Rupa Marya v. Warner Chappell Music Inc Doc. 219

BETSY C. MANIFOLD (182450)
manifold@whafh.com
WOLF HALDENSTEIN ADLER FREEMAN & HERZ LLP
750 B Street, Suite 2770
San Diego, CA 92101
Telephone: 619/239-4599
Facsimile: 619/234-4599

Interim Lead Counsel for Plaintiffs and the [Proposed] Class

GLENN D. POMERANTZ (112503)
glenn.pomerantz@mto.com
KELLY M. KLAUS (161091)
kelly.klaus@mto.com
MELINDA E. LeMOINE (235670)
melinda.lemoine@mto.com
ADAM I. KAPLAN (268182)
adam.kaplan@mto.com
MUNGER, TOLLES & OLSON LLP
355 South Grand Avenue
Thirty-Fifth Floor
Los Angeles, California 90071-1560
Telephone: (213) 683-9100
Facsimile: (213) 687-3702

Attorneys for Defendants Warner/Chappell Music, Inc. and Summy-Birchard, Inc.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA - WESTERN DIVISION

GOOD MORNING TO YOU PRODUCTIONS CORP., *et al.*,

Plaintiffs,

v.

WARNER/CHAPPELL MUSIC, INC., *et al.*,

Defendants.

Lead Case No. CV 13-04460-GHK (MRWx)

JOINT SUPPLEMENTAL BRIEF FILED PURSUANT TO DKT. NO. 215

Room: 650
Judge: Hon. George H. King, Chief Judge

Dockets.Justia.com

TABLE OF CONTENTS

Page

I. PLAINTIFFS' INTRODUCTION 1

II. WARNER/CHAPPELL'S INTRODUCTION 1

III. PLAINTIFFS' ARGUMENT 2

A. Abandonment Depends Upon the Nature of the Copyright 2

1. Abandonment Under the Federal Copyright Act 3

2. Abandonment Under the Common Law 4

B. Patty Hill Abandoned Any Common Law Copyright To *Happy Birthday* 5

1. Patty Hill's Overt Acts of Abandonment 6

2. Patty Hill's Subsequent Acts Confirming Abandonment 11

3. References to Jessica Hill and *Good Morning* Are Misleading 12

IV. WARNER/CHAPPELL'S ARGUMENT 14

A. Patty and Jessica Exploited, Fought to Protect, and Profited from the *Happy Birthday to You* Lyrics 14

B. Abandonment of a Common Law *or* Statutory Copyright Requires an Overt Act, and Not Just the Failure to Enforce One's Rights 17

C. Plaintiffs Have No Evidence That Patty Hill Abandoned Her Rights in the *Happy Birthday to You* Lyrics 18

D. Plaintiffs Have No Evidence That Jessica Hill Abandoned Her Rights in the *Happy Birthday to You* Lyrics 23

E. In the Alternative, There Are Triable Issues on Abandonment 24

TABLE OF AUTHORITIES

Page

FEDERAL CASES

A&M Records, Inc. v. Napster, Inc.¸
239 F.3d 1004 (9th Cir. 2001) 17

Abend v. MCA, Inc.,
863 F.2d 1465 (9th Cir. 1988) 2

Am. Tobacco Co. v. Werckmeister,
207 U.S. 284 (1907) 4

Application of People of State of N.Y.,
138 F. Supp. 661 (S.D.N.Y. 1956) 4

Ashton-Tate Corp. v. Ross,
916 F.2d 516 (9th Cir. 1990) 13

Bartlett v. Crittenden,
2 F. Cas. 967 (C.C.D. Ohio 1849) 4, 5, 17, 20

Bell v. Com. Reg. Co.,
397 F. Supp. 1241 (N.D. Ill. 1975) 3, 4

Bobbs-Merrill Co. v. Straus,
210 U.S. 339 (1908) 3

Capitol Records, Inc. v. MP3tunes, LLC,
821 F. Supp. 2d 627 (S.D.N.Y. 2011) 17

Covington Indus., Inc. v. Nichols,
2004 WL 784825 (S.D.N.Y. Apr. 12, 2004) 21

Davis v. Blige,
419 F. Supp. 2d 493 (S.D.N.Y. 2005) 13, 14

Davis v. Blige,
505 F.3d 90 (2d Cir. 2007) 23

Dodd, Mead & Co. v. Lilienthal,
514 F. Supp. 105 (S.D.N.Y. 1981) 21

Egner v. E.C. Schirmer Music Co.,
139 F.2d 398 (1st Cir. 1943) 22

Egner v. E.C. Schirmer Music Co.,
48 F. Supp. 187 (D. Mass. 1942) 9, 22

Ferris v. Frohman,
223 U.S. 424 (1912) 4

Hadady Corp. v. Dean Witter Reynolds, Inc.,
739 F. Supp. 1392 (C.D. Cal. 1990) 18

Hampton v. Paramount Pictures,
279 F.2d 100 (9th Cir. 1960) .... passim

Holmes v. Hurst,
174 U.S. 82 (1899) 3

Hosp. for Sick Children v. Melody Fare Dinner Theatre,
516 F. Supp. 67 (E.D. Va. 1980) 20

Johnson v. Berry,
171 F. Supp. 2d 985 (E.D. Mo. 2001) 15

Judscott Handprints, Ltd., v. Washington Wall Paper Co., Inc.,
377 F. Supp. 1372 (E.D.N.Y. 1974) 19, 24

Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.,
380 F.3d 624 (2d Cir. 2004) 2

Marvin Worth Prods. v. Superior Films Corp.,
319 F. Supp. 1269 (S.D.N.Y. 1970) 17, 19, 24

Maternally Yours, Inc. v. Your Maternity Shop, Inc.,
234 F.2d 538 (2d Cir. 1956) 22

Maurel v. Smith,
220 F. 195 (S.D.N.Y. 1915) 9

Meredith v. Smith,
145 F.2d 620 (9th Cir. 1944) 16

Mills Music v. Cromwell Music,
126 F. Supp. 54 (S.D.N.Y. 1954) 20, 24

National Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc.,
191 F.2d 594 (2d Cir. 1951) 3, 17, 19, 24

Neva, Inc. v. Christian Duplications Int'l, Inc.,
743 F. Supp. 1533 (M.D. Fla. 1990) 2

Nutt v. Nat'l Inst. Inc. for the Improvement of Memory,
31 F.2d 236 (2d Cir. 1929) 6, 20

Oravec v. Sunny Isles Luxury Ventures L.C.,
469 F. Supp. 2d 1148 (S.D. Fla. 2006) 18

Pac. & S. Co. v. Duncan,
572 F. Supp. 1186 (N.D. Ga. 1983) 18

Paramount Pictures Corp. v. Carol Publ'g Group,
11 F. Supp. 2d 329 (S.D.N.Y. 1998) 19, 24

Richlin v. MGM Pictures, Inc.,
531 F.3d 962 (9th Cir. 2008) 9, 14

Rohauer v. Killiam Shows, Inc.,
379 F. Supp. 723 (S.D.N.Y. 1974) 18, 21

Sandler and Richard Robins, Inc. v. Katz,
U.S.C.O. Bull. No. 20, 1924-35 (S.D.N.Y. June 8, 1925) 9, 10, 22

Schellberg v. Empringham,
36 F.2d 991 (S.D.N.Y. 1929) 6, 20

Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.,
161 F.2d 406 (2d Cir. 1946) 15

Sony BMG Music Entm't v. Tenenbaum,
672 F. Supp. 2d 217 (D. Mass. 2009) 19, 24

Sweet Music, Inc. v. Melrose Music Corp.,
189 F. Supp. 655 (S.D. Cal. 1960) 14

Tilford v. Jones,
2006 U.S. Dist. LEXIS 64729 (S.D. Tex. Sept. 11, 2006) 13

United States v. Hsia,
87 F. Supp. 2d 10 (D.D.C. 2000) 21

Weissmann v. Freeman,
868 F.2d 1313 (2d Cir. 1989) 13

Wheaton v. Peters,
33 U.S. 591 (1834) 4

White v. Kimmell,
193 F.2d 744 (9th Cir. 1952) 6, 7, 20, 22

White-Smith Music Publ'g. Co. v. Apollo Co.,
209 U.S. 1 (1908) 6

Young Money Entm't, LLC v. Digerati Holdings LLC,
2012 WL 5571209 (C.D. Cal. Nov. 15, 2012) 23

STATE CASES

Robert A. Kreiss, *Abandoning Copyright to Try to Cut Off Termination Rights*
58 MO. L. REV. 85, 100(1993) 2

