

EXHIBIT 8

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

TOMMY I. GRANVILLE, JR.	§	
	§	
VS.	§	
	§	
SUCKAFREE RECORDS, INC.,	§	
WESLEY ERIC WESTON p/k/a “LIL	§	CIVIL ACTION NO. H-03-3002
FLIP”, ESTELLE DOUGLAS HOBBS,	§	
JR., a/k/a “HUMP”, SONY MUSIC	§	
ENTERTAINMENT INC., COLUMBIA	§	JURY
RECORDS, INC. (a/k/a COLUMBIA	§	
RECORDING CORPORATION),	§	
LOUD RECORDS, LLC, LUCKY	§	
PUBLISHING COMPANY, and	§	
HOBBS PUBLISHING COMPANY	§	

**MEMORANDUM OF LAW FOR JOINT PRE TRIAL ORDER
BY SONY BMG MUSIC ENTERTAINMENT INC, LOUD RECORDS, LLC,
WESLEY WESTON AND LUCKY PUBLISHING COMPANY**

Defendants SONY BMG MUSIC ENTERTAINMENT INC, as successor in interest to SONY MUSIC ENTERTAINMENT INC., LOUD RECORDS, LLC (collectively, “Sony”) and WESLEY ERIC WESTON p/k/a “LIL FLIP” and LUCKY PUBLISHING COMPANY file this Memorandum of Law in connection with the parties’ Joint Pre Trial Order.

Respectfully submitted,

Geoffrey H. Bracken
Texas State Bar No. 02809750
ATTORNEY-IN-CHARGE FOR DEFENDANTS,
SONY BMG MUSIC ENTERTAINMENT INC.
LOUD RECORDS, LLC, WESLEY WESTON
AND LUCKY PUBLISHING COMPANY

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Defendants SONY BMG MUSIC ENTERTAINMENT INC, as successor in interest to SONY MUSIC ENTERTAINMENT INC., and LOUD RECORDS, LLC (collectively, “Sony”) file this Memorandum of Law in connection with the parties’ Joint Pre Trial Order.

This is a straightforward music copyright case. Sony presents the following legal issues for the Court’s consideration. Most of these issues can be decided as a matter of law and are the subject of the parties’ pending motions for summary judgment.

- Does Plaintiff have any valid copyright interests in the songs at issue, or did he assign all such rights to Defendant Suckafree Records? If Plaintiff assigned such rights, Plaintiff has no basis to proceed in this action.
- Were the songs at issue created as “Works for Hire” or as “Joint Works?” Alternatively, did Plaintiff license the songs to Defendants? These doctrines preclude Plaintiff’s claim of copyright infringement.
- Was Plaintiff’s copyright registration for application number PAu2-793-076 untimely? If Plaintiff failed to register his copyright within three months of the alleged acts of infringement, Plaintiff is precluded from recovering statutory damages and attorneys’ fees.

- Should damages be calculated based upon the number of infringed works or upon the number of infringing acts? The Fifth Circuit’s answer limits Plaintiff’s potential recovery to the number of infringed works.
 - Does Plaintiff have legitimate causes of action for a Lanham Act violation, a Phonogram Convention violation, and state law unfair practices claims? This is a copyright case; all of Plaintiff’s extraneous claims fail as a matter of law.
- I. **Plaintiff has no valid copyrights because he assigned all rights by written “Work for Hire” agreements.**

In order to prevail on a claim of copyright infringement, Plaintiff must prove two elements “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.” *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). Plaintiff cannot succeed upon this claim of infringement because Plaintiff transferred his copyright rights in the music in question when he signed virtually identical “Work for Hire” agreements covering the three songs at issue. On May 16, 2002, Plaintiff executed three agreements with Defendant Suckafree Records. These Agreements constitute valid and enforceable work for hire agreements or, in the alternative, valid and enforceable assignments of the copyrights in question. The Agreements provide:

“each musical composition produced for, performed on, written or furnished to SUCKA FREE RECORDS, INC. (a ‘Musical Composition’), shall be considered a work made for hire ... [and] ... if any such Musical Composition is determined not to be a work made for hire for SUCKA FREE RECORDS, INC., it shall be deemed transferred to SUCKA FREE RECORDS, INC. by this document, with all rights in it, throughout the universe.”

The Agreements are valid and enforceable and leave Plaintiff with no valid copyrights as to the melodies in question.

A. The Agreements Satisfy §204(a)’s Writing Requirement

The Federal Copyright Act requires that a transfer of copyright ownership be “in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.” 17

U.S.C. § 204(A). The writing requirement of 17 U.S.C. §204(a) contemplates a low evidentiary threshold for a writing to be sufficient. This point was recently articulated in the United States District Court for the Southern District of Texas, where the Honorable Melinda Harmon stated that:

“[t]he writing requirement [for an assignment] is not unduly burdensome; it necessitates neither protracted negotiations nor substantial expense. The rule is really quite simple: If the copyright holder agrees to transfer ownership to another party, that party must get the copyright holder to sign a piece of paper saying so. It doesn't have to be the Magna Carta; a one-line pro forma statement will do.”

Compaq Computer Corp. v. Ergonome, Inc., 210 F. Supp. 2d 839, 844 (S.D.Tex. 2001), *rev'd in part* on other grounds. The Agreements sufficiently satisfy the writing requirement of §204(a).

