

No. 16-

IN THE
Supreme Court of the United States

TCA TELEVISION CORP., HI NEIGHBOR,
DIANA ABBOTT COLTON,

Petitioners,

v.

KEVIN MCCOLLUM; BROADWAY GLOBAL
VENTURES; CMC; MORRIS BERCHARD; MARIANO
V. TOLENTINO JR.; STEPHANIE KRAMER; LAMS
PRODUCTIONS, INC.; DESIMONE/WINKLER;
JOAN RAFFE; JHETT TOLENTINO; TIMOTHY
LACZYNSKI; LILY FAN; AYAL MODOVNIK; JAM
THEATRICALS LTD.; ENSEMBLE STUDIO THEATRE
INC.; MCC THEATER; ROBERT ASKINS; HAND TO
GOD LLC; ABC COMPANIES,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

JONATHAN D. REICHMAN
JONATHAN W. THOMAS
ANDREWS KURTH KENYON LLP
One Broadway
New York, New York 10004
(212) 908-6256

LOUIS P. PETRICH*
LEOPOLD, PETRICH & SMITH, P.C.
2049 Century Park East, Suite 3110
Los Angeles, California 90067
(310) 277-3333
lpetrich@lpsla.com

Counsel for Petitioners

April 18, 2017

**Counsel of Record*

272467



COUNSEL PRESS

(800) 274-3321 • (800) 359-6859

QUESTION PRESENTED

The case concerns the effect of the renewal of the unitary copyright in a motion picture under the 1909 Act. Until the Opinion below, the Copyright Office policy adopted by the Second and Ninth Circuits, held that a motion picture was a unitary work that acquired a unitary copyright that included all material incorporated in it and first published by the publication of the movie. Failure to renew the movie copyright injected into the public domain all previously unpublished material. Timely renewal of the movie copyright renewed everything first published by the movie. The Opinion below held that such incorporated material could acquire copyright protection but would not be renewed by renewal of the movie copyright unless it was created specifically for the movie.

This case therefore presents the question, under the 1909 Act, whether material that was incorporated into, and first published by, a movie to become protected by the movie copyright is not protected by renewal of the movie copyright unless such material was created specifically for the movie.

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PARTIES TO THE PROCEEDINGS

The petitioners herein, plaintiffs/appellants below, are TCA Television Corp., Hi Neighbor, and Diana Abbott Colton (collectively “Petitioners”).

The respondents herein, defendants/appellees below, are Kevin McCollum, Broadway Global Ventures; CMC; Morris Berchard; Mariano V. Tolentino Jr., Stephanie Kramer; Lams Productions, Inc.; Desimone/Winkler; Joan Raffe; Jhett Tolentino; Timothy Laczynski; Lily Fan; Ayal Miodovnik; Jam Theatricals Ltd.; Ensemble Studio Theatre Inc.; MCC Theater; Robert Askins; Hand To God LLC; and ABC Companies (collectively “Respondents”).

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**CORPORATE DISCLOSURE
PURSUANT TO RULE 29.6**

Petitioner TCA Television Corp., a California corporation, hereby confirms that (i) it has no parent corporation, and (ii) no publicly held company owns ten percent (10%) or more of its stock.

Petitioner Hi Neighbor, a California general partnership, hereby confirms that (i) it has no parent corporation, and (ii) no publicly held company owns ten percent (10%) or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Petitioners respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Second Circuit.

OPINIONS BELOW

The Second Circuit's opinion is reported at 839 F.3d 162 and is reproduced at App. 3a-52a. The Second Circuit affirmed a judgment of dismissal by the Southern District of New York (Daniels, J.) The district court's opinion is reported at 151 F. Supp. 3d 419 and is reproduced at App. 53a-84a.

JURISDICTION

The jurisdiction of the district court was invoked under 28 U.S.C. § 1331 (general federal question jurisdiction) and § 1338(a) (infringement of a federal copyright). The United States Court of Appeals for the Second Circuit entered judgment on October 11, 2016, App. 1a-2a, and denied Petitioners' timely petition for a panel and/or *en banc* rehearing on December 20, 2016. App. 85a-86a. On March 7, 2017, Justice Ginsburg extended the time for filing this petition to and including April 19, 2017. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Sections 3, 5, 7, 9, 11 and 24 of the 1909 Copyright Act, 28 U.S.C. §§ 3, 5, 7, 9, 11 and 24 (repealed 1977) are reproduced at App. 87a-92a. Sections 102(a), 107, 201(d), 302(a) 304(a) & (b) and 501(a) of the 1976 Copyright Act,

28 U.S.C. §§ 102(a), 107, 201(d), 302(a) 304(a) & (b) and 501(a) are reproduced at App. 92a-98a.

INTRODUCTION

The Second Circuit's Opinion (App. 3a-52a) conflicts with decisions of the Supreme Court, prior Second and Ninth Circuit precedents, as well as established Copyright Office policy regarding the renewal of copyright in previously unpublished material that secured copyright protection before 1978 by its incorporation into a published motion picture. Until this case, under the 1909 Act, the first authorized publication of previously unpublished copyrightable material incorporated into a movie simultaneously extinguished any common law copyright protection and invested statutory or federal copyright protection in that material as part of a unitary copyright owned by the owner of the movie's copyright --- without regard to whether it was created specifically for inclusion in the movie. The Opinion below held for the first time that material incorporated into a movie and protected by a unitary movie copyright was not protected by that renewal copyright because it was not created specifically for inclusion into the movie. The Opinion thus raises a question of exceptional jurisprudential importance warranting review.

Prior decisions of the Second Circuit and of other Courts of Appeal, as well as a published Copyright Office decision (approved by the Second and Ninth Circuits) have held that under the 1909 Act¹, the first publication of

1. Copyright protection for a movie first published as late as 1963 and timely renewed will endure through 2058. Section 304(a)(1), App. 95a-98a.

unpublished material by its incorporation into a published movie (e.g., the Abbott and Costello Routine here) simultaneously extinguished any common law copyright protection and invested statutory or federal copyright protection in that material as part of a unitary copyright owned and controlled by the owner of the movie copyright. Prior decisions of Second and Ninth Circuits Courts of Appeal as well as Copyright Office policy adopted by the courts held that a renewal of a unitary movie copyright necessarily renews federal copyright in all previously unpublished material incorporated in it with the consent of the common law copyright owner, because the movie copyright (unlike the copyright in a composite work, such as a periodical) is a unitary copyright covering all material not previously protected by federal copyright. The Opinion departs from and conflicts with those precedents by creating a rule that such material is not renewed by the renewal of the movie copyright unless the material was created specifically for the movie. There is an overriding need for national uniformity in the interpretation of the effect of renewal on copyright interests in previously unpublished material published for the first time by incorporation into motion pictures under the 1909 Act.