Roby v. New York, C. & H. R. R. Co.,
142 N.Y. 176 (1894)....................4

Starrett City, Inc. v. Smith,
889 N.Y.S.2d 362 (Sup. Ct. 2009)....................4

STATUTES AND RULES

17 U.S.C. § 101....................9

Fed. R. Evid. 803(b)(3)(A)....................7

Fed. R. Evid. 805....................13

OTHER

Robert A. Kreiss, *Abandoning Copyright to Try to Cut Off Termination Rights*
58 MO. L. REV. 85, 100(1993)....................2

I. PLAINTIFFS' INTRODUCTION

The Court has directed Plaintiffs to identify evidence in the record that Patty Hill abandoned "her alleged rights to the *Happy Birthday* lyrics." Dkt. 215 at 1. Patty Hill never obtained a federal copyright to *Happy Birthday* – *i.e.*, the derivative work in which the familiar lyrics are set to the melody of *Good Morning to All* (the joint work she created with her sister Mildred before 1893) – and there is no evidence she ever tried to do so. Patty's name does not appear anywhere in the copyright records for E51990 (the principal copyright on which Defendants base their claim) or E51988.[1] Patty's sisters Mildred and Jessica had no copyright to *Happy Birthday* (Mildred's rights were limited to *Good Morning*). Patty wrote the *Happy Birthday* lyrics as a derivative work. The record includes evidence of at least six overt acts of abandonment by her and many other acts consistent with abandonment of any copyright to the *Happy Birthday* lyrics and her intent to give that song, unlike *Good Morning* (for which the copyright expired in 1949), to the public.

II. WARNER/CHAPPELL'S INTRODUCTION

Plaintiffs' abandonment argument fails as a matter of law. Plaintiffs rely on incorrect legal standards, inadmissible hearsay, conduct uniformly held not to constitute abandonment, and factual misrepresentations. Patty Hill did obtain a federal copyright in *Happy Birthday to You*, and the undisputed facts show why. Patty co-wrote the song with Mildred;[2] when Mildred died, her co-ownership interest passed to, among others, Mildred and Patty's sister, Jessica; in 1934 and 1935 Jessica licensed Clayton F. Summy Co. ("Summy") the rights to publish, copyright and sell the song as sheet music, as any

---

[1] Defendants originally asserted that Mildred Hill wrote the *Happy Birthday* lyrics. At the summary judgment hearing, they admitted that Patty, not Mildred, wrote the lyrics. *See*, *e.g.*, Dkt. 208 at 33:18-25. They have back-tracked from that admission, now asserting that Mildred wrote the lyrics with Patty. *See infra* at 14-15.

[2] Contrary to Plaintiffs' contention, *ante*, at n.1, Defendants stated on summary judgment that "[w]hile writing *Good Morning to All*, the Hill Sisters [*i.e.*, Mildred and Patty] wrote a number of songs with the melody of *Good Morning to All* but different titles and lyrics," one of which was *Happy Birthday to You*. Mot. for Summ. J. ("MSJ," Dkt. 182) at 4 (citing Ex. 87 at 1007-08); *see also* Ex. 50 at 664.

co-owner of the song could do; Summy then registered the copyright in the song upon publishing the sheet music; and the copyright inured to the benefit of the song's co-owners, including both Patty (who co-wrote the song) and Jessica (who inherited part of Mildred's co-ownership interest).[3] Finally, because both Patty and Jessica transferred all of their respective rights in *Happy Birthday to You* to Summy in 1944, Plaintiffs must prove that both Patty and Jessica abandoned their respective rights before this transfer. Plaintiffs cannot prove that either of them did. Undisputed evidence shows both Patty and Jessica exploited their rights in *Happy Birthday to You*, brought claims in federal court to protect those rights, and accepted royalties for the song's publication and performance.

III. PLAINTIFFS' ARGUMENT

A. Abandonment Depends Upon the Nature of the Copyright

The Copyright Act does not provide for abandonment of copyright; it is a judicially created doctrine. However, an author is free to withhold her work rather than publish or distribute it. *See* L. RAY PATTERSON & STANLEY W. LINDBERG, THE NATURE OF COPYRIGHT 52 (1991). Thus, "an author's abandonment of her copyrights should be honored as a matter of personal freedom and personal autonomy." Robert A. Kreiss, *Abandoning Copyright to Try to Cut Off Termination Rights* 58 MO. L. REV. 85, 100(1993). As Prof. Kreiss noted:

> An author might choose to abandon a work based on the author's desire to treat some works as non-economic in nature . . . . An author should be allowed to ***declare that a particular work is outside of the economic system*** . . . .

Id. (emphasis added).

---

[3] As a licensee, Summy was authorized to register the song for copyright. *Abend v. MCA, Inc.*, 863 F.2d 1465, 1468-70 (9th Cir. 1988), *aff'd sub nom. Stewart v. Abend*, 495 U.S. 207 (1990). Summy's registration of the copyright in its own named preserved the copyright for the song's co-owners. *Id.*; *see also Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624, 638 n.30, 645 (2d Cir. 2004); *Neva, Inc. v. Christian Duplications Int'l, Inc.*, 743 F. Supp. 1533, 1547-48 (M.D. Fla. 1990).

Abandonment depends upon the nature of the copyright in question. As discussed below, the test for abandonment under the common law differs from the test for abandonment under the federal Copyright Act. Before the Copyright Act was amended in 1976, federal and common law copyrights did not coexist for the same work. Works created prior to 1978 could not be protected under a common law copyright and the federal Copyright Act at the same time. The common law copyright ended when the statutory federal copyright began. *Holmes v. Hurst*, 174 U.S. 82, 85 (1899). *See also Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346-47 (1908) (citation omitted) (federal copyright begins when common-law right ends).

Since Patty never obtained a federal copyright to *Happy Birthday* or ever tried to obtain one,[4] whether she abandoned any alleged copyright to the *Happy Birthday* lyrics must be decided under state common law.

1. Abandonment Under the Federal Copyright Act

The test for abandonment of a ***federal*** copyright is whether the author has shown by some overt act his intention to surrender his or her federal copyright. As Judge Learned Hand held more than sixty years ago:

> [W]e do not doubt that the "author or proprietor of any work made the subject of copyright" by the Copyright Law may "abandon" his literary property in the "work" before he has published it, or his copyright in it after he has done so; but he must "abandon" it by some overt act which manifests his purpose to surrender his rights in the "work," and to allow the public to copy it.

National Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc., 191 F.2d 594, 598 (2d Cir. 1951), *modified*, 198 F.2d 927 (2d Cir. 1952).

In *Bell v. Com. Reg. Co.*, 397 F. Supp. 1241 (N.D. Ill. 1975), the court held:

> Abandonment of a copyright occurs if the owner intends to give up his copyright protection. Some overt act is necessary to evidence such an intent, *National Comics v. Fawcett Pub.*, 191 F.2d 594 (2d Cir. 1951), mere

[4] Defendants' unsupported assertion that Patty had a federal copyright to *Happy Birthday* is based on their fanciful speculation that Patty and Mildred wrote it together, even though Patty claimed that she wrote the lyrics herself. Ex. 87 at 1007.

> inaction is not enough, *Hampton v. Paramount Pictures*, 279 F.2d 100 (9th Cir. 1960). . . . A limited distribution, even if not widespread enough to effect a forfeiture, can, coupled with the requisite intent, cause an abandonment.

Id. at 1249. The court found that ***after registering a federal copyright*** for the poem "Desiderata," the author, Max Ehrman, abandoned his copyright by including it in Christmas cards he sent to friends, authorizing a psychiatrist to use the poem when treating soldiers, and declaring in his diary that he left a "gift" to the world. *Id*.

2. Abandonment Under the Common Law

The state common law copyright is regarded as an ordinary property right. *Ferris v. Frohman*, 223 U.S. 424, 434 (1912) (referring to the authors as having a "common-law right of property in the play"); *Wheaton v. Peters*, 33 U.S. 591, 657 (1834) ("an author, at common law, has a property in his manuscript . . . and exclusive property in the future publication of the work, after the author shall have published it to the world"); *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 290-91, 299 (1907) (considering the "nature of the property" in copyright).

Abandonment of a ***common law*** property right requires an intention to abandon or relinquish, which may be manifested either by an overt act ***or by some failure to act*** implying that the party neither claims nor retains any interest in the abandoned property. *See Starrett City, Inc. v. Smith*, 889 N.Y.S.2d 362, 365 (Sup. Ct. 2009) (tenant's failure to pay rent for over a year and absence from premises and relocation to Florida justified inference that she abandoned premises); *Roby v. New York, C. & H. R. R. Co*., 142 N.Y. 176, 181 (1894) ("easement may be abandoned by unequivocal acts showing a clear intention to abandon, ***or by mere non-user***, if continued for a long time") (emphasis added); *Application of People of State of N.Y.*, 138 F. Supp. 661, 666 (S.D.N.Y. 1956) ("property unclaimed over a large number of years has been abandoned"). No single act of abandonment is required; courts consider the totality of circumstances to decide whether a copyright has been abandoned. *See Am. Tobacco*, 207 U.S. at 299.