B. The Agreements Are Signed by the Owner of the Rights Conveyed

The Agreements also reflect Plaintiff's signature, thereby satisfying the second requirement under §204(a). Plaintiff acknowledged that his signature is on the two Agreements attached as Exhibit B to Sony's motion for summary judgment (docket #130). In signing these written agreements, Plaintiff transferred his copyright rights in the works in question to Sucka Free. Further, the fact that Plaintiff received and cashed multiple checks issued by Sucka Free shows that Plaintiff accepted the benefit and consequently the terms of the Agreements. In addition, Plaintiff admitted in his deposition to signing and cashing these checks. *See* Exhibit F to Sony's motion, pg. 178, l. 10 to pg 180, l.25 and pg. 181, l. 5 to pg. 183, l. 6. If Plaintiff owned any rights to these copyrights prior to May 16, 2002, he assigned all such rights through the Agreements. As a result, Plaintiff cannot prove ownership of a valid copyright, an essential element of his cause of action.

Plaintiff admits that he signed two separate documents regarding two of the songs in question on May 16, 2002, the same date as the Agreements. *See id.*, p. 145, l. 9-21. He admits that the documents were also two pages in length and that the first and third paragraphs were

identical to those contained in the Agreements, but contends that the Agreements' second paragraph, which contains the language relevant to the transfer of the copyrights, was not the same as the documents he signed. *See id.*, pg. 150, l. 9 to pg. 151, l. 21. However, upon being specifically questioned on the subject, Plaintiff could offer no description whatsoever as to the contents, language, or meaning of the allegedly omitted paragraph. *See id.* Nor has Plaintiff offered an expert report contesting the authenticity of the Agreements.

C. The Agreements' Recitations of Consideration Are Sufficient.

Plaintiff claims that the Agreements are invalid and unenforceable because he was never paid the consideration in the Agreements. Plaintiff also disputes that the checks cashed by him represent this consideration although Plaintiff does not dispute that he did in fact endorse and accept the benefit of each of these checks. *See* Exhibit F to Sony's motion for summary judgment, pp. 178 l. 10 – p. 180 l. 25; p. 181 l. 5 – p. 183 l. 6. Under Texas law, however, the enforceability of a contract does not depend upon the payment of the consideration promised. *See 1464-Eight, Ltd. v. Joppich*, No. 03-0109, 2004 Tex. LEXIS 1426 at *24 (Tex. Dec. 31, 2004).

In *Joppich*, the Texas Supreme Court thoroughly examined relevant case law dating back to the 1840's and including decisions from United States Supreme Court and Texas state courts. *See id.* at *11-18. One such guidepost considered in *Joppich* directly confirms Defendants' position, holding "[a] valuable consideration, however small or nominal, *if given or stipulated for in good faith*, is, in the absence of fraud, sufficient to support an action on any parol contract." *Lawrence v. McCalmont*, 43 U.S. (2 How.) 426, 452 (1844) (emphasis added). The Court also analyzed decisions from other state supreme courts, the Second Restatement of Contracts, and various well-known treatises in formulating its holding. *See Joppich*, 2004

LEXIS 1426 at *18-24. In the end, the Court sided with the proponents of the contract, holding that the failure to tender the stated nominal consideration under the contract did not invalidate the agreement. *See id.* at *24.

Regardless of whether or not the checks Plaintiff cashed represent consideration under the Agreements, the recital of consideration in the Agreements, even if merely nominal, is sufficient to support the enforceability of the Agreements. *See id.* Failure to pay the recited consideration leaves the contracting party with a breach of contract claim, not a claim of unenforceability. Because the Agreements are in writing, are signed by the owner of the rights to be conveyed, and adequately recite the consideration exchanged, the Agreements are valid and enforceable against Plaintiff.

D. The Agreements constitute valid “Work for Hire” agreements.

Under 17 U.S.C. §201(a), the general rule is that ownership of a copyright vests initially in the author of the copyrighted work. 17 U.S.C. §201(A). However, §201(b) carves out an exception providing that in the case of a “work made for hire,” the person for whom the work was prepared is considered the author and owns all the rights comprised in the copyright. *See* 17 U.S.C. §201(B). *See also Kasten v. Jerrytone*, No. 02-421, 2004 U.S. Dist. LEXIS 16540 at *10 (E.D. La. 2004).

Plaintiff argues that the Agreements are invalid because they were signed after the commencement or occurrence of the infringing act. Plaintiff’s argument ignores recent authority validating such agreements. According to the Second Circuit, a work for hire agreement will be upheld even if executed after the work is created, if the writing confirms a prior agreement. *See Playboy Enterprises, Inc. v. Dumas*, 53 F.3d 549, 559 (2nd Cir. 1995); *see also* 1 NIMMER §5.03(B)(2)(B). Courts within the Fifth Circuit generally recognize the Second Circuit as

exerting “particular persuasion in matters of copyright.” *Compaq Computer Corp. v. Ergonome, Inc.*, 210 F.Supp.2d 839 (S.D.Tex. 2001), rev’d in part on unrelated grounds; *see also Easter Seal Society for Crippled Children and Adults of Louisiana, Inc. v. Playboy Enter.*, 815 F.2d 323, 325 (5th Cir. 1987). Plaintiff’s legal argument fails as a matter of law. Moreover, the parties’ intent for the songs at issue to be works made for hire is implicit in the fact that Plaintiff willingly signed the Work For Hire agreements. Plaintiff never once presented any Defendant with a contract to define his copyrights, even though Plaintiff had drafted similar agreements in his prior recording relationships. *See* Exhibit D to Sony’s response to Plaintiff’s motion for summary judgment, p.74:6 – p.75:4 (admitting Plaintiff prepared a prior contract concerning the recording of certain songs without selling Plaintiff’s own musical works); p.157:21 – p.158:2, p.158:14-25 and p.160:10-18 (Plaintiff never presented Defendants with a contract). Plaintiff then failed to file copyright applications for at least two of his musical works until well after the *Undaground Legend* album was released with favorable results. *See* Exhibit G to Sony’s response to plaintiff’s motion for summary judgment, Certificate of Copyright Registration for “The Works of Tomi Gran Vol. 5,” Registration No. PAu2-793-076 (filed June 17, 2003). Taking all available evidence as a whole, the only reasonable conclusion to be reached is that Plaintiff intended for the songs to be works made for hire and signed confirmatory Agreements with Suckafree.

