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While intellectual property attorneys are familiar with the four statutory factors of fair use, those factors can be confusing to apply to specific situations. In their article, Michael C. Donaldson and Lisa A. Callif offer a simpler approach to a subset of fair use—nonfiction. They propose a three-question test: 1) Does the asset illustrate or support a point that the creator is trying to make in the new work? 2) Does the creator of the new work use only as much of the asset as is reasonably appropriate to illustrate or support the point being made? 3) Is the connection between the point being made and the asset being used to illustrate or support the point clear to the average viewer? The authors examine recent cases in light of this three-question test and offer it as a means to understanding whether a proposed use is within a safe harbor.

Fair use may be complicated, but perhaps less so than bankruptcy. In Michael V. Blumenthal’s article on intellectual property rights in bankruptcy, he examines the application of intellectual property law in bankruptcy. His analysis of the rights of the parties to a bankruptcy includes consideration of the type of property that is the subject of the license, whether the license is exclusive or nonexclusive, whether the license provides for assignability, and the jurisdiction in which the bankruptcy case is filed. Circuit courts have split on whether a licensor’s consent is necessary when a debtor-licensee seeks to assume or assign its licensing agreement, and this circuit split has created a certain amount of forum shopping for companies hoping to reorganize through bankruptcy.

This special issue also covers fine art. Michael D. Kuznetsky and Mark D. Kesten examine the application of copyright law to large-scale sculptural works. This type of litigation implicates a complete range of the nuances of the statute of limitations, proper notice and registration of copyright, the type of infringement, and determination of damages.

While an artist who spends months carving an original work in granite may have ownership interest in the final product, who should own the copyright to one’s life story? Lee S. Brenner and Cathy D. Lee argue that while there may be practical reasons to pay people for their life stories, the legal justification for doing so is not as solid. One of the primary benefits of a life rights agreement is that it eliminates or significantly reduces the risk of a lawsuit. However, obtaining permission from every real person who may be depicted in a work may not be possible. Brenner and Lee examine the issue with an eye toward the practical realities and the legal principles that affect life rights agreements.

Greg Victoroff’s book review, in turn, recounts an author’s battle to reclaim the profits from a stolen work. Please enjoy this special issue of Los Angeles Lawyer.
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Janna Sidley general counsel of the Port of Los Angeles

Janna Sidley’s responsibilities include management of the attorneys in the Harbor Division, serving as legal adviser to the Board of Harbor Commissioners, the Governing Boards of the Alameda Corridor Transportation Authority, and the Intermodal Container Transfer Facility Joint Powers Authority. Before joining the Los Angeles City Attorney’s Office in 2003, she directed press teams, events, and domestic and foreign travel for the president of the United States and the first lady.

What is the perfect day? A day in which I am engaged intellectually and personally, and moving forward.

As general counsel for the port of Los Angeles, what are your three major job duties? I oversee the legal staff, I support the client—the port, and it is my responsibility to be a good member of the community.

What is a common problem that one of your 21 staff members might handle? We are a landlord port, so we have a tremendous amount of real estate work. We also specialize in environmental concerns.

You have worked as a trial attorney as an assistant U.S. attorney. Were you scared the first time you stood in front of a jury? Petrified. I think you should be.

You have had both civil and criminal trial experience. Is one easier than the other? The federal criminal bar in Los Angeles is very small, so you could do things on a handshake.

What was your best job? Working at the White House—there’s nothing quite like that. But this job is fascinating—it’s an honor to have the responsibility.

How many people are employed by the port? Nine hundred by the Los Angeles Harbor Department and more than 10,000 longshore and terminal jobs. Jobs related to the port are about one in 12 in Los Angeles.

What kind of tax revenues are generated by the port? In 2014, state and local revenues throughout California were $6.1 billion.

What is the economic benefit of the port of Los Angeles and the port of Long Beach’s trade gateway? The value of trade to the economy throughout California is $89.2 billion.

Is the port of Los Angeles the busiest port in America versus 8.5 million containers? Yes, we call them TEUs—Twenty-foot Equivalent Units. It is the standard measurement for a box.

Do you have your own police? We do. They are responsible for the harbor district, which is 7,500 acres and 43 miles of waterfront. They work hand in glove with the feds.

What precautions are taken as to terrorism? We are always on alert. We have very tight security. Our efforts are consistent with what is happening in the rest of the world and country.

The busiest port in America based on tonnage is South Louisiana. Is number of containers versus tonnage an important distinction? It’s an important distinction for them.

Does the port of Los Angeles compete with the port of Long Beach? Yes, but we are partners in security, in environmental issues, and in moving boxes in a more sustainable manner. We do not talk about price and terms.

Are the two ports only seven miles apart? Yes, when you come through Angel’s gate, Los Angeles is left and Long Beach is right. The distinction is not that real to lay persons who just see big ships and boxes.

Together, the port of Los Angeles and port of Long Beach, are the sixth busiest port in the world. Which is the busiest? Shanghai. They move 33 million TEUs a year.

In 2006, an aggressive plan was approved to reduce air pollution by at least 45 percent by 2011. Did you meet the goal? We did. We are a leader in sustainability and green port activity. Everybody knows there is more that can be done. It is a matter of understanding the technology that is in place today and understanding how to pay for it.

The port is known for cutting at-berth emissions. How is that accomplished? The port was the creator of AMP—alternative marine power. Ships come in, plug in, and turn off their engines.

What about offshore? We have a speed reduction program, 20 and 40 nautical miles out, which is an incentive program. When the ships slow down, they put out fewer emissions.

What is your favorite attraction at LA Waterfront? The San Pedro Fish Market. Stand in line, order fish, get it cooked, and eat it with tortillas and a beer.

Following World War II, the cargo container was adopted into commercial use. What was the effect? The advent of the container made on-loading and off-loading more efficient. Before, things were lashed down, in bags, sometimes on pallets. It changed the way ships are loaded and unloaded.

Does that mean no more love trysts like the one in the Titanic’s hold between Leo and Kate? Well, you could get on any rolo, which is basically a car-carrying ship.
What is a Post Panamax vessel? It is a ship of a size that would not fit through the current Panama Canal.

What role has the Panama Canal had in the port? The new Panama Canal will be bigger. Some believe that cargo will go directly to different ports.

Should the port of Los Angeles be “craning up” to service supertankers and the largest modern container ships? Last December, we had our biggest ship yet call. It was longer than the Empire State Building. The cranes have to be higher and longer.

What advantage does the port have? Location—proximity to Asia and the 20 million people who live here.

If you were handed $10 million tomorrow, what would you do with it? Promote the Southern Poverty Law Center. Selfishly, I’d like a private plane to get out of going through airport security.

Who is on your music playlist? David Bowie, Queen, Adele.

What book is on your nightstand? *The Devil Wears Prada.*

You have traveled to all 50 states. Which is your favorite? California.

What is your favorite vacation spot? Italy—I love it all. The food is lovely, the wine…it’s magical.

What do you do on a three-day weekend? Ski in Mammoth or Colorado.


What app do you wish you could work on your iPhone? I don’t have many apps. I am bricks and mortar.

Which person in history would you like to take out for a beer? Harriet Tubman—what kept her going? I would probably drink wine.

If you had to choose only one dessert for the rest of your life, what would it be? Cheesecake.

What are the three most deplorable conditions in the world? Lack of opportunities for women, hunger, homeless refugees.

Who are your two favorite U.S. presidents? Bill Clinton and Abraham Lincoln.

What is the one word you would like on your tombstone? Tried.

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Steps to Take in Beginning a New Legal Career

**Starting a Legal Career** directly out of law school is extremely difficult. Trying to start a career by moving to a market in which one did not attend school or does not have connections can prove even more daunting. It is similar to being the new kid in a high school where everyone else has known each other since grade school. Nevertheless, there are steps that newly minted JDs can take to settle into a new and foreign market.

Of course, in order to obtain that first new job, applications have to be e-mailed (or mailed in the case of many federal government positions) to potential employers, but, additionally, new lawyers need to take the initiative and get actively involved in their legal community. Employers are inundated with applications from recent graduates, making the odds of obtaining a job through an e-mailed application a numbers game. In today’s market, personal relationships are more important than ever. Unless you are lucky enough to have a job straight out of law school or obtain a position quickly after entering the legal field, the best route to obtaining a job in the current market is through seeking out and developing relationships.

One of the first steps a new attorney can take is to sign up with the local bar association, for example LACBA, and any sections that are of interest. It can be worthwhile to look into discounts for new lawyers or lawyers of a certain income level. As an illustration, LACBA offers complimentary membership to those newly admitted to the California bar. Then, as soon as possible, attend an event of any section that may be of interest and seek out the leaders of the respective executive committees. Get to know these people and offer to volunteer at future events. The goal is to secure a future position on the executive committee of that section and make more contacts. While this may seem to be a calculating plan, one reason that professional organizations exist is to make networking possible. Many attorneys join organizations in order to go to CLE events and the occasional networking event. A chief value of the organizational dues is attending events and becoming actively involved in running a section or the overall organization. This same approach is also worthwhile for professional organizations other than bar associations.

Another step a new attorney can take is to volunteer. Volunteering time is the quickest way to get to know the local firms, service organizations, and attorneys in the area. Pick an area of the law that is of interest and find a private or public organization that could use help. For example, LACBA has many initiatives in which new lawyers can volunteer and be trained in various areas of law, including the Domestic Violence Legal Services Project, Veterans Legal Services Project, Immigration Legal Assistance Project, AIDS Legal Services Project, and the Civic Mediation Project. When you pick an organization, make sure to be reliable, for even though it is an activity you are performing for free, any work product should be of top quality, as your reputation will be held out for scrutiny.

There is another form of volunteering that a new attorney may be in a position to consider—working for free. There are many opportunities to volunteer as an attorney for several government positions, although some require a year or six-month commitment. Also, in order to get experience, volunteering at smaller firms that are willing to take you on and train you in exchange for your work and time may prove to be beneficial. Depending on the individual’s financial situation, volunteering may not always be an option. However, if it is a possibility, it affords the opportunity to gain skills and put productive experience on your resume.

Volunteering is the quickest way to get to know the local firms, service organizations, and attorneys in the area.

Recently, for example, LACBA launched a new offering that also can significantly help career-building for new attorneys—the Lawyer Referral Service (LRS) Limited Experience Panel. The panel is designed to help young lawyers get practical experience on very basic legal issues by connecting them with solvent clients who may not be able to pay typical market rates. Because lawyers on the Limited Experience Panel will not qualify for regular LRS referral business due to a lack of experience, there are some unique requirements for participation. However, this is a great way for young lawyers to get their feet wet with paying clients.

Whether through networking, volunteering, or something new such as the Limited Experience Panel, once connections have been made, it is very important to maintain contact. E-mailing contacts every so often to check on how they are doing or how a project or case they were working on turned out ensures that the sender will be remembered. Even better, meeting with these connections over lunch or coffee (especially if you offer to treat) goes further than an e-mail in solidifying relationships. Be sure, though, not to directly ask for a job or assistance in finding a job until a closer connection has been made.

This advice may not be feasible for everyone, and it may not lead to a job. Every person’s path to success is different. There are no perfect sets of instructions on how to obtain an associate or in-house position, much less your dream position, but taking the initiative to get involved in the local legal community will always prove to be of benefit to both the community and you.

Victor Ortiz is a healthcare and corporate transactional attorney for several healthcare companies based in Southern California. He also serves on the executive committees of the Barristers, Healthcare Law, and Corporate Law Sections of LACBA.
The Disposition of Intellectual Property Licenses in Bankruptcy

A FUNDAMENTAL POLICY of intellectual property (IP) law is to promote creation of advances in technology and design by protecting the rights of owners and licensors. Intellectual property generally consists of intangible assets falling into categories such as patents, copyrights, and trademarks, all of which are governed by federal law. The owner of a trademark, patent, or copyright often may decide that the most efficient way to exploit its IP is to license the creation of advances in technology and design by protecting the rights of owners and licensors. Intellectual property generally consists of intangible assets falling into categories such as patents, copyrights, and trademarks, all of which are governed by federal law. The owner of a trademark, patent, or copyright often may decide that the most efficient way to exploit its IP is to license the production, distribution, or development of its IP, separately or in combination, to another company that may have a particular manufacturing expertise, lower costs, or a more expansive network than the owner. Typically, the owner of IP will choose a licensee because of the owner’s confidence in the licensee to exploit the particular type of IP being licensed. IP law and most licensing agreements generally require consent of the owner-licensor to allow a licensee to assign or sublicense any interest in patents, copyrights, or trademarks. When a licensee files a bankruptcy, whether an IP license is assignable (or even assumable)1 without the consent of the owner-licensor, triggers a unique intersection of bankruptcy and IP law. The analysis of parties’ rights centers around issues that include 1) the type of IP that is the subject of the license, 2) whether the license is exclusive or nonexclusive,2 3) whether the license provides for assignability, and 4) the particular jurisdiction in which the bankruptcy case is filed. In interpreting the relationship of the Bankruptcy Code to the assumption and assignment of IP licenses, circuit courts have split on whether a licensor’s consent is necessary when a debtor-licensee seeks to assume or assign its licensing agreement. Consequently, this circuit split has created a certain amount of forum shopping for companies hoping to reorganize through bankruptcy.