Bartlett v. Crittenden, 2 F. Cas. 967 (C.C.D. Ohio 1849), cited by Defendants *infra*

at 17, 20, does not support their argument that abandonment of a common law copyright, like abandonment of a federal copyright, also requires an overt act. Discussing the difference between transfer and abandonment (rather than between abandonment under common law and federal law), the court held only that "evidence of a transfer or abandonment must be as clear and as specific in the one case as in the other." *Id*. at 970.[5] The court never considered or addressed, and did not decide, that a common law copyright may only be abandoned by an overt act.

B. Patty Hill Abandoned Any Common Law Copyright To *Happy Birthday*

Mildred and Patty Hill jointly composed a collection of songs they published for the World's Fair in Chicago in 1893. Ex. 87 at 1006. Mildred composed the melodies and Patty wrote the lyrics for the songs. *Id*. at 1013. *Good Morning* was one of 73 songs included in the songbook *Song Stories for the Kindergarten*. Ex. 5 at 93. Patty explained how she and Mildred composed *Good Morning*:

> It [*Good Morning*] was one of the earliest of the group and for that reason took longer to work out with the children. It would be written and I would take it into the school the next morning and test it with the little children. If the register [*i.e.*, the singing part] was beyond the children we went back home at night and altered it and I would go back the next morning and try it again and again until we secured a song that even the youngest children could learn with perfect ease.

Ex. 87 at 1007. Patty claimed that she later wrote the *Happy Birthday* lyrics. *Id*. The *Happy Birthday* lyrics were ***not*** included in either the original (1893) or the revised (1896) edition of *Song Stories*. Ex. 1 at 9, ¶ 26, Ex. 2 at 50, ¶ 26.

Assuming Patty wrote the *Happy Birthday* lyrics, the record is replete with evidence that she abandoned any copyright to that work, both by her overt acts and by her persistent failure to act when others used the lyrics over a period of decades.

---

[5] In *Bartlett*, the plaintiff intended to publish his work under copyright and immediately complained about the defendant's own publication of his work. Here, there is no evidence that Patty ever intended to publish the *Happy Birthday* lyrics under copyright, and she never complained about anyone's use of those lyrics.

1. Patty Hill's Overt Acts of Abandonment

Patty Hill's first act of abandonment was to teach *Happy Birthday* to all her students without restricting their right to sing it anywhere and everywhere thereafter. She taught *Happy Birthday* to ***all her students*** and to other teachers as well, and she placed ***no restriction whatsoever on their subsequent use of the song***.[6] By not limiting their use of those lyrics, she left her students and colleagues free to sing and teach *Happy Birthday* whenever and wherever they wanted to for the rest of their lives. That way, *Happy Birthday* spread quickly and became immensely popular and part of the public conscience by 1901.

Nutt v. Nat'l Inst. Inc. for the Imp. of Memory, 31 F.2d 236 (2d Cir. 1929), cited by Defendants *infra* at 20 n.23, is irrelevant. There is a fundamental difference between lecturing to a class and teaching students and other teachers a new song. When a professor gives a lecture, he does not expect his students to memorize it and repeat it verbatim to all their family and friends for the rest of their lives. However, that is precisely what Patty Hill intended when she taught the *Happy Birthday* lyrics to all her students and to other teachers.[7]

In *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952), the Ninth Circuit reversed the district court's decision that the author of a manuscript entitled "Gaelic" retained his common law copyright after publishing the work, holding that "White clearly did not wish to publish Gaelic as a conventionally printed book . . . . His only apparent purpose was to enable any persons interested to obtain a copy of the manuscript." The

---

[6] There is no evidence that Patty Hill distributed copies of the *Happy Birthday* lyrics to her students. She most likely taught the song to them by telling them the words. Under the early versions of the Copyright Act, only tangible copies of copyrightable works were protected. *White-Smith Music Publ'g. Co. v. Apollo Co.*, 209 U.S. 1, 16 (1908) (perforated rolls used to produce music on player piano were not copies under then-existing Copyright Act).

[7] Likewise, a doctor who distributes unmarked copies of reprinted journal articles to patients does not expect them to republish the articles any more than he expects them to go out and treat other patients. *See Schellberg v. Empringham*, 36 F.2d 991, 994 (S.D.N.Y. 1929) (no abandonment where doctor provided copies of journal article to patients for informational purposes).

facts in *White* are very similar to the facts in this case. Both authors provided their works to a fairly large number of people (manuscripts given to 80 people in *White*, *id*. at 745); Patty Hill taught the new song to all her students for many years. Neither author placed any limitations on whom the work was given to, nor did they limit how the recipients could use it (*id.*at 745-46). Just as in *White*, Patty's act of teaching *Happy Birthday* to all her students and teachers in training for many years divested her of any copyright she had in those new lyrics.

Patty's overt acts of abandonment continued long after she taught the *Happy Birthday* song to all her students and other teachers:

(1) On August 15, 1934, Patty Hill told the *New York Times* that the use of *Happy Birthday* in the Broadway play "As Thousands Cheer" was a "plagiarism on the ***music***" of *Good Morning*, but claimed no interest in the *Happy Birthday* lyrics (Ex. 34 at 591) (emphasis added).

(2) On August 15, 1934, the *New York Herald* reported that performance of *Happy Birthday* in "As Thousands Cheer" used the melody, but not the words, of the song Patty Hill claimed as theirs. (Ex. 37 at 603).

(3) On August 27, 1934, Patty Hill told *Time* that she had "***no complaint to make of the use of the words because she long ago resigned herself to the fact that her ditty had become common property of the nation***," again referring to performance of *Happy Birthday* in "As Thousands Cheer" (Ex. 90 at 1047) (emphasis added).

(4) In *The Hill Foundation, Inc. v. Clayton F. Summy Co.*, No. 19-377 (S.D.N.Y.) (1942), when The Hill Foundation, on behalf of Patty and her sister Jessica Hill, sued Summy Co. for an accounting, the plaintiff asserted a claim under the federal copyrights for *Good Morning* only, and never asserted a claim under any common law copyright to the *Happy Birthday* lyrics. (Ex. 50).

Together, all these acts were a clear and unequivocal declaration that Patty did not intend to assert any copyright to the *Happy Birthday* lyrics.[8]

Any doubt that Patty Hill intended to forego any copyright to *Happy Birthday* was

---

[8] The statements attributed to Patty in the articles are admissible as statements against an unavailable declarant's pecuniary or property interest. *See* Fed. R. Evid. 803(b)(3)(A). Defendants do not argue otherwise, but merely wishfully assert without any analysis, *infra* at 21, that the cited statements satisfy no hearsay exception.

eliminated when she admitted that she and Mildred intended to protect only their copyright to the published work, *Good Morning* (which copyright Defendants concede expired in 1949), and did ***not*** intend to protect the *Happy Birthday* lyrics or any other lyrical variation of the song: "we were not trying to protect ourselves in any way ***except as to publication at that time***." Ex. 87 at 1024 (emphasis added). The only work published at that time was *Good Morning*. Ex. 87 at 1007 ("only the words 'Good Morning to All' were put in the book"). That is why, when The Hill Foundation sued Summy for an accounting, it asserted only the copyrights to *Good Morning*; no claim was made for an accounting under E51990 or E5198 because the Hill sisters knew those copyrights did ***not*** cover the *Happy Birthday* lyrics.[9] It is also why the Jessica Hill complained ***only*** about the *Good Morning* melody, not about the *Happy Birthday* lyrics when she sued Sam Harris and Irving Berlin for using *Happy Birthday* in "As Thousands Cheer" without permission. The Hill sisters always intended to protect their copyright in the *Good Morning* melody but – as Patty herself admitted – they also intended to share the *Happy Birthday* lyrics with the public.

Defendants cannot erase these acts of abandonment from the record simply by denying they exist. Instead, they try to confuse the Court by blurring the distinction between Mildred's and Patty's original joint work, *Good Morning*, with Patty's derivative work, *Happy Birthday*.[10] However, the record proves that Mildred and Patty protected ***only*** their rights to their joint work, *Good Morning*, which was published in 1893, 1896, 1899, and 1907, not *Happy Birthday*. They are not the same song. *Good Morning* was a joint work composed by Mildred and Patty.[11] According to Patty, *Good*

---

[9] Although The Hill Foundation alleged that Summy Co. allowed others to use the "sound and dialogue rights" for *Happy Birthday*, *see* Ex. 50 at 664, it complained that ***only*** their *Good Morning* copyright was infringed. That copyright did ***not*** include the new lyrics. It ***never*** asserted any copyright to the *Happy Birthday* lyrics.

