

No. _____

IN THE
Supreme Court of the United States

DONNA CORBELLO,

Petitioner,

v.

FRANKIE VALLI, *ET AL.*,

Respondents.

**On Petition for a Writ of Certiorari to
the United States Court of Appeals
for the Ninth Circuit**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the century-old equitable doctrine of copyright estoppel, which states that, once a work has been held out to the public as entirely factual, an author-plaintiff cannot later claim it is actually fiction, and entitled to the higher protection accorded fictional works, may be invoked to deny protection to original expression in an unpublished biography, for which no such public claims have been made.

2. Whether the Ninth Circuit's newly-adopted "asserted truths doctrine," which: modifies copyright estoppel by rejecting its equitable basis; is grounded, instead, in U.S. Const. art. 1, § 8, cl. 8; and, denies protection to narrative expression and original dialogue in unpublished historical works, in addition to facts and ideas, conflicts with the purposes of the Copyright Clause, the Copyright Act of 1976, and this Court's decisions in *Harper & Row, Publs. v. Nation Enters.*, 471 U.S. 539 (1985), and *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991); encroaches upon an author's right of first publication; and departs from traditional principles of equity unduly.

3. Whether the Ninth Circuit's decision, in holding that an author's first written account of his own prior remarks, and subjective characterizations of public figures are unprotected by copyright, directly conflicts with this Court's decisions in *Harper & Row* and *Feist*.

4. Whether paraphrasing and adapting original expression from an unpublished biography infringes copyright unless excused by fair use.

PARTIES TO THE PROCEEDINGS BELOW

Petitioner, Donna Corbello, was the plaintiff in the district court and appellant in the court of appeals.

Respondents Frankie Valli, Robert J. Gaudio, Marshall Brickman, Eric S. Elice, Des McAnuff, Michael S. David, DSHT, Inc., FKA Dodger Stage Holding Theatricals, Inc, Dodger Theatricals, Ltd., JB Viva Vegas, LP, Jersey Boys Broadway Limited Partnership, Skunk, Inc., and Getting Home, Inc., were defendants in the district court and appellees in the court of appeals.

RULE 29.6 NOTATION

Petitioner is an individual, with no parent corporation, stock, or shareholders.

RELATED PROCEEDINGS

There are no other proceedings in any court that are directly related to this case.

TABLE OF CONTENTS

QUESTIONS PRESENTED. i

PARTIES TO THE PROCEEDINGS BELOW. ii

RULE 29.6 NOTATION ii

RELATED PROCEEDINGS. ii

TABLE OF AUTHORITIES. vi

OPINIONS BELOW. 1

JURISDICTION 1

CONSTITUTIONAL AND STATUTORY
PROVISIONS INVOLVED 2

INTRODUCTION. 2

STATEMENT OF THE CASE 7

 A. Factual Background 7

 B. District Court Proceedings 19

 C. The First Appeal 20

 D. Proceedings Upon Remand. 21

 E. The Ninth Circuit’s Decision 23

REASONS FOR GRANTING THE WRIT 25

I. The Ninth Circuit’s Newly-Adopted “Asserted Truths Doctrine” Departs from Traditional Principles of Equity; Decides Important Questions of Federal Law Which Should Be Settled By This Court; and Conflicts with Relevant Decisions of Other Circuits and This Court. 25

A. The Purposes of Copyright Law, Traditional Contours of Copyright Protection, and the First Amendment 25

B. The Equitable Doctrine of Copyright Estoppel. 28

C. The Ninth Circuit’s “Asserted Truths Doctrine,” and Its Constitutional, Statutory, and Common Law Defects 33

1. The Asserted Truths Doctrine’s Treatment of Dialogue Creates a Conflict with the Tenth Circuit and Tensions with This Court. . . . 34

CONCLUSION 36

APPENDICES

APPENDIX A
Ninth Circuit Opinion
(Sept. 8, 2020). 1a

APPENDIX B
District Court Opinion
(Jun. 13, 2017) 33a

APPENDIX C	
District Court Opinion	
(Nov. 17, 2016)	80a
APPENDIX D	
District Court Opinion	
(Sept. 29, 2015).	84a
APPENDIX E	
Ninth Circuit Opinion in Earlier Appeal	
(Feb. 10, 2015)	120a
APPENDIX F	
Ninth Circuit Order Denying Rehearing	
(Nov. 13, 2020)	152a
APPENDIX G	
Statutory Provisions Involved	153a
17 U.S.C. § 101.	153a
17 U.S.C. § 102.	155a
17 U.S.C. § 106.	156a
17 U.S.C. § 107.	157a
17 U.S.C. § 204.	158a
17 U.S.C. § 501.	158a

TABLE OF AUTHORITIES

Cases:

<i>American Tobacco Co. v. Werckmeister</i> , 207 U.S. 284 (1907)	28
<i>Arica Inst., Inc. v. Palmer</i> , 970 F.2d 1067 (2d Cir. 1992)	30
<i>Bonito Boats v. Thunder Craft Boats</i> , 489 U.S. 141 (1989)	6
<i>Cooley v. Penguin Grp. (USA) Inc.</i> , 31 F. Supp. 3d 599 (S.D.N.Y. 2014), as corrected (July 14, 2014)	32
<i>Corbello v. DeVito</i> , 2015 U.S. Dist. LEXIS 132726 (D. Nev. September 29, 2015) (unreported)	1
<i>Corbello v. DeVito</i> , 2016 U.S. Dist. LEXIS 184860 (D. Nev. November 17, 2016) (unreported)	1
<i>Corbello v. DeVito</i> , 262 F.Supp. 3d 1056 (D. Nev. 2017)	1
<i>Corbello v. DeVito</i> , 777 F.3d 1058 (9th Cir. 2015) . .	1
<i>Corbello v. Valli</i> , 974 F.3d 965 (9th Cir. 2020)	1
<i>Davies v. Bowes</i> , 209 F.53 (S.D.N.Y. 1913)	30
<i>eBay Inc. v. MercExchange, L.L.C.</i> , 547 U.S. 388 (2006)	34

<i>Effie Film, LLC v. Pomerance</i> , 909 F. Supp. 2d 273 (S.D.N.Y. 2012)	29
<i>Eldred v. Ashcroft</i> , 537 U.S. 186 (2003).....	4, 26, 27
<i>Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.</i> , 499 U.S. 340 (1991)	i, 3, 7, 25, 28
<i>Golan v. Holder</i> , 565 U.S. 302 (2012).....	4, 25-27
<i>Greenbie v. Noble</i> , 151 F. Supp. 45 (D.N.Y. 1957)	29
<i>Harper & Row, Publr. v. Nation Enters.</i> , 471 U.S. 539 (1985)	i, 3-7, 25-28
<i>Harris v. Miller</i> , 50 U.S.P.Q. 306, (S.D.N.Y. 1941)	35
<i>Houts v. Universal City Studios, Inc.</i> , 603 F.Supp. 26 (C.D. Cal. 1984)	29
<i>Hughes v. Fox Broad. Co.</i> ,2007 U.S. Dist. LEXIS 117783 (W.D. Mo. Oct. 10, 2007)	31
<i>Jacobsen v. Deseret Book Company</i> , 287 F.3d 936 (10th Cir. 2002)	5, 7, 35
<i>Marshall v. Yates</i> , 1983 U.S. Dist. LEXIS 12305 (C.D. Cal. Oct. 26, 1983)	31
<i>Nash v. CBS, Inc.</i> , 691 F. Supp. 140 (N.D. Ill. 1988)	31

<i>Nester's Map & Guide Corp. v. Hagstrom Map Co.</i> , 796 F. Supp. 729 (E.D.N.Y. 1992)	29, 31
<i>Pac. Gas & Elec. Co. v. Pub. Utils. Com.</i> , 475 U.S. 1 (1986)	27
<i>Petrella v. Metro-Goldwyn-Mayer, Inc.</i> , 572 U.S. 663 (2014)	5, 33
<i>Salinger v. Random House, Inc.</i> , 811 F.2d 90 (2d Cir. 1987)	6
<i>Suid v. Newsweek Magazine</i> , 503 F. Supp. 146 (D.D.C. 1980)	34
<i>Weinberger v. Romero-Barcelo</i> , 456 U.S. 305 (1982)	3
<i>Wooley v. Maynard</i> , 430 U.S. 705 (1977)	27
Constitution:	
U.S. Const. amend. I	2, 4, 26
U.S. Const. art. 1, § 8, cl. 8.	i, 4, 5, 24, 26
Federal Statutes:	
17 U.S.C. § 101	20
17 U.S.C. § 102(b)	26
17 U.S.C. § 106(3)	27

17 U.S.C. § 107 4, 27, 28

28 U.S.C. § 1254(1) 2

Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541
(1976) (codified at 17 U.S.C. §§ 101, *et seq.*) 2

Other Authorities:

1 *Nimmer on Copyright* § 2.11(c). 29

1-2 *Nimmer on Copyright* § 2.11[C] 32

Sup. Ct. R. 29.6 ii

William F. Patry, 2 *Patry on Copyright* § 4:8 (Sept.
2015) 29

Petitioner respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals is reported at 974 F.3d 965, and reproduced in Appendix (App.) A. (App. 1a-32a). The opinion and order of the district court, vacating three of five verdicts, and entering judgment as a matter of law, is reported at 262 F.Supp. 3d 1056, and reprinted in Appendix B. (App. 32a-79a). An earlier order of the district court, entering judgment as a matter of law for two respondents, is unreported, but available at 2016 U.S. Dist. LEXIS 184860, and reproduced in Appendix C. (App. 80a-83a). A previous opinion by that court is unreported, but available at 2015 U.S. Dist. LEXIS 132726, and reprinted in Appendix D. (App. 84a-119a).

The earlier opinion of the court of appeals cited in the judgment is reported at 777 F.3d 1058, and reproduced in Appendix E. (App. 120a-151a).

JURISDICTION

The judgment of the court of appeals was entered on September 8, 2020. (App. 1a). A petition for panel rehearing and rehearing en banc was denied on November 13, 2020, by the order reproduced in Appendix F. (App. 152a). On March 19, 2020, this Court, by general order, extended the deadline to petition for a writ of certiorari to 150 days from the date of the lower court judgment, or order denying a

timely petition for rehearing. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, Section 8 of the United States Constitution provides, in relevant part: “[The Congress shall have Power . . .] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries” U.S. Const. art. I, § 8, cl. 8.

The First Amendment to the United States Constitution provides, in pertinent part: “Congress shall make no law . . . abridging the freedom of speech” U.S. Const. amend. I.

The relevant provisions of the Copyright Act of 1976, as amended, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified at 17 U.S.C. §§ 101, *et seq.*), are reprinted in Appendix G. (App. 153a-158a).

INTRODUCTION

The Ninth Circuit’s decision in this case, involving unlicensed appropriations of expression from an unpublished autobiography, for the stageplay, *Jersey Boys*, not excused by fair use, creates and deepens division among the circuits concerning: the scope of copyright protection in historical and factual narratives, and extent to which expressive language in such works may be copied, paraphrased, or adapted to

disseminate underlying facts; the treatment of fictional elements in otherwise factual works, including reconstructed or fictitious dialogue in biographical memoirs; and, the extent to which an author's right of first publication protects against appropriations of expression in *unpublished* memoirs, when fair use does not apply. The decision also directly conflicts with this Court's decisions in *Harper & Row, Publrs. v. Nation Enters.*, 471 U.S. 539 ("Harper & Row") and *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 ("Feist"), by denying copyright protection to expression held protected in *Harper & Row*, and expression satisfying the constitutional and statutory "originality" requirement elucidated in *Feist*.

Most of these conflicts flow from the Ninth Circuit's adoption of a newly-coined principle of federal common law for this case: the "asserted truths doctrine," which is triggered by an author's assertions within or concerning a work that its accounts are truthful, and then treats its expression, including narratives *about* facts, as unprotectable fact, excluded from copyright. Though inspired by the century-old equitable doctrine of "copyright estoppel," stating that, once a work has been held out to the public as entirely factual, an author-plaintiff cannot later claim it is actually fiction, and entitled to the higher protection accorded fictional works, the asserted truths doctrine materially differs from copyright estoppel in rationale and application. First, it rejects the equitable underpinnings of copyright estoppel entirely, despite this Court's warnings against departures from long traditions of equity practice, *e.g.*, *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 320 (1982), and is

grounded instead in the Copyright Clause, as a means of promoting the “Progress of Science.” Second, there is no requirement that its triggering assertions be made “to the public,” and unlike copyright estoppel, the asserted truths doctrine applies to unpublished works. Third, while copyright estoppel may preclude an author-plaintiff from claiming an account is fictitious, it does not place narrative expression in the public domain. The asserted truths doctrine can, and did in this case.

These differences alter the traditional contours of copyright protection in ways reserved for Congress, *see Eldred v. Ashcroft*, 537 U.S. 186, 212-213 (2003), shifting the delicate balance Congress struck between the rights of authors in their original expression, and public access to their works. *Id.* The Copyright Act accommodates First Amendment rights through the idea/expression dichotomy and fair use, *Golan v. Holder*, 565 U.S. 302, 327-29 (2012), including the negative free speech rights embodied in the right of first publication, which gives authors exclusive control over their works while grooming them for public dissemination, and the right to choose when, how, and whether to publish. *Harper & Row*, 471 U.S. at 554-555, 560. Under this scheme, original expression is protected, before and after publication, subject only to fair use. *Id.* at 548; 17 U.S.C. § 107. The asserted truths doctrine subverts this, by reclassifying provably original expression as fact, and permitting its appropriation from unpublished works without fair use. Moreover, it does so based on an objective under the Copyright Clause that Congress did not select.

The equitable nature of copyright estoppel *may* permit *its* limited interventions, to avoid unfairness in a particular case. *See Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 688 (2014) (Breyer, J., dissenting). But the Ninth Circuit’s asserted truths doctrine has no equitable foundation, not only raising questions regarding its authority, but also producing inequitable and conflicting results. Here, statements in a draft, unpublished manuscript, which had not been fully vetted and edited for publication, or even formally approved by its co-author/subject; was maintained in confidence; had not been spoken of publicly; and, was appropriated through deception, produced a judgment that the work is “entirely true,” and a drastic, “estoppel-type” remedy, without the misconduct for which such estoppel is normally imposed.¹ The court used the doctrine to eliminate half of the similarities considered; hold that the work’s subjective portraits of real persons are unprotected, conflicting with this Court’s contrary holding in *Harper & Row*, 471 U.S. at 563; and rule that reconstructed and fictitious dialogue in biographical works is unprotected, placing the Ninth Circuit in conflict with the Tenth,² and in tension with this Court’s treatment of an author’s first written account of his own prior remarks. *Id.* at 566, n. 8.

These outcomes thwart the national uniformity that is a primary purpose of the Copyright Clause.

¹ Indeed, the subject statements may never have appeared in the published text, or, may have been prefaced by a disclaimer.

² *See Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 947 (10th Cir. 2002).

Bonito Boats v. Thunder Craft Boats, 489 U.S. 141, 162 (1989). And no court in any other circuit has adopted this doctrine, or applied copyright estoppel, its sibling, in this way.³ Only this Court can resolve the circuit conflict, enforce its prior decisions, and clarify whether either “asserted truths” or copyright estoppel may be invoked against unpublished works.

