

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK (SYRACUSE)

JAMES BASS,

Plaintiff,

- against -

SYRACUSE UNIVERSITY

Defendant.

Case No.: 5:19-CV-566-TJM-ATB

**MEMORANDUM OF LAW IN SUPPORT OF PLAINTIFF'S MOTION FOR
PARTIAL SUMMARY JUDGMENT ON LIABILITY AGAINST DEFENDANT FOR
COPYRIGHT INFRINGEMENT**

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PRELIMINARY STATEMENT

This is a copyright infringement action involving a private university's unauthorized use of copyrighted photographs of Syracuse basketball players on a commercial billboard (the "Photographs").

Plaintiff James Bass ("Plaintiff" or "Bass") is a professional photographer who took photographs of Syracuse University basketball players in September of 2018.

Defendant Syracuse University ("Defendant" or "Syracuse University") is a private university which claims that it had a license to re-publish the Photographs on a commercial billboard. However, the license which Plaintiff granted to Defendant only included use on social media, but did not extend to a commercial billboard.

Plaintiff readily proves the two elements of his infringement action, namely: (1) ownership of a valid copyright; and (2) copying without authorization. Moreover, Defendant cannot show that it had license authority to re-publish the Photographs on a commercial billboard. Further, Defendant's boilerplate affirmative defenses, such as failure to state a claim, waiver, estoppel, laches and ratification should be summarily dismissed for lack of sufficient evidence.

In sum, the Court should GRANT Plaintiff's motion for partial summary judgment against Syracuse University on the issue of liability for copyright infringement with respect to the two Photographs at issue on this motion.

UNCONTROVERTED FACTS

Plaintiff James Bass

Bass is a professional photographer who is in the business of licensing his work for a fee.
[Plaintiff's Statement Pursuant to Local Rule 7.1(a)(3) ("7.1") ¶ 1]

Defendant Syracuse University

Syracuse is a private university with address at 900 South Crouse Avenue, Syracuse, New York 13244. [7.1 ¶ 2]

The Photographs of Syracuse Basketball Players – September 21, 2018

Plaintiff photographed members of the 2018 Syracuse basketball team, specifically Oshae Brissett (Player #11) and Tyrus Battle (Player #25) (the “Photographs”). [7.1 ¶ 3]

Plaintiff is the author of the Photographs and has at all times been the sole owner of all right, title and interest in and to the Photographs, including the copyright thereto. [7.1 ¶ 4]

The Narrow License Granted to Syracuse University

Plaintiff licensed the Photographs to Defendant for certain uses. Specifically, Defendant was permitted to use the Photographs on its own social media accounts, but not on commercial billboards, third-party cross promotion purposes or any other commercial purpose. [7.1 ¶ 5]

Plaintiff never authorized Defendant to display the Photographs on billboards. [7.1 ¶ 6]
Plaintiff did not enter into any written contract with Defendant. [7.1 ¶ 7]

Based on oral communications with a Syracuse University’s employee, Plaintiff understood that he was providing the Photographs for use on Defendant’s social media accounts in exchange for a flat fee. [7.1 ¶ 8]

Plaintiff never agreed to permit the Photographs to be used for commercial purposes, such as on billboards, third-party cross promotion purposes or any other commercial purpose. [7.1 ¶ 9]

Defendant’s Unauthorized Publication of the Photographs – November 2018

Defendant used the Photographs on a billboard, thereby exceeding the scope of the oral licensing agreement. [7.1 ¶ 10] Plaintiff first became aware of the Defendant’s infringing

activities in November 2018 with respect to unauthorized use on a billboard and then later in March 2019 with respect to third-party cross-promotional materials. [7.1 ¶ 11]

Defendant did not license the Photographs from Plaintiff for other uses besides social media, nor did Defendant have Plaintiff's permission or consent to publish the Photographs in media other than social media. [7.1 ¶ 12]

Registration of the Photographs – March 21, 2019

Plaintiff's counsel in this action, Liebowitz Law Firm, PLLC (the "Firm"), follows a routine practice of registering photographs with the U.S. Copyright Office (the "USCO") on behalf of the Firm's clients. [7.1 ¶ 13] Plaintiff authorized the Firm to register the Photograph with the USCO on his behalf. [7.1 ¶ 14]