[10] Defendents' predecessor, Summy Co., judicially admitted that the *Happy Birthday* lyrics – which Patty wrote – were added ***after*** Mildred and Patty created *Good Morning*. Ex. 51 at 680-81. Defendants' creative argument, *infra* at 14-15, that Mildred and Patty co-wrote *Happy Birthday*, is contradicted by Summy Co.'s binding admission.

[11] As defined in the Copyright Act, a "'joint work' is a work prepared by two or more
(footnote continued on following page)

Morning was one of the earliest songs they wrote together. Ex. 87 at 1007. *Happy Birthday* was one of many lyrical variations Patty later wrote using the melody Mildred composed for *Good Morning*. Ex. 87 at 1007. All those lyrical variations, including *Happy Birthday*, were derivative works.[12]

Patty's acts of abandonment of *Happy Birthday* are remarkably similar to the facts in *Egner v. E.C. Schirmer Music Co.*, 48 F. Supp. 187 (D. Mass. 1942), *aff'd,* 139 F.2d 398 (1st Cir. 1943) (finding abandonment through failure to assert rights). In *Egner*, the author of "The Caissons Go Rolling Along" taught the song to his fellow soldiers in 1908 so they could sing it to celebrate the reunion of two portions of their Army regiment. *Id*. at 188. Soon thereafter, the song became widely used throughout the military service. *Id*. In 1917, John Philip Sousa used the song in his own composition, "The Field Artillery March." *Id*. The author never objected to Sousa's use of the song, which ***constituted a practical abandonment . . . of his rights to a copyright***. *Id*. (emphasis added).

Sandler and Richard Robins, Inc. v. Katz, U.S.C.O. Bull. No. 20, 1924-35 (S.D.N.Y. June 8, 1925), also is especially instructive. Sandler allegedly composed the words and music of a lament, called "Eili Eili," in 1896. Ten years later, the song was published by someone named Goldberg without identifying its author. The song was

---

authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 U.S.C. § 101. The Copyright Act adopted the common law concept of joint authorship. *See Richlin v. MGM Pictures, Inc.*, 531 F.3d 962, 967 (9th Cir. 2008) (citing *Maurel v. Smith*, 220 F. 195, 199 (S.D.N.Y. 1915) (Hand, J.)).

[12] "A derivative work is a work based on or derived from one or more already existing works." COPYRIGHT OFFICE CIRCULAR 14, COPYRIGHT IN DERIVATIVE WORKS AND COMPILATIONS 1 (Oct. 2013). "The copyright in a derivative work covers ***only the additions, changes, or other new material*** appearing for the first time in the work. Protection does ***not extend to any preexisting material***, that is, previously published or previously registered works or works in the public domain or owned by a third party." *Id*. at 2 (emphasis added). Likewise, under Section 6 of the 1909 Copyright Act, "other versions of . . . copyrighted works when produced with the consent of the proprietor of the copyright in such work, or works republished with new matter, shall be regarded as ***new works*** subject to copyright under the provisions of this Act; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed . . . or be construed to imply an exclusive right to such use of the original works, or to ***secure or extend copyright in such original works***." (Emphasis added).

published several more times over several years without any authorship or copyright attribution. In 1917, it was performed during a concert at the Metropolitan Opera House in New York and soon thereafter became very popular in the Jewish community. Two years later, Sandler authorized a publisher to obtain a federal copyright for him. The publisher hired a composer to compose a piano arrangement for the song and registered a copyright in August of 1919. Sandler was later identified as the author of Eili Eili in articles written about the song.

On facts remarkably similar to this case, the court held that Sandler abandoned his copyright, holding, "it is to be regretted that Sandler, if in fact he wrote Eili Eili, cannot enjoy the fruits of his labor; but it is difficult to find that he did not, for many years, ***acquiesce in the wide-spread publication of the song***." *Id.* (emphasis added). As in this case, there was some doubt whether Sandler actually wrote the song in question (although Sandler at least produced a manuscript for Eili Eili, whereas no manuscript ever has been produced for *Happy Birthday*). Many years passed between when each song was written and when the respective federal copyrights were sought. Both songs became immensely popular (*Happy Birthday* obtained far more widespread popularity). Both songs were published many times without authorship or copyright ownership attributed to anyone. Both songs were performed on the stage in New York, after which music publishers sought to obtain federal copyrights for piano arrangements of them. Neither author sought to protect his or her rights to the song in question. Finally, the authors were identified in articles about each song (Patty Hill disclaimed ownership of the song in the articles written about *Happy Birthday*; Sandler never disclaimed ownership of Eili Eili).

Thus, these overt acts of distributing the song and renouncing any interest in it, together with Patty relying only upon the *Good Morning* copyright without claiming any copyright to the *Happy Birthday* lyrics, make it abundantly clear that she intended for *Happy Birthday* to be outside the economic system and, therefore, abandoned any common law copyright she may have had to that song's lyrics.

There is no evidence in the record – none – to support Defendants' argument, *infra*

at 16-17, that Patty and Jessica asserted "rights" to *Happy Birthday*. To the contrary, the evidence is overwhelming that the ***only*** rights Mildred and Patty ever asserted, exploited, or protected were to *Good Morning*: (i) they published *Good Morning* at least four times, but they ***never*** published *Happy Birthday*; (ii) they copyrighted *Good Morning*, but ***not*** *Happy Birthday*; (iii) they kept others from publishing *Good Morning*, but ***not*** *Happy Birthday* – which Patty herself admitted was "common property of the nation"; and (iv) they sued to protect their copyright to *Good Morning*, but ***never*** for *Happy Birthday*, and after the copyright to *Good Morning* expired in 1949, nobody has ever been sued for infringing *Happy Birthday*.

2. <u>Patty Hill's Subsequent Acts Confirming Abandonment</u>

The evidence that Patty Hill abandoned any copyright she may have had to *Happy Birthday* is consistent with a mountain of other evidence corroborating her intent to relinquish any copyright to the *Happy Birthday* lyrics:

(1) The *Happy Birthday* lyrics were not published in either version of *Song Stories* (Ex. 1 at 9, ¶ 26; Ex. 2 at 51, ¶ 26; Ex. 7 at 127).

(2) No infringement lawsuit was ever filed over the sale or use of *Happy Birthday* in the 1901 edition of *Inland Educator* (Ex. 8 at 212-213), in *Tell Me a True Story* in 1909 (Ex. 10 at 217-218), in *The Elementary Worker and His Work* in 1911 (Ex. 11 at 290), as sheet music published by Cable Company in 1912 (Ex. 13 at 492-493), in *Golden Book of Favorite Songs* (Ex. 14 at 495-497), as sheet music in *Harvest Hymns* in 1924. (Ex. 19 at 512), and as sheet music in *Children's Praise and Worship* (Ex. 21 at 528).[13]

(3) No infringement lawsuit was ever filed over the performance of *Happy Birthday* in *Girls About Town* in 1931 (Ex. 35), in *Bosko's Party* in 1932 (Ex. 25), in *Strange Interlude* in 1932 (Ex. 26), in *Baby Take a Bow* in 1934 (Ex. 30), in *The Old Homestead* in 1935 (Ex. 39), and in *Way Down East* in 1935) (Ex. 41).

(4) No infringement claim of any common law copyright for *Happy Birthday* was asserted in the original complaint filed in *Hill v. Harris* on Aug. 14, 1934 (Ex. 32 at 580-587) or in the amended complaint filed in that case on Jan. 28, 1935 (Ex. 36 at 594-601).

---

[13] Patty testified that she made it her business to be familiar with songs books published for young children, "especially those in this country." (Ex. 87 at 1018).

(5) No claim for infringement was asserted under either E51990 or E51988 in the complaint filed in *The Hill Foundation v. Postal Telegraph-Cable Co.* (filed Mar. 2, 1943) (Ex. 52 at 691-696).

These additional acts are fully consistent with Patty Hill's abandonment of any common law copyright she may have had in *Happy Birthday*; they are equally consistent with her vigorous protection of the federal copyright to *Good Morning*. The juxtaposition of these acts are overwhelming evidence that Patty intended for *Happy Birthday* – unlike *Good Morning* – to be outside the economic system and that she abandoned any common law copyright to that song's lyrics.