II. Plaintiff and Weston were Joint Authors of the Resulting Works

In the alternative, the recordings in question are joint works, produced as a result of joint authorship on the part of Plaintiff and Weston, the former the alleged author of the music and the latter responsible for the lyrics. The law is well established “a joint owner of a copyright and his licensees cannot be liable to a co-owner for copyright infringement.” *Donna v. Dodd, Mead &*

Co., Inc., 374 F.Supp. 429, 430 (S.D.N.Y. 1974). 17 U.S.C. §101 defines “joint work as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” *See* 17 U.S.C. §101.

A. The Presumption of Joint Copyright Ownership.

17 U.S.C. §201(a) provides “[t]he authors of a joint work are coowners of copyright in the work.” 17 U.S.C. §201(a). *See also* 6 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT, §30.02(A) (2004)(“writers of the two elements of a musical composition (i.e., the music and lyrics) each immediately acquire upon creation an undivided fifty percent interest in the entire copyright in that musical composition, unless varied by a written agreement to the contrary”); *Thomson v. Larson*, 147 F.3d 195, 199 (2nd Cir. 1998)(quoting *Childress v. Taylor* 945 F.2d 500, 508 (2nd Cir. 1991): “Joint authorship entitles the co-authors to equal undivided interests in the whole work”).

It is undisputed that Weston authored the lyrics to the works at issue in this case. Therefore, even assuming that Plaintiff authored the music, Weston would still have an undivided fifty percent interest in the joint work that resulted and would have just as much right to distribute the entire work as any joint owner. *See* 6 NIMMER §30.02(A)(each writer of a joint work is entitled “to exploit the entire musical composition domestically”). *See also Larson*, 147 F.3d at 199 (“each joint author has the right to use or to license the work as he or she wishes”).

B. Plaintiff and Defendant Weston are Joint Authors

Federal case law has developed a two part test where a joint-authorship claimant must show “that each of the putative co-authors (1) made independently copyrightable contributions to the work; and (2) fully intended to be co-authors.” *Id.*, at 200 (citing *Childress*, 945 F.2d at 507-08). The *Larson* court also refers to the legislative history of 17 U.S.C. §101, stating that “[t]he

touchstone of the statutory definition” of a joint work ““is the intention at the time the writing is done that the parts be absorbed or combined into an integrated unit.”” *Id.*, at 199. *See* H.R. REP. NO. 94-1476, at 121 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5735. The principal issue in this case is the parties’ intention at the time the songs were created.

The requirement that co-authors intend to create a joint work does not necessitate collaboration or proximity in time or place. *See* 1 NIMMER §6.03. The *Marks* case involved joint authors who not only did not collaborate, but had never even met each other until years after the fact. *See Edward B. Marks Music Corp. v. Jerry Vogel Music Co., Inc.*, 140 F.2d 266 (2nd Cir. 1944)(joint authorship found where music publisher bought writer’s lyrics and later hired composer to set music to lyrics, without writer’s knowledge). The Second Circuit held that “it makes no difference whether the authors work in concert, or even whether they know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work to be performed as such.” *Id.*, at 267. *See C & C Entertainment, Inc. v. Rios-Sanchez*, 208 F.Supp.2d 139, 143 (D.P.R. 2002)(joint-authorship found where author gave lyrics to another, intending that the latter would compose music to accompany the lyrics). It is likewise immaterial that the accompanying intention that an author’s work be combined in a joint work be directed at a particular co-author. *See Donna*, 374 F.Supp at 430 (“Although Larsen’s photographs were not taken with Donna’s text specifically in mind, it appears that they may have been intended from the start to become part of a joint work from another source”).

Both Plaintiff and Weston exhibited an intention that their independent work be combined into complete songs. Plaintiff admits that his initial meeting with Weston involved discussion of Plaintiff providing Weston with some pre-recorded music for Weston’s upcoming recording project. *See* Exhibit A to Sony’s motion, Plaintiff’s Third Amended Complaint, ¶ 12.

Moreover, after discussing this collaboration, Plaintiff admits that he presented Weston with a copy of approximately twenty-one songs, and arranged for Weston to return to Plaintiff's studio specifically to conduct a recording session using some or all of those twenty-one songs. *See Id.*, ¶ 13, 15.

Plaintiff's intent of "joint work" ownership is evident in his deposition testimony:

10 Q ... at the time that each of those songs was created
11 did you believe that you owned the entire song or half
12 of the song?

13 A I only believe -- I only believed or ever
14 wanted to believe that I owned the musical content of
15 the song. I don't want anybody else's credit or
16 anybody else's compensation for their work, I just want
17 what's due me.

See Exhibit F to Sony's motion, page 183. Plaintiff knew from the moment the songs were recorded in his studio up through the final mastering of the entire *Undaground Legend* album that the three songs at issue were to be commercially distributed:

3 Q Okay. When you recorded this three songs
4 that are at issue in this case, was the intent to have
5 them be made commercially available?

6 A I think any true production's intent is
7 always at some point to have their material made
8 commercially available.

See id., page 190. Granville understood at the time of recording that the songs were to be included on one of Weston's albums. *See id.*, p.157: 7-11. Through his mastering of the complete album, Granville knew the final version of *Undaground Legend* contained the three songs at issue. *See id.*, p.39:10-12; p.39:22 – p.42:2.

Plaintiff clearly intended his musical contributions to conclude in three complete songs available for commercial distribution. As recently described in a music copyright case concerning joint work status:

Intentional collaboration is inherent in the facts which plaintiff has pled. The song was allegedly created in a recording session in which [composer] and [lyricist] both willingly participated in the marriage of [composer's] pre-existing tune with [lyricist's] newly-created lyrics. These facts demonstrate an intention that their respective contributions be merged into interdependent parts of a unitary whole...