Bankruptcy law serves to protect the interest of the debtor and its creditors by promoting free alienation of contract rights for the benefit of creditors. When a bankruptcy case is filed, an estate is created that comprises all of the debtor’s legal and equitable property rights as of the bankruptcy petition date, as well as any subsequent proceeds derived therefrom.3 The estate includes any IP in which the debtor may hold an interest. Pursuant to Section 365(a) of the Bankruptcy Code, a debtor is given the ability to assume or reject4 any executory contract or unexpired lease. An executory contract is defined and generally accepted as one that is so far unperformed and upon which the failure of either party to complete performance would constitute a material breach excusing performance of the other.5 Debtors may assume or assign—or both assume and assign—executory contracts without the consent of the nondebtor counterparty even if the contract expressly prohibits assignment or is silent on the issue. Most licensing agreements are executory. In order to assume an executory contract a debtor must cure all defaults, including monetary and nonmonetary breaches, and provide adequate assurance of future performance under the applicable contract.6

The general rule of free assignability and alienation is found in Section 365(f)(1) of the Bankruptcy Code, which provides that a trustee or debtor may assign a contract “except as provided in subsection (c) of this section, notwithstanding a provision in an executory contract…or in applicable law, that prohibits, restricts or conditions the assignment of such contract.” The exception in Section 365(f)(1) provides that an executory contract may not be assumed or assigned if applicable law excuses a party, other than the debtor, to such contract…from accepting performance from or rendering performance to an entity other than the debtor or the debtor-in-possession, whether or not such contract…prohibits or restricts assignment of rights or delegation of duties…and such party does not consent to such assumption or assignment.

Assignment and Assumption

A majority of courts have held that IP licenses are executory contracts7 and that therefore Section 365(c)(1) restricts a debtor from freely assigning a licensing agreement without the licensor’s consent, because applicable federal law involving patents, trademarks, and copyrights restricts alienability without the consent of licensor. The rationale to this approach is that the policy behind IP law requiring consent from a licensor to assign an IP license overrides the basic policy behind bankruptcy law reflected in Section 365(c)(1).

If an IP agreement is held by a court to be executory in nature, most courts will hold that a licensing agreement cannot be assigned without the consent of a licensor, particularly when a licensing agreement is nonexclusive. Virtually all patent cases dealing with exclusive and nonexclusive patents have held that a debtor cannot assign a patent license without the consent of the licensor based upon federal common law holding that a patent license is personal to the licensee.8

Trademark licenses are also not assignable to third parties based upon non-bankruptcy law holding that they are personal to the licensee, and when a bankruptcy court applies “applicable law,” trademark licensors are able to prevent a debtor-licensee from...
assigning trademark licenses regardless of whether the license is exclusive or nonexclusive. Similarly, nonexclusive copyright licenses are not considered to be a transfer of copyright ownership and are generally held to be nonassignable without the consent of the licensor under federal law.10

Exclusive copyright licenses are considered an actual transfer of property in the underlying copyright, and therefore an assignment should be allowed without the consent of a licensor. However, there are cases holding that even exclusive copyright licenses are not assignable without consent.12 A Delaware bankruptcy court, in ruling that a nonexclusive licensee has only a personal and not property interest that could not be assigned without the copyright holder’s consent, stated in dicta: “By contrast...an exclusive licensee does acquire property rights and ‘may freely transfer his rights, and moreover, the licensor cannot transfer the same rights to anyone else.’”13

If a debtor-licensee seeks only to assume the license and continue to utilize the technology, mark, or material upon emerging from bankruptcy, there is a circuit split as to whether the debtor may do so without the consent of the licensor. The circuit split arises from two distinct interpretations of the interplay of Sections 365(f) and 365(c)(1) in the wording of Section 365(c), which states that “the trustee may not assume or assign.” The courts have debated whether the word “or” really means “and” and whether the word “trustee” in the statute nevertheless allows a debtor-in-possession to assume an IP license. The two interpretations have been coined the “hypothetical” and “actual” tests. Under the hypothetical test courts interpret Section 365(c)(1) as asking whether the debtor hypothetically could assign the license even if it is only proposing to assume it. Thus, these courts read “or” in the disjunctive, find that “trustee” also applies to a debtor and debtor-in-possession, and do not allow assumption. Courts utilizing the actual test interpret “or” in the conjunctive and the statutory language to mean only what the debtor is actually proposing to do, draw a distinction between a trustee and debtor or debtor-in-possession, find that a debtor-in-possession is the same entity with whom the nondebtor counterparty contracted, and allow assumption.

**Hypothetical Test**

To date, a majority of the courts have adopted the hypothetical test, which holds that a debtor may not assume an IP license based upon the express language in Section 365(c)(1), even if the debtor has no intention of ever assigning the license because applicable law would bar assignment to a hypothetical third party. Under the hypothetical test, the licensor controls whether a debtor can continue utilizing the license, even though it is the same party with whom the licensor entered into the licensing agreement. The Third Circuit first enunciated the hypothetical test in the case of In re West Electronics Inc.,14 holding that a debtor could not assume a prepetition contract with the federal government calling for the production of military equipment based upon the fact that federal law prohibited an assignment of the contract without the government’s consent, even though the debtor had no intention of assigning the contract. The Third, Fourth, Ninth and Eleventh Circuits follow the hypothetical test.15

In an oft-cited case, In re Catapult Entertainment, Inc., the Ninth Circuit subsequently held that a nonexclusive patent license was personal, nondelegable, and could not be assumed by a debtor over the licensor’s objection because applicable law would bar assignment to a hypothetical third party, even when the debtor had no intention of assigning the contract to a third party.16 This decision carefully analyzed the provisions of Sections 365(a), (f), and (c)(1). Since Section 365(c)(1) provides that notwithstanding the general policy of free alienation by debtors-in-possession set out in Sections 365(a) and (f), if applicable law excuses a party, other than the debtor, from accepting performance or rendering performance to an entity other than the debtor or debtor-in-possession, the contract may not be assumed or assigned absent consent by such third party. The Catapult court held that it was bound by the plain terms of the statute and joined the other circuits in adopting the hypothetical test. The court emphasized that federal patent law constitutes applicable law within the meaning of Section 365(c) and nonexclusive patent licenses are “personal and assignable only with the consent of the licensor.”17 The hypothetical test has been so coined based upon a hypothetical transfer to a third party despite a debtor’s not intending to do so, as well as a debtor’s hypothetically being a different entity than that with which the licensor contracted prior to the filing of a bankruptcy petition. The hypothetical test has also been called the literal test. This appellation is derived from the literal interpretation of Section 365(c)(1).18

In Gardner v. Nike, Inc., the Ninth Circuit went further and held that, based upon the hypothetical test, an exclusive licensee did not have the right to resell or sublicense a copyright without the consent of the owner.19 The court cited the Copyright Acts of 1909 and 1976 in concluding that under the doctrine of indivisibility, a copyright owner possessed an indivisible “bundle of rights” that are incapable of assignment without the consent of the original licensor.20 The Gardner holding has been criticized and is problematic in light of the Copyright Act of 1976, which expressly provides that “[a]ny of the exclusive rights comprised in a copyright...may be transferred...and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to a copyright owner by this title.”21

Courts following the actual test allow assumption of licenses by a debtor-in-possession. Thus, any company dependent on or with substantial revenue derived from its IP licenses that need to be assumed should not file a bankruptcy petition in the circuits adopting the hypothetical test22 unless the consents of licensors have been previously obtained.

**Actual Test**

The actual test, which allows a debtor to assume an IP license over the objection of a licensor when an assignment is not contemplated, is followed in the First and Fifth Circuits,23 as well as several bankruptcy courts outside of the Third, Fourth, Ninth, and Eleventh Circuits. The Fifth Circuit, in the case of Mirant Corporation, applied the actual or “as-applied” approach in holding that the consent of the nondebtor party was not required for a debtor to assume a federal power marketing agency agreement.24 The Mirant court compared the hypothetical versus actual test and concluded that when no assignment is occurring or contemplated, the exception in Section 365(a)(2) is not applicable. This court reasoned that Congress did not intend for a debtor going through bankruptcy to be a different entity for purposes of an antiaignment act.

The First Circuit also adopted the actual test25 and cited congressional history, suggesting that the abstract analysis under the hypothetical test was not envisioned, but contemplated a case-by-case inquiry into the actual consequences to the nondebtor party of permitting executory contracts to be performed by the debtor party. The court in Summit Investment and Development Corporation v. Leroux, in holding that 365(c) presented no bar to assumption of an executory contract, stated:

The historical evidence of legislative intent is buttressed by the 1984 amendment to section 365(c)(1) and its legislative history....Congress intended to “make [ ] clear that the prohibition against the trustee’s power to assume an executory contract does not apply where it is the debtor that is in possession and the performance to be given or received under a personal service contract, will be the same as if no petition had been filed because of the personal nature of the contract.”26
Another First Circuit case, *Institut Pasteur v. Cambridge Biotech Corporation*, applying the actual test held that a debtor holding a nonexclusive license for patented technology was allowed to assume the license under its plan of reorganization in which the debtor’s stock was sold to a company in direct competition with the patent holder. The court reasoned that the reorganized debtor was not a different entity from that with which the patent holder had entered into the licensing agreement, so federal common law and contract restrictions against the assignment of patents did not preclude assumption by the Chapter 11 debtor-in-possession.

The Sixth Circuit has not rendered a direct opinion in connection with the two tests. However, in *Rieser v. Dayton County Club Company (In re Magness)*, the court affirmed the refusal to allow the assignment of a membership interest in a private club, stating that it was not addressing assumption and that it should be “clear that we are not dealing with the right to assume.” The Magness court, in discussing its reasoning in not allowing a trustee to assign an executory contract, reasoned that a trustee cannot reshape, to the detriment of the nondebtor party, that for which the prepetition debtor bargained. In a subsequent case by a bankruptcy court in the Northern District of Ohio, *Ohio Skill Games Inc. v. Pace-O-Matic, Inc. (In re Ohio Skill Games Inc.)*, a debtor was allowed to assume a software license and distribution agreement over the objection of the manufacturer nondebtor counterparty. The bankruptcy court made extensive reference to the Sixth Circuit opinion in *Magness* and reasoned that because the assumption would maintain the relationship of the parties under the agreements, it was not a situation in which the nondebtor counterparty would be forced to accept performance from an unknown third party when it contracted for the same services from the debtor prepetition. The bankruptcy court stated that the agreement was the “soul” of the debtor’s business and there was no intent to assign the contract to a third party; therefore, the ability to assume the contract was the key to the debtor’s survival. The court went on to state that it was adopting the debtor’s position and the employment of the actual test.

**Third Test**

Although the Second, Eighth and Tenth Circuits have not ruled on whether the hypothetical or actual test is applicable, bankruptcy courts in these districts have allowed assumption utilizing a hybrid of the actual test. The courts in the Southern District of New York, *In re Adelphia Communications Corporation*, rejecting the hypothetical test and embracing the rationale of *Footstar* allowed Adelphia Communications to assume a franchise agreement despite provisions in cable ordinances prohibiting assignment without consent from local franchising authorities. The bankruptcy judge referred to the *Footstar* decision, noting that the Second Circuit had not ruled on the issue and that the reasoning in *Footstar* was correct. Under the approach being adopted in the Southern District of New York, a debtor-in-possession would be precluded from assigning IP agreements without the consent of the nondebtor counterparty because it would force the non-

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debtor to accept performance from or render performance to an entity other than the debtor. However, a debtor-in-possession can assume or assign IP licenses, irrespective of whether they are exclusive or nonexclusive, can assume or assign IP licenses, irrespective of whether the consent of a licensor is obtained. This type of approach recognizes the fundamental policy of bankruptcy law to allow a debtor and its creditors to reorganize a business while protecting the rights of owners and licensors of IP. Until Congress acts to correct the contrasting views among courts throughout the country or the Supreme Court rules on the conflict among circuits, companies will continue to forum shop when considering where to file a bankruptcy case.