The Ninth Circuit’s decision also squarely raises long-elusive issues concerning the scope of copyright protection for historical narrative works, including whether they are protected against paraphrasing and adaptation, as well as the verbatim copying proscribed in *Harper & Row*. Most remaining similarities between the respective works which the lower court held did not concern protected elements of petitioner’s work, were dismissed on grounds that they involved only “ordinary phrases.” But closer examination reveals that more was taken, even where only short phrases were reproduced verbatim. These larger passages should be protected where they display, “as a whole, a sufficient degree of creativity as to sequence of thoughts, choice of words, emphasis, and arrangement” *Salinger v. Random House, Inc.*, 811 F.2d 90, 98 (2d Cir. 1987).

³Notably, had the asserted truths doctrine, or the Ninth Circuit’s construction of copyright estoppel, been applied in *Harper & Row*, the outcome would have differed. President Ford’s unpublished memoir was held out as entirely factual, promising “‘significant hitherto unpublished material’ concerning the Watergate crisis, Mr. Ford’s pardon of former President Nixon and ‘Mr. Ford’s reflections on this period of history, and the morality and personalities involved.’” *Harper & Row*, 471 U.S. at 542. Yet, copyright estoppel was not applied, and its expression was protected, even against fair use.

These issues are not novel; are of tremendous importance to authors and publishers of expressive nonfiction works, and the need for guidance has long been noted,⁴ including by the Court itself. In *Harper & Row*, this Court acknowledged that “in the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author’s original contributions to form protected expression.” 471 U.S. at 548. Later, in *Feist*, it provided a partial clarification: “no one may claim originality as to facts,” which “do not owe their origin to an act of authorship,” 499 U.S. at 347, but factual compilations may be entitled to “thin” protection for a compiler’s original selection and arrangement of facts. *Id.* at 349. But the scope of protection for more expressive factual works, including “elegantly written biographies,” *Harper & Row*, 471 U.S. at 563, remains uncertain. This case is an ideal vehicle for resolving that uncertainty at last, and the petition for certiorari should be granted.

STATEMENT OF THE CASE

A. Factual Background

1. Petitioner is the widow of Rex Woodard, an attorney, author, and fan of the Four Seasons, who died in May 1991. Shortly before his death, in January 1991, Woodard completed a “rough manuscript” about the group, and its co-founder, Tommy DeVito (“the Work”),

⁴ *E.g.*, *Jacobsen*, 287 F.2d at 948 (noting, concerning the paraphrasing of expression in biographies, that “the Supreme Court has not settled this issue.”).

under an agreement entered with DeVito in 1988 for his autobiography. The agreement provided Woodard would do “all of the actual writing,” based on taped interviews and “any other relevant information that would benefit the book,” but the two would be “shown as co-authors,” and DeVito would have “exclusive control over the final text.” CA9 Br. 3-4.⁵ The Work is a 275-page, first-person narrative, in DeVito’s “voice,” with 222 pages devoted to the Four Seasons. *Id.* at 4.⁶

In late-1990, before completing the Work, Woodard wrote prospective publishers, providing an outline. The “pitch” was that the Work would reveal the group’s previously undisclosed ties to organized crime, and criminal histories for certain band members, including DeVito, who had lied about their ages in the 1960’s to appeal to teens, and conceal “missing years” spent in prison. *Id.*; ER10844-10860. The letters requested “discretion,” because “key individuals” in the Work “remain unaware of its existence,” and did not include copies of the Work itself. ER10846; CA9 Rep. Br. 15-16. When this failed to generate interest, Woodard contacted two prospective literary agents, in late-January 1991, and sent both copies of the Work, but each declined; returned the copies; and Woodard died shortly thereafter. CA9 Br. 4; ER10874-10879.

⁵ Docket entries in Ninth Circuit Appeal No. 17-16337 are cited “R__.” References to petitioner’s *Opening Brief*, at R49-1, are cited “CA9 Br. __.” References to her *Reply Brief*, at R107, are cited “CA9 Rep. Br. __.” References to petitioner’s *Excerpts of Record* in the lower court are cited “ER__.”

⁶ The cover page for the draft manuscript read, “Untitled Tommy DeVito/Four Seasons Biography.” ER12001.

Petitioner inherited Woodard's rights in the Work, and continued to seek a publisher after his death, with his sister, Cindy Ceen, using the same form letter Woodard had employed. Mrs. Ceen dispatched 10 such letters over a 12-to-13-year period. The number petitioner sent is uncertain, but many were misaddressed and "returned to sender," because she used an outdated address list that Woodard had prepared. CA9 Rep. Br. 16. None included copies of the Work. These efforts were unsuccessful, and the Work remains unpublished. CA9 Br. 4.

Few were aware of the Work, or Woodard's authorship thereof during his lifetime, and neither he, petitioner, nor Mrs. Ceen made public statements regarding it before this action was filed. Nor did DeVito discuss the Work publicly, or make public claims of truthfulness. ER10443-10444. Like Woodard, DeVito considered the Work a draft that was "never finished," CA9 Br. 5, and, he had not approved its "final text" per the 1988 agreement, which was one of several barriers to petitioner's publication of the Work in its existing form. In fact, in 2005, through his attorney, DeVito rebuffed Mrs. Ceen's renewed attempts to elicit his cooperation, telling her the Work was "not saleable." (App. 4a).

DeVito registered the Work with the Copyright Office in January 1991, shortly before Woodard's death, but solely in his name, without advising Woodard. The deposit copy for his application was the manuscript typed by Woodard's secretary, but the title page differed, and Chapter 41 was missing page 264 (App. 40a), which included harsh criticisms of Frankie Valli.

ER13048. (*See also* App. 5a). On July 3, 2007, the registration was corrected, adding Woodard as co-author and co-claimant. *Id.*; CA9 Br. 4.

2. Contrary to foundational assertions in the Ninth Circuit’s decision, the Work, as registered with the Copyright Office; used by respondents; and shown to the jury, *does not include the cited representations of truthfulness on which the decision is based*. The only page of the Work where the words, “a complete and truthful chronicle of the Four Seasons” (App. 4a, 21a) appear, and the cited references to DeVito’s “candor” (App. 4a), is page 264 – the page missing from the Work as registered by DeVito and petitioner. *See* ER13048.⁷ This page was also missing from the “Defendants’ Copy” of the Work, *see infra*, p. 14, and respondents did not see it. ER5549. Consequently, the district court withheld it from the jury, permitting jurors to review only the registered version in Trial Exhibit 15. ER5549-5551; ER1412.⁸

Moreover, the Work is *not* entirely factual, due, in part, to the circumstances surrounding its creation. Although DeVito provided interviews to Woodard, and

⁷ The decision states this appears “[a]t the outset of the Work” (App. 4a), but it is eleven pages from the end.

⁸ The Prologue quotes from a mailgram sent to DeVito upon his induction into the Rock and Roll Hall of Fame, and DeVito wonders whether he would have received it, if “they knew the whole story.” ER12002. It may be inferred that this is a reference to his criminal history, rather than a claim that the Work is “entirely true,” and it is not cited as an assertion on which the decision is based.

taped stories for the Work, he had little familiarity with the manuscript, because he did no “actual writing,” and Woodard died so soon after completing his draft. At his deposition, used as his trial testimony, DeVito admitted the Work was not something he had read numerous times;⁹ knew little about its structure or content; and, denied making statements the Work recounts, which would later surface in *Jersey Boys*. CA9 Br. 5; ER5002. The Work was never vetted, line-edited, or groomed for publication, CA9 Br. 5, and includes errors, as well as fictional accounts. CA9 Br. 6-7; CA9 Rep. Br. 33-34.

Woodard also invented dialogue, as is customary for such works, according to a former editor of *Time* magazine at trial. *Id.* A notable example concerns the Four Seasons’ hit, “Walk Like a Man.” CA9 Br. 5-6. In Woodard’s interview with DeVito about the song, DeVito said he liked the music, but “couldn’t understand the lyric,” explaining:

I thought that was . . . the winner right there. Walk Like a Man itself, I don't know. You know, I'm saying, Walk Like a Man, Walk Like a Man. Whoever said the saying Walk Like a Man? Nobody. I never heard anybody say Walk Like a Man, you know? Or act like a man or something else, but not Walk Like a Man. Or have I been walking like a girl lately?

⁹DeVito’s primary exposure to the manuscript occurred during a cross-country drive, when his wife read it aloud in the car. ER5046-5047.

ER6379. In the Work, Woodard transformed these feelings into an exchange with Gaudio, which never actually occurred:

“What's the name of your new hit, Bobby?”
“Walk Like A Man.” “Walk Like A Man? As opposed to what -- like a woman?” “No, no,” explains Gaudio defensively, “the song is directed to teenage boys who need to walk and talk like men.” “In other words, instead of like girls?” “No! Instead of like boys. This song is going to serve as an anthem for every teenage boy who has let some girl twist him around her little finger!”

CA9 Br. 5-6, 19; CA9 Rep. Br. 26.¹⁰ Woodard also invented dialogue for the Work's accounts of a faked murder in Valli's car, and the band's induction into the Rock Hall of Fame. CA9 Br. 6. And, the Work contains “internal dialogue” in which the thoughts of DeVito and others are quoted or described. Finally, it includes DeVito's subjective descriptions of himself and others, including Valli, Gaudio, actor Joe Pesci, Valli's first wife Mary, and Four Seasons member, Nick Massi. *Id.*

Respondents Valli and Gaudio have also confirmed numerous fictions in the Work, including stories about DeVito's intercession with a probation officer at the behest of Valli's mother, when Valli was

¹⁰The Ninth Circuit's decision incorrectly states that the parties do not dispute this conversation actually happened. (App. 31a). That has always been disputed, including by DeVito, who testified he had no recollection of it, and did not even know what “anthem” means. CA9 Br. 6.

arrested as a teen; Valli's performances with the Variety Trio, for which the Work claims he knew only one song; and Gaudio's depiction as a naive virgin at an orgy thrown by a record company. CA9 Br. 6-7.

A compendium of fictional and erroneous accounts in the Work, with additional examples, appears in Volume 41 of petitioner's *Excerpts of Record*, at ER10436-10441.

3. In 1999, DeVito and Nick Massi signed an agreement with Valli/Gaudio for a stageplay based on the Four Seasons. The agreement conveyed rights in their names, likenesses, "biographies," and other "materials," including derivative works rights. But it also included a reversionary clause, under which these conveyances were withdrawn, if the first producer's contract lapsed, and an agreement with a second was not executed within a specified period of time. The parties stipulated at trial that these rights *did* revert to DeVito, on December 10, 2004. CA9 Br. 8. Because neither DeVito nor Valli/Gaudio believed the agreement covered the Work, of which Valli/Gaudio were not yet aware, the rights conveyed were never exercised before the lapse. *Id.* at 8-9.¹¹

In mid-2003, the proposed Four Seasons play still remained undeveloped, despite efforts that had begun in 1999. But by early-2004, talks had become more serious between writers, Rick Elice and Marshall Brickman, director Des McAnuff, and producer Michael

¹¹ The facts in this paragraph are relevant only to an understanding of the first Ninth Circuit appeal.

David, and McAnuff suggested that the existing, highly-fictionalized “treatment” for the play, called “Oh What a Night!,” be replaced with an attempt to relate the band’s history. All agreed, and the play was reconceived between January and April 2004. CA9 Br. 9-10.

4. McAnuff also suggested that they contact DeVito, which Brickman did on January 19, 2004. During this conversation, DeVito expressed concern about the way his friend, mobster, Ray DeCarlo, might be portrayed in the play; told Brickman of the Work; and offered to lend him a copy, so he could “flip through it” for information about DeCarlo’s relationship with DeVito’s family. But DeVito insisted that Brickman use it only for that purpose; return it immediately; not share it with anyone, including Elice; and not copy or circulate it. At deposition, Brickman testified he was aware of these restrictions. At trial, he backtracked, calling DeVito “naive” if he thought Elice would not see the Work. CA9 Br. 11.

Shortly before the Work arrived, McAnuff scheduled the inaugural planning meeting for the play – “a day in front of a bulletin board with index cards,” to “start constructing an outline” – and he appointed Elice to copy from the Work. ER4358-4360, 10960. When delivered, between January 23 and January 27, 2004, Brickman gave it to Elice, who made copies, keeping one, ER13071 (“the Defendants’ Copy”), sending McAnuff another, and returning the original to Brickman for DeVito, who was unaware of this copying. Elice then mined the Work, marking almost 100 pages, and writing notes, such as, “That’s a scene!,” and

“Scene,” in the margins. He also copied the Work’s verbiage onto notecards for the planning meeting, and the cards were used to structure and organize the play. CA9 Br. 12-13.

On January 28, 2004, as early as one day following his receipt of the Work, Elice created a “First Scene Idea for Marshall” for the reconceived play, dominated by verbatim copying and close paraphrasing from its pages. For example, the “First Scene Idea” adopts the Work’s descriptions of Valli’s early performances, including the falsity that he knew only one song. The Work states, “*it’s the only song he knows,*” and “*Frankie never receives a penny for working with us,*” while the First Scene portrays Valli stating, “*It’s the only song I know,* as bandmate Nick echoes, “*it’s the only song he knows,*” adding, “*We’re not paying you one penny.*” The First Scene states, “*Owner says we set a house record, gives us a fat bonus,*” from the Work’s “*The owner tells us . . . we’ve set a number of crowd attendance records. He rewards us with a fat bonus.*” The Work refers to the song “My Mother’s Eyes” as “*a real tear jerker,*” while the First Scene calls it, “*the tear jerker.*” The First Scene recites, “*The kid is desperate,*” from the Work’s: “*Frankie desperately wants to get into the group.*” Elice conceded this was not “coincidental” – he admittedly copied from the Work. ER4347-4348, ER4353-4354. CA9 Br. 14.

On February 6, 2004, McAnuff’s assistant wrote Brickman, requesting a copy of the “Tommy DeVito biography/transcript,” and Brickman’s response showed his intent to violate the restrictions DeVito had imposed:

[T]here's a 300 p. typescript of an unpublished memoir of Tommy DeVito & someone else *given to us by Tommy with the request that it not be circulated*. Des [McAnuff] has a copy. *On Monday we'll see about duplicating it*

ER6712. Copies were made and provided to the dramaturge, actors, choreographer, music director, and prospective producer; excerpts were recited during “table readings” for the cast; and, excerpts were used for auditions, because no script had yet been prepared. Meanwhile, because DeVito’s copy had been promptly returned, he believed Brickman had abided by his instructions. CA9 Br. 14-15.¹²

On February 13, 2004, the writers produced an outline called “the Thing,” which was the “starting point” for the new story that replaced “Oh What a Night!,” and came to be known as *Jersey Boys*. It, too, copied extensively from the Work, as shown in these two examples:

The Thing: “They puff on cigarettes and dare anyone to mess with them. They think they are cool beyond belief” (ER10320)

The Work: “We puff on cigarettes and dare anyone to mess with us. We are fourteen and cool beyond belief.” (ER13076).

¹²The Ninth Circuit’s decision omits any reference to DeVito’s restrictions, instead portraying him as having given the Work to the “writers” and “developers of the play” to use for research. (App. 5a, 24a).

The Thing: “Bob is totally humiliated and disgraced” (ER10342)

The Work: “Bob mutters, ‘I have never been so humiliated and disgraced in my life.’” ER13217.

CA9 Br. 16.

