

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

WE SHALL OVERCOME FOUNDATION
and BUTLER FILMS, LLC, on behalf of
themselves and all others similarly situated,

Plaintiffs,

v.

THE RICHMOND ORGANIZATION, INC.
(TRO INC.) and LUDLOW MUSIC, INC.,

Defendants.

C.A. No. 16-cv-02725-DLC

**PLAINTIFFS' MEMORANDUM OF LAW IN OPPOSITION TO
DEFENDANTS' MOTION TO DISMISS AMENDED CLASS ACTION COMPLAINT**

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Plaintiffs, We Shall Overcome Foundation (“WSOF”) and Butler Films, LLC (“Butler”), on behalf of themselves and all others similarly situated, by their undersigned attorneys, hereby submit this Memorandum of Law in Opposition to Defendants’ Motion to Dismiss the Amended Class Action Complaint (“Complaint”).

I. INTRODUCTION

The Library of Congress called *We Shall Overcome* (the “Song”) “the most powerful song of the 20th century” because it “inspired one of the greatest freedom movements in U.S. history, and went on to topple governments and bring about reform all over the world.” The Song is an adaptation of an African-American spiritual with *exactly the same melody and nearly identical lyrics* from the late 19th or early 20th century. It was first used as an inspirational song by African Americans and then as a protest song by the labor movement in the early part of the 20th century. By the 1950s, *We Shall Overcome* was the unofficial anthem of the Civil Rights Movement, and the Song has since become an important part of American culture and politics.

Defendants, The Richmond Organization, Inc. (TRO Inc.) (“TRO”), and Ludlow Music, Inc. (“Ludlow”), claim to own the copyright to *We Shall Overcome*, including the Song’s melody and lyrics, under two narrow, expressly limited copyrights obtained by Ludlow in 1960 and 1963, *neither of which covers the Song’s melody or familiar lyrics*. Plaintiffs seek a judicial determination that those copyrights do *not* cover the Song’s melody or familiar lyrics. In addition, to the extent the copyrights cover other elements of the Song (including both musical arrangements and six alternate verses), Plaintiffs seek to invalidate them based on Defendants’ fraud upon the Copyright Office. Although Defendants now admit (*see* Defs. Br. at 2, emphasis added) that *We Shall Overcome* “incorporated rich and important traditional elements *from the public domain*” – apparently referring to the identical melody and nearly identical lyrics of the African-American spiritual – Defendant Ludlow falsely claimed in its 1960 copyright application

that the Song was derived from a prior *copyrighted* work called “I’ll Overcome.”¹ *We Shall Overcome* was *not* derived from that song, and Ludlow’s claim was materially false.

As the main point of their motion to dismiss, Defendants argue that *We Shall Overcome* is “distinguishable from any predecessor or prior version of the Song.” Defs. Br. at 2. In particular, Defendants focus their argument on just two words, “shall” and “deep,” which they say are original and unique to their works. *See, e.g.*, Defs. Br. at 15. Significantly, however, Defendants do *not* assert (or even imply) that they wrote the words “shall” or “deep,” nor do they attempt to identify who did so or how they acquired any rights to those words from the author(s). Defendants have not done so in their lengthy motion to dismiss for the simple reason that they did *not* write those words, nor did the individuals named in the 1960 and 1963 copyrights. Defendants also do *not* claim anywhere in their voluminous motion papers that they wrote any part of the Song’s melody,² implicitly conceding Plaintiffs’ well-pled factual allegation that it is, in fact, *identical* to the African-American spiritual.

Defendants’ factual argument over the lyrics is easily refuted in any event. In addition to the African-American spiritual itself, the Complaint alleges at least two prior works that included

¹ No prior copyright existed for a work entitled “I’ll Overcome.” However, a prior copyright was obtained in 1900 for a song by the Rev. Charles Tindley entitled “I’ll Overcome Some Day.” The melody of that song is entirely different from the melody of *We Shall Overcome*.

² Defendants argue that the 1960 and 1963 copyrights cover the “classic arrangement” of the Song (*see* Defs. Br. at 2), but they stop short of claiming that the copyrights cover the *melody itself*. The “melody of a song ‘consists primarily of pitch and rhythm. Pitch is the specific high or low placement of a musical sound, often within a musical scale.’” *Velez v. Sony Discos*, No. 05 Civ. 0615 (PKC), 2007 U.S. Dist. LEXIS 5495, at *33 (S.D.N.Y. Jan. 16, 2007) (Castel, J.) (citation omitted). A musical arrangement is a derivative work. *See TufAmerica, Inc. v. Codigo Music LLC*, No. 11 Civ. 1434 (ER), 2016 U.S. Dist. LEXIS 18462, at *8 n.5 (S.D.N.Y. Feb. 16, 2016) (Ramos, J.). An arrangement “is a musical reconceptualization of a previously composed work. It may differ from the original work by means of reharmonization, melodic paraphrasing, orchestration, or development of the formal structure.” *See Arrangement*, WIKIPEDIA (Aug. 5, 2016, 11:27 PM), <https://en.wikipedia.org/wiki/Arrangement>. In *Velez*, the Court noted that two versions of the alleged infringing work “*differ* in their arrangement [but] the melodies of the songs are nearly *identical*.” *TufAmerica*, 2016 U.S. Dist. LEXIS 18462 at *6 (emphasis added).

the *exact same lyrics* as *We Shall Overcome*. For example, in December 1959, a year *before* Ludlow registered the 1960 copyright, the composer Robert De Cormier (“De Cormier”) published a song entitled “We Shall Overcome,” which (as documents submitted by Defendants with their motion papers prove conclusively) included the *exact same melody and lyrics* that Defendants claim as theirs, including both “shall” and “deep” in the lyrics. Likewise, in June 1960, four months *before* Ludlow’s 1960 copyright, American folk singer Pete Seeger (“Seeger”) and Irwin Silber (“Silber”) published the *exact same lyrics* as *We Shall Overcome* – again, including both “shall” and “deep” – without identifying any author of the lyrics.

Leaving apart Defendant Ludlow’s fraud on the Copyright Office and notwithstanding Defendants’ repetitious argument to the contrary, the copyrights do *not* cover the Song’s melody or well-known lyrics. To the contrary, the registrations cover *different* elements of the Song. In its application for the 1960 copyright, Reg. No. EU645288, Defendant Ludlow identified the new matter as follows: “Original registration under title I’LL OVERCOME. Melody has been changed. *Harmonization wholly original. Verses 2, 3, 4 of lead sheet attached all original.*” (Emphasis added.) While the Song’s melody is completely different from “I’ll Overcome,” it was *identical* to the African-American spiritual that Defendants now admit was the basis for the Song. In addition, on its face, the 1960 copyright does *not* cover the Song’s familiar lyrics, which were set forth in Verses 1 and 5, not in Verses 2, 3, or 4. The 1988 renewal of that copyright, Reg. No. RE386757, identifies the renewable matter as “New Words & Music Arrangement,” and expressly does not cover any part of the Song’s melody.

Similarly, in its application for the 1963 copyright, Reg. No. EP179877, Defendant Ludlow identified the new matter as: “Arr[angement] for voice and piano with guitar chords plus completely new words in *verses 6, 7, and 8.*” (Emphasis added.) The 1963 copyright likewise

does *not* cover the familiar lyrics, which were again set forth in Verses 1 and 5, not in Verses 6, 7, or 8. And again, the 1991 renewal of that copyright, Reg. No. RE523130, identifies the renewable matter as “Arr[angement] for voice and piano with guitar chords plus completely new words in verses 6, 7, and 8,” and expressly does not cover any part of the Song’s melody.

We Shall Overcome is simply too important to be subject to Defendants’ bogus copyright claim. Defendants do not have the right to say who may use the Song and how it may be used, they do not have the right to determine how the Song’s history is told, and they do not have the right to determine how the story of the Civil Rights Movement is told. As the Supreme Court recently recognized, the Copyright Clause of the Constitution requires “striking a balance between two subsidiary aims: encouraging and rewarding authors’ creations while also *enabling others to build on that work.*” *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct. 1079, 1086 (2016) (2016) (emphasis added). However Defendants may choose to characterize their motives, they simply have no right to stop others, such as Plaintiffs in this case, from building upon work already in the public domain to produce their own important works.

Defendants have failed to identify any legal deficiency in the Complaint that would require it to be dismissed. Their motion to dismiss is nothing more than a long-winded denial of Plaintiffs’ detailed factual allegations, based almost entirely upon their erroneous assertion that the words “shall” and “deep” in the 1960 and 1963 works were original and unique. They were not. It is axiomatic that a complaint cannot be dismissed under Rule 12(b)(6) merely because the defendant disputes the plaintiff’s factual allegations, particularly where (as here) the defendant’s denial is inconsistent with historical documents and public records. *See, e.g., Sharette v Credit Suisse Int’l*, 127 F Supp 3d 60, 84 (S.D.N.Y. 2015) (Marrero, J.) (denying motion to dismiss that “merely raised a factual dispute inappropriate for resolution at the pleading stage”).

For these reasons, explained more fully below, Defendants’ motion to dismiss the Complaint should be denied and this case should proceed to a determination on the merits.

II. FACTUAL BACKGROUND

The musical composition³ *We Shall Overcome* is a derivative work adapted from an earlier public work: an African-American spiritual with *exactly the same melody and nearly identical lyrics* from the late 19th or early 20th century. Comp. ¶ 69. The well-known lyrics of *We Shall Overcome* are as follows:

We shall overcome
We shall overcome
We shall overcome some day
Oh deep in my heart, I do believe
We shall overcome some day

Comp. ¶ 48. The nearly identical lyrics of the African-American spiritual, sung to the exact same melody, are:

We (or I) will overcome
We (or I) will overcome
We (or I) will overcome some day
Oh deep (or down) in my heart, I do believe
We (or I) will overcome some day

Comp. ¶ 49.

The first known printed reference to “We Will Overcome,” in the February 1909 edition of the *United Mine Workers Journal*, referred to performances of that song in 1908 and much earlier. Comp. ¶ 50. The front page of the February 1909 *United Mine Workers Journal* stated: “Last year at a strike [in Alabama], we opened every meeting with a prayer, and singing that good old song, ‘We Will Overcome.’” *Id.* At that time, no copyright was registered or claimed,

³ According to the Copyright Office, a “musical composition consists of music, including any accompanying words, and is normally registered as a work of the performing arts.” Copyright Office Circular 56A, “Copyright Registration of Musical Compositions and Sound Recordings,” at 1 (Feb. 2012) (available at www.copyright.gov/circs/circ.56a.pdf). Comp. ¶ 19.

and no copyright existed, for “We Will Overcome.” Comp. ¶ 51.

