

# **EXHIBIT 16**

Patry on Copyright  
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Chapter

17. Jurisdiction, Venue, and Forum Non Conveniens

IX. Subject-Matter Jurisdiction and the Prima Facie Case of Copyright Infringement

References

**§ 17:109. Section 410(c) prima facie evidentiary status to the validity of the copyright and of the facts stated in the certificate**

**West's Key Number Digest**

West's Key Number Digest, [Copyrights and Intellectual Property](#)  79

Holders of issued registrations are given significant procedural advantages in section 410(c),<sup>[1]</sup> by providing prima facie evidence to the validity of the copyright and of the facts noted in the certificate:

In any judicial proceedings the certificate of registration made before or within five years after first publication of work shall constitute prima facie evidence of the validity of copyright and of facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within discretion of the court.<sup>[2]</sup>

[Section 410\(c\)](#) does not affect the validity of the copyright,<sup>[3]</sup> only the evidentiary weight to be given to a certificate obtained within or outside of the statutory five-year period.<sup>[4]</sup> Because the five-year period is determined from publication, the technical concept of “publication” must be examined.<sup>[5]</sup> Courts have granted a certificate prima facie status for registrations beyond the five-year period<sup>[6]</sup> where there appeared to be little reason to call the validity of the facts in the certificate into question. Where there are doubts, however, prima facie status has been withheld.<sup>[7]</sup> In all cases, courts are free to make an independent determination, notwithstanding the Copyright Office's action pro or con.<sup>[8]</sup> [Section 410\(c\)](#) is an evidentiary rule, and has no bearing on the ultimate legal issue of copyrightability, which is determined by the court or the trier of fact.<sup>[9]</sup>

Although courts occasionally incorrectly hold that [section 410\(c\)](#) does not apply to unpublished works,<sup>[10]</sup> it does.<sup>[11]</sup> The correct way to parse the first sentence in [section 410\(c\)](#) is “the certificate of a registration made *before* ... first publication of the work” as well as “the certificate of a registration made ... *within* five years after first publication of the work” shall both “constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” The prima facie status applies, however, only if registration has actually been made (rather than just applied for)<sup>[12]</sup> and, with respect to ownership, applies only to the original claimant. Assignees not named in the certificate do not benefit from the presumption,<sup>[13]</sup> nor does a coauthor who is not named in the certificate.<sup>[14]</sup> Of course, if a coauthor is listed, the certificate constitutes prima facie

evidence of that status.[15]

The prima facie status accorded by [section 410\(c\)](#) is slight,[15.10] since the Copyright Office is merely an office of record. Of necessity, the Office's examination is limited. The large number of applications, the small number of examiners, the Office's inability to make factual determinations, and, in the case of derivative works, the Office's lack of comparison with works previously deposited in order to evaluate whether particular material has either already been registered or meets the requisite standard of originality, all contribute to a fairly cursory examination process.[16] [Section 410\(c\)](#) serves only to order the initial burden of production of evidence.[17] The small benefit provided by the certificate may, though, be of importance in particular circumstances, especially at the preliminary injunction stage.[18]

Defendants can rebut the prima facie effect accorded by the certificate and thereby shift the burden back to the plaintiff by introducing “some evidence” calling into question the plaintiff's originality or the facts stated in the certificate.[19] Defendant need not prove the ultimate proposition asserted since the ultimate risk of nonpersuasion remains on plaintiff.[20]

Requiring more than “some evidence” would be inconsistent with the nature of the examination process. The Copyright Office does not verify the facts stated in the certificate. While examination for originality does occur in a number of cases substantial, it does not occur in anything more than a cursory fashion in many instances.[21] Under these circumstances, according the certificate prima facie status much beyond the ability to prevail in the absence of any evidence challenging it is stretching matters.