STATEMENT OF THE CASE

1. *The Parties*. Petitioners are heirs or the companies of heirs of Bud Abbott and Lou Costello, the authors of the iconic “Who’s On First” comedy skit.

Respondents are the producers and investors in a Broadway play entitled “Hand To God,” (the “Play”). The Play quotes from the skit without license.

2. *The Facts.* Abbott and Costello were a popular mid-Twentieth Century comedy duo. One of their routines, commonly referred to as “Who’s on First?” (the “Routine”) was described by the Court of Appeals in the Opinion as “a treasured piece of American entertainment history.” 839 F.3d at 172, App. 5a. The Routine’s humor derives from Costello’s misunderstandings when Abbott announces the roster of a baseball team filled with such oddly named players as “Who,” “What,” and “I Don’t Know.” A rapid-fire exchange reveals that “Who’s on first” is not a question, but a statement of fact, *i.e.*, a player named “Who” is the first baseman, “What” is the second baseman, and a player named “I Don’t Know” is the third baseman.

Abbott and Costello first performed the Routine in the late 1930s, notably on a 1938 live radio broadcast of “The Kate Smith Hour.” App. 6a, 124a. Performance does not constitute “publication.” *Ferris v. Frohman*, 223 U.S. 424, 434-35 (1912). The Routine was first published for purposes of federal copyright law when Abbott and Costello performed a version of it in their first motion picture appearance, in *One Night in the Tropics* (“Tropics movie”), which movie was published. Their appearance in the 1940 Tropics movie was pursuant to a July 24, 1940 contract (the “July Agreement”) with Universal Pictures Company, Inc. (“UPC”) whereby they (“Artists”) granted to UPC:

the sole and exclusive right to photograph and/or otherwise reproduce any and all of their acts, poses, plays and appearances of any and all kinds during the term hereof, and ... further agree to furnish to [UPC] ... the material and

routines heretofore used and now owned by the Artists for use by [UPC] in the photoplay in which they appear hereunder and for which [UPC] shall have the exclusive motion picture rights....

App. 7a. On November 6, 1940, days before the public release of the Tropics movie, Abbott and Costello entered into a new agreement with UPC that terminated the July Agreement without prejudice to UPC's "ownership ... of all rights heretofore acquired," including those "in or to any... material furnished or supplied by the Artists." The Artists reserved the right to use materials and routines created by them (without the assistance of UPC writers) "on the radio and in personal appearances." App. 8a-9a.

In November of 1940, UPC registered a copyright for Tropics with the U.S. Copyright Office, which it timely renewed in December 1967. App. 9a, 126a: First Amended Complaint ("FAC") ¶ 44, Supp. Appx. 1. In 1945, Abbott and Costello performed an expanded version of the Routine incorporated into another movie for UPC, The Naughty Nineties ("Nineties"). That version maintains the core of the Routine – with "Who" on first base, "What" on second, and "I Don't Know" on third – but with additional players: left fielder "Why," center fielder "Because," pitcher "Tomorrow," catcher "Today," and shortstop "I Don't Care." App. 9a. In June 1945, UPC registered a copyright for Nineties with the U.S. Copyright Office, which UPC timely renewed in 1972. App.10a, Supp. Appx. 2, 5-6.

Lou Costello died in 1959; Bud Abbott died in 1974. App. 11a & n. 7.

On January 1, 1978, the Copyright Act of 1976, 17 U.S.C. §§ 101 *et seq.* (the “1976 Act”), became effective. Section 201(d)(1) provided that “ownership of a copyright may be transferred in whole or in part by means of conveyance ...” Section 201(d)(2) provided that any “of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately.” App. 94a.

By a Quitclaim agreement dated March 12, 1984 (the “Quitclaim”) with UPC’s successor-in-interest, Universal Pictures (“Universal”). Universal granted to Abbott & Costello Enterprises (“A & CE”), a partnership formed by the comedy team’s heirs, “any and all” of Universal’s rights, title and interest in the Routine, reserving to Universal the right to continue use of the Routine as recorded in the Tropics and Nineties. App. 11a-12a, Supp. Appx. SA7-9.² A & CE dissolved in 1992, with 50% of its assets transferred to Petitioner TCA Television Corporation, a California entity owned by Lou Costello’s heirs, and the other 50% divided evenly between Bud Abbott’s heirs, Vickie Abbott Wheeler and Bud Abbott, Jr. Wheeler later transferred her 25% interest to a California partnership, Petitioner Hi Neighbor, and Abbott Jr. transferred his 25% interest to Petitioner Diana Abbott Colton. FAC ¶¶ 49-52, App. 127a-128a.

2. Standing to sue in this case required Petitioners to allege that Respondents infringed “an exclusive right under a copyright” owned by Petitioners. 17 U.S.C. § 501(a). App. 98a. 3 M. & D. Nimmer, *Nimmer On Copyright*, §12.02[B][1] at 12-66.22 to 112-66.22(1) (2016)(“*Nimmer*”).

Petitioners' amended complaint described Respondents' Play as a "dark comedy about an introverted student in religious, small-town Texas who finds a creative outlet and a means of communication through a hand puppet, wh[ich] turns into his evil or devilish persona." After two successful off-Broadway runs, the Play opened to critical acclaim on Broadway in the spring of 2015. App. 12a. When Petitioners learned that the Play incorporated part of the Routine in one of its key scenes without license or permission, they sent Respondents a cease and desist letter, and thereafter filed a civil action on June 4, 2015 in the Southern District of New York. App. 12a, 17a. Petitioners' amended complaint alleged, among other things, an infringement of copyright in the Routine as first published in the Tropics movie. App. 118a-141a.

Respondents filed a motion under Fed. R. Civ. Proc. 12(b)(6) asserting that Petitioners did not hold a valid copyright in the Routine; that the Routine was in the public domain; and that the Play's use of the Routine was sufficiently transformative that the use was a "fair use" under 17 U.S.C. § 107. App. 17a.

The district court applied this Court's direction that to survive a motion to dismiss "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). The district court also referred to writings attached to the amended complaint or incorporated by reference including matters such as federal copyright registrations of which a district court may take judicial notice. App. 55a-56a.