5. Although *Jersey Boys* is filled with dialogue from all four members of the Four Seasons, including Valli, and Gaudio, as quoted above in *The Thing*, both Valli and Gaudio have testified that they provided *no* dialogue for the play. Gaudio testified that he provided no dialogue, because “God knows, who can be specific about what happened 40 years ago? Specifically what was said. It's . . . dramatic license.” ER8811, ER4473-4474. Valli also provided no dialogue. ER3783. CA9 Br. 18. Thus, it may be inferred that where dialogue appears in *Jersey Boys* that also appears in the *Work*, the *Work* was the source, and as evidenced by the recorded interviews between Woodard and DeVito, Woodard was sometimes that source, rather than DeVito himself.

6. The inaugural planning meeting, with whiteboard, and notecards bearing expression from the *Work*; the marked-up Defendants’ Copy, with Elice’s annotations regarding “scenes” to include in *Jersey Boys*; the “First Scene Idea for Marshall;” and “The Thing,” were the earliest steps in an ongoing appropriation extending through every outline and draft script for the play. The *Work* was copied, not only for these earliest treatments, but also for more substantial outlines, dated March 11, ER10359; March

19, ER8663; and April 7, 2004, ER8735; complete draft scripts dated May 28, ER8830, and July 7, 2004, ER10471-10475; and, the final performance scripts for the play, in La Jolla, where it debuted; on Broadway; and in cities throughout the world. Certain outlines and draft scripts were also used to greenlight the production, or obtain approvals for the next phase of development. CA9 Br. 18. Finally, Elice admitted that he copied from the Work, or from notecards with its verbiage, for the earliest treatments, and later outlines; that such material carried into succeeding drafts; and, that he undertook no effort to remove it from the final scripts. CA9 Br. 16, 17, 19. For these reasons, petitioner maintains that *Jersey Boys* is a derivative work, based, in part, on the Work.

Petitioner's expert, Richard Krevolin, whose area of expertise is adaptation, has testified that "at least thirty percent of the play . . . is attributable to the Work," after accounting for the music and other creative elements," CA9 Br. 64; ER10741, and his report, which identifies all known similarities between the Work and each landmark outline, draft script, and final script for *Jersey Boys*, traces the adaptive process, and appears in the record at ER7301-7466.

7. McAnuff's pre-litigation interviews, including a podcast, stated that, upon reading the Work, which he described as "delicious," "beyond description," he was "smitten," and, "As soon as I read this material, I went, "This is a story that really needs to be told." Elice wrote that the Work provided the "guiding premise for the entire musical," while acknowledging that "another individual" besides DeVito "probably did most of the

‘writing.’” ER10260; CA9 Br. 15. And, in an interview with the *Los Angeles Times*, McAnuff and Elice identified the line in *Jersey Boys*, “We weren’t a social movement like the Beatles,” as a major theme of the play, that runs through all of the songs, saying: “That’s the moment in the show that people in the audience thank us for, that blue-collar speech.” And, this theme-establishing dialogue was admittedly paraphrased from the Work’s statement: “the Beatles come to represent a whole social movement. We never aspire to be more than entertainers.” CA9 Br. 19; ER3969; ER13234.

Upon learning of these and other public statements by respondents, reading about the play; speaking with Woodard’s sister, who saw it; and, investigating the registration status of the Work, and learning it was registered to DeVito alone, petitioner filed suit.

B. District Court Proceedings

Petitioner sued DeVito in Texas in 2007, for declaratory relief, breach of contract, and equitable accounting. The case was transferred to Nevada in 2008, and petitioner’s operative *Third Amended Complaint* included actions against DeVito, and the writers, director, and producers of *Jersey Boys*. for declaratory relief, equitable accounting, foreign infringement, and direct and secondary infringement, in the alternative. (App. 5a-6a); CA9 Br. 26-27.¹³

¹³Besides the copying of protected expression from the Work for the final *Jersey Boys* production, the complaint included actions for the intermediate copying in draft scripts used to

Petitioner ultimately settled with DeVito, who is not a respondent in this appeal. (App. 5a-6a); CA9 Br. 31.

The district court issued summary judgments adjudicating most of the claims. (App. 6a). First, it declared that the Work is a “joint work,” under 17 U.S.C. § 101; Woodard and DeVito were co-authors and co-owners thereof; and petitioner and DeVito are the current co-owners, each holding an undivided 50% share. (App. 6a, 51a). Second, it denied petitioner’s accounting claims against respondents, holding that the 1999 agreement for the play was not a transfer of copyright. CA9 Br. 27. However, it ruled that the agreement did convey a “selectively exclusive license” to Valli/Gaudio, which foreclosed petitioner’s U.S. and foreign infringement claims, and issued judgments releasing all respondents except DeVito from the case. *Id.* (App. 6a, 125a). Petitioner appealed. CA9 Br. 27.

C. The First Appeal

On February 10, 2015, the Ninth Circuit reversed, holding that the 1999 agreement was an assignment to Valli/Gaudio of DeVito’s share in the right to prepare derivative works based on the Work, but that fact issues remained for trial regarding whether the agreement lapsed under the reversionary clause discussed *supra*, p. 13. The court further held that DeVito did not grant respondents an implied license to use the Work. (App. 120a-151a, 6a).

greenlight the production; the distribution of copies of the Work; and unlicensed conveyances of rights therein. CA9 Br. 15-20, 63-64, 22-24; CA9 Rep. Br. 12, 29.

D. Proceedings Upon Remand

On remand, the district court revived, and granted in part, a motion for summary judgment on petitioner's infringement claims, dismissed as moot before the appeal. First, it held the Work is entitled to only "thin" protection against "virtually identical" copying." (App. 109a-112a, 116a). Then, adjudicating similarities between the works based on two "bullet-lists" in Mr. Krevolin's 148-page report (App. 113a-117a); ER10593, the court: (1) applied copyright estoppel, without using the term, to exclude over 100 similarities from consideration, including 22 involving fictitious and erroneous matter (App. 114a-117a);¹⁴ (2) dismissed other similarities as the copying of "ordinary phrases" (App. 114a-117a); (3) held that DeVito's characterizations of real persons are "not protected by copyright" (App. 115a, n. 5); and (4) treated dialogue as "historical fact." (App. 114a-117a).¹⁵ The order left only four similarities for trial (App. 116a) under a "virtual identity" standard for infringement.¹⁶

The trial commenced in October 2016. Before trial, the parties stipulated that the 1999 agreement

¹⁴The court examined 68 similarities involving the La Jolla production, and 90 involving the Broadway production.

¹⁵ A chart, showing the court's disposition of these similarities appears at ER7856.

¹⁶ Petitioner moved for reconsideration, but the motion was denied. ER7885; ER782. Petitioner also moved to certify the order for interlocutory appeal, but the motion was denied. ER7595; ER736.

lapsed, ER657, eliminating the accounting claims against respondents, and leaving only infringement claims for trial. During the trial, the court expanded the number of similarities the jury could consider, but only from four to twelve, CA9 Br. 34; prohibited petitioner from arguing that *Jersey Boys* is a derivative work, or from mentioning “adaptation” in front of the jury, *id.* at 37; rejected petitioner’s claims concerning the draft scripts, CA9 Rep. Br. 10-12; and denied petitioner’s request for an instruction that “combinations of unprotectable elements” may be entitled to copyright protection. *Id.* at 30-31. Finally, on November 16, 2016, at the conclusion of petitioner’s case, the court granted JMOLs for Valli/Gaudio on direct and secondary liability for infringement. CA9 Br. 37-38.

Despite these obstacles, on November 28, 2016, the jury found that: (1) *Jersey Boys* infringes the Work; (2) DeVito did not grant an implied license to respondents; (3) respondents’ uses were not fair; (4) 10% of *Jersey Boys*’ success is attributable to respondents’ infringements; and, (5) respondents were liable for direct infringement. CA9 Br. 39.

Following the verdicts, the district court granted respondents’ renewed motion for JMOL on fair use, and motions for new trial on implied license and apportionment. But the court denied motions for JMOL on other grounds, and left the infringement verdicts intact (App. 79a), noting: “[t]here was evidence adduced at trial of direct copying and more than de minimis use” (App. 74a), and “the jury could have properly found that the average audience familiar with the Work

would recognize the protected, copied portions in the Play.” (App. 75a). Petitioner again appealed.

E. The Ninth Circuit’s Decision

The Ninth Circuit affirmed the district court’s judgments, but solely on alternate grounds; namely, that *Jersey Boys* does not infringe the Work. (App. 3a). Limiting its review to the twelve similarities identified for the jury by the district court, the court of appeals held that six pertain to unprotectable elements of the Work, because they are “historical,” “ordinary phrases” or “scenes a faire” (App. 14a-18a), and the remainder are barred by an analogue of copyright estoppel, coined the “asserted truths doctrine.” (App. 19a-32a).

With respect to the initial six, the Ninth Circuit first held that the Work’s characterizations and descriptions of DeVito cannot be “original,” because “DeVito is not a fictional character,” and “a character based on a historical figure is not protected.” (App. 14a). The court also held unprotectable the Work’s expression that the Four Seasons, unlike the Beatles, did not represent a social movement, but instead were merely entertainers, stating the Work is not likely the first to describe the *Beatles* as a social movement, and calling the phrase “all but inevitable” in the expression of that idea. (App. 16a-17a). Finally, the court held that using “time machine” to describe the feelings of a former band member at a reunion, is both scenes a faire, and an unprotectable ordinary phrase. (App. 18a). The decision does not mention the other dialogue copied for this scene and asserted by petitioner, and words such as “paraphrase” and “adapt” are absent

from its text.

For the remaining similarities, the Ninth Circuit unveiled its “asserted truths doctrine,” ostensibly derived from the doctrine of copyright estoppel, which the decision references. (App. 12a, 19a). But the decision expressly “rejects” that terminology, and the underlying equitable rationale (App. 23a), grounding the doctrine in the Copyright Clause instead. According to the court, it would hinder the progress of science to permit a copyright owner to spring an infringement suit on subsequent authors who “built freely” on a work held out as factual. (App. 20a-21a). Moreover, the decision rejects the notion that copyright estoppel requires publication, or public representations of truthfulness, before it may be invoked (App. 22a), and suggests that any such requirement rests on the detrimental reliance and culpability concepts connected to the now-rejected “estoppel” terminology. (App. 23a). Finally, the decision announces that the asserted truths doctrine “applies not only to the narrative but also dialogue reproduced in a historical nonfiction work represented to be entirely truthful.” (App. 24a).

Based on this doctrine, and the court of appeals’ belief that the Work promises a “complete and truthful chronicle of the Four Seasons,” *see supra*, p. 10, the Ninth Circuit held that the Work’s account of Valli’s introduction to Mary, and characterizations of her, are not protectable, whether or not fictitious (App. 27a); that the account of DeVito’s childhood intercession on behalf of a young Valli upon his arrest, is unprotectable fact (App. 27-28); that the characterization of Gaudio at a “Roman Orgy,” and dialogue attributed to him at the

event, are also unprotected asserted truths; and that the dialogue Woodard wrote for the “Walk Like a Man” recording session and faked murder in Valli’s car, now reside in the public domain, despite the fact that the Work remains unpublished. Finally, it led to the judgment entered on September 8, 2020, which leaves little protectable expression in the Work.

The Ninth Circuit denied rehearing on November 13, 2020, and this petition followed.

REASONS FOR GRANTING THE WRIT

I. The Ninth Circuit’s Newly-Adopted “Asserted Truths Doctrine” Departs from Traditional Principles of Equity; Decides Important Questions of Federal Law Which Should Be Settled By This Court; and Conflicts with Relevant Decisions of Other Circuits and This Court.

A. The Purposes of Copyright Law, Traditional Contours of Copyright Protection, and the First Amendment

The primary purpose of copyright law is to promote the progress of science and useful arts, and increase, rather than impede, the flow of knowledge. *Feist*, 499 U.S. at 349-350; *Harper & Row*, 471 U.S. at 545; *Golan*, 565 U.S. at 324. However, as this Court cautioned in *Harper & Row*, sufficient deference must be accorded the “scheme established by the Copyright Act for fostering the original works that provide the seed and substance of this harvest.” 471 U.S. at 545-

546. The Framers intended copyright to be the “engine of free expression,” *id.* at 558, by rewarding individual authors to benefit the public, and “[t]his principle applies equally to works of fiction and nonfiction.” *Id.* at 546 (citation omitted). “It is fundamentally at odds with the scheme of copyright to accord lesser rights to those works that are of greatest importance to the public.” *Id.* at 559. Establishing “a marketable right to the use of one’s expression” supplies the economic incentive to create and disseminate ideas. *Golan*, 565 U.S. at 328. And “copyright assures those who write and publish factual narratives . . . that they may at least enjoy the right to market the original expression contained therein as just compensation for their investment.” *Harper & Row*, 471 U.S. at 556.

It is for Congress, not the courts to decide how best to pursue the Copyright Clause’s objectives, and Congress has been assigned the task of defining the scope of rights that should be granted to authors, to provide appropriate access to their work product. *Eldred*, 537 U.S. at 212-213. The Copyright Clause empowers Congress to determine the intellectual property regimes which, “in its best judgment, will serve the ends of the Clause.” *Golan*, 565 U.S. at 325. And, that “delicate balance” is struck in the Copyright Act.

The traditional contours of copyright protection consist of of the “idea/expression dichotomy” and the “fair use” defense, *id.* at 328, both of which also serve as “built-in First Amendment accommodations.” *Eldred*, 537 U.S. at 219. The idea/expression dichotomy is codified at 17 U.S.C. § 102(b), which provides: “In no

case does copyright protec[t] . . . any idea procedure process, system, method of operation, concept, principle, or discovery, described, explained, illustrated, or embodied in [the copyrighted] work.” Due to this dichotomy, “every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication: the author’s expression alone gains copyright protection.” *Golan*, 565 U.S. at 328 (citing *Eldred*, 537 U.S. at 219). This permits the free communication of facts while still protecting an author’s expression. 565 U.S. at 329; *Harper & Row*, 471 U.S. at 556.

The second traditional contour, “fair use,” codified at 17 U.S.C. § 107, “allows the public to use not only facts and ideas contained in a copyrighted work, but also [the author’s] expression itself in certain circumstances.” *Golan*, 565 U.S. at 328.

The Copyright Act also accommodates negative free speech rights -- the countervailing First Amendment interest in “freedom of thought and expression [that] ‘includes both the right to speak freely and the right to refrain from speaking at all.’” *Harper & Row*, 471 U.S. at 559 (quoting *Wooley v. Maynard*, 430 U.S. 705, 714 (1977)). See also *Pac. Gas & Elec. Co. v. Pub. Utils. Com.*, 475 U.S. 1, 32-33 (1986) (Rehnquist J, dissenting). This is accomplished through the right of first publication, codified at 17 U.S.C. § 106(3), under which, a copyright owner has the right to control the first public distribution of of his or her work. *Id.*

Prior to the current Copyright Act, the right of

first publication was secured by common law copyright – “the property of an author . . . in his intellectual creation [was] absolute until he voluntarily [parted] with the same.” *Harper & Row*, 471 U.S. at 551 (citing *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299 (1907)). Today, that absolute control is tempered somewhat by the fair use doctrine, which, since the 1992 amendment to 17 U.S.C. § 107, has been the method designated by Congress for making lawful, unlicensed use of an unpublished work. *Id.* Still, this court has recognized what every author surely knows – that “[t]he period encompassing the work's initiation, its preparation, and its grooming for public dissemination is a crucial one for any literary endeavor.” *Harper & Row*, 471 U.S. at 554=555.