This is not to say that the party challenging can rebut the certificate merely by denying its validity.[22] Defendant must offer a plausible basis for challenging the certificate, either in law or fact, but once such a plausible challenge is mounted, the presumption vanishes.[23] Some courts have stated that the burden shifts back to the certificate holder only once the challenger has “proved” its challenge.[24] If by this the courts mean that the burden of persuasion has shifted, then the statements in these cases are wrong. Once the challenge has been “proven” (the burden of persuasion has been met), defendant has prevailed on the merits and has not merely shifted the burden of production of evidence.[25]

The type of evidence required to rebut the presumptive force of the certificate will vary, understandably, with the type of challenge and the work involved. Where originality is challenged, evidence[26] that plaintiff's work was copied from a third party's copyrighted work[27] or from a public domain source,[28] that plaintiff's work is a derivative work that was not disclosed as such to the Copyright Office,[29] that it is clearly unoriginal,[30] as a matter of law and that the work was published without the requisite notice[31] is sufficient.[32]

In the case of challenges to the claimant's ownership, evidence that a third party created the work[33] or that the author named in the certificate contributed only ideas is sufficient to rebut the presumption. In the case of work-for-hire disputes, evidence that a claim by an individual for a work that was done within the scope of employment, or conversely, if by an employee that the work was not within the employee's scope of employment is sufficient,[34] as is, in the case of specially ordered or commissioned works, evidence that the work was not created at the instance or expense of the commissioning party.

Rebutting the prima facie effect of the certificate of registration is not the same as prevailing on the issue presented; it merely requires plaintiff to prove its case without the slight presumption provided by the certificate.

[FN1] 17 U.S.C.A. § 410(c).

[FN2] See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1203 (10th Cir. 2005); *MyWebGrocer, LLC v. Hometown Info, Inc.*, 375 F.3d 190, 192 (2d Cir. 2004); *Boisson v. Banian, Ltd*, 273 F.3d 262, 267 (2d Cir. 2001); *Langman Fabrics, a div. of Blocks Fashion Fabrics, Inc. v. Graff Californiawear, Inc.*, 160 F.3d 106, 111 (2d Cir. 1998). By contrast, § 209 of the 1909 Act granted prima facie status only to the facts stated in the certificate. *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 854 (6th Cir. 1991); *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, 2000 WL 1028634 (S.D. N.Y. 2000), vacated, 2004 WL 906301 (S.D. N.Y. 2004); *PRC Realty Systems, Inc. v. National Ass'n of Realtors, Inc.*, 766 F. Supp. 453, 461 (E.D. Va. 1991), aff'd in part, rev'd in part on other grounds, 972 F.2d 341 (4th Cir. 1992) (table). Nevertheless, many courts ignored the plain language of the statute and accorded prima facie status to the work's originality. See discussion in *Urantia Foundation v. Burton*, 1980 WL 1176 (W.D. Mich. 1980).

[FN3] *But see* the confused discussion in *Arthur v. Shoshone County*, 133 Idaho 854, 993 P.2d 617 (Ct. App. 2000).

[FN4] *Swirsky v. Carey*, 376 F.3d 841, 851 (9th Cir. 2004); *Sterpetti v. E-Brands Acquisition, LLC*, 2006 WL 1046949 (M.D. Fla. 2006); *Cameron v. Graphic Management Associates, Inc.*, 817 F. Supp. 19, 23 (E.D. Pa. 1992).

[FN5] *Niemi v. American Axle Mfg. & Holding Inc.*, 2008 WL 905558, at \*13–14 (E.D. Mich. 2008); *Shea v. Fantasy Inc.*, 2003 WL 881006 (N.D. Cal. 2003); *W.H. Porter, Inc. v. Kline Multiproducts, Inc.*, 2001 WL 35741246 (W.D. Mich. 2001).

[FN6] *R. Miller Architecture, Inc. v. Edgington Enterprises, Inc.*, 2006 WL 2226297 at \*5 (M.D. Fla., August 03, 2006); *i-Systems, Inc. v. Softwares, Inc.*, 2004 WL 742082 (D. Minn. 2004); *Gallup, Inc. v. Talentpoint, Inc.*, 2001 WL 1450592 (E.D. Pa. 2001); *Religious Technology Center v. Netcom On-Line Communication Services, Inc.*, 923 F. Supp. 1231, 1242 (N.D. Cal. 1995); *Cameron v. Graphic Management Associates, Inc.*, 817 F. Supp. 19, 23 (E.D. Pa. 1992); *Koontz v. Jaffarian*, 617 F. Supp. 1108, 1111 (E.D. Va. 1985), aff'd on other grounds, 787 F.2d 906 (4th Cir. 1986); *Goldsmith v. Max*, 1981 WL 1428 (S.D. N.Y. 1981). For a discussion of when the five year period runs in the case of works that are revised over a substantial period of time, see *Logicom Inclusive, Inc. v. W.P. Stewart & Co.*, 2004 WL 1781009 (S.D. N.Y. 2004).