1 For the basic definition of “assign” and “assume,” see, e.g., http://thelawdictionary.org.
2 An exclusive license is “limited to a specific scope or field, such as context, market, territory, or time. ‘Exclusive’ does not mean ‘one and only’ license granted, but only that the licensor agrees not to grant other licenses that have the same rights within the scope or field covered by the exclusive license. It may refer to a geographical area, technological application, method of production, or production of a specific product. Exclusivity may or may not include competition from other licensees or the licensor itself, granting of sublicenses, performance requirements to be met by the licensee, and/or a time limitation.” A nonexclusive license is one in which “the same rights to an intellectual property are granted to several licensees within the same scope or field, consecutively or simultaneously.” See http://www.businessdictionary.com.
4 When a contract is rejected, the Bankruptcy Code treats the agreement as being breached as of the petition date, and the licensor has an unsecured claim against the debtor for damages resulting from the breach.
7 Although a majority of courts have held that IP licenses are executory, some courts have held certain licenses to be nonexecutory; therefore, assignability is not restricted by Section 365(c)(1). An irrevocable, exclusive license in perpetuity to use trademarks and tradenames in connection with patents in a battery business was found to be nonexecutory, based upon a licensee’s paying a one-time fee. The licensee was not obligated to use the patent or pay royalties if the patent was utilized, and licensee’s obligations to enforce the patent were only conditional. In re Exide Tech., 607 F. 3d 957 (3d Cir. 2010). Also, the Eighth Circuit, sitting en banc, held a bread label licensing agreement that was perpetual, exclusive, and royalty-free in connection with a substantially consummated asset purchase agreement was not executory. The court reasoned that the license agreement was not a separate agreement but part of a $20 million integrated transaction to sell and transfer all the assets of the bread business operations, which comprised all tangible and intangible assets, including the license. Lewis Brothers Bakeries, Inc. and Chicago Baking Co. v. Interstate Brands Corp., 751 F. 3d 955 (8th Cir. 2014).
8 In re Catapult Entm’t Inc., 165 F. 3d 747 (9th Cir. 1999); see also Gardner v. Nike, Inc., 279 F. 3d 774

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An exclusive licensee of a copyright is deemed to have a "transfer of copyright ownership" under §201(d)(2) of the Copyright Act, which is said to constitute an explicit recognition of the principle of divisibility of copyright. 3-10 NIMMER ON COPYRIGHT §10.02 [hereinafter NIMMER]; see also Morris v. Business Concepts, Inc., 259 F. 3d 65, 70 (2d Cir. 2001).

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14 In re West Elecs., Inc., 852 F. 2d 79 (3d Cir. 1988).

15 See, e.g., In re Catapult Entm’t, Inc., 165 F. 3d 747 (9th Cir. 1999); Gardner, 279 F. 3d 774; In re Sunterra Corp., 361 F. 3d 257 (4th Cir. 2004); In re West Elecs., 852 F. 2d 79; In re James Cable Partners, L.P., 27 F. 3d (11th Cir. 1994); In re Cartron, 158 B.R. 629 (E.D. Va. 1993), aff’d without op., 25 F. 3d 1038 (4th Cir. 1994) (the Fourth Circuit affirmed the district court, which, like the Third and Eleventh Circuits, determined that the terms "trustee" and "debtor" were synonymous, relying on §1107(a) of the Bankruptcy Code).

16 In re Catapult, 165 F. 3d at 747.

17 Id. at 750-51.


19 Gardner, 279 F. 3d 774.

20 Id. at 778 (citing 3 NIMMER, supra note 11, at §10.02[C][4]).


22 In fact, many Chapter 11 cases have been filed in the Southern District of New York versus Delaware (Third Circuit) and California (Ninth Circuit) for this very reason. See, e.g., In re Adelphia Commc’ns Corp., 359 B.R. 65 (Bankr. S.D. N.Y. 2007); In re MGM Resorts Int’l, No. 10-15774 (SMB) Bankr. S.D. N.Y. 2010); In re Relativity Media, LLC, No. 15-11989 (Bankr. S.D. N.Y. 2015).

23 See, e.g., Summit Inv. & Dev. Corp. v. Leroux & Curran, 69 F. 3d 608 (1st Cir. 1995); Institut Pasteur v. Cambridge Biotech Corp., 104 F. 3d 489 (1st Cir. 1997); In re Mirant, 440 F. 3d 238 (5th Cir. 2006).

24 In re Mirant, 440 F. 3d at 238.

25 Summit, 69 F. 3d at 613 (holding that an executory partnership agreement, which was personal in nature, could be assumed if no assignment was contemplated);

26 Id. (quoting H.R. Rep. No. 1195, 96th Cong., 2d Sess. §27(b) (1980)).

27 Institut Pasteur, 104 F. 3d at 489.


29 Ohio Skill Games Inc. v. Pace-O-Matic, Inc. (In re Ohio Skill Games Inc.), No. 08-06049, 2010 WL 2710522 (Bankr. N.D. Ohio, July 8, 2010).

30 Id. at *12.


32 Id. at 570-72.


35 Id. at 142.

FAIR USE has existed as a court-created concept since 1841, and it has been memorialized in the U.S. Copyright Act since 1978. The four nonexclusive factors listed in the act, however, have confounded many, which is understandable because the factors are designed to guide the courts in a myriad of circumstances ranging from mass digitization of every book on the planet to using materials in films or to decoding garage door openers. This general test for fair use can be difficult to apply in specific cases.

However, academics have opined that examination of a subset of uses could produce a more predictable fair use test for that subset. A review of every published opinion on fair use in nonfiction works produces a pattern that can be formulated into a simple three-question test to determine whether something is fair use in a nonfiction context. The following three questions define a safe harbor for fair use in nonfiction works:

1) Does the asset illustrate or support a point that the creator is trying to make in the new work?
2) Does the creator of the new work use only as much of the asset as is reasonably appropriate to illustrate or support the point being made?
3) Is the connection between the point being made and the asset being used to illustrate or support the point clear to the average viewer?

The word “illustrate” in the first question is important because it obliges users of copyrighted material—in particular, nonfiction

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firms—to have a justifiable purpose in using the copyrighted asset. The asset must be used in a manner that demonstrates the commentary, critique, or argument that the filmmaker intends to make. The second question specifically ties length to purpose and ignores whether the amount of the copyrighted work used is very small or 100 percent of the asset. The relevant inquiry is whether the defendants only used what was reasonably appropriate to illustrate the point they were making in the new work. The phrase “reasonably appropriate” was used by Judge Pierre Leval in Authors Guild v. Google, which allowed copying of 100 percent of books in order to create a word-and-phrase search of all existing books.6 He opined that “completely unaltered copying has repeatedly been found justified as fair use when the copying was reasonably appropriate to achieve the copier’s transformative purpose and was done in such a manner that it did not offer a competing substitute for the original.”7 A filmmaker considering use of copyrighted material should make an honest assessment of when the illustration function is fulfilled. The safe harbor is not available for use that goes beyond illustration of a point and instead extends into the realm of viewing pleasure or, as the courts often say, “entertainment value.”9

In the third question, the “average viewer” implicates the intended audience for the new work. Legitimate journalistic effort is sometimes needed to make clear the connection between the material being used and the point being illustrated. If the answers to the three questions are ambiguous or only slightly negative, the test does not necessarily rule out fair use. Rather, it just means that the use could fall outside the safe harbor but still within the larger fair use doctrine, depending on how far from a firm yes the answer falls. A brief summary of case law involving nonfiction works demonstrates the safe harbor approach and how it applies in practice. Although the court opinions use the traditional nonexclusive four fair use factors, the three-question safe harbor test may be used to reach the same conclusion in terms that may be easier to apply to new situations.

In 2008, the feature documentary titled EXPELLED: No Intelligence Allowed was released in the theaters. At one point in the film, a person named Dr. Myers explains that science will push society “to that point where religion has taken that appropriate place, as [a] side dish rather than the main course.” Narrator Ben Stein intones, “Dr. Myers would like you to think he’s being original, but he’s merely lifting a page out of John Lennon’s songbook.” Then, for 15 seconds, the audience hears John Lennon singing his famous song “Imagine”: “Nothing to kill or die for/And no religion too.” The clip of the song is accompanied by the lyrics on screen in subtitles and stock footage of totalitarian Russia. The music was unlicensed. Yoko Ono sued for copyright infringement.8 The answer to the first question is clear: the song is being used to illustrate the point being made. Second, the filmmaker used only two lines from the song to demonstrate the point. Finally, the connection between the point being made and the use of “Imagine” was obvious. The trial court ruled in favor of the defense, finding fair use.10

In 1997, the Discovery Channel aired a program titled Aliens Invade Hollywood. The program explored the popular fascination with the idea of alien visitations and government cover-ups as expressed in Hollywood films. It used, among other items, three clips from a trailer for the film Invasion of the Saucermen totaling 48 seconds. Susan Hofheinz held the copyright to the trailer, and she brought an infringement action against Discovery.11 Discovery argued a fair use defense. The court not only affirmed Discovery’s position on fair use but also used language in the opinion that affirms the existence of a safe harbor for nonfiction works, explaining that “Discovery used the clips for various purposes, including: (1) to illustrate the theme of the government cover-up; (2) to demonstrate how, and with what special effects technology, aliens have been represented in film; and (3) to provide contrasts between the early science fiction films like ‘Saucermen’ and more recent films.”12 Turning to the second question of the safe harbor test, the court concluded that “the fleeting clips betray little of ‘Saucermen’s’ plot, only the fact that aliens visited and the government tried to cover up the evidence.”13 By focusing on the film’s critical interest instead of focusing on the 48 seconds of use, the court clearly implies that Discovery did not use more from the film than was reasonably appropriate to illustrate the point. Finally, the court affirmatively provided language in its statutory analysis that comports with the safe harbor approach, explaining that the clips were used for the “transformative purpose of enriching the commentary on the alien visitation genre” and that the clips enabled the viewer to understand and appreciate the commentary on the genre.14

SOFAs Entertainment, Inc. v. Dodger Productions, Inc., confirms that the safe harbor approach may be applied to any nonfiction medium, including scripted works such as stage plays or musicals. SOFA involves the wildly successful Broadway musical Jersey Boys, which tells a condensed and occasionally fictionalized version of the rise of the 1960s singing group The Four Seasons. At one point, a seven-second clip plays on a large screen showing Ed Sullivan introducing The Four Seasons on national television.15 SOFA owns the copyright to The Ed Sullivan Show and is in the business of licensing clips. SOFA sued Dodger Productions for copyright infringement, and the production company mounted a successful fair use defense. The court explicitly acknowledged that “the fact that Jersey Boys is a commercial production is of little significance.”16

The language in the opinion affirms the utility of analyzing nonfiction works using the three questions listed above that define a safe harbor. As the court observed, “Dodger references the Four Seasons’ performance on...The Ed Sullivan Show to mark an important moment in the band’s career. At that point in rock & roll history, many American bands were pushed into obscurity by the weight of the ‘British Invasion,’ which was kicked off by the Beatles’ performance on The Ed Sullivan Show. The Four Seasons, however, thrived.”17 This observation addresses the first question affirmatively. The second question is also answered affirmatively, as “Sullivan simply identifies the group that is about to perform.”18 The clip does not feature any of the Four Seasons’ actual televised performance—clearly a reasonably appropriate amount of use. As for the final question, the court noted that the clip strongly illustrates the importance of “Being selected by Ed Sullivan to perform on his show [as] evidence of the band’s enduring prominence in American music.”19

In 2013, the Weinstein Company released Lovelace, a scripted biopic about Linda Lovelace’s rise to cultural icon status through her role as the star of the famous pornographic film Deep Throat. Lovelace contains several re-creations of scenes from Deep Throat to tell the story of Lovelace’s formative years of her film career. Arrow Productions, which owns the copyright to the porn film, sued the Weinstein Company for copyright infringement. The court held that the use of three re-creations was a fair use.20 The three-question safe harbor test produces the same result that the court found when it applied the four statutory factors. The re-creations were included in the film in order to illustrate the filmmakers’ point that Lovelace was an “unsuspecting amateur, anxious about her role in the film, and ultimately, susceptible to the influence of her domineering and manipulative husband.”21 The re-creations were deemed to be fair use because “defendants did not copy any more than necessary to achieve its creative purposes,” and the average audience understands the connection between the film’s message and the re-creations.22

A final example in this category involves the 2010 Sundance hit Catfish. The film was listed by the festival as a documentary. Later,
1. Scholars have indicated that patterns can be found in subgroups of fair use cases to allow for more predictability in outcomes.
   - True.
   - False.

2. For nonfiction works, an affirmative answer to the three questions posed by the authors will predict fair use.
   - True.
   - False.

3. The safe harbor approach may not be applied to nonfiction films that include fictional elements.
   - True.
   - False.

