December 2003

Cases of Note

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Recommended Citation

Strauch, Bruce (2003) "Cases of Note," *Against the Grain*: Vol. 15: Iss. 6, Article 26.

DOI: <https://doi.org/10.7771/2380-176X.4217>

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QUESTION: For an email reference question, may a reference librarian copy and paste something from an online database into the response to the user?

ANSWER: The answer to this question is found in the license agreement that the library signed with the database vendor. If the reference question comes from a patron who is covered under the license agreement, then providing that user with material from that database is fine by cutting and pasting the material into the email answer to the reference question. If the inquiry comes from an outside patron who is not covered under the library's license agreement with the database vendor, then cutting and pasting would violate the terms of the license. The license agreement could contain a provision that permits use of material from the database for responding to reference questions by library staff members. Thus, under this condition, it would not be a violation of the license agreement to include material in any response to an email reference question. The basic answer to all of these questions is to check the license agreement.

QUESTION: What is the difference between the composer's rights and royalties and those of the music publishing company and recording company?

ANSWER: Under US copyright law, the copyright in a work initially vests with the author, i.e., the composer. The owner of the copyright is entitled to the exclusive rights provided under the Copyright Act: reproduction, distribution, adaptation, performance and display. If the work in question is a sound recording, the owner also has the right of public performance via digital transmission.

The composer usually transfers to the music publisher only the rights of reproduction and distribution of the composition. The publisher then collects royalties for sales of copies of the sheet music and pays a share of the royalties back to the composer. Generally, the composer retains all of the other rights such as public performance, so she continues to collect royalties for the public performance of her music.

A sound recording of the performance of a musical composition embodies at least two and sometimes three separate copyrights: the underlying musical composition, the recording of the performance of the music and a copyright in the arrangement of the music for the sound recording. The performer, who may or may not

be the composer, normally transfers the copyright in the performance of the music to the recording company that collects royalties for the sale of the recordings. The composer is compensated for the sale of recordings through the mechanical license, a compulsory license under the statute. The composer normally continues to own the copyright in the musical composition. When music is played on radio or television, royalties are paid to the composer in the form of a blanket license with the performance royalty organizations such as the **Association of Composers, Authors and Publishers (ASCAP)** and **Broadcast Music Inc. (BMI)**. There are no performance rights in sound recordings except for digital transmission. So, traditionally, the recording company makes its money from the sale of records and not from performance.

In 1995 and 1998 the Copyright Act was amended to provide public performance rights for sound recordings transmitted digitally. Thus, radio stations that Webcast now pay a second blanket license fee for performance royalties to the recording companies that may or may not share the proceeds with the recording artists. 🎧

Cases of Note

by **Bruce Strauch** (The Citadel) <strauchk@earthlink.net>

Copyright - Exhaustive Elvis Enjoined

Elvis Presley Enterprises, Inc., Jerry Lieber, Mike Stoller et al. v. Passport Video, a business of unknown form and origin et al., United States Court of Appeals for the Ninth Circuit, 2003 US App. LEXIS 22775 (2003).

Tallman, Circuit Judge: "The King is dead. His legacy, and those who wish to profit from it, remain very much alive."

Initially, I thought this judge was going to write in mock-tabloid language. But no. It's as dry as any other appellate holding.

Plaintiffs are companies that own copyright in various clips of **Elvis** appearances on **Ed Sullivan**, **Steve Allen** and the extremely Baroque *Elvis Aloha From Hawaii*. **Lieber** and **Stoller** are, of course, the famous Brill Building producers who hold copyright in his greatest hits such as *Jailhouse Rock* and *Hound Dog*.

Passport Video created a 16-hour life of **Elvis** called *The Definitive Elvis*. Since even the most rabid fan couldn't sit through sixteen hours, it was broken into one hour segments with such gripping titles as "The Army Years" and "The Spiritual Soul of Elvis."

The plaintiffs' clips are used throughout for a total of 5% to 10% of the new work. Nearly the entire **Steve Allen** appearance is used and 35% of the **Ed Sullivan**. Copyrighted photos

and, of course, the music is used throughout.

As to damages, the **Ed Sullivan Elvis** sells for \$10,000 per minute.

Plaintiffs got a preliminary injunction and this was appealed. A prelim injunc should not be issued unless they can show likelihood of success on the merits. Which is to say likelihood of overcoming **Passport's** fair use defense.

And, of course, there are no "bright line rules" to simplify things, but only the laborious "case-by-case analysis." *Los Angeles News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 938 (9th Cir. 2002). So let's drag ourselves through fair use once again.