The district court granted the Respondents' motion on December 17, 2015. App. 17a. The court held that Petitioners had sufficiently alleged that the Routine was protected by copyright and that Petitioners had standing to sue:

Because as much of the 1938 Routine as was disclosed in the motion picture was published when the motion picture was published, and because the law treats motion pictures as unitary works, the copyrights in *One Night [in the Tropics]* and *The Naughty Nineties* that UPC registered “merged” the Routine with the films. *See 16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 257-58 (2d Cir. 2015) (holding that because “[f]ilmmaking is a collaborative process typically involving artistic contributions from large numbers of people,” statutory copyright in the film itself could be undermined if “copyright subsisted separately in each of their contributions to the completed film” (citing *Richlin [v. Metro-Goldwyn-Mayer Pictures, Inc.]* 531 F.3d at 975 (“A motion picture is a work to which many contribute, however, those contributions ultimately merge to create a unitary whole.”))); *see also Garcia v. Google, Inc.*, 786 F.3d 733, 743 (9th Cir. 2015) (“Untangling the complex, difficult-to-access, and often thousands of standalone copyrights [in a film] is a task that could tie the distribution chain in knots.”). Thus, Plaintiffs have sufficiently alleged a continuous chain of title encompassing the Routine.

TCA Television Corp. v. McCollum, 151 F.Supp. 3d at 431; App. 70a. (bracketed material and emphasis added). Nevertheless, the district court granted the motion to dismiss on the ground that Respondents' use was a fair use, excused by section 107 of the 1976 Act. App. 70a-83a.

On appeal, the Court of Appeals for the Second Circuit affirmed the dismissal of the amended complaint but reversed the reasoning of the district court. The Court of Appeals determined that the use of the Routine in the Play was not "transformative" and not a fair use, App. 17a-39a, but that Petitioners lacked standing to sue because the copyright in the Routine as incorporated in the Tropics movie was not renewed by renewal of the movie copyright, and thus the Routine had fallen into the public domain on January 1, 1968. App. 39a-52a. Petitioners' petition for a panel and/or *en banc* rehearing was denied. App.85a-86a.

REASONS FOR GRANTING THE PETITION

I. THE SECOND CIRCUIT'S OPINION IS PLAINLY INCORRECT, CONFLICTS WITH SEVERAL DECISIONS OF VARIOUS COURTS OF APPEAL AND PRACTICES OF THE COPYRIGHT OFFICE, AND ANNOUNCES A NEW RULE TOO LATE FOR RIGHTS HOLDERS TO SATISFY- THUS RESULTING IN A FORFEITURE OF VALUABLE COPYRIGHT RIGHTS

The Opinion below dismissed the copyright infringement claim on the grounds that although the alleged use of the Routine by Respondents/Defendants' Play of the Routine was not a "fair use" under section 107, the amended complaint failed sufficiently to allege

that Petitioners had ownership of a valid copyright. By its Opinion, the Second Circuit announced a new rule of eligibility for copyright renewal under the 1909 Act, applied retroactively to a 1940 work – *i.e.*, that the previously unpublished material did not become part of the movie’s unitary copyright for renewal purposes unless it was created solely for the movie. Nothing in the 1909 Act supports such a judge-made rule. The Opinion directly conflicts with decisions of the Second and Ninth Circuit Courts of Appeals and by the Copyright Office, which conflict will encourage forum shopping and create confusion about the enforceability of unpublished works first published and incorporated into motion pictures between 1923 and 1977.³

More than most areas of copyright law, the question of duration and renewal requires an historical perspective. Successive lengthening of the period of protection leaves works subject to disparate terms, depending on when they were created in relation to the schemes later adopted during the period of their protection.

3 M. & D. Nimmer, *Nimmer On Copyright* (“*Nimmer*”), § 9.01 at 9-4 (2016).

3. Although the Copyright Renewal Act of 1992, amended 17 U.S.C. § 304(a)(1) & (2), automatically renews copyrights first “secured” from 1964 through 1977, the Opinion below begs the question as to what material in a movie is renewed and who owns those renewal rights; according to the Opinion, even an automatic renewal will leave for future litigation whether the movie’s renewal copyright covers some or all incorporated material. 1976 Act, as amended, §§ 304(a)(2)(A)(i) & (304)(a)(2)(B)(i). *See* 3 *Nimmer*, § 9.05[C][1][c].

**A. The Acquisition And Renewal Of Copyrights
In The “Routine” Were Governed By The
Copyright Act Of 1909**

This case involves both the 1909 and the 1976 Copyright Acts. Any acquisition and renewal of copyrights in so much of the Routine as was incorporated into the movies was governed by the 1909 Act. 17 U.S.C. §§ 3, 5, 7, 9, 11, and 24 (repealed 1977). *Stewart v. Abend*, 495 U.S. 207, 212 (1990). The duration of the movie copyright was governed initially by the 1909 Act which afforded protection for an initial 28 year term, and upon application for an additional 28 year term. 1909 Act, § 23 (renumbered § 24 when codified in 1947). App. 91a-92a. The 1976 Act, 17 U.S.C. §§ 304(a)(1) & (2) extended the terms of copyrights existing as of December 31, 1977 for an additional 39 years, for a total of 75 years. App. 95a-98a.

The 1976 Act abolished the renewal provision for works created after 1977 because it was:

(o)ne of the worst features of the present [1909 Act] copyright law

A substantial burden and expense, this unclear and highly technical requirement results in incalculable amounts of unproductive work. In a number of cases it is the cause of inadvertent and unjust loss of copyright.

H.R. Rep. No. 94-1476, 94th Cong., 2d sess. 134 (“H.R. Rep. 94-1476”) (1976); S. Rep. No. 94-473, 94th Cong., 1st sess. 117-118 (1975) (Bracketed material added).

The Copyright Renewal Act of 1992, amended 17 U.S.C. § 304(a)(1) & (2), automatically renews copyrights first “secured” in 1964 through 1977. Congress noted that

Because of its complexities, The Copyright Office, book and music publishers, authors, filmmakers and other copyright organizations criticized the registration renewal provision for being burdensome and unfair to thousands of copyright holders and heirs.

S. Rep. No. 102-194, 102d Cong. 1st Sess. 4 (1991).

In 1998, the Sonny Bono Copyright Term Extension Act extended every copyright still in its renewal term to afford “a copyright term of 95 years from the date copyright was originally secured.” 17 U.S.C. § 304(b). App. 98a.

B. Under The 1909 Act, A Federal Copyright Was Secured Either By Publication With A Notice Affixed Or By Registration; Unpublished, Unregistered Material First Published By Incorporation Into A Movie Obtained Copyright Protection Under the Movie Copyright.