The photograph depicting Oshae Brissett (Player #11) was registered with the U.S. Copyright Office ("USCO"), was deposited with the USCO under content title "09.21.18_cuse_mbb_082.jpg" and was given registration number no. VA 2-144-186 (the "186 Registration"). [7.1 ¶ 15]

The photograph depicting Tyrus Battle (Player #25) was registered with the USCO and was deposited with the USCO under content title "09.21.18_cuse_mbb_195.jpg" as part of the 186 Registration. [7.1 ¶ 16]

Plaintiff obtained the 186 Registration on March 21, 2019, within five years after first publication of the Photographs, which took place on September 21, 2018. [7.1 ¶ 17] The Firm's registration of the Photograph on Bass' behalf was carried out in accordance with the Firm's routine practice of registering photographs with the USCO on behalf of its clients. [7.1 ¶ 18]

LEGAL STANDARD

Summary judgment is appropriate when “the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c). The burden is on the moving party to establish the lack of any factual issues. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). An otherwise properly supported motion for summary judgment will not be defeated because of the mere existence of some alleged factual dispute between the parties. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986).

Under Rule 56(e), the party opposing the motion “may not rest upon the mere allegations or denials of his pleadings, but . . . must set forth specific facts showing there is a genuine issue for trial.” *Anderson*, 477 U.S. at 248. The district court “must also be ‘mindful of the underlying standards and burdens of proof’ . . . because the evidentiary burdens that the respective parties will bear at trial guide district courts in their determination of summary judgment motions.” *SEC v. Meltzer*, 440 F. Supp. 2d 179, 187 (E.D.N.Y. 2006).

“Where a plaintiff uses a summary judgment motion, in part, to challenge the legal sufficiency of an affirmative defense - on which the defendant bears the burden of proof at trial - a plaintiff may satisfy its Rule 56 burden by showing that there is an absence of evidence to support an essential element of the non-moving party’s case.” *F.D.I.C. v. Giammettei*, 34 F.3d 51, 54 (2d Cir. 1994) (*quoting DiCola v. SwissRe Holding (North America), Inc.*, 996 F.2d 30, 32 (2d Cir. 1993)). It is well-settled that when a party moves for summary judgment, there is “no express or implied requirement in Rule 56 that the moving party support its motion with affidavits or other similar materials *negating* the opponent’s claim.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986).

ARGUMENT

On summary judgment, the Court may determine liability against a defendant on plaintiff's copyright infringement claim. *See, e.g., Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992).

POINT I: PLAINTIFF READILY ESTABLISHES HIS INFRINGEMENT CLAIM

To establish a claim of copyright infringement, plaintiff must show two elements: (1) ownership of a valid copyright; and (2) unauthorized copying of the copyrighted work. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991); *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 137 (2d Cir. 1998).

A. PLAINTIFF OWNS A VALID COPYRIGHT

“A certificate of registration from the U.S. Register of Copyrights constitutes *prima facie* evidence of the certificate holder's copyright ownership, as well as of the truth of the facts stated in the registration.” *BWP Media USA, Inc. v. Gossip Cop Media, Inc.*, 196 F.Supp.3d 395, 401 (S.D.N.Y. 2016) (“*Gossip Cop*”) (*citing* 17 U.S.C. § 410(c)). A certificate of copyright registration is *prima facie* evidence of both valid ownership of copyright and originality. *Scholz Design, Inc. v. Sard Custom Homes, LLC*, 691 F.3d 182, 186 (2d Cir. 2012). To be timely, a certificate of registration must be obtained “before or within five years after first publication” of a work. *Island Software & Computer Serv., Inc. v. Microsoft Corp.*, 413 F.3d 257 (2d Cir. 2005).

Here, Bass is in possession of a certificate of the 186 Registration from the USCO [7.1, ¶ 17] The Photographs are both on deposit with the 186 Registration. [7.1 ¶¶ 15-16] The registration of the Photographs was carried out in accordance with the Firm's routine practice of registering photographs on behalf of its clients. [7.1 ¶ 13] *See* F.R.E. 406 (evidence showing

“an organization’s routine practice may be admitted to prove that on a particular occasion the . . . organization acted in accordance with the . . . routine practice.”); accord *Chicoineau v. Bonnier Corp.*, No. 18-CV-3264 (JSR), 2018 WL 6039387, at *2 (S.D.N.Y. Oct. 16, 2018) (finding photographer’s sworn declaration that photograph was on deposit to be sufficient in the absence of any contrary evidence).

