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The following are excerpts selected from Inside the Minds: Litigation Strategies for Intellectual Property Cases, 2011 ed., authored by Alan Behr, a partner at Alston & Bird.

Staying on Top of IP Litigation Trends: Savvy Solutions for Today's Attorneys and Clients*

Copyright Turned Upside Down for Many

The biggest issue in copyright law in the last year was something of a surprise for many in the copyright bar. Essentially, as of the date of this writing, the Copyright Office's own policy as to registration of collective works has been expressly refuted by two federal courts, and a decision is pending from another. The rulings have upset a long-standing practice for photographers and caused many of them to have to face that they effectively have no redress against infringement of works that they thought were adequately protected under law.

Rather unusually among major nations, the United States maintains a system for the registration of copyrights. Indeed, for United States residents to start an action under the Copyright Act, registration is a prerequisite (although there is a conflict among the circuits on certain specifics). For people who create many small items of content (such as photographers), registering them individually can be burdensome and costly. A solution was to use the system for registration of a collective work. When doing so, the Copyright Office, in interpreting the Copyright Act, had stated, in Section 615.06 of its own publicly available administrative staff manual, known as Compendium II, that, "[t]he names of the individual authors of separate contributions being registered as part of the claim need not be given on the application." It was that reasoning that photography agencies employed on behalf of their members. The way that would work in practice is that a number of photographers under contract with an agency would temporarily cede their ownership rights to their new works to their common agency, solely for registration purposes. The agency, as the temporary owner of all those images for copyright purposes, would compile them into a single electronic collection and register them together under a single

copyright registration number. The agency would list itself as an "author," perhaps along with the names of a handful of the photographers whose images were included in the collection. Once the registration was complete, all title to their respective photographs would be promptly assigned back to the individual photographers.

As with so many things in history of the law, it all worked well enough until one day, thanks to litigation, it did not work at all. In 2010, in both *Muench Photography Co. v. Houghton Mifflin Harcourt Publ'g Co.,* 09-CV-2669 (LAP), 2010 U.S. Dist. LEXIS 45080 (S.D.N.Y. May 4, 2010), and an Arizona case, *Bean v. Houghton Mifflin Harcourt Publ'g Co.,* No. 10-8034-PCT-DGC, 2010 U.S. Dist. LEXIS 83676 (D. Az. Aug. 10, 2010), federal district courts independently came to the same conclusion: a collective registration of that kind would only cover the constituent works of the photographers expressly identified in the registration. The *Muench* court appeared to be satisfied if the actual photographers were correctly named, even if all the images were not; the *Bean* court held that correct titles for each of the works had to be provided as well and threw out a registration that correctly named one of the plaintiff photographers but not the titles of his images at issue. If you were a photographer who was lucky enough to have your name included in the registration in *Muench* (and it may indeed have simply been a matter of luck), your rights were protected—but if not, your photographs inside those compilations were not, in fact, registered. As a result, until you run to the Copyright Office and procure an (expensive) registration on an expedited basis, you effectively have no legal recourse against infringers. When you consider that media photographers are facing the same rough justice in the marketplace as are journalists (a proliferation of infringements of their work and of amateur substitutes), as well as new demands (thanks to electronic capture, editing and delivery, "postproduction" refinements of each image are now often the job of the photographer instead of the publication), the blow felt by the many affected by the court decisions has hit them especially hard.

For that reason, we filed an amicus curiae brief in *Muench* on behalf of the American Society of Media Photographers (of which I am a member) in support of the plaintiff's efforts to have the court reconsider its holding. *See Muench Photography Co. v. Houghton Mifflin Harcourt Publ'g Co*., 09-CV-2669 (LAP), 2010 U.S. Dist. LEXIS 107705 (S.D.N.Y. Sept. 27, 2010). In our brief, we noted that Section 615.06 was added to Compendium II in 1988. As a lawyer, I watched over two decades of administratively sanctioned practice disappear in front of me; as a photographer, I had to consider how to register the copyrights in stacks of my own photographs without taking more time than I can spare and without paying excessively to get it done.

From a litigation point of view, the decisions have several implications. First, we have been reminded in a blunt way that, even though the copyright world is rather clubby, and even though copyright practitioners have come to see the Copyright Office as a friendly and efficient partner in the protection of content, just because the subject-matter experts at a federal agency have taken a certain position does not mean that the judges of federal courts—probably the most capable generalists of our legal system—will agree with it. The second implication is that we can only show respect for the defense lawyers who thought outside the box and came up with the winning strategy here, however much trouble it caused so many other people. It is all a reminder that conventional wisdom, when used in planning an IP litigation strategy, can be highly overrated.