“The sine qua non of copyright is originality,” *Feist*, 499 U.S. at 345, and it is a “constitutional mandate.” *Id.* at 346.”Original” means only that the work was independently created by the author, and that it possesses at least some minimal degree of creativity. *Id.* The requisite level of creativity is extremely low; even a slight amount will suffice.” *Id.* at 340. But no one may claim originality as to facts, because facts do not owe their origin to authorship – they are discovered, rather than created. *Id.* at 347

Under this scheme, original expression is protected, before and after publication, unless fair use applies. *Id.* at 548; 17 U.S.C. § 107.

B. The Equitable Doctrine of Copyright Estoppel

Although the Court has not previously addressed this issue, it is not surprising, given the traditional contours of copyright, and the constitutional mandate of originality, that many lower courts follow the general rule that: “fictional elements, or fictionalized versions of factual elements, of an otherwise factual work, are protectable under copyright law.” *E.g., Houts v. Universal City Studios, Inc.*, 603 F.Supp. 26, 28 (C.D. Cal. 1984) (citing 1 *Nimmer on Copyright* § 2.11(c)). *See also Effie Film, LLC v. Pomerance*, 909 F. Supp. 2d 273, 297 (S.D.N.Y. 2012).¹⁷ Absent a countervailing equitable doctrine, this seems unavoidable. Such expression would be “original,” and thus protected, subject only to fair use.

Copyright estoppel is an exception to this general rule. Under the doctrine of copyright estoppel, once a plaintiff's work has been held out to the public as entirely factual, the author-plaintiff cannot then claim that the work is, in actuality, fiction and thus entitled to the higher protection allowed to fictional works. *Nester's Map & Guide Corp. v. Hagstrom Map Co.*, 796 F. Supp. 729, 733 (E.D.N.Y. 1992); *Houts*, 603 F.Supp. at 28. *See also* William F. Patry, 2 *Patry on Copyright* § 4:8 (Sept. 2015) (“Where plaintiff has previously asserted his or her work is “entirely factual” . . . plaintiff should be estopped from later claiming to the contrary Having deceived the public . . . plaintiff should not later reap the benefit from a

¹⁷*See also Greenbie v. Noble*, 151 F. Supp. 45, 65 (D.N.Y. 1957) (fictionalizing events and incidents in life of historic figure protectable); *De Acosta v. Brown*, 146 F.2d 408, 409 (2d Cir. 1944) (original treatment of historic character).

contrary position.”).

The earliest known decision applying the doctrine is *Davies v. Bowes*, 209 F.53 (S.D.N.Y. 1913), in which an author-plaintiff who had published an article in the newspaper, was not permitted to later claim in a litigation that it was fiction. The court held: “it is a matter of morals that he who puts forth a thing as verity shall not be heard to allege for profit that it is fiction.” *Id.* at 55. The court noted that “it was *printed* as news; it was presented *to the public* as a matter of fact and not of fiction; [and] the readers of the Sun were invited to believe it” 209 F. at 55. Although the words “copyright estoppel” were not employed, the essential elements of the doctrine were present. Most of the cases refer to a representation made “to the public;” most indicate that the work must be represented to be “entirely true,” and in every instance, the dispute involves a published work. Never in the history of U.S. jurisprudence has copyright estoppel been applied to an unpublished work.

The Ninth Circuit avers that petitioner’s assertion that copyright estoppel may be applied only to published works, or works for which “public” representations have been made, “has no basis in either the case law or the doctrine of copyright law.” (App. 23a), and states that the phrase, “to the public” appeared in only one unpublished case the court reviewed. (*Id.*). But most copyright estoppel cases *do* include such verbiage, and every such case involves either a work that was published, or a public representation regarding a work. *E.g.*, *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1075 (2d Cir. 1992)

(“expressly represented to the world”); *Hughes v. Fox Broad. Co.*, 2007 U.S. Dist. LEXIS 117783, *25-27 (W.D. Mo. Oct. 10, 2007) (“to the public”); *Marshall v. Yates*, 1983 U.S. Dist. LEXIS 12305, *6-7 (C.D. Cal. Oct. 26, 1983) (“presented to the public as a non-fiction work”); *Nash v. CBS, Inc.*, 691 F. Supp. 140, 142 (N.D. Ill. 1988) (“held out to the public as factual”); *Nester’s Map & Guide Corp.*, 796 F. Supp. at 731 (“held out to the public as factual”); *Oliver v. Saint Germain Foundation*, 41 F. Supp. 296 (S.D. Cal. 1941) (“held out to the public”).

Additionally, the relationship between copyright estoppel and publication almost certainly involves right of first publication concerns. When the doctrine of copyright estoppel arose, federal copyright protection commenced on publication. Prior to publication, only state common law copyright was available. And then, perhaps even more than now, publication marked the point at which the author’s ideas were released into the world. Before that time, while a work remains unpublished, an author has absolute control over his work. To the extent that copyright estoppel would encroach upon the right of first publication, by excusing violations thereof, as an alternative to employing the fair use defense, it would create conflict, not only with that right, but also with the manifest intentions of Congress, which amending the fair use provisions of the Copyright Act in 1992, to make fair use the mechanism for appropriations from unpublished works. Finally, it would be inequitable, leading to circumstances such as those in this case, where the act of purloining a manuscript that was not yet intended or ready for circulation, It would also be inequitable,

leading to circumstance such as those that arose in this case. The law should not be such that someone can steal a private unfinished manuscript from a desk drawer, and, because there are representations of truthfulness within it, copy original expression therefrom, the right of first publication would be meaningless, along with the negative free speech rights it helps protect.

Finally, at present there are questions regarding whether copyright estoppel necessarily applies to histories and biographies. Copyright commentators have suggested that the answer is no. Nimmer, for example, has long maintained:

[W]ith respect to histories and biographies, there is some indication that the courts will not imply a representation that the work is entirely factual, and consequently, will not raise such an estoppel against the authors of such works, in the absence of an express representation that the entire work is factual. This is in accord with the accepted literary usage that histories and biographies may to some minor degree be fictionalized in order to more accurately convey the flavor of the period or persons depicted.

1-2 *Nimmer on Copyright* § 2.11[C]

Speaking of a different kind of copyright estoppel, the Southern District of New York has warned: “Estoppel [in a copyright action] is drastic remedy, and must be utilized sparingly.” *Cooley v. Penguin Grp. (USA) Inc.*, 31 F. Supp. 3d 599, 613

(S.D.N.Y. 2014), as corrected (July 14, 2014) This is true, regardless of the type of estoppel involved. Any judicially-created doctrine that eliminates copyright protection for original works of authorship should be used sparingly, if at all, given the purposes of the Copyright Clause and Copyright Act to protect and reward an author's original expression, to stimulate creativity and advance the progress of science.

C. The Ninth Circuit's "Asserted Truths Doctrine," and Its Constitutional, Statutory, and Common Law Defects

As discussed, *supra*, pp. 4, the Ninth Circuit's asserted truths doctrine alters the traditional contours of copyright protection in ways reserved for Congress, bypassing fair use as the Congressionally-specified mechanism for permissible use of unpublished works. The 1992 amendments to the Copyright Act created an opportunity, subject to the equitable principles and elements of fair use, to make permissible, unlicensed use of original expression in unpublished works in limited circumstances. But Congress has not passed legislation permitting others, outside of the Congressional body, to invalidate or reclassify original expression, otherwise protected by our copyright laws, for reasons other than equitable ones.

Courts have the power to employ equitable doctrines and remedies to help "avoid the unfairness that might otherwise result if legal rules are applied strictly to every case no matter how unusual the circumstances." *Petrella*, 572 U.S. at 688 (Breyer, J.,

dissenting). But copyright estoppel exists for that purpose already, and has been used therefor for 108 years. The asserted truths doctrine strips copyright estoppel of its equitable foundations without cause, and accordingly, warrants the scrutiny of this Court. See *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 394-95, (2006) (Roberts, CJ, concurring) (“a major departure from the long tradition of equity practice should not be lightly implied). But it also conflicts with other courts and legal doctrines, warranting this Court’s review.

1. The Asserted Truths Doctrine’s Treatment of Dialogue Creates a Conflict with the Tenth Circuit and Tensions with This Court.

The Ninth Circuit’s asserted truths doctrine “applies . . . to dialogue reproduced in a historical nonfiction work represented to be entirely truthful.” (App. 24a), and stripped the Work of all protection for the fictitious and reconstructed dialogue created by Woodard and DeVito.

It is clear that one cannot copyright the actual statements of others reported in a work, because they are not original. *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148-49 (D.D.C. 1980). However, if the statements were not contemporaneously recorded, but instead, are fictionalized or reconstructed from memory, they exhibit originality, and sufficient creativity, to warrant protection. Finally, even if the purported statements of third parties were not protectable, DeVito’s first written account, in the Work, of his own prior oral remarks, is protectable, and was

protected in *Harper & Row*, which also involved a biographer memoir purloined by the defendants therein.

In the Tenth Circuit, reconstructed and fictitious dialogue are protected in biographies. This is because such authorship involves creativity, and is sufficiently original to meet the minimum constitutional threshold. *Jacobsen*, 287 F.3d at 947. As stated by the Tenth Circuit:

We agree quotations may be freely copied if the quotation is recorded contemporaneously or taken directly from a written source as in *Suid*. Dr. Jacobsen did not, however, contemporaneously record the quotations or copy them from a written source. For this reason, a trier of fact might conclude the material in quotation marks in *Who Refused to Die* was original expression rather than the actual words used.

This is consistent with the holdings of other courts, including *Harris v. Miller*, 50 U.S.P.Q. 306, (S.D.N.Y. 1941), wherein the court held:

It is apparent no stenographer was present and that the statement of the conversations is the biographer's version, the result of his literary effort. If Harris was only trying to reconstruct the conversations he had with Wilde that would be authorship There is no point to compare these conversations to a bald statement of historical facts, which cannot be copyrighted

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully Submitted,

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APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

No. 17-16337

D.C. No. 2:08-cv-00867-RCJ-PAL

DONNA CORBELLO,

Plaintiff-Appellant,

v.

FRANKI VALLI; ROBERT J. GAUDIO; MARSHALL
BRICKMAN; ERIC S. ELICE; DES MCANUFF;
DSHT, INC., FKA DODGER STATE HOLDING
THEATRICALS, INC.; DODGER THEATRICALS, LTD.;
JB VIVA VEGAS, LP; MICHAEL S. DAVID;
JERSEY BOYS BROADWAY LIMITED PARTNERSHIP;
JERSEY BOYS RECORDS LIMITED PARTNERSHIP;
SKUNK, INC.; GETTING HOME, INC.,

Defendants- Appellees.

Appeal from the United States
District Court for the District of Nevada
Robert Clive Jones, District Judge, Presiding

Argued and Submitted June 11, 2019
Anchorage, Alaska

Filed: September 8, 2020

OPINION

Before: A. Wallace Tashima, William A. Fletcher, and
Marsha S. Berzon, Circuit Judges.

BERZON, Circuit Judge:

The musical *Jersey Boys* depicts the history of a popular musical quartet, the Four Seasons (“the Band”), from its origins in Belleville, New Jersey, in the 1950s, to the Band’s induction into the Rock and Roll Hall of Fame in 1990. Four Seasons hits such as “Walk Like a Man,” “Big Girls Don’t Cry,” and “Sherry” accompany the play’s dialogue, recreating the Band’s musical legacy on stage. *Jersey Boys* (“the Play”) debuted on Broadway in 2005 and ran for over ten years, toured the country repeatedly, and was adapted as a movie in 2014.

In the late 1980s, Band member Tommy DeVito partnered with Rex Woodard to write a book telling “the whole story” of The Four Seasons. The result of this partnership was an autobiography of DeVito (“the Work”), ghostwritten by Woodard and completed before the Play was developed.

Our question is whether Four Seasons front man Frankie Valli and other defendants associated with *Jersey Boys* infringed Woodard’s copyright in the autobiography, now owned by Donna Corbello, Woodard’s surviving wife. After many years of litigation, including several summary judgment orders, one previous appeal, and a trial, the district court granted judgment as a matter of law (“JMOL”) on *971 the basis that much of the alleged infringement concerned unprotected elements of the Work, and that any infringement of protected elements

was fair use. We affirm on the sole ground that *Jersey Boys* did not infringe DeVito's biography, and so do not reach the district court's fair use rationale.

Our decision rests primarily on “the unremarkable proposition that facts, in and of themselves, may not be form [*sic*] the basis for a copyright claim.” 1 Nimmer on Copyright § 2.11(A). Although books generally contain the author's creative expression, protectable by copyright, a nonfiction biography like the work in this case is necessarily structured around historical facts and events, not themselves copyrightable. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985).

On close examination, each of the alleged similarities between the Play and the Work are based on historical facts, common phrases and *scenes-a-faire* (scenes that are “indispensable, or at least standard, in the treatment of a given idea,” *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994) (internal alteration and quotation marks omitted)), or elements that were treated as facts in the Work and are thus unprotected by copyright, even though now challenged as fictional. Neither Valli nor the other defendants violated Corbello's copyright by depicting in the Play events in their own lives that are also documented in the Work. Because the Play did not copy any *protected* elements of the Work, we conclude, there was no copyright infringement.

I. Background

A. Factual History

Rex Woodard was an attorney, a writer, and a devoted Four Seasons fan. In 1988, Woodard agreed to ghostwrite the autobiography of Tommy DeVito, one of the original members of the Four Seasons, and to share equally in any profits arising from the book. Woodard completed the autobiography in early 1991, but he and DeVito were unable to find a publisher before Woodard's death that same year. Woodard's widow, Donna Corbello, is the successor to Woodard's interest in the Work. Corbello and Woodard's sister Cindy Ceen continued the search for a publisher after Woodard's death, still without success.

The Work reads as a straightforward historical account and is presented as an autobiography, with DeVito listed as a co-author. At the outset of the Work, the first-person narrator, whom the reader understands is DeVito, describes the book as the “complete and truthful chronicle of the Four Seasons.” The narrator contrasts the Work with assertedly inaccurate accounts that others had published, and notes his own “candor.” In addition, Woodard and Corbello both emphasized in letters to potential publishers that the Work provided a behind-the-scenes factual look at the Four Seasons.

Ceen contacted DeVito in September 2005 to discuss her family's continuing interest in publishing the Work. She noted that she and Corbello were considering self-publishing the Work if they could not “attract a recognized publishing company.” A few months later, DeVito's attorney told Ceen that DeVito had concluded that the Work was “not saleable.”

The musical *Jersey Boys* debuted soon after. A smash hit, it garnered four Tony Awards. Hopeful that the show could renew interest in the Band, Corbello and Ceen sought to confirm the registration of Woodard's and DeVito's copyright in the Work.

The U.S. Copyright Office's records, it turned out, indicated that shortly before Woodard's death in 1991, DeVito had registered *972 the Work solely under his own name. The copy deposited with DeVito's copyright application was identical to the Work written by Woodard with two exceptions: the title page now excluded Woodard and changed the title, and a single page in Chapter 41 was missing. Corbello was eventually able, without DeVito's cooperation, to secure recognition of Woodard as a co-author and co-claimant of the copyrighted Work; Corbello's copyright of the work was registered in 2007.

Around the same time, Corbello learned through news accounts that writers of the Play had had access to the Work while creating the production and that DeVito was profiting from the Play's success. DeVito confirmed that he had provided a copy of the Work to individuals who were involved with developing the Play to use in their research.