The 186 Registration was obtained within five years after first publication of the work. [7.1 ¶ 17] Accordingly, the 186 Registration serves as *prima facie* evidence of Bass’ valid copyright ownership in the Photographs. *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 455 (2d Cir. 1989). “The validity of a registration may be rebutted by proof of a certificate holder’s fraud on the Copyright Office, though the party seeking to establish such fraud bears a ‘heavy burden.’” *BWP Media USA, Inc. v. Gossip Cop Media, LLC*, 87 F.Supp.3d 499 (S.D.N.Y. 2016) (citation omitted); see also *Fonar Corp. v. Domenick*, 105 F.3d 99, 105 (2d Cir. 1997) (“the presumption [of validity] may be overcome only by ‘proof of deliberate misrepresentation.’”).

Here, Defendant has failed to produce any evidence that Plaintiff or his counsel defrauded the USCO upon obtaining the 186 Registration. Indeed, there is no evidence that Defendant even bothered to contact the USCO during discovery. Accordingly, there is no issue of material fact concerning the validity of the 186 Registration respecting the two Photographs at issue on this motion.

B. DEFENDANT COPIED BASS’ WORK WITHOUT AUTHORIZATION

To satisfy the second element of an infringement claim, a plaintiff must show both that his work was “actually copied” and that the portion copied amounts to an “improper or unlawful appropriation.” *Castle Rock*, 150 F.3d at 137 (citations omitted).

There is no factual dispute concerning whether Defendant “actually copied” the Photographs as they prominently appear on a commercial billboard [7.1 ¶ 10] *See Otto v. Hearst Commc'ns, Inc.*, 345 F. Supp. 3d 412, 425 (S.D.N.Y. 2018) (finding actual copying took place where “the parties do not contest the fact that Hearst actually copied Otto’s photograph for its use in the Esquire Article, nor that the works are substantially similar because they are the same photograph.”)

Further, Defendant did not obtain Plaintiff’s permission to publish the Photograph on a commercial billboard and Plaintiff never granted Defendant authorization to copy or display the Photographs for purposes of a billboard. [7.1 ¶¶ 5-9] As such, Defendant violated Bass’ exclusive rights under section 106 of the Copyright Act because its actual copying amounted to “an improper and unlawful appropriation.” *Castle Rock*, 150 F.3d at 137; *Otto* at 425 (“The parties do not dispute Hearst did not have Otto’s permission to use the Photograph, making the appropriation unlawful.”)

In sum, there is no genuine issue of material fact concerning the two elements of Bass’ copyright infringement claim. *See Otto* at 425 (“because Otto has established that he owns a valid copyright in the image, and because the actual copying and substantial similarity elements have been met, the Court finds that Hearst infringed upon Otto’s exclusive right to control the reproduction and distribution of his photograph.”).

POINT II: THE LICENSE DEFENSE FAILS AS A MATTER OF LAW

While “it is a defense to copyright infringement that the alleged infringer possessed a license to use the copyrighted work, *Graham v. James*, 144 F.3d 229, 236 (2d Cir. 1998), “[t]he burden of proving that a license exists falls on the party invoking the defense.” *Associated Press v. Meltwater U.S. Holdings, Inc.*, 931 F.Supp.2d 537, 561-62 (S.D.N.Y. 2013) (Cote, J.) (citing

Graham, 144 F.3d at 236).

It is well-established that a copyright infringement claim lies where defendant's challenged use exceeds the scope or duration of a license. *See, e.g., Microsoft Corp. v. Harmony Computers & Elecs., Inc.*, 846 F. Supp. 208, 214 (E.D.N.Y. 1994) ("plaintiff's claim that defendants exceeded the scope of its license agreements states a claim for copyright infringement rather than breach of contract"); *Marshall v. New Kids On The Block P'ship*, 780 F. Supp. 1005, 1009 (S.D.N.Y. 1991) ("Case law in this Circuit indicates that a copyright licensee can make himself a 'stranger' to the licensor by using the copyrighted material in a manner that exceeds either the duration or the scope of the license."); *Leutwyler v. Royal Hashemite Court of Jordan*, 184 F. Supp. 2d 303 (S.D.N.Y. 2001); *Marvullo v. Gruner & Jahr*, 105 F. Supp. 2d 225 (S.D.N.Y. 2000).

