (2008); “When Art Meets Commerce, What Happens?” Copyright Society of the U.S.A. (Boston, San Francisco and Philadelphia Chapters), Federal Bar Association (Connecticut, Minneapolis and New Orleans Chapters); “Nazi Art Looting” Federal Bar Association (Cleveland Chapter).

**Of Note:** Petitioned successfully for removal of the co-executors of American Tobacco heiress Doris Duke’s estate, upheld the first honorary pet trust challenged in New York history, obtaining a \$100,000 trust for heiress Doris Duke’s dogs.

**Memberships and Affiliations:** Federal Bar Association, Vice President for the Second Circuit (2008- ); Editorial Board, Federal Lawyer Magazine; President, Southern District of New York Chapter (2006-2008); Copyright Society of the U.S.A.; New York State Bar Association; Commercial and Federal Litigation Section; Intellectual Property law Section; New York County Lawyers’ Association; Board of Directors (2003 - 2006); Co-Chair, Entertainment Media, Intellectual Property and Sports Law Section (2000 - 2003); Continuing Legal Education Committee (2003 - 2008); National Arts Club.

**Bar Admissions:** New York (1993); U.S. District Court for the Southern and Eastern Districts of New York (1994); Northern U.S. Court of Appeals for the Second Circuit (1998); U.S. Supreme Court (2000); U.S. District Court for the Northern District of New York (2000); U.S. Tax Court (2007); U.S. Court of International Trade (2006).

**Education:** Manhattan College (B.A. International Studies 1986); Fordham University School of Law (J.D. 1991), Articles Editor, Fordham International Law Journal.

**Languages:** Fluent French (Certificate, Sorbonne Paris France 1985), Fluent Italian (Certificate, Centro Linguistico Dante Alighieri 1991).

## Acknowledgments

My clients, whose trust, support, and friendship make everything possible.

My friend Jacob Getz, who got me mixed up in all of this.

My editors at West publishing, Phil Dorsey and Molly McNulty, for their patient brand of tough love cheerleading that helped me put together this book during a period of intense litigation practice. I needed the drop-dead deadlines just as much as the adjournments. Ross Barron, a talented intern from New York Law School whose research and writing helped me through the home stretch and Professor Mariana Hogan for recruiting Ross.

Register of Copyright Marybeth Peters and the U.S. Copyright Office's legal expert Jule Sigall, for showing me around the office and helping me understand some of the difficulties facing litigators and judges who try to interpret the Copyright Act.

The leaders and members of the Copyright Society of the United States of America. The warm reception and the stimulating scholarship that I've been exposed to has been tremendously valuable. Special thanks to Amy Nickerson, Jay Kogan, Barry Slotnick, Helene Blue, Judith Bresler, Alan Hartnick, Howard Abrams, Corey Field, Noel Silverman, Nancy Wolff, and Bob Clarida. Professor Hugh Hansen has been a great friend for many years. Judi Finell, one of the nation's top musicologists, gave me a greater understanding of how experts can be used before a complaint is filed. Professor Carol Steinberg for the fine arts. Professor William Patry's copyright blog has been a delight throughout. Scott Bain of the Recording Industry Association of America for the jury instructions. Mary Minow for the copyright duration charts.

The leaders and members of the New York County Lawyers' Association and the Federal Bar Association. These two organizations have supported me through the years and helped me grow as a professional. Judge Stephen Crane and Barry Levy have been my mentors and role models. Steve Masur, Marty Novar and Olivera Medenica for their collaboration.

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My editors at the *New York Law Journal*, Steve Homan, Mike Paquette and Editor-in-Chief Kris Fischer for supporting me through the years.

The judges of the Second Circuit and the Southern and Eastern Districts of New York, whose brilliance has informed the nation's understanding of the Copyright Act, and whose patience I have tested on so many occasions. Judge Loretta Preska for the Nuts & Bolts of Copyright Litigation Continuing Legal Education program.

Finally, my many learned adversaries over the years. To learn chess, you must play the masters. I am grateful for the lessons and the many friendships that have resulted.

Special thanks to Michael Zussman, a student from New York Law School, for his help updating the 2007 edition.

Publisher and author gratefully acknowledge the contributions of Karen B. Tripp to the 2011 upkeep of this book



## **Preface to the First Edition**

This book was conceived during a copyright infringement trial before the Honorable Denny Chin in United States District Court, Southern District of New York. I realized at the time that much of the information I needed at my fingertips was scattered in different sources. Brilliant treatises have been written, but all too large to fit in a briefcase and carry into a courtroom for quick reference. This book began as an attempt to pull those scattered sources together and to provide practitioners with useful checklists.