Before the 1909 Act, federal copyright protection in the United States was obtained by registration or deposit in a U.S. District Court of the work before publication. H.R. Rep. No. 2222, 60th Cong. 2d Sess. at 10 (1909) (“H.R. Rep. No. 2222”).

Under the 1909 Act, works were initially protected by state-based common law until the work was “published” under authority of the author. 1 *Nimmer*, §4.01[B] at 4-5 to 4-7.

Under the 1909 Act, a work obtained federal protection either by registration with the Copyright Office or by publication with a copyright notice affixed. 1909 Act, §§ 9, 11. H.R. Rep. No. 2222, at 9-11.

Under that Act, if publication occurred without a copyright notice attached, the work was injected into the public domain. *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586, 591-92 (2d Cir. 1999); 1 *Nimmer*, § 4.01[B] at 4-5.

Works could obtain a 28 year renewal term if a renewal application was filed with the Copyright Office in the 28th year of the first term. By reason of the Copyright Renewal Act of 1992, existing copyrights first secured from 1964 through 1977 were automatically renewed. Pub. L. No. 102-307, 106 Stat. 264 (June 26, 1992). Thus, timely renewal was an important requirement for works whose copyright protection was “secured” between 1909 and 1963. If timely renewed, the 1976 Act provided copyright protection for a total of 95 years. 17 U.S.C. § 304(a) (1) & (2). App. 95a-98a.

1. The 1909 Act Renewal Provisions Applicable To “Contributions” To Periodicals Or Composite Works Are Different than Provisions Governing Material Incorporated Into and First Published By Movies

Respondents argued in the district court that the copyright life of the Routine in this case was governed by the provisions of the 1909 Act, section 23 as enacted (renumbered section 24 in the 1947 codification), which

created a separate rule for contributions, *e.g.*, articles or photos, “to a periodical or to a cyclopedic or other composite work.” The 1909 Act did not define “composite work” but Judge Learned Hand suggested that it referred to works “to which a number of authors have contributed distinguishable parts, which they have not however ‘separately registered.’” *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 699 (2d Cir. 1941). However, as discussed, *infra* at 20-21, a motion picture has never been treated as a “composite work” under the Act.

If an article or photograph was separately copyrighted by publication with notice and later published in a periodical or published work, the periodical’s “blanket” copyright notice gave notice that all of its contents were protected by copyright, but the contribution did not enlarge the copyright of the periodical. 1909 Act, § 3, App. 87a. By contrast, if the (unregistered) contribution was first published with the consent of its author in a periodical, the blanket copyright notice of the periodical was deemed to trigger federal copyright of its entire contents. *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 399-400 (2d Cir. 1970); *Abend v. MCA, Inc.*, 863 F.2d 1465, 1468-70 (9th Cir. 1988) (expressly following the Second Circuit in *Goodis*), *aff’d* on other grounds, *sub nom.*, *Stewart v. Abend*, 495 U.S. 207 (1990).

A blanket copyright notice in the name of the periodical’s name protected all contributions – not separately published beforehand with a notice affixed – and the periodical copyright would

protect all the copyrightable component parts of the work copyrighted, and all matter therein

in which copyright is already subsisting, but without extending the duration or scope of such copyright. The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if the part were individually copyrighted under this Act.

1909 Act, § 3; H.R. Rep. No. 1222, at 9-10.

Early decisions held that the contribution to a periodical would obtain copyright protection and would not be injected into the public domain only if the contributor either created the contribution as a work for hire for the publisher or assigned the entire common law copyright to the publisher so that the publisher was its owner at the time of publication. *See Goodis v. United Artists Television, Inc.*, 278 F. Supp. 122, 125 (S.D.N.Y. 1968). However, that rule – an extension of the judicially-created “indivisible copyright doctrine”⁴ – was abrogated on appeal by the Second Circuit Court of Appeals to provide copyright protection for the contribution so long as the publisher had *any* interest in the contribution’s copyright, such as periodical publication rights. *Goodis*, 425 F.2d at 400, reversing *Goodis*, 278 F. Supp. 122. The Ninth Circuit agreed in *Abend*, 863 F.2d at 1468-70, (expressly following the Second Circuit in *Goodis*), aff’d on other grounds, *sub nom.*, *Stewart v. Abend*, 495 U.S. 207 (1990).

4. The indivisible copyright doctrine holds that it is impossible to “assign” anything less than the totality of rights commanded by copyright. A transfer of anything less was considered to be a “license.” 3 *Nimmer*, § 10.01[A] at 10-5.

The rules for renewal of contributions to composite works have evolved since 1909. Section 23 of the 1909 Act as enacted (renumbered 24 in the 1947 codification), 3 *Nimmer*, § 9.03 at 9-9 n.6, gave publishers the “exclusive right to apply for the renewal term” because “the contributors to such a work might number hundreds and be scattered over the world, and it would be impossible for the proprietor of the work to secure their cooperation...” H.R. Rep. No. 2222, at 15. By the time the initial terms of copyright in post-1909 contributions were eligible for renewal, Congress was advised that periodicals were falling into the public domain because of a failure to renew the periodical’s copyright. In 1940, Congress amended section 23 (later renumbered 24) to allow the authors of the individual contributions themselves to seek renewal of their contributions apart from the entire periodical in which they first were published. *See* 3 *Nimmer*, § 9.03[B], at 9-17 to -23 & n. 67.14; B. Ringer, *Renewal of Copyright* (1960) reprinted as Copyright Law Revision Study No. 31, prepared for the Senate Committee on the Judiciary, 86th Cong., 2d Sess. 131-33, 148-49 (1961) (“*Ringer*”). Barbara Ringer (who later served as the Copyright Register) opined that the result of this amendment was to permit a renewal of a contribution by its author or by the publisher renewing the entire periodical. *Ringer*, at 148-49. The *Nimmer* treatise agrees. 3 *Nimmer*, § 9.03[B], at 21-22.

By reason of the 1940 amendment, the Ninth Circuit concluded that the copyright in such a contribution could be renewed either by the author of the contribution, *Abend v. MCA, Inc.*, 863 F.2d 1465, 1468-70 (9th Cir. 1988) (expressly following the Second Circuit in *Goodis*), aff’d on other grounds, *sub nom.*, *Stewart v. Abend*, 495 U.S.

207 (1990),⁵ or by the publisher of the entire periodical, *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 206 F.3d 1322, 1329 (9th Cir. 2000)⁶ (“In Abend [863 F.2d at 1468-70], we recognized that the 1940 amendment granted a new renewal right in individual authors of magazine contributions...however, .. this new right did not extinguish the pre-existing right in the magazine publisher.”). (Bracketed matter added).