[FN7] *Blackthorne Publishing, Inc. v. Black*, 210 F.3d 381 (9th Cir. 2000) (not granting certificate any presumption status); *Tuff 'N' Rumble Management, Inc. v. Profile Records, Inc.*, 1997 WL 158364 (S.D. N.Y. 1997) (not giving prima facie status); *World Thrust Films Inc. v. International Family Entertainment Inc.*, 1996 WL 605957 (S.D. Fla. 1996); *Shea v. Fantasy Inc.*, 2003 WL 881006 (N.D. Cal. 2003).

[FN8] *Celebration Intern., Inc. v. Chosun Intern., Inc.*, 234 F. Supp. 2d 905 (S.D. Ind. 2002); *SGC Communication Resources, LLC v. Seminar Center, Inc.*, 2001 WL 274053 (S.D. N.Y. 2001); *Whimsicality, Inc. v. Battat*, 27 F. Supp. 2d 456 (S.D. N.Y. 1998).

[FN9] *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 299 n.18 (3d Cir. 2004) (dissenting opinion of Judges Roth and Chertoff). See *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*,

122 F.3d 1211, 1218 (9th Cir. 1997); *SAS Institute, Inc. v. S & H Computer Systems, Inc.*, 605 F. Supp. 816, 827 (M.D. Tenn. 1985) (treating question of compliance with registration requirements as fact issue); *eScholar, LLC v. Otis Educational Systems, Inc.*, 2005 WL 2977569 (S.D. N.Y. 2005) (noting issue but not deciding it).

[FN10] *Logicom Inclusive, Inc. v. W.P. Stewart & Co.*, 2004 WL 1781009 (S.D. N.Y. 2004); *W.H. Porter, Inc. v. Kline Multiproducts, Inc.*, 2001 WL 35741246 (W.D. Mich. 2001).

[FN11] *William A. Graham Co. v. Haughey*, 430 F. Supp. 2d 458, 467 (E.D. Pa. 2006); *Religious Technology Center v. Netcom On-Line Communication Services, Inc.*, 923 F. Supp. 1231, 1242 (N.D. Cal. 1995); *Infodek, Inc. v. Meredith-Webb Printing Co., Inc.*, 830 F. Supp. 614, 622 (N.D. Ga. 1993); *PRC Realty Systems, Inc. v. National Ass'n of Realtors, Inc.*, 766 F. Supp. 453, 461 (E.D. Va. 1991), *aff'd in part, rev'd in part on other grounds*, 972 F.2d 341 (4th Cir. 1992).

[FN12] *Marshall & Swift v. BS & A Software*, 871 F. Supp. 952, 957 (W.D. Mich. 1994).

[FN13] *Lumiere (Rights) Ltd. v. Baker & Taylor, Inc.*, 116 F.3d 484 (9th Cir. 1997). Licensees may, however, institute litigation based either on a preexisting registration by the author or on a registration they obtain as a claimant, in which case § 410(c) vests their claimant status with prima facie status. Copyright Office regulations permit only the author or the owner of all rights to register a claim to copyright, 37 C.F.R. § 202.3(a)(3); Compendium II of Copyright Office Practices § 623.04(e) (“unacceptable transfer statements; less than all rights”). Nevertheless, it does on occasion happen that an owner of less than all rights registers a claim. Such a claim is sufficient for § 411(a) purposes, *Tang v. Hwang*, 799 F. Supp. 499, 503 n. 13 (E.D. Pa. 1992); *Wales Indus. Inc. v. Hasbro Bradley, Inc.*, 612 F. Supp. 510, 515 (S.D. N.Y. 1985).

[FN14] *Boardman v. County of Spokane*, 61 F.3d 909 (9th Cir. 1995).

[FN15] *Swan v. EMI Music Pub. Inc.*, 2000 WL 1528261 (S.D. N.Y. 2000).

[FN15.10] *Lapham v. Porach*, 2007 WL 1224924, at \*4 (S.D. N.Y. April 25, 2007) (the prima facie case “can be rebutted. In this case, plaintiff’s case unravels pretty quickly.”)

[FN16] See the court’s discussion of the April 8, 2003 letter from Marybeth Peters, Register of Copyrights to United States Court of Appeals for the Second Circuit in *Estate of Burne Hogarth v. Edgar Rice Burroughs, Inc.*, 342 F.3d 149, 166–167 (2d Cir. 2003); *Universal Furniture Intern., Inc. v. Collezione Europa USA, Inc.*, 2006 WL 2491201, at \*2 (4th Cir., August 29, 2006). In *Sapon v. DC Comics*, 2002 WL 485730 (S.D. N.Y. 2002), the court declined to give prima facie effect to a certificate that contained noticeable inconsistencies.