In September 1948, People’s Songs, Inc. (“PSI”), an organization founded by American folk singer Seeger and others in 1945, printed “We Will Overcome” in Vol. 3, No. 8 of *People’s Songs*, the periodical it published. Comp. ¶¶ 53-55. The publication (reproduced in the Complaint) included sheet music with the melody and lyrics from the African-American spiritual as well as two additional verses. Comp. ¶ 55. Next to the title for “We Will Overcome,” PSI identified the author of the musical composition as follows: “By FTA-CIO Workers Highlander Students,” a reference to the affiliated Food, Tobacco, Agricultural, and Allied Workers (FTA) and Congress of Industrial Organizations (CIO) and to the Highlander Folk School. Comp. ¶ 56. The September 1948 edition of *People’s Songs* was registered with the Copyright Office under Reg. No. B184728. That copyright was never renewed, and consequently it expired 28 years later, in 1976, by which point (if not sooner) the melody and lyrics of “We Will Overcome” entered the public domain. Comp. ¶ 58.

On May 14, 2013, Lawrence Ferrara, Ph.D., a professor of music at New York University, prepared a musicological report (the “Ferrara Report”) for Defendants regarding *We Shall Overcome*. Comp. ¶ 100. Defendants have relied upon the Ferrara Report to substantiate their claim that they own a copyright to the Song. *Id.* According to the Ferrara Report, the “music and lyrics” of “We Will Overcome” published in *People’s Songs* in 1948 “is *virtually the same as*” the music and lyrics of *We Shall Overcome*. Comp. ¶ 101 (emphasis added).

In 1959, Vanguard Records, a record company, released a phonograph record narrated by Charlton Heston entitled *Out of Egypt: The Story of Moses*, which included a performance of *We Shall Overcome*. Comp. ¶ 62. On December 14, 1959, Cherry Lane Music, Inc. (“Cherry Lane”), a music publisher that frequently collaborated with Vanguard Records, registered a copyright

(Reg. No. EU606164) for *Music for 1st 5 Books of Moses*. Comp. ¶¶ 63-65. That work corresponded with the phonograph record entitled *Out of Egypt: The Story of Moses*. Comp. ¶ 64. *Music for 1st 5 Books of Moses* included sheet music for *We Shall Overcome*. *Id.* Reg. No. EU606164 covered the following work: “arr. & adapted w & m Bob Corman, pseud. of Robert De Cormier. NM: *arr. & adapted w&m*,” meaning arranged and adapted words and music. Comp. ¶ 65 (emphasis added). In its application for that copyright, Cherry Lane identified De Cormier as author of the “ARRANGEMENT + ADAPTATION OF WORDS AND MUSIC.”⁴ See Affirmation of Ofer Reger (“Reger Aff.”), Ex. I at 2. The melody (*i.e.*, music) is *identical* to the melody of the African-American spiritual and of *We Shall Overcome*. And the lyrics (*i.e.*, words) are *identical* to the familiar lyrics of *We Shall Overcome*. See *id.*, Ex. H at 3.⁵

In June 1960, Seeger and Silber published Vol. 10, No. 2 of a magazine entitled *Sing Out! The Folk Song Magazine* (“*Sing Out!*”), which included an article by Silber, entitled “He Sings for Integration,” about American folk singer Guy Carawan (“Carawan”). Comp. ¶¶ 59 & 66. The article included the Song’s lyrics, as follows:

We shall overcome,
 We shall overcome,
 We shall overcome some day;
 Oh, deep in my heart,
 I do believe,
 We shall overcome some day.

⁴ De Cormier renewed the 1959 copyright in 1988 (Reg. No. RE321286), claiming a copyright in the “New musical arrangement and *adaptation of words*” and identifying himself as “Author of arrangement and *adaptation of words*.” See Reger Aff., Ex. I at 4 (emphasis added).

⁵ Inexplicably, Defendants deny that the lyrics printed in *Music for 1st 5 Books of Moses* were *identical* to Verses 1 and 5 of the work copyrighted in 1960 and 1963. See Defs. Br. at 22. However, the sheet music for *Music for 1st 5 Books of Moses*, submitted by Defendants themselves, clearly included both “shall” and “deep” – the purportedly unique words protected by the 1960 and 1963 copyrights – in the lyrics. See Reger Aff., Ex. H at 3.

Comp. ¶ 66.⁶ The lyrics in Vol. 10, No. 2 of *Sing Out!* are **identical** to the well-known lyrics of *We Shall Overcome*. Comp. ¶ 67. The article did not include a copyright notice identifying either the copyright owner or the year of first publication of the lyrics. Comp. ¶ 66.

On October 27, 1960 – a year **after** Cherry Lane registered *Music for 1st 5 Books of Moses* and four months **after** SOI registered Vol. 10, No. 2 of *Sing Out!* – Defendant Ludlow filed a copyright Registration Application (Reg. No. EU645288) for *We Shall Overcome* as a purportedly unpublished derivative work.⁷ Comp. ¶ 69. The Song included the **exact same melody** as the work previously registered by Cherry Lane and the **exact same lyrics** as the works previously registered by Cherry Lane and SOI, but Ludlow failed to mention either of those two works or the African-American spiritual from which they were all derived. Comp. ¶¶ 70, 76, 79. Defendant Ludlow registered the copyright not to protect its own original work or the original work of the purported authors named in the copyright application, but instead to stop others from using a song they did not create. Comp. ¶¶ 104 & 105. In 1993, Seeger wrote that Defendant Ludlow did not identify Lucille Simmons as the author of the Song because no one knew her name at the time, suggesting that she may have written it. Comp. ¶ 106.⁸

In Paragraph 3 of the Registration Application for Reg. No. EU645288, Defendant Ludlow listed Zilphia Horton (deceased), Frank Hamilton, and Carawan as the authors of “New words & music Arrangement.” Comp. ¶ 70. Defendant Ludlow did not specify what was written by either of the authors. *Id.*; Reger Aff., Ex. F. In Paragraph 5(b) of the Registration Application,

⁶ On June 1, 1960, Vol. 10, No. 2 of *Sing Out!* was registered by Sing Out, Inc. (“SOI”), with the Copyright Office under Reg. No. B845820. Comp. ¶ 68.

⁷ A “derivative work” is “a work based upon one or more preexisting works, such as a . . . musical arrangement.” 17 U.S.C. § 101 (2012).

⁸ According to Seeger, Simmons changed the word “I” to “We,” which he considered the most important word in the Song. Comp. ¶ 104. Defendant Ludlow did not identify Simmons as a co-author in either copyright application. See Reger Aff., Exs. F at 2 and G at 2.

Ludlow described the new work as follows: “Original registration under title I’LL OVERCOME. Melody has been changed. Harmonization wholly original. *Verses 2, 3, 4* of lead sheet attached all original.” Comp. ¶ 71 (emphasis added); Reger Aff., Ex. F (same).

The deposit copy for Reg. No. EU645288 identified Horton, Hamilton, and Carawan as authors of “new words and music arrangement,” not the well-known lyrics or the melody itself. *See* Reger Aff., Ex. B at 2.

The Registration Application for Reg. No. EU645288 was false and misleading in at least four material respects. *First*, the work was *not* unpublished: the exact same melody and exact same lyrics had been published multiple times *before*, including PSI’s 1948 publication in *People’s Songs*, Cherry Lane’s publication in 1959, and SOI’s publication in June 1960. *Second*, the Song was *not* derived from “I’ll Overcome.” Although there was no prior copyright registration for any song with that name, *see* Comp. ¶ 76, Defendants now claim the work was actually the song “I’ll Overcome Some Day,” written by C. Albert Tindley and copyrighted by Hall-Mack Co. on November 1, 1900. *See* Reger Aff. Ex. E. A simple comparison of the two works shows they are entirely unrelated.⁹ *Third*, the Registration Application did *not* identify either PSI’s 1948 publication, Cherry Lane’s 1959 publication, SOI’s 1960 publication, or the original African-American spiritual, even though the melody and lyrics are all *identical or nearly identical* to *We Shall Overcome*. Those unnamed works were the original works from which *We Shall Overcome* was derived. And *fourth*, the Song’s melody was *not* changed from PSI’s 1948 publication, Cherry Lane’s 1959 publication, or the original African-American spiritual from which they are all derived – a well-pled fact that Defendants do not deny anywhere

⁹ *We Shall Overcome* is written in the G major heptatonic scale in 4/4, or common time, while “I’ll Overcome Some Day” has a completely different melody written in the pentatonic scale in 3/4 time. The lyrics of the two songs also are entirely different.

in their lengthy motion to dismiss.

On October 8, 1963, Defendant Ludlow filed another Registration Application (Reg. No. EP179877) for *We Shall Overcome* as a derivative work. Comp. ¶ 87. The Song again included the *exact same melody* as the African-American spiritual and the work previously registered by Cherry Lane and the *exact same lyrics* as the works previously registered by Cherry Lane and SOI, but Ludlow failed to mention either of those works in the application. Comp. ¶¶ 88-89, 94; Reger Aff., Ex. G. Defendant Ludlow did not identify the original work from which the work being registered was derived. *See* Reger Aff., Ex. G at 2.

In Paragraph 3 of the Registration Application for Reg. No. EU645288, Defendant Ludlow listed Horton (deceased), Hamilton, Carawan, and Seeger as authors of “New words and music adaptation.” Comp. ¶ 88. Defendant Ludlow did not specify what was written by either of the authors. *Id.*; Reger Aff., Ex. G. And it certainly failed to identify what additional new work Horton, who died in 1956 (*see* Comp. ¶ 61), added to the Song between 1960 and 1963. In Paragraph 5(b) of the 1963 Registration Application, Defendant Ludlow identified the new matter by stating: “Arr. for voice and piano with guitar chords plus *completely new words in verses 6, 7, and 8*. The addition of Pete Seeger’s name to writer credits is new.” Comp. ¶ 89 (emphasis added); Reger Aff., Ex. G (same).

The deposit copy for Reg. No. EP179877 identified Horton, Hamilton, Carawan, and Seeger as authors of “New Words and Music Adaptation,” again not the well-known lyrics or the melody itself. *See* Reger Aff., Ex. A at 3.

III. LEGAL ARGUMENT

A. Standards Governing Defendants’ Motion to Dismiss

A complaint should not be dismissed if it “give[s] the defendant fair notice of what the . . . claim is and the grounds upon which it rests.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555

(2007). Federal Rule of Civil Procedure 8 requires only that a complaint present a “short and plain statement of the claim showing that the pleader is entitled to relief.” To meet this standard and survive a motion to dismiss under Rule 12(b)(6), “a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 570).

Neither *Twombly* nor *Iqbal* “require the pleading of specific evidence or extra facts beyond what is needed to make the claim plausible.” *Arista Records LLC v. Doe 3*, 604 F.3d 110, 120-21 (2d Cir. 2010). As this Court recently held, a “claim has facial plausibility when ‘the factual content’ of the complaint ‘allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.’” *In re Lyondell Chem. Co.*, No. 16 Civ. 518 (DLC), 2016 U.S. Dist. LEXIS 98057, at *37-38 (S.D.N.Y. July 27, 2016) (Cote, J.) (quoting *Tongue v. Sanofi*, 816 F.3d 199, 209 (2d Cir. 2016) (citation omitted)).¹⁰ While the plausibility standard requires a plaintiff to show at the pleading stage that success on the merits is more than a “sheer possibility,” it is not a “probability requirement.” See *Anderson News, LLC v. Am. Media, Inc.*, 680 F.3d 162 185 (2d Cir 2012) (“a court . . . may not properly dismiss a complaint that states a plausible version of the events merely because the court finds a different version more plausible”).

