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**UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA**

_____)
DONNA CORBELLO,)
)
Plaintiff,)
)
vs.)
)
THOMAS GAETANO DEVITO et al.,)
)
Defendants.)
_____)

2:08-cv-00867-RCJ-PAL

ORDER

Plaintiff Donna Corbello is the widow and heir of Rex Woodard, who assisted Defendant Thomas Gaetano “Tommy” DeVito in writing his unpublished autobiography (the “Work”). Plaintiff alleges that DeVito and others wrongfully appropriated the Work to develop the screenplay for *Jersey Boys*, a hit musical based on the band The Four Seasons that has played in the United States, Canada, England, and Australia. Corbello has sued several companies and individuals for copyright infringement, and she has sued DeVito for an accounting and under several state law causes of action. The Court granted summary judgment to certain Defendants and certified the order for immediate appeal. The Court of Appeals reversed and remanded for further proceedings. Pending before the Court are four motions for summary judgment.

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1 **I. FACTS AND PROCEDURAL HISTORY**

2 **A. Factual Background**

3 **1. The Work**

4 Rex Woodard was an attorney, author, and avid Four Seasons fan who finally met
5 Defendant and founding Four Seasons member Tommy DeVito for an interview on December 9,
6 1981 as a result of the publicity generated from an article Woodard had written about the band in
7 *Goldmine* magazine earlier that year (the “1981 Article”) that focused on the years between the
8 band’s breakup in 1970 and reconstitution in 1975. (*See* Third Am. Compl. ¶¶ 26–29, ECF No.
9 457). On December 23, 1981, Woodard interviewed Tommy’s brother Nick DeVito, and on
10 January 8, 1982 he interviewed Nick Massi, another founding member of The Four Seasons. (*Id.*
11 ¶ 29). The result of these three interviews was a second article published in *Goldmine* in June of
12 1982 (the “1982 Article”), which focused on the band’s earliest incarnation, The Four Lovers.
13 (*Id.*).

14 Woodard kept in touch with DeVito and founding Four Seasons member Frankie Valli
15 throughout the 1980s, and in November of 1988 Woodard flew to Las Vegas, Nevada for a series
16 of interviews (the “1988 Interviews”) with DeVito that sowed the seeds of the present litigation.
17 (*See id.* ¶ 31–32). During these interviews, DeVito explained to Woodard that except for Valli
18 and final Four Seasons founding member Robert “Bob” Gaudio, the members of the band
19 (DeVito and Massi) had spent several years engaged in criminal enterprises and in prison and
20 retained “underworld contacts” throughout the band’s era of popularity. (*See id.* ¶ 32). Because
21 this revelation was in stark contrast to the clean-cut image of the band presented in the popular
22 media, Woodard realized the journalistic value of the story, and DeVito offered Woodard the
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1 opportunity to write his authorized biography with full credit and an equal share in any profits.
2 (*See id.*).

3 Woodard returned to Beaumont, Texas to begin writing DeVito's authorized biography
4 (the "Work"), which has never been published. (*See id.*). On December 1, 1988, Woodard sent
5 DeVito a letter (the "Letter Agreement") memorializing their previous verbal understandings
6 concerning creation of the Work. (*Id.* ¶ 33). DeVito signed the Letter Agreement beneath the
7 word "APPROVED" and mailed it back to Woodard. (*See id.*; Letter Agreement, Dec. 1, 1988,
8 ECF No. 457-11). The Letter Agreement reads in full:

9 December 1, 1988

10 Mr. Tommy DeVito
11 [street address]
12 Las Vegas, Nevada [zip code]

13 Dear Tommy:

14 I am making progress on the taped interviews we did. You suggested that
15 I prepare a written memorandum of our arrangement for future reference. I will
16 do so by this letter.

17 I agreed to write your authorized biography based on the recorded
18 interviews you gave me, plus any other relevant information which would benefit
19 the book. You and I will be shown as co-authors, with you receiving first billing.
20 I will do all of the actual writing, but you will have absolute and exclusive control
21 over the final text of this book.

22 We have further agreed that we will share equally in any profits arising
23 from this book, whether they be in the form of royalties, advances, adaptations
24 fees, or whatever. This agreement will be binding upon our heirs, both as to
obligations and benefits, in the event one or both of us should die.

If this letter accurately sets forth our agreement as you understand it, sign
the enclosed photocopy where indicated and return it to me in the enclosed self-
addressed, stamped envelope. Keep this original letter in your own file.

Thank you for asking me to work with you on this project. I look forward
to working with you over the next several months.

1 Sincerely,
2 [signed Rex Woodard]
Rex Woodard

3 RW/ml
4 Enclosures

5 APPROVED:
6 [signed Tommy DeVito]
TOMMY DEVITO

7 (Letter Agreement). Over the next two years, Woodard used the 1988 Interviews and all of his
8 other knowledge about the band to create the Work, including his past interviews with band
9 members, newspaper articles, magazine articles, album linings, Freedom of Information Act
10 requests he filed with law enforcement agencies, and questionnaires he sent to DeVito. (Third
11 Am. Compl. ¶ 34). Woodard compiled all of this information into the Work, resulting in a first-
12 person, narrative-style biography told from DeVito's perspective. (*See id.*). Woodard remained
13 in close contact with DeVito throughout his creation of the Work and sent DeVito each chapter
14 for approval and editing as they were completed. (*Id.* ¶ 35).

15 **2. Woodard's and DeVito's Publication Attempts**

16 As the Work neared completion in late 1990, Woodard and DeVito attempted to find a
17 publisher and even provided an outline of the Work to actor Joe Pesci to explore adaptation to a
18 screenplay. (*See id.* ¶ 36). Plaintiff provides a copy of what she claims is a cover sheet to a
19 January 1991 version of the Work, which reads in full:

20 UNTITLED
TOMMY DEVITO/FOUR SEASONS
21 BIOGRAPHY

22

23 TOMMY DEVITO
24 REX WOODARD
©, January, 1991

1 (See January 1991 Work Cover Page, ECF No. 457-15).

