

2 of 2 DOCUMENTS

**MICHAEL SYLVESTRE and DOUGLAS RICHWINE, p/k/a ATTICA, and MADHOUSE MANAGEMENT, Plaintiffs, v. JOHN PATRICK OSWALD p/k/a JANI LANE, JOEY CAGLE p/k/a JOEY ALLEN, JERRY DIXON, ERIC TURNER, STEVEN CHAMBERLAIN p/k/a STEVEN SWEET, (collectively p/k/a WARRANT), VIRGIN SONGS, INC., DICK DRAGON MUSIC, LIKITE SPLIT MUSIC, CRAB SALAD MUSIC, RICH MCBITCH MUSIC, GREAT LIPS MUSIC, and CBS RECORDS, INC., Defendants.**

91 Civ. 5060 (JSM)

**UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF  
NEW YORK**

1993 U.S. Dist. LEXIS 7002; Copy. L. Rep. (CCH) P27,120

May 18, 1993, Decided

May 21, 1993, Filed

**JUDGES:** [\*1] MARTIN, JR.**OPINION BY:** JOHN S. MARTIN, JR.**OPINION:**

MEMORANDUM OPINION AND ORDER

JOHN S. MARTIN, JR., District Judge:

Plaintiffs Michael Sylvestre and Douglas Richwine bring this copyright infringement action alleging that defendant John Patrick Oswald, p/k/a Jani Lane ("Lane"), members of the rock band "Warrant" (of which Lane is one), and various music publishing companies have infringed plaintiffs' copyright on their song entitled "Heaven" (hereinafter referred to as "Heaven-P") by writing, recording, performing and publishing a song authored by Lane also entitled "Heaven" (hereinafter referred to as "Heaven-D"). Plaintiff Madhouse Management allegedly manages plaintiffs Sylvestre and Richwine and under the management agreement is entitled to a portion of the revenue received from Heaven-P.

Defendants move for summary judgment on the grounds that plaintiffs cannot prove infringement; plaintiffs cross-move for partial summary judgment on the issue of similarity and for sanctions.

Discussion

Summary judgment is proper when there is no genuine issue of material fact and, based upon facts not in dispute, the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); [\*2] *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). The court's role on a motion for summary judgment is not to decide disputed issues of fact but only to determine whether there is a genuine issue to be tried. *Rattner v. Netburn*, 930 F.2d 204, 209 (2d Cir. 1991). Moreover, the court must resolve all ambiguities and draw all factual inferences in favor of the nonmoving party. *Rattner*, 930 F.2d at 209 (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986)). Summary judgment is properly granted where the evidence is such that a reasonable jury could not return a verdict in favor of the nonmoving party. *Anderson*, 106 S. Ct. at 2510-11.

In order to succeed in a claim of, copyright infringement, plaintiffs must prove (1) that they own a valid copyright in their work, and (2) that the defendants copied original elements of their work. *Feist Pub., Inc. v. Rural Tel. Serv. Co.*, 113 L. Ed. 2d 358, 111 S. Ct. 1282, 1296 (1991); [\*3] *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992).

#### Validity of Registration

Defendants contend that plaintiffs are unable to prove that they own a valid copyright in their work, or more accurately, that they possess a valid copyright registration for Heaven-P. Registration is a necessary pre-

cursor to a suit for infringement. 42 U.S.C. § 411(a). Plaintiffs point to copyright Registration No. PAu 1-029-999, which states that it is a registration for a work entitled "Cherry Bomb," and further states that creation of such work was completed in 1987.

Plaintiffs explain that Heaven-P was one of fifteen songs on a cassette tape deposited with the application for registration, and that the title "Cherry Bomb", which was the title of a song on the cassette, refers to the collection of songs as a whole. They further explain that 1987 was given as the date of completion because that is the date on which the compilation tape was made. Defendants claim that this registration certificate does not cover Heaven-P because that song is not identified anywhere in the certificate. Plaintiffs respond that the [\*4] certificate covers songs on the tape deposited, and thus includes Heaven-P.