In the plausibility analysis, a court must construe the complaint in the light most

¹⁰ Although Plaintiffs’ claims are not brought under the Copyright Act, there is no heightened requirement for copyright claims. “Thus, copyright infringement must be pleaded in accordance with Rule 8, rather than the heightened pleading standard of Rule 9.” *Blagman v. Apple Inc.*, No. 12 Civ. 5453 (ALC) (JCF), 2013 U.S. Dist. LEXIS 71280, at *7-8 (S.D.N.Y. May 20, 2013) (Carter, J.) (citing *Salerno v. City Univ. of New York*, 191 F. Supp. 2d 352, 356 (S.D.N.Y. 2001)). See also *Levine v. Landy*, 860 F. Supp. 2d 184, 191 (N.D.N.Y. 2012) (citing *Arista*, 604 F.3d at 119-21) (same); *Maverick Rec. Co. v. Goldshteyn*, No. 05 Civ. 4523 (DGT), 2006 U.S. Dist. LEXIS 52422, at *11-12 (E.D.N.Y. July 31, 2006) (quoting *Salerno*, 191 F. Supp. 2d at 356) (same).

favorable to the plaintiffs, must accept all factual allegations as true, and must draw all reasonable inferences in favor of the plaintiffs. *Tellabs, Inc. v. Makor Issues & Rights, Ltd.*, 551 U.S. 308, 321 (2007). The Court cannot resolve a factual dispute in ruling on a motion under Rule 12(b)(6). *Sharette*, 127 F. Supp. 3d at 84 (denying 12(b)(6) motion that “merely raised a factual dispute inappropriate for resolution at the pleading stage, before the development of a fuller factual record of discovery, including the opinion of other experts whose testimony may shed better light on these complex economic and industry practice issues”); *In re Bear Stearns Cos., Inc. Sec., Derivative, & ERISA Litig.*, 763 F. Supp. 2d 423, 496 (S.D.N.Y. 2011) (Sweet, J.) (quoting *Joffe v. Lehman Bros., Inc.*, No. 04 Civ. 3507 (RWS), 2005 U.S. Dist. LEXIS 12313, *18 (S.D.N.Y. June 23, 2005) (“factual disputes are ‘inappropriate for disposition on a motion to dismiss’”).

In addition, when a claim sounds in fraud, the complaint must also satisfy the heightened pleading standards of Federal Rule of Civil Procedure 9(b). *Lyondell*, 2016 U.S. Dist. LEXIS 98057, at *37. “Under Rule 9(b), ‘though mental states may be pleaded generally, Plaintiffs must nonetheless allege facts that give rise to a strong inference of fraudulent intent.’” *Id.* (quoting *Loreley Fin. (Jersey) No. 3 Ltd. v. Wells Fargo Sec., LLC*, 797 F.3d 160, 171 (2d Cir. 2015) (citation omitted)). A strong inference of fraud may be established “by alleging facts showing *either* (1) a ‘motive and opportunity to commit the fraud’; *or* (2) ‘strong circumstantial evidence of conscious misbehavior or recklessness.’” *Id.* at *37-38 (quoting *Employees’ Ret. Sys. v. Blanford*, 794 F.3d 297, 306 (2d Cir. 2015)) (emphasis added).

The highly detailed Complaint easily satisfies those pleadings standards.

B. Plaintiffs Plausibly Allege that the Song’s Melody and Familiar Lyrics Were Preexisting Works

As a fundamental principle of copyright law, only those parts of a work that are original

to an author are eligible for copyright protection. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). As the Supreme Court held, “[t]he *sine qua non* of copyright is *originality*.” *Id.* (emphasis added). *See also Rogers v Koons*, 960 F.2d 301, 307 (2d Cir. 1992) (“cornerstone of [Copyright Act] is that the *work protected must be original*”) (citing *Feist*, 499 U.S. at 344) (emphasis added). A “copyright affords protection only for original works of authorship and, consequently, copyrights in derivative works secure protection only from the incremental additions of originality contributed by the authors of the derivative works.” *Pannonia Farms, Inc. v. USA Cable*, No. 03 Civ. 7841 (NRB), 2004 U.S. Dist. LEXIS 23015, at *26 (S.D.N.Y. June 7, 2004) (Buchwald, J.) (quoting *Silverman v. CBS, Inc.*, 870 F.2d 40, 49 (2d Cir. 1989)). In *Silverman*, the Second Circuit held that a derivative copyright “provide[s] protection only for the increments of expression beyond what is contained in [preexisting works], which are in the public domain.” 870 F.2d at 49-50.

Defendants argue that their 1960 and 1963 copyrights are valid and cover the Song’s familiar lyrics. They claim their original work consisted of three trivial changes to Verses 1 and 5 of the Song: (i) the word “will” was changed to “shall” in the phrase “we shall overcome”; (ii) the word “down” was changed to “deep” in the phrase “deep in my heart”; and (iii) the contraction “we’ll” was expanded to “we shall” in the phrase “we shall overcome some day.”¹¹ On that basis, Defendants ask the Court to “*find*, as a matter of law, that the *lyrics* in the first verse of the Song, which are [purportedly] different from any of the allegedly public domain predecessor versions referenced in the Complaint, contain sufficient originality” to be copyrightable as a derivative work. Defs. Br. at 13 (emphasis added).

Defendants do not even attempt to identify any supposed deficiency in the Complaint that

¹¹ Defendants ignore the important fact that, on their face, the copyrights do not even cover Verses 1 and 5 of the Song. *See* Section C below.

might require it to be dismissed; rather, they leap to the merits of the case and ask the Court to “*find*” in their favor on this highly fact-specific inquiry. Significantly, Defendants make no similar argument that the Court should *find* that the 1960 or 1963 copyrights cover the Song’s *melody*, or that the melody is original, conceding Plaintiffs’ well-pled allegation that the melody was copied from the African-American spiritual, is not covered by either the 1960 or 1963 copyright (or their renewals), and is in the public domain.

In the Complaint, Plaintiffs allege at least *four identical preexisting works*, thus precluding a finding that the Song’s melody or familiar lyrics were original to Defendant Ludlow or the authors identified in the 1960 and 1963 copyrights. *First*, Plaintiffs allege the preexisting African-American spiritual, with identical melody and virtually identical lyrics. Comp. ¶¶ 5 and 47-49. *Second*, in September 1948, PSI printed sheet music for “We Will Overcome,” including exactly the melody and well-known lyrics from the African-American spiritual as well as two additional verses. Comp. ¶ 55. The Ferrara Report, which Defendants commissioned, found that the “music and lyrics” of “We Will Overcome” published in *People’s Songs* in 1948 and in the Song registered by Ludlow in 1960 were “*virtually the same.*” Comp. ¶ 101 (emphasis added).

Third, in 1959, Cherry Lane published sheet music for *Music for 1st 5 Books of Moses*, Comp. ¶¶ 63-65, which included sheet music comprised of the *identical* melody of the African-American spiritual and the *identical* familiar lyrics of *We Shall Overcome*, including both “shall” and “deep” in the lyrics. *See* Reger Aff., Ex. H at 3. And *fourth*, in June 1960, Seeger and Silber published Vol. 10, No. 2 of *Sing Out!*, which included the *exact same* familiar lyrics as *We Shall Overcome*, again including both “shall” and “deep” in the lyrics. Comp. ¶¶ 59 & 66; Reger Aff., Ex. K at 4.

While Defendants attempt to distinguish the Song from PSI’s 1948 publication of “We

Will Overcome” in their motion to dismiss – an argument that directly conflicts with the Ferrara Report’s finding that the two songs were “virtually the same,”¹² Defendants ignore altogether the *identical* lyrics in the 1959 publication and in the June 1960 publication. Those two identical preexisting works preclude Defendants’ copyright claim.

Sanga Music, Inc. v. EMI Blackwood Music, Inc., 55 F.3d 756 (2d Cir. 1995), involved facts nearly identical to the facts here. In *Sanga Music*, a songwriter named Doris Plenn (“Plenn”) learned a traditional two-verse folk hymn, called “How Can I Keep From Singing,” from her grandmother. *Id.* at 757. She added a third verse of her own in the early 1950s. *Id.* In 1956, Plenn taught the song to Seeger, who published the song, including the third verse, in *Sing Out!* *Id.* The only copyright notice was for “Volume 7, Number 1” of the magazine itself. *Id.* In an introductory note, Seeger said he learned the song from Plenn, who learned it from her grandmother, and “suggested that it was probably over 100 years old.” *Id.* In 1964, Seeger published the song again, with Plenn’s added verse, without any copyright notice protecting her work. On those facts, which are eerily similar to the facts here – both cases even involved Seeger and *Sing Out!* – the Second Circuit held that Seeger’s 1956 and 1964 publications “in a manner that did not comply with the statutory [notice] requirement, placed Plenn’s third verse in the public domain.” *Id.* at 761.

In light of those three preexisting identical works – PSI’s 1948 publication of “We Will Overcome” with “*virtually the same*” music and lyrics as *We Shall Overcome*, Cherry Lane’s 1959 publication of *Music for 1st 5 Books of Moses* with the *identical melody and lyrics*, and Seeger’s and Silber’s June 1960 publication of the *identical lyrics* of *We Shall Overcome*, the Court cannot “*find*” that the lyrics in Verses 1 and 5 of the Song were different from any of the

¹² Defendants do not address the Ferrara Report or its findings in the lengthy motion to dismiss. They do not mention it anywhere in the brief.

three preexisting versions of the Song referenced in the Complaint. To the contrary, because Defendants cannot possibly carry their burden to prove that their works were original, the Court should deny Defendants' motion to dismiss outright.

C. Defendants Will Not Be Able to Prove that the 1960 and 1963 Copyrights Cover Verses 1 and 5 of the Song

Defendants' motion to dismiss also overlooks Plaintiffs' challenge regarding the limited scope of Defendant Ludlow's 1960 and 1963 copyrights. In *Rogers, supra*, the Second Circuit held: "that a whole work is copyrighted does not mean that every element of it is copyrighted; copyright protection extends *only to those components of the work that are original to the creator*. 960 F.2d at 307 (emphasis added) (citing *Feist*, 499 U.S. at 348). Thus, the mere fact that Defendants own two copyrights for *We Shall Overcome* does not mean they own a copyright to every component of the Song. To the contrary, they own at most only copyrights to works that are original to the authors identified in the copyrights.

Plaintiffs allege in detail that the two copyrights – and their renewals in 1988 and 1991 – covered *at most* only the new work claimed by Defendant Ludlow in the two applications: musical arrangements and new verses of the Song – specifically, Verses 2, 3, and 4 purportedly added in 1960 and Verses 6, 7, and 8 purportedly added in 1963¹³ – *not* the Song's melody or its familiar lyrics (repeated in Verses 1 and 5 of both versions). Defendants have no answer for Plaintiffs' well-pled allegations, and they have not identified any deficiency in the Complaint regarding the limited scope of the two copyright applications. They merely ignore this dispute.¹⁴

¹³ Plaintiffs do not concede that Defendants or the four individuals identified in the applications for the 1960 and 1963 copyrights were the authors of the six additional verses covered by those copyrights. Although not alleged in the Complaint, evidence recently uncovered by Plaintiffs during their ongoing investigation of the facts strongly suggests that some of those "new" lyrics were written by others as early as 1952.