2
3 Though he never smoked, Woodard had been diagnosed with lung cancer in 1989, and
4 his condition had begun seriously to worsen by late 1990. (*Id.* ¶ 39). By February or March of
5 1991, he was bedridden, and he died on May 25, 1991 at age forty-one. (*Id.* ¶ 40). Woodard had
6 hoped that income generated from the Work would support his wife and children. (*Id.* ¶ 41).

7 **3. Plaintiff's and Ceen's Publication Attempts**

8 In accordance with Woodard's wishes, Plaintiff and Woodard's sister Cindy Ceen
9 continued to seek publication after Woodard's death independently of DeVito; however, public
10 interest in The Four Seasons had waned, making it difficult to find a publisher. (*Id.* ¶ 42). In
11 September 2005, Ceen decided to contact DeVito for his assistance in publishing the Work. (*See*
12 *id.*). Ceen first contacted a prominent member of an Internet Four Seasons fan group named
13 Charles Alexander to facilitate contact with DeVito. (*See id.* ¶ 43). Alexander responded to Ceen
14 on September 22, 2005 that he had met with DeVito the previous day, had told DeVito of Ceen's
15 desire to publish the Work, and that DeVito had agreed to help. (*See id.*). Ceen called DeVito
16 the same day at a telephone number provided by Alexander, and DeVito indicated that he wanted
17 to update the Work with post-1990 events and restore some "obscene" language Woodard had
18 omitted. (*Id.*). DeVito also claimed he had lost his copy of the Work and asked Ceen for a
19 replacement, which she mailed to DeVito the next day, along with a letter memorializing their
20 telephone conversation and informing DeVito that Plaintiff was considering self-publishing the
21 Work if a traditional publisher could not be found. (*Id.*). Neither Plaintiff nor Ceen heard from
22 DeVito again. (*Id.* ¶ 44). DeVito's attorney Jay Julien left Ceen a voice mail message on
23 November 2, 2005, and Ceen returned his call the next day, during which conversation Julien
24 told Ceen that he had spoken with DeVito regarding the Work and concluded that it was "not

1 saleable.” (*Id.*). Ceen was surprised by this conclusion, because the play *Jersey Boys* was
2 scheduled to open on Broadway a few days later. (*Id.*). Julien did not disclose that the Work had
3 been used or exploited in any way or that rights in the Work had been licensed or assigned. (*Id.*).

4 **4. *Jersey Boys* and Plaintiff’s Discovery of the Alleged Infringements**

5 By late 2006, *Jersey Boys* had become a Broadway hit, earning four Tony Awards. (*Id.*
6 ¶ 45). Plaintiff had not seen the show, but she and Ceen estimated that the show’s success would
7 revive interest in the band and make publication of the Work viable. (*Id.*). Plaintiff and Ceen
8 engaged counsel to confirm the registration of Woodard’s and DeVito’s copyright in the Work,
9 to register the copyright if not yet registered, and to contact Julien to see if DeVito had changed
10 his mind about joint publication of the Work in light of *Jersey Boys*’s success. (*Id.*). A January
11 3, 2007 search of the U.S. Copyright Office’s online records indicated no registration of the
12 Work to Woodard but showed that on January 11, 1991 (four months before Woodard’s death)
13 DeVito had registered a literary work entitled *Tommy DeVito - Then and Now*, Reg. No. Txu 454
14 118 (the “DeVito Work”). (*Id.* ¶ 46). Plaintiff’s counsel ordered a copy of the registration and
15 discovered that DeVito had registered the DeVito Work in his own name only, claiming that the
16 work was unpublished and that he wrote it in its entirety in 1990. (*Id.* ¶ 47). Plaintiff’s counsel
17 ordered a copy of the DeVito Work itself and discovered that the DeVito Work was identical to
18 the Work, and in fact appeared to be a photocopy of the manuscript typed by Woodard’s
19 secretary Myrtle Locke, with two exceptions. (*Id.* ¶¶ 48–49). First, the original cover page from
20 the January 1991 version of the Work had been replaced with a cover page in a different font and
21 font size, reading:

22 TXu 454 118

23

1 Tommy DeVito - Then and Now
2 by
3 Tommy DeVito

4 (*Id.* ¶ 49; *see* DeVito Work Cover Page, ECF No. 457-23). Second, the first page of Chapter 41
5 (page 264 of the Work) was missing. (*See* Third Am. Compl. ¶ 49). Plaintiff concluded in light
6 of the Letter Agreement and her dealings with DeVito and his counsel after Woodard’s death
7 that DeVito had registered the Work without credit to Woodard or disclosure to Woodard or his
8 heirs. (*Id.* ¶ 50).

9 Plaintiff also soon discovered that the writers of and several actors in *Jersey Boys* had
10 access to the Work and that DeVito had received royalties or other profits from *Jersey Boys*, and
11 she concluded that the Work had “inspired the form, structure, and content of the musical”
12 (*See id.* ¶ 51). As support for this conclusion, Plaintiff notes that Defendant Des McAnuff, the
13 director of *Jersey Boys*, was quoted in a July 8, 2006 report in *Backstage* magazine as stating that
14 Defendants Marshall Brickman and Eric Elice had relied in part on “an unpublished
15 autobiography by DeVito” in creating the libretto. (*See id.* ¶ 52). Plaintiff notes that Christian
16 Hoff, the first actor to play DeVito in *Jersey Boys*, stated in what appears to be an online
17 interview that he was provided with a synopsis of the Work for his audition and a full copy for
18 background research. (*See id.*). Plaintiff also cites to a Wikipedia entry for support that the Work
19 served as a basis for the musical. (*See id.*). Plaintiff also notes an exchange on a *Jersey Boys*
20 podcast website indicating that one fan had reported to another that the musical was based on
21 DeVito’s unpublished biography. (*See id.*). Plaintiff also saw public reports of DeVito’s
22 financial profits from the musical. (*See id.*).