Neither party identifies a single case on point, and the Court is aware of none. The late Professor Nimmer has differentiated between registration and deposit as follows: "The function of deposit is to provide the Library of Congress via the Copyright Office with copies and phonorecords of all works published within the United States. The function of registration is to create a written record of a copyright ownership in a work." 2 Nimmer on Copyright § 7.17[A]; see *National Conf. of Bar Examiners v. Multistate Legal Studies*, 692 F.2d 478, 487 (7th Cir. 1982) ("Copyright Act when viewed as a whole negates the notion that deposit requirements are for the purpose of delineating the scope of a copyright through public disclosure"), cert. denied, 464 U.S. 814, 78 L. Ed. 2d 83, 104 S. Ct. 69 (1983). Moreover, there is no requirement that the Copyright Office preserve deposits for longer than it deem necessary, which, as Professor Nimmer noted, attenuates the argument that "deposit has a copyright as well as an archival function." 2 Nimmer, supra, at § 7.17[A].

Nonetheless, [\*5] plaintiffs claim that "the copyright certificate encompasses whatever is deposited with the copyright office," citing *E. Mishan & Sons, Inc. v. Marycana, Inc.*, 662 F. Supp. 1339 (S.D.N.Y. 1987). However, far from declaring registration to extend to any item deposited, that case instead "assumed without deciding" that registration was limited to items deposited; in short, it narrowed, rather than broadened, the scope of registration, and so to the extent it made any holding it is of no avail to plaintiffs. *Id.* at 1346.

The question is whether the title "Cherry Bomb" extends registration to a song entitled "Heaven" which was on the same deposit tape on the grounds that it refers to a collection of songs. An application for registration requires only a title of the work, any previous titles, and a description of the "Nature of the Work"; the latter ques-

tion was answered "Words and Music" in this instance. The Copyright Office allows registration of a "collection" of unpublished works if

(1) The elements are assembled in an orderly form; (2) the combined elements bear a single title identifying the collection as [\*6] a whole; (3) the copyright claimant in all of the elements, and in the collection as a whole, is the same; and (4) all of the elements are by the same author, or, if they are by different authors, at least one of the authors has contributed copyrightable authorship to each element.

37 C.F.R. § 202.3(b)(3)(i)(B). Such a regulation permitting registration of a "collection" is authorized by Congress. 17 U.S.C. § 408(c); *Grundberg v. Upjohn Co.*, 137 F.R.D. 372, 383 (D.Utah 1991). Moreover, Sylvestre testified that he pursued registration by this means at the suggestion of the Copyright Office itself. Sylvestre Declaration at 6 n.4.

Given the lenient nature of registration requirements, see 4 Nimmer, supra at § 17.20, it is apparent that plaintiffs have established a valid registration for the song Heaven-D. As for the effect of the assertion of a date of authorship of 1987, that date clearly referred to the date of assembly of the collection, and not to the date of authorship of a particular song. Therefore, it shall be no bar to the claim of a different date of authorship.

#### Copying

As to the second [\*7] element of an infringement suit, that of copying, plaintiffs must prove either direct copying, which is rarely susceptible to proof, or (1) substantial similarity such as to support an inference of copying and (2) access to plaintiffs' work. *Arica*, 970 F.2d at 1072.