¹⁴ Defendants admit that a copyright can be limited to musical arrangements. *See* Defs. Br. at 17

Determining the scope of a copyright is often a difficult task. For example, in *Marya v. Warner/Chappell Music, Inc.*, 131 F. Supp. 3d 975, 986 (C.D. Cal. 2015), on a massive summary judgment record including a 160-page detailed factual statement and more than 125 documents, the Central District of California found it “unclear whether [the *Happy Birthday*] lyrics were being registered, and therefore it is unclear whether the Copyright Office determined the validity of [the defendants’] alleged interest in the lyrics in 1935.” The Court refused to adopt a presumption that the copyright covered that song’s familiar lyrics even though the copyright application referred to “text” because there was no clear indication in the copyright record whether the author of the derivative work, Preston Ware Orem, had written those lyrics. *Id.* After parsing the immense record, the Court found that the defendants never acquired any interest in the *Happy Birthday* lyrics and granted summary judgment for the plaintiffs. *Id.* at 1002-03.

In this case, determining the scope of Defendant Ludlow’s 1960 and 1963 copyrights will be no less difficult and will likely require expert testimony; surely, it is not appropriate for adjudication on a motion to dismiss. Based on the detailed factual allegations in the Complaint, as well as the documents Defendants have placed in the record, there is considerable doubt that Reg. Nos. EU645288 and EP179877 or their renewals cover the Song’s familiar lyrics at all.¹⁵ It certainly is not possible for the Court to resolve the crucial dispute over the scope of the 1960 and 1963 copyrights in Defendant’s favor on this motion to dismiss.

Defendant Ludlow’s applications for the 1960 and 1963 copyrights do *not* support Defendants’ claim to own a copyright covering the Song’s familiar lyrics; to the contrary, on

(citing *Plymouth Music Co. v. Magnus Organ Co.*, 456 F. Supp. 676, 679 (S.D.N.Y. 1978) (Pierce, J.) (finding copyright in musical arrangement and translation of traditional public domain songs), and *Wihitol v. Wells*, 231 F.2d 550, 552-54 (7th Cir. 1956) (finding copyright in musical arrangement of public domain folk song)).

¹⁵ At least in their motion to dismiss, Defendants do not dispute, and thus implicitly concede, that the two copyrights do not cover the Song’s melody.

their face they support Plaintiffs' claim that the narrow copyrights cover musical arrangements and perhaps other lyrics, but not the familiar lyrics in Verses 1 and 5. In defining the scope of the new work added in 1960, Defendant Ludlow specifically identified "**Verses 2, 3, 4 of lead sheet attached all original.**" Comp. ¶ 71 and Reger Aff., Ex. F (emphasis added). The Song's familiar lyrics were set forth in Verses 1 and 5, **not** in Verses 2, 3, or 4. *Id.* Similarly, three years later, Defendant Ludlow specifically identified the new matter added in 1963 as "completely new words in **verses 6, 7, and 8.**" Comp. ¶ 18 and Reger Aff., Ex. G at 1 (emphasis added). The Song's familiar lyrics were again set forth in Verses 1 and 5, **not** in Verses 6, 7, or 8. *Id.* Plainly, the two copyrights do **not** cover Verses 1 and 5. Defendants would have the Court ignore Defendant Ludlow's specific claims to find that they own a copyright to the Song's familiar lyrics.

The applications and registration certificates for Reg. Nos. EU645288 and EP179877 do not allow the Court to resolve this difficult question in Defendants' favor at the pleading stage. To the contrary, by specifically identifying "**Verses 2, 3, and 4**" as new matter in the 1960 application and "**verses 6, 7, and 8**" as new matter in the 1963 application, Defendant Ludlow's applications provide compelling support for Plaintiffs' claim that the authors of those two works did **not** write the Song's familiar lyrics – including the words "shall" and "deep" – repeated in Verses 1 and 5 both times.¹⁶ It is axiomatic that a copyright covers only original work

¹⁶ Indeed, in 1993, Seeger denied that the three authors named in the 1960 copyright were responsible for the change:

No one is certain who changed "will" to "shall." It could have been me with my Harvard education. But Septima Clarke, a Charleston schoolteacher (who was director of education at Highlander and after the Civil Rights Movement was elected year after year to the Charleston, S.C. Board of Education) always preferred "shall."

Comp. ¶ 103. Neither Seeger nor Ms. Clarke was named as an author in the 1960 copyright. *See* Comp. ¶ 70; Reger Aff., Ex. F at 2.

contributed by the author. 17 U.S.C. § 102(a) (copyright protects “*original works of authorship*”) (emphasis added). Thus, derivative work copyrights “secure protection only for the incremental additions of originality contributed by the authors of the derivative works.” *Silverman*, 870 F.2d at 49; *see also* 17 U.S.C. § 103 (“copyright in a compilation or derivative work extends *only to the material contributed by the author of such work*, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material”) (emphasis added).¹⁷

In light of Plaintiffs’ well-pled factual allegations regarding the expressly limited claims in the 1960 and 1963 copyrights, both of which *exclude* Verses 1 and 5, as well as Plaintiffs’ allegation of Seeger’s own admission in 1993, the Court cannot “*find*” at this preliminary stage that the authors of those derivative works wrote any of the Song’s familiar lyrics – including “shall” and “deep.”

Defendant Ludlow failed to identify the original African-American spiritual, “We Will Overcome” published in 1948, “We Shall Overcome” published in 1959, or “We Shall Overcome” published in June 1960 in either copyright application.¹⁸ The failure to do so eliminates any presumption that the copyrights are valid. In *Gibson Tex, Inc. v. Sears Roebuck & Co.*, 11 F. Supp. 2d 439, 442 (S.D.N.Y. 1988), this Court held that “the failure to alert the Copyright Office to relationships between the work for which registration is sought and prior works of others endangers the presumption of validity.” *See also Russ Berrie & Co., Inc. v. Jerry Elsner Co., Inc.*, 482 F. Supp. 980, 988 (S.D.N.Y. 1980) (when registrant fails to identify prior

¹⁷ Defendants concede that a derivative work copyright protects only the work added by the author of the derivative work. *See* Defs. Br. at 31 (citing *Silverman*).

¹⁸ By sharp contrast, in its 1959 copyright application, Cherry Lane described De Cormier’s work as “AN ARRANGEMENT AND ADAPTATION OF VARIOUS NEGRO SPIRITUALS.” *Cf. Reger Aff.*, Ex. I at 2.

work in the public domain, Copyright Office is denied opportunity to pass on originality).

Plaintiffs do not believe the Court should find that Cherry Lane, De Cormier, or SOI own a copyright to the Song’s familiar lyrics, any more than it should find that Defendants do, particularly at the pleading stage before any discovery has been taken and before any evidence has been presented. Plaintiffs merely point to these *preexisting identical works* to dispute Defendants’ claim to own the copyright. It is more plausible that either De Cormier or the unnamed author of the June 1960 publication, as authors of the preexisting identical works, were responsible for the “changed” lyrics, rather than Defendants or the four authors named in the 1960 and 1963 copyrights. There is no reason why the Court should interpret Cherry Lane’s 1959 copyright and De Cormier’s 1987 renewal or SOI’s June 1960 copyright exceedingly narrowly, so as to exclude a claim to the lyrics, and Defendant Ludlow’s 1960 and 1963 copyrights and 1988 and 1991 renewals exceedingly broadly, so as to include a claim to the lyrics – which is what Defendants urge the Court to do. Certainly, the Court should not do so to “*find*” on this motion to dismiss that Defendants own a copyright to lyrics that were copyrighted by others at least twice before Defendant Ludlow copyrighted other elements of the Song.

D. Defendants Will Not Be Able to Prove That the Words “Shall” and “Deep” Are Copyrightable

Defendants’ main argument – that the words “shall” and “deep” in Verses 1 and 5 are “original” works – is premised on a fundamentally flawed legal premise that the words are eligible for copyright protection. Even if Defendant Ludlow had claimed a copyright to Verses 1 and 5 and if Defendants or one of the four individuals named as authors in the 1960 and 1963 applications were responsible for writing the words “shall” and “deep” in those verses – which Plaintiffs vigorously dispute – under binding Second Circuit precedent and this Court’s prior decision, Defendants will not be able to meet their burden to prove those words – at most, trivial

changes from the 1948 version of the Song – are copyrightable. *See Marya, supra*, 131 F. Supp. 3d at 983-84 (citing *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S.Ct. 843, 849 (2014)) (burden is on defendant-copyright claimants to prove scope of their copyright in a challenge to copyright claim under Declaratory Judgment Act). For this additional reason, Defendants’ main argument will fail as a matter of law.

As a fundamental principle of copyright law, only those parts of a work that are original to an author are eligible for copyright protection. *Feist*, 499 U.S. at 345. For example, in *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 143 (2d Cir. 1998), the Second Circuit held that the phrase “[y]ou’ve got to stand for something, or you’ll fall for anything,” lacked originality and was therefore not protected” under the Copyright Act. In *Edwards v Raymond*, this Court held that the phrase “caught up” was not copyrightable because “it is used in everyday speech in a variety of contexts.” 22 F. Supp. 3d 293, 298-99 (S.D.N.Y. 2014) (Cote, J.) (citing *Acuff-Rose*, 155 F.3d at 143). The Court likewise held that “‘I can’t believe it’ is a commonplace phrase ineligible for copyright protection.” *Id.* at 299. In a prior related action over the same song, *Pyatt v Raymond*, No. 10 Civ. 8764 (CM), 2011 U.S. Dist. LEXIS 55754, at *23 (S.D.N.Y. May 19, 2011) (McMahon, J.), the Court held that the phrase “caught up” was “not infused with the minimal creativity necessary to warrant copyright protection.” And in *Bell v Blaze Mag.*, cited by Defendants (*see* Defs. Br. at 11), the Court held that words and phrases “are insufficient to warrant copyright protection, as they do not exhibit the minimal creativity required for such protection.” No. 99 Civ. 12342 (RCC), 2001 U.S. Dist. LEXIS 2783, at *6 (S.D.N.Y. Mar. 15, 2001) (Casey, J.) (citing *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir 1992)).

In the context of a derivative work, for which Defendants have claimed their copyrights, the new work “must contain ‘some substantial’ and ‘not merely a trivial’ variation. . . . Thus,

only non-trivial, original features contributed by the author or creator of a derivative work are entitled to copyright protection. *Weissmann v Freeman*, 684 F.Supp. 1248, 1260 (S.D.N.Y. 1988) (citing *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir.) (en banc), *cert. denied*, 429 U.S. 857 (1976)). “The law requires *more than a modicum of originality*. This has been interpreted to require a distinguishable variation that is *more than merely trivial*.” *Waldman Publ’g Corp. v. Landall, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994).