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1 **5. Pre-Litigation Negotiations**

2 On June 13, 2007, Plaintiff’s counsel wrote Julien by email and overnight courier
3 demanding that DeVito execute an application for supplementary registration with the U.S.
4 Copyright Office to add Woodard as a coauthor and co-claimant of the Work and demanding an
5 accounting of profits in accordance with the Letter Agreement. (*Id.* ¶ 53). Counsel conferred
6 with one another by email and telephone between June and October 2007, and Julien admitted at
7 one point that DeVito had provided a copy of the Work “to Jersey Boys” and expressed interest
8 in the possibility of a joint copyright infringement action against “Jersey Boys,” but later decided
9 that Plaintiff’s only recourse was a suit against DeVito because he had authorized the use of the
10 Work. (*Id.* ¶ 54). Although DeVito initially considered filing a supplemental registration of the
11 Work to credit Woodard, he later refused, claiming that he in fact was the sole author and that
12 Woodard had been a mere scribe. (*Id.*).

13 On July 2, 2007, Plaintiff filed her own supplementary application with the U.S.
14 Copyright Office to add Woodard as a coauthor and co-claimant of the Work, but the office
15 rejected the application because DeVito, the original claimant, had not signed it. (*Id.* ¶ 55). The
16 office could not under 17 U.S.C. § 201(a) permit a non-author, non-claimant as to an original
17 registration, i.e., a “basic registration,” to supplement the basic application, but such a person
18 could apply to register her own work, in which case the office would consider the new claim to
19 be adverse to the existing claim if the claims purported to register the same work exclusively to
20 different claimants. (*See* Copyright Office Letter, June 16, 2008, ECF No. 457-27, at 7).
21 However, the Copyright Office Review Board granted Plaintiff’s appeal based on a closer
22 examination of regulations and practices, determining that her supplemental registration could be
23 accepted, and that a certificate of registration would be issued after processing. (*See* Copyright
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1 Office Letter, Mar. 27, 2009, ECF No. 457-28). The amended certificate, Reg. No. Txu1 372-
2 636, lists Woodard and DeVito as coauthors of the entire text of the Work and co-claimants
3 thereto. (*See* Certificate of Registration TXu1 372-636, July 3, 2007, ECF No. 457-29).

4 Thereafter, further indication of the connection between *Jersey Boys* and the Work
5 emerged through public sources such as public interviews of certain Defendants. (*See* Third Am.
6 Compl. ¶ 56). Plaintiff alleges that the evidence that the musical was an adaptation of the Work
7 means that *Jersey Boys* is a “derivative work” of the Work under 17 U.S.C. § 101. (*See id.* ¶ 57).
8 Plaintiff recounts various similarities between *Jersey Boys* and the Work. (*See id.*).

9 **6. The “Cover-Up”**

10 DeVito and Julien then took steps to conceal the fact that DeVito had exploited the Work
11 to create and profit from *Jersey Boys*. (*See id.* ¶ 58). First, DeVito withdrew his quotes from
12 Charles Alexander’s forward to the upcoming *Jersey Boys* book, because the use of those
13 quotations would have linked the book, and hence the musical, to the Work. (*See id.*). Second,
14 DeVito reported in an interview that he had never shown the Work to anyone except Brickman,
15 Elice, and McAnuff, the writers and director of *Jersey Boys*. (*Id.*). Third, DeVito “dismantled”
16 his website <www.tommydevito.com> to remove reference to “his SMASH HIT *Jersey Boys*.”
17 (*Id.*). Fourth, he stated in an interview that he had dictated the Work to a lawyer and that the
18 book was not to be published yet. (*Id.*).

19 **7. DeVito’s Licensing of the Work**

20 Certain documents made public during Valli’s divorce proceedings in July 2008 revealed
21 that DeVito had granted Valli and Gaudio an exclusive, irrevocable, perpetual, worldwide,
22 assignable license (the “1999 Agreement”) freely to use and adapt certain “Materials,” including
23 his “biographies,” for the purpose of creating a musical based on the “life and music” of The
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1 Four Seasons. (*Id.* ¶ 59). The 1999 Agreement included the right to “ancillary and subsidiary
2 exploitations thereof including, without limitation, cast albums, motion picture and televised
3 versions, merchandise, and/or other works . . . in all media now existing or later devised.” (*Id.*).
4 The 1999 Agreement waived any claim of copyright infringement by DeVito, provided that
5 DeVito would be entitled to 20% of any royalties Valli and Gaudio obtained through exploitation
6 of the Materials, and provided that Massi would be entitled to 5% of any such royalties. (*See id.*).
7 Plaintiff suspects that Valli and Gaudio further licensed the Materials, which included the Work,
8 to one or more unknown authors in 1999 for adaptation into an early version of *Jersey Boys*
9 called Walk Like a Man. (*See id.*). When the original producer rejected Walk Like a Man, Valli
10 and Gaudio fired its authors, permitted their agreement with the original producer to lapse, and
11 further licensed the Materials to Brickman and Elice, who used them to write Jersey Boys. (*See*
12 *id.*). Plaintiff implies that Valli’s and Gaudio’s joint ventures related to their exploitation of the
13 Materials constitutes a general partnership as a matter of law that Plaintiff refers to as “The Four
14 Seasons Partnership.” (*See id.* ¶ 4–5).

15 **8. *Jersey Boys***

16 The *Jersey Boys* foundational production agreement (the “Jersey Boys Agreement”) is
17 dated May 1, 2004. (*See id.* ¶ 61; Jersey Boys Agreement 1, ECF No. 457-34, at 2). The Jersey
18 Boys Agreement lists five parties: Valli and Gaudio as “Owner,” Brickman and Elice as
19 “Bookwriter,” and Dodger Stage Holding Theatricals, Inc. (now known as DSHT, Inc.) as
20 “Producer.” (*See* Jersey Boys Agreement 1). The copies of the signature page of the Jersey Boys
21 Agreement attached to the Third Amended Complaint (“TAC”) include signatures by all of these
22 parties except Brickman, and DSHT’s signature is typewritten, without the handwritten signature
23 of any natural person as an agent of DSHT. (*See id.* at 24, ECF No. 457-34, at 25–26). The
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1 signatures are not dated. (*See id.*). The Jersey Boys Agreement is comprehensive and appears to
2 govern the worldwide exploitation of *Jersey Boys*. (*See generally id.*). The details of the twenty-
3 three-page agreement need not be recounted here, but will be noted where relevant to the
4 determination of claims. The Jersey Boys Agreement includes a schedule and two exhibits as
5 attachments, all of which the base agreement identifies. Schedule A is a table of musical
6 compositions to be used in the musical along with details of authorship and copyright ownership.
7 Exhibit A is the 1999 Agreement. Exhibit B is a list of “payment instructions” consisting of
8 addresses for mailing payments to the signatories and other beneficiaries.

