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Successfully Defending Copyright Infringement Suits

**David J. Meiselman
and Jeffrey I. Carton**

**MEISELMAN, DENLEA, PACKMAN,
CARTON & EBERZ P.C.**

The successful defense of a copyright infringement suit is part art, and part science. With the rapid proliferation of mobile devices and Internet sites capable of distributing original, artistic content, the likelihood that creative, for-profit entertainment endeavors will be challenged as allegedly owing their origins to others is occurring with alarming frequency. While the legal standards which govern copyright infringement suits are well settled, the application of those standards to the facts of a particular dispute often requires as much creativity as the underlying, competing works themselves. The lawyer defending a copyright infringement suit must become a master of the art or field in which the two works compete (e.g. film, music, literature, or television) and marshal compelling evidence from which to establish that the similarities between the works at issue do not represent unlawful copying but, rather, the expression of facts and ideas over which no one has a monopoly. This article summarizes several of the most recent, notable decisions in the



David J. Meiselman and Jeffrey I. Carton

David J. Meiselman and Jeffrey I. Carton are Senior Litigation Partners in the White Plains firm of Meiselman, Denlea, Packman, Carton & Ebertz P.C. Christine M. Ford helped contribute to this article. The firm represents plaintiffs and defendants in state and federal courts throughout the country. Messrs. Meiselman and Carton have been selected by their peers for inclusion in "Best Lawyers" and "Super Lawyers" and were noted in 2008 to be amongst the top 25 New York Metro area attorneys in the Westchester area of Business Law.

copyright infringement arena and the lessons to be learned for the successful defense of such claims.

The U.S. Copyright Act was originally enacted in 1790 to protect the writings of authors.¹ Changing technology has led to an expansive interpretation of "writings" and now, in addition to literary works, the Copyright Act also protects motion pictures and other dramatic, musical and choreographic works, as well as graphic arts, architectural design, software and other forms of creative expression. Under the Copyright Act, a copyright holder is granted "five fundamen-

tal rights" – the exclusive rights of reproduction, adaptation, publication, performance and display. These fundamental rights can be significant assets.

To prevail on a claim of copyright infringement, a plaintiff must establish (1) a valid copyright, (2) unauthorized copying of the copyrighted work, and (3) that the infringing work is substantially similar to the protected work. The first prong of the test is presumptively established by registration with the Copyright Office and the second element is often not challenged. The dispute in copyright infringement cases frequently

Please email the authors at dmeiselman@mdpcelaw.com or jcarton@mdpcelaw.com with questions about this article.

centers on the third element – whether the infringing work is substantially similar. Substantial similarity has both qualitative and quantitative aspects. Thus, to prove substantial similarity, a plaintiff must show that the copied work was “protected expression” and that the amount copied was “more than *de minimis*.”²

Not all expression is protected under copyright law. Unprotected elements of a work include facts and ideas as distinguished from the particular expression of such facts and ideas. Although this distinction can be elusive, one court recently explained “the nub is that an author must use creativity to transform facts and ideas into an expression that displays the stamp of an author’s originality.”³ For example, under the doctrine of *scènes à faire*, expressions that are stock, standard, or commonplace in a particular genre are not considered protected expression. When similar works resemble each other only in unprotected aspects, the alleged infringer will prevail in a copyright action.

To prove substantial similarity, a plaintiff must also satisfy a quantitative threshold and show that the copying was more than trivial. The legal doctrine of *de minimis non curat lex* – the law does not concern itself with trifles – applies in the copyright context. Courts therefore examine the extent to which a copyrighted work is copied in the infringing work to determine whether there is substantial similarity.

The United States Court of Appeals for the Seventh Circuit recently applied these principles in a copyright infringement action against New Line Cinemas, the producer of the popular Denzel Washington movie *John Q*.⁴ In *John Q*, Denzel Washington plays John Quincy Archibald, a hard working factory laborer whose son tragically collapses from a heart disorder requiring a transplant. Unfortunately, John’s health insurance does not cover his son’s transplant and the hospital refuses to perform the surgery. The desperate father takes everyone in the hospital emergency waiting room hostage in an effort to force the hospital to perform the lifesaving surgery. At the movie’s climax, John turns his gun on himself in an effort to give his own heart to his son. However, the authorities apprehend John before he can shoot himself and, although the hospital agrees to save John’s son, John is held accountable for his actions and taken into custody.

The plaintiff, Chitunda Tillman, claimed that New Line “filched” the script for *John Q* from his own screenplay, *Kharisma Heart of Gold*. The screenplay for *Kharisma* also featured a father, a millionaire whose assets were frozen by the IRS, who is unable to obtain the funds to pay for critical heart

surgery for his newborn daughter, Kharisma. While eating lunch at a mall, the father intervenes in a robbery and has a near-death experience. This incident inspires the father to insure his life for \$3.5 million and then commit suicide enabling his family to pay for Kharisma’s surgery with the proceeds. After the father drives off a cliff, the movie ends with his spirit visiting a healthy Kharisma five years later.