4. An example of fair use is the incorporation of a copyright-protected item into the background of a film’s scene in an incidental and fortuitous manner.
   - True.
   - False.

5. A commercial use is a dispositive factor in the court’s fair use analysis.
   - True.
   - False.

6. One may never use 100 percent of an unlicensed asset pursuant to fair use.
   - True.
   - False.

7. Material used primarily for its entertainment value is permissible pursuant to fair use.
   - True.
   - False.

8. Courts have applied the fair use doctrine to fictional films that are based on realistic settings.
   - True.
   - False.

9. An unlicensed item may appear blatantly and prominently in a film but still be deemed a de minimis use.
   - True.
   - False.

10. If a filmmaker does not attempt to seek permission or a license before using a creator’s copyrighted work, the court will find that the filmmaker acted in bad faith.
    - True.
    - False.

11. In *Gottlieb v. Paramount*, the court found that a film’s inclusion of a pinball machine in the background of a three-and-a-half-minute scene was a de minimis use.
    - True.
    - False.

12. The statutory fair use factors listed in the 1976 Copyright Act are exclusive and exhaustive.
    - True.
    - False.

13. The fair use doctrine may not be applied to cases involving music, books, or software.
    - True.
    - False.

14. If a filmmaker looks for but is unable to locate the copyright owner of a copyright-protected asset, that asset is:
   - An abandoned work.
   - Public domain.
   - An orphan work.
   - Discarded property.
   - B. Public domain.
   - C. An orphan work.
   - D. Discarded property.

15. In *Amsinck v. Columbia*, the court found that Columbia did not “copy” the plaintiff’s three-dimensional artwork when it used a mobile bearing the artwork because the mobile was different in nature from the plaintiff’s copyrighted design.
    - True.
    - False.

16. The appellate court in *Ringgold v. BET* affirmed the lower court’s holding that the defendant’s use of the poster depicting the quilt was de minimis.
    - True.
    - False.

17. The first safe harbor question asks whether the asset does which of the following with regards to the point that the creator is trying to make in the new work?
   - A. Distinguishes.
   - B. Isolates.
   - C. Presents counterarguments.
   - D. Illustrates or supports.

18. The second safe harbor question uses the following language related to the permissible amount of the unlicensed asset used in the new work:
   - A. Necessary.
   - B. Reasonably appropriate.
   - C. Reasonably requested.
   - D. Up to 50 percent.

19. The clip of John Lennon’s song “Imagine” as used in the documentary *EXPULLED* was not a fair use.
    - True.
    - False.

20. Judge Pierre Leval set the proper standard for determining the amount of an item that can be used pursuant to fair use as “reasonably appropriate” in *Authors Guild v. Google*.
    - True.
    - False.
it was categorized by the filmmakers as a “reality thriller” filmed in a documentary style. Plaintiff Threshold Media filed a copyright infringement action against defendant Relativity and the filmmakers for the unauthorized use of almost 49 percent of its song. The film’s protagonist, a young man looking for love on the internet, realizes his female correspondent is a fake by comparing a song she sent to him as something she was singing against other renditions of the same song found on the internet. Although the film has some fictional elements, the court still applied the fair use doctrine to the song “All Downhill from Here.” The court reasoned that “how Defendants chose to label their film is not dispositive as to how it should be characterized.” The court asserted that filmmakers must not feel obliged to alter the genre of their films to fall under the ambit of the fair use doctrine because “such alternatives artificially impinge upon the creative process” and “would force the filmmakers to sacrifice the film’s verisimilitude, its drama, or both.” Thus, the fair use doctrine may be applied to films despite the film’s inclusion of fictionalized elements.

**Distractions**

The three-question safe harbor approach also avoids certain distractions that have muddled the craftsmanship of some decisions and the utility of the statute for the practitioner. The language of the first statutory factor includes “whether such use is of a commercial nature or is for nonprofit educational purposes.” However, commerciality did not affect the outcome in any case found in which the defendant relied on fair use in creating a nonfiction work. Even when the use is purely for advertising or promotional purposes, the commercial component alone will not keep a court from finding fair use if it is otherwise appropriate to do so. In L.A. News Service v. CBS, for example, the defendant, Court TV, used a few seconds of the plaintiff’s footage of the beating of Reginald Denny in on-air teasers promoting its coverage of the sentencing phase for the two men who were depicted assaulting Denny in the footage. LANS had already won a lawsuit against KTLA and another against Reuters for using that footage without permission. LANS was confident when it filed an infringement action against CBS, the owner of Court TV, but LANS lost. The court noted that Court TV’s commercial use is not dispositive, but rather is just one element of the fair use analysis. After analyzing the remaining three factors, the court confirmed that the use was clearly fair use. The three-question safe harbor approach reaches the same result.

Since the fair use doctrine is seen as a rule of reason, courts have long expressed the notion that “fair use presupposes ‘good faith and fair dealing’” and have discussed a defendant’s bad faith as a factor militating against a finding of fair use. However, a deep analysis of pertinent case law reflects that this consideration is more of a distraction than a factor in the courts’ decisions. In Harper & Row v. Nation Enterprises, the U.S. Supreme Court held that the defendant’s knowing use of a purloined manuscript militates against a fair use defense. Harper & Row owned the copyrights to President Gerald Ford’s memoirs and negotiated an exclusive prepublication excerpt licensing agreement with Time magazine. Before the Time article’s scheduled release, The Nation illicitly obtained and published the most interesting and most anticipated points by way of excerpts from Ford’s unreleased manuscript. The court rejected The Nation’s ill-conceived fair use defense, reasoning that “The Nation’s use had not merely the incidental effect, but the intended purpose, of supplanting the copyright holder’s commercially valuable right of first publication.” While the defendant’s actions could not have helped, the case would have turned out exactly the same way if the court had relied solely on the four statutory factors or, for that matter, solely on the three questions—in other words, the outcome in this case would have been exactly the same whether the court had noted The Nation’s bad faith or not. The Supreme Court took the contrary stance on bad faith in Campbell v. Acuff-Rose in stating that “even if good faith were central to fair use, [defendants’] actions do not necessarily suggest they believed their version was not fair use.” In spite of this precedent, some subsequent cases have continued to cite Harper & Row as requiring courts to consider the bad faith of the defendant when going through the fair use analysis.

Plaintiffs commonly claim bad faith when defendants had not attempted to seek permission or a license before using the copyrighted work. Courts have rejected this proposition based on the language in Campbell that “[i]f the use is otherwise fair, then no permission need be sought or granted.” The court in Blanch v. Koons went even further, asserting that “we are aware of no controlling authority to the effect that the failure to seek permission for copying, in itself, constitutes bad faith.”

Some may opine that once posted on the Internet, content is available for use for anyone who happens upon it. That is not the law, and it certainly does not place the asset into the public domain or make the use of it necessarily a fair use. In the event that a filmmaker has diligently attempted to find a copyright owner in order to properly license a work but to no avail, the asset is called an orphan work, which has nothing to do with fair use. The standard tests for infringement and fair use must still be applied. Fair use analysis should be thought of as a spectrum of possibilities, with some fair uses being clearly in the safe harbor and other uses not so clearly in the safe harbor, but fair use nonetheless. Of course, there are many uses that are so far from the safe harbor as to fall on the “not fair use” end of the spectrum.

**Fictional Films Based on Facts**

Many films use real-world events in their scripted stories. Almost any war movie, for example, has a specific war as a factual starting point, and other films are very specific to a city, person, or event. These films can be thought of as hybrids because they involve real-world events that are used as a launching pads to tell fictional stories. The three-question safe harbor approach may be used in evaluating unlicensed materials used in the truthful portion of the picture.

Many independent films have relied on this logic, received errors and omissions insurance coverage, and been commercially released without a claim. Sony Pictures, however, was not so lucky after it used a famous quote from William Faulkner’s *Requiem for a Nun* in a movie titled *Midnight in Paris.* The movie, which mixes fact with fiction in its portrayal of great artists and literary figures in Paris in the 1920s, was directed by Woody Allen. Faulkner’s literary rights agency sued and lost. In the movie, the male lead, Gil, accuses his fiancée of carrying on an affair with a mutual friend. When his skeptical fiancée asks Gil where he might have gotten such an idea, Gil responds that he got the idea from “Hemingway, Fitzgerald, Gertrude Stein and Salvador Dali,” a notion that his fiancée “ridicules because they are all dead.” In response, Gil states, “The past is not dead. Actually, it’s not even past. You know who said that? Faulkner, and he was right. And I met him too. I ran into him at a dinner party.” The court found that the use of Faulkner’s famous phrase supported the movie’s point that Gil did, in fact, have a conversation with deceased authors and artists and also that the past is not dead because Gil can transport to the 1920s during the film’s 2011 setting. Thus, question one is answered in the affirmative. The court found that the amount of the copyrighted material that filmmakers used was justified, as it was of minuscule quantitative importance. This case confirms that the courts are willing to allow fair use in fictional films that are based on realistic settings. The three questions apply well to the films’ factual portions.

**Natural Settings and Soundstages**

Completely fictional films shot in natural settings can be protected by fair use as far
as their natural settings are concerned. A 1976 House Committee Report that was written to educate members of Congress about the 1976 Copyright Act stated that one example of fair use is the incorporation of a copyright-protected item in a manner that is “incidental and fortuitous.” To date, no court has defined what an “incidental” or a “fortuitous” use means in the context of fair use, so the plain language meaning of the two words are the only guide. “Incidental” means “accompanying but not a major part of something.” “Fortuitous” is defined as “happening by chance.” Applying this logic to film, the incidental and fortuitous inclusion of background settings in films fall within the doctrine of fair use. Shooting a scene on any commercial street in America could record material in the background that is under copyright. For example, the 2007 Oscar-winning musical film, Once, illuminates the point that fictional films with natural settings can be protected by fair use. The film’s protagonist plays a musician that performs in the streets and neighborhoods of Dublin. The film was largely shot on the public streets of Ireland, so many copyrighted images and murals incidentally appear in the background. Still, the film’s producers successfully distributed the film without any subsequent infringement suits.

Fictional films that are shot on a soundstage use a variety of decorative items, such as paintings or posters hung on the walls. These items may fall under fair use protection. Not many cases on this issue have been decided since 1976, but all federal trial court cases that were decided found fair use. The 1994 decision in Amsinck v. Columbia Pictures Industries, for example, involves a graphic artist, Carola Amsinck, whose pastel colored teddy bear artwork was part of a baby crib mobile. Amsinck sued Columbia Pictures for copyright infringement because her artwork in the mobile appeared in Columbia’s film Immediate Family. The Amsinck court found that Columbia did not mechanically copy the artwork and thus did not infringe upon the artwork’s copyright, because the film’s display of the mobile was different from Amsinck’s copyrighted design.

The court further reasoned that the mobile rarely visible, appearing for only seconds at a time, and was “fleeting and impermanent.” The court hypothesized that even if there was an infringement by virtue of copying the art, the defendants would be protected by fair use. The court based its fair use decision on the analysis of the four statutory factors, focusing primarily on the minimal effect that Columbia’s use has on the potential market for the copyrighted artwork.

Jackson v. Warner Bros. involves the film Made in America, a story about a single mother in whose home artwork hangs. The artwork’s creator, Earl Jackson, sued Warner Bros. The art can be seen in the background of a scene for no more than 60 seconds. In its 1997 decision, the court found that Warner Bros. was protected by fair use for a number of reasons: the paintings were only briefly displayed and never became the focus of the scene or the film; Made in America did not use the paintings in a financially exploitative way; and the film did not adversely affect the painting’s potential markets. Although Jackson would not have agreed to license the paintings to Warner Bros. because he considered the film to be culturally exploitive, the court found that he did not suffer demonstrable harm from the paintings’ use.

A 1997 case, Ringgold v. Black Entertainment Television, involved a decorative quilt called by artist Faith Ringgold. A poster of the quilt appears in the final scene of an episode of BET’s sitcom Roc. The scene takes place in a church hall, with the poster hung on the back wall of the set. Because the poster of the quilt was never shot in its entirety and not always in focus, the federal trial court in New York said the use of the quilt as set dressing was de minimis and fair use. Ringgold went to the appellate level, where it was reversed after a long and detailed discussion concerning the de minimis doctrine. The appellate court reversed the lower court’s holding, finding that the 26 seconds in which the poster was used was not de minimis.