In *Faulkner v. National Geographic Society*, 211 F. Supp. 2d 450, 464-66 (S.D.N.Y. 2002), relied upon by Respondents here,⁷ District Judge Kaplan interpreted the 1940 legislative history to limit the right to renewal of contributions for periodicals to the individual contributors. Thus, the *Faulkner* court rejected the contributor’s argument that just as the publisher’s blanket copyright notice on initial publication gave copyright protection to the contribution to the individual author’s benefit, so a renewal of the entire periodical by the publisher would renew the contribution for the benefit of the individual author. Instead, the district court treated the matter as an attempted renewal by the wrong party. It held that the publisher’s renewal of the entire periodical did not renew copyright of the individual contribution, or, if it did, the renewal belonged solely to the proprietor and not the contributor. Of course, even that alternative holding

5. This writer argued on behalf of defendants in the Ninth Circuit and on behalf of petitioners in this Court.

6. This writer argued on behalf of plaintiff in the Ninth Circuit.

7. The Opinion below draws an analogy between the efficacy of the movie company’s renewal here and the renewal of the collective work by the publisher in *Faulkner*. App. 41a.

could not prevent the proprietor from assigning sufficient exclusive rights to the contributor, as Universal did here to Petitioners predecessors in interest, so it could sue in its name. App. 11a-11b; 1976 Act, §§ 201(d), 501(a), App. 94a, 98a. On reconsideration, the *Faulkner* court refined its holding to prevent a publisher from effectively renewing copyright in an individual contribution to the periodical where “the proprietor of the collective work never had any ownership interest in the individual contributions in the first place.”⁸ *Faulkner v. National Geographic Society*, 220 F. Supp. 2d 237, 240 (S.D.N.Y. 2002).⁹

8. Section 201(c) of the 1976 Act (not applicable here) effected a change from the 1909 Act by expressly stating that contributions to a “collective work” would be considered to have copyrights separate and apart from the periodical in which they were published. H.R. Rep. No. 94-1476, at 123. This is so because under the 1976 Act a work is invested with a federal copyright as soon as it is fixed in a tangible medium of expression, section 102(a), whether or not published – whereas, under the 1909 Act, many contributions to periodicals first acquired federal copyright protection precisely because they were published in the periodical with the consent of the author.

9. *Faulkner* purported to rely in the decision in *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 206 F.3d 1322, 1329 (9th Cir. 2000) to support a rule that if the publisher initially obtained an assignment of common law copyright in the contribution, only the publisher could renew. However, the Ninth Circuit ruled that the publisher’s ownership of some interest in the contribution at the time of renewal was sufficient to give it a renewal right. It also construed the 1940 amendment to section 24 to grant “a new renewal right in individual authors” while acknowledging that “this new right did not extinguish the pre-existing right in the magazine publisher.” As Barbara Ringer (later the Copyright Register) had reported to Congress in 1960, *Ringer*, at 148, so long as a publisher still

Faulkner concluded that “[s]ection 24 gave the right to renew as to a particular contribution either to the proprietor (assuming it had obtained an initial interest in the contribution ... or the author, but not both.” *Faulkner* rejected a real-world practice where the owner of a contribution could grant the publisher some rights (e.g., magazine publication rights) in the copyright but reserve other interests in the copyright. See *Goodis*, *supra*, *Abend*, *supra*. Obviously, the *Faulkner* decision represented a resurrection of the indivisible copyright theory, repurposed to forfeit copyright protection for contributions at the time of renewal. The *Faulkner* court acknowledged – as required by the Second Circuit’s precedent in *Goodis* -- that the publisher had a sufficient copyright interest in the contribution so that the publisher’s blanket copyright conferred initial copyright protection on the contribution. 211 F. Supp. 2d 465-66. The *Faulkner* decision does not explain whether or how the publisher lost all copyright interests in the contribution over time. Instead, *Faulkner* represents a regressive reliance on the indivisible copyright doctrine, rejected by the Second Circuit in *Goodis*, and by the Ninth Circuit in *Abend*.¹⁰ It

owned any interest in the contribution at the time of renewal, that publisher could renew the contribution.

10. Earlier that year, Judge Kaplan decided another case where, Ward, an independent contractor contributed stories and photos to the National Geographic magazine which were covered by the magazine’s blanket copyright notice. Ward did not register any of these works during their initial copyright terms but did obtain renewal registrations for the pre-1978 works which the magazine challenged, claiming the works were made for hire. Judge Kaplan found a triable issue regarding the work for hire status of the contributions and noted that as to the contributions if the author “granted NGS only the right of first publication, then

seems fair to conclude that the 1940 Congress was acting to afford additional means to assure that copyrights would be renewed, not to devise traps to forfeit copyrights.

Although the Second Circuit's erroneous Opinion below carefully avoided relying on the holding in *Faulkner* to explain its new rule regarding renewals of unitary copyrights in movies, it cited *Faulkner* to support an equivalence between a collective work and a movie. App. 41a. It applied the mistaken rationale of *Faulkner*, even though a movie is not a "composite" work and not subject to the special statutory and case law applicable to periodicals and other composite works. In this case, the Second Circuit has applied a ghost of the indivisible copyright doctrine.

2. A Different Rule Has Governed The Renewal Of Material First Published By Incorporation Into Motion Picture Works Because A Movie Is Treated As A Unitary Work

Motion pictures were never designated or treated as composite or periodical works under the 1909 Act. *See Husbands*, Copyright Office Board of Appeals Letter, Control No. 10-600-754-2(C), 5/14/2002, App. 105a-108a. (Exhibit 1 to Plaintiffs' Memorandum of Law In Opposition to Defendants' Motion To Dismiss, DI #61) (reproduced as App. F). Section 5 of the 1909 Act, as enacted, described "composite and cyclopaedic works" and "Periodicals" as classes of works which could claim

the *Goodis* rule may shelter him." *Ward v. National Geographic Society*, 208 F. Supp. 2d 429, 448 & n. 119 (S.D.N.Y. 2002).

copyright, but did not provide for “motion pictures.” App. 84a-85a. In 1912, Congress amended section 5 (l) and (m) to add “motion picture photoplays” and “motion pictures other than photoplays” as separate classes of works. 37 Stat. 488 (1912) (App. 90a-91a), later codified as 17 U.S.C. § 5 (repealed 1977).