If anything, however, what the two recent decisions have done is to reinforce what we have been telling our clients over and over and over again: register your copyrights. The process is easier than getting a driver's license; you just go on the Copyright Office's website at www.copyright.gov and follow the instructions. There are some subtleties and nuances with respect to some applications, and occasionally a lawyer has to patch up the holes in an application, but nothing should stand in the way of a well-maintained registration program. Registration creates a record of authorship and ownership of a work that bears protection; most of all, it is your admission ticket to the court system.

Gaming the Games in Court

I was once the head of the legal department for the predecessor of Atari, and during my watch, there was vocal commentary, mostly from off the main stream, to the effect that violent videogames were causing children to behave in violent ways. The two teenaged boys who killed thirteen students and teachers at Columbine High School in 1999 were eager players of the *Doom* series of videogames, which my company published. One of the attackers had even written to the developer, offering his services as a level designer; he also, in a video he made of himself, referred to the game as an inspiration. There was some discussion at the time about whether the killers' game playing influenced their behavior. It is certainly part of the record that they played *Doom*, but it is a long and intellectually unsupportable leap to say that *Doom* made those teenagers kill people. Mentally unbalanced individuals or those infused with the cold resolution of human evil do not need muses; they require only excuses for their behavior.

A lawsuit resulted from a horrible incident in Kentucky in which a fourteen-year-old boy opened fire on a prayer group meeting before school started. He killed three girls and wounded five other students. The parents of three victims filed suit in 1999 against our company and a number of others in the videogame business (along with two pornography sites and the makers and distributors of the film *Natural Born Killers*). Dismissal of the case was affirmed two years later by the Sixth Circuit, which held that, "We find that it is simply too far a leap from shooting characters on a video screen (an activity undertaken by millions) to shooting people in a classroom." *James v. Meow Media, Inc.,* 300 F.3d 683, 693 (6th Cir. 2002).

That suit and others like it have proven to be ineffective (except to make a political, cultural or religious point—which may have been the main reason for filing that one in the first place). What may help prevent much future litigation of that kind is the very jumble of useful and useless data tumbling out of the Internet every second of every day: a potential plaintiff, whatever his motivation, may be hard pressed to prove what actual electronic content a murderer had perceived and which, if any of it, could have meant anything to him.

Fashionably Late into the Zone of Protection

We represent quite a few fashion and accessories companies, and we know that it has been frustrating to a number of fashion designers that clothing designs were not protectable by copyright. That is because functional aspects of products are not protected by copyright in the USA. For clothing, that means that you cannot obtain copyright protection on the cut of the

dress; however, because fabric patterns are mostly decorative and do not have a function (except, perhaps, military or hunting camouflage), you can obtain a copyright registration in the pattern.

Legislation has been proposed over the year to permit limited copyright-style protection for fashion designs. Some EU member nations and the EU itself already allow the protection of fashion designs, and the EU has a registration scheme that provides for protection for five years. Yves Saint Laurent was able to sue and Ralph Lauren under French law for copying a tuxedo dress, resulting in a fine to Ralph Lauren of the equivalent of $385,000. *Société Yves Saint Laurent Couture S.A. v. Société Louis Dreyfus Retail Mgmt. S.A.,* [1994] E.C.C. 512, 514 (Trib. Comm. (Paris)). That case made headlines in part because it was so exceptional. European practice has shown that major fashion designers by and large do not avail themselves of the protection the various laws allow. Zara and other companies that copy the designs of major houses for the budget market continue to do a lively trade in Europe as well as the USA. Many high-end designers either do not care or see the young woman who goes to Zara for inexpensive copies as an aspiring customer, one who is training herself to graduate, in time, and when her budget permits, into a customer for the designer's originals. There is also the fact that most high-fashion goods are seasonal: they are typically in stores for only six months. For those reasons and more, even if US law should change to allow some form of copyright registration for fashions (and related functional products such as luggage), the change may not spark the marathon run to the courthouse door that some have suggested would result.

Even if there is no change to the copyright law, designers of fashions and related goods are not without effective means of redress against the makers and importers of unauthorized copies. Over the past few years, we have been able effectively to use design-patent registrations to stop infringements on high-end eyeglass frames. In one case in federal court, the infringing goods appeared to be quite dangerous: the temple could break off, leaving an exposed hinge pin within less than an inch of the wearer's eye. We continue to believe that, here, as with the protection of content, a two-pronged strategy is usually the most effective: (1) take the time and expense to register what you own and what is important to you to protect, and (2) remember that litigation is a weapon best used with discretion: you may not stop them all, but do not hesitate to use the courts to halt those who are doing the most harm.

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