Johnson v. Berry, 171 F.Supp.2d 985, 988 (E.D.Mo. 2001). The evidence from Plaintiff himself and applicable case law suggest the songs at issue were joint works as a matter of law.

III. Plaintiff Granted Defendants a Non-Exclusive License

17 U.S.C. § 204(a) requires that a transfer of exclusive rights in copyright be in writing. Section 101 provides, however, that a “transfer of copyright” does not include a nonexclusive license. 17 U.S.C. §101. Courts interpret this statutory interplay to allow for the transfer of nonexclusive licenses by oral grant or by conduct of the parties. *See Lulirama, Ltd., Inc. v. Access Broad. Servs., Inc.*, 128 F.3d 872 (5th Cir. 1997); *I.A.E. v. Shaver*, 74 F.3d 768 (7th Cir. 1996)(a nonexclusive license need not be in writing, but may be implied from conduct).

An nonexclusive license is implied from conduct when (1) the licensee requests the creation of a work; (2) the licensor creates the work and delivers it to the licensee who asked for it; and (3) the licensor intends that the licensee copy and distribute the work. *Lulirama Ltd., Inc. v. Access Broadcast Svs., Inc.*, 128 F.3d 872, 879 (5th Cir. 1997)(citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558-59 (9th Cir. 1990)). Uses of a copyrighted work that stay within the scope of a nonexclusive license are immunized from infringement claims. *Danielson v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 40 (1st Cir. 2003). Because Defendants’ obtained such an implied nonexclusive license from Plaintiff, their use of any such copyrighted material should be immunized from Plaintiff’s infringement claims.

A. Weston Requested Creation of the Works

In his Third Amended Complaint, Plaintiff admits that Weston, after first hearing some of Plaintiff's music, contacted Plaintiff and expressed interest in recording certain tracks of Plaintiff's music. *See* Plaintiff's Third Amended Complaint, ¶ 15. Over the course of the next year, Weston returned to Plaintiff's studio on several occasions, each time for the express purpose of recording certain tracks of Plaintiff's, including the three songs which would become the basis of this lawsuit: "Make Momma Proud," "Texas Boys," and "What I Been Through." *See id.* at ¶¶ 17, 21, 24. Plaintiff admits that on each of these occasions, Weston requested that he record and Plaintiff produce the music in question.

B. Plaintiff Delivered the Works to Weston

Plaintiff freely delivered the works in question to Weston. Plaintiff admits in his current trial pleading that Weston left these recording sessions with a CD copy of the newly recorded "Make Momma Proud" and "Texas Boys." *See id.* at ¶¶ 19, 21. Plaintiff similarly delivered a hard copy of "What I Been Through" to Defendants through Weston.

C. Plaintiff Intended that Defendants Copy and Distribute the Works

The intent of a supposed implied licensor has been determined in the courts by certain factors of the licensor's conduct such as the permanent or piecemeal nature of the parties' relationship, the direct delivery of the copyrighted materials to the licensee, and the lack of warning or prohibition against the use of such materials. As explained in more detail below, Plaintiff's conduct clearly evidences an intent to grant a nonexclusive license to Defendants.

Plaintiff's involvement in the recording of these individual songs, recorded in an individual piecemeal fashion, reflects the type of "short-term transactions" interpreted in relevant case law as suggesting an intent to grant an implied nonexclusive license. *Nelson-Salabes, Inc.*

v. Morningside Development, LLC, 284 F.3d 505, 515 (4th Cir. 2002). By recording the songs with Weston and releasing them to him to take back to Suckafree and Sony, Plaintiff neither gave any indication that the use of the materials was contingent on Plaintiff's future involvement on the project nor manifested any outward expectations of continued involvement. *See Danielson*, 322 F.3d at 42 (short-term nature of the assignment and lack of outward signs of expectations of future involvement suggest intent to grant a nonexclusive license); *Nelson-Salabes*, 284 F.3d at 515; *I.A.E. v. Shaver*, 74 F.3d 768, 776-7 (7th Cir. 1996).

In addition, direct receipt of copyrighted material from the supposed licensor, as occurred in this case, has generally been held to suggest permission to use them. *Danielson*, 322 F.3d at 42. *See also Shaver*, 74 F.3d at 777. Based on the applicable case law concerning the conduct exhibited by Plaintiff in the case at bar, Plaintiff granted an implied nonexclusive license to Defendants and Defendants should be immunized from Plaintiff's infringement claims.

IV. 17 U.S.C. §412 Precludes Plaintiff's Recovery

Plaintiff is precluded by 17 U.S.C §412 from recovering statutory damages or attorney's fees for his claimed infringements of music included in "What I Been Through" or "Make Mama Proud" because his copyright registrations were untimely. Section 412 dictates that in order to recover statutory damages and attorney's fees, a claimant must show that the copyright was registered before the alleged acts of infringement commenced, including a three month grace period for published works. *See* 17 U.S.C. §412. The music in question was not copyrighted until ten months after the alleged acts of infringement commenced.

Plaintiff alleges that music contained on "The Works of Tomi Gran: Vol. 5," was incorporated into two of Weston's recordings. *See* Plaintiff's Third Amended Complaint, ¶ 30. Specifically, Plaintiff alleges Track 24 "My Life" was used on "What I Been Through" and

Track 25 “For My Mama” was used on “Make Mama Proud.” *See id.* Weston’s album “Undaground Legend” was released in August 2002. *See id.*, at ¶ 28. The copyright for “The Works of Tomi Gran: Vol. 5,” Registration No. PAu2-793-076, was not registered until June 17, 2003, roughly ten months after the alleged acts of infringement. *See* Certificate of Registration, attached as Exhibit “E” to Plaintiff’s Motion for Summary Judgment (docket # 109). 17 U.S.C. §412 provides that:

“no award of statutory damages or attorney’s fees, as provided by sections 504 and 505, shall be made for—

- (1) any infringement of copyright in an unpublished work commenced before the effective date of its registration, or
- (2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.”