3. References to Jessica Hill and *Good Morning* Are Misleading

Faced with overwhelming evidence that Patty abandoned any copyright to the *Happy Birthday* lyrics, Defendants now resort to a new argument: that ***Jessica Hill*** also had to abandon the copyright to *Happy Birthday*. That sleight-of-hand is now the heart of their argument. Defendants deceptively assert that Mildred had a copyright to *Happy Birthday*, which Jessica inherited upon Mildred's death in 1916. In fact, Mildred had no copyright in the *Happy Birthday* lyrics because that was Patty's derivative work. Thus, there was nothing for Jessica to inherit from Mildred, and the issue of Jessica's abandonment is nothing more than a red herring.[14]

The parties agree that *Good Morning* was a joint work created by Mildred and Patty some time before it was published in 1893. *Good Morning* was one of the first songs the Hill sisters wrote together. Ex. 87 at 1007. *Happy Birthday*, on the other hand, was a derivative work subsequently created only by Patty (assuming the Court accepts Patty's testimony that she wrote those lyrics). The summary judgment record includes multiple admissions by Defendants that Patty, ***not*** Mildred, wrote the *Happy Birthday* lyrics. *See*, *e.g.*, Dkt. 208 at 19:17-19 ("the lyrics were written by Patty Hill"); 20:18 ("Patty says she did it"); 33:18-25 (admitting that Patty, not Mildred, wrote the lyrics).

[14] Defendants also argue, *infra* at 16, that Jessica Hill licensed *Happy Birthday* to Summy Co. in 1934 and 1935. That is false. In its answer to the amended complaint in *The Hill Foundation v. Summy Co.*, Summy Co. judicially admitted it acquired only rights to "***various piano arrangements of the said musical composition 'Good Morning to All***'" from Jessica. Ex. 81 at 684-85 (emphasis added).

Under the Copyright Act, each different version of a work is a separate work, and the copyright for either one does not cover the other. This concept applies even when the original work was a joint work and the derivative work was made by one of the original joint authors. Thus, in *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 523 (9th Cir. 1990), the Ninth Circuit held that an "author of a joint work does ***not*** acquire an authorship interest in derivative works that utilize part of the joint work." Likewise, in *Weissmann v. Freeman*, 868 F.2d 1313, 1317 (2d Cir. 1989), the Second Circuit reversed the district court's holding that both authors of a joint work also shared copyrights in a derivative work created by one author of the original work. *See also Davis v. Blige*, 419 F. Supp. 2d 493, 501 (S.D.N.Y. 2005) ("non-participating co-owner acquires no property rights in a newly created derivative work"); *Tilford v. Jones*, No. H-05-2989, 2006 U.S. Dist. LEXIS 64729, at *8 (S.D. Tex. Sept. 11, 2006) (prior interest in song is not sufficient to declare joint ownership in derivative work).

Jessica has only the rights she inherited as Mildred's heir. Since Mildred had no copyright to Patty's derivative work, Jessica did not inherit a copyright from Mildred in 1916,[15] and, thus, she had no interest in the *Happy Birthday* lyrics to abandon. Jessica did not abandon any rights she never had.[16]

---

[15] There is no admissible evidence to support Defendants' argument that either Patty or Jessica received any royalties from ASCAP for *Happy Birthday*. To begin, Ex. 126, the October 16, 1944, assignment agreement between Patty, Jessica, The Hill Foundation and Summy Co., refutes Defendants' argument: it expressly ***excludes*** ASCAP royalties – that is, Summy was ***not*** required to share any royalties from ASCAP (regardless of why they were paid to Summy) with Patty or Jessica. *Id*. at 1947 (¶ 6(a)). The other document they cite, Ex. 60, the January 1950 *American Family* magazine article, claims that Jessica was "supported by royalties from 'Happy Birthday,'" but did ***not*** say that the royalties came from ASCAP. The other assertion in that article, that "ASCAP reports that Happy Birthday is very valuable to the ASCAP repertory," is inadmissible hearsay within hearsay. *See* Fed. R. Evid. 805 (imbedded hearsay must separately fall within its own hearsay exception). Moreover, ASCAP does not attribute payment to any particular work.

[16] Regarding Defendants' last argument that there are triable issues of fact on whether Patty abandoned any alleged copyright to the *Happy Birthday* lyrics, *infra* at 24, both parties agreed the Court may decide disputed questions of fact on that issue before a jury trial of the remaining issues. Dkt. 208 at 47:20-21 (Defendants) and 79:5-7 (Plaintiffs).

IV. WARNER/CHAPPELL'S ARGUMENT

A. Patty and Jessica Exploited, Fought to Protect, and Profited from the *Happy Birthday to You* Lyrics

Happy Birthday to You was "written and composed by … Patty S. Hill and Mildred J. Hill." Ex. 50 at 664. Mildred and Patty jointly created the song sometime between 1889 and 1893. Ex. 87 at 1006. Patty's deposition explains that while she was the lyricist and Mildred the composer, the two worked together closely in creating *Happy Birthday to You* and other songs from this time period. Patty explained that she and Mildred "were writing" different versions of *Good Morning to All* "practically every day." *Id*. at 1007-08. The collaborative nature of Mildred and Patty's work is evident throughout Patty's testimony. *Id*. at 1007-09, 1013-15.[17] Similarly, when asked if she had seen Mildred and Patty working together on *Good Morning to All* and *Happy Birthday to You*, Jessica testified that she "saw it so often." *Id*. at 1031. Because *Happy Birthday to You* was a joint work, Mildred and Patty each held an undivided one-half interest in both the melody and lyrics of the song. *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.,* 531 F.3d 962, 967 (9th Cir. 2008) (defining a joint work at common law); *Sweet Music, Inc. v. Melrose Music Corp*., 189 F. Supp. 655, 659 (S.D. Cal. 1960) (noting default rule that each of two co-authors holds an undivided one-half interest in the joint work).[18]

---

[17] *See also* Ex. 87 at 1004 ("We were writing songs from 1889 to 1893."); *id*. at 1006 ("When my sister Mildred and I began the writing of these songs …."); *id*. ("[W]e wished the song to express the idea and the emotions …."); *id*. ("We did not write them for publication. We wrote them for the group of children I was teaching ….").

[18] Contrary to Plaintiffs' contention (*ante*, at 12-13), the record contains no evidence that Patty created *Happy Birthday to You* on her own. Patty and Jessica's unrefuted testimony (and not "fanciful speculation") demonstrates that both Mildred and Patty jointly created *Good Morning to All* in its various forms—including *Happy Birthday to You*—and other songs for their manuscript. Ex. 87 at 1004, 1007-09, 1013-15, 1031. Accordingly, Patty and Jessica's 1942 suit against Summy specifically alleged that *Happy Birthday to You* was "written and composed by the said Patty S. Hill and Mildred J. Hill." Ex. 50 at 664. Plaintiffs also are wrong on the law. *Ante*, at 13. They draw a false distinction between derivative and joint works. Their cases, however, show only that a person may not claim co-ownership of a derivative work that she took no part in creating. *E.g., Davis v. Blige*, 419 F. Supp. 2d 493, 501 (S.D.N.Y. 2005). Because Mildred actively participated with Patty in creating the *Good Morning to All*/*Happy Birthday to You* combination, the sisters (footnote continued on following page)

Mildred and Patty began exploiting their rights almost immediately. Mildred licensed *Good Morning to All* to Summy, which published and copyrighted the song in 1893, 1896 and 1899, and she contracted for a share of the sales. Exs. 50 at 663-64, 126 at 1939-40. Patty taught *Good Morning to All* and *Happy Birthday to You* to kindergartners and other teachers, although before *Good Morning to All* was published, she was careful to tell them "specifically that it must never appear in print." Ex. 87 at 1024. Patty was also careful to restrict the permissible uses of Mildred and Patty's works. Teachers were only to use *Good Morning to All*, in its various versions, "for educational purposes with young children." *Id*. at 1021.

Mildred died intestate in 1916. Ex. 50 at 670. Because Mildred and Patty had not yet published or authorized the publication of *Happy Birthday to You*, they shared a common law copyright in the song (*i.e.*, the melody and lyrics). MSJ at 16-20. As Defendants previously explained, Jessica inherited an interest in Mildred's common law co-ownership rights upon Mildred's death. MSJ at 17; Ex. 50 at 670.