9 Plaintiff believes that DSHT further assigned or licensed its rights under the Jersey Boys
10 Agreement to Defendant Dodger Theatricals, Ltd., which is the primary producer of *Jersey Boys*
11 on Broadway, tours throughout the United States, and in London, U.K. (*See Third Am. Compl.*
12 ¶ 62). Plaintiff believes that DSHT and/or Dodger Theatricals further licensed their rights to
13 others and eventually assigned them to Defendant Jersey Boys Broadway Limited Partnership,
14 which in turn licensed them to several parties, including Defendants JB Viva Vegas and Jersey
15 Boys Records Limited Partnership. (*See id.*). Plaintiff alleges that *Jersey Boys* has earned profits
16 of approximately \$150 million per year, with a life expectancy of at least ten years, and believes
17 she is entitled to at least \$6.5 million. (*See id.* ¶ 70).

18 **B. Procedural History**

19 **1. The Present Lawsuit**

20 In December 2007, Plaintiff sued DeVito in the U.S. District Court for the Eastern
21 District of Texas on three causes of action: (1) declaratory judgment; (2) equitable accounting;
22 and (3) breach of contract. That court transferred the case to this District in 2008 pursuant to 28
23 U.S.C. § 1404(a), without deciding whether it had personal jurisdiction over DeVito, and it
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1 denied Plaintiff's motion to reconsider. The TAC, filed in March 2011, lists fourteen Defendants
2 and twenty causes of action: (1) declaratory judgment (DeVito); (2) equitable accounting
3 (DeVito); (3) breach of contract (DeVito); (4) unjust enrichment (DeVito); (5) breach of the
4 covenant of good faith and fair dealing (DeVito); (6) constructive fraud (DeVito); (7) fraud
5 (DeVito); (8) conversion (DeVito); (9) copyright infringement under § 16(2) of the Copyright,
6 Designs, and Patents Act of 1988 (U.K.) (DeVito); (10) copyright infringement under § 27(1) of
7 the Copyright Act, R.S.C. 1985 (Can.) (DeVito); (11) copyright infringement under §§ 115(1),
8 36, and 39 of the Copyright Act of 1968 (Cth) (Austl.) (DeVito); (12)–(13) declaratory judgment
9 (Valli, Gaudio, DSHT, Dodger Theatricals, and Jersey Boys Broadway); (14) equitable
10 accounting (Valli, Gaudio, DSHT, Dodger Theatricals, and Jersey Boys Broadway, in the
11 alternative) (15) copyright infringement under 17 U.S.C. § 501(a) (Valli, Gaudio, Brickman,
12 Elice, McAnuff, DSHT, Dodger Theatricals, Jersey Boys Broadway, JB Viva Vegas, and Jersey
13 Boys Records); (16) vicarious copyright infringement under 17 U.S.C. § 502 (Valli, Gaudio,
14 Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, Jersey Boys Broadway, Jersey Boys
15 Records, Skunk, and Getting Home); (17) contributory copyright infringement under 17 U.S.C.
16 § 502 (Valli, Gaudio, Brickman, Elice, McAnuff, Michael S. David, DSHT, Dodger Theatricals,
17 Jersey Boys Broadway, and Jersey Boys Records); (18) copyright infringement under § 16(2) of
18 the Copyright, Designs, and Patents Act of 1988 (U.K.) (Valli, Gaudio, Brickman, Elice,
19 McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway); (19) copyright infringement
20 under § 27(1) of the Copyright Act, R.S.C. 1985 (Can.) (Valli, Gaudio, Brickman, Elice,
21 McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway); and (20) copyright
22 infringement under §§ 115(1), 36, and 39 of the Copyright Act of 1968 (Cth) (Austl.) (Valli,
23 Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway).

1 **2. The First Summary Judgment Order (No. 300)**

2 On March 31, 2010, the Court issued an order resolving ten pretrial motions as against
3 the Second Amended Complaint (“SAC”). The Court denied DeVito’s motion to dismiss, or in
4 the alternative for summary judgment, finding that certain state law defenses were preempted by
5 the Copyright Act and that in any case there was no evidence of an attorney–client relationship
6 but only of a business relationship between DeVito and Woodard. The Court also found that
7 there remained genuine issues of material fact as to the eligibility of the Work or certain parts of
8 it for copyright protection and as to what parts of the Work were used to create *Jersey Boys*. The
9 Court granted Corbello’s cross motion for summary judgment as to DeVito’s state law defenses
10 but denied it as to infringement for the same reasons the Court denied DeVito’s motion.

11 The Court denied Valli’s, Gaudio’s, Brickman’s, Elice’s, McAnuff’s, DSHT’s, Dodger
12 Theatricals’, and JB Viva Vegas, LP’s (collectively, “New Defendants”) motion to dismiss
13 counts 15–17 for copyright infringement. New Defendants argued that DeVito had waived and
14 released any right to sue them and that they had an “implied nonexclusive license” from DeVito.
15 Finding no New York law to the contrary, the Court ruled in accordance with Ninth Circuit
16 precedent that a failed attempt to grant an exclusive license could result in a nonexclusive license
17 and that that was what happened in this case according to undisputed facts. The Court denied the
18 motion to dismiss, however, because it had been sufficiently alleged that New Defendants had
19 sublicensed the work beyond the scope of their own license.