17 U.S.C. §412 (emphasis added). *See Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 144 (5th Cir. 1992) (plaintiff, upon proving infringement, would only be entitled to recover statutory damages and attorney’s fees for one of 233 claims of infringement because only the copyright to that one work was registered before or within three months after the alleged acts of infringement). *See also On Davis v. The Gap, Inc.*, 264 F.3d 152, 158 (2nd Cir. 2001) (because the alleged infringement occurred “far more than three months after the first publication” and “before registration of the copyright, ... [plaintiff] is ineligible for statutory damages or attorney's fees”). Under 17 U.S.C. §412, Plaintiff is precluded from recovering statutory damages or attorney’s fees for any alleged acts of infringements of the material contained in “The Works of Tomi Gran: Vol. 5.” *See* 17 U.S.C. §412.

In addition, Plaintiff is also unable to recover for any acts of infringement pertaining to this copyright that Plaintiff alleges to continue after the effective date of registration. *See Mason*, 967 F.2d at 144 (“a plaintiff may not recover an award of statutory damages and

attorney's fees for infringements that commenced after registration if the same defendant commenced an infringement of the same work prior to registration").

V. Statutory Damage Awards Are Calculated Based on Number of Infringed Works

Statutory damages under the Copyright Act must be calculated based upon the number of copyrighted works found to be infringed, rather than the number of alleged infringements or the number of participating persons in the infringement. In the event of any finding of liability in favor of Plaintiff and a subsequent election by Plaintiff of statutory damages, Plaintiff's recovery should be limited to a calculation based on this incontrovertible premise of law.

A. Statutory Damages Are Calculated Based Upon the Number of Infringed Works, Not the Number of Alleged Infringements

Under 17 U.S.C. §504, a copyright owner may elect to recover statutory damages, in lieu of actual damages and profits, for all copyright infringements with respect to any one work infringed.¹ *See* 17 U.S.C. 504(c)(1). The statute continues, providing for an award of between \$750 and \$30,000 for each work infringed for unknowing violations. *See id.*

Federal case law has been uniform in its interpretation of section 504(c)(1), holding that "the total number of 'awards' of statutory damages that a plaintiff may recover in any given action depends on the number of *works* that are infringed and the number of individually liable *infringers*, regardless of the number of *infringements* of those works." *Mason*, 967 F.2d at 143("the total number of 'awards' of statutory damages that a plaintiff may recover in any given action depends on the number of *works* that are infringed and the number of individually liable

¹ Plaintiff has not yet made an election between statutory and actual damages. To the extent Plaintiff elects actual damages, Defendants note that Plaintiff has provided no evidence on Plaintiff's actual damages and his proffered expert report only discusses statutory damages and Defendant's alleged profits from the *Undaground Legend*. There is little to no evidence that Plaintiff could recover any amount of actual damages or an apportionment of defendants' profits from the published album.

infringers, regardless of the number of *infringements* of those works”).² A similar holding resulted in *Hernandez v. Sonolux Records*, wherein plaintiff songwriter sued two recording companies for sixteen albums, each including at least one of two infringed songs belonging to plaintiff. *Hernandez v. Sonolux Records*, 370 F.3d 183, 185 (1st Cir. 2004). The First Circuit “joining in the prevailing reading in the circuits” held that “the total number of ‘awards’ of statutory damages that a plaintiff may recover ... depends on the number of works that are infringed and the number of individually liable infringers and is unaffected by the number of infringements of those works.” *Id.*, at 194. Thus, despite plaintiff’s claim of entitlement to a \$100,000 award for each of the sixteen willfully infringing albums, the lower court’s award of \$1,600,000 was vacated and the case was remanded to determine damages based on the number of plaintiff’s songs infringed. *See id.*, at 196-97.

The Second Circuit concurs with the reasoning in *Mason* and *Sonolux*, stating that § 504(c) “shifts the unit of damages inquiry from the number of infringements to the number of works.” *Twin Peaks Productions, Inc. v. Publications International, Ltd.*, 996 F.2d 1366, 1381 (2nd Cir. 1993). In that case, an author of a book concerning a popular television miniseries was held to have infringed eight separate copyrighted teleplays of the series, instead of the series as a whole, and was held liable for \$15,000 per teleplay, or a total of \$120,000. *See, id.*, at 1380. The Second Circuit made a point of demonstrating that “[h]ad the District Court not considered eight separate works to have been infringed, statutory damages would have been limited to \$20,000 for a non-willful violation and \$100,000 for a willful violation.” *Id.*

² The legislative history and leading treatise on the subject concur. *See* H.R. REP. 94-1476, 2D SESS. AT 162, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5778 (quoted in *Mason*, 967 F.2d at 144, “[a] single infringer of a single work is liable for a single amount ..., no matter how many acts of infringement are involved”). *See generally* 4 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT, §14.04(E)(2)(A) (2004).

Although issues of infringement and the amount of damages are reserved for the finder of fact, the method of calculating the number of statutory damages is a matter of law to be decided by the Court. *See Hernandez*, 370 F.3d at 194 (interpreting §504(c) as a matter of law). If the Court should find that Plaintiff's copyright infringement claim survives its motion for summary judgment, Defendants request the Court to also hold that any recovery of statutory damages awarded under 17 U.S.C. §504(c) be calculated based on the number of works allegedly infringed rather than the number of infringements.