Jessica fought to protect these rights. In 1934, Jessica sued producer Sam Harris and composer Irving Berlin for the unauthorized performance of *Happy Birthday to You* in "As Thousands Cheer." Ex. 32 at 580-87.[19] Patty and Jessica were both deposed in that case. They testified as to the creation of *Good Morning to All* and *Happy Birthday to You* and their limited awareness of unauthorized uses of these works. Ex. 87 at 1015-19, 1036-37. Patty explained that she "expected the publisher to look after that end of it." *Id*. at 1016, 1018. There is no testimony or any other evidence showing that either Patty or Jessica intended irrevocably to dedicate the lyrics to the public.

---

jointly owned the new work. It is irrelevant that the melody was composed first for a different song, or that Patty wrote the lyrics later. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406, 409-10 (2d Cir. 1946) (composer became the co-author of a new work when his 1911 melody was combined with 1912 lyrics that he did not write); *Johnson v. Berry*, 171 F. Supp. 2d 985, 988 (E.D. Mo. 2001) (Chuck Berry and Johnnie Johnson became co-owners of a new work when they "both willingly participated in the marriage of Johnson's pre-existing tune with Berry's newly-created lyrics.") (emphasis added); *see generally* 1 Nimmer on Copyright § 6.03.

[19] Jessica alleged that the performances infringed the *Good Morning to All* copyright. Defendants explain below why this does not support Plaintiffs' abandonment theory.

In 1934 and 1935, Jessica granted Summy the rights to publish, copyright, and sell *Happy Birthday to You* as sheet music, in exchange for a percentage of the list price for sales. Ex. 50 at 668-69; Ex. 126 at 1939-43, 1947.[20] Summy then published four musical and two lyrical versions of song. It published the lyrical versions in December 1935 and copyrighted them under registrations E51988 and E51990. Exs. 43, 44, 48, 106. Patty and Jessica's foundation, the Hill Foundation, sued Summy in 1942. Ex. 50. The Foundation asserted that Summy had exceeded the scope of its license to publish *Happy Birthday to You* sheet music by sublicensing the "sound and dialogue rights for the use of the song"—*i.e.*, the melody and lyrics—in movies and plays. Ex. 50 at 666-70 (emphasis added). The Hill Foundation sought an accounting from Summy for royalties received, and demanded that Summy account for a percentage of the sales of its *Happy Birthday to You* sheet music. *Id*. at 673-74.

Patty and Jessica settled their suit against Summy by transferring to Summy all of their respective rights in *Good Morning to All* and *Happy Birthday to You*. Ex. 126; *see also* Exs. 113, 115. The settlement also provided for the Hill Foundation to receive about $11,000, which reflected a portion of Summy's royalties for licensing the melody and lyrics of *Happy Birthday to You* in movies and plays (*i.e.*, the conduct that led to the suit in the first place). Ex. 126 at 1941, 1945-46; *see also* Exs. 50 at 666-67, 51 at 683. It also entitled the Hill Foundation to one-third of any recovery Summy obtained for the infringement of *Happy Birthday to You*. Ex. 126 at 1941-46. Similarly, the settlement provided for the Hill Foundation to receive one-third of any future royalties Summy collected for licensing *Happy Birthday to You*—which would include royalties for Summy's continued licensing of the *Happy Birthday to You* lyrics in movies and plays. Ex. 126 at 1945-46; *see also* Ex. 50 at 666-67.

The settlement did not affect the Hill Foundation's right to 10 percent of the list price for sales of *Happy Birthday to You* sheet music—including sales of sheet music

---

[20] As co-owner, Jessica could authorize Summy to publish, copyright, and sell the song. *Meredith v. Smith*, 145 F.2d 620, 621 (9th Cir. 1944).

with lyrics. Ex. 126 at 1947; *see also* Ex. 50 at 668-69. Nor did it make Patty or Jessica accountable to Summy for any royalties they received from ASCAP for *Happy Birthday to You*. Ex. 126 at 1947.[21] ASCAP was Patty and Jessica's "greatest protection against unlicensed commercial use of the song." Ex. 60 at 755. Jessica was "to a considerable extent supported by the royalties from 'Happy Birthday'" *Id*. at 754.[22]

B. Abandonment of a Common Law *or* Statutory Copyright Requires an Overt Act, and Not Just the Failure to Enforce One's Rights

"[A]bandonment of copyright occurs only if there is an intent by the copyright proprietor to surrender rights in his work." *A&M Records, Inc. v. Napster, Inc.*¸ 239 F.3d 1004, 1026 (9th Cir. 2001). Abandonment "must be manifested by some overt act indicative of a purpose to surrender the rights and allow the public to copy." *Hampton v. Paramount Pictures Corp.*, 279 F.2d 100, 104 (9th Cir. 1960). Plaintiffs bear the burden of proving abandonment. *Capitol Records, Inc. v. MP3tunes, LLC*, 821 F. Supp. 2d 627, 647-48 (S.D.N.Y. 2011). Plaintiffs incorrectly draw a distinction between abandonment of a common law copyright and abandonment under the Copyright Act. *Ante*, at 2-5. The same "overt act" requirement applies in each instance. Plaintiffs cite, but do not comprehend, the very law that makes this clear. *See Nat'l Comics Publ'ns, Inc. v. Fawcett Publ'ns*, *Inc.,* 191 F.2d 594, at 597-98 (2d Cir. 1951); *see also Marvin Worth Prods. v. Superior Films Corp.*, 319 F. Supp. 1269, 1273 (S.D.N.Y. 1970) ("As in *National Comics*, so here, there is no affirmative evidence of intention to abandon common law copyright ...."); *Bartlett v. Crittenden*, 2 F. Cas. 967, 970 (C.C.D. Ohio

---

[21] Summy was not required to share its publisher royalties with Patty or Jessica, but the sisters were entitled separately to a share of writer royalties from ASCAP. Ex. 126 at 1947; *see also* Ex. 60 at 755.

[22] Plaintiffs' attempt to cabin the 1934 and 1935 licenses to piano arrangements without lyrics, *ante*, at n. 14, fails for the reasons shown in Defendants' summary judgment papers, MSJ at 37. Plaintiffs' portrayal of these licenses also is flatly contradicted by what actually transpired after the licenses were executed: Summy published and copyrighted lyrical versions of *Happy Birthday to You*; Patty and Jessica challenged Summy's licensing of the lyrics; and Patty and Jessica resolved their dispute with Summy by transferring to it the lyrical versions of the songs in exchange for a share of future royalties derived from the songs.

1849).

The "overt act" requirement is demanding; findings of abandonment are uncommon. "Lack of action," such as the failure to police one's copyright through litigation or otherwise, is not enough. *Hampton*, 279 F.2d at 104; *see, e.g., Rohauer v. Killiam Shows, Inc.*, 379 F. Supp. 723, 730-31 (S.D.N.Y. 1974) (no abandonment where copyright owner failed to object to frequent television broadcasts of his film for 19 years), *rev'd on other grounds*, 551 F.2d 484 (2d Cir. 1977). Courts have found abandonment only in extreme cases, such as where the owner intentionally destroyed the only copy of the videotape at issue, *Pac. & S. Co. v. Duncan*, 572 F. Supp. 1186, 1196 (N.D. Ga. 1983), *aff'd in part, rev'd in part on other grounds*, 744 F.2d 1490 (11th Cir. 1984), signed a letter stating that "he 'reserve[d] no … copyright'" in his architectural design, as required to enter the World Trade Center design competition, *Oravec v. Sunny Isles Luxury Ventures L.C.*, 469 F. Supp. 2d 1148, 1178 (S.D. Fla. 2006), or employed a copyright notice explicitly stating that a commodities newsletter was protected by copyright only "through noon EST on the 2d day after its release," *Hadady Corp. v. Dean Witter Reynolds, Inc.*, 739 F. Supp. 1392, 1395 n.2, 1398-99 (C.D. Cal. 1990).

C. Plaintiffs Have No Evidence That Patty Hill Abandoned Her Rights in the *Happy Birthday to You* Lyrics

The record shows without exception that Patty intended to retain and exploit her rights in the *Happy Birthday to You* lyrics.

First, as a co-owner of the common law copyright in this song, Patty was entitled to share in the royalties and other benefits of Jessica's licenses with Summy to the extent of Patty's interest. These licenses allowed Summy to publish, copyright, and sell *Happy Birthday to You* sheet music in exchange for a percentage of the list price for sales. Ex. 50 at 668-69; Ex. 126 at 1939-43, 1947. Summy published, copyrighted, and sold six versions of *Happy Birthday to You* in 1934 and 1935, two of which included the *Happy Birthday to You* lyrics. *See* Ex. 1 at 15-19; Ex. 43; Ex. 106; MSJ at 40-45. There is no evidence that Patty ever disavowed her interest in the licenses. On the contrary, in 1944,

Patty, Jessica and Summy reaffirmed Patty and Jessica's rights to a share of sheet music sales, which would include sales of the *Happy Birthday to You* publications with lyrics. Ex. 126 at 1946-47. Courts routinely rely on evidence of publication and registration in rejecting claims of abandonment. *See*, *e.g., Fawcett,* 191 F.2d at 598 (attempts to publish a work are "conclusive evidence" of author's intent to retain his/her rights); *Judscott Handprints, Ltd., v. Washington Wall Paper Co., Inc.*, 377 F. Supp. 1372, 1378 (E.D.N.Y. 1974) (issuance of license to publish work with proper copyright notice "indicates a positive and continuing purpose to maintain one's rights") (citation and internal quotation marks omitted); *Marvin Worth*, 319 F. Supp. at 1273 (that plaintiff copyrights "his own material during his lifetime is compelling evidence that he intended his original work to be protected in every respect").