B. Procedural History

In 2007, Corbello sued DeVito for breach of contract and an equitable accounting, among other claims. The operative third amended complaint listed fourteen defendants – band members DeVito, Frankie Valli, and Bob Gaudio, as well as writers, directors, and producers of the Play (and related entities – and twenty causes of action, including various forms of copyright infringement. DeVito subsequently settled

with Corbello and is not a party to this appeal.

The district court issued summary judgment orders that, taken together, adjudicated most of the claims. The court first declared that the Work was a joint work, that Woodard was a co-owner, and that Corbello, as successor-in-interest to her husband, had a 50 percent interest in the Work. But the court then entered summary judgment in favor of all defendants other than DeVito and one producer of the Play based on its interpretation of a contract between DeVito, Valli, and Gaudio.

A panel of this court reversed in part. *Corbello v. DeVito*, 777 F.3d 1058, 1066 (9th Cir. 2015). *Corbello* held that a material issue of fact remained regarding the construction of DeVito's contract with Valli and Gaudio. *Id.* at 1064, 1066. Concurring, Judge Sack noted that “it would vastly simplify matters. . . if [on remand] the district court first decided the defendants' summary judgment motion arguing that *Jersey Boys* does not infringe the Work as a matter of law in any event, an issue which it previously avoided by granting summary judgment on contract grounds. That might be the end of the matter as far as ‘Jersey Boys’ Valli and Gaudio are concerned irrespective of the difficult issues that the majority and we address here.” *Corbello*, 777 F.3d at 1073 (Sack, J., concurring) (citations omitted).

On remand, the district court granted summary judgment in part, holding that, while there was substantial similarity sufficient to avoid summary judgment at least with respect to “thin” copyright protection, most of the similarities were based on historical fact or ordinary phrases, and the similarities

based on protectable material were insufficient to entitle the work to regular “thick” protection as a matter of law. That ruling had large impact on the scope of the trial and on the jury instructions, as explained later, *infra* pp. 974–75.

The case proceeded to trial. The jury found for Corbello on the contract issue, and, on the infringement claim, found that the Play infringed the Work, use of the Work was not fair use, and 10% of the success of the Play was attributable to infringement of the Work. The jury was not asked to calculate or award damages.

After the verdict, the district court granted the Defendant's motion for JMOL as to fair use, denied Defendant's motion for JMOL on other grounds, and granted a *973 motion for a new trial on apportionment. This appeal followed.

We review the grant of judgment as matter of law de novo, *Spencer v. Peters*, 857 F.3d 789, 797 (9th Cir. 2017), viewing the evidence in the light most favorable to the non-moving party, *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150, 120 S.Ct. 2097, 147 L.Ed.2d 105 (2000); *Torres v. City of Los Angeles*, 548 F.3d 1197, 1205–06 (9th Cir. 2008). Grant of new trial under Rule 59 is reviewed for abuse of discretion. *Kode v. Carlson*, 596 F.3d 608, 612–13 (9th Cir. 2010).

II. Discussion

Some basic precepts of copyright law are at play in this case, so we begin with fundamentals.

“To qualify for copyright protection, a work must be original to the author.” *Feist Publ'ns, Inc. v. Rural*

Tel. Serv. Co., 499 U.S. 340, 345, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991) (citing *Harper & Row*, 471 U.S. at 547–49, 105 S.Ct. 2218). A work is original if it is created by the author with “at least some minimal degree of creativity.” *Id.* Although the “[c]reation of a nonfiction work, even a compilation of pure fact, entails originality,” *Harper & Row*, 471 U.S. at 547, 105 S.Ct. 2218, “[n]o author may copyright his ideas or the facts he narrates,” *id.* at 556, 105 S.Ct. 2218. Copyright law, in other words, protects authors’ original expression in their work but does not protect ideas and facts. *Id.* at 547, 105 S.Ct. 2218.

This division as to the copyright protection accorded creative expression on the one hand and the lack of such protection for facts and ideas on the other often leads to the need to delineate, with respect to the copyright protection accorded a particular work, whether the particular claim of infringement concerns the protected or the unprotected aspects of the work. “The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author.” *Feist Publ’ns.*, 499 U.S. at 348, 111 S.Ct. 1282. As a result, “copyright does not prevent subsequent users from copying from a prior author’s work those constituent elements that are not original – for example, . . . facts.” *Harper & Row*, 471 U.S. at 548, 105 S.Ct. 2218.

It is thus a feature of copyright law, not a bug or anomaly, that an author who deals in fact rather than fiction receives incomplete copyright protection for the results of his labor. “The primary objective of copyright

is not to reward the labor of authors, but ‘to promote the Progress of Science and useful Arts.’” *Feist Publ’ns.*, 499 U.S. at 349, 111 S.Ct. 1282 (alteration omitted) (quoting U.S. Const. Art. I, § 8, cl. 8). “To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.” *Id.* at 349–50, 111 S.Ct. 1282 (citation omitted).

It is against this backdrop that we must evaluate Corbello’s claims alleging infringement of the Work, a nonfiction autobiography. “Proof of copyright infringement requires [a plaintiff] to show: (1) that he owns a valid copyright. . .;¹ and (2) that [the defendant] copied protected aspects of the work.” *Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1064 (9th Cir. 2020) (en banc) (citing *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1116–17 (9th Cir. 2018)).

Only the second element is here at issue. “The second prong of the infringement analysis contains two separate *974 components: ‘copying’ and ‘unlawful appropriation.’” *Id.* (quoting *Rentmeester*, 883 F.3d at 1117). Copying can be demonstrated either through direct evidence or “by showing that the defendant had access to the plaintiff’s work and that the two works share similarities probative of copying,” while “the hallmark of ‘unlawful appropriation’ is that the works share *substantial* similarities.” *Id.*

Similarity only as to unprotected aspects of a work does not result in liability for copyright infringement. *See id.*; *see also Harper House, Inc. v. Thomas Nelson*,

¹ Defendants do not dispute that Corbello is a joint owner of the Work.

Inc., 889 F.2d 197, 207–08 (9th Cir. 1989). So, “[t]o determine whether similarities result from unprotectable expression, analytic dissection of *similarities* may be performed. If this demonstrates that all similarities in expression arise from use of common ideas, then no substantial similarity can be found.” *Data E. USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1988) (citing *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987)).

The parties’ central disagreements in this case are whether the Play is substantially similar to the Work and whether the defendants copied any protectable portions of the Work. “The substantial- similarity test contains an extrinsic and intrinsic component.” *Funky Films, Inc. v. Time Warner Ent. Co., L.P.*, 462 F.3d 1072, 1077 (9th Cir. 2006), *overruled on other grounds by Skidmore*, 952 F.3d 1051. The extrinsic test requires a three- step analysis: (1) the plaintiff identifies similarities between the copyrighted work and the accused work; (2) of those similarities, the court disregards any that are based on unprotectable material or authorized use; and (3) the court must determine the scope of protection (“thick” or “thin”) to which the remainder is entitled “as a whole.” *Apple Computer*, 35 F.3d at 1443 (referring to what we here call “thick” protection as “broad” protection). Only if the extrinsic analysis succeeds does the so- called “intrinsic” analysis take place. *See Funky Films*, 462 F.3d at 1077. The intrinsic test “examines an ordinary person’s subjective impressions of the similarities between two works,” and involves questions of fact determined by the jury under instructions as to the level of protection applicable. *Funky Films*, 462 F.3d at 1077 (citing *Shaw v. Lindheim*, 919 F.2d 1353,

1360–61 (9th Cir. 1990)).

Applying this framework, the district court, before trial, conducted the extrinsic analysis and granted partial summary judgment for the defendants, concluding that much of the alleged infringement in this case involved either elements original to the Play or similarities between the Play and unprotected elements of the Work, such as “historical fact[s] or ordinary phrases.” Twelve alleged similarities between the Work and the Play survived this initial review and went to the jury.² *975 In its post-trial order granting

² Corbello argues that the district court improperly limited the jury’s consideration to twelve potentially protectable similarities, because she should have been able to seek protection for the original selection and arrangement of otherwise unprotectable elements. “We have extended copyright protection to ‘a combination of unprotectable elements . . . only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.’” *Skidmore*, 952 F.3d at 1074 (alteration in original) (quoting *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003)). “Put another way, what a selection and arrangement copyright protects is the particular way in which the artistic elements form a coherent pattern, synthesis, or design.” *Id.*

There is no viable arrangement and selection argument here, both because the unprotectable elements that appear in both the Play and the Work are not “numerous enough” and because, even if there were an original “synthesis” of those elements in the Work, it is not present in the Play. *See id.* The selection of the true stories behind the Band’s most popular songs and the arrangement of those stories in roughly chronological order is not original, and so not protectable by copyright. The Work and the Play depict those historical events from different perspectives, with different characterizations of the people involved, in different media, and communicating a different overall message. “Without [a particular, original] arrangement, there is no liability for taking

JMOL for Defendants, the district court concluded that most of the twelve remaining similarities were aspects of the Work not protectable by copyright. The court undertook this analysis as part of its conclusion that any infringement was fair use and did not explicitly frame its conclusions as rulings on infringement.

We conclude that all twelve similarities the jury considered were not infringing, some under an analysis similar to that used in the district court's order and others under what some courts have referred to as the doctrine of copyright estoppel.³

We discuss each category in turn.

'ideas and concepts' from the plaintiff's work, 'even in combination.'" *Id.* at 1075 (quoting *Rentmeester*, 883 F.3d at 1122–23).

³ We may affirm entirely on the ground that the Play did not infringe protected aspects of the Work, rather than relying at all on the district court's fair use rationale, even though Defendants did not cross-appeal the infringement verdict. "An appellee who does not take a cross-appeal may 'urge in support of a decree any matter appearing in the record, although his argument may involve an attack upon the reasoning of the lower court.'" *Jennings v. Stephens*, 574 U.S. 271, 135 S. Ct. 793, 798, 190 L.Ed.2d 662 (2015) (quoting *United States v. Am. Ry. Express Co.*, 265 U.S. 425, 435, 44 S.Ct. 560, 68 L.Ed. 1087 (1924)). The appellee must file a cross-appeal only if he is "attack[ing] the decree with a view either to enlarging his own rights thereunder or of lessening the rights of his adversary." *Id.* Our decision will neither enlarge Defendants' rights nor lessen Corbello's. The district court granted judgment in favor of Defendants. As a result of our affirmance on alternative grounds, it remains true that Defendants are not liable to Corbello, so all parties remain in the same position they were as a result of the district court's judgment.

A. Application of the Extrinsic Test to Elements of the Work that Are Undisputedly Factual

We first carefully examine whether the alleged copying or similarities are based on protectable elements of the copyrighted work. The extrinsic test for substantial similarity lays out a useful framework for this inquiry.

“Extrinsic analysis is objective in nature,” and examines “articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events in the two works.” *Funky Films*, 462 F.3d at 1077 (internal quotation marks omitted). “Protectable expression includes the specific details of an author’s rendering of ideas. . . . [The court] must take care to inquire only whether the *protectable elements, standing alone*, are substantially similar. In so doing, we filter out and disregard the non-protectable elements.” *Id.* (citations and internal quotation marks omitted). Non-protectable elements include ideas; historical facts; common phrases; *scenes-a-faire* (that is, “situations and incidents that flow necessarily or naturally from a basic plot premise” or generic plot line) and “[f]amiliar stock scenes and themes that are staples of literature.” *Benay v. Warner Bros. Ent., Inc.*, 607 F.3d 620, 624–25 (9th Cir. 2010) (citations omitted), *overruled on other grounds by Skidmore*, 952 F.3d 1051; *see also Narell v. Freeman*, 872 F.2d 907, 910–11 (9th Cir. 1989).

As the district court correctly summarized,

[t]he Work is a work of historical fact, as recounted by DeVito with the assistance *976 of Woodard’s writing skills. The creative aspects of the Work do not generally concern

things like character, plot, and setting, but rather writing style and presentation. Neither DeVito nor Woodard created or even claimed to have created any characters, plot lines, settings, etc.

Though the creative expression that is in the Work – the “writing style and presentation” – is protected by copyright, the assertedly historical elements are not.

Each of the six similarities between the Play and the Work discussed below fails the extrinsic test for substantial similarity because each involves only non-protectable elements of the Work.

1. Tommy DeVito’s Introduction

Chapter One of the Work introduces Tommy DeVito “hanging out on a Jersey Street Corner” with his friends, “puff[ing] on cigarettes and dar[ing] anyone to mess with [them,] . . . cool beyond belief.” At the outset of the Play, the DeVito character addresses the audience, his cool demeanor on display. Corbello alleged that this description of DeVito is substantially similar to the one in the Play and so infringing. But DeVito is not a fictional character whose personality was created in the Work. This depiction of DeVito – as Corbello’s expert put it, his “voice, cool demeanor, and braggadocio” – is not original to the Work, and so not a protectable element. *See Benay*, 607 F.3d at 627. A character based on a historical figure is not protected for copyright purposes. *Id.*

2. Introduction of the Song “Sherry”

Both the Play and the Work depict Bob Gaudio arriving late to a rehearsal excited about a new song he just wrote, “Sherry,” which — no surprise —

became a major hit. In the Work, DeVito recalls that he liked the song but “didn’t think [they] could get away with it,” because it was “clearly intended for someone younger than us.” In the Play, DeVito says it was a “fuckin’ insult” that Gaudio arrived late “with some bullshit song he wrote fifteen minutes ago.” As the district court concluded, “[t]he dialogue is completely different, as is DeVito’s initial reaction to the song.” The only similarities are unprotectable historical facts: Gaudio wrote the song at the last minute, he was late to rehearsal, and the song was ultimately successful. *See Narell*, 872 F.2d at 912.

3. Introduction of the Song “Big Girls Don’t Cry”

The Work recounts that Bob Crewe, a producer and songwriter who worked with the Four Seasons, was inspired to write the song “Big Girls Don’t Cry” after watching a movie in which a female character dramatically says exactly that – “big girls don’t cry.” In the Play, Gaudio tells the audience a transformed version of this story – Gaudio was the person who saw the movie, it was a John Payne movie, and Rhonda Fleming was the actress who delivered the line. Both the Play and the Work report that Crewe and Gaudio co-wrote the song. As the district court correctly concluded, the “only similarity is the unprotectable historical fact that the song was inspired by the Rhonda Fleming line.” That similarity does not include any protectable element of the Work.⁴ *See*

⁴ In writing the Work, Woodard relied on notebooks he had assembled containing research and articles about the Four Seasons. His research notebooks included an article that quoted Gaudio telling this story. Just as Woodard, writing the Work, was

Narell, 977 872 F.2d at 912.*977

4. Comparisons between the Four Seasons and the Beatles

The Work states that “[i]n the Beatles we are not just competing against another band; the Beatles come to represent a whole social movement. [The Four Seasons] never aspire to be more than entertainers.” In the Play, the Gaudio character describes the competition between the Band and the Beatles, telling the audience,

We weren’t a social movement like the Beatles. Our fans didn’t put flowers in their hair and try to levitate the Pentagon. Maybe they should have. Our people were the guys who shipped overseas . . . and their sweethearts. They were the factory workers, the truck drivers. The kids pumping gas, flipping burgers. The pretty girl with circles under her eyes behind the counter at the diner. They’re the ones who really got us, who pushed us over the top.