In *Batlin*, the Second Circuit held that protection for a derivative work requires a “distinguishable variation” from the preexisting work and a “minimal element of creativity over and above the requirement of independent effort.” 536 F.2d 490. *See also Matthew Bender & Co., Inc. v. West Publ’g Co.*, 158 F.3d 674, 680 (2d Cir. 1998) (“the new contributions must, ‘when analyzed as a whole . . . display sufficient originality so as to amount to an ‘original work of authorship’”) (quoting 17 U.S.C. § 101). As the Second Circuit explained in *Batlin*:

Absent a *genuine difference* between the underlying work of art and the copy of it for which protection is sought, the public interest in promoting progress in the arts – indeed, the constitutional demand, *Chamberlin v. Uris Sales Corp.*, – could hardly be served. To extend copyrightability to *minuscule variations* would simply put a *weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work*.

536 F.2d at 491 (emphasis added).

Here, Defendants claim to rely entirely upon just two trivial differences between the work they copyrighted and the original African-American spiritual from which it was copied: changing the “will” to “shall” in the first line of Verse 1 and changing “down” to “deep” in the next to last line of Verse 1. They concede Plaintiffs’ allegation that every other element of the Song – its melody, its rhythm, and the rest of the familiar lyrics in Verse 1 – is copied exactly from the original African-American spiritual. And, of course, as Plaintiffs allege and as Defendants’ own

evidence proves, the *exact* words “shall” and “deep” are copied from De Cormier’s 1959 work and from Seeger’s and Silber’s June 1960 work. When the Song is analyzed as a whole, those two trivial changes do not amount to new, copyrightable, original work.

That the words “shall” and “deep” were trivial and uncopyrightable changes is easily demonstrated. As Plaintiffs allege in the Complaint, in April-May 1961, SOI published Vol. 11, No. 2 of *Sing Out!*, which included sheet music for the entire musical composition of *We Shall Overcome*. Comp. ¶ 80. The Song was published with the title “We *Shall* Overcome,” but the lyrics were “We *will* overcome, We *will* overcome . . .” – unchanged from how the Song was published in *People’s Songs* in 1948. *Id.* (emphasis added). Other verses of the Song added at the bottom of the sheet music also used the words “shall” and “will” interchangeably. Comp. ¶ 81. Although the verse “We will overcome” was unchanged in the 1961 publication, the Song included the verse “Oh *deep* in my heart.” *Id.* (emphasis added). No copyright notice was provided for “We Shall Overcome” in Vol. 11, No. 2 of *Sing Out!*. *Id.*

This is precisely the kind of misuse of the Copyright Act that concerned the Second Circuit in *Batlin*. Defendants have sought to use two “miniscule variations” – the words “shall” and “deep” (which are not copyrightable themselves) – to “We Will Overcome,” a work long in the public domain in order to claim a new copyright. That is precisely the kind of “*weapon for harassment*” the Second Circuit sought to prevent in *Batlin* when it emphasized the need for a “*genuine difference*” from a prior work before a derivative work could be copyrightable. 536 F.2d at 491 (emphasis added).¹⁹

¹⁹ Defendants cite *Gaste v. Kaiserman*, 863 F.2d 1061, 1066 (2d Cir. 1988), to support their argument that the copyright certificate entitles them to a presumption of originality because “authorship presumptively connotes originality, and authorship of the work is among the facts stated in the copyright certificate.” Defs. Br. at 18. Defendants are wrong for a number of reasons. *First*, that decision has been questioned and narrowly interpreted. For example, in

The two commonplace words “shall” and “deep” –the extent of the purported original work Defendants have identified – are used in everyday speech in a variety of contexts. They are no more eligible for copyright protection than “you’ve got to stand for something, or you’ll fall for anything,” “caught up,” or “I can’t believe it.” *Cf. Acuff-Rose*, 155 F.3d at 143; *Edwards*, 22 F. Supp. 3d at 298-99; *Pyatt*, 2011 U.S. Dist. LEXIS 55754 at *23. The words “shall” and “deep” are even *less* original, and therefore *less* eligible for protection, than any of those phrases. Defendants cannot be allowed to use those two commonplace words as *weapons for harassment*.

To assess the copyrightability of a derivative work, the Court must consider the extent of the new, original work. *See Durham*, 630 F.2d. at 913. Numerous differences between two works will tend to undermine substantial similarity and weigh in favor of finding that the later derivative work is independently copyrightable. As the Second Circuit held in *Durham*, “The more numerous the differences between the two works, the less likely it is that they will create the same aesthetic impact so that one will appear to have been appropriated from another.” *Id.* The two minuscule variations that Defendants rely upon – from “shall” and “deep” – simply do not meet the Second Circuit’s test for copyrightability.²⁰

Seeking to avoid the conclusion required by *Acuff-Rose* and *Edwards*, Defendants cite *Santrayll v. Burrell*, No. 91 Civ. 3166 (PKL), 1996 U.S. Dist. LEXIS 3538 (S.D.N.Y. Mar. 25, 1996) (Leisure, J.), to support their argument that “shall” and “deep” are copyrightable.

Tempo Music v. Famous Music Corp., the Court suggested that *Gaste* did not “effectively promote the policies underling copyright protection. 838 F.Supp. 162, 172 (S.D.N.Y. 1993) (Sand, J.) (quoting *Batlin*, 536 F.2d at 492). *Second*, the presumption described in *Gaste* is limited. A “certificate of registration creates no irrebuttable presumption of copyright validity. Where other evidence in the record casts doubt on the question, validity will not be assumed.” *Durham*, 630 F.2d at 908.

²⁰ In *MCA, Inc. v. Wilson*, 677 F2d 180, 185 (2d Cir. 1981), the Second Circuit held that “a composer cannot plagiarize a competitor’s copyrighted song, substitute dirty lyrics of his own, perform it for commercial gain, and then escape liability” for copyright infringement. The changes in *MCA* were, arguably, more substantial than the two so-called changes here.

Defendants misstate the narrow holding in *Santrayll*, which actually undermines their originality argument. In that case, the Court held that “the repetition [four times] of the *non-protectible* [sic] word ‘uh-oh’ *in a distinctive rhythm* comprises a sufficiently original composition to render it protectible [sic] by the copyright laws.” *Id.* at *4 (emphasis added). The original, copyrightable work consisted of the *combination* of an otherwise unprotectable word, “uh-oh,” repeated four times to an original, distinctive rhythm. The syncopated rhythm and repetition of “uh-oh” *together* were an original work covered by the copyright. The Court held that the *combination* was protectable, but that the word “uh-oh” itself was not protectable. *Id.* Because Defendants admit that the Song’s melody was not their original work – conceding it was in the public domain long before Defendant Ludlow registered the 1960 and 1963 copyrights – the *only* “original” work they claim is the commonplace words “shall” and “deep.” Those two words, like “uh-oh,” lack sufficient originality to be protectable themselves.²¹

²¹ Defendants also cite *Pryor v. Warner/Chappell Music, Inc.*, No. 13 Civ. 4344 RSWL (AJWx), 2014 U.S. Dist. LEXIS 22132 (C.D. Cal. June 20, 2014), as support for their argument that “shall” and “deep” are copyrightable. In that case, the district court held that the repetition of the phrase “get down,” sung in David Pryor’s “signature voice” in a copyrighted sound recording was sufficiently original to warrant copyright protection. *Id.* at *16-17 (emphasis original). As in *Santrayll*, the copyrightable work was a combination of a commonplace two-word phrase *and* a unique singing voice. The sound recording at issue in *Pryor* was made in 1975, and thus was eligible for protection under the Copyright Act. Sound recordings made before 1972 were *not* eligible for federal copyright protection. See *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 62 F. Supp. 3d 325, 337-38 (S.D.N.Y. 2014) (McMahon, J.).

Defendants also cite *Italian Book Co. v. Rossi*, 27 F.2d 1014 (S.D.N.Y. 1928) (Thacher, J.), to support their argument that “different words and music” from any prior version of a song are copyrightable. Obviously, changing the words and music of a traditional folk song may be a copyrightable work. However, in *Italian Book*, the Court explained that copying a preexisting work with mere “colorable changes” does *not* constitute an original work. *Id.* The Court described that effort – which was, at most, what Defendants say they did here – “a clumsy effort to conceal their infringement” of the preexisting work. *Id.* Thus, *Italian Book* actually supports Plaintiffs’ argument that Defendants have no copyright in any original work they claim as their own. At most, by changing two words, Defendant Ludlow undertook a clumsy effort to conceal its own copying of the African-American spiritual and the preexisting 1948 work.

Finally, in *McDonald v. West*, 138 F. Supp. 3d 448 (S.D.N.Y. 2015) (Nathan, J.), the plaintiff

Since two commonplace words “shall” and “deep” are not eligible for copyright protection, Defendants’ 1960 and 1963 copyrights would not and could not cover them even if Defendant Ludlow had claimed a copyright to Verses 1 and 5 of the Song.

E. Plaintiffs Plausibly Allege that the Song Was Not Independently Created by the Authors Identified in the 1960 and 1963 Copyrights

As discussed at length in Section D above, for a work to be copyrightable as a derivative work, the author must have “contributed something more than a ‘merely trivial’ variation, something recognizably ‘his own.’” *Weissmann*, 868 F.2d at 1321. At a minimum, the copyright owner must show that “the work was *independently created by the author (as opposed to copied from other works)* and that it possesses at least some minimal degree of creativity.” *SimplexGrinnell LP v. Integrated Sys. & Power, Inc.*, 642 F. Supp. 2d 206, 211 (S.D.N.Y. 2009) (Lynch, J.) (quoting *Merkos L’Inyonei Chinuch, Inc. v. Otsar Sifrei Lubavitch, Inc.*, 312 F.3d 94, 97 (2d Cir. 2002) (per curiam) (emphasis added)). Under the well-pled factual allegations in the Complaint, Defendants will not be able to meet the burden to prove the work was created by the authors named in the copyright applications; it is certainly plausible that they will not do so.²²

Plaintiffs allege that the Song’s familiar lyrics, including the words “shall” and “deep,”

alleged that the defendants infringed his copyright for a song entitled “Made in America” with their own song of the same title. The two songs shared little other than the same title and some common themes. *See id.* at 456-60. Apart from a few uncopyrightable words, the lyrics were almost completely different. *Id.* at 457. At most, the Court found that the defendants copied “a selection and arrangement of public domain elements” from the plaintiff’s song. *Id.* at 459. Apart from some shared “commonplace” musical structures, the Court found that the two songs had no musical similarities. *Id.* at 457-58. As the Court concluded, “[l]istening to the two tracks side by side demonstrates beyond dispute how little they have in common.” *Id.* at 460. The facts in this case could not be more different from the facts in *McDonald*. Except for two words, the Song is exactly identical to the 1948 work published in *Sing Out!*. The Ferrara Report, commissioned by Defendants, found that the songs had “*virtually the same*” music and lyrics. The undoubtedly shared the exact same melody and had practically identical lyrics.