Purpose and Character

Passport was in the business of making money and this tilts against fair use. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 US 539, 562 (1985); see also *Harper & Row*, 471 US at 562 ("The crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.").

The defense to this is a "transformative" nature of the new **Elvis**. *Campbell v. Acuff-Rose Music, Inc.*, 510 US 569, 579 (1994). Is it su-

perseding the old work or adding something new through new expression, meaning, or message?

Monster Communications, Inc. v. Turner Broadcasting System, Inc., 935 F. Supp. 490, 493-94 (S.D.N.Y. 1996) held that the use of **Muhammad Ali** film clips in a commercial biography of the boxer was fair use because it constituted "a combination of comment, criticism, scholarship and research" concerning "a figure of legitimate public concern."

Hofheinz v. A&E Television Networks, 146 F. Supp. 2d 442, 444 (S.D.N.Y. 2001) found fair use in copyrighted clips of the actor **Peter Graves** again because it was transformative. "B" movie clips of **Graves** were used to demonstrate his humble beginnings in outdated, "campy" trash films.

Until he advanced to up-to-date, "campy" trash films.

The Ninth Circuit did not care for the fact that **Passport** advertised its video as containing "Every Film and Television Appearance." It was trying to profit by pulling together the TV appearances in one place without paying the customary fee.

Also, the use by **Passport** was not consistently transformative. Some are used only briefly

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while a narrator places them in time and career context. But a "voice-over" may not be adequate transformation. "There must be real, substantial condensation of the materials ... and not merely the facile use of scissors; or extracts of the essential parts, constituting the chief value of the original work." *CBS Broad., Inc.*, 305 F.3d at 939 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 345, F. Cas. No. 4901 (C.C.D. Mass. 1841) (Story, J.)).

Of course, the famous **Elvis** only-above-the-waist gyration on **Ed Sullivan** is needed to tell his story. But many of the TV clips ran in their entire length providing the entertainment value owned by plaintiffs.

Assuming you liked to watch Elvis gyrate above the waist as you relax in the evening.

The Ninth Circuit acknowledged that this element was a close contest with the *Monster* and *Hofheinz* theories on one side and the over-use of the TV clips on the other. But they were merely reviewing for abuse of discretion by the District Court and didn't have to make a decision.

Yes, this will have to go back to trial and then back up to appeal years from now before we learn what the 9th Cir. thinks.

Nature of the Copyrighted Works

Fair use prefers factual works to fiction. *Harper & Row*, 471 US at 563. Fiction, original songs and motion pictures are more apt to receive copyright protection than news broadcasts. *L.A. News Serv. v. KCAL-TV Channel 9*, 108 F.3d 1119, 1122 (9th Cir. 1997).

Again the Ninth Circuit pronounces it a close call. The **Elvis** act is creative, but the shows he was on became "newsworthy" events.

As to the still photos and songs, there is no question that they are protected. Bundle that up together, and you have no abuse of discretion.

Amount and Substantiality of the Part Used

Just using a little may not be decisive, but using a whole bunch sure is. Is the "heart" of the copyrighted work used — the part "most likely to be newsworthy and important in licensing serialization"? *Campbell*, 510 US at 565.

Many of the short clips were used repeatedly. And the *Steve Allen Show* clip went on for more than a minute. Yes, it was only a brief moment in the entirety of that show, but the **Elvis** moment was the heart of what made copyright in the show valuable.

Ah yes, the days of early television when sex was taboo rather than total. And come Sunday night, all of the USA was glued to Ed or Steve. I came from a family that watched Ed Sullivan and I never once saw Steve Allen. Which all my friends did. So I had nothing to talk about in school on Monday.

Being a Monday outcast was particularly bitter because Steve had comedy while Ed was totally lame with circus-type acts of dorks rotating plates on multiple spindly wands. The only limited joy was being able to do the famous Ed Sullivan imitations so beloved of comedians at the time.

Effect on the Market for the Works

Yes, it's not just market damage by the **Elvis** epic, but the old "what if everyone did it" question. *Campbell*, 510 US at 590.

Passport was in commerce and advertised its use of the TV appearances. If everyone did this, there would be no market for plaintiffs' copyrighted materials.

And is there a market for said materials? Well, let's just remember that Elvis was the first important rock 'n' roller to appear on TV prior to the Beatles. Elvis, in fact, saved Sullivan's show from a ratings dive and convinced Ed that there was a youth market. Which caused him to import the Beatles and then almost the entire British Invasion. Which was certainly a seminal event in rock history.

I mean is that important or what?

And that leads us to the public interest question and the confusion of the dissent.