In contrast to the Ringgold decision, however, the same appellate court reached the opposite result in considering 10 unlicensed photographs used for less than 36 seconds in a short scene in the film Seven. In the majority of the shots, actors or furniture obstructed the photographs, and the photos were never in focus. The court embraced the de minimis argument that the “photographs as used in the movie [were] not displayed with sufficient detail for the average lay observer to identify even the subject matter of the photographs, much less the style used in creating them.” The court mentioned the factors it considered to determine de minimis use: the copyrightable work may appear fleetingly, be obscured, severely out of focus, and virtually unidentifiable to be deemed de minimis. This de minimis rule may be considered in the context of nonfiction films as well.

Another example of de minimis use appears in the 2008 decision Gottlieb Development LLC v. Paramount Pictures Corporation. The case concerns Paramount’s film What Women Want and its inclusion of a pinball machine—the Silver Slugger—in the background of a three-and-a-half-minute scene. The Silver Slugger was used as set dressing and only appears for seconds at a time, always in the background, and always obscured to some extent by an actor or other set furniture. The court in Gottlieb ultimately found that the use of the Silver Slugger was de minimis because it appeared sporadically in the short scene, it was never in the focus or foreground of the scene or mentioned by the film’s characters, it played no role in the plot, and its designs were never fully visible or discernable to the “average lay observer.” Although the Silver Slugger was chosen by production staff “because it fit in with the ‘sporty’ theme of the background of the scene,” it was filmed in such a manner and appears so fleetingly that it was de minimis.

While the de minimis test and the statutory four-prong test are certainly to be considered in evaluating fair use, in the context of nonfiction filmmaking, the simple three-question test may also be applied to predict whether the use of copyright-protected materials falls within the doctrine of fair use. The three-question test may be used whether the nonfiction film is scripted or not scripted. In other words, the nonfiction film can be a live-action feature film or a documentary. Use of the three questions can clear away the complications of the four-question statutory test. Fictional films using facts as a starting point, for example, may be protected by the safe harbor if there is an affirmative answer to the three questions with regard to the factual portion of the film. Fictional films shot in realistic settings may use unlicensed materials in an incidental and fortuitous fashion. Typically this means that the material is seen fleetingly in the background of a shot. When a fictional film is shot on soundstage without a license, however, filmmakers are best advised to use a de minimis approach with regard to paintings, posters, and photographs.

2 See, e.g., Authors Guild, Inc. v. HathiTrust, 755 F. 3d 87, 95 (2d Cir. 2014).
6 Authors Guild v. Google, 804 F. 3d 202 (2d Cir. 2015).
7 Id. at 221 (emphasis added).
8 See Elvis Presley Enters., Inc. v. Passport Video, 349 F. 3d 622, 629 (9th Cir. 2003).
9 Lennon, 556 F. Supp. 2d at 316.
10 Id.
12 Id. at *4.
13 Id.
14 Id. at *6.
15 SOFA Entm’t, Inc. v. Dodger Prods., Inc., 709 F. 3d 1273 (9th Cir. 2013).
16 Id. at 1278-79.
17 Id.
18 Id. at 1279.
19 Id. at 1278.
21 Id. at 368-69.
22 Id. at 371.
24 Id.; see also Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994) (“2 Live Crew need not label their whole album, or even this song, a parody in order to claim fair use protection.”).
25 Threshold, Case 2:10-cv-09318, at 1889.
27 See, e.g., Castle Rock Entm’t, Inc. v. Carol Publ’g 150 F. 3d. 132. 141 (“No man but a blockhead ever wrote, except for money.”).
28 L.A. News Serv. v. CBS, 305 F. 3d 924 (9th Cir. 2002).
29 L.A. News Serv. v. KAL-1 TV Channel 9, 108 F. 3d 1119 (9th Cir. 1997).
30 L.A. News Serv. v. Reuters Television Int’l, Ltd., 149 F. 3d 987 (9th Cir. 1998).
31 L.A. News Serv., 305 F. 3d at 939.
32 Id. at 942.
36 Id. at 562-63 (see also Meredith Corp. v. Harper & Row, Publishers, Inc., 378 F. Supp. 686, 690 (S.D. N.Y. 1974), aff’d, 500 F. 2d 1221 (2d Cir. 1974).)
38 See, e.g., NXIVM Corp. v. Ross Inst., 364 F. 3d 471, 478 (2d Cir. 2004); Bouchat v. Baltimore Ravens, Ltd. P’ship, 619 F. 3d 301, 311 (4th Cir. 2010).
39 Campbell, 510 U.S. at n.18.
40 Blanch v. Koons, 467 F. 3d 244, 256 (2d Cir. 2006).
42 Id. at 704-05.
43 Id.
44 Id. at 710.
47 Id.
49 Id. at 1048.
50 Id.
51 Id. at 1050.
52 Id. at 1048.
54 Id. at 588-590.
55 Id. at 590.
57 Ringgold v. Black Entm’t Television, 126 F. 3d 70, 77 (2d Cir. 1997).
59 Id. at 218.
60 Id. at 217.
62 Id. at 633.
63 Id. at 634.
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FILMS AND TELEVISION shows based on real people and events have been and continue to be popular. At the 2014 Academy Awards, movies based on true stories dominated the nominations, with American Hustle, Captain Phillips, Dallas Buyers Club, Nebraska, Philomena, 12 Years a Slave, and The Wolf of Wall Street all receiving Best Picture nominations. Of those, American Hustle and The Wolf of Wall Street were subjects of defamation lawsuits, while the heroics portrayed in Captain Phillips were subject to public skepticism.

“Real life” stories are often produced with the consent and encouragement of their subjects, who are compensated in exchange for entering into what is commonly known as a life rights agreement. One of the primary benefits of a life rights agreement is that it eliminates or significantly reduces the risk of a lawsuit, especially a claim for injunctive or other equitable relief. However, obtaining permission from every real person who may be depicted in a work may not be practical or even possible. This raises the question of whether life rights agreements are legally necessary.

The term “life rights” is misleading because a person does not own the facts that make up his or her life story or a portion thereof. What a producer is purchasing when it enters into a life rights deal is permission to use and perhaps fictionalize the person’s story and to use the person’s name and likeness without the risk of claims for libel, invasion of privacy, or misappropriation of personality. In fact, often it is film financiers, distributors, and insurers that require an executed life rights agreement in order to reduce the risk of litigation or other interference with the production and distribution of the film. A life rights agreement also may secure the depicted real person’s agreement to cooperate with the producers, assist with the promotion of the film, and furnish nonpublic materials that may be helpful to the creative process.

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Although these are significant practical reasons for entering into a life rights agreement, it may not be necessary from a legal perspective, particularly if the person is deceased, is or was a public figure, has been depicted in other media, or is involved in a newsworthy topic. A life rights agreement also may be impractical if, for example, the holder of the rights demands an unreasonable fee or approval rights over various creative and business decisions. Ultimately, an analysis of the risks of liability is warranted. The most common claims are for libel, invasion of privacy, and misappropriation of personality. If the risk of liability for these claims is low, the producer may elect to produce a project without any life rights agreements.

To establish a claim for libel under California law, a plaintiff must establish that a publication, film, or television show 1) contained a false statement of fact, 2) of and concerning the plaintiff, 3) that exposed the plaintiff to hatred, ridicule, or disgrace, or that had a tendency to injure the person in his or her occupation. In a risk analysis, an important consideration is whether the work will be “of and concerning” the potential plaintiff. If the work is not going to be “of and concerning” the potential plaintiff, there may be little risk of a libel claim. To make this determination, courts ask whether a reasonable person, viewing the work, would understand that the character was, in fact, the plaintiff. Mere similarity—even identical names—is insufficient as a matter of law to establish that a work of fiction is of and concerning a real person.

Examples from cases decided in the past year are instructive. In *Blakley v. Cartwright*, the California Court of Appeal upheld the trial court’s determination that the plaintiff was unlikely to prevail on her libel claim because the similarities between plaintiff and the character played by Julianne Moore in the film *What Maisie Knew* were “tenuous.” On the other hand, in *Greene v. Paramount*, a New York court granted in part and denied in part the defendants’ motion to dismiss under Federal Rule of Civil Procedure 12(b)(6), refusing to dismiss a libel claim, finding that it was plausible that someone aware of plaintiff’s role at the company could reasonably associate the character in the film, *The Wolf of Wall Street*, with the plaintiff. Another key consideration in determining whether to enter into a life rights agreement is whether the portrayal of the subject is true. A defendant can defeat a libel action by showing that the allegedly libelous publication is substantially true. Libel claims have been defeated in cases in which no reasonable person would consider the allegedly libelous statements to be true due to the absurd nature of the content. Therefore, if the producer intends to produce a project in which the content is so absurd that no reasonable person would consider the allegedly libelous statements to be true, there is a low risk of liability of a libel claim.

Other typical claims are known as privacy torts, such as claims for false light, public disclosure of private facts, and intrusion into private matters. While these claims are similar, there are some distinctions. A false light analysis is very similar to a libel analysis.
A false light claim requires a showing that the false light in which the plaintiff was placed would be highly offensive to a reasonable person. As a practical matter, when a false light claim is coupled with a libel claim, the false light claim essentially is the same as the libel cause of action—that is, the plaintiff must establish that he or she was exposed to hatred, contempt, ridicule, or obloquy.

A claim for public disclosure of private facts requires 1) the public disclosure of 2) private facts that are 3) offensive and objectionable to a reasonable person of ordinary sensibilities, and 4) not of legitimate public concern. Newsworthiness is a complete bar to liability on this claim. Courts consider the following factors when determining whether the newsworthiness exemption applies: 1) the social value of the facts published, 2) the depth of the intrusion into ostensibly private affairs, and 3) the extent to which an individual voluntarily acceded to a position of public notoriety. The newsworthiness inquiry focuses on the particular fact that was disclosed, not on the general topic of the publication. As to public figures, the general rule is that “once a man has become a public figure, or news, he remains a matter of legitimate recall to the public mind to the end of his days.”

The tort of intrusion into private matters is the intrusion into a private place, conversation, or matter in a manner that is highly offensive to a reasonable person. The plaintiff must show that the defendant penetrated some zone of physical or sensory privacy surrounding, or obtained unwanted access to data about, the plaintiff. To establish this claim, the plaintiff must have “an objectively reasonable expectation of seclusion or solitude in the place, conversation, or data source.” As such, the collection of information from public sources, including public records or the subject’s family members or friends, are generally not actionable. However, if information is gathered by fraudulent means, such as interviews obtained by misrepresenting one’s identity and true purpose, there can be liability for improper intrusion. Given the limitations that producers face when gathering information, life rights agreements can be helpful in obtaining information that is not available to the public, while simultaneously limiting liability for improper intrusion.

A claim also may arise when a project includes the name or likeness of a real person. California recognizes both a common law and statutory right of publicity (also known as misappropriation of likeness). A defendant may be liable for a common law right of publicity claim if 1) the defendant uses the plaintiff’s identity, 2) to the defendant’s advantage, commercially or otherwise, 3) without the plaintiff’s consent, and 4) the plaintiff is injured as a result. The statutory cause of action is based upon Section 3344 of the California Civil Code and adds two elements to the common law claim: 1) knowing use of the plaintiff’s likeness, and 2) a direct connection between the defendant’s use and the commercial purpose (i.e., the use was directly connected with advertising or sales). As such, under the common law claim (as opposed to the statutory claim), liability is strict—i.e., the unauthorized use itself creates liability regardless of the user’s intent. Although most of the case law concerns celebrities, the right of publicity protects noncelebrities as well.

The right of publicity, however, may conflict with two First Amendment values. One is the preservation of the marketplace of ideas, and the other is furthering the individual right of self-expression. One approach courts have taken when facing a First Amendment defense is whether the work is expressive. Expressive works may be protected from right of publicity claims if the work of the plaintiff’s name or likeness is not wholly unrelated to the expressive work or used to promote a collateral commercial product. This holds true whether the work is factual or fictional, and regardless of whether the work is undertaken for profit.

Further, a “newsworthy” defense applies to both the common law and statutory causes of action for right of publicity. Under this defense there can be no cause of action if the work discusses matters of public interest, and the scope of matters that fall within the public interest is extremely broad. Indeed, “a publication is newsworthy if some reasonable members of the community could entertain a legitimate interest in it.” As a result, courts consistently have found that this defense extends to a wide array of subject matters, ranging from topics found in popular culture to factual news.

Courts have held that the facts concerning newsworthy persons and events is constitutionally protected and, as such, does not give rise to right of publicity liability. In Elizabeth Taylor v. National Broadcasting, a California court refused to enjoin the airing of a miniseries based on Elizabeth Taylor’s life, noting that the right of publicity should not “be used as a vehicle to stifle undesired discussion and legitimate commentary on the lives of public persons.” Similarly, in Rosemont Enterprises v. Random House, a New York court dismissed right of publicity claims arising out of the biography of Howard Hughes, explaining that because of the value in the free dissemination of ideas, newsworthy events, and matters of public interest, “a public figure can have no exclusive rights to his own life story, and others need no consent…of the subject to write a biography of a celebrity.” It is clear that if the person’s stature is well known, a court likely will find in favor of the defendant based upon the First Amendment.