²² At trial, the burden of proof will be on Defendants, as would-be owners of the purported copyrights. *Marya v. Warner/Chappel*, 131 F. Supp. 3d at 983-84 (citing *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S.Ct. 843, 849 (2014)).

were not written by the four authors identified in the 1960 and 1963 copyrights. *See* Comp. ¶¶ 75, 90, 92-93. Indeed, Seeger, who once mused that he might have substituted the word “shall,” suggested that Septima Clarke (“Clarke”), a Charleston schoolteacher was responsible for the miniscule change. Comp. ¶ 103. In either event, neither Seeger nor Clarke were not identified as authors in the 1960 copyright, which included the word “shall” in Verses 1 and 5.

The work must come exclusively from the purported author. *SimplexGrinnell*, 642 F. Supp. 2d at 211. Plaintiffs allege that the melody and familiar lyrics for *We Shall Overcome* were copied from earlier public domain works and other preexisting copyrighted works rather than the independent work of the four individuals named as “authors” by Defendant Ludlow in the 1960 and 1963 copyright applications. In the copyright applications, Defendant Ludlow did *not* attribute authorship of either of those two words in Verses 1 and 5 of the Song to any of the four named individuals. *See* Reger Aff., Exs. F and G. At most, Defendant Ludlow identified them as authors of alternate lyrics in Verses 2 through 4 and 6 through 8 of the Song. And Defendants do not assert that any of the four individuals was the author of either “shall” or “deep” in their lengthy motion to dismiss.

In *Matthew Bender*, *supra*, 158 F.3d at 678, the Second Circuit held that the *author* must make non-trivial changes to a preexisting work for the derivative work to be copyrightable. Defendants have never identified the author(s) who made the changes from “will” to “shall” or from “down” to “deep.” Leaving apart that those two trivial changes could never qualify for copyright protection, Defendants have failed to satisfy the original authorship requirement for copyrightability as well.

Thus, Plaintiffs plausibly allege that Defendants and the four individuals named in the 1960 and 1963 copyright applications were not authors of the Song’s melody or familiar lyrics.

F. Plaintiffs Plausibly Allege that the 1960 and 1963 Copyrights Are Invalid Because They Were Procured Fraudulently

Apart from Plaintiffs' challenge regarding the limited scope of the 1960 and 1963 copyrights and the related dispute regarding whether Defendants or any of the four individuals named as authors in those copyrights actually wrote the Song's familiar lyrics, Plaintiffs also allege that the copyrights are invalid because Defendant Ludlow's applications were materially false and misleading. A material misstatement regarding authorship or the assignment of rights between the author and copyright claimant, when made with intent to defraud, makes a copyright invalid. *Shady Records, Inc. v. Source Enters.*, No. 03 Civ. 9944 (GEL), 2004 U.S. Dist. LEXIS 26143, at *37 (S.D.N.Y. Dec. 30, 2004) (Lynch, J.) (citing *Medforms, Inc. v. Healthcare Mgmt. Solutions, Inc.*, 290 F.3d 98, 109 (2d Cir. 2002); *Billy-Bob Teeth v. Novelty, Inc.*, 329 F.3d 586, 591 (7th Cir. 2003); *Sunham Home Fashions, LLC v. Pem-America, Inc.*, No. 02 Civ. 6284 (JFK), 2002 U.S. Dist. LEXIS 24185, at *14 (S.D.N.Y. Dec. 17, 2003) (Keenan, J.)). "[T]he failure to alert the Copyright Office of relationships between the work for which registration is sought and prior works of others specifically endangers the presumption of validity." *Santrayll v. Burrell*, 993 F. Supp. 173, 175 (S.D.N.Y. 1998) (Leisure, J.) (citing *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435, 1440 n.5 (S.D.N.Y. 1986) (Leisure, J.)). Defendants do not dispute these basic legal principles.

Defendant Ludlow registered *We Shall Overcome* on October 27, 1960, as an unpublished derivative work. Defendant Ludlow failed to identify the preexisting African-American spiritual as the prior work from which the Song was derived, even those two works shared "*virtually the same*" the music and lyrics. Comp. ¶ 101; Reger Aff., Ex. F at 2. Nor did Defendant Ludlow identify PSI's 1948 publication in *People's Songs*, Cherry Lane's publication in 1959, and SOI's publication in June 1960, as the prior work from which the Song was derived,

even those three works shared the *identical* melody and lyrics. Comp. ¶¶ __; Reger Aff., Exs. C, F at 2, H, and K. Because Defendant Ludlow identified the Song as a derivative work, it was required to identify the previously registered or published work from which it was derived and describe the differences from the prior work. *See* Reger Aff. Ex. F at 2, ¶¶ 5(a) and (b); *cf.* Reger Aff. Ex. I at 2 (Cherry Lane identifying “NEGRO SPIRITUAL” as prior work).

Despite these mandatory registration requirements, Defendant Ludlow failed to identify either of the works from which the Song actually was derived. Instead, Defendant Ludlow identified “I’ll Overcome” as the prior copyrighted work from which the Song was purportedly derived. Comp. ¶ 69. Ludlow’s application for the 1960 copyright was materially false. In particular, the Song was *not* unpublished: according to Defendants’ own expert, Ferrara, “virtually the same” melody and lyrics had been published in 1948 and the exact same melody and lyrics had been published in 1959 and June 1960. In addition, and no less significantly, there was no song called “I’ll Overcome” registered prior to October 27, 1960. Comp. ¶ 76. According to Defendants, the reference was to the song “I’ll Overcome Some Day,” a completely unrelated work. The claim that Defendant Ludlow owned a copyright to every element of *We Shall Overcome* that differed from the completely unrelated work “I’ll Overcome Some Day” – essentially every part of the song – merely compounded the fraud. Whether called “I’ll Overcome” or “I’ll Overcome Some Day,” the reference to that entirely unrelated song hid from the Copyright Office the material fact that *We Shall Overcome* was *identical or nearly identical* to at least four unnamed preexisting works.

The melody and lyrics repeated in Verses 1 and 5 of *We Shall Overcome* in the 1963 copyright, Reg. No. EP179877, are also the same melody and lyrics as “We Will Overcome” published in *People’s Songs* in 1948, the exact same melody and lyrics published in *Music for*

Ist 5 Books of Moses in 1959, the same lyrics published in *Sing Out!* in June 1960, and the same melody and nearly identical lyrics as the African-American spiritual from which they all originated. Comp. ¶ 93. Defendant Ludlow failed to identify any of those prior publications of the words and music in its 1963 application for Reg. No. EP179877. Comp. ¶ 94.

Defendant Ludlow's failure to properly identify the identical or nearly identical preexisting works on which *We Shall Overcome* actually was based, coupled with its misidentification of "I'LL OVERCOME" as the preexisting work for the Song in 1960, eliminates any presumption that either the 1960 or 1963 copyright is valid. *See Gibson, supra*, 11 F. Supp. 2d at 442 ("failure to alert the Copyright Office to relationships between the work for which registration is sought and prior works of others endangers the presumption of validity"); *Russ Berrie, supra*, 482 F. Supp. at 88 (failure to identify prior work in public domain deprives Copyright Office of opportunity to pass on question of originality).

There is no room to debate that Defendant Ludlow's repeated failure to identify four identical preexisting works in both copyright applications and its misidentification of a completely unrelated work in the 1960 application for Reg. No. EU645288 was deliberate. Surely, Defendant Ludlow did not honestly believe its Song was related in any way to "I'll Overcome," assuming it meant "I'll Overcome Some Day," because a side-by-side comparison of those two songs shows them to be completely dissimilar. They share no common musical elements, and their lyrics are almost entirely different. No one, including the Copyright Office, could or would confuse the two songs for one another. On the other hand, *We Shall Overcome* and "We Will Overcome" are "*virtually the same.*" Comp. ¶ 101. The Song registered by Defendant Ludlow in 1960 is *exactly the same* as the song registered by Cherry Lane in 1959, and the familiar lyrics are *exactly the same* as "We Shall Overcome" published by SOI in June

1960. Anyone, including the Copyright Office, would immediately recognize all these works as the same. It simply could not have happened by accident that Defendant Ludlow was confused to believe its work was based on “I’ll Overcome,” and it strains credibility beyond the breaking point to suggest that it was unaware of all four preexisting identical or nearly identical works. The same can be said for Defendant Ludlow’s 1963 application for Reg. No. EP179877. Plaintiffs more than plausibly allege that the misidentification of the prior work was *no accident*.

Nor is there any question that Defendant Ludlow’s failure to identify the four identical preexisting works and its misidentification of a completely unrelated work was material. As discussed above, if the Copyright Office compared the Song to “I’ll Overcome,” assuming it understood Ludlow’s reference to mean “I’ll Overcome Some Day,” it would have concluded that nearly all of the work submitted by Defendant Ludlow was original because the two share no common musical elements, and their lyrics are almost entirely different. Had Defendant Ludlow instead properly identified any of the prior works from which it was actually derived, the Copyright Office would have concluded, as Defendants’ own expert concluded in the Ferrara Report, that *We Shall Overcome* and the preexisting public domain work “We Will Overcome” are *virtually the same*,” and it would have determined that the Song is *exactly the same* as the preexisting works previously registered by Cherry Lane and SOI. Unquestionably, this information was vitally important to the Copyright Office when making its originality determinations. *See Gibson*, 11 F. Supp. 2d at 442; *Russ Berrie*, 482 F. Supp. at 88.

The Second Circuit has held that “the knowing failure to advise the Copyright Office of facts which *might have occasioned a rejection* of the application constitute[s] reason for holding the registration invalid and thus incapable of supporting an infringement action . . . or denying enforcement on the ground of unclean hands.” *Eckes v. Card Prices Update*, 736 F.2d 859, 861-

62 (2d Cir. 1984) (quoting *Russ Berrie*, 482 F.Supp. at 988) (emphasis added);²³ *see also Santrayll, supra*, 993 F.Supp. at 176 (same). Certainly, on the basis of the well-pled facts alleged in the Complaint, the Copyright Office *might have* rejected Defendant Ludlow’s application had it known of the similarity – indeed, the identity – of the lyrics in the various works. In fact, on the basis of the facts alleged in the Complaint, it almost certain that the Copyright Office would have concluded that *We Shall Overcome* was *not* original.

Even the identification of the “authors” in Defendant Ludlow’s 1960 application for Reg. No. EU645288 was a misrepresentation. Seeger, who once mused that he might have substituted the word “shall,” was not identified as an author in the 1960 copyright application even though the word “shall” is included in Verses 1 and 5 of the work that Defendant Ludlow registered. Comp. ¶ 103; Reger Aff., Exs. B and F. Nor is Clarke, whom Seeger also suggested was responsible for the word “shall,” identified as an author in the 1960 copyright application. *Id.* When, as here, the failure to identify all co-authors of a work is “material to [the] disposition of the registration, the Copyright Office would invalidate, rather than permit amplification of

²³ Defendants’ cases are inapposite. In *Eckes*, an infringement action cited by Defendants, the defendant was unable to prove at trial that the copyright owner had failed to notify the Copyright Office of its prior works because the new work was “substantial[ly] change[d] from the 1976 and 1978 publications.” 736 F.2d at 861 (latter work was a much more comprehensive listing of baseball cards, including their values, and grouping the cards according to average selling prices). Here, Plaintiffs will be able to prove that the preexisting works were *identical or substantially identical* to the Song.