If a contribution (*e.g.*, a play, or musical work), was separately copyrighted before incorporation into a motion picture, that earlier work retained its separate copyright protection even if the derivative work motion picture copyright fell into the public domain for failure of renewal. *Russell v. Price*, 612 F.2d 1123, 1128-29 (9th Cir. 1979) (failure to renew the copyright in the movie adaptation of the play Pygmalion did not put underlying play into the public domain because the play held a pre-existing and separate federal copyright); *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469, 471-72 (2d Cir. 1951) (failure to renew the copyright in a derivative work Play did not put the underlying but separately registered novel into the public domain). This Court approved these holdings in *Stewart v. Abend*, 495 U.S. 207, 235 (1990).

If an (unregistered) contribution was first published with the consent of its author in a motion picture, the publication of the movie was deemed to divest the contribution of its common law copyright¹¹ and the blanket

11. Curiously, the Opinion below notes that because “both parties seemingly concede that the Routine was protected from entering the public domain through at least *Tropics’s* initial copyright term, we need not determine whether *Tropics’s* publication automatically divested Abbott & Costello of their common law copyright and injected it into the public domain.” App. 40a & n.15. The suggestion puts the Opinion in conflict with

copyright notice of the motion picture was deemed to afford federal copyright to its entire contents, including any previously uncopyrighted material. 2 *Nimmer*, § 7.12[C][1], at 7-94 & n. 31; 1909 Act, §§ 3, 9. App. 87a, 89a. If at the time for renewal the proprietor of the motion picture copyright failed to renew, then all previously uncopyrighted contributions which had been incorporated into the motion picture were deemed to be injected into the public domain for a failure to renew copyright. *Classic Film Museum, Inc. v. Warner Bros., Inc.*, 597 F.2d 13, 14 (1st Cir. 1979) (failure to renew copyright in film A Star Is Born put the film and incorporated screenplay into the public domain); *Harris Custom Builders, Inc. v. Hoffmeyer*, 92 F.3d 517, 520 (7th Cir. 1996) (publication of previously unpublished and unregistered blueprint plans in a brochure which was published without proper notice put both the brochure and the blueprint plans into the public domain); *Batjac Prods., Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223, 1233-36 (9th Cir. 1998) (failure to renew copyright in film McClintock, put both the film and the incorporated parts of the screenplay into the public domain); *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586, 589-592 (2d Cir. 1999) (failure to

the major circuit decisions on point, including *Goodis* and *Abend*, supra. The Opinion cites *Roy Export Co. Establishment of Vaduz, Liechtenstein v. Columbia Broad. Sys. Inc.*, 672 F.2d 1095, 1101-04 (2d Cir. 1982) in support of its statement. But *Roy* only held that the inclusion of film clips into a “collective work” of clips *id.* at 1102, did not have to be treated as an “investive” publication to protect the film clips because the collective work was only “performed” (i.e., broadcast) and not “published,” *i.e.*, it was not divestive of the film clips’ common law protection. *Roy* is inapt here as there can be no doubt that the Tropics and Naughty Nineties movies were “published.” Supp. Appx. SA1-SA6.

renew copyright in the film Little Shop of Horrors injected into public domain so much of previously unpublished screenplay as was incorporated into the film).

The Copyright Office has maintained that under the 1909 Act contributors to a motion picture of previously uncopyrighted and unpublished material, such as a script, musical score, or other contributions by the “producer, director, camera operator, editor, screenplay writer, and other individuals” have no separate right to renew the copyright in those contributions – because movies are not periodicals or composite works. In *Husbands*, the Copyright Office affirmed its refusal to register a renewal claim by the heirs of the author of a screenplay that had been merged into the movie “Husbands”. The Office explained that it registered a renewal of the movie copyright but would not issue a separate renewal registration for the screenplay because it considered a motion picture to be a unified work of authorship for purposes of registration under the 1909 law. *Husbands* noted that the Office’s Compendium I (1973) describes a motion picture as

“ordinarily ... embod[y]ing a large number of contributions, including those of the author of the story, author of the screenplay, director, editor, cameraman, individual producer, etc.”
... In its administration of the 1909 Copyright Act, the Copyright Office did not consider the authorship of a motion picture to be a composite work, *i.e.*, a work consisting of distinct and separable contributions which do not merge into a unitary whole.

App. 106a. Id. at 107a, 110a. The Office noted that prior to publication of the “*Husbands*” movie, it was possible for the “Husbands” screenplay to have acquired a separate federal copyright by the act of registration. But because that did not occur

the Office, viewing the motion picture as an integrated entity, cannot now insert into the public record a claim to renewal rights owned by a party different than the owner of record of the rights in the integrated entity, *i.e.*, in the motion picture as a whole.

App. 111a. So it is here. No part of the Routine was published or registered before a portion of it was performed and embedded into the 1940 Tropics movie.¹² Abbott and Costello had no standing to renew a copyright in their embedded Routine; the renewal of the movie copyright renewed the integrated whole. As the *Husbands*’ decision confirmed, no renewal of the Routine separate from the renewal of the entire movie copyright would have been permitted. Neither the *Husbands* decision nor the copyright registration and renewal policy it states makes the distinction – made by the Opinion below -- as to whether contributions were or were not created expressly for the movie in which they were first published.

The Copyright Office’s position that a movie is an integrated whole has been adopted by the Second and Ninth Circuit Courts of Appeals. In *Richlin v. Metro-*

12. The same principle applies to the “new matter” added to that portion of the Routine first published in the 1945 movie *The Naughty Nineties*.

Goldwyn-Mayer Pictures, Inc., 531 F.3d 962, 972-73 (9th Cir. 2008), the Ninth Circuit Court of Appeals held that renewal of the copyright for the movie The Pink Panther also renewed copyright for so much of the previously unpublished treatment and screenplay as was incorporated into the movie. The *Richlin* court relied on the Copyright Office's *Husbands*' opinion to reinforce the notion of a unified copyright. In *Garcia v. Google, Inc.*, 786 F.3d 733, 741 (9th Cir. 2015) (*en banc*), the Court of Appeals approved the Copyright Office's refusal to register a claim of copyright for an actor's performance in a movie because "[f]or copyright registration purposes, a motion picture is a single integrated work...".

In *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 257-58 (2d Cir. 2015), the Court of Appeal found "persuasive" the Copyright Office's analysis that an individual who "intend[s] her contribution or performance to be 'merged into inseparable or interdependent parts of a unitary whole...may assert a claim in joint authorship in the motion picture, but no sole authorship of her performance in a portion of the work.'").

The Second Circuit's Opinion below, explained, App. 48a-49a, that it rejected Petitioners' allegations that the movie company's renewal of the movie copyright protected so much of the Routine as was incorporated into the Tropics film, because the Routine could have been *separately published with notice* or registered before its incorporation into the Tropics movie.