Here, Plaintiff granted Defendant the right to display the Photographs on its social media accounts. [7.1, ¶¶ 5-9] But that license did not extend to use of the Photographs on a commercial billboard. [*Id.*] Defendant is therefore liable for infringement because it exceeded the scope of the license by displaying the Photographs on unauthorized platforms, namely a billboard, without Plaintiff's authorization. *Microsoft Corp.*, 846 F. Supp. at 214

POINT III: THE REMAINING AFFIRMATIVE DEFENSES SHOULD BE DISMISSED

A. Failure to State a Claim Should Be Dismissed

A defense based on failure to state a claim must be directed to the pleading. *See Eclairre Advisor Ltd. v. Daewoo Engineering Co.*, 375 F.Supp.2d 257, 260 (S.D.N.Y. 2005). A complaint must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). "A claim has facial plausibility when the

plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

Here, Plaintiff’s complaint sets forth a plausible set of facts to support each element of his copyright infringement claim. *See* Complaint, Dkt. #1, ¶¶ 7-9 (ownership and validity of copyright); ¶¶ 10-12 (Defendant’s unauthorized copying of Bass’ work for purpose of a billboard). Accordingly, the defense of failure to state a claim should be dismissed.

B. The Defense of Waiver Should Be Dismissed

As to the defense of waiver, “[w]aiver is the voluntary or intentional relinquishment of a known right, or intentional conduct inconsistent with claiming such a right.” *Torain v. Clear Channel Broad., Inc.*, 651 F. Supp. 2d 125, 145 (S.D.N.Y. 2009). Accordingly, “[i]ntent is the key element in establishing waiver.” *Id.* at 146 (citation omitted). Waiver is an affirmative defense. Fed.R.Civ.P. 8(c)(1).

Here, no reasonable trier of fact can conclude that Bass manifested an intent to intentionally and knowingly relinquish his copyright to the Photographs. Because Defendant fails to raise a question of fact as to Bass’ intent to knowingly waive his rights, the waiver defense fails as a matter of law.

C. The Defense of Estoppel Should Be Dismissed

As to the defense of equitable estoppel, Defendant is required to show “(1) an act constituting a concealment of facts or a false misrepresentation; (2) an intention or expectation that such acts will be relied upon; (3) actual or constructive knowledge of the true facts by the wrongdoer; (4) reliance upon the misrepresentations which causes the innocent party to change its position to its substantial detriment.” *Patriarch Partners VIII, LLC*, 842 F.Supp.2d 682, 713 (S.D.N.Y. 2012).

Here, there is no evidence whatsoever to support the elements of Defendant's estoppel defense s there is no evidence that Bass made any misrepresentations to Defendant, nor is there evidence that Defendant reasonably relied on Defendant's statements.

D. The Defense of Laches Should Be Dismissed

"Laches, we hold, cannot be invoked to preclude adjudication of a claim for damages brought within the three-year window." *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 134 S.Ct. 1963 (May 19, 2014).

Here, the laches claim must be dismissed because Plaintiff filed suit on May 13, 2019 [Dkt. #1], within three years of his discovery of the infringement in November 2018.

E. The Defense of Ratification Should Be Dismissed

"Ratification has three conjunctive elements: (1) acceptance by the principal of the benefits of the transaction (2) with full knowledge of the relevant facts (3) under circumstances indicating an intention to adopt the unauthorized acts." *Monarch Ins. Co. v. Insurance Corp. of Ireland*, 835 F.2d 32, 36 (2d Cir.1987).

Here, there is no evidence that Bass ratified Defendant's unlawful conduct as there is no evidence to suggest that Bass manifested an intent to adopt Defendant's unauthorized use of the Photographs on a commercial billboard.

CONCLUSION

For the foregoing reasons, Plaintiff James Bass' motion for partial summary judgment on liability against Defendant Syracuse University should be GRANTED.

Respectfully Submitted,

LIEBOWITZ LAW FIRM, PLLC

by: s/richardliebowitz/
Richard Liebowitz
11 Sunrise Plaza, Suite 305
Valley Stream, NY 11580
(516) 233-1660
RL@LiebowitzLawFirm.com

Counsel for Plaintiff James Bass