In *Fonar Corp. v. Domenick*, 105 F.3d 99, 105 (2d Cir. 1997), a summary judgment decision in another infringement case cited by Defendants, the defendant had not even alleged that the plaintiff defrauded or made any deliberate misrepresentation to the Copyright Office.

In *Lennon v. Seaman*, 84 F. Supp. 2d 522, 524 (S.D.N.Y. 2000) (Sand, J.), Yoko Ono claimed to own copyrights to six photographs of John Lennon. Among other claims, she alleged that the defendant fraudulently applied for a copyright for one of the photographs without identifying her preexisting work. *Id.* at 525. The Court dismissed the fraud claim on ripeness grounds because the Copyright Office had not yet ruled on the defendant’s application. *Id.* at 526. That case has no relevance here.

registrations suffering such omissions.” *Shady Records*, 2004 U.S. Dist. LEXIS 26143, at *36. Since Seeger denied originality in one of the two words on which Defendants base their copyright claim, the failure to identify him or Clarke in the 1960 application, and the failure to identify Clarke in the 1963 application, was material to disposition of the application, and therefore invalidates both copyrights.

For all these reasons, Plaintiffs plausibly allege that the 1960 and 1963 copyrights were procured by fraud. The result of that determination will be to invalidate the entire copyrights, not just to restrict them to their narrow claims. *Eckes*, 736 F.2d at 861-62 (“knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application constitute[s] reason for holding the registration invalid”); *Santrayll*, 993 F.Supp. at 176 (same).

G. Defendants Dedicated the Song to the Public by Permitting Subsequent Publications Without a Statutory Copyright Notice

Under the 1909 Copyright Act, which the parties agree is controlling, a “work had to bear a valid copyright notice upon publication in order to secure copyright protection.” *Innovative Networks v Satellite Airlines Ticketing Ctrs.*, 871 F.Supp. 709, 720 (S.D.N.Y. 1995) (Kram, J.) (citing Nimmer, *Nimmer on Copyright* § 7.02[C][1] (1994)). The 1909 Copyright Act, as amended in 1954, required either the word “Copyright,” the abbreviation “Copr.,” or the symbol “©,” together with the name of the name of the copyright owner and the year of first publication. *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 403 (2d Cir 1971). A work published without the required statutory notice lost copyright protection. *Silverman*, 632 F.Supp. at 1353 (“publication without copyright notice resulted in loss of copyright protection”) (citing 1 *Nimmer on Copyright* § 4.01[B] at 4-5); *Wildman v. N.Y. Times Co.*, 42 F.Supp. 412, 415 (S.D.N.Y. 1941) (Conger, J.) (“publication without such notice amounts to a dedication to the public sufficient to defeat all subsequent efforts at copyright protection”).

Here, assuming Defendant Ludlow had a valid copyright covering the Song's melody and familiar lyrics under the 1960 and 1963 copyrights, Plaintiffs plausibly allege that the copyright was lost, and the Song was dedicated to the public, as a result of multiple subsequent publications with Defendant Ludlow's consent but without the statutory copyright notice. Those divesting publications included:

- *The Folk Music of the Newport Folk Festival 1959-60*, Vol 2. divested Verses 1, 2, and 3 (Comp. ¶ 85);
- *Call of Freedom* divested Verses 1, 2, and 3 (Comp. ¶ 86);
- *Sing Out! Hootenanny with Pete Seeger and the Hooteneers* divested Verses 1, and 6 (Comp. ¶ 95);
- *We Shall Overcome; Songs of the "Freedom Riders" and the "Sit-Ins"* divested Verses 1, 2, 3, and 7 (Comp. ¶ 96); and
- *Broadsides Songs and Ballads Sung by Pete Seeger* divested Verses 1 and 5 (Comp. ¶ 97)

Thus, Plaintiffs allege that any copyright to Verses 1 and 5, 2, 3, 6, and 7 have been lost, and those verses, along with the Song's melody (if there ever were a copyright in the words or music) were dedicated to the public.²⁴

Plaintiffs' allegations regarding *Broadsides Songs and Ballads Sung by Pete Seeger* are particularly instructive. In 1964, Folkways Records released a phonograph record with that title, which included a recording of nine songs, including *We Shall Overcome* (performing Verses 1 and 5). Comp.¶ 97. *Broadside Songs* was sold with authorized liner notes, which set out the familiar lyrics of Verses 1 and 5 in full, including the words "shall" and "deep," exactly as included the work purportedly covered under Reg. Nos. EU645288 and EP179877. *Id.* The liner notes for *Broadside Songs* included a copyright notice for the larger collective work and copyright notices identifying the authors or copyright owners for the eight other songs, but

²⁴ Plaintiffs have not alleged any divesting publication with respect to Verses 4 and 8.

lacked any copyright notice for the melody or familiar lyrics of *We Shall Overcome*. *Id.*; Reger Aff., Ex. Q. The fact that the liner notes provided no copyright notice for *We Shall Overcome*, even though a notice was provided for all eight other individual works on the phonograph record, is indicative of the fact that there was no copyright for the familiar lyrics in Verses 1 and 5 of *We Shall Overcome*. In any event, the authorized publication of the familiar lyrics in the liner notes for *Broadside Songs* lost any copyright protection the lyrics might have had and dedicated them to the public. *Silverman*, 632 F.Supp. at 1353; *Wildman*, 42 F.Supp. at 415.

Citing no case law or other authority, Defendants argue that the subsequent publications of *We Shall Overcome* did not divest the copyrights or dedicate the Song to the public because all the publications were protected by a blanket copyright notice for the larger collective works which purportedly covered each individual work in the collection. That is not the applicable law. Prior to 1976, a copyright notice for a collective work did *not* protect previously registered works included in the collection; a separate copyright notice had to be provided for each previously registered work. Prior to 1976, authors of individual contributions to a collective work lost their copyrights in their individual works absent a copyright notice for the particular work in the author's name. *Greenberg v. Nat'l Geographic Soc'y*, 533 F.3d 1244, 1248 (11th Cir. 2008); *See also Morris v Bus. Concept Inc.*, No. 99 Civ. 59 (RCC), 2000 U.S. Dist. LEXIS 3835, at *9 (S.D.N.Y. Mar. 24, 2000) (Casey, J.) (under 1909 Copyright Act, registration of collective work protected only the collective work being registered, *not* "the individual and independent works" within the collective work). That is why *Broadside Songs* included a copyright notice for the larger work and separate copyright notices for eight of the songs, but not for *We Shall Overcome*. *See Reger Aff.*, Ex. Q.

Defendants also deny that subsequent publications of the Song were authorized by the

authors.²⁵ Defs. Br. at 24-25. Plaintiffs plausibly allege that Defendant Ludlow or the authors²⁶ consented to the divesting publications. For example, Plaintiffs allege that Ludlow “frequently collaborated with Folkways Records . . . whereby Defendant Ludlow would register or publish sheet music for musical compositions and Folkway Records would produce sound recordings of artists performing the musical compositions.” Comp. ¶ 84. That collaboration led to at least five divesting publications: (i) *The Folk Music of the Newport Folk Festival* in 1961; (ii) *Call of Freedom* in 1962; (iii) *Sing Out! Hootenanny* in 1963; (iv) *We Shall Overcome; Songs of the “Freedom Riders”* in 1964; and (v) *Broadsides Songs and Ballads* in 1965. Comp. ¶¶ 85-86 & 95-97. Defendants’ factual denial of consent cannot be resolved by a motion to dismiss.

H. The Copyright Act Does Not Preempt Plaintiffs’ State Law Claims

Finally, Defendants argue that the Copyright Act preempts Plaintiffs’ state law claims. Despite Defendants’ lengthy argument to the contrary, the Copyright Act does not preempt every state law claim whenever a pleading also refers to “copyrights.” *See* 17 U.S.C. § 301(a). Preemption is not nearly as broad as Defendants’ argument suggests.

Copyright preemption is limited: it applies only when a state law repackages one of the exclusive rights provided in the Copyright Act. Section 301(a) of the Copyright Act preempts state laws that seek to protect rights “equivalent to” the exclusive rights generally within the scope of copyright protection. Section 301(a) provides that “all legal or equitable rights that are *equivalent to any of the exclusive rights within the general scope of copyright* as specified by

²⁵ The owner of a copyright in a collective work is presumed to have received consent from each author whose work is incorporated in the collective work. *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 487 (2001).

²⁶ Any one of the purported co-authors could have consented to the subsequent publications. *See Jasper v. Sony Music Entm’t, Inc.*, 378 F. Supp. 2d 334, 346 (S.D.N.Y. 2005) (McMahon, J.) (each co-author may exploit copyrighted work with other co-author’s consent) (citations omitted); *Siegel v. Time Warner Inc.*, 496 F. Supp. 2d 1111, 1144 (C.D. Cal. 2007) (each co-owner can license work without another co-owner’s permission) (citations omitted).

section 106 . . . are governed exclusively by this title.” 17 U.S.C. § 301(a) (emphasis added).²⁷ However, Section 301(b) of the Copyright Act makes it equally clear that the statute does *not* preempt state laws governing “activities violating legal or equitable rights that are *not equivalent to any of the exclusive rights* within the general scope of copyright as specified by section 106.” 17 U.S.C. § 301(b) (emphasis added).

Courts in the Second Circuit apply a two-pronged test to determine if a state law claim is preempted. *See WNET v Aereo, Inc.*, 871 F. Supp. 2d 281, 283-84 (S.D.N.Y. 2012) (Nathan, J.).

As the Court explained in *WNET*:

First, courts consider the “subject matter requirement” and assess whether the state law claim asserts rights in the type of works protected by the Copyright Act. *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 305 (2d Cir. 2004). Second, under the “general scope requirement,” the rights provided by the state law claim must be “*equivalent to one of the bundle of exclusive rights already protected by copyright law.*” *Id.* at 305. If *both* prongs are met, the state law claim is preempted.

Id. at 283. Under the Second Circuit test, preemption is appropriate “only when the state-created right may be abridged by an act that would, by itself, infringe one of the exclusive rights provided by federal copyright law. In other words, the state law claim *must involve acts of reproduction, adaptation, performance, distribution or display.*” *Id.* at 284 (emphasis added).

Under the Second Circuit test for preemption, Plaintiffs’ state law claims are not preempted here for at least two different reasons. *First*, the state law claims do not assert any rights in the type of works protected by the Copyright Act. The state law claims do not even remotely concern the right to reproduce, perform, use, display, or distribute copyrighted works. *Second*, the state law claims do not involve acts of reproduction, adaptation, performance,

²⁷ The Copyright Act protects the following property rights: (1) to reproduce a copyrighted work; (2) to prepare derivative works based upon a copyrighted work; (3) to distribute copies or phonorecords of a copyrighted work to the public; (4) to perform a copyrighted work publicly; and (5) to display a copyrighted work publicly. *See* 17 U.S.C. § 106.

distribution, or display. Rather, they involve acts of deception, breaches of contract, and unfairness. Because neither required condition for preemption is met here, Defendants' preemption argument must fail.