While putting the book together, I realized that no book had been written for a litigator who knew nothing about copyright having to figure out the issues, and litigate a case. This work attempts to explain how to prepare and conduct a copyright litigation from beginning to end. I hope that specialists find it a handy complement to their existing libraries and that it will help nonspecialists to separate the forest from the trees.

I urge readers to contact me at [rdowd@dunnington.com](mailto:rdowd@dunnington.com) to point out my errors and omissions. Critical feedback will strengthen future editions.



## **Foreword**

### **Purpose of this work**

Copyright litigation has exploded in recent years. Many attorneys must confront litigation involving copyright with little or no experience involving the subject matter of copyright. This work is intended to assist those attorneys in investigating, pursuing, or defending a copyright litigation from the first client interview through judgment. It is also intended to be useful to the experienced practitioner wishing to consult a work organized around the Federal Rules of Civil Procedure. This work differs from available works on copyright by focusing on what a litigator will need at each stage of litigation in federal court involving copyright, with a particular focus on copyright infringement actions.

This reference is designed to be a handy volume kept at a practitioner's desk; to fit in a briefcase; or to be brought to court. It provides a trial lawyer's perspective of the laws and procedures with corresponding checklists and practice tips. Copyright office procedures described are only those most common for a litigator. The Copyright Act of 1976, 17 U.S.C.A. § 101 et seq. broadly preempts equivalent state law claims. Accordingly, this work's emphasis is on the Federal Rules of Civil Procedure, the Federal Rules of Evidence, and the issues related to choosing a forum such as removal and preemption. It is designed by and written for the civil, rather than the criminal, practitioner.

### **Scope and limitations of this work**

This work is intended as a simple and handy reference for an attorney encountering copyright issues in a litigation with a particular emphasis on federal practice and copyright infringement litigation. The checklists and practice tips are subjective assessments of information that have proved useful in the author's experience. Such checklists and practice tips are not intended to be exhaustive or to substitute for genuine independent legal research, nor may they be useful or appropriate in every situation. Excellent scholarly

treatises analyze the many facets of copyright in depth and should be consulted in the ordinary course of practice.<sup>1</sup> Constantly changing case law and statute mean that the practitioner must check case citations for new developments.

Each chapter is designed to help the litigator separate the forest from the trees in terms of focusing on the aspects of copyright law relevant to the tasks to be accomplished. Criminal aspects of copyright litigation are not covered. This work covers practice before a Copyright Arbitration Royalty Panel (“CARP”) and litigation practice in state courts only in passing.

**Overview of chapters**

Each chapter provides citations to relevant cases, statutes, and rules; and includes practice tips and practical examples.

Chapter 1.	Copyright Law: A Litigation Perspective
Chapter 2.	Copyrightable Matter
Chapter 3.	The Client Interview and Initial Investigation
Chapter 4.	The Copyright Office: Litigation Practice
Chapter 5.	Calculating Dates Prior To Commencing Litigation
Chapter 6.	Cease and Desist Letters and Declaratory Judgment Actions
Chapter 7.	Drafting the Infringement Complaint
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Chapter 15.	Evidence and Experts

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<sup>1</sup> See, e.g., Howard Abrams, *The Law of Copyright* (Thomson/West 2005).

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- Chapter 16. Jury Instructions
- Chapter 17. Damages and Profits
- Chapter 18. Costs and Attorney's Fees
- Appendices

### **Appendices**

The appendices include the three documents critical to the litigator: the Copyright Act, the Federal Rules of Civil Procedure, and the Federal Rules of Evidence.

### **Explosion of copyright issues**

With the advent of the internet and a software-driven economy, average citizens and their children have become worldwide creators, publishers and distributors of text, photographs, music, graphics, and software. Entering into license agreements involving intellectual property occurs on a daily basis in the most ordinary of consumer transactions. Copyright has emerged from an arcane practice of the intellectual property “boutique” law firm into everyone’s lives. The average consumer uses licensed intellectual property, including copyrighted materials, on a daily basis and may make thousands of reproductions of copyrighted works—often without permission of the author.

These technological changes carry tremendous social, political and legal implications. Overzealous enforcement and pushing the protections of copyright law are serious threats to personal liberties such as freedom of speech, creative expression, and documentary filmmaking. On the other hand, authors, artists, and programmers are threatened with becoming unpaid laborers whose creative works are being stolen without fair compensation. Courts and commentators agree on little, and eminent jurists express widely divergent views and philosophies on where the boundaries of property should end and creativity should begin.