[A]s this court recently observed, "authors of *freestanding* works that are incorporated into a film... may copyright these `separate

and independent works.” 16 Casa Duse, LLC v. Merkin, 791 F.3d 247, 259 (2d Cir. 2015) (emphasis added) (quoting 17 U.S.C. § 101); see *id.* at 257 (noting that separate copyright may be necessary where motion picture incorporates “separate, freestanding pieces that independently constitute “works of authorship.”). Who’s on First? was such a freestanding work within *Tropics*. As already noted, plaintiffs acknowledged in the amended complaint that the Routine (1) was prepared and existed on its own for some years before it was performed in *Tropics*, see Am. Compl. ¶ 32; and (2) was performed independently from the films “thousands of times” on the radio and elsewhere, see *id.* at ¶ ¶ 34-35; see also J.A. 129 (stating in November Agreement that “Artists reserve the right to use on the radio and in personal appearances” all preexisting routines). The Quitclaim representation that plaintiffs’ predecessors-in-interest still owned the Routine’s copyright in 1984 is also at odds with the argument that the Routine had so merged with *Tropics* as to admit a single copyright owned by UPC.

Except for its confirmation that the constituent parts of a movie are covered by a unitary copyright, the Opinion’s reliance on the *Casa Duse* decision is inapt here. The *Casa Duse* decision concerned post-1977 works whose copyright was governed by the 1976 Act, which made “original works of authorship fixed in any tangible medium of expression” immediately protected by a separate federal copyright, without regard to publication. 17 U.S.C. § 102(a). This

was a monumental change from the 1909 Act's reliance on "publication" as the trigger to attach federal copyright protection. 1 *Nimmer*, § 4.01, at 4-2 to -3 ("The concept of publication was of immense importance under the 1909 Act...due largely to the American dichotomy between common law and statutory copyright, wherein the act of publication constituted the dividing line between the two systems of protection." (citations omitted)). Thus, the material in *Casa Duse* was not just able to be separately copyrighted; by operation of law under the 1976 Act, it was protected by statutory copyright as soon as it was fixed in a tangible medium of expression. That would be analogous to a situation under the 1909 Act where the contribution to a movie had obtained federal copyright (by registration or publication with notice affixed) before its incorporation into a movie. *See, e.g., G. Ricordi, and Russell v. Price, supra.* The *Casa Duse* decision did not opine as to how contributions in a film were to be renewed because *Casa Duse* involved works created after 1977 and thus entitled only to a single term of copyright. 17 U.S.C. § 302, App. 95a. *Casa Duse* involved an ownership dispute between the financier/producer and the film's director, and posed a different question of first impression:

May a contributor to a creative work whose contributions are inseparable from, and integrated into the work maintain a copyright interest in his or her contributions alone? We conclude that, at least on the facts of the present case, he or she may not.

791 F.3d at 254. The *Casa Duse* Court agreed with the reasoning of the recent *en banc* decision of the Ninth Circuit in *Garcia v. Google, supra*, in concluding that the

defendant film director did not obtain and does not possess a separate copyright in his directorial contributions to the finished film because a motion picture is a unitary work. 791 F.3d at 258-59. Neither *Casa Duse* nor the precedents of this Court, the Copyright Office or the Courts of Appeal support the new rule announced by the Second Circuit's Opinion below.

Although Abbott and Costello's Routine was protected by common law copyright while being performed (not published) on radio, when the time came to publish some portion of it, the authors elected to perform it themselves in the 1940 Tropics movie and to have that performance and the underlying text merged into the movie for its first publication. The fact that the Routine was incorporated into the movie made it inseparable and integrated. The initial unitary copyright for the 1940 Tropics movie governed and protected that contribution; nothing changed throughout that contribution's copyright life in the 1940 Tropics movie to require that contribution to be renewed separately by Abbott and Costello or their heirs. The Second Circuit's Opinion has simply attempted to import the *Faulkner* decision's invocation of the indivisible copyright doctrine¹³ to defeat renewals of copyright in contributions to periodicals to the unitary copyright created for pre-1978 movies.

Notwithstanding the Opinion's suggestion, that the "performance" of the Routine should matter, under the

13. This is even odder because section 201(d)(1)(a) of the 1976 Act was intended to put to rest the "indivisible copyright doctrine" which had been judicially modified before then. H.R. Rept. No. 94-1476, 94th Cong. 2d Sess. at 122. 3 *Nimmer*, § 10.02[A], at 10-19.

1909 Act, no matter how often the unpublished Routine might have been “performed” in a play¹⁴, on radio¹⁵ or otherwise, it was not published¹⁶ so as to divest it of common law copyright or to invest it with federal copyright protection.

The Opinion rejects Petitioners’ reliance on the *Richlin* decision as follows:

As for *Richlin*, the Ninth Circuit did not there hold, as plaintiffs contend, that an author is “not entitled to an independent copyright by reason of inclusion of his [story] treatment’s material in [a] motion picture.” Appellants’ Reply Br. 27-28 (emphasis in original). Rather, the court there assumed that plaintiffs’ story treatment was independently copyrightable when it held that plaintiffs had “failed to secure a federal copyright for it.” *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.*, 531 F.3d at 976.

App. 49a-50a. The Opinion below misapprehends the difference between a treatment¹⁷ that could have been separately copyrighted before it is incorporated into a

14. *Ferris v. Frohman*, 223 U.S. 242, 424, 435-36 (1912).

15. *Silverman v. CBS, Inc.*, 632 F.Supp. 1344, 1350, 1353-54 (S.D.N.Y 1980), aff’d in part, vacated in part, 870 F.2d 40 (2d Cir. 1989).

16. 1 *Nimmer*, § 4.08, at 4-46.2 to 4-49.

17. A “treatment” is a brief outline in prose describing the actions of a movie plot, indicating characters with little or no dialogue. See *Richlin*, 531 F. 3d at 964n. 1.

movie, as distinguished from a portion of a treatment that actually was first published in a movie, thereby extinguishing common law protection for that portion in return for federal copyright protection. Relying expressly and at length on the Copyright Office's ruling in *Husbands* that an author of a contribution to a Movie could not separately renew the portion first published in that movie, the *Richlin* Court explained:

Because [the Treatment] was never invested with statutory copyright protection, there was no right to renew and, therefore, no renewal right to revert to the Richlin heirs.

Indeed, the Copyright Office has rejected the Richlin heirs' theory that previously unpublished components of a motion picture receive independent statutory protection by virtue of incorporation into a motion picture.