[FN17] See *Woods v. Bourne Co.*, 60 F.3d 978, 990 (2d Cir. 1995); *eScholar, LLC v. Otis Educational Systems, Inc.*, 2005 WL 2977569 (S.D. N.Y. 2005); *Sapon v. DC Comics*, 2002 WL 485730 (S.D. N.Y. 2002) (citing author). See also Federal Rule of Evidence 301:

In all civil actions and proceedings not otherwise provided for by Act of Congress or by these rules, a presumption imposes on the party against whom it is directed the burden of going forward with evidence to rebut or meet the presumption, but does not shift to such party the burden of proof in the sense of the risk of nonpersuasion, which remains throughout the trial upon the party on whom it was originally cast.

*See also* [Durham Industries, Inc. v. Tomy Corp.](#), 630 F.2d 905, 908 (2d Cir. 1980).

[FN18] *See, e.g.*, [Triad Systems Corp. v. Southeastern Exp. Co.](#), 64 F.3d 1330, 1335 (9th Cir. 1995).

[FN19] [Lamps Plus, Inc. v. Seattle Lighting Fixture Co.](#), 345 F.3d 1140, 1145 (9th Cir. 2003); [Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.](#), 122 F.3d 1211, 1217 (9th Cir. 1997); [Durham Industries, Inc. v. Tomy Corp.](#), 630 F.2d 905 (2d Cir. 1980); [Judith Ripka Designs, Ltd. v. Preville](#), 935 F. Supp. 237, 246–247 (S.D. N.Y. 1996). For decisions in the various circuits generally discussing rebuttal of the presumption under § 410(c), see:

#### **First Circuit**

[Saenger Organization, Inc. v. Nationwide Ins. Licensing Associates, Inc.](#), 119 F.3d 55, 59 (1st Cir. 1997) (unsuccessful effort to rebut ownership based on alleged violation of oral agreement on joint authorship since work for hire relationship existed); [CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc.](#), 97 F.3d 1504, 1513 (1st Cir. 1996); [Lotus Development Corp. v. Borland Intern., Inc.](#), 49 F.3d 807, 813 (1st Cir. 1995), *aff'd* by an equally divided court, 516 U.S. 233, 116 S. Ct. 804, 133 L. Ed. 2d 610 (1996)

#### **Second Circuit**

[Estate of Burne Hogarth v. Edgar Rice Burroughs, Inc.](#), 342 F.3d 149, 166–167 (2d Cir. 2003); [Boisson v. Banian, Ltd.](#), 273 F.3d 262, 267 (2d Cir. 2001); [Hamil America Inc. v. GFI](#), 193 F.3d 92, 98–99 (2d Cir. 1999) (supplemental registration sufficient to correct ownership by related companies); [Langman Fabrics, a div. of Blocks Fashion Fabrics, Inc. v. Graff Californiawear, Inc.](#), 160 F.3d 106, 111 (2d Cir. 1998); [Fonar Corp. v. Domenick](#), 105 F.3d 99, 104 (2d Cir. 1997); [Folio Impressions, Inc. v. Byer California](#), 937 F.2d 759, 763 (2d Cir. 1991); [Carol Barnhart Inc. v. Economy Cover Corp.](#), 773 F.2d 411 (2d Cir. 1985)

#### **Third Circuit**

[Masquerade Novelty, Inc. v. Unique Industries, Inc.](#), 912 F.2d 663 (3d Cir. 1990); [Schiffer Publishing, Ltd. v. Chronicle Books, LLC](#), 350 F. Supp. 2d 613 (E.D. Pa. 2004) (presumption rebutted on originality); [R&B, Inc. v. Needa Parts Mfg., Inc.](#), 2001 WL 1251211 (E.D. Pa. 2001), *aff'd* on other grounds, 50 Fed. Appx. 519 (3d Cir. 2002)