As the late Supreme Court Justice William Brennan put it: “Although the Court pursues the laudable goal of protecting the ‘economic incentive to create and disseminate ideas’, . . . this zealous defense of the copyright owner’s prerogative will, I fear, stifle the broad dissemination of ideas and

information copyright is intended to nurture.”<sup>2</sup> The clash between ideas and expression is at the heart of copyright law. As the Supreme Court recently noted: “every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation and the moment of publication. . . . The First Amendment securely protects the freedom to make—or decline to make—one’s own speech; it bears less heavily when speakers assert the right to make other people’s speeches.”<sup>3</sup>

### **Copyright law moving forward**

New sources of information on developments in copyright law are sprouting up on the Internet. Gigalaw.com has a terrific daily update on developments in high-tech law.<sup>4</sup> Professor William Patry maintains The Patry Copyright Blog, an entertaining and erudite collection of observations on new developments in copyright law.<sup>5</sup> Professor Lawrence Lessig maintains a blog called the Lessig Blog.<sup>6</sup> The Chilling Effects web site is an excellent resource for persons receiving Cease and Desist letters who wish to know what their rights are or to see what companies have sent out cease-and-desist letters.<sup>7</sup> The Electronic Frontier Foundation maintains an excellent web site dedicated to free speech issues related to copyright and information regarding the latest litigation and legislative developments.<sup>8</sup>

Other exciting resources abound. The Columbia Law School Arthur W. Diamond Law Library Music Plagiarism Project provides hundreds of documents including texts, scores, audio, and video associated with music copyright infringe-

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<sup>2</sup> *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588, 11 Media. Rep. (BNA) 1969, 225 U.S.P.Q. 1073 (1985) at 2240 (Brennan, J., dissenting).

<sup>3</sup> *Eldred v. Ashcroft*, 537 U.S. 186, 123 S. Ct. 769, 154 L. Ed. 2d 683, 65 U.S.P.Q.2d 1225 (2003) at 220-221.

<sup>4</sup> <http://www.gigalaw.com/news/index.html>.

<sup>5</sup> <http://www.williampatry.blogspot.com/>.

<sup>6</sup> <http://www.lessig.org/blog/>.

<sup>7</sup> <http://www.chillingeffects.org/>.

<sup>8</sup> <http://www.eff.org/>.

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ment cases in the United States from 1845 forward.<sup>9</sup> Duke University Law School has produced an excellent introduction to copyright law from the point of view of documentary filmmakers wishing to understand what copyright protects; a discussion of the issues of fair use in copyright law and the extent of the public domain is found in a downloadable comic book titled “Tales from the Public Domain: Bound by Law?” on that site.<sup>10</sup> The Piet Zwart Institute has produced an excellent “A Guide to Open Content Licenses” authored by Lawrence Liang.<sup>11</sup>

In consulting any of these resources, it is important to understand that many come from a polemical point of view. The “copyleft” movement which has fostered use of the Creative Commons licenses and open source software now covers billions in assets. Little or no case law interprets issues covered by these licenses. “The Documentary Filmmakers’ Statement of Best Practices in Fair Use” published by American University’s Center for Social Media has attracted severe criticism from major film studios.<sup>12</sup> These are exciting times for those who care about access to and management of the fruits of mankind’s intellectual achievements. From Google’s announcement that it will copy every book in the world to Wikipedia’s communal pooling of human knowledge, our world of copyright has become the celestial jukebox Professor Paul Goldstein described so well in *Copyright’s Highway: From Gutenberg to the Celestial Jukebox*.<sup>13</sup>

Clearly, more and more copyright research and case law will be enhanced by the audiovisual experience, and trial lawyers will have to master the techniques of effectively using new technology to empower argumentation in legal briefs, in motion practice and oral argument, and in persuading juries. As the technology improves and the costs drop, the average litigator will be compelled to master techniques once reserved for high-priced consultants.

It is my sincere hope that this work proves useful in assisting the legal profession in meeting these challenges and in demystifying some of the challenges that copyright

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<sup>9</sup> <http://ccnmtl.columbia.edu/projects/law/library/entrance.html>.

<sup>10</sup> <http://www.law.duke.edu/cspd/comics/>.

<sup>11</sup> [http://pzwart.wdka.hro.nl/mdr/research/liang/open\\_content\\_guide](http://pzwart.wdka.hro.nl/mdr/research/liang/open_content_guide).

<sup>12</sup> [http://www.centerforsocialmedia.org/resources/fair\\_use/](http://www.centerforsocialmedia.org/resources/fair_use/).

<sup>13</sup> (Stanford University Press 1994).

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presents. Future editions will benefit from any suggestions. Please feel free to forward comments and criticism to [rdowd@dunnington.com](mailto:rdowd@dunnington.com).



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from the U.S. Department of Commerce, Patent & Trademark Office

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