B. Statutory Damages Are Not Multiplied By the Number of Nature of the Infringing Acts

Any calculation of statutory damages in this case must be limited to only one award. Plaintiff alleges infringement of his copyrights through various activities, including both the distribution of copies of songs containing his musical compositions and the subsequent public performance of those songs. *See*, Plaintiff's Third Amended Complaint, at ¶31. However, neither each activity nor each right complained of, even if proven, acts as a multiplier of the number of statutory damage awards. The number of statutory damage sets is still calculated based upon the number of works infringed.

The current Copyright Act states that only one set of statutory damages "will be applicable 'for all infringements involved in the action, with respect to any one work'" for which an infringer is liable. *Sonolux*, 370 F.3d at 192 (quoting NIMMER § 14.04(E)(2)(A)). In addition, the legislative history surrounding § 504 on the subject concurs with this rule. The House Report on the issue states "[a] single infringer of a single work is liable for a single amount ..., no matter how many acts of infringement are involved." H.R. REP. NO. 94-1476, 2D SESS. at 162, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5778 (as quoted in *Mason*, 967 F.2d at 144). *See generally*, 4 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT, § 14.04(E)(2)(A) (2004).

The Copyright Act also makes no allowance for multiple acts of infringement regardless of whether they violate the same or different exclusive rights. The legislative history again states that “although the minimum and maximum amounts are to be multiplied where multiple ‘works’ are involved in the suit, the same is not true with respect to multiple copyrights, multiple owners, multiple exclusive rights, or multiple registrations.” 17 U.S.C. § 504, Notes of Committee on the Judiciary, H.R. REP. NO. 94-1476, n.3.

Consequently, the number of sets of statutory damages is unaffected by both the number and nature of infringing acts. The number of statutory damages awards remain limited to the number of works infringed then and are linked neither to the number of infringing acts committed, nor the number of exclusive rights violated. The infringement of a single copyrighted work by an individually liable infringer or a group of jointly liable infringers will be compensated by a single award of statutory damages, regardless of how many infringing acts occur or how many exclusive rights are violated.

C. Statutory Awards Are Not Multiplied In This Case By the Number of Defendants

The number of Defendants allegedly responsible for the infringement of a particular work will not act as a multiplier of statutory damages sets, unless they are proven to be independently liable, as opposed to jointly. Because Plaintiff alleges that Defendants acted jointly regarding the alleged infringements in this case, there is no number by which to multiply the number of sets of statutory damages recoverable.

17 U.S.C. § 504 states that a copyright owner may elect to recover “an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally.” 17 U.S.C. § 504(c)(1). The leading treatise on the subject adds “[w]here two or

more persons have joined in or contributed to a single infringement of a single copyright, they are all jointly and severally liable, and in such circumstances, in a single infringement action there is but a single set of statutory damages ... for which all such persons are liable.” 4 NIMMER ON COPYRIGHT §14.04(E)(2)(D) (2005). *See also, Universal Studios, Inc. v. Ahmed*, No. 93-3266, 1993 U.S. Dist. LEXIS 14951, at *10-11 (E.D. Pa. 1993); *Warner Bros., Inc., v. Dae Rim Trading, Inc.*, 677 F.Supp. 740, 769 (S.D.N.Y. 1988) (“Where two or more persons join in or contribute to a single infringement, they are all jointly and severally liable”); *Fitzgerald Publishing Company, Inc. v. Baylor Publishing Company, Inc.*, 807 F.2d 1110, 1116 (2nd Cir. 1986) (because the infringement flowed from the joint action of two defendants, both were held jointly and severally liable).

For each infringing activity alleged in Plaintiff’s most recent complaint, all defendants are listed by name as jointly having had “participated in” or “participated in and contributed to” the stated alleged acts of infringement. *See*, Plaintiff’s Third Amended Complaint, at ¶ 32. In detailing the factual basis for his allegations of willful and knowing infringements, Plaintiff likewise groups all of the defendants together as one joint actor. *See, id.*, at ¶ 33-34. Because the defendants are alleged to have joined in or contributed to infringe the stated copyrights, their joint action is counted as if committed by a single infringer and they will only be jointly and severally liable for one statutory damage award for each copyright infringed. *See, Dae Rim*, 677 F.Supp. at 769 (“in such circumstances in a single infringement, there is but a single set of statutory damages”).

VI. Plaintiff’s extraneous claims are invalid.

Plaintiff’s complaint centers around one allegation – Defendants allegedly obtained and distributed Plaintiff’s work without obtaining Plaintiff’s permission. This is a straightforward

copyright claim, which is addressed by the Federal Copyright Act. Plaintiff's extraneous claims for unfair practices under Texas law, Lanham Act violations, and violations of the Geneva Phonogram Convention should be dismissed.

A. Plaintiff's state law claims for unfair trade practice and unfair competition are preempted by federal copyright law.

The Federal Copyright Statute (the "Copyright Act"), 17 U.S.C. § 101, *et seq.*, contains the following preemption provision:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

17 U.S.C. § 301. Federal appellate courts, including the Fifth Circuit, interpret this provision to preempt state law causes of action when the state cause of action falls within the subject matter of copyright law, and the cause of action protects rights that are "equivalent" to any of the exclusive rights of federal copyright provided in 17 U.S.C. § 106. *See Daboub v. Gibbons*, 42 F.3d 285, 289 (5th Cir. 1995). Plaintiff's state law claims for unfair trade practice and unfair competition are preempted for the following reasons.

Plaintiff pleaded his claim of "Unfair Trade Practices & Statutory And Common Law Unfair Competition" as follows:

Defendants respectively have been publishing, selling, and otherwise marketing the Songs entitled 'What I Been Through,' 'Make Mama Proud,' and 'Texas Boys.' The foregoing acts and conduct of Defendants, and each of them, constitute an appropriation and invasion of the property rights of Mr. Granville in and to Mr. Granville's recordings as alleged herein.