The similarities between the Work’s allusions to the Beatles and the longer, more detailed and more evocative comparison in the Play are the words “social movement” and the unprotectable historical fact that the two music groups competed for record sales and chart placements. *See Harper & Row*, 471 U.S. at 556, 105 S.Ct. 2218. Even if the Work was the first to

able to recount historical events documented in another author’s work, it is not infringement for the writers of the Play to use the Work as a source for this historical event.

describe the Beatles as representing a “social movement” – which is neither proven nor disproven in the record – this concept is an idea unprotectable by copyright. *See id.* The expression of that idea could be protected if it was original to the Work, but use of the phrase “social movement” is all but inevitable in the presentation of that idea. The words “social movement” thus form an unprotectable common phrase describing an idea. “Ordinary phrases are not entitled to copyright protection.” *Narell*, 872 F.2d at 911. *Grosso v. Miramax Film Corp.*, 383 F.3d 965 (9th Cir.2004), for example, held that there was no substantial similarity where “the only similarities in dialogue between the two works come from the use of common, unprotectable poker jargon,” *id.* at 967.

5. Introduction of the Song “Dawn”

The Work recounts that the Beatles had “hit the public consciousness like a load of bricks” when the Four Seasons song “Dawn” was ready for release. The Work then goes on to describe competition between the two bands in the Billboard charts, noting that “Dawn” charted third, “sandwiched in by the Beatles at number one, number two, number four and number five!”

In the Play, Gaudio says, “Around this time, there’s a little dust-up called the British Invasion. Britannia is ruling the airwaves. So we start our own American Revolution. The battle begins on a Sunday night at eight o’clock, and the whole world is watching.” The scene shifts to historical footage of Ed Sullivan introducing the Band, which then performs “Dawn.”

Again, it is an unprotectable historical fact that the

Beatles and the Four Seasons generally competed for chart placement. That “Dawn” charted against songs by the Beatles is similarly an unprotectable historical fact. *See Narell*, 872 F.2d at 912. No protectable elements of the Work share any similarity with the “American Revolution” scene in the Play.

6. Description of the Rock and Roll Hall of Fame Induction Ceremony

Both the Play and the Work depict the Four Season’s induction into the Rock and Roll Hall of Fame in 1990. The Band’s members reunited at the induction ceremony and performed for the first time in many years. These historical events are not protectable by copyright. *See *978 Harper & Row*, 471 U.S. at 556, 105 S.Ct. 2218; *Narell*, 872 F.2d at 912.

In the Work, DeVito describes “reunit[ing] with Frankie Valli, Bob Gaudio, Nick Massi and Bob Crewe for the first time since 1965. I felt like I was stepping from a time machine.” In the play, as the Band performs, DeVito asks, “Is this like being in a fuckin’ time machine, or what?” The idea that band members performing together after many years apart would evoke the feeling of a time machine flows naturally from the plot premise of a band reuniting and is classic *scenes-a-faire*. *See Cavalier v. Random House, Inc.*, 297 F.3d 815, 823 (9th Cir. 2002). And as the district court correctly ruled, the words “time machine” constitute an ordinary phrase and so is not protectable. *See Narell*, 872 F.2d at 911; *Grosso*, 383 F.3d at 967.

B. Application of the Extrinsic Test to Claimed Fictions Represented to be Facts — So-Called “Copyright Estoppel”

Other circuits, and district courts in this circuit, have employed a doctrine of copyright law sometimes called “copyright estoppel.” Under the doctrine, elements of a work presented as fact are treated as fact, even if the party claiming infringement contends that the elements are actually fictional. An author who holds their work out as nonfiction thus cannot later claim, in litigation, that aspects of the work were actually made up and so are entitled to full copyright protection. *See Nash v. CBS, Inc.*, 899 F.2d 1537, 1541 (7th Cir. 1990); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2nd Cir. 1980); *Idema v. Dreamworks Inc.*, 162 F. Supp. 2d 1129, 1183 (C.D. Cal. 2001); *Houts v. Universal City Studios, Inc.*, 603 F. Supp. 26, 30–31 (C.D. Cal. 1984); *Lake v. Columbia Broad. Sys.*, 140 F. Supp. 707, 708–09 (S.D. Cal. 1956); *Oliver v. Saint Germain Found*, 41 F. Supp. 296, 299 (S.D. Cal. 1941). “Given an express representation that the work is factual, the case law indicates that the author will be estopped from claiming fictionalization, even if most readers would not believe the representation.” 1 Nimmer on Copyright § 2.11. Claimed fictions that have been treated as facts for copyright purposes under this approach include a novel hypothesis about the cause of the Hindenburg explosion, *Hoehling*, 618 F.2d at 978–79; a theory that John Dillinger was not killed by law enforcement and instead retired to the West Coast, *Nash*, 899 F.2d at 1538, 1541; a “true crime” book with fantastical stories, *Houts*, 603 F. Supp. at 30; and representations that the author was the scribe of a spiritual power,

Oliver, 41 F. Supp. at 297.

In legal parlance, “estoppel” encompasses various equitable doctrines that ordinarily include as an element detrimental reliance. *See, e.g., Barnes v. Yahoo!, Inc.*, 570 F.3d 1096, 1099 (9th Cir. 2009), *as amended* (Sept. 28, 2009); *see also* Restatement (Second) of Contracts § 90 (1981). “Estoppel” is not, in our view, an apt descriptor for the doctrine at work here. For one thing, as the court correctly observed in *Houts*, detrimental reliance is not an element of this doctrine, as “the [so-called] estoppel [is] created solely by plaintiff’s affirmative action and representation that the work was factual.” 603 F. Supp. at 31. For another, application of estoppel concepts often suggests that the party against whom estoppel is applied is in some way culpable. *See, e.g., Santa Maria v. Pac. Bell*, 202 F.3d 1170, 1176 (9th Cir. 2000) (equitable estoppel looks to “evidence of improper purpose on the part of the defendant”); *Russell v. Rolfs*, 893 F.2d 1033, 1037 (9th Cir. 1990) (judicial estoppel “protect[s] against a litigant playing ‘fast and loose with the courts’” (quoting *Religious Tech. Ctr. v. Scott*, 869 F.2d 1306, 1311 (9th Cir. 1989) (Hall, J., dissenting))).*979 There are core concerns of copyright law, not equitable or estoppel principles, that, in our view, animate the misnamed “copyright estoppel” analysis. “[C]opyright . . . encourages others to build freely upon the ideas and information conveyed by a work,” *Feist*, 499 U.S. at 349–50, 111 S.Ct. 1282, “[t]o promote the Progress of Science and useful Arts,” *id.* at 349, 111 S.Ct. 1282 (quoting U.S. Const. Art. I, § 8, cl. 8). It would hinder, not “promote the progress of science and useful arts” to allow a copyright owner to spring an infringement suit on subsequent authors who “buil[t] freely” on a work

held out as factual, contending after the completion of the copyrighted work, and against the work's own averments, that the purported truths were actually fictions. *Id.* at 350, 111 S.Ct. 1282. Copyright protects the creative labor of authors; it does not protect authors' post-completion representations about the lack of veracity of their own avowedly truthful work.

We find this copyright-grounded rationale for this principle compelling and so adopt the doctrine. Rather than "copyright estoppel," we will refer to this rule of copyright law as the "asserted truths" doctrine, because it is the author's assertions within and concerning the work that the account contained in the book is truthful that trigger its application.

Here, the text of the Work explicitly represents its account as historically accurate, not historical fiction. In the Work's early pages, the DeVito narrator describes the Work as the "complete and truthful chronicle of the Four Seasons." He promises not to allow "bitterness to taint the true story," and notes his "candor." Both Corbello's husband and she herself sent potential publishers cover letters emphasizing that the Work provided a behind-the-scenes factual look at the Band, promising "disclosure[]" of "the truth about" several events, including the "secret past that these performers successfully hid for almost three decades." Consistent with those promises of truthfulness, the Work reads as a straightforward historical account and is presented as an autobiography, with DeVito listed as

co-author. So the Work was expressly and repeatedly held out as a factual account.⁵

Corbello argues strenuously that the asserted truths doctrine cannot apply in this case because the Work was never published. She argues that only representations of truth made to the public trigger the asserted truths doctrine, and that there was no representation *to the public* because the Work was unpublished.

This suggested limitation of the asserted truths doctrine to published works has no basis in either the case law or the doctrine's copyright law foundations. As to the case law, Corbello does not point to any case supporting the limitation, and we are not aware of any. One district court, in an unpublished opinion, characterized the doctrine as "normally applied to . . . a plaintiff who represented *to the public* that his work was factual." *Garman v. Sterling Pub. Co.*, No. C-91-0882 SBA, 1992 WL 12561293, at *3 (N.D. Cal. Nov. 5, 1992) (emphasis added). Aside from the nonbinding nature of its source, this passing reference to "the public," does not suggest that publication is a prerequisite to the application of the asserted truths doctrine; "the public" could include actual or intended

⁵ We note that the asserted truths doctrine would not cover fictional works that use claims to truthfulness as a literary device, like the Orson Welles radio broadcast of "War of the Worlds." See *Terror by Radio*, N.Y. Times, Nov. 1, 1938, at A22. We are not required, in this case, to decide what the outer limits should be of the test for whether a work's representations for truthfulness are sufficient to support the application of this rule. We hold only that the representations here are definitely sufficient.

*980 readers of work, including works not mass produced for sale.

As to the copyright origins of the doctrine, the suggested publication limitation appears to rest on the detrimental reliance and culpability concepts connected to the “estoppel” locution. But we have rejected both the terminology and its related implications as not pertinent to the asserted truths copyright principle as we understand it.

Rather than treat prior publication as dispositive, we examine the representations made by a work, whether made only to a few actual readers, to future intended readers, or, upon publication, to the general public. In this case, again, the Work made unequivocal representations of truthfulness. The Work’s emphatic and express representations of truthfulness were made both to potential publishers and to readers of the unpublished manuscript, as well as to future readers of the Work if published. Those representations were, as described earlier, central to the manuscript’s claim to readers’ attention and appreciation. And the representations applied to the book as a whole, a consideration emphasized in the case law. In *Houts*, for example, the district court stressed that the book had been held out as *completely* factual, because its jacket described the book as containing “*real life* detective stories,” the book had the notation “N-F” for nonfiction on its spine, and the first page proclaimed that the book “shows that truth can be more brutal than fiction.” 603 F. Supp. at 28–29 (emphasis in original). Similarly, *Lake* held that a plaintiff could not claim copyright protections for portions of a book about Wyatt Earp as fictionalized because the book’s preface promised “an accurate historical biography based on a

factual account of Wyatt Earp's career [that was] 'in no part a mythic tale.'" 140 F. Supp. at 708.

Just as the court in *Houts* determined that "[g]iven these broad and inclusive representations [that the book is factual], the reader is compelled to conclude that the *entire book* is true," 603 F. Supp. at 29, here the Work presents itself to the reader as a reliable source of factual information about the Four Seasons. So, when DeVito, an owner and co-author of the book, gave it to the Play's writers as they researched the history of the Four Seasons, they had reason to view it as a factual source, even better than newspaper or magazine articles, because it was co-written by a participant in the events described. Whether a Work is published may inform how its readers perceive and evaluate any claims of truthfulness – for example, a reader may discount such claims made in an unpublished work that appears to be an unfinished draft, or find assertions that a book is nonfiction particularly compelling if the publisher has a strong reputation for fact-checking its publications. But publication alone is not dispositive of whether this doctrine applies.

Relatedly, the asserted truths doctrine applies not only to the narrative but also to dialogue reproduced in a historical nonfiction work represented to be entirely truthful. As detailed above, even dubious assertions of truthfulness can prevent an author from later claiming that part of a work is fiction. *See, e.g., Oliver*, 41 F. Supp. at 297, 299. The asserted truths doctrine thus includes dialogue that an author has explicitly represented as being fully accurate, even if the author was unlikely to have recalled or been able to report the quotations exactly. Courts have applied the doctrine to,

for example, dialogue surrounding the death of Pope John Paul, see *Crane v. Poetic Prods. Ltd.*, 593 F. Supp. 2d 585, 595 (S.D.N.Y.), *aff'd*, 351 F. App'x 516 (2d Cir. 2009), and to other purportedly accurate conversations, *981 even where the author “could not possibly have been present to experience” them, *Houts*, 603 F. Supp. at 30.

As the court observed in *Houts*, this dialogue corollary follows from “the very nature of biographical works that involve any historical perspective. All historical renditions would be deemed fictionalized under [a contrary] theory merely because the author was not there personally.” *Id.* Requiring readers of purported nonfiction to investigate the accuracy of each quoted statement in a work that presents itself as completely true and accurate nonfiction would frustrate the pro-creation goals of copyright law. “To avoid a chilling effect on authors who contemplate tackling an historical issue or event, broad latitude must be granted to subsequent authors who make use of historical subject matter.” *Hoehling*, 618 F.2d at 978.

There may be instances in which extensive dialogue – for instance, dialogue in a biography of an ancient politician – necessarily indicates that a work is partially fictional. But this is indubitably not such a case. Here, the Work purports to accurately document conversations in which its co-author, DeVito, *actually participated*. Because of the autobiographical representation that is central to the Work, the assertions of accuracy carry extra force, and the asserted truths doctrine applies to the dialogue as well as to the narrative.

Each of the six similarities between the Play and the Work we next discuss fail the extrinsic test for substantial similarity because, whether or not actually factual, they involve – sometimes in combination with other non-protected features – elements of the work held out as facts and so not protectable.

1. DeVito’s Introduction of Valli to Mary and Mary’s Characterization

In the Work, Valli first sees Mary Mandel, a friend of DeVito’s current girlfriend, while hanging out with DeVito at a “hotdog joint.” Valli asks DeVito about her; DeVito reports that Mary is several years older than Valli, has a daughter, and “comes from a rotten family; her two brothers are junkies and a lot of her people are in prison. She talks kind of rough herself, but she seems nice.”

In the Play, Valli notices Mary Delgado – a composite character of two of Valli’s ex-wives – at a show, and DeVito warns him away but ultimately introduces them. Valli then takes Mary on a date. No dialogue is alleged to have been copied. The only similarity between the two accounts is the fact that Valli asked DeVito about a woman named Mary.

The Work and the Play characterize Mary and her relationship with Valli very differently. The Work depicts Mary Mandel as “mean spirit[ed]” and highly critical of Valli, causing him to become more reserved and “quenching the sparkle in his eye.” The Play does not portray Mary Delgado negatively, although it does depict an argument between Valli and Mary before the couple divorces. Gaudio reports to the audience that Valli told the other band members his divorce was “for the best,” but they knew “that wasn’t the whole story”;

Valli's character then sings a love song, indicating he had loved Mary and was sad about the divorce.

As the district court correctly concluded, "the Play copied no creative expression from the Work in relation to Valli's introduction to or relationship with Mary. The Play used its own creative expression in telling the story of Valli's interest in Mary, DeVito having warned him away, and any conflict between Valli and Mary. The historical facts of these events are not protectable by copyright."

At his deposition, Valli testified that DeVito did not in fact introduce him to Mary Mandel, and that he couldn't remember *982 whether DeVito helped set them up. Whether Valli's recollection is correct or not does not affect whether the Work's version is protectable as an original creation of the writers. DeVito may have remembered events differently than Valli did, or he may have reported his memory to Woodard inaccurately, or he or Woodard may have invented the story that he introduced Valli and Mary. Any such inconsistency, inaccuracy, or invention does not transform what was represented in the Work as a completely truthful account into creative fiction protectable by copyright. Facts presented in a historical work, "whether correct or incorrect," may be used by subsequent authors without infringing. *Hoehling*, 618 F.2d at 979; *see also Idema*, 162 F. Supp. 2d at 1183. As the Work holds it out as true that DeVito talked to Valli about Mary, that asserted fact is unprotectable under copyright law.