While defendants concede for the purposes of their motion for summary judgment that the two songs are substantially similar, they argue that plaintiffs must still prove access in order to be successful on a copyright infringement claim. "Access is hearing or having a reasonable opportunity to hear the plaintiff's work, in other words having the opportunity to copy." *Intersong-USA v. CBS, Inc.*, 757 F. Supp. 274, 281 (S.D.N.Y. 1991). Generally, in order to show access plaintiffs must demonstrate more than a "bare possibility" that defendant had access to the work; access must be shown to a "reasonable possibility." *Novak v. NBC, Inc.*, 752 F. Supp. 164, 168 (S.D.N.Y. 1990); see *Ferguson v. NBC, Inc.*, 584 F.2d 111, 113 (5th Cir. 1978); *Alexander v. Irving Trust*

Co., 132 F. Supp. 364, 367 [\*8] (S.D.N.Y.), aff'd, 228 F.2d 221 (2d Cir. 1955), cert. denied, 350 U.S. 996, 100 L. Ed. 860, 76 S. Ct. 545 (1956). Mere conjecture and hypothesis is will not suffice to establish access. *Inter-song*, 757 F. Supp. at 281.

Absent a wide dissemination of the infringed work, see *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988, 998 (2d Cir. 1983), access generally needs to be proved by showing a particular chain of events or "link" by which the alleged infringer might have gained access to the work. See, e.g., *Moore v. Columbia Pictures Indus., Inc.*, 972 F.2d 939, 942 (8th Cir. 1992) (summary judgment denied because plaintiff produced evidence tending to show direct link from plaintiff to defendant via third party); *Gaste v. Kaiserman*, 863 F.2d 1061, 1067 (2d Cir. 1988) ("access through third parties connected to both a plaintiff and a defendant may be sufficient to prove a defendant's access to a plaintiff's work"); *Novak*, 752 F. Supp. at 168-69 (no reasonable possibility of access where president [\*9] of entertainment company testified he never saw submission, and evidence established his practice of not viewing submissions); *Meta-Film Assoc., Inc. v. MCA, Inc.*, 586 F. Supp. 1346, 1358 (C.D. Cal. 1984) ("dealings between the plaintiff and the intermediary and between the intermediary and the alleged copier must involve some overlap in subject matter to permit an inference of access"). However, whether there was a "reasonable possibility" of access is obviously a case-specific question, and it is possible for a "theory of access to rely on a somewhat attenuated chain of events." *Gaste*, 863 F.2d at 1067.

Clearly, a predicate to resolving whether Lane had access to Heaven-P before authoring Heaven-D is a determination of when each song was authored. Plaintiffs have alleged and submitted evidence tending to indicate that Heaven-P was authored in February 1984, and defendants have accepted that date as accurate for the purposes of this motion, as must the Court in drawing all factual inferences in plaintiffs' favor. Defendants have submitted sixteen declarations, among them Lane's, supporting the claim that Lane authored [\*10] Heaven-D at least by July 1985. n1 Plaintiffs' only argument against this claim of authorship is an irrelevant attack on the consistency of the sixteen declarations; plaintiffs point to no evidence establishing that Heaven-D was authored later than July 1985. Thus, plaintiffs must show that there is a genuine issue of material fact that Lane had access to Heaven-P during or before July 1985.

n1 In addition to Lane's own declaration, defendants submit declarations from six people who claim to have participated in or been present at a July 1985 studio recording of Heaven-D by Lane's then band Plain Jane and a declaration of

one person who claims to have heard Plain Jane perform Heaven-D in her house during July 1985. Other declarants claim they heard the song during August and September of 1985.

As is further discussed in n.2., *infra*, plaintiffs' only proof of direct access is testimony that a cassette tape containing Heaven-P was given to Jani Lane at a club in October 1985. Thus, establishing a date of authorship of Heaven-D before that October 1985 is critical to defendants' motion for summary judgment.

[\*11]