Second, after *Happy Birthday to You* sheet music was published and the copyright registered in 1935, Patty dedicated substantial time and resources to enforcing her rights in the *Happy Birthday to You* lyrics through litigation in the federal courts. She and Jessica, through the Hill Foundation, jointly sued Summy in 1942 to obtain a share of the royalties Summy received for licensing the lyrics in movies and plays. Ex. 50 at 666-70, 673. This undermines any claim that Patty "foreswore any effort to enforce [her] copyrights or otherwise intended to surrender the rights to [*Happy Birthday to You*]." *Sony BMG Music Entm't v. Tenenbaum*, 672 F. Supp. 2d 217, 233 (D. Mass. 2009); *see also Paramount Pictures Corp. v. Carol Publ'g Group*, 11 F. Supp. 2d 329, 337 (S.D.N.Y. 1998) (rejecting abandonment, and emphasizing that Paramount "expended substantial resources in enforcing its copyrights" in Star Trek properties).

Third, as part of the 1944 settlement with Summy, the Hill Foundation negotiated to receive $11,000, which reflected a share of Summy's royalties for having licensed the melody and lyrics of *Happy Birthday to You* in movies and plays; and one-third of any future royalties Summy collected for licensing *Happy Birthday to You*, which would include royalties for use of the *Happy Birthday to You* lyrics. Ex. 126 at 1941, 1945-46; *see also* Exs. 50 at 666-67, 51 at 683. Separately, Patty also received royalties for the

public performance of *Happy Birthday to You* through ASCAP. *See* Ex. 60 at 755. All this compels the conclusion that Patty never intended to abandon her copyright in the lyrics. *See, e.g.*, *Mills Music v. Cromwell Music*, 126 F. Supp. 54, 70 (S.D.N.Y. 1954) (no abandonment where author collected royalties for the use of his song).

Plaintiffs have no proof that Patty committed any overt act showing an intent to abandon her copyright interest before 1944, when she transferred all of her rights to Summy. Plaintiffs argue abandonment based on Patty teaching the song to kindergartners and other teachers. They once again conflate abandonment with divestive general publication (which the teaching, in any event, was not, *see* MSJ at 18-19). Courts have long held that teaching or performing one's work publicly is not an "overt act" showing an intent to abandon all rights in one's work. *See, e.g.*, *Bartlett*, 2 F. Cas. at 971 (no abandonment of common law copyright in manuscript where author used it in instructing students and allowed students to possess copies of it).[23] *White v. Kimmell*, 193 F.2d 744 (9th Cir. 1952), is inapposite because there is no evidence that Patty distributed <u>physical copies</u> of *Happy Birthday to You*;[24] and because Patty's teaching the song—which did not constitute publication—was "restricted both as to persons and purpose." *White*, 193 F.2d at 746-47.[25]

Plaintiffs also rely on cites from three newspaper or magazine articles. Two of the

---

[23] *See also Nutt v. Nat'l Inst. Inc. for the Improvement of Memory*, 31 F.2d 236, 238 (2d Cir. 1929) (no abandonment where author publicly delivered lectures prior to copyrighting them); *Schellberg v. Empringham*, 36 F.2d 991, 994 (S.D.N.Y. 1929) (no abandonment where doctor distributed unmarked copies of reprinted journal articles to patients for instructional purposes). Plaintiffs' attempt to distinguish these authorities is unpersuasive. *Ante,* at 6.

[24] *See, e.g., Hosp. for Sick Children v. Melody Fare Dinner Theatre*, 516 F. Supp. 67, 69-70 & n.3 (E.D. Va. 1980) (performances of the play *Peter Pan* between its creation in 1904 and its copyright in 1928 did not constitute "publication").

[25] *See* Ex. 87 at 1019 ("Q. And you were entirely willing that it should be used as extensively as possible with children? A. In training only with permission and for educational use, yes – where the children were simply singing it."); *id.* at 1021 ("Q. What did you expect them to do with it after you had taught it to them? [objection] A. Why, I expected them to use it for educational purposes with young children."); *id.* at 1023-24 ("Q. But they then thought there was no restriction placed upon their use? [objection] A. Provided it was with children and teachers.").

cites simply reference the allegations in the *Hill v. Harris* litigation, which was based on the *Good Morning to All* copyright. Exs. 34, 37. The third cite is inadmissible hearsay (Exhibit 37 is as well). Ex. 90. There is no evidence that Patty made the statement that Plaintiffs try to attribute to her in the third cite; the author does not quote Patty or claim to have spoken with her. In any event, even if Plaintiffs could show the third cite was a quotation from Patty (which they cannot), this cite would be hearsay that would not qualify for the statement-against-interest exception because Plaintiffs offer no evidence that Patty "perceive[d] and underst[ood] the potential consequences" of making the alleged statement. *United States v. Hsia*, 87 F. Supp. 2d 10, 15 (D.D.C. 2000). Moreover, the alleged statement, if admissible, would show only that Patty was "resigned" to the song being common property (Ex. 90), not that she intentionally "relinquish[ed] [her] rights" in it. *Covington Indus., Inc. v. Nichols*, 2004 WL 784825, at *5 (S.D.N.Y. Apr. 12, 2004).

Plaintiffs also make much of the fact that the suits against Harris and Summy were explicitly based on the *Good Morning to All* copyrights rather than the *Happy Birthday to You* copyright. Under controlling law, the failure to pursue a common law copyright claim in the *Harris* suit (before E51990 was registered) or a federal claim in the *Summy* suit (once E51990 was registered) is mere inaction or negative behavior, and not an "overt act" capable of demonstrating abandonment. *Hampton*, 279 F.2d at 104; *Dodd, Mead & Co. v. Lilienthal*, 514 F. Supp. 105, 108 (S.D.N.Y. 1981) (abandonment cannot be premised on "[m]ere inaction or negative behavior"); *Rohauer*, 379 F. Supp. at 730.[26] Jessica's and the Hill Foundation's election to base their suits on one valid and enforceable copyright that they owned (*Good Morning to All*) rather than another valid and enforceable copyright that they owned (*Happy Birthday to You*) does not "overtly" demonstrate an intent forever to relinquish their rights in the latter copyright.[27]

---

[26] Likewise, Jessica's failure to base her 1943 claim against the Postal Telegraph-Cable Co. on E51990 was not an "overt act" of abandonment. *Contra ante*, at 12.

[27] Moreover, the fact that Patty and Jessica did not identify E51990 in their complaint against Summy proves nothing, given that the settlement of this litigation entailed an (footnote continued on following page)

Plaintiffs incorrectly assert that Patty admitted when deposed that she did not intend to protect the *Happy Birthday to You* lyrics. In reality, Patty testified that before *Good Morning to All* was first published in *Song Stories for the Kindergarten*, "we were not trying to protect ourselves in any way except as to publication." Ex. 87 at 1024. Patty's intent is obvious because immediately before this, she explained that the other teachers "were told specifically that it [*i.e.*, the various versions of *Good Morning to All*] must never appear in print, that the book would be published and that they could not even from memory write it down and publish it." *Id*. (emphasis added). This evidences an intent to protect rights to *Good Morning to All* and its alternate versions, including *Happy Birthday to You*, not to abandon them.