2. DeVito's Intercession After Valli's Arrest

Both the Play and the Work relay a story about DeVito helping Valli after he was arrested. In the

Work, DeVito says that “Frankie Valli and a kid named Lamonica get arrested for stealing. [Valli’s mother] calls me very worried, so I tell her I’ll look into it. She’s terrified Frankie will get sent away.” DeVito knows the probation officer writing Valli’s presentence report and convinces him to recommend probation. In the Play, DeVito promises Valli’s mother he will watch out for him, then pressures Valli to join DeVito in robbing a jewelry store. After they are caught, DeVito tells the judge, “Your Honor. Please. The kid didn’t know what he was doing. I coned him into it.” Valli gets probation and DeVito goes to prison.

The only similarities are the unprotectable historical fact of intervention by DeVito on Valli’s behalf and Valli’s probation sentence. That Valli testified at his deposition that neither story is accurate does not change this analysis. Again, if DeVito’s memory of events differs from Valli’s, then the account in the Work is either inconsistent with Valli’s, but accurate, or it is inaccurate. Either way, it is not protectable creative fiction. *See Hoehling*, 618 F.2d at 978–79. As the Work holds it out as true that DeVito helped Valli, that asserted fact is not copyright protectable.

3. The “Roman Orgy” Scene

Both the Work and the Play depict a party the record label threw for the Band during their first nationwide tour. At the party, DeVito encourages a shy Gaudio to approach a girl. The Work compares the party to “a Roman orgy,” and describes a naïve and embarrassed Gaudio sitting on the ground “look[ing] like he is going to throw up.” DeVito asks, “What’re you doing? Grab a girl and have a good time.’ . .

[Gaudio] eventually gets up and leaves with one of the girls. He reminds me of a condemned man leaving for his last meal. I didn't know whether it was from his youth or shyness, but Gaudio is definitely not in a party mood."

The Play takes a more graphic approach. The party scene is set to the song "December, 1963 (Oh, What a Night)." DeVito tells Gaudio to "grab some Christmas cheer," and Gaudio is approached by a girl and eventually loses his virginity off stage, with DeVito and Massi reporting his progress to the audience using space travel metaphors.

As the district court correctly noted, that the party took place is an unprotectable historical event. That is also true of the account that Gaudio left the party with a girl. The only similar dialogue in the two accounts are the "grab a girl"/"grab some Christmas cheer" lines, which share only the word "grab." This loose similarity does not involve any protectable elements of the Work, both because the Work represents *983 as historical fact that DeVito told Gaudio to "grab a girl," and because "grab a girl" – actually, "grab" – is an unprotectable ordinary phrase. *See Narell*, 872 F.2d at 911.

4. Fake Murder in Valli's Car

The Work and the Play both depict an incident in which some men attempt to extort money from Valli after staging a fake murder in his car. In the Work, Valli's car is being driven by a friend, and Valli and two other people are passengers. An argument between the two men in the front seat ends when the passenger says, "Well, asshole, what do you plan to do about it?" and the driver shoots him. A few days later,

the driver and the other passenger ask Valli for money in exchange for their silence. Valli turns to DeVito, who contacts Ray DeCarlo, a mobster. DeCarlo says he knows the men, assures Valli it was a scam and that the man was not really killed, and arranges for Valli's car to be returned to him unharmed two days later. The Play recounts a version of the same story, and the "victim" similarly says, "Yeah, asshole, what're you gonna do about it?" before being shot.

The incident itself is an unprotectable historical event, *see Narell*, 872 F.2d at 912, and Valli himself has told the story many times, including to the writers of the Play. The only similar expression is the "asshole" line. That line alone is unprotected by copyright because the Work holds it out as historically accurate dialogue. The Play may have "taken facts and ordinary phrases from [the Work], but [it] has not taken protected expression." *Id.*

5. and 6. The Dialogue Surrounding the Song Title and Subject Matter of the Song "Walk Like a Man"

The Work and the Play feature a similar portrayal of the origin of the title of the song "Walk Like a Man," written by Gaudio. The Work describes the Band kidding Gaudio about the title but does not attribute the teasing to a specific person:

"Walk Like A Man?". As opposed to what — like a woman?"

"No, no," explains Gaudio defensively, "the song is directed to teenage boys who need to walk and talk like men."

"In other words, instead of like girls."

“No! Instead of like boys. This song is going to serve as an anthem for every teenage boy who has let some girl twist him around her little finger!”

The Play features similar dialogue, but portrays DeVito as mocking Gaudio rather than playfully teasing him:

TOMMY: I don't get it.

BOB: What don't you get, Tommy?

TOMMY: The title, Walk like a man. . . . As opposed to what — a woman?

BOB: It's for boys, Tommy. Teenage boys. We're telling them to act like men.

TOMMY: Instead of like girls.

BOB: Instead of like boys. Why are you doing this?

CREWE: Look, Miss Congeniality — it's a metaphor. This is an anthem for every guy who's ever been twisted around a girl's little finger!

The parties do not dispute that this conversation actually happened, so the event itself is not protectable. They do dispute whether the particular language used in the Work was original expression, rather than a report of what was actually said. Corbello claims that the dialogue was “Woodard's invented banter,” and thus protected expression. DeVito testified that he did not remember supplying Woodard the words “anthem” or “twisted around a girl's finger.” Gaudio testified that the dialogue does

reflect the substance and language of the actual conversation, and that he described the argument using these phrases to the writers of the Play.*984 We need not resolve this factual dispute. Whether the dialogue accurately represents what was actually said does not change our analysis. The dialogue is held out by the Work as a historically accurate depiction of a real conversation. The asserted facts do not become protectable by copyright even if, as Corbello now claims, all or part of the dialogue was made up.

III. Conclusion

Given the Work's emphatic representation that it is a nonfiction autobiography, the Play did not infringe on any of the protected expressive elements of the Work, even if the writers of the Play "appropriated [Woodard's] historical research." *Narell*, 872 F.2d at 911. As the similarities between the Play and the Work involve only elements of the Work not protected by copyright, we affirm the district court's grant of JMOL.⁶

AFFIRMED.

⁶ Because we affirm, we do not reach the questions whether the district court erred in granting JMOL that Valli and Gaudio had not committed infringement, whether the district court abused its discretion in ordering a new trial, or whether this case should be reassigned to another district judge.

APPENDIX B
UNITED STATES DISTRICT COURT
District of Nevada

2:08-cv-00867-RCJ-PAL

DONNA CORBELLO,

Plaintiff,

v.

THOMAS GAETANO DEVITO, *et al.*,

Defendants.

Decided June 13, 2017

ROBERT C. JONES, United States District Judge

ORDER

Plaintiff Donna Corbello is the widow and heir of Rex Woodard, who assisted Defendant Thomas Gaetano “Tommy” DeVito in writing his unpublished autobiography *Tommy DeVito – Then and Now* (“the Work”). Plaintiff sued DeVito and others when they used the Work to develop the screenplay for *Jersey Boys* (“the Play”), a hit musical based on the band The Four Seasons that has played in the United States, Canada, England, and Australia. Corbello sued several Defendants for copyright infringement, and she sued DeVito for an accounting. The Court granted summary judgment to Defendants. The Court of Appeals reversed in part and remanded for trial. At the close of

Plaintiff's evidence, Defendants orally moved for judgment as a matter of law, and the Court granted the motion in part and denied it in part, ruling that Defendants Frankie Valli and Robert Gaudio were entitled to judgment as a matter of law against the claims of copyright infringement, and that all Defendants were entitled to judgment as a matter of law against enhanced damages for willful copyright infringement. The jury returned a verdict for Plaintiff. Three post-trial motions are pending before the Court.

I. FACTS AND PROCEDURAL HISTORY

A. Factual Background

1. The Work

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

Woodard kept in touch with DeVito and founding Four Seasons member Frankie Valli throughout the

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

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

December 1, 1988

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

Dear Tommy:

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

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

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

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

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

Sincerely, [signed Rex Woodard] Rex Woodard

RW/mlEnclosures

APPROVED: [signed Tommy DeVito]

TOMMY DEVITO (Letter Agreement).

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

2. Woodard's and DeVito's Publication Attempts

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

UNTITLED TOMMY DEVITO/FOUR

SEASONS BIOGRAPHY

.....

TOMMY DEVITOREX WOODARD©,
January, 1991

(*See* January 1991 Work Cover Page, ECF No. 1061457–15).^{*1061} Though he never smoked, Woodard had been diagnosed with lung cancer in 1989, and his condition had begun seriously to worsen by late 1990. (*Id.* ¶ 39). By February or March of 1991, he was bedridden, and he died on May 25, 1991, at age forty-one. (*Id.* ¶ 40). Woodard had hoped that income generated from the Work would support his wife and children. (*Id.* ¶ 41).

3. Plaintiff's and Ceen's Publication Attempts

In accordance with Woodard's wishes, Plaintiff and Woodard's sister Cindy Ceen continued to seek publication after Woodard's death independently of DeVito; however, public interest in *The Four Seasons* had waned, making it difficult to find a publisher. (*Id.* ¶ 42). In September 2005, Ceen decided to contact DeVito for his assistance in publishing the Work. (*See id.*) Ceen first contacted a prominent member of an Internet *Four Seasons* fan group named Charles Alexander to facilitate contact with DeVito. (*See id.* ¶ 43). On September 22, 2005, Alexander responded to Ceen that he had met with DeVito the previous day, had told DeVito of Ceen's desire to publish the Work, and that DeVito had agreed to help. (*See id.*) Ceen called DeVito the same day at a telephone number provided by Alexander, and DeVito indicated that he wanted to update the Work with post-1990 events and

restore some “obscene” language Woodard had omitted. (*Id.*) DeVito also claimed he had lost his copy of the Work and asked Ceen for a replacement, which she mailed to DeVito the next day, along with a letter memorializing their telephone conversation and informing DeVito that Plaintiff was considering self-publishing the Work if a traditional publisher could not be found. (*Id.*) Neither Plaintiff nor Ceen heard from DeVito again. (*Id.* ¶ 44). DeVito’s attorney Jay Julien left Ceen a voicemail message on November 2, 2005, and Ceen returned his call the next day, during which conversation Julien told Ceen that he had spoken with DeVito regarding the Work and concluded that it was “not saleable.” (*Id.*) Ceen was surprised by this conclusion, because the play *Jersey Boys* was scheduled to open on Broadway a few days later. (*Id.*) Julien did not disclose that the Work had been used or exploited in any way or that rights in the Work had been licensed or assigned. (*Id.*)

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

By late 2006, *Jersey Boys* had become a Broadway hit, earning four Tony Awards. (*Id.* ¶ 45). Plaintiff had not seen the show, but she and Ceen estimated that the show’s success would revive interest in the band and make publication of the Work viable. (*Id.*) Plaintiff and Ceen engaged counsel to confirm the registration of Woodard’s and DeVito’s copyright in the Work, to register the copyright if not yet registered, and to contact Julien to see if DeVito had changed his mind about joint publication of the Work in light of *Jersey Boys*’s success. (*Id.*) A January 3, 2007 search of the U.S. Copyright Office’s online records indicated

no registration of the Work to Woodard but showed that on January 11, 1991 (four months before Woodard's death), DeVito had registered a literary work entitled *Tommy DeVito – Then and Now*, Reg. No. Txu 454 118 (the “DeVito Work”). (*Id.* ¶ 46). Plaintiff's counsel ordered a copy of the registration and discovered that DeVito had registered the DeVito Work in his own name only, claiming that the work was unpublished and that he wrote it in its entirety in 1990. (*Id.* ¶ 47). Plaintiff's counsel ordered a copy of the DeVito Work itself and discovered that the DeVito Work was identical to the Work, and in fact appeared to be a photocopy of the manuscript typed by Woodard's secretary Myrtle Locke, with two *1062 exceptions. (*Id.* ¶¶ 48–49). First, the original cover page from the January 1991 version of the Work had been replaced with a cover page in a different font and font size, reading:

TXu 454 118

. . . .

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

Plaintiff also soon discovered that the writers of and several actors in *Jersey Boys* had access to the Work and that DeVito had received royalties or other

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

5. Pre-Litigation Negotiations

On June 13, 2007, Plaintiff’s counsel wrote Julien by email and overnight courier demanding that DeVito execute an application for supplementary registration with the U.S. Copyright Office to add Woodard as a coauthor and co-claimant of the Work and demanding an accounting of profits in accordance with the Letter Agreement. (*Id.* ¶ 53). Counsel conferred with one another by email and telephone between June and October 2007, and Julien admitted at one point that DeVito had provided a copy of the Work “to Jersey Boys” and expressed interest in the possibility of a

joint copyright infringement action against “Jersey Boys,” but later decided that Plaintiff’s only recourse was a suit against DeVito because he had authorized the use of the Work. (*Id.* ¶ 54). Although DeVito initially considered filing a supplemental registration of the Work to credit Woodard, he later refused, claiming that he in fact was the sole author and that Woodard had been a mere scribe. (*Id.*).

On July 2, 2007, Plaintiff filed her own supplementary application with the U.S. Copyright Office to add Woodard as a coauthor and co-claimant of the Work, but the office rejected the application because DeVito, the original claimant, had not signed it. (*Id.* ¶ 55). Under 17 U.S.C. § 201(a), the office could not permit a non-author, non-claimant of an original registration, i.e., a “basic registration,” to supplement the basic application. However, such a person could apply to register her own work, in which case the office would consider the new claim to be adverse to the existing claim if the claims purported to register the same work exclusively to *1063 different claimants. (*See* Copyright Office Letter, June 16, 2008, ECF No. 457–27, at 7). However, the Copyright Office Review Board granted Plaintiff’s appeal based on a closer examination of regulations and practices, determining that her supplemental registration could be accepted, and that a certificate of registration would be issued after processing. (*See* Copyright Office Letter, Mar. 27, 2009, ECF No. 457–28). The amended certificate, Reg. No. Txu1 372–636, lists Woodard and DeVito as coauthors of the entire text of the Work and co-claimants thereto. (*See* Certificate of Registration TXu1 372–636, July 3, 2007, ECF No. 457–29).

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

6. The “Cover-Up”

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

7. DeVito’s Licensing of the Work

Certain documents made public during Valli’s divorce proceedings in July 2008 revealed that DeVito had granted Valli and Gaudio an exclusive, irrevocable, perpetual, worldwide, assignable license (the “1999 Agreement”) freely to use and adapt certain “Materials,” including his “biographies,” for the

purpose of creating a musical based on the “life and music” of The Four Seasons. (*Id.* ¶ 59). The 1999 Agreement included the right to “ancillary and subsidiary exploitations thereof including, without limitation, cast albums, motion picture and televised versions, merchandise, and/or other works . . . in all media now existing or later devised.” (*Id.*) The 1999 Agreement waived any claim of copyright infringement by DeVito, provided that DeVito would be entitled to 20% of any royalties Valli and Gaudio obtained through exploitation of the Materials, and provided that Massi would be entitled to 5% of any such royalties. (*See id.*) Plaintiff suspects that Valli and Gaudio further licensed the Materials, which included the Work, to one or more unknown authors in 1999 for adaptation into an early version of *Jersey Boys* called Walk Like a Man. (*See id.*) When the original producer rejected Walk Like a Man, Valli and Gaudio fired its authors, permitted their agreement with the original producer to lapse, and further licensed the Materials to Brickman and Elice, who used them to write *Jersey Boys*. (*See id.*) Plaintiff implies that Valli’s and Gaudio’s joint ventures related to their exploitation of the Materials constitute a general partnership as a matter of law that Plaintiff refers to as “The Four Seasons Partnership.” (*See id.* ¶ 4–5).