20 The Court denied Brickman’s, Elice’s, McAnuff’s, DSHT’s, Dodger Theatricals’, and JB
21 Viva Vegas, LP’s other motion to dismiss counts 15–17 for copyright infringement. Movants
22 argued that the alleged similarities were unprotectable under copyright law, that many alleged
23 similarities were not similarities, and that there was no “bodily appropriation” or “wholesale
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1 appropriation” of the Work by the *Jersey Boys* script. The Court found the claims to have been
2 sufficiently alleged.

3 The Court denied Valli’s, Gaudio’s, DSHT’s, and Dodger Theatricals’ motion to dismiss
4 counts 13–14 for declaratory judgment and an equitable accounting. The Court denied the
5 motion, finding that Corbello had sufficiently alleged in the alternative that DeVito had assigned
6 his copyright in the Work via the 1999 Agreement such that movants could authorize others to
7 use it but would owe Corbello, a joint owner, an accounting for any profits thereby obtained.

8 The Court denied three of Corbello’s motions to strike and granted two of them in part,
9 striking DeVito’s affidavit as to certain purposes and ordering an exhibit to be placed under seal.

10 **3. The Second Summary Judgment Order (No. 661)**

11 On October 27, 2011, the Court granted in part and denied in part two summary judgment
12 motions. Corbello and Defendants Valli, Gaudio, DSHT, Dodger Theatricals, and Jersey Boys
13 Broadway filed cross motions for summary judgment as to counts 12–14 for declaratory
14 judgment and an equitable accounting. As to count 12 for a declaration that DeVito as a joint
15 owner of the Work lacked the legal ability to grant Valli and Gaudio an exclusive license and
16 that the 1999 Agreement was therefore either void, a nonexclusive license, or a transfer of
17 DeVito’s rights in the Work, the Court denied summary judgment, ruling that the 1999
18 Agreement was not a transfer but a license that was exclusive as against DeVito but
19 nonexclusive as against Corbello. As to count 13 for an alternative declaration that the 1999
20 Agreement permitted Valli and Gaudio to further transfer or license the Work, that they did
21 transfer or license it to DSHT and/or Dodger Theatricals via the Jersey Boys Agreement, and that
22 Dodger Theatricals thereafter transferred or licensed to Jersey Boys Broadway, the Court granted
23 summary judgment to Plaintiff in part, ruling that the 1999 Agreement permitted further
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1 assignment and that Valli and Gaudio had further assigned the rights in the Work to DSHT via
2 the Jersey Boys Agreement, but that it was not clear whether there had been any further
3 assignment. The Court granted summary judgment to Defendants as to count 14 for an
4 accounting because there had been no transfer of the Work and the relevant agreements included
5 no duty to account.

6 **4. The Third Summary Judgment Order (No. 780)**

7 On January 31, 2012, the Court adjudicated seven of the seventeen claims then remaining
8 and entered judgment in favor of all Defendants except DeVito and David. Jersey Boys Records
9 had moved for summary judgment based on personal jurisdiction and failure to state a claim.
10 The Court found that it had jurisdiction over Jersey Boys Records but granted the motion on the
11 merits, ruling that Plaintiff had adduced no evidence that Jersey Boys Records had control over
12 any other Defendant, that there was no allegation that Jersey Boys Records was aware of any
13 infringement, so it could not be liable for contributory infringement, and that the album at issue
14 did not pass the extrinsic test as to substantial similarity to the Work. The Court denied two
15 motions for summary judgment based on the statute of limitations. The Court denied David's
16 motion for summary judgment based on personal jurisdiction. The Court denied a motion for
17 summary judgment on the merits of the infringement issue (Motion No. 626) as moot because it
18 granted another motion based on the Defendants' having licenses to use the Work. The Court
19 granted a motion for summary judgment as against the claims of infringement under foreign law,
20 following the Second Circuit's persuasive ruling that the Berne Convention did not provide
21 choice-of-law rules for copyright claims, and finding that U.S. law governed issues of copyright
22 ownership and licensing in this case even if foreign law governed substantive infringement
23 claims, and that the licenses under U.S. law protected Defendants from the foreign infringement
24

1 claims. The Court granted Corbello’s motion for summary judgment as to declarations that the
2 Work was a joint work, that Woodard was a co-owner of the Work, and that DeVito held a 50%
3 interest in the DeVito Work in constructive trust for Corbello, as successor-in-interest to
4 Woodard.

5 **5. Further District Court Proceedings**

6 At that point, claims 2–11 against DeVito remained for trial. On July 9, 2012, the Court
7 denied fees to Defendants, added David to the Judgment, and certified Orders No. 780 and the
8 current Order No. 809 for immediate appeal under Rule 54(b).

9 **6. The Appeal and Remand**

10 Corbello appealed Orders No. 780 and 809. On February 10, 2015, the Court of Appeals
11 reversed, ruling that the 1999 Agreement was a transfer of ownership such that Valli and Gaudio
12 became joint owners with Corbello in 1999, *Corbello v. DeVito*, 777 F.3d 1058, 1064 (9th Cir.
13 2015), and that although Valli and Gaudio could not be liable for infringement while they were
14 joint owners, there remained a genuine issue of material fact whether the 1999 Agreement’s
15 reversionary clause had later been triggered such that Valli and Gaudio might be liable for
16 infringement for their use of the Work thereafter, *id.* at 1066–67. The Court of Appeals also
17 ruled there remained a genuine issue of material fact as to whether DeVito had granted Valli and
18 Gaudio an implied nonexclusive license upon reversion. *Id.* at 1067–68.