See Plaintiff's Third Amended Complaint, ¶ 36. His purported interests in these songs fall within the subject matter of copyright law because § 102 of the Copyright Act provides, "Copyright protection subsists . . . in original works of authorship Works of authorship include . . . musical works, including any accompanying words . . .". 17 U.S.C. § 102. Moreover, in *Daboub v. Gibbons*, the Fifth Circuit held that songwriters and performers' interests in their musical selections fall within the subject matter of copyright law. 42 F.3d at 289 n.6 (noting that the plaintiffs correctly conceded that an interest in a musical selection falls within the subject matter of copyright law). Accordingly, the first prong of copyright preemption is satisfied because Plaintiff is seeking to protect interests in songs that are subject to copyright law.

The second prong of the preemption analysis is also satisfied because Plaintiff's unfair trade practice and unfair competition claims seek to protect rights that are "equivalent" to the rights already given protection in § 106 of the Copyright Act. Section 106 provides:

the owner of [a] copyright . . . has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; [and] (4) in the case of . . . musical . . . works . . . , to perform the copyrighted work publicly . . . , to display the copyrighted work publicly . . . and in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 106. "A state law cause of action is 'equivalent' to any of these rights if 'the mere act of reproduction, distribution, or display infringes it.'" *Tavormina v. Evening Star Products, Inc.*, 10 F.Supp.2d 729, 733-34 (S.D. Tex. 1998). Stated otherwise, a state law cause of action will protect rights that are equivalent to the rights protected in § 106 if the acts that give rise to the state cause of action would also constitute a violation of federal copyright law. See generally *Alcatel USA, Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 787 (5th Cir. 1999); see also, *Sefton v. Jew*,

201 F. Supp. 2d, 730, 745 (W.D. Tex. 2001)(noting that rights protected by state and federal copyright law are equivalent "if the defendant's alleged acts would violate both state law and federal copyright law. . . .").

The rights protected in § 106 are precisely the type of rights that Plaintiff claims Defendants infringed when they purportedly authorized the making and distributing of songs which incorporated songs previously authored, recorded, and copyrighted by Plaintiff. More importantly, these are precisely the type of rights that Plaintiff is attempting to vindicate in his unfair trade practice and competition claims, and it is particularly noteworthy that Plaintiff has pleaded these claims to be contingent on the very same allegations that he offers to support his federal copyright claim.

B. Plaintiff has failed to state a cognizable claim for relief under the Lanham Act.

The relevant portions of section 43(a) of the Lanham Act provide:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1). This statute is designed to ensure proper identification of the geographic area from which goods and services originate and to ensure proper identification of the source or manufacturer of the goods or services. *See Dastar Corp. v. Twentieth Century Fox Film Corp.*,

123 S.Ct. 2041, 2045-46 (2003). The statute does not, however, "have boundless application as a remedy for unfair trade practices" *Id.* at 2045. Specifically, the Lanham Act does not prevent what Plaintiff alleges here, i.e., the alleged unauthorized copying of a copyrighted work.

None of the parties dispute that the United State Supreme Court's opinion in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 123 S.Ct. 2041 (2003) controls Plaintiff's Lanham Act claim. *Dastar* stands for the proposition that failure to credit the creative contribution of a particular author is not cognizable under the Lanham Act. Plaintiff contends that the Supreme Court's dicta – that an unauthorized exact duplication of an item creates an exception to this rule – is applicable to the present facts. As is evident by the *Dastar* opinion itself and the material facts contained in Plaintiff's live complaint, any such exception does not apply in this case.

The Supreme Court stated that a Lanham Act claim "would undoubtedly be sustained if [the defendant] had bought some of [plaintiff's] videotapes and merely repackaged them as its own." *Dastar*, 123 S.Ct. at 2046. Plaintiff in this case attempts to salvage his claim by shoehorning his facts to fit within this statement. However, the Supreme Court gave more guidance on this point. Immediately after the quoted statement, the Supreme Court continued:

[defendant's] alleged wrongdoing, however, is vastly different: it took [plaintiff's] creative work ... copied it, made modifications (arguably minor), and produced its very own series of videotapes.

Dastar, 123 S.Ct. at 2046-47. This complete recitation of the "Dastar exception" reveals the fallacy of Plaintiff's Lanham Act claim. Defendants did not receive an album from Plaintiff and merely reproduce it as an exact duplicate without Plaintiff's name – what is typically referred to as counterfeiting. As Plaintiff indicates throughout his Third Amended Complaint, the ultimate album distributed by Defendants was "vastly different" from Plaintiff's copyrighted compositions and not the simple "repackaging of a product."

Plaintiff's Third Amended Complaint states that Plaintiff presented Defendant Weston with a "Beat CD" containing musical compositions from the copyrighted work entitled "The Works of Tomi Gran: Volume 2." See Plaintiff's Third Amended Complaint at ¶ 13. According to Plaintiff, Defendant Weston expressed an interest in twenty-one songs contained therein, including a song which would later be entitled "Texas Boys." It is this and other copyrighted compositions that Defendants allegedly incorporated into the three songs at issue here. See *id* at ¶ 30. Plaintiff alleges that: (1) his compositions "Bring the Jazz Back" and "My Life" were used on Defendants' recording "What I Been Through"; (2) his composition "Welcome to Texas" was used on Defendants' recording "Texas Boys"; and (3) his composition "For My Mama" was used on Defendants' recording "Make Momma Proud". See *id*.