With respect to noncelebrities, it is not always as clear that the newsworthy defense will apply. To make the determination, the number of public works and internet space dedicated to the subject may help determine whether the subject and their life story are newsworthy topics. For example, in Porco v. Lifetime Entertainment, a person convicted of murdering his father brought a lawsuit under New York’s right of privacy statute against a television network that intended to broadcast a film depicting his crimes and prosecution. The court dismissed the complaint, concluding that the film fell within the newsworthiness exception because the plaintiff’s trial had been covered in national news stories and featured on an episode of 48 Hours. However, a court is less likely to find the portrayal of a noncelebrity to be newsworthy if the noncelebrity was not part of any news, public affairs, sports broadcast, or political campaign.

The Ninth Circuit recently reiterated that the First Amendment provides a powerful defense for entertainment works. In Sarver v. Charter, the court expressly stated that the First Amendment “safeguards the storytellers and artists who take the raw materials of life—including the stories of real individuals, ordinary or extraordinary—and transform them into art, be it articles, books, or plays.” In Sarver, the Ninth Circuit determined that, even assuming the plaintiff (a private person, rather than a celebrity) could establish all the elements of a right of publicity claim, it was nevertheless barred by the First Amendment. In other words, the panel determined that allowing the plaintiff to pursue his right of publicity claim would infringe the defendants’ constitutional right to free speech.

With respect to the First Amendment defense, the court explained that it does not protect against a California right of publicity claim if the defendant has either 1) appropriated the economic value of a performance or persona or 2) sought to capitalize on a celebrity’s image in commercial advertisements. Having set forth the test, the court held that the First Amendment defense did indeed preclude the claims against the filmmakers behind The Hurt Locker. First, the court explained that the plaintiff had made no investment (time or money) to build up any economic value in a marketable identity. Put differently, the defendants did not exploit the “economic value” of any persona that Sarver had worked to develop. Merely living your life and working your job is not sufficient, the court explained. Second, The Hurt Locker is not speech proposing a commercial transaction.
As such, the defendants’ movie was fully protected by the First Amendment, which meant that applying California’s right of publicity law to the movie would be unconstitutional as a matter of law. The Ninth Circuit upheld the dismissal of the plaintiff’s right of publicity claim.44

Further demonstrating a producer’s First Amendment right to free expression, courts will not prohibit the use of a person’s identity in a work that meets the transformative use test. As the court in Comedy III Productions v. Saderup found, to pass that test, the work is “so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”45 The same court summarized the four-part analysis of the test in this manner: 1) If the “celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized,” it is more likely to be transformative than if “the depiction or imitation of the celebrity is the very sum and substance of the work,” 2) the work is protected if it is “primarily the defendant’s own expression” if that expression is “something other than the likeness of the celebrity,” 3) To avoid making judgments concerning the “quality of the artistic contribution,” a court should conduct a “more quantitative than qualitative” inquiry and ask “whether the literal and imitative elements or the creative elements predominate,” and 4) A “subsidiary inquiry” is whether “the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted.”46

In short, for the use to be transformative, it must not be a “literal depiction or imitation of a celebrity for commercial gain.”47 The more that the work contributes “significant distinctive and expressive content,” the more likely the work will meet the transformative use test.48 This test attempts to strike a balance between individuals’ rights of publicity and the First Amendment right to free expression.

For example, in Arenas v. Shed Media, the court agreed that the show would make use of basketball star Gilbert Arenas’s identity as a celebrity through a cast member’s discussions about her previous relationship with Arenas. The court found, however, that any such use would be transformative,49 reasoning that “any references in [the show] will be incidental to the show’s plot as a whole. At its core, the show is about the women who have or have had relationships with basketball players rather than the players themselves. Thus, the show appears to be transformative.”50 Thus, any proposed television series will likely not violate the subject’s or others’ rights of publicity provided, like in Arenas, the work contains creative and expressive elements sufficient to render it “transformative.” Specifically, if viewers watch the television show or film because they are interested in the overall subject matter, content, and the creative contribution of the program, rather than the person per se, the more likely the work will not violate another’s right of publicity.

Similarly, parodies are not actionable under the right of publicity claim.51 Parodies and distortions of celebrities are not good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect.52 Thus, a life rights deal is not necessary for parodies. Finally, incidental use of a name or likeness does not give rise to liability for the right of publicity claim.53 The rationale is that an incidental use has no commercial value and, thus, allowing anyone briefly depicted would unduly burden expressive activity.54 Whether the incidental use doctrine is applicable is determined by the role that the use plays with respect to the entire work, namely: 1) whether the use has a quality or value that would result in commercial profit to the defendant, 2) whether the use contributes something of significance, 3) the relationship between the reference to the plaintiff and the purpose and subject of the work, and 4) the duration, prominence, or repetition of the name or likeness relative to the rest of the publication.55 Thus, to the extent that there is only incidental use regarding a subject, the producer likely does not need to obtain a life rights deal from that subject.

Some of the foregoing rights and claims are extinguished upon the death of the claimant, while others survive. Claims for defamation do not survive the death of the person allegedly defamed.56 Thus, there is no risk of defamation claims arising from the depiction of deceased subjects, unless the subjects’ living heirs or relatives establish that defamation of the deceased subject somehow harmed their own reputations. As with defamation claims, no claim for invasion of privacy can be made on behalf of deceased subjects.57 However, to the extent that the producer intends to portray the deceased subject’s living relatives or close associates, who may not be public figures, there should be attention to where and how information about those living persons is obtained, i.e., obtained from publicly available sources or from consenting individuals without deceit.

Unlike defamation and privacy torts, assuming that the subject was domiciled (not just present) in California at the time of death, the subject’s postmortem right of publicity does not expire until 70 years after death.58 However, many localities (such as New York) do not recognize a postmortem right of publicity.59 For example, in Diana Princess of Wales Memorial Fund v. Franklin Mint, because Princess Diana’s domicile at the time of her death was England, which does not recognize the right of publicity, no right of publicity could pass to her estate upon her death.60 Accordingly, depending on the subject’s domicile at the time of death, the subject’s death itself does not foreclose a claim by the heirs or the estate for violation of the subject’s right of publicity—which may be another reason to obtain a life rights agreement.

While there may be benefits to securing life rights, those rights are not always necessary. Instead, if not legally required, the producer should weigh the risks and benefits before entering into a life rights agreement, including an analysis of the potential claims which may be asserted if an election to proceed is made without obtaining life rights. If the risks are low, the producer has the opportunity to avoid paying for unnecessary rights which could come with significant headaches.

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2 Misappropriation of personality encompasses the right to prevent commercial uses of one’s name, voice, likeness, or image. 3 Civ. Code §45; Blatty v. New York Times Co., 42 Cal. 3d 1033, 1042 (1988).
5 Aguilar, 174 Cal. App. 3d at 388; see also Tamkin v. CBS Broad., Inc., 193 Cal. App. 4th 133, 137-38 (2011) (fictional characters’ portrayals were not “of and concerning the plaintiffs,” despite use of plaintiffs’ actual first names, in light of the absence of any uniquely identifiable traits that were shared by both fictional and real characters); Springer, 90 A.D. 2d at 316 (libel claim dismissed as a matter of law because any alleged similarities between fictional character and plaintiff were superficial and dissimilarities “negat[e]d any suggestion that characters were the same). 6 Blakley v. Carrwright, No. BC543217, 2015 WL 556386, at *5-7 (Cal. Super. Ct. June 20, 2015) (granting anti-SLAPP motion based in part on the differences between the stories of the plaintiff and the character, despite the similarities).
8 Wynberg v. Natl Enquirer, Inc., 564 F. Supp. 924, 927 (C.D. Cal. 1982) (granting summary judgment on libel claim because published statements characterized plaintiff as a person who financially exploited his relationship with a celebrity were substantially true); Campanelli v. Regents of U. of Cal., 44 Cal. App. 4th 572, 582 (1996) (affirming dismissal of libel claim concerning statement by player’s father that player was “in trouble psychologically,” which was deemed true since coach admitted he had temper tantrums towards his players which included verbally abusive and profane remarks); see also Guccione v. Hustler Magazine, Inc., 800 F. 2d 298, 304 (2d Cir. 1986) (truth of statement that publisher was living was not a valid argument); see also Gruenke v. Hustler, Inc., 800 F. 2d 298, 304 (2d Cir. 1986) (truth of statement that publisher was living with another woman while he was still married provided basis for granting summary judgment on libel claim to Hustler).
Da Ali G. Show not libel).
10 See M.G. v. Time Warner, Inc., 89 Cal. App. 4th 623, 636 (2001) (“A ‘false light’ claim, like libel, exposes a person to hatred, contempt, ridicule, or obloquy and assumes the audience will recognize it as such.”).
12 M.G., 89 Cal. App. 4th at 636.
14 Id. at 717-18 (statements at conference by author of academic article criticizing theory of repressed memory of childhood abuse were newsworthy); Wilkins v. National Broad. Co., Inc., 71 Cal. App. 4th 1066, 1084-86 (1999) (public disclosure of private facts claim was barred by fact that names, voices, and occupations of salesmen were newsworthy, as broadcast regarding salesmen that charge for so-called free 800 lines without knowledge of person billed was of legitimate public concern).
15 Doe v. Gangland Prods., Inc., 730 F. 3d 946, 859 (9th Cir. 2013) (depiction of identity of former gang member in documentary on gangs was not a topic of legitimate public concern when it threatened his life); Mahau v. CBS, Inc., 201 Cal. App. 3d 662, 675 (1988) (public disclosure of private facts about Howard Hughes was newsworthy); M.G., 89 Cal. App. 4th at 632-36 (television network’s showing team photo in stories about adult coaches who molest youths playing team sports not newsworthy despite the fact of players’ membership on child molester’s team).
16 Gangland, 703 F. 3d at 946.
18 Taus, 40 Cal. 4th at 724-25.
20 Taus, 40 Cal. 4th at 724-25; Shulman, 18 Cal. 4th at 232 (affirming that plaintiffs had no reasonable expectation of privacy at an accident scene, which was within sight and hearing of the public).
21 Taus, 40 Cal. 4th at 707.
22 Id.
24 CIV. CODE §3344.
25 CAL. BUS. & PROF. CODE §334; see Downing v. Abercrombie & Fitch, 265 F. 3d 994, 1001 (9th Cir. 2001) (right of publicity claim brought by surfers portrayed in Abercrombie’s catalog).
27 Id. at 865-66.
28 Id. at 865 n.6.
29 Id. at 868.
32 Shulman, 18 Cal. 4th at 225; Dora, 15 Cal. App. 4th at 546 (“[T]he public is interested in and constitutionally entitled to know about things, people, and events that affect it.”).
881 F. Supp. 2d 1181, 1191-92 (C.D. Cal. 2011) (A celebrity’s family life was a matter of public concern).


37 Id.


39 Sarver v. Chartier, 813 F. 3d 891, 905 (9th Cir. 2016).

40 Id. at 906.

41 Id. at 905.

42 Id.

44 The court also dismissed the plaintiff’s claims for defamation, false light invasion of privacy, and intentional infliction of emotional distress. Id. at 906-07. The court reasoned that the overall (alleged) depiction of the plaintiff in the movie was not defamatory or highly offensive to a reasonable person. Id.

45 Comedy III Prods., 25 Cal. 4th at 406.

46 Id. at 406-07; see also Pierre N. Leval, Toward a Fair Use Standard, 103 Harv. L. Rev. 1105 (1990).


48 Sarver, 2011 WL 11574477, at * 6-7 (The Hurt Locker was transformative because the defendants contributed distinctive and expressive content to the character, and significant original expressive content was inserted through the writing, production, and direction of the film); Moore v. Weinstein Co., LLC, 545 Fed. Appx. 405, 406-07 (6th Cir. 2013) (Film “added significant expressive elements.”).


50 Id. at 1191.


52 Id. at 888.


54 Id.

55 Id. at *3.

56 Flynn v. Hgham, 149 Cal. App. 3d 677, 680 (1983) (“[l]ibel on the memory of a deceased person is not deemed to inflict on the surviving relatives of the deceased any such legal damage as will sustain a civil action for the defamation”); accord Meropol v. Nizer, 381 F. Supp. 29, 39 (S.D. N.Y. 1974) (Under New York law, “no person, not even a close relative or descendant, can bring an action for defamation of a deceased person…except…in those comparatively rare instances where a living relative is able to show that his reputation is damaged by the defamation of the deceased.”).