19 **7. The Fourth Summary Judgment Order (No. 872)**

20 The case will now proceed to trial, but the parties requested that the Court first determine
21 certain issues as a matter of law, i.e., whether certain parts of the Work were protected at all,
22 whether the Work was entitled to “thick” versus “thin” copyright protection, and whether
23 Defendants were entitled to summary judgment on the infringement issue under the extrinsic test.
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1 The Court ruled that under the law of the case, the jury must be instructed that the 1999
2 Agreement was a transfer of ownership whereby Valli and Gaudio became joint owners with
3 Corbello, and that Valli and Gaudio could not be liable for infringement while they were joint
4 owners. The jury must determine whether the 1999 Agreement's reversionary clause was ever
5 triggered such that Valli and Gaudio might be liable for infringement thereafter. If that occurred,
6 the jury must also determine whether DeVito granted Valli and Gaudio an implied nonexclusive
7 license such that they cannot have been liable for infringement even after their ownership interest
8 reverted to DeVito. Finally, the jury must determine infringement under direct copying or
9 substantial similarity theories. To find liability under the latter theory, the jury must first
10 perform the extrinsic test. The Court granted summary judgment in part as to the extrinsic test,
11 finding that regular "thick" copyright protection did not apply as a matter of law, so the jury
12 must be instructed that if the Work passed the extrinsic test, the jury must apply "thin" protection
13 under the intrinsic test. The Court also noted at a status conference that it intended to bifurcate
14 the trial into infringement and damages phases and intended to hold accounting proceedings
15 without a jury if any Defendant is found to be liable for an accounting. The parties have now
16 filed four additional motions for summary judgment.

17 **II. SUMMARY JUDGMENT STANDARDS**

18 A court must grant summary judgment when "the movant shows that there is no genuine
19 dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R.
20 Civ. P. 56(a). Material facts are those which may affect the outcome of the case. *See Anderson*
21 *v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute as to a material fact is genuine if
22 there is sufficient evidence for a reasonable jury to return a verdict for the nonmoving party. *See*
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1 *id.* A principal purpose of summary judgment is “to isolate and dispose of factually unsupported
2 claims.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323–24 (1986).

3 In determining summary judgment, a court uses a burden-shifting scheme. The moving
4 party must first satisfy its initial burden. “When the party moving for summary judgment would
5 bear the burden of proof at trial, it must come forward with evidence which would entitle it to a
6 directed verdict if the evidence went uncontroverted at trial.” *C.A.R. Transp. Brokerage Co. v.*
7 *Darden Rests., Inc.*, 213 F.3d 474, 480 (9th Cir. 2000) (citation and internal quotation marks
8 omitted). In contrast, when the nonmoving party bears the burden of proving the claim or
9 defense, the moving party can meet its burden in two ways: (1) by presenting evidence to negate
10 an essential element of the nonmoving party’s case; or (2) by demonstrating that the nonmoving
11 party failed to make a showing sufficient to establish an element essential to that party’s case on
12 which that party will bear the burden of proof at trial. *See Celotex Corp.*, 477 U.S. at 323–24.

13 If the moving party fails to meet its initial burden, summary judgment must be denied and
14 the court needn’t consider the nonmoving party’s evidence. *See Adickes v. S.H. Kress & Co.*, 398
15 U.S. 144 (1970). If the moving party meets its initial burden, the burden then shifts to the
16 nonmoving party to establish a genuine issue of material fact. *See Matsushita Elec. Indus. Co. v.*
17 *Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). To establish the existence of a factual dispute,
18 the nonmoving party need not establish a material issue of fact conclusively in its favor. It is
19 sufficient that “the claimed factual dispute be shown to require a jury or judge to resolve the
20 parties’ differing versions of the truth at trial.” *T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors*
21 *Ass’n*, 809 F.2d 626, 631 (9th Cir. 1987). In other words, the nonmoving party cannot avoid
22 summary judgment by relying solely on conclusory allegations unsupported by facts. *See Taylor*
23 *v. List*, 880 F.2d 1040, 1045 (9th Cir. 1989). Instead, the opposition must go beyond the
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1 assertions and allegations of the pleadings and set forth specific facts by producing competent
2 evidence that shows a genuine issue for trial. *See* Fed. R. Civ. P. 56(e); *Celotex Corp.*, 477 U.S.
3 at 324.

4 At the summary judgment stage, a court’s function is not to weigh the evidence and
5 determine the truth, but to determine whether there is a genuine issue for trial. *See Anderson*, 477
6 U.S. at 249. The evidence of the nonmovant is “to be believed, and all justifiable inferences are
7 to be drawn in his favor.” *Id.* at 255. But if the evidence of the nonmoving party is merely
8 colorable or is not significantly probative, summary judgment may be granted. *See id.* at 249–50.
9 Notably, facts are only viewed in the light most favorable to the nonmoving party where there is
10 a genuine dispute about those facts. *Scott v. Harris*, 550 U.S. 372, 380 (2007). That is, even
11 where the underlying claim contains a reasonableness test, where a party’s evidence is so clearly
12 contradicted by the record as a whole that no reasonable jury could believe it, “a court should not
13 adopt that version of the facts for purposes of ruling on a motion for summary judgment.” *Id.*

14 **III. ANALYSIS**

15 **A. Plaintiff’s Motions**

16 First, Plaintiff asks the Court to grant her summary judgment against the affirmative
17 defense of “implied nonexclusive license.” The Court denies the motion. The Court of Appeals
18 specifically stressed the uncertainty of this issue. *See Corbello v. DeVito*, 777 F.3d 1058, 1067–
19 68 (9th Cir. 2015). Second, Plaintiff asks the Court to grant her summary judgment on the issue
20 of whether the 1999 Agreement lapsed under its reversionary clause. The Court denies the
21 motion, because the Court of Appeals specifically found there to be a genuine issue of material
22 fact on that point to be resolved at trial. *See id.* at 1066–67. That does not preclude the
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1 availability of a future Rule 50(a) motion, but the Court perceives the law of the case to require
2 these issues to be tried.