8. *Jersey Boys*

The *Jersey Boys* foundational production agreement (the “*Jersey Boys Agreement*”) *1064 is dated May 1, 2004. (*See id.* ¶ 61; *Jersey Boys Agreement* 1, ECF No. 457–34, at 2). The *Jersey Boys Agreement* lists five parties: Valli and Gaudio as “Owner,” Brickman and Elice as “Bookwriter,” and

Dodger Stage Holding Theatricals, Inc. (now known as DSHT, Inc.) as “Producer.” (*See* Jersey Boys Agreement 1). The copies of the signature page of the Jersey Boys Agreement attached to the Third Amended Complaint (“TAC”) include signatures by all of these parties except Brickman, and DSHT’s signature is typewritten, without the handwritten signature of any natural person as an agent of DSHT. (*See id.* at 24, ECF No. 457–34, at 25–26).

The signatures are not dated. (*See id.*) The Jersey Boys Agreement is comprehensive and appears to govern the worldwide exploitation of *Jersey Boys*. (*See generally id.*) The details of the twenty-three-page agreement need not be recounted here, but will be noted where relevant to the determination of claims. The Jersey Boys Agreement includes a schedule and two exhibits as attachments, all of which the base agreement identifies. Schedule A is a table of musical compositions to be used in the musical along with details of authorship and copyright ownership. Exhibit A is the 1999 Agreement. Exhibit B is a list of “payment instructions” consisting of addresses for mailing payments to the signatories and other beneficiaries.

Plaintiff believes that DSHT further assigned or licensed its rights under the Jersey Boys Agreement to Defendant Dodger Theatricals, Ltd., which is the primary producer of *Jersey Boys* on Broadway, tours throughout the United States, and in London, U.K. (*See* Third Am. Compl. ¶ 62). Plaintiff believes that DSHT and/or Dodger Theatricals further licensed their rights to others and eventually assigned them to Defendant Jersey Boys Broadway Limited

Partnership, which in turn licensed them to several parties, including Defendants JB Viva Vegas and Jersey Boys Records Limited Partnership. (*See id.*). Plaintiff alleges that *Jersey Boys* has earned profits of approximately \$150 million per year, with a life expectancy of at least ten years, and believes she is entitled to at least \$6.5 million. (*See id.* ¶ 70).

B. Procedural History

1. The Present Lawsuit

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

and Jersey Boys Broadway, in the alternative) (15) copyright infringement under 17 U.S.C. § 501(a) (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, *1065 Jersey Boys Broadway, JB Viva Vegas, and Jersey Boys Records); (16) vicarious copyright infringement under 17 U.S.C. § 502 (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, Jersey Boys Broadway, Jersey Boys Records, Skunk, and Getting Home); (17) contributory copyright infringement under 17 U.S.C. § 502 (Valli, Gaudio, Brickman, Elice, McAnuff, Michael S. David, DSHT, Dodger Theatricals, Jersey Boys Broadway, and Jersey Boys Records); (18) copyright infringement under § 16(2) of the Copyright, Designs, and Patents Act of 1988 (U.K.) (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway); (19) copyright infringement under § 27(1) of the Copyright Act, R.S.C. 1985 (Can.) (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway); and (20) copyright infringement under §§ 115(1), 36, and 39 of the Copyright Act of 1968 (Cth) (Austl.) (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway).

2. The First Summary Judgment Order (ECF No. 300)

On March 31, 2010, the Court issued an order resolving ten pretrial motions as against the Second Amended Complaint (“SAC”). The Court denied DeVito’s motion to dismiss, or in the alternative for summary judgment, finding that certain state law defenses were preempted by the Copyright Act and that in any case there was no evidence of an attorney-

client relationship but only of a business relationship between DeVito and Woodard. The Court also found that there remained genuine issues of material fact as to the eligibility of the Work or certain parts of it for copyright protection and as to what parts of the Work were used to create *Jersey Boys*. The Court granted Corbello's cross motion for summary judgment as to DeVito's state law defenses but denied it as to infringement for the same reasons the Court denied DeVito's motion.

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

The Court denied Brickman's, Elice's, McAnuff's, DSHT's, Dodger Theatricals', and JB Viva Vegas, LP's other motion to dismiss counts 15–17 for copyright infringement. Movants argued that the alleged similarities were unprotectable under copyright law, that many alleged similarities were not similarities, and that there was no "bodily appropriation" or

“wholesale appropriation” of the Work by the *Jersey Boys* script. The Court found the claims to have been sufficiently alleged.

The Court denied Valli’s, Gaudio’s, DSHT’s, and Dodger Theatricals’ motion to dismiss counts 13–14 for declaratory judgment and an equitable accounting, finding that Corbello had sufficiently alleged in the alternative that DeVito had assigned his copyright in the Work via the 1999 Agreement such that movants could authorize others to use it but would owe *1066 Corbello, a joint owner, an accounting for any profits thereby obtained.

3. The Second Summary Judgment Order (ECF No. 661)

On October 27, 2011, the Court granted in part and denied in part two summary judgment motions. Corbello and Defendants Valli, Gaudio, DSHT, Dodger Theatricals, and Jersey Boys Broadway filed cross motions for summary judgment as to counts 12–14 for declaratory judgment and an equitable accounting. As to count 12 for a declaration that DeVito as a joint owner of the Work lacked the legal ability to grant Valli and Gaudio an exclusive license and that the 1999 Agreement was therefore either void, a nonexclusive license, or a transfer of DeVito’s rights in the Work, the Court denied summary judgment, ruling that the 1999 Agreement was not a transfer of ownership but a license that was exclusive as against DeVito but nonexclusive as against Corbello. As to count 13 for an alternative declaration that the 1999 Agreement permitted Valli and Gaudio to further transfer or license the Work, that they did transfer or license the Work to DSHT and/or Dodger Theatricals

via the Jersey Boys Agreement, and that Dodger Theatricals thereafter transferred or licensed the Work to Jersey Boys Broadway, the Court granted summary judgment to Plaintiff in part, ruling that the 1999 Agreement permitted further assignment and that Valli and Gaudio had further assigned the rights in the Work to DSHT via the Jersey Boys Agreement, but that it was not clear whether there had been any further assignment. The Court granted summary judgment to Defendants as to count 14 for an accounting because there had been no transfer of the Work, and the relevant agreements included no duty to account.

4. The Third Summary Judgment Order (ECF No. 780)

On January 31, 2012, the Court adjudicated seven of the seventeen claims then remaining and entered judgment in favor of all Defendants except DeVito and David. Jersey Boys Records had moved for summary judgment based on personal jurisdiction and failure to state a claim. The Court found that it had personal jurisdiction over Jersey Boys Records but granted the motion on the merits, ruling that Plaintiff had adduced no evidence that Jersey Boys Records had control over any other Defendant, that there was no allegation that Jersey Boys Records was aware of any infringement (so it could not be liable for contributory infringement), and that the album at issue did not pass the extrinsic test as to substantial similarity to the Work. The Court denied two motions for summary judgment based on the statute of limitations. The Court denied David's motion for summary judgment based on personal jurisdiction. The Court denied a motion for

summary judgment on the merits of the infringement issue as moot because the Court contemporaneously granted another motion based on the Defendants' having licenses to use the Work. The Court granted a motion for summary judgment as against the claims of infringement under foreign law, following the Second Circuit's persuasive ruling that the Berne Convention did not provide choice-of-law rules for copyright claims, finding that U.S. law governed issues of copyright ownership and licensing in this case even if foreign law governed substantive infringement claims and that the licenses under U.S. law protected Defendants from the foreign infringement claims. The Court granted Corbello's motion for summary judgment as to declarations that the Work was a joint work, that Woodard was a co-owner of the Work, and that DeVito held a 50% interest in the *1067 Work in constructive trust for Corbello, as successor-in-interest to Woodard.

5. Further District Court Proceedings

At that point, claims 2–11 against DeVito remained for trial. On July 9, 2012, the Court denied fees to Defendants, added David to the Judgment, and certified the Third Summary Judgment Order and the present order for immediate appeal under Rule 54(b).

6. The Appeal and Remand

Corbello appealed the certified orders, and on February 10, 2015, the Court of Appeals reversed in part, ruling that the 1999 Agreement had been a transfer of ownership such that Valli and Gaudio became joint owners with Corbello in 1999, *Corbello v. DeVito*, 777 F.3d 1058, 1064 (9th Cir. 2015), and that

although Valli and Gaudio could not be liable for infringement while they were joint owners, there remained a genuine issue of material fact whether the 1999 Agreement's reversionary clause had later been triggered such that Valli and Gaudio might be liable for infringement for their use of the Work thereafter, *id.* at 1066–67. The Court of Appeals also ruled there remained a genuine issue of material fact as to whether DeVito had granted Valli and Gaudio an implied nonexclusive license upon reversion. *Id.* at 1067–68.

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

Before trial, the parties requested that the Court determine certain issues as a matter of law, i.e., whether certain parts of the Work were protected at all, whether the Work was entitled to “thick” versus “thin” copyright protection, and whether Defendants were entitled to summary judgment on the infringement issue under the extrinsic test. The Court ruled that under the law of the case, the jury would have to be instructed that the 1999 Agreement was a transfer of ownership whereby Valli and Gaudio became joint owners with Corbello, and that Valli and Gaudio could not be liable for infringement while they were joint owners. The jury would also have to determine whether the 1999 Agreement's reversionary clause was ever triggered such that Valli and Gaudio might be liable for infringement thereafter. If the exclusive license had reverted, the jury would also have to determine whether DeVito had granted Valli and Gaudio an implied nonexclusive license such that they could not have been liable for infringement even after their ownership interest reverted to DeVito.

Finally, the jury would have to determine infringement under direct copying or substantial similarity theories. To find liability under the latter theory, the jury would first have to perform the extrinsic test. The Court granted summary judgment in part as to the extrinsic test, finding that regular “thick” copyright protection did not apply as a matter of law, so the jury would have to be instructed that if the Work passed the extrinsic test, the jury would then have to apply “thin” protection under the intrinsic test. *See Funky Films, Inc. v. Time Warner Entm’t Co., L.P.*, 462 F.3d 1072, 1076–77 (9th Cir. 2006); *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994). The Court also noted at a status conference that it intended to bifurcate the trial into infringement and damages phases and intended to hold accounting proceedings without a jury if any Defendant were found to be liable for infringement or an accounting.

8. The Fifth Summary Judgment Order (No. 972)

The parties filed four additional motions for summary judgment. Plaintiff asked the Court to grant her summary judgment against the affirmative defense of an implied *1068 nonexclusive license and whether the 1999 Agreement had reverted. Defendants asked the Court to grant them summary judgment based on fair use and against the UK, Canadian, and Australian infringement claims. The Court denied all four motions.

9. The Trial

After 15 days of trial, the Court mostly denied Defendants’ motion for a judgment as a matter of law

but granted the motion in favor of Valli and Gaudio as to infringement and in favor of all Defendants as to willful infringement. The jury found: (1) Tommy DeVito did not grant Defendants an implied nonexclusive license to use the Work to create the Play; (2) the Play infringed the Work; (3) the use of the Work in the Play did not constitute fair use; (4) 10% of the success of the Play was attributable to infringement of the Work; and (5) the remaining Defendants were liable for direct infringement (as opposed to vicarious or contributory infringement).

II. DISCUSSION

Three substantive motions are pending before the Court. First, DeVito has asked the Court to vacate part of a previous order requiring his royalty payments from Defendants to be placed into escrow, because he has settled with Plaintiff. Second, Defendants have renewed their motion for judgment as a matter of law. Third, Defendants have moved for a new trial.

A. DeVito's Motion

The Court grants DeVito's motion and will separately enter the proposed order attached thereto. No party has objected (although Defendants have "replied" to the motion in order to make additional arguments against the outcome of the trial).

B. Renewed Motion for Judgment as a Matter of Law

Defendants note that during trial, the Court stated it believed Defendants were entitled to a directed verdict on the fair use issue but did not want to risk a retrial in the case of reversal, and it therefore denied

the Rule 50(a) motion but intended to grant a Rule 50(b) motion. Plaintiff notes that the Court later opined that it believed the fair use issue was properly a jury question. The Court has closely examined the evidence under the relevant standards and concludes Defendants are entitled to a judgment as a matter of law on the fair use issue.

Fair use is a mixed question of law and fact determined by four nonexclusive statutory factors: “(1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the substantiality of the portion used in relation to the copyrighted work as a whole; (4) the effect on the potential market for or value of the copyrighted work.” *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560–61, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985) (citing 17 U.S.C. § 107).

1. Effect on the Potential Market for or Value of the Copyrighted Work

The fourth *Harper & Row* factor is the most important, *id.* at 566, 105 S.Ct. 2218 (citing 3 M. Nimmer, Copyright § 13.05[A], at 13–76 (1984)), so the Court will begin there. The evidence at trial indicated that before the Play debuted, the Work had no market value. Woodard, DeVito, Plaintiff, and Plaintiff’s sister had been unable to find any company interested in publishing the Work despite their various attempts to do so between 1990 and 2005, because interest in the Four Seasons was not great enough to make sales of the Work profitable. Under these circumstances, the fourth and most important *1069 *Harper & Row* factor “greatly favors” a defendant. *Blanch v. Koons*, 467 F.3d 244, 258 (2nd Cir. 2006) (affirming summary judgment

under similar circumstances even where the infringing use was commercial and successfully so, the copyrighted work was an artistic photograph created for a magazine advertisement, and the third factor did not favor either party). Plaintiff only discovered that DeVito had registered the Work when she attempted to register it herself in 2007, having been motivated by the success of the Play, which had opened in 2006. To the extent the Work may be profitable today, it is almost certainly only because of the Play, which – and this is important under the third *Harper & Row* factor – consists of over 50% musical works (by running time) in which Plaintiff has no copyright, and the remainder of which (the non-musical script of the Play) is comprised of less than 1% of creative expression found in the Work and uses less than 1% of the Work. If anything, the Play has increased the value of the Work. The fourth, most important factor strongly favors a finding of fair use.

2. Purpose and Character of the Use

Commercial use, as here, generally weighs against a finding of fair use. *Harper & Row Publishers, Inc.*, 471 U.S. at 562, 105 S.Ct. 2218. The first factor weighs against fair use in the present case as it does in most cases, because the producers of the Play have profited from exploitation of the copyrighted material without paying the customary price. *See id.*

3. Nature of the Copyrighted Work

This factor depends on the extent of the Work's creativity and whether it is published. The biographical nature of the Work (which is claimed therein to constitute a factual relation of events as

contrasted with other allegedly untrue accounts of events) weighs in favor of a finding of fair use. *See id.* at 563, 105 S.Ct. 2218 (“The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.”). The unpublished nature of a work normally weighs against a finding of fair use. *Id.* at 564, 105 S.Ct. 2218 (“[T]he scope of fair use is narrower with respect to unpublished works [because of] the author’s right to control the first public appearance of his expression.”). As Defendants note, however, in this case the publication of (small parts of) the Work did not diminish its value by preempting Plaintiff’s right to control the first public appearance of the Work. The reason the Work was not yet published was because it was simply not publishable despite years of effort. As the Supreme Court has noted, the Senate reasoned that “[t]he applicability of the fair use doctrine to unpublished works is