#### **Fourth Circuit**

[Universal Furniture Intern., Inc. v. Collezione Europa USA, Inc.](#), 2006 WL 2491201, at \*2 (4th Cir. 2006); [Bouchat v. Baltimore Ravens, Inc.](#), 241 F.3d 350 (4th Cir. 2001); [O'Well Novelty Co. v. Offenbacher, Inc.](#), 225 F.3d 655 (4th Cir. 2000); [ABC, Inc. v. Primetime 24](#), 232 F.3d 886 (4th Cir. 2000); [Silver Ring Splint Co. v. Digisplint, Inc.](#), 543 F. Supp. 2d 509, 513 (W.D. Va. 2008); [M. Kramer Mfg. Co., Inc. v. Andrews](#), 783 F.2d 421, 434 (4th Cir. 1986); [SecureInfo Corp. v. Telos Corp.](#), 387 F. Supp. 2d 593 (E.D. Va. 2005); [Superior Form Builders v. Dan Chase Taxidermy Supply Co., Inc.](#), 851 F. Supp. 222, 223 (E.D. Va. 1994), *aff'd*, 74 F.3d 488 (4th Cir. 1996); [Watkins v. Chesapeake Custom Homes, L.L.C.](#), 330 F. Supp. 2d 563, 571 (D. Md. 2004) (presumption rebutted)

#### **Fifth Circuit**

[Norma Ribbon & Trimming, Inc. v. Little](#), 51 F.3d 45, 47 (5th Cir. 1995) (presumption rebutted where defendant showed works substantially based on public domain works); [Lakedreams v. Taylor](#), 932 F.2d 1103, 1107 (5th Cir. 1991); [Buckward Digital Services, Inc v. Millar Instruments](#), 2006 WL 1118003

(S.D. Tex. 2006) (presumption not rebutted)

#### **Sixth Circuit**

Mid-South Institute of Self Defense Shooting, Inc. v. Habermehl, 221 F.3d 1335 (6th Cir. 2000) (work-for-hire registration rebutted); Hi-Tech Video Productions, Inc. v. Capital Cities/ABC, Inc., 58 F.3d 1093, 1095 (6th Cir. 1995)

#### **Seventh Circuit**

Mid America Title Co. v. Kirk, 59 F.3d 719, 721 (7th Cir. 1995); Wildlife Exp. Corp. v. Carol Wright Sales, Inc., 18 F.3d 502, 507 (7th Cir. 1994); O'Connor v. Cindy Gerke & Associates, Inc., 300 F. Supp. 2d 759 (W.D. Wis. 2002)

#### **Eighth Circuit**

United Telephone Co. of Missouri v. Johnson Pub. Co., Inc., 855 F.2d 604, 607 (8th Cir. 1988); Taylor Corp. v. Four Seasons Greetings, LLC, 315 F.3d 1039 (8th Cir. 2003); Janel Russell Designs, Inc. v. Mendelson & Associates, Inc., 114 F. Supp. 2d 856 (D. Minn. 2000)

#### **Ninth Circuit**

Lamps Plus, Inc. v. Seattle Lighting Fixture Co., 345 F.3d 1140, 1144 (9th Cir. 2003); Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1075–1076 (9th Cir. 2000); Entertainment Research Group, Inc. v. Genesis Creative Group, Inc., 122 F.3d 1211 (9th Cir. 1997); North Coast Industries v. Jason Maxwell, Inc., 972 F.2d 1031, 1033 (9th Cir. 1992); Bibbero Systems, Inc. v. Colwell Systems, Inc., 893 F.2d 1104, 1106 (9th Cir. 1990); Seiler v. Lucasfilm, Ltd., 808 F.2d 1316, 1321–1322 (9th Cir. 1986)

#### **Tenth Circuit**

Palladium Music, Inc. v. EatSleepMusic, Inc., 398 F.3d 1193, 1196 (10th Cir. 2005); Oklahoma Nat. Gas Co. v. LaRue, 156 F.3d 1244 (10th Cir. 1998) (finding certificate rebutted on work-for-hire grounds on summary judgment); Autoskill Inc. v. National Educational Support Systems, Inc., 994 F.2d 1476, 1487 (10th Cir. 1993); Gates Rubber Co. v. Bando Chemical Industries, Ltd., 9 F.3d 823, 832 (10th Cir. 1993); Harris Market Research v. Marshall Marketing and Communications, Inc., 948 F.2d 1518, 1526 (10th Cir. 1991); Todd v. Montana Silversmiths, Inc., 379 F. Supp. 2d 1110 (D. Colo. 2005)