57 Flynn, 149 Cal. App. 3d at 683.

58 CIV. CODE §3344.1.

59 Frosch v. Grosset & Dunlap, 75 A.D. 2d 768, 768 (N.Y. Sup. Ct. 1980).

ENFORCING COPYRIGHTS in sculptural works of fine art entails elements shared with other works of authorship eligible for protection under federal copyright law as well as issues peculiar to the nature of fine art. In the first instance there are established shared standards, including the statutes of limitations, proper notice and registration of copyright, the different types of infringement (e.g., direct, vicarious, etc.), and measures of damages. However, even within these broad categories claims for infringement of copyright in sculptural works of fine art encounter special nuances in copyright law. Some of the unique legal issues that arise in connection with these claims include the size of the work and the tendency of sculptures to be published in limited editions or as one-of-a-kind pieces. Recently, a pair of related cases, Wakefield v. Olenicoff¹ and Raimondi v. Olenicoff,² have highlighted the issues involved in copyright infringement of large-scale sculptural works of fine art.

In Wakefield, the plaintiff Don Wakefield is a professional artist and sculptor who creates one-of-a-kind works of sculptural and mixed media fine art. In Raimondi, the plaintiff John Raimondi is a professional sculptor who fabricates monumental sculptures in limited editions. The named defendant in each case, Igor Olenicoff, has been reported as both a billionaire real estate developer on the Forbes 400 list³ and a “notorious tax cheat” who pled guilty to hiding over $200 million offshore from the IRS.⁴ The other defendant, Olen Properties Corp. (Olen), is a company founded by Olenicoff that owns, manages, and leases commercial real estate throughout California, Florida, and Illinois, as well as numerous residential apartment communities.⁵

In 2014, both cases were tried before juries in the Central District of California. In Wakefield, the jury found the defendants liable for direct, vicarious, and contributory copyright infringement of the sculpture Untitled and awarded the plaintiff $450,000 in actual damages.⁶ In Raimondi, the defendants admitted infringement of the sculptures Ceres and Dian, and the case was tried solely on the issue of damages; the jury similarly awarded the plaintiff $640,000 in actual damages.⁷ Some of the contested issues were the statute of limitations, actual damages, and indirect damages. Although these issues are currently on cross-appeal to the Ninth Circuit in Wakefield, the application of copyright law in these cases is exemplary of some of the particular legal challenges faced in

Copyright claims involving large, one-of-a-kind sculptural works involve distinctive challenges.
attempts to protect and enforce copyrights in sculptural works of fine art.

**Sculptural Works and Copyright Act**

Protection under U.S. copyright law for sculptural works can be traced back as far as 1865, with works of fine art being afforded specific protections under the omnibus revision of the Copyright Act of 1870. Sculptural works were then incorporated into Section 5 of the Copyright Act of 1909, which still provides the governing law for pre-1978 claims. At present, Section 102(5)(a) of the 1976 Copyright Act (the Copyright Act) includes “pictorial, graphic and sculptural works” as a specific category of works of authorship eligible for copyright protection. This category includes two- and three-dimensional works of fine, graphic, and applied art.

In a claim for the infringement of a copyright in a sculptural work of fine art the plaintiff must prove two essential elements: 1) the plaintiff’s ownership of a valid copyright and 2) copying of the elements of copyrighted work that are capable of being protected under the Copyright Act. The Ninth Circuit has held that the word “copy” is a term of art encompassing any activity that may infringe any of the copyright owner’s exclusive rights. While these elements are no different than those needed to prove infringement in any other category of authorship, there are some unique aspects when dealing with fine art that has been published in limited editions or as one-of-a-kind pieces.

**Notice and Registration**

Contrary to other types of copyrighted works, when dealing with sculptural works that were published before March 1, 1989, there is an increased risk that these works have been unwittingly thrust into the public domain and lost all copyright protection by failing to comply with notice requirements. Proper copyright notice for works reproduced in three-dimensional copies requires “a notice affixed directly, durably, and permanently to: [a]ny visible portion of the work; [or a]ny base, mounting, or framing or other material on which the copies are durably attached.” If an author finds it impractical to affix the notice to the sculpture in this manner, “a notice is acceptable if it appears on a tag or durable label attached to the copy so that it will remain with it as it passes through commerce.”

A sculpture’s date of publication is vital to determining whether it is protected by copyright. The Copyright Act defines publication as the distribution of copies...of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies...to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication. For a sculpture that was first published prior to January 1, 1978, failure to include the proper copyright notice would mean that the work was thrust into the public domain, permanently losing all copyright protection therein. The notice requirement also applies to sculptures published between January 1, 1978, and March 1, 1989, with the caveat that an omission or error in the notice requirements could be corrected if the work was registered before it was first published without proper notice or if the work was properly registered with the Library of Congress within five years after the date of publication without proper notice. In addition, no corrective steps needed to be taken if such omission “violated an express written requirement that published copies...bear the prescribed notice” or proper notice was omitted from a small number of copies distributed to the public. However, the latter safeguard does little good for authors of sculptural works, who often only produce sculptures in limited editions or as one-of-a-kind pieces.

For a sculpture first published on or after March 1, 1989, the omission of proper notice does not affect copyright protection because the implementation of the Berne Convention essentially makes copyright notice optional. However, authors would be wise to continue to place proper copyright notices on all sculptural works since the notice can play a factor in determining damages in an infringement action by limiting a defendant’s ability to assert a defense of innocent infringement. In addition to potentially correcting an omission of proper notice and maintaining copyright protection, the Copyright Act provides significant benefits to having a timely registered work. Registration is a prerequisite to a prevailing copyright plaintiff’s recovering attorneys’ fees. Attorney’s fees in these cases are often substantial and easily reach six figures. In addition, statutory damages may be elected at any time before judgment is entered in the case. These damages range from $750 to $30,000 for each infringement, and may be increased up to $150,000 in cases of willful infringement. More importantly, actual damages may be difficult to prove with sculptural works of fine art, and statutory damages provide a safety net in not having to prove any actual damages. In order to receive these benefits, however, an unpublished work must have been registered before infringement occurs, and in the case of published works, it must have been registered within the earlier of 1) three months of publication of the work, or 2) one month after the copyright owner has discovered the infringement.

**Statute of Limitations**

Sculptural works of fine art face unique statute of limitation challenges. Under the Copyright Act the statute of limitations is three years from the time the claim accrued. A claim of copyright infringement accrues when a prospective plaintiff knew or should have known that his or her work was infringed. In a claim for infringement, it is a question of fact whether the plaintiff will be charged with knowledge (i.e. should have known) of a claim if the plaintiff had information that would prompt a reasonable person to perform an investigation that would lead to discovery of the infringement. Depending upon the facts, knowledge of one infringement or potential infringement may place a duty on the plaintiff to search for other infringements.

When dealing with sculptural works, the determination of when a claim accrues for multiple infringing copies may be difficult, especially when the original sculpture was created in a large scale, like the monumental sculptures in Raimondi, or in a medium that is difficult to work with, like the granite sculpture in Wakefield. If the sculpture is of a scale or medium that is unlikely to be mass-produced, the discovery of one copy may not lead a copyright holder to believe that there are other copies in existence. Unlike with consumer goods such as CDs, DVDs, and T-shirts, or even works of fine art such as paintings or prints, a particular sculpture may not be the type of work that can easily be reproduced at all, let alone multiple times. For example, Wakefield concerned a large-scale work sculpted out of a single piece of granite. It took Wakefield five months of full-time work to create the piece, which was eventually completed and shipped to a resident in Chicago as a gift in 1992. In 2008, Wakefield discovered what he believed to be his original sculpture in Newport Beach, California. Wakefield was surprised it had been moved from Chicago and went to see it at what turned out to be defendant Olen’s headquarters. While photographing the sculpture for his portfolio, Wakefield had a brief discussion with an Olen employee, who disputed that Wakefield was the author. Wakefield disagreed with him and left convinced that it was his original work. He was not until 2010, when he discovered six further infringing copies among several of Olen’s commercial properties, that he realized that the Newport Beach sculpture was also a copy. Wakefield filed suit in 2012.

The District Court held that Wakefield’s claim of infringement in connection with the Newport Beach sculpture was barred by the three-year statute of limitations. While the
District Court accepted that Wakefield did not believe that the Newport Beach sculpture was an infringing copy until 2012, the District Court ruled that Wakefield should have known earlier. The District Court reasoned that Raimondi has sufficient knowledge to prompt further investigation because he knew the original had been initially shipped to Chicago and not Newport Beach, coupled with the dispute Wakefield had with the Olen employee about its authorship.

However, the District Court held that the claims of infringement in connection with the six later-discovered copies were not time-barred because the original was a large unique work, not the type of art that is normally mass-produced, and Wakefield should not have been charged to scour the defendants’ many properties located in multiple states in search of infringing copies. Both holdings are the subject of cross-appeals to the Ninth Circuit, whose decision will likely be instructive on the accrual of claims in these types of sculptural works. In the meantime, sculptural copyright holders and their counsel would be well advised to diligently investigate any potentially infringing activity they discover.

Proving Damages

The Copyright Act expressly provides for a plaintiff to recover both actual damages and a defendant’s profits from the infringement that are not included in the calculation of actual damages. Actual damages are usually determined by the loss in the fair market value of the copyright, measured by the profits lost due to the infringement or by the value of the use of the copyrighted work to the infringer. There is no presumption that actual damages are a “natural and probable result” of infringing activity. Instead, the plaintiff bears the burden of establishing a causal nexus between the infringement and actual damages.

To obtain actual damages, a plaintiff must prove “the extent to which the market value of a copyrighted work has been injured or destroyed by an infringement.” A plaintiff may establish this by evidencing either lost profits or a “hypothesized lost license fee.” Lost profits may be available, for example, for an artist who sells multiple editions of sculptures and experiences lost sales as the result of infringing activity. For one-of-a-kind or limited edition works of fine art, however, it may often be the case that the infringement takes place after the author has sold the work or placed it in a museum or gallery. This was the case in Wakefield, in which the sculpture was a one-of-a-kind original work, was given as a gift, and Wakefield testified that he had no intention of producing other copies or editions.

If lost profits are unavailable, a plaintiff may still establish a hypothetical lost license fee. In the Ninth Circuit, this is demonstrated through “the amount that a willing buyer would have reasonably been required to pay a willing seller at the time of the infringement for the use made by the defendants of the plaintiff’s work.” Typically, a “license price is established through objective evidence of benchmark transactions, such as licenses previously negotiated for comparable use of the infringed work, and benchmark licenses for comparable uses of comparable works.”

In Wakefield, the District Court held that the fair market value of the finished sculpture at the time of infringement did not sufficiently evidence a hypothetical lost license fee. Instead, the court found that Wakefield should be required to demonstrate the value of a license fee for the copyright itself, separate and apart from its embodiment within the sculpture, to create an exact copy (both in size and medium) as the original for public display. Further, despite case law to the contrary in the context of other copyrighted works, the court held that Wakefield’s testimony was insufficient to evidence the value of his own copyright.

Thus, the District Court made it clear that expert testimony is required to value the copyright in such works. However, even the use of expert testimony may be problematic for sculptors who have no sales history or create only one-of-a-kind works for which there is no comparable license fee. Ultimately, proving any actual damages may be an uphill battle for a copyright plaintiff, which underscores the importance of registering the work early to make statutory damages available.

To obtain a defendant’s profits, a plaintiff need only show a defendant’s gross revenue earned from the infringement. The plaintiff must demonstrate a causal nexus between the infringements and the defendants’ gross revenues. The burden then shifts to the defendant to evidence expenses that should be deducted, but if infringing sculptures are merely displayed (i.e. not sold), the damages will not be available as direct damages. This was the case in Wakefield and Raimondi; the defendants displayed multiple copies of infringing works among several commercial properties located throughout Southern California but never sold the copies. In such instances a plaintiff may seek to recover indirect damages.

The Copyright Act provides that a plaintiff may recover indirect damages attributable to an infringement in addition to actual damages, and these damages can be substantial. For example, a plaintiff whose copyrighted music made up a small portion of a musical revue at a Las Vegas casino was able to recover a portion of the defendant’s profits earned from sales of tickets for that show and a smaller portion of profits earned by the entire gaming facility, including the casino and hotel, during the time that the copyrighted music was used.

Similar to obtaining a defendant’s profits, to prove indirect damages a plaintiff first has the burden of establishing a causal nexus between the infringement and the defendant’s gross revenue. This causal nexus must be supported by evidence that the gross revenue is related to the infringement in a legally significant manner, and speculative evidence is insufficient. As this sort of knowledge is generally outside the experience of the average person, an expert witness should be sought to provide this evidence. It is imperative that the expert directly address the amount of revenue generated by the infringement, since the courts will not deduce this amount from mere evidence of the total profits earned by a defendant. Once this causal nexus is established, the burden shifts to the defendant to show what part of the revenue did not result from their infringement.