Dissent — The Vital Need to Know About Elvis

The dissent does the usual deal of completely turning you around just when you thought you

understood it all.

It notes that the music used is only little blips and would never be a substitute for the actual music that plaintiffs own. Likewise, the still photos are embedded in the film and are not a viable substitute for someone seeking a photo of **Elvis**.

Where the TV clips are used, there is substantial voice-over from a narrator, **Elvis'** buddies and band members including **Elvis** himself talking about the show. This is highly transformative. And it's not a substitute for someone wanting to watch **Elvis'** performance on the show.

Then, not to be outdone by the majority, the judge unleashes: "The King is dead, but his legacy remains very much alive." And quotes from that vital airport news source, *The USA Today*, a review of just how special this Compleat **Elvis** video is in our desperately needed understanding of **ELVIS THE MAN**.

Sammartano v. First Judicial District, 303 F.3d 959 (9th Cir. 2002) adds a public interest element into the equation as to preliminary injunctions. And by the 9th Cir. abusing their discretion in ignoring this, millions of knowledge-starved **Elvis** fans are prevented from viewing this important epic of their God-Man.

And this is in accord with the public's need to learn all about **Muhammad Ali** that was granted in *Monster Communications*. And the public's need to learn all about **Peter Graves**.

Copyright - Substantial Similarity - In Which An Aspiring Beer Baron Learns About the Total Feel of a Six-pack

Leslie Atkins, D/B/A Leslie Atkins Communications, Appellant v. Benson J. Fischer, et al., Appellees, United States Court of Appeals for the District of Columbia Circuit, 331 F.3d 988; 2003 US App. LEXIS 12702 (2003).

Realtor **Benson Fischer** was a man with an idea — **Redneck Beer** — and not much else since he didn't really have his own brew. He took this grand vision to major brewers, but they were less than impressed. But that didn't stop him from heading out for Las Vegas and a beer convention where he hoped to find a partner.

Wanting to have something to show, he hired **Leslie Atkins** whose marketing firm developed brand identities. The two agreed that she would develop a bottle design and then a six-pack carrier with logo labels. **Leslie** must not have been too established herself as the fees for this two-stage deal were \$2,000 and \$4,000 respectively and there was no obligation on the part of either party to go on to the second stage.

Leslie did get him to agree that "ownership and possession of all underlying creative work" would remain with her. She thought this meant she owned the design and could later set a price

for its use. She worked cheap with visions of later royalties dancing in her head.

Leslie also worked pretty quickly because she sent **Benson** off to Vegas with a cunning design of a bottle with a blue jeans pocket label and red bandana hanging from it.

Benson didn't seem to achieve a lot in Vegas, but upon his return he got **Leslie** to add his name "**Fischer**" to the label. Then he paid her \$2,000.

As visionaries will do, **Benson** changed his mind and dumped **Leslie** telling her he was displeased with her work. So stage two was aborted.

Incredibly, **Benson** advanced the project by forming **Fischer Brewing Company** and actually contracted with **Stroh Brewing Company** to manufacture a product.

Is it really this easy? What are we doing in our dumb jobs?

As part of the contract **Benson** warranted that he owned all trademarks and copyrights for **Redneck Beer**. He was paying a lawyer at this point, who told him he had better get **Leslie** to agree that she had done a work-for-hire. Just to be on the safe side.

Leslie predictably refused. And she copyrighted her design.

Fischer and **Stroh** trademarked **Redneck Beer**.

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There must be lots of beer formulas out there because within the same year **Stroh** and **Fischer** actually had **Redneck Beer** on the market. The logo, designed by another firm featured — you guessed it — a blue jeans pocket and a red bandana.

Leslie sued for copyright infringement, false designation of origin under the Lanham Act. The district court gave summary judgment to **Benson** saying he had an implied non-exclusive license to use **Leslie Atkins'** work in commercial production and anyhow, the end result was not substantially similar. It dismissed the Lanham claim without explanation.

Implied License

Transfer of copyright ownership requires a writing, but nonexclusive licenses are not a transfer of ownership. It can be given orally or be found in the conduct of the parties. *Nelson-Salabes, Inc. v. Morningside Development, LLC*, 284 F.3d 505, 514 (4th Cir. 2002).

A license is implied when (1) creation of a work is requested; (2) the creator makes and delivers the work; and (3) licensor intends the licensee to copy and distribute the work. *Lulirama Ltd., Inc. v. Access Development, LLC*, 128 F.3d 872, 879 (5th Cir. 1997).