#### **Eleventh Circuit**

Montgomery v. Noga, 168 F.3d 1282, 1289–1290 (11th Cir. 1999); Bateman v. Mnemonics, Inc., 79 F.3d 1532, 1541 (11th Cir. 1996); MiTek Holdings, Inc. v. Arce Engineering Co., Inc., 89 F.3d 1548, 1554 (11th Cir. 1996); Donald Frederick Evans and Associates, Inc. v. Continental Homes, Inc., 785 F.2d 897, 903 (11th Cir. 1986); Gulfstream Aerospace Corp. v. Camp Systems Intern., Inc., 428 F. Supp. 2d 1369 (S.D. Ga. 2006); Genzmer v. Public Health Trust of Miami-Dade County, 219 F. Supp. 2d 1275 (S.D. Fla. 2002)

#### **D.C. Circuit**

Stenograph L.L.C. v. Bossard Associates, Inc., 144 F.3d 96, 99 (D.C. Cir. 1998)

[FN20] Mid America Title Co. v. Kirk, 59 F.3d 719, 721 (7th Cir. 1995); LZT/Filliung Partnership, LLP v. Cody/Braun & Associates, Inc., 117 F. Supp. 2d 745 (N.D. Ill. 2000).

[FN21] See the court's discussion of the April 8, 2003 letter from Marybeth Peters, Register of Copy-

rights to United States Court of Appeals for the Second Circuit in *Estate of Burne Hogarth v. Edgar Rice Burroughs, Inc.*, 342 F.3d 149, 166–167 (2d Cir. 2003); *Universal Furniture Intern., Inc. v. Collezione Europa USA, Inc.*, 2006 WL 2491201, at \*2 (4th Cir., August 29, 2006). In *Sapon v. DC Comics*, 2002 WL 485730 (S.D. N.Y. 2002), the court declined to give prima facie effect to a certificate that contained noticeable inconsistencies.

[FN22] *Caldwell-Gadson v. Thomson Multimedia, S.A.*, 2001 WL 1388052 (S.D. Ind. 2001).

[FN23] *O'Connor v. Cindy Gerke & Associates, Inc.*, 300 F. Supp. 2d 759 (W.D. Wis. 2002).

[FN24] *CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504, 1513 (1st Cir. 1996); *Marobie-Fl., Inc. v. National Ass'n of Fire Equipment Distributors*, 2000 WL 1053957 (N.D. Ill. 2000); *R. Ready Productions, Inc. v. Cantrell*, 85 F. Supp. 2d 672 (S.D. Tex. 2000).

[FN25] See also *Shady Records, Inc. v. Source Enterprises, Inc.*, 2005 WL 14920 (S.D. N.Y. 2005).

[FN26] Evidence is just that; mere allegations of copying from other sources are insufficient. See *Stanislowski v. Jordan*, 337 F. Supp. 2d 1103 (E.D. Wis. 2004) (“Though [the defendant's] statement is potential evidence that may be used against the [plaintiffs], the Court, at this stage, gives little weight, absent something more, to the Defendants' allegations of unoriginality.”); Cf. *Schiffer Publishing, Ltd. v. Chronicle Books, LLC*, 350 F. Supp. 2d 613 (E.D. Pa. 2004) (defendant presented detailed evidence challenging originality).

[FN27] *Sapon v. DC Comics*, 2002 WL 485730 (S.D. N.Y. 2002); *Don Post Studios, Inc. v. Cinema Secrets, Inc.*, 124 F. Supp. 2d 311 (E.D. Pa. 2000).

[FN28] *Norma Ribbon & Trimming, Inc. v. Little*, 51 F.3d 45, 47–48 (5th Cir. 1995); *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 763 (2d Cir. 1991); *William A. Graham Co. v. Haughey*, 2006 WL 1704539 at \*1 (E.D. Pa., June 14, 2006); *Stanislowski v. Jordan*, 337 F. Supp. 2d 1103 (E.D. Wis. 2004); *Imperial Toy Corp. v. Goffa Intern. Corp.*, 988 F. Supp. 617, 619 (E.D. N.Y. 1997). See also *Garcia-Goyco v. Puerto Rico Highway Authority*, 275 F. Supp. 2d 142, 152 (D.P.R. 2003) (defendant rebutted § 410(c) presumption by demonstrating material in question was unprotectible under § 102(b)).