In Wakefield and Raimondi, the plaintiffs’ indirect damages expert opined that a certain percentage of the defendants’ gross revenue from leasing its commercial properties in which the infringing sculptures were located was attributed to the infringing sculptures. On summary judgment, however, the District Court held that the expert’s opinions were too general, and thus the plaintiff had not met his burden in establishing the causal nexus between the infringing works and the defendants’ leasing revenues. This holding is currently on appeal to the Ninth Circuit in Wakefield but is instructive as to the level of specificity judges look for before allowing the issue of indirect damages to proceed to a jury.

As exemplified by the issues encountered in the Wakefield and Raimondi cases, the nature of sculptural works of fine art presents unique and challenging issues when attempting to protect and enforce their copyrights. These challenges are amplified when dealing with works that have only been published in limited editions or as one-of-a-kind pieces. Accordingly, in addition to the timely proper registration of their copyrights, authors and copyright practitioners should be diligent in both policing and enforcing their intellectual property.

5 Id.
Wakefield, No. SACV122077AG (RNBx), 2015 U.S. Dist. LEXIS 43274, at *4.
8 2 PATRY ON COPYRIGHT §3:122 (2016).
9 Id. at §3:98.
10 Id. at §3:99.
11 2 NEWER ON COPYRIGHT §0V (2015).
14 Feist Publ’ns v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991); see also Swirsky v. Carey, 376 F. 3d 841, 844 (9th Cir.2004).
15 S.O.S., Inc., v. Payday, Inc., 886 F. 2d 1081, 1085 n.3 (9th Cir.1989).
18 Id.
20 See, e.g., Lifshitz v. Waller Drake & Sons, Inc., 806 F. 2d 1426, 1432-34 (9th Cir.1986).
21 CIRCULAR 3, supra note 17.
22 Id.
28 Roley v. New World Pictures, Ltd., 19 F. 3d 479, 481 (9th Cir. 1994).
29 See Polar Bear Prods., Inc. v. Timex Corp., 384 F. 3d 700, 707 (9th Cir. 2004).
30 Fahmy v. Jay-Z, 835 F. Supp. 2d 783, 790 (C.D. Cal. 2011) (citing Pinay v. Andrews, 238 F. 3d 1106, 1109-10 (9th Cir. 2001)).
31 See, e.g., Fahmy, 835 F. Supp. 2d at 790 (holding that, upon learning that the song “Big Pimpin” infringed plaintiff’s song, plaintiff reasonably could have discovered that the acoustic version of “Big Pimpin” and the экспли- tive-free version of “Big Pimpin” also infringed).
33 Polar Bear, 384 F. 3d at 708.
34 Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc., 772 F. 2d 505, 513 (9th Cir. 1985).
35 Id. at §12.
36 Polar Bear, 384 F. 3d at 708-09.
37 Id.
38 17 U.S.C. §504(b); Wall Data v. Los Angeles County Sheriff’s Dept., 447 F. 3d 769, 787 (9th Cir. 2006).
42 Polar Bear, 384 F. 3d at 711.
44 Id.
45 Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc., 886 F. 2d 1545, 1550 (9th Cir. 1989).
46 Polar Bear, 384 F. 3d at 711.
47 Id. at 711-12.
48 Mackie v. Rieser, 296 F. 3d 909, 915-16 (9th Cir. 2002).
50 Polar Bear, 384 F. 3d at 711.
Narrative of My Captivity among the Sioux Indians

By Fanny Kelly
Wilstach, Baldwin, 1871
$0.99 (Kindle), 196 pages

History often presents stories about books that rival those of the books themselves. Fanny Kelly’s nonfiction book is a harrowing first-person account of capture, survival, and escape. The reserved and refined Victorian-era voice of *Narrative of My Captivity among the Sioux Indians* often starkly contrasts with the facts she recounts. Although her months of captivity were highly distressing, they did not involve years of intellectual property litigation, a sad epilogue that may, to contemporary readers, overshadow that of her book.

On July 12, 1864, five wagons were crossing the Wyoming territory on their way to the Montana gold fields. As the wagons crossed Little Box Elder Creek, they were met by 250 Sioux Indians. Not long after, arrows and bullets began to fly, and the Sioux took as captives 19-year-old Francis “Fanny” Wiggins Kelly, her seven-year-old adopted niece Mary, Sarah Larimer, and Sarah’s son Frank. Fanny arranged for Mary’s escape by leaving a trail of small pieces of paper behind to guide Mary back to safety. The day after Mary’s escape, a rescue party saw the child signaling from a ridge, but fearing an ambush left and returned the next day, finding Mary’s remains pierced by three arrows, scalped, and partially eaten by animals. (At the time, removing scalps, fingers, breasts, and other body parts from murdered women and children was not uncommon among the Sioux and U.S. troops who attacked innocents with orders to take no prisoners and retain proof of death.) Sarah and Frank, who had obtained Fanny’s promise not to escape without them, escaped next, abandoning Fanny, who escaped a little more than five months later, having endured beatings, starvation, and death threats.

**Fraud and Plagiarism**

After their escape, Fanny and Sarah Larimer orally agreed to write a manuscript of their experiences together. The manuscript, however, was written entirely by Fanny. After Fanny’s husband Josiah died of cholera and Fanny gave birth to a son, Sarah and William Larimer invited Fanny and her newborn child to come and live with them in Wyoming. In May 1869, Sarah Larimer secretly took Fanny’s manuscript to Philadelphia, claimed it as her own, and arranged for it to be published under a different title. Fanny sued Sarah and William Larimer for fraud in Kansas and won $5,000 in damages. The Larimers appealed twice to the Kansas State Supreme Court. (The cases are *Larimer et al. v. Kelly* and *Wm. J. Latimer v. Fanny Kelly*.)

In the first appeal, the Kansas Supreme Court remanded the decision to the Allen County District Court, which affirmed the trial court decision. The second appeal was made on the grounds that Kelly had not properly established the value of the manuscript at trial. The Larimers argued that the damages were calculated incorrectly because Fanny’s experts testified to the value of the novel had it been published in 1870, rather than its value when Kelly stopped working on it in 1869. Further, because Sarah Larimer planned to finance the publishing, she demanded publishing costs be deducted from the verdict and that the true damages should have been half the value of the manuscript when Fanny stopped working on it in 1869, less publishing costs.

When the case reached the Kansas State Supreme Court, the Larimers argued that no partnership existed between Sarah and Fanny and that Sarah was incapable of making a contract because she was a *feme covert*, or a married woman who did not earn money from her own trade or business. The Larimers also argued that under the doctrine of coverture Fanny was incapable of making a contract because she was married, and that the Kansas Statute of Frauds voided any agreement because the book was not published within one year.

The court disagreed, observing that there was no evidence that the parties agreed the book would not be completed within a year and because the manuscript could have been completed within a year, it fell outside the statute of frauds. In response to defense claims grounded on the status of women as *femae coetares*, Fanny asserted that under the Married Woman’s Act of 1859, married women could act as responsible parties for the product of their own labor or services, and thus could legally contract for that labor or service. The demurrer to the statute of frauds defense was sustained, but the amount of damages was remanded to the trial court for a recalculation.

After changing venue, the court found again in Fanny’s favor but reduced Fanny’s damages from $5,000 to $285.50, half of the value of the manuscript when it was stolen by Sarah in 1869. The Larimers appealed once more, this time because they believed that a number of the jurors were drunk when they made their decision. The court quickly struck down the appeal for failing to prove that jurors had drunk any alcohol, or that, assuming they were drunk, intoxication had affected their judgment. The Larimers were charged $2,000 in legal fees and ordered to pay Kelly $285.50 in damages. The bitter contest continued until 1876, when the parties reportedly reached a settlement. Fanny remarried in 1880, moved to Washington, D.C., and was a moderately wealthy woman when she died in 1904.

*Narrative of My Captivity among the Sioux Indians* thus reaches contemporary readers as several stories at once. It is a stirring first-person account of trauma and survival, and it is an example of the captivity narrative—which was an American literary staple from the seventeenth to the nineteenth century and is now a field of research into this country’s history, ethnography, and ideology. Similarly, the legal troubles that Kelly endured as a woman and author are telling not only for what they reveal of the past but also of the present.

Greg Victoroff handles copyright and art law transactions and litigation, including book publishing, plagiarism, and Native American Grave Repatriation Act matters. He has studied and collected Native American art for over 50 years.
Finding New Perspectives on Time to Help Improve Productivity

A CONSISTENT TOPIC IN COACHING sessions with attorneys is that of time management. A busy attorney may have such perspectives on time as “time is money,” “there is not enough time,” and “there is not enough time to do everything I need to do.” It seems that attorneys live in a world that never allows a moment in which we have finished everything on our to-do list. This perception of time informs our experience of it, and changing that perception can likewise change our experience of it. While it may be beyond human power to turn back the clock, it is possible to train ourselves to consider time in more useful ways.

As Jill Bolte Taylor, a brain scientist, observes in her book My Stroke of Insight: “[O]ur minds are highly sophisticated ‘seek and ye shall find’ instruments. We are designed to focus on whatever we are looking for. If I seek red in the world then I will find it everywhere.” In addition, another brain expert, Norman Doidge, points out that there is substantial evidence that we can effectively rewire our brains with our thoughts. Brains can be reprogrammed like computers. As Judith Horstman, puts it in her article “Brave New Brain” in Scientific American, “Your brain is the most modifiable part of your whole body.” Just as stroke victims can learn to speak again, so too can attorneys facing time management challenges learn to deal with them more effectively.

Similarly, just as an attorney may hear a potential client’s impassioned story neutrally, when an attorney comes as a client to a counseling session to discuss a topic, that topic is neutral. The way the client is describing the topic in that moment, however, is not likely to be neutral. The client may be stuck in his or her perception of the topic, requiring us to reconsider the topic from various angles. This may involve exploring the current viewpoint, then brainstorming some different viewpoints. The goal is to arrive at a perspective that is more affirming for the client to adopt.

A busy attorney’s perspective on time may be that it is in perpetual shortage. As a first step toward reviewing this perception, one may think of viewpoints as pairs of sunglasses. What images come to mind when hearing that “time is money”? How does your body react to “there is not enough time”? Do the glasses feel good, bad, or neutral? This process can reveal our beliefs to ourselves, and once we recognize how our brains are programed, we can begin to reprogram them. Our beliefs shape our reality, and we may consciously choose a more positive and effective mindset.

We can become more effective when we review and revise our thinking about time. We all have the same number of hours, minutes, and seconds in the day. What differentiates us is how we spend that time. In making choices, we necessarily have to say yes to some things and no to others, including stress, procrastination, and worry. Time management thus involves priorities and boundaries. One well-known way to begin to mark boundaries is to make a to-do list. Once it is made, it may be reordered by priority. The project that feels the most challenging, or that you want to put off is the one to put at the top of the list.

Another way to set boundaries is to turn everything off or otherwise take conscious steps to decrease the number of things making claims on your time. Turn off your cell phone and hold all calls. Clear everything from your desk other than what you are working on. The next step may seem counterintuitive, but reprogramming one’s perceptions of time requires doing things that challenge those perceptions. Work on the one task at hand in short increments.

(These may be, for example, 40 to 50 minutes or less. It may be a pleasant surprise how much of the matter can be dealt with when other claimants on one’s time, such as the telephone or e-mail, are not allowed to intrude.) Another possibly counterintuitive step: give yourself at least a 15-minute break between increments. It helps to leave your desk and go outside, run a quick errand, grab something to drink, or otherwise move your body. It rejuvenates the brain (and your ability to pay attention) if you switch environments even for a short time. These 40- to 50-minute increments can be strung together as much as you need throughout the day. Make sure that you focus solely on the task during that entire time, then step away from the task and take a break. Unless there is a deadline, do something completely different in the next increment.

Setting conscious time boundaries around our work day is a way to make self-care a priority, which can increase our efficiency. Adequate sleep, exercise, and play can also boost energy levels and concentration. Making health and happiness a priority will reduce resentment, and productivity is optimized when we are completely present and fully engaged. When we are in a good frame of mind and our needs have been met, we can get more accomplished in two hours than in four.

When we think that something is unalterable reality, even if it is the nature of time, we may be limiting ourselves. We can rewrite our thinking. Every time we learn new things, we are reminded that the brain is the most adaptable part of our bodies. As attorneys who bill by the hour and face filing deadlines, it is part of our professional development to teach ourselves to make the most effective use of time, even if that means seeming to slow down a little.

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