But did she intend **Benson** to copy and distribute her work? She admits she wanted him to show her design at the Vegas beer conven-

tion, but says what he did afterwards goes beyond the scope of the license. **Benson** said the implied license allowed them to use the stage one drawing in the development of the stage two six-pack.

The written agreement they signed shed no light on this. But a question of fact existed as to whether they intended to use the stage one drawing for work on stage two without **Leslie's** cooperation and **Benson** handing over more money. And he sure didn't pay much for the drawing that was to be used in a nationally marketed beer.

In *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 559 (9th Cir. 1990) much emphasis was placed on a payment of \$56,000 for seven special effects shots used in a movie. There must have been a broad license to use the shots granted at that price.

And **Leslie** had given him a note along with the drawing saying "I'm glad we're finally going to design a look for **Redneck Beer**." Which sounds like they were going to do something other than blue jean pocket and bandana. Further, **Benson** talked her down in price promising her the standard pie-in-the-sky of big bucks down the road. Thus, an issue of material fact exists as to what the parties meant to do and what she had granted him.

Substantial Similarity

A derivative work is based upon an original. If it's substantially similar, it's a violation of copyright. 17 U.S.C. § 101, *Sturdza v. United*

Arab Emirates, 350 U.S. App. D.C. 154, 281 F.3d 1287 (D.C. Cir. 2002). As you can imagine, substantial similarity is a tough call and summary judgment seldom fits. *Id.* at 1296.

Would the average lay observer or common doofus as it may be spot the similarity? *Hamil America, Inc. v. GFI*, 193 F.3d 92, 199 (2d Cir. 1999). Courts look at the "total concept and feel" of the design. *Id.* at 102.

It's not enough to dissect separate components and dissimilarities. The focus should be how the original author "selected, coordinated, and arranged the elements." *Id.* at 103.

You're right. I didn't understand that either. And I would challenge anyone to write a paragraph on how Leslie selected, coordinated and arranged her pocket and bandana.

Anyhow, the district court just pronounced it dissimilar and presumably couldn't write about selection, coordination and arrangement any more than we could.

A little more light is thrown on this by *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996 (2d Cir. 1995). There, two sweaters had leaf designs. One was a five-leaf design of leaf and acorn appliques made of felt and two pairs of leaves above and one leaf below. The other had an eight-leaf design of leaf appliques made of puffy polar fleece and placed in three rows. Despite those differences, the 2d Cir. felt they both had the same feel and the second was a leaf design rip-off.

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Books Are Us

by Anne Robichaux (Professor Emerita, Medical University of South Carolina) <awkr772@charleston.net>

Column Editor's Note: This column covers fictitious accounts of people in our industry — librarians, publishers, vendors, booksellers, etc. — people like us. All contributions, comments, suggestions are welcome. — AR

Thanks again to **Diane Rourke**, Director, Health Sciences Library, Baptist Health Systems of South Florida (Miami), for recommending *The Music Lesson* by **Katharine Weber** (Crown Publishers, 1999, ISBN 0-609-60317-5). This is a concise and well written novel presented as a journal of the protagonist's intense involvement with a distant Irish cousin, the story of a stolen (fictitious) Vermeer painting, *The Music Lesson*, and the "healing truths of art."

Patricia Dolan is a 41 year old Irish American, an art historian and librarian who works in the Frick Museum's Art Reference Library. She assists scholars with their research and is quite knowledgeable. When the Chief Librarian hired her he told her it was because she was ideally suited to the job: she knows "something about everything, and everything about something." She was also the number two person in the art library at Yale, which helped her get the job at Frick. She is paid only when she works, allowing her flexibility to travel for extended periods.

However, Patricia has experienced enormous tragedy in her life. She sees life as "nothing more than a series of losses, from beginning to end." She describes herself as other library staff might view her as an "efficient, rather cold, humorless person, a woman on her own, someone neither adventurous or passionate." Although she appears to lead a dull, reclusive, rather joyless life, we learn that she is indeed passionate: about art, in particular the works of Vermeer; about her 25 year old third cousin from Ireland; about her family; and about her Irish heritage.

An immediate attraction to her charming cousin leads to an intense physical reawakening, a no-holds-barred affair, and to Patricia's complicity in a major art theft. Her cousin, Mickey, uses her expertise, and her passion for Vermeer

in particular, to steal *The Music Lesson* for ransom on behalf of an IRA splinter group, the "Irish Republican Liberation Organization." Patricia uses her position at Frick to access correspondence at various museums to find out specific details about an Exhibition at The Hague. She notes that "only when I was searching the computer files for information to help Mickey did I realize that I had agreed, that I was, in fact, taking part in a conspiracy to break the law, to steal."