3 At the hearing, counsel also argued that the Court’s previous finding of “thin” protection
4 was in error, reasoning that if biographies had only “thin” protection, no biography could ever be
5 infringed unless copied word-for-word. But that isn’t so. “Thin” versus “thick” protection
6 concerns differing standards for a finding of substantial similarity, which in combination with
7 proof of access to a work can show infringement as an alternative to showing direct copying.
8 But one need only resort to a substantial similarity analysis in the absence of evidence of direct
9 copying. *Funky Films, Inc. v. Time Warner Entm’t Co., L.P.*, 462 F.3d 1072, 1076 (9th Cir.
10 2006). Plaintiff has survived summary judgment on the direct copying issue in this case based
11 on the evidence of access to the Work in late January 2004, the early February 2004 meeting at
12 which Brickman, Elice, and McAnuff poured over, annotated, and began to adapt the Work, and
13 the Krevolin Report’s comparisons of the Work to the evolving scripts, i.e., the February 13,
14 2004 Outline, the March 11, 2004 Outline, the March 19, 2004 Outline, the April 7, 2004
15 Outline, the May 28, 2004 Draft Script, the July 7, 2004 Draft Script, the La Jolla Jersey Boys
16 Script of October 2004, and the Broadway Jersey Boys Script of November 2005. The
17 substantial similarity test is an alternative method for a plaintiff to show infringement via
18 circumstantial evidence. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000).
19 The “thick” versus “thin” issue concerns differing standards of showing “substantial similarity”
20 based on the prevalence of protectable elements within a copyrighted work as a whole. *See Apple
21 Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994).

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1 **B. Defendants’ Motions**

2 **1. Fair Use**

3 First, Defendants ask the Court to grant them summary judgment based on fair use. They
4 argue: (1) any use of the Work was fair use, particularly the “Walk Like a Man” dialogue and
5 “Social Movement” reference; (2) any use of the “Einstein” or “cool” references were de
6 minimis; and (3) if the Court agrees with (1) and (2), then the only four similarities between the
7 Work and the LaJolla or Broadway *Jersey Boys* scripts remaining after the Court’s previous
8 “thick” versus “thin” analysis will have been shown to be unprotectable for other reasons, no
9 intrinsic question will remain for the jury, and Defendants will accordingly be entitled to
10 summary judgment on the infringement issue altogether.

11 The Copyright Act does not grant a copyright holder exclusive rights to
12 reproduce his or her work. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464
13 U.S. 417, 432–33, 104 S. Ct. 774, 78 L.Ed.2d 574 (1984). Section 107 of the
14 Copyright Act explains that “the fair use of a copyrighted work . . . for purposes
such as criticism, comment, news reporting, teaching . . . , scholarship, or
research, is not an infringement of copyright.” 17 U.S.C. § 107. In determining
whether the use of a copyrighted work is fair, we consider:

- 15 (1) the purpose and character of the use, including whether such use is of a
16 commercial nature or is for nonprofit educational purposes;
- 17 (2) the nature of the copyrighted work;
- 18 (3) the amount and substantiality of the portion used in relation to the
copyrighted work as a whole; and
- 19 (4) the effect of the use upon the potential market for or value of the
20 copyrighted work.

21 *Id.* When conducting a fair use analysis, we are not restricted to these factors;
22 rather, the analysis is a flexible one that we perform on a case-by-case basis.
Campbell v. Acuff–Rose Music, Inc., 510 U.S. 569, 577, 114 S. Ct. 1164, 127
23 L.Ed.2d 500 (1994) (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471
U.S. 539, 560, 105 S. Ct. 2218, 85 L.Ed.2d 588 (1985)). Moreover, we do not
24 consider these factors in isolation but weigh them together, in light of the
copyright law’s purpose “to promote the progress of science and art by protecting

1 artistic and scientific works while encouraging the development and evolution of
2 new works.” *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 799–800
(9th Cir. 2003) (citing *Campbell*, 510 U.S. at 575–76, 114 S. Ct. 1164).

3 Fair use is a mixed question of law and fact, *Harper & Row Publishers*,
4 471 U.S. at 560, 105 S. Ct. 2218, but it is well established that a court can resolve
5 the issue of fair use on a motion for summary judgment when no material facts
are in dispute. *See Mattel*, 353 F.3d at 800 (citing *Harper & Row Publishers*, 471
U.S. at 560, 105 S. Ct. 2218).

6 *Leadsinger, Inc. v. BMG Music Publ’g*, 512 F.3d 522, 529–30 (9th Cir. 2008).

7 The alleged use here was commercial. Although such use is not categorically excluded
8 from the fair use doctrine, “[c]ommercial use is a ‘factor that tends to weigh against a finding of
9 fair use’ because ‘the user stands to profit from exploitation of the copyrighted material without
10 paying the customary price.’” *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1176 (9th Cir.
11 2012) (quoting *Harper & Row Publishers*, 471 U.S. at 562). Whether the alleged infringer
12 profits from the use is one of four enumerated statutory factors to consider. *See* 17 U.S.C.
13 § 107(1) (“the purpose and character of the use, including whether such use is of a commercial
14 nature or is for nonprofit educational purposes”). The other factors are the nature of the
15 copyrighted work, the amount and substantiality of the portion used in relation to the copyrighted
16 work as a whole, and the effect of the use upon the potential market for or value of the
17 copyrighted work. *See id.* § 107(2)–(4). The second factor also weighs against a finding of fair
18 use in this case, where the Work is unpublished. *See Harper & Row Publishers*, 471 U.S. at 554
19 (citing S. Rep. No. 94–473, p. 64 (1975); 3 M. Nimmer, *Copyright* § 13.05, at 13–62, n.2 (1984);
20 W. Patry, *The Fair Use Privilege in Copyright Law* 125 (1985)) (“We conclude that the
21 unpublished nature of a work is ‘[a] key, though not necessarily determinative, factor’ tending to
22 negate a defense of fair use.”). The third factor weighs in favor of a finding of fair use, because
23 the two references constituted a small fraction of the Work. The effect of the use on the market
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1 value of the Work was likely to have increases its value and likely didn't decrease it by much, if
2 at all. The fourth factor therefore weighs in favor of a finding of fair use. The Court finds that
3 there is at least a genuine issue of material fact whether the "Walk Like a Man" dialogue and
4 "Social Movement" reference were fair use in this case, leaves the issue for the jury, and denies
5 the motion, accordingly.

6 **2. The Foreign Infringement Claims**

7 Second, Defendants ask the Court to grant them summary judgment against the UK,
8 Canadian, and Australian infringement claims in Counts 18–20, respectively. They argue that
9 they are entitled to summary judgment: (1) to the extent that the Court has granted them
10 summary judgment as against the U.S. claims, i.e., on the issue of "thick" versus "thin"
11 protection; (2) that as to the accounting claim, a choice of law provision in the 1999 Agreement
12 would require that U.S. law control any alleged infringing uses anywhere in the world; and (3)
13 that U.S. courts cannot constitutionally apply or enforce foreign copyright laws with a narrower
14 scope of fair use or a broader scope of protection to non-original elements than U.S. law.