Affirming a grant of summary judgment in favor of *John Q*’s producers, the Seventh Circuit noted that “[w]here no reasonable juror could find that two works are substantially similar, summary judgment in favor of the alleged infringer is appropriate.”⁵ Plaintiff argued that *John Q* was substantially similar to *Kharisma* because both screenplays involved sick children, caring fathers, the lack of health insurance, hospital nurses, praying and crying. The Seventh Circuit held that “any similarities between the two scripts, such as the leading character being a concerned father willing to do anything for his sick child, are standard elements known as *scènes à faire*, that are unprotectable under copyright law.” Because the central characters, theme and plot of the movies were markedly different, summary judgment in favor of New Line was appropriate.

Another recent case alleged that Universal Studios and others infringed upon plaintiff’s play *Bronx House* in creating the movie *Life*, starring Eddie Murphy and Martin Lawrence.⁶

To determine whether they were substantially similar, the Court conducted an extensive comparison of the two works. *Bronx House*, which is set over one week in the mid-1990s, is the story of a New York City Comptroller wrongfully accused of stealing millions from New York City who is jailed at the Bronx House of Detention where rival gangs try to kill him. *Life* is a dramatic comedy that tells the story, starting in the 1930s, of two men who are wrongfully incarcerated in Mississippi. The relationship of the two men and the long-term effects of incarceration are central to the story in *Life*, which contains elements of humor. The common elements of the works included, among other minor points, (1) they were set in prisons; (2) some of the characters were African-American men; (3) the main characters were wrongfully incarcerated; and (4) there were overbearing prison guards. After assessing the purported similarities between the works, the court noted that any common elements were “unprotectable facts and ideas and/or *scènes à faire*.” In granting summary judgment in favor of Universal Studios, the Court concluded that there was no substantial similarity “in the total concept and feel, theme, setting or plot of *Bronx House* and *Life*.”⁷

Outside the motion picture context, a New York court recently addressed a copyright infringement claim asserted against American Express and its advertising agency over the popular tagline “My Life. My Card.” featured in American Express advertisements from 2004 to 2006.⁸

The plaintiff, a graphic designer, alleged that American Express infringed upon copyrighted aspects of his mark “My Card. My Work.” as used on plaintiff’s website. Plaintiff alleged that the similarities in the two works were probative of copying because (1) they employed similar phrases; (2) the phrases appeared to be handwritten; (3) they were linked to “real world” rather than drawn objects; (4) the objects bleed off the page; and (5) all of this occurs on a white horizontal rectangle.⁹

The Court found, however, that similar elements appear frequently in print and internet advertising. These “stock design elements commonly used in advertising” could be “expected to arise, either alone or in combination, in independently created work.”¹⁰ Accordingly, the Court granted summary judgment in favor of American Express because the plaintiff could not establish substantial similarity between the two works.

As each of these recent decisions reflect, a successful defense to a plaintiff’s charge of copyright infringement can readily be mounted by demonstrating the commonplace, unprotectable elements that pervade the plaintiff’s charge of copying. Typically, by reference to other competing works beyond those at issue in the suit, the trivial, stock, or commonplace nature of the similarities can best be demonstrated. For instance, no one could properly claim ownership to a storyline in a romantic comedy in which “boy meets girl,” “boy loses girl,” and subsequently “boy gets girl back.” Thus, the successful defense of a claim of copyright infringement can often be achieved by demonstrating the trite and stereotypical nature of the alleged similarities between the two competing works.

¹ 17 U.S.C. §§ 101-810.

² Gottlieb Development LLC v. Paramount Pictures Corp., No. 08-civ. 2416 (DC), 2008 WL 5396360, at *3 (S.D.N.Y. Dec. 29, 2008).

³ Hudson v. Universal Studios, Inc., No. 04 Civ. 6997 (GEL), 2008 WL 4701488, at *2 (S.D.N.Y. Oct. 23, 2008).

⁴ Tillman v. New Line Cinema Corp., No. 08-1667, 2008 WL 4488204 (7th Cir. Oct. 7, 2008).

⁵ Id. at *2.

⁶ Hudson v. Universal Studios, Inc., No. 04 Civ. 6997 (GEL), 2008 WL 4701488 (S.D.N.Y. Oct. 23, 2008).

⁷ Id. at *4.

⁸ O’Keefe v. Ogilvy & Mather Worldwide, Inc., No. 06-cv-6278 (SHS), 2008 WL 5101156 (S.D.N.Y. Dec. 4, 2008).

⁹ Id. at *11.

¹⁰ Id.