[FN29] *Fonar Corp. v. Domenick*, 105 F.3d 99, 104 (2d Cir. 1997); *Folio Impressions, Inc. v. Byer California*, 937 F.2d at 763–764; *Watkins v. Chesapeake Custom Homes, L.L.C.*, 330 F. Supp. 2d 563, 572–573 (D. Md. 2004); *Bell v. E. Davis Intern., Inc.*, 197 F. Supp. 2d 449 (W.D. N.C. 2002), *aff'd*, 45 Fed. Appx. 253 (4th Cir. 2002); *Janel Russell Designs, Inc. v. Mendelson & Associates, Inc.*, 114 F. Supp. 2d 856, 863 (D. Minn. 2000); *Gibson Tex, Inc. v. Sears Roebuck & Co.*, 11 F. Supp. 2d 439 (S.D. N.Y. 1998); *Native Textiles, div. of Carisbrook Inc. v. Intimate Touch Inc.*, 1993 WL 14962 (S.D. N.Y. 1993). See also *Watkins v. Chesapeake Custom Homes, L.L.C.*, 330 F. Supp. 2d 563, 571–572 (D. Md. 2004) (presumption rebutted where statements that material used with permission was false). Cf. *Bouchat v. Baltimore Ravens, Inc.*, 241 F.3d 350, 357 (4th Cir. 2001) (failure to disclose “obvious inclusion” of public domain element excused).

[FN30] See *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (“Once defendant's response to plaintiff's claim put in issue whether the four Barnhart forms were copyrightable,

[the trial court] correctly reasoned that the ‘mute testimony’ of the forms put him in as good a position as the Copyright Office to decide the issue.”); [Durham Industries, Inc. v. Tomy Corp.](#), 630 F.2d 905, 908–09 (2d Cir. 1980) (“One look at Tomy's figures reveals that, in each the element of originality that is necessary to support a valid copyright is totally lacking.”). *See also* [Universal Furniture Intern., Inc. v. Collezione Europa USA, Inc.](#), 2006 WL 2491201 (4th Cir. August 29, 2006) (useful article).

[FN31] [Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.](#), 288 F. Supp. 2d 544 (S.D. N.Y. 2003).

[FN32] [Sefton v. Webbworld, Inc.](#), 2001 WL 34313227 (N.D. Tex. 2001).

[FN33] [O'Connor v. Cindy Gerke & Associates, Inc.](#), 300 F. Supp. 2d 759 (W.D. Wis. 2002); [Bell v. E. Davis Intern., Inc.](#), 45 Fed. Appx. 253 (4th Cir. 2002).

[FN34] [Mid-South Institute of Self Defense Shooting, Inc. v. Habermehl](#), 221 F.3d 1335 (6th Cir. 2000) ; [Genzmer v. Public Health Trust of Miami-Dade County](#), 219 F. Supp. 2d 1275 (S.D. Fla. 2002) (individual created software as for-hire); [Montgomery v. Alcoa, Inc.](#), 19 Nat'l Disability Law Rep. P 177, 2000 WL 1769526 (E.D. Mich. 2000), *aff'd*, 11 Fed. Appx. 471 (6th Cir. 2001); [WindSoft Inc. v. Intercon Systems \(1988\) Ltd.](#), 1995 WL 903453 (D.N.J. 1995) (evidencing status of work-for-hire certificate weak due to having been obtained during litigation). *Cf.* [Oklahoma Nat. Gas Co. v. LaRue](#), 156 F.3d 1244 (10th Cir. 1998) (employee's certificate invalidated, court finding work was created within scope of employment). In [Pem-America, Inc. v. Sunham Home Fashions, LLC](#), 83 Fed. Appx. 369 (2d Cir. 2003), the court of appeals appears to have confused two issues. Defendant asserted fraud on the Copyright Office alleging, among other things, that plaintiff falsely claimed the work was for-hire. Plaintiff produced a transfer agreement, thereby indicating that the work was not for-hire. The court, invoking a controversial practice in that (and in certain other circuits) of disallowing third parties to challenge the sufficiency of a transfer, see Chapter 4, text at notes 485–490, held that defendant had no standing to challenge the matter, seemingly referring to the erroneous work-for-hire designation. If this was the import of the court's holding, it was wrong: a false designation of authorship is not an equitable matter, but is a violation of the statute. *Cf.* [In re Napster, Inc. Copyright Litigation](#), 191 F. Supp. 2d 1087 (N.D. Cal. 2002) (distinguishing this line of cases and permitting discovery into defendant's challenge where recording artists also contested work-for-hire designation).

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