531 F.3d at 974-75. The statement in the Opinion below that *Richlin* acknowledged that the treatment could have obtained a separate statutory copyright before it was embedded into the Movie misses the point. Of course, if that treatment or the Routine obtained separate statutory copyrights before they were incorporated into the Movie, they could be separately renewed. The Opinion, App. 50a, does not contradict Petitioners' interpretation:

Thus, the [*Richlin*] court acknowledged that "publication of a motion picture with notice secures federal copyright protection for all of its component parts," but observed "that does not mean that the component parts necessarily

each secure an independent federal statutory copyright.” *Id.* at 975-76. The movie’s publication protected so much of the treatment as was disclosed therein, but it “did not constitute publication of the Treatment ‘as such’ – i.e., as a work standing alone.” *Id.* at 973.

Richlin approved the *Husbands* approach by the Copyright Office and explained that so much of the treatment as was first published in the Pink Panther movie was merged into the unitary movie copyright, and for that reason the authors of the *Richlin* treatment had no copyrightable interest in that incorporated segment.

The publication of a portion of the treatment in the Pink Panther movie did not constitute publication of the entire treatment “as such.” For the same reason, publication of that part of the Routine selected for publication in the 1940 Tropics and 1945 Naughty Nineties movies did not constitute publication of the entire Routine “as such.” But the publication did invest the incorporated portion of the Routine with statutory protections as part of the unitary movie copyright.

The Opinion below attempts, at 60, App. 48a, to distinguish *Richlin* on the ground that the authors of the *Richlin* treatment “clearly intended” that the treatment “be merged into inseparable or interdependent parts of a unitary whole.” So did Abbott and Costello intend merger when they authorized the first publication of that part of their Routine incorporated into the movie – otherwise their permission to put the Routine in a movie would have injected it into the public domain. It is the intent *to publish* without injecting a work into the public domain

that is determinative. In fact, in *Goodis*, the Second Circuit explained why the “indivisible copyright doctrine” should not be employed to forfeit copyright protection of the contributor to a periodical in precisely these terms:

We unanimously conclude that where a magazine has purchased the right of first publication under circumstances which show that the author has no intention to donate his work to the public, copyright notice in the magazine’s name is sufficient to obtain a valid copyright on behalf of the beneficial owner, the author or proprietor.

425 F. 2d at 399. In rejecting the argument that the indivisibility doctrine required a different result, the Second Circuit in *Goodis* wrote:

We are convinced, however, that the doctrine of indivisibility of copyright is a judge-made rule which relates primarily to the requisite interest needed to bring an infringement action....

....

We are loath to bring about the unnecessarily harsh result of thrusting the author’s product into the public domain when, as here, everyone interested in “Dark Passage” could see Curtis’ [the publisher’s] copyright notice and could not have believed there was any intention by *Goodis* to surrender the fruits of his labor.

Id., at 400. The *Goodis* court explained that the shift from obtaining copyright by registration – before 1909 – to obtaining copyright thereafter by publication with notice could “too often provide a trap for the unwary author who had assumed the publisher would attend to copyrighting the work in his behalf.” 425 F. 2d at 402.

Where the question is the interest needed to obtain copyright, we reiterate that the important considerations are the intention of the parties to obtain copyright and the adequacy of notice to the public; the characterization of the publisher as assignee or licensee is secondary.

Id., at 403. As noted *supra*, at 14-16, the Ninth Circuit agreed: *Abend v. MCA, Inc.*, 863 F.2d 1465, 1468-70 (9th Cir. 1988) (expressly following the Second Circuit in *Goodis*), *aff’d* on other grounds, *sub nom.*, *Stewart v. Abend*, 495 U.S. 207 (1990). The short story in the *Abend* case obtained its federal copyright protection even though the author gave the magazine publisher “the rights to magazine publication of the story and [the author] retained all other rights.” 495 U.S. at 211. The magazine’s blanket copyright invested the story with copyright protection.

The fact that Abbott and Costello reserved the right by contract to continue performing parts of their Routine outside of the movie does not change the fact that the Routine was first published and given federal copyright protection in the movie. There is no authority for the Opinion’s assumption that, because a pre-1978 work was “performed” before it was first published in a movie, it is injected into the public domain when the movie company alone renews the copyright in the unitary copyright.

The Second Circuit's new rule excluding renewal of the copyright in the Routine because the Routine was not originated for use in the movie is unprincipled and not supported by any provision of the 1909 Act or case law or copyright policy.

II. THE QUESTION PRESENTED IS CRITICALLY IMPORTANT TO THE HOLDERS OF RIGHTS IN COPYRIGHTABLE MATERIAL FIRST PUBLISHED AND INCORPORATED INTO A MOTION PICTURE BETWEEN 1923 AND 1963, AN IMPORTANT QUESTION OF FEDERAL LAW THAT HAS NOT BEEN, BUT SHOULD BE, SETTLED BY THIS COURT

The new rule propounded by the Opinion below retroactively – that the authors of unpublished material first published in a motion picture must file separate renewal applications for renewal copyrights for works which first secured copyright protection between 1923 and 1963 – creates an unprincipled exception to the “unified copyright” theory of the Copyright Office, as adopted by the Ninth Circuit Court of Appeals and a prior Second Circuit opinion. It announced this new rule at a time when the holders of such rights can no longer comply. The Opinion's ruling is expressly based on a decision that does not involve a pre-1978 work and thus did not involve the issue of renewal. Instead, the Opinion seems to import the rationale of the *Faulkner* decision that is based on rules regarding the renewal of copyrights in periodicals, not contributions to movies.

CONCLUSION

The 1909 Act moved from a system where federal copyright protection was initiated by registration, to a less cumbersome system where protection was triggered by “publication” with notice. Because of the vagaries of the term “publication,” the 1976 Act shifted the moment of protection to creation, “fixation in a tangible medium of expression.” In 1976 and again in 1989 copyright duration was extended. In the Copyright Renewal Act of 1992, renewal was made automatic to avoid forfeitures. All of these changes were intended to encourage and protect new works to entertain, to educate and to inform. Unlike the Opinion below, they were intended to remove traps for the unwary and to avoid forfeitures.

The Petition for a writ of certiorari should be granted.

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Respectfully submitted,

JONATHAN D. REICHMAN	LOUIS P. PETRICH*
JONATHAN W. THOMAS	LEOPOLD, PETRICH & SMITH, P.C.
ANDREWS KURTH KENYON LLP	2049 Century Park East,
One Broadway	Suite 3110
New York, New York 10004	Los Angeles, California 90067
(212) 908-6256	(310) 277-3333
	lpetrich@lpsla.com

Counsel for Petitioners

**Counsel of Record*