Plaintiff repeatedly states in his Third Amended Complaint that the recordings made by Defendant Weston "incorporated song(s)" wholly authored, recorded and copyrighted by Plaintiff. See *id*. at ¶¶ 18, 22 and 24. Furthermore, Plaintiff states that the copyrighted compositions were "used on" the allegedly infringing tracks. See *id*. at ¶ 30. Nowhere does Plaintiff contend that Defendants simply repackaged commercial versions of his copyrighted compositions or that Defendants reproduced his copyrighted compositions as an exact duplicate without Plaintiff's name. In short, the allegedly infringing tracks were not duplicates (counterfeits) of Plaintiff's copyrighted compositions. In addition, as Plaintiff admits in his Third Amended Complaint, the song titles were all changed from their original titles on Plaintiff's copyrighted compositions to their eventual titles on Defendants' *Undaground Legend* album. See *id*.

These facts are analogous to the facts in *Dastar* in which the court found that the defendant's conduct did not constitute a Lanham Act violation. In *Dastar*, the defendant

“substituted a new opening sequence, credit page, and final closing..., inserted new chapter-title sequences and narrated chapter introductions; moved the ‘recap’ in the Crusade television series to the beginning and retitled it as a ‘preview’; and removed references to and images of the book. Dastar created new packaging and ... a new title.” *Dastar*, 123 S.Ct. at 2044.

As in *Dastar*, Plaintiff’s claims against Sony do not fall under the Lanham Act because, even taking all of Plaintiff’s allegations as true, Sony did not simply repackage Plaintiff’s compositions as its own. *See id.* at 2046-47. According to Plaintiff’s own pleadings, Sony’s alleged wrongdoing consisted of taking “a creative work ... [making] modifications (arguably minor), and produc[ing] its very own [album].” *See id.* at 2047.

The Lanham Act only protects the identity of the geographic origin or the actual manufacturer or producer of a tangible good, not the person who conceived of the idea embodied or communicated in the good. *Id.* at 2050. As explained in *Dastar*, the focus is on the entire product distributed, not the ideas embodied in the good. *Id.* This was further explained by the Fifth Circuit in affirming Judge Melinda Harmon’s summary judgment dismissal of a plaintiff’s Lanham Act claim:

[Plaintiff] has not accused [defendant] of taking tangible copies of its software, removing its trademarks, and selling them as its own. Rather, [plaintiff] asserts that [defendant] copied the ideas, concepts, structures, and sequences embodied in its copyrighted work. In sum and substance, [plaintiff's] claim is simply a claim that [defendant] has infringed its copyright.... *Dastar* makes clear that such claims are not actionable under § 43(a).

General Universal Systems, Inc. v. Lee, 379 F.3d 131, 149 (5th Cir. 2004) (dismissing plaintiff’s claims of palming off also known as reverse passing off). Again, Defendants did not duplicate Plaintiff’s “master recording.” Defendants manufactured and distributed a marketable album complete with sixteen songs, artwork, song titles, credits, photographs, etc. “In sum and substance, [Plaintiff’s] claim is simply a claim that [Defendants] [have] infringed [his]

copyright.” *Lee*, 379 F.3d at 149. The Lanham Act does not apply and Plaintiff’s claim should be dismissed.

C. Plaintiff has no claim under the Phonogram Convention.

The Phonogram Convention is a treaty promulgated under the auspices of the United Nations and subsequently ratified by the United States to address piracy of sound recordings. Any protection potentially afforded by the Phonogram Convention applies only to nationals of other contracting states, not to American citizens complaining of acts committed in the United States. *See* Melville B. Nimmer & Paul Edward Geller, *International Copyright Law and Practice* §3[3][d] (2004). The treaty, by its express terms, simply does not apply.

Moreover, the treaty does not cover private litigants, nor does it grant a private cause of action. In the absence of suitable granting language or some concomitant enabling statute, a private cause of action cannot be implied. *See, Diggs v. Richardson*, 555 F.2d 848, 180 U.S. App. D.C. 376 (D.C. 1976) (U.N. resolution or treaty to which United States is a signatory does not confer rights on U.S. citizens that are enforceable in court absent implementing legislation); *Sosa v. Alvarez-Machain*, 124 S.Ct. 2739 (2004) (decision to create a private cause of action should not be inferred and should rest on express congressional action). Moreover, for the reasons set out in Paragraph V, *infra*, any such novel claim by Plaintiff would be preempted. *See*, the Phonogram Convention at Art. 3 (implementation of the Convention shall be a matter of U.S. law and shall include copyright grants), Art. 6, and Art. 7. Plaintiff has no legal right to seek affirmative relief under the Phonogram Convention.

For the foregoing reasons, all relief sought by Plaintiff should be denied, with costs and fees assessed against the Plaintiff.

Respectfully submitted,

/s/ Geoffrey H. Bracken by permission ST

Geoffrey H. Bracken
Texas State Bar No. 02809750
ATTORNEY-IN-CHARGE FOR DEFENDANTS,
SONY BMG MUSIC ENTERTAINMENT INC. AND
LOUD RECORDS, LLC

OF COUNSEL:
Samantha Trahan
Texas State Bar No. 24028073
GARDERE WYNNE SEWELL LLP
1000 Louisiana, Suite 3400
Houston, Texas 77002-5007
713-276-5500 (Telephone)
713-276-5555 (Facsimile)

CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure, I hereby certify that a true and correct copy of the foregoing instrument was served electronic mail or U.S. mail on this 2nd day of August 2005, to the following counsel of record:

Raymond Mbala
Mbala & Williams, PLLC
100 North Central Expressway, Suite 400
Dallas, Texas 75201

D. Scott Hemingway
Malcolm Pipes
Charles D. Herrick
Hemingway, LLP
460 Preston Commons West
8117 Preston Road
Dallas, Texas 75225

Alton J. Hall, Jr.
O. Darcele Holley
Epstein Becker Green Wickliff & Hall, P.C.
1000 Louisiana, Suite 5400
Houston, Texas 77002

/s/ Samantha Trahan
Samantha Trahan