15 **a. "Thick" versus "Thin" Protection**

16 Defendants argue that historical and biographical works have lesser protection under the
17 law of the Commonwealth nations, just as under U.S. law, such that the Court should grant
18 Defendants partial summary judgment against the foreign claims to the same extent. The Court
19 declines to do so at this time, but leaves open the possibility of a future Rule 50(a) motion.
20 Without deciding whether Defendants are generally correct, the contours of the foreign claims
21 are not likely exactly the same as those of the U.S. claims. Indeed, the case law under which the
22 Court based its previous "thick" versus "thin" ruling was particular not only to U.S. law
23 generally, but also to the law of this Circuit. The Court will in its discretion await expert
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1 testimony at trial before determining the precise contours of copyright protection under the laws
2 of the relevant nations and will instruct the jury accordingly. *See* Fed. R. Civ. P. 44.1. At this
3 stage, there is expert testimony supporting both sides. (*Compare* Burshtein Report, ECF No.
4 632-1 (opining that the protection of historical and biographical works under Canadian law is no
5 broader than that under U.S. law); *with* Second Guay Report, ECF No. 756-6 (opining that
6 Burshtein has misunderstood or mischaracterized the relevant Canadian law)),¹ and the Court
7 prefers to permit the parties to cross-examine one another's experts in the context of an
8 evidentiary hearing during trial.

9 **b. Choice of Law as to an Accounting**

10 Defendants argue that for the purposes of the accounting claim, the 1999 Agreement
11 specifies that U.S. law controls infringing uses, regardless of the place of infringement.
12 Defendants argue that the Court has already so ruled, and that the ruling was not upset by the
13 Court of Appeals' reversal on other issues. But Defendants concede that this conclusion only
14 follows if the transfer of ownership under the 1999 Agreement did not revert, and the Court of
15 Appeals has ruled that the reversion issue must be tried. The Court therefore will not rule on the
16 choice-of-law issue as to the accounting claim at this time. Furthermore, only if the jury finds
17 that one or more of the accused *Jersey Boys* products infringed the Work will there be any
18 accounting. That accounting will be conducted by the Court, if necessary, and only at that time
19 the Court will conduct any choice-of-law analysis based on the 1999 Agreement.

20 **c. Constitutional Limits on the Foreign Claims**

21 Finally, Defendants argue that a U.S. court cannot constitutionally apply or enforce
22 foreign copyright laws with a narrower scope of fair use or a broader scope of protection to non-

23 ¹ Although Defendants argue against all of the foreign claims, the evidence they cite in the
24 present motion (the Burshtein Report) focuses on Canadian law.

1 original elements than U.S. law. The first case Defendants rely on is a statutory-interpretation
2 case, not a judicial-review case. *See generally Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*,
3 499 U.S. 340 (1991). The *Feist* Court cited Article I of the Constitution as an aid in interpreting
4 the Copyright Act to respect the limits of Congress' constitutional power to protect copyright
5 under U.S. law. *See id.* at 346, 349–50. That case did not concern First Amendment-based or
6 other putative constitutional limitations on a U.S. court's application of foreign copyright law, as
7 Defendants appear to imply. The second case Defendants rely on is a Second Circuit case. *See*
8 *Sarl Louis Feraud Int'l v. Viewfinder, Inc.*, 489 F.3d 474 (2nd Cir. 2007). In that case, the
9 defendant had defaulted in the French courts as to a French copyright claim, and the only
10 remaining issue was whether enforcing the judgment would be against New York policy under
11 the statutes of that state. *See id.* at 478–79. The court noted that laws antithetical to the federal
12 First Amendment implicated New York's public policy exception against enforcing foreign
13 judgments under New York law. *See id.* at 480. The Court did not rule that foreign copyright
14 claims brought directly in the U.S. courts are limited by the First Amendment. It ruled only that
15 under New York law, a foreign judgment cannot be enforced by the courts of that state where the
16 underlying cause of action is repugnant to the First Amendment.

17 Defendants' First Amendment argument may ultimately have merit, but Defendants have
18 not cited any relevant case law. There is no doubt, as Plaintiff notes in response, that the
19 “national treatment principle” of the Berne Convention makes the controlling law the law of the
20 state in which the infringement occurred. *See Subafilms, Ltd. v. MGM–Pathe Comm.*, 24 F.3d
21 1088, 1097 (9th Cir. 1994) (en banc) (quoting 3 David Nimmer and Melville B. Nimmer,
22 *Nimmer on Copyright* § 17.05 at 17–39 (1994)). That, however, does not answer the question of
23 whether the U.S. courts can apply foreign law that is repugnant to the Constitution. They cannot.

1 *Reid v. Covert*, 354 U.S. 1, 17 & n.33 (1957) (collecting cases). The Court therefore will have to
2 consult any applicable constitutional limitations on foreign copyright claims when authoring the
3 jury instructions. The Court will not attempt to do that at this time but will leave it to Defendants
4 to identify any alleged limitations along with their proposed jury instructions.

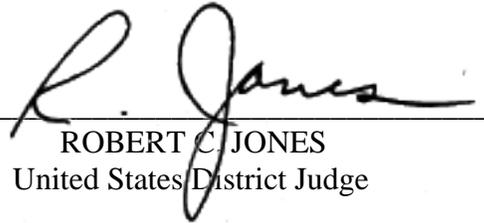
5 **CONCLUSION**

6 IT IS HEREBY ORDERED that the Motions for Summary Judgment (ECF Nos. 928,
7 933, 934, 935) are DENIED.

8 IT IS FURTHER ORDERED that the unopposed Motions to Seal (ECF Nos. 927, 931)
9 are GRANTED.

10 IT IS SO ORDERED.

11 Dated this 2nd day of August, 2016.

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14 _____
15 ROBERT C. JONES
16 United States District Judge
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