Plaintiffs' continued reliance on *Egner* is misplaced as already shown in the summary judgment papers, at 20-21. In *Egner*, the plaintiff authorized publication of his work before he copyrighted it; that is why the First Circuit affirmed. *Egner v. E.C. Schirmer Music Co*., 139 F.2d 398, 399 (1st Cir. 1943). Plaintiffs have no evidence of a general or divestive publication here. Any claim that *Egner* holds that abandonment is shown by failing to object to unauthorized uses is foreclosed in this Circuit. *Hampton*, 279 F.2d at 104 (distinguishing *Egner* and holding that "lack of action" cannot support an abandonment defense). *Sandler and Richard Robins, Inc. v. Katz*, U.S.C.O. Bull. No. 20, 1924-35, pp. 621-625 (S.D.N.Y. June 8, 1925)—an obscure unreported order cited only by the district court in *Egner*—does not help Plaintiffs. It is not the law in the Ninth or Second Circuits.[28] *White v. Kimmell* does not help Plaintiffs either, for the reasons shown

---

accounting and future royalties for use of that very copyright. Ex. 126 at 1939-40, 1945-47. And Jessica could not even have asserted a common law copyright claim in the *Harris* suit because the court likely would have lacked pendent jurisdiction over the claim, *see Maternally Yours, Inc. v. Your Maternity Shop, Inc.,* 234 F.2d 538, 543-44 (2d Cir. 1956), and there was no diversity, Ex. 36 at 594. The fact that Patty (and Jessica) vigorously protected their rights to *Good Morning to All* does not suggest that Patty (or Jessica) intended to abandon their rights in *Happy Birthday to You*, which they also exploited and protected and from which they also profited.

[28] Language in *Sandler* suggests that it turned on estoppel principles. *See Sandler*, U.S.C.O. Bull. No. 20 at 625 ("[T]he defendant, who was personally known to Sandler, continued to publish and sell Eili Eili in the honest belief that it was a Jewish folk song,
(footnote continued on following page)

above.

Finally, none of the other items in Plaintiffs' "mountain" of acts that purportedly corroborate an intent to abandon *Happy Birthday to You* actually supports abandonment under Ninth Circuit law. *Ante*, at 11-12. The failure to publish the *Happy Birthday to You* lyrics alongside early publications of *Good Morning to All* in no way indicates an intent irrevocably to surrender their rights to *Happy Birthday to You*. And it is not an overt act, in any event. It is simply a failure to act. Likewise, the failure to bring infringement suits for unauthorized uses of *Happy Birthday to You* also "was at most lack of action," which does not satisfy the overt act requirement. *Hampton*, 279 F.2d at 104. Plaintiffs have no evidence that Patty Hill even was aware of the unauthorized uses they cite. MSJ at 19-20.

D. Plaintiffs Have No Evidence That Jessica Hill Abandoned Her Rights in the *Happy Birthday to You* Lyrics

Even if Plaintiffs were able to show that Patty Hill abandoned her rights, which they cannot, there would be no legal significance to that fact absent proof that her co-owner, Jessica, equally abandoned her rights. The evidence proves the opposite.[29]

The record is replete with evidence that Jessica intended to retain and exploit the rights she inherited in the *Happy Birthday to You* lyrics, and that she had not relinquished these rights before transferring them to Summy in 1944. Jessica licensed Summy the rights to publish, copyright, and sell *Happy Birthday to You* sheet music in exchange for a percentage of the list price for sales. Ex. 50 at 668-69; Ex. 126 at 1939-43, 1947. Summy did just this, securing registrations E51988 and E51990. This alone is

without a word of protest or complaint from him who now claims to be its author."). Plaintiffs cannot show detrimental reliance or estoppel.

[29] Summy obtained *Happy Birthday to You* from both Patty and Jessica Hill, so Plaintiffs must prove that both of these sisters committed an "overt act" demonstrating an intent to surrender their respective rights in the song. Neither Patty nor Jessica could relinquish the other sister's rights. *Davis v. Blige*, 505 F.3d 90, 100, 103-104 (2d Cir. 2007); *Young Money Entm't, LLC v. Digerati Holdings LLC*, 2012 WL 5571209, at *7 (C.D. Cal. Nov. 15, 2012) ("[A] co-owner in copyright may not transfer away more rights than he holds.").

compelling evidence that there was no abandonment. *Fawcett*, 191 F.2d at 598; *Judscott*, 377 F. Supp. at 1378; *Marvin Worth*, 319 F. Supp. at 1273.

Jessica also enforced her rights in *Happy Birthday to You* and/or *Good Morning to All*, through litigation. She sued a famous Broadway producer in 1935 and her family's longtime publisher in 1942. Ex. 1 at 14; Ex. 32; Ex. 50. These are not the acts of someone who intends to give up her rights to the public. Jessica's "aggressive litigation campaign" belies any suggestion she "foreswore any effort to enforce [her] copyrights or otherwise intended to surrender the rights to [*Good Morning to All* or *Happy Birthday to You*]." *Tenenbaum*, 672 F. Supp. 2d at 233; *see Carol Publ'g Group*, 11 F. Supp. 2d at 337.

Moreover, the Hill Foundation, which acted on Patty and Jessica's behalf, settled its suit against Summy in exchange for an $11,000 payment, based on the royalties Summy had collected in licensing the melody and lyrics of *Happy Birthday to You* in movies and plays, and a one-third share of any royalties Summy received in the future as a result of such licenses. Ex. 126 at 1941, 1945-46; *see also* Exs. 50 at 666-67, 51 at 683. Jessica also received, and was "to a considerable extent supported by," *Happy Birthday to You* royalties, Ex. 60 at 754-55, further demonstrating the absence of an intent to abandon, *Mills Music*, 126 F. Supp. at 70. Plaintiffs' purported evidence of abandonment is unavailing also for the reasons shown above.

E. <u>In the Alternative, There Are Triable Issues on Abandonment</u>

For the reasons stated, Plaintiffs' abandonment theory fails as a matter of law. If the Court disagrees, however, the Court must resolve the abandonment issue during a bench trial, and not on summary judgment, given the substantial evidence that neither Patty nor Jessica intended to abandon their rights in *Happy Birthday to You*.

Respectfully submitted,

Dated: June 15, 2015

WOLF HALDENSTEIN ADLER FREEMAN & HERZ LLP

By: */s/ Betsy C. Manifold*
BETSY C. MANIFOLD

FRANCIS M. GREGOREK
gregorek@whafh.com
BETSY C. MANIFOLD
manifold@whafh.com
RACHELE R. RICKERT
rickert@whafh.com
MARISA C. LIVESAY
livesay@whafh.com
750 B Street, Suite 2770
San Diego, CA 92101
Telephone: 619/239-4599
Facsimile: 619/234-4599

WOLF HALDENSTEIN ADLER FREEMAN & HERZ LLP
MARK C. RIFKIN (*pro hac vice*)
rifkin@whafh.com
JANINE POLLACK (*pro hac vice*)
pollack@whafh.com
270 Madison Avenue
New York, NY 10016
Telephone: 212/545-4600
Facsimile: 212-545-4753

Interim Lead Counsel for Plaintiffs

RANDALL S. NEWMAN PC
RANDALL S. NEWMAN (190547)
rsn@randallnewman.net
37 Wall Street, Penthouse D
New York, NY 10005
Telephone: 212/797-3737

HUNT ORTMANN PALFFY NIEVES DARLING & MAH, INC.
ALISON C. GIBBS (257526)
gibbs@huntortmann.com
OMEL A. NIEVES (134444)
nieves@huntortmann.com
KATHLYNN E. SMITH (234541)
smith@ huntortmann.com
301 North Lake Avenue, 7th Floor
Pasadena, CA 91101
Telephone 626/440-5200
Facsimile 626/796-0107
Facsimile: 212/797-3172

DONAHUE FITZGERALD LLP
WILLIAM R. HILL (114954)
rock@donahue.com
ANDREW S. MACKAY (197074)
andrew@donahue.com
DANIEL J. SCHACHT (259717)
daniel@donahue.com
1999 Harrison Street, 25th Floor
Oakland, CA 94612-3520
Telephone: 510/451-0544
Facsimile: 510/832-1486

GLANCY PRONGAY & MURRAY LLP
LIONEL Z. GLANCY (134180)
lglancy@glancylaw.com
MARC L. GODINO (188669)
mgodino@glancylaw.com
1925 Century Park East, Suite 2100
Los Angeles, CA 90067
Telephone: 310/201-9150
Facsimile: 310/201-9160

Attorneys for Plaintiffs

Dated: June 15, 2015

MUNGER TOLLES & OLSON

By: /s/ Kelly M. Klaus
KELLY M.KLAUS

KELLY M. KLAUS (161091)
kelly.klaus@mto.com
ADAM I. KAPLAN (268182)
adam.kaplan@mto.com
560 Mission St., 27th Floor
San Francisco, CA 94105
Telephone: 415/512-4000

MUNGER TOLLES & OLSON LLP
GLENN D. POMERANTZ (112503)
glenn.pomerantz@mto.com
MELINDA E. LEMOINE
melinda.lemoine@mto.com
355 South Grand Ave., 35th Floor
Los Angeles, CA 90071
Telephone: 213/683-9100

Attorneys for Defendants