Plaintiffs have submitted evidence tending to show that Lane might have had access to Heaven-P in one of three ways: (1) by hearing one of ten to twenty cassette tapes (or a derivative of one of those tapes) containing a recorded version of Heaven-P which were distributed to musicians, managers, and record industry representatives in the Los Angeles and San Francisco areas from "early 1985 to mid-1986" by Mark Holley, an acquaintance of plaintiffs'; (2) by being at one of numerous parties in Los Angeles from 1984 to 1987 at which Richwine claims he played Heaven-P before "dozens to hundreds of people"; or (3) by hearing Richwine play Heaven-P on a keyboard unit at a recording studio in Los Angeles where Richwine worked. n2 Thus, plaintiffs have presented evidence tending to establish that Heaven-P was performed before and distributed to persons such as Lane, i.e. musicians in the Los Angeles "live band scene," prior to Lane's claimed date of authorship of Heaven-D. Plaintiffs are presented with two significant obstacles in demonstrating access: Lane was only in Los Angeles for four months at the most before authoring Heaven-D in July 1985 (he arrived in March 1985, and spent [\*12] an unspecified number of weeks from March to April in Ohio), and plaintiffs are unable specifically to link Lane, even through a chain of contacts, to any of the possible performances or recordings of Heaven-P before or during July 1985. Stressing the latter deficiency, defendants claim that plaintiffs' evidence is not sufficient to show access as a matter of law.

n2 Plaintiffs also claim Lane had access by virtue of a tape allegedly given to him in October of 1985 by an acquaintance of plaintiffs'. Given Lane's undisputed assertion of July 1985 authorship, such a contention is irrelevant. Nonetheless, plaintiffs press the argument, stating: "Even if one assumes the accuracy of Lane's July 1985 claim of composition, there is a very real possibility that Lane heard Heaven before July 1985 . . . in October 1985 from the tape given to him by Holley." Answer Brief p.25. Parties, such as

plaintiffs, who make Rule 11 motions for sanctions for frivolous filings should refrain from suggesting fact patterns that require a time machine to complete.

[\*13]

Although plaintiffs have produced no direct evidence demonstrating a particular link from them to Lane, the evidence submitted places Lane within Los Angeles in the small universe of local live band performers at a time when Heaven-P was being performed before people from this circle and distributed to same and the high degree of similarity (see *infra*) between the two works supports an inference of access. Indeed, where the similarity between two works is so striking as to "preclude any reasonable possibility of independent creation," the trier of fact is permitted to infer access without any affirmative evidence. *Gaste*, 863 F.2d at 1068; *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946); *Textile Innovations, Ltd. v. Original Textile Collections, Ltd.*, 1992 WL 125525, \*4 (S.D.N.Y.). Thus, if a jury could find two works to be strikingly similar, summary judgment on the issue of access is inappropriate.

Although there are conflicting expert affidavits on this issue, a reasonable juror could find that the two works are strikingly similar on the basis of plaintiffs' experts' testimony and on the basis of the [\*14] works themselves. *Gaste*, 863 F.2d at 1068. The two songs share a common chorus, with the melody, the words, and the phrasing being completely identical. Each chorus begins with the words "Heaven isn't too far away" sung to the identical eight notes. The same eight notes are then repeated in each song; in Heaven-P the lyrics are also

repeated, although in Heaven-D different lyrics are employed. Heaven-P then repeats the eight note melody and lyrics a third time, while Heaven-D employs a variant on the eight-note melody with different lyrics again. A mere textual description does not fully capture the sense of identity the listener experiences upon hearing the choruses of these two works; the perception is such that, in the words of Circuit Judge Learned Hand, "piracy appears almost inevitable." *Darrell v. Joe Morris Music Co.*, 113 F.2d 80, 80 (2d Cir. 1940). Thus, defendants' motion for summary judgment on the grounds of access will be denied.

However, in this case partial summary judgment for plaintiffs on the grounds of similarity is also not warranted. While the Court believes that an aural comparison of the two [\*15] choruses yields the conclusion that one must have been copied from the other, a reasonable juror might not necessarily agree. This issue is better left to the trier of fact, who will also have an opportunity to evaluate the credibility of the expert witnesses.

#### Conclusion

For the foregoing reasons, defendants' motion for summary judgment is DENIED. Plaintiffs' motion for partial summary judgment is DENIED. Plaintiffs' motion for sanctions is DENIED.

SO ORDERED.

May 18, 1993

JOHN S. MARTIN, JR., U.S.D.J.