1. The Song Does Not Fall Within the Subject-Matter of Copyright

As a preliminary matter, Defendants' preemption argument fails because the Song does not fall within the "subject matter" of copyright. *WNET*, 871 F. Supp. 2d at 283-84 (under the "subject matter requirement," Copyright Act only preempts claims covered by Copyright Act). Because the Song does not meet the definitions of Sections 102 or 103 of the Copyright Act, it does not fall within the "subject matter" of copyright.

Under Section 102 of the Copyright Act, copyright protection subsists, "in original works of authorship, fixed in any tangible medium of expression." 17 U.S.C. § 102(a). Plaintiffs allege, however, that *We Shall Overcome* is **not** an "original work of authorship," but rather was copied from an earlier public domain work and preexisting copyrighted works. Likewise, Section 103 of the Copyright Act provides that "copyright in a compilation or derivative work extends **only to the material contributed by the author of such work**, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." 17 U.S.C. § 103 (emphasis added). Plaintiffs allege that neither Defendant Ludlow nor the four authors contributed any original material to the Song. Comp. ¶¶ 76, 94, 104. Thus, as alleged in the Complaint, the only works covered by the 1960 and 1963 copyrights were the **musical arrangements** and possibly some new lyrics, not the melody or familiar lyrics. Comp. ¶¶ 9, 70-71, 73, 75, 119, 129-130, 142. At most, the copyrights covered just the musical arrangements and possibly the new lyrics. *Id.*

For these reasons, *We Shall Overcome* does not come within the "subject matter of

copyright.” *See WNET*, 871 F. Supp. 2d at 283-84. To be sure, Defendants have not identified a single piece of evidence, written or otherwise, to the contrary. Standing alone, this is a sufficient basis to find that Plaintiffs’ state law claims are not preempted by the Copyright Act.

2. Plaintiffs’ State Law Claims Assert Rights That Are Fundamentally Different From the Exclusive Rights Enumerated in Section 106

Even if the state law rights at issue could possibly fall within Sections 102 and 103 of the Copyright Act – they do not – Defendants’ preemption challenge must still fail because those state rights are not equivalent to the rights protected under the Copyright Act. “A state law claim is not preempted if . . . the ‘nature of the action . . . is qualitatively different from a copyright infringement claim.’” *Computer Assocs. Int’l v. Altai, Inc.*, 982 F.2d 693, 716 (2d Cir. 1992) (citation omitted). Preemption applies only when the state law claim “involve[s] acts of reproduction, adaptation, performance, distribution or display.” *Briarpatch*, 373 F3d at 305-06 (citations omitted). In addition, “the state law claim must not include any extra elements that make it qualitatively different from a copyright infringement claim.” *Id.* (citations omitted). Courts generally apply a presumption against preemption of state law, particularly in realms traditionally associated with state police powers such as consumer protection. *See New York v. FERC*, 535 U.S. 1, 18 (2002) (“*FERC*”) (courts “start[] with the assumption that the historic police powers of the States [are] not to be superseded . . . unless that was the clear and manifest purpose of Congress”); *Cipollone v. Liggett Group*, 505 U.S. 504, 517 (1992) (statute is construed “in light of the presumption against the pre-emption of state police power regulations”).

Here, each state law claim “contains an element not shared by the federal law, an element which changes the nature of the action so that it is *qualitatively different from a copyright infringement claim.*” *See Summit Mack Tool Mfg. Corp. v. Victor CNC Sys.*, 7 F.3d 1434, 1439

(9th Cir. 1993) (emphasis added).²⁸ Section 106 of the Copyright Act grants a copyright owner certain exclusive rights, including the right to reproduce, prepare derivative works, distribute, and display copyrighted works. *See* 17 U.S.C. § 106. Significantly, ***no part of the Copyright Act protects a party's right to be free from the unlawful assertion of copyright.*** Plaintiffs' state law claims are fundamentally different than any right protected under the Copyright Act.

In Count Three, Plaintiffs assert a claim under New York General Business Law ("GBL") § 349, which prohibits "deceptive acts or practices in the conduct of any business, trade or commerce or in the furnishing of any service." Comp. ¶ 142. The Copyright Act has no provision prohibiting anyone from falsely claiming to own a copyright. Indeed, the Copyright Act does not contain any provision involving deceit or misrepresentation. Its focus is the innocent or willful copying of another's copyrighted work. Thus, preemption of Plaintiffs' GBL § 349 claim does not meet either the subject-matter or equivalence prong of the Second Circuit test.

In *Samara Bros. v Wal-Mart Stores, Inc.*, 165 F.3d 120, 131 (2d Cir 1998), after recognizing that "unfair competition and misappropriation claims grounded solely in the copying of a plaintiff's protected expression are preempted" because such claims are essentially identical to an infringement claim, the Second Circuit held that ***other*** unfair competition claims, such as the one Plaintiffs assert here, would ***not*** be preempted.²⁹

In *Colour & Design v U.S. Vinyl Mfg. Corp.*, No. 04 Civ. 8332 (MBM), 2005 U.S. Dist. LEXIS 10964, at *16-17 (S.D.N.Y. May 19, 2005), this Court held that state law unfair

²⁸ Although this Court has subject-matter jurisdiction over this action with respect to claims seeking declaratory and other relief "arising under," *inter alia*, the Copyright Act, 17 U.S.C. §§ 101 *et seq.*, Plaintiffs do ***not*** assert any substantive claim under the Copyright Act.

²⁹ The protection of state statutory claims from preemption is very broad. For example, in *Wojnarowicz v Am. Family Ass'n*, 745 F. Supp. 130, 135 (S.D.N.Y. 1990) (Conner, J.), the Court held that the Copyright Act does not preempt claims under the New York Artists' Authorship Rights Act, which "protect[s] the artist's reputation, a species of tort law traditionally reserved to the states." Just as that statute is not preempted, neither is GBL § 349.

competition claims are not preempted when “they do not entail the assertion of rights equivalent to those protected by federal copyright law.” While *Color & Design* involved a passing-off claim, its reasoning is equally applicable here. Plaintiffs allege that Defendants are engaged in deceptive acts and practices by claiming to own a copyright to the Song’s melody and well-known lyrics despite the fact that the 1960 and 1963 copyrights cover only specific arrangements and possibly new lyrics, and despite the fact that the work was not original, thus misleading and deceiving the public within the meaning of GBL § 349. Comp. ¶¶ 142-43. Deception and the risk of confusion are not elements of a copyright infringement claim. *See id.*, at *17 (risk of confusion is “extra element” not found in Copyright Act claim).³⁰

Eyal R.D. Corp. v Jewalex N.Y. Ltd., 784 F. Supp. 2d 441, 445 (S.D.N.Y. 2011) (Hellerstein, J.), cited by Defendants, is irrelevant. In that case, the plaintiff alleged that the defendant copied its copyrighted jewelry design. *Id.* After dismissing the plaintiff’s copyright infringement claim without prejudice, the Court also dismissed its unfair competition claim because the plaintiff there, unlike Plaintiffs here, did not allege any acts of deception. *Id.* at 447 (noting that unfair competition claim alleging deception “might not be preempted because it would involve allegations beyond the scope of the Copyright Act”).

Atrium Group de Ediciones y Publicaciones, S.L. v Harry N. Abrams, Inc., 565 F. Supp. 2d 505 (S.D.N.Y. 2008) (McMahon, J.), also does not support Defendants’ preemption argument. In that inapposite case, the plaintiffs alleged that the defendants copied their

³⁰ Other courts have found that similar unfair competition laws are not preempted. For example, California’s unfair competition law claims are not preempted. *See Valente-Kritzer Video v. Pinckney*, 881 F.2d 772, 776 (9th Cir. 1989) (fraud claim was not substantially equivalent to any right protected under Copyright Act because it required proof of misrepresentation); *Educ. Testing Serv. v. Simon*, 95 F. Supp. 2d 1081, 1091 (C.D. Cal. 1999) (California unfair competition law claim *not* preempted because Copyright Act preempts only those state laws that are “equivalent to” copyrights).

intellectual property and asserted an infringement claim and several state law claims (but not a claim under GBL § 349) against the defendant. *Id.* at 507. The Court dismissed the plaintiffs’ state law claims because they advanced essentially “only one theory” – that the defendants misappropriated their copyrighted works – cast under a variety of legal claims. *Id.* at 510. Here, Plaintiffs do not allege that Defendants misappropriated their own work; rather, they advance a number of different legal theories involving deception, the failure of consideration, and unjust enrichment, none of which overlap with the exclusive rights protected under the Copyright Act. For that reason, *Atrium Group* does not support Defendants’ preemption argument.

In Count Four, Plaintiffs assert a claim for breach of contract, and in Counts Five and Six, they assert quasi-contractual claims for money had and received and rescission (based on the failure of consideration). Comp. ¶¶ 158-68. In *Stadt v. Fox News Network LLC*, 719 F. Supp. 2d 312, 321 (S.D.N.Y. 2010), another inapposite case cited by Defendants, this Court held that a breach of contract claim in which the plaintiff alleges more than that the defendant used the plaintiff’s copyrighted work without authorization, as Plaintiffs allege here, is *not* preempted by the Copyright Act. Such contract claims survive preemption, for example, when they involve a breach of a promise or failure of consideration, neither of which is required for an infringement claim. *See A. Brod, Inc. v SK&I Co. L.L.C.*, 998 F.Supp. 314, 323 (S.D.N.Y. 1998) (Sotomayor, J.) (collecting cases). This is because breach of contract claims “turn on evidence and legal principles that are largely different from and irrelevant to the federal [copyright] claim.” *Smith v Weinstein*, 578 F.Supp. 1297, 1305 (S.D.N.Y. 1984) (Sofaer, J.). *See also Altera Corp. v. Clear Logic, Inc.*, 424 F.3d 1079, 1089 (9th Cir. 2005) (reviewing cases from the Seventh, Eighth, and Federal Circuits); H.R. REP. No. 94-1476, 94th Cong., 2d Sess. 132, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748) (“In elaborating the meaning of the term ‘equivalent rights’ the House

committee report to the Copyright Act suggests that *breaches of contract were not generally preempted*: ‘nothing in the bill derogates from the rights of parties to contract with each other and *to sue for breaches of contract.*’”) (emphasis added).

Plaintiffs’ quasi-contractual claims for money had and received and rescission likewise possess elements that are qualitatively different from any right protected under the Copyright Act. Comp. §§ 164-168. Both claims assert Plaintiffs’ rights to receive something of consideration in exchange for their payments of synchronization and mechanical licensing fees. Comp. §§ 158-168. As Plaintiffs allege, the right to receive valid consideration was breached because “Defendants’ purported licenses were worthless.” Comp. § 167. Accordingly, the Copyright Act does not preempt Plaintiffs’ quasi-contract claims. *See Grosso v. Miramax Film Corp.*, 383 F.3d 965, 968 (9th Cir. 2004).

IV. CONCLUSION

For all these foregoing reasons, the Court should enter an order denying Defendants’ motion to dismiss and allow this case to proceed for a determination on the merits.

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