Patricia writes that the "whole scheme seemed like a lark, like some elaborate role-playing fantasy, a wonderful game," a game in which she was thrilled to be invited to participate, a tremendously exciting adventure. Should we interpret this to mean the dull librarian can spice up her life with big time crime and a desperate forbidden love? The story really isn't that simplistic.

There are wonderful descriptions of Vermeer's works and Patricia's reactions to *The Music Lesson* in particular. She writes about her sense "that a painting can contain knowledge, information, beautiful information." She discovers many truths about herself as she has studied this painting during the days she has been sequestered with it in the small cottage on a remote Irish Coast. She realizes that only in the presence of this painting has she felt truly alive, that all else she has experienced has been an "approximation of a life."

The story is well told, with a twist at the end. Reviewers at **Amazon.com** are primarily positive, one describes the story as a "startling, contemplative literary thriller." Reviewers quoted on the book jacket describe the novel as captivating, compelling, an ingenious, artful, evocative mystery. The book jacket also informs us that the author, **Katharine Weber**, teaches fiction writing at Yale, and spends part of every year in Ireland. She dedicated this novel to her mother: "who loves words."

La Cucina: A Novel of Rapture by Lily Prior (Harper Collins, November 2000, ISBN 006019538X; paper, September 2001) is a delicious and lascivious novel about food and passion in Italy, featuring a young peasant woman from Sicily who becomes a librarian in Palermo. From an early age, Rosa Fiore found creativity in cooking, and solace, after her lover of one night was killed. She eventually leaves her familiar life and takes a job as a library assistant in the *Biblioteca Nazionale* in Palermo, resigning herself to a staid, loveless life, growing fat on her succulent creations.

In looking for a place to live in Palermo, Rosa found rooms over a grocery, which pleased

her as she continued to indulge in her passion for cooking. In requesting the apartment, she told the grocer that she worked at the library, lived quietly and could promise she would cause no trouble. The grocer felt "she had a great respect for learning and books, and would be proud to be able to tell her customers when they came in to buy their coffee that she had rented her rooms to a librarian."

Rosa starting working in the Library as a clerk who shelved books, progressing to assistant junior librarian, eventually becoming the cataloger and keeper of the manuscripts. Twenty five years pass, and she laments "years of cataloging books in the library had weakened my eyesight so that I balanced a pair of severe spectacles on the bridge of my nose." The younger girls in the library mimicked her country accent, laughed at her homemade clothes, mocked her passion for food, her generous size, her overwhelming breasts, and her lack of a man — basically she became the be-spectacled, spinster stereotype.

There is an hilarious description of bureaucracy in action when a patron comes into the library to research the heritage of Sicilian cuisine — the delay she took in seeing him, the fact that it was the wrong day to look at the manuscripts, that he needed a permit from another agency to access them, etc. The patron, a chef and writer, who immediately sparked interest in Rosa (the feeling was quite mutual), called her a "petty bureaucrat. . . thinking I was an embittered old maid enjoying my little bit of power." Sounded like a good call, eh?

Rosa began to dress more as a business woman than a librarian (?) as the mysterious chef, known only as L'Inglese, continued to visit the library to conduct his research. They began a mutual and passionate love affair during which time Rosa teaches him the secrets of her Italian kitchen, and he teaches her the secrets of love. As the affair progresses, Rosa declares "from the dull spinster librarian I had suddenly turned into a woman, a real woman regarded by the staff with awe." And further, "we both learned our lessons: L'Inglese had become skilled in the arts of the Sicilian kitchen and I, the librarian, had learned what it is to love and be loved by a man. What a banquet of the senses it had been!"

From **harpercollins.com**, *La Cucina* is described as exuberant and touching, a novel that "celebrates family, food, passion, and the eternal rapture of romance." **Joanne Harris**, author of *Chocolat*, relates the novel to *Like Water for Chocolate* in its celebration of love, the family, the body, and food. "Like an excellent meal, it leaves the reader feeling warm, satisfied. . ." — stereotypical descriptions aside. 🍷

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In **Redneck Beer** — they never give you pictures in these things — the lettering was different and differently colored. In **Leslie's**, the bandana hangs out of the pocket. On the **Fischer** six-pack the bandana is on the handle of the carrier. And there's no "suds" on the six-pack as there is on **Leslie's** beer bottle.

But on the other hand, a reasonable juror could find the total concept to be quite similar.

So the case got sent back down for trial with instructions to the district court to write down why it dismissed the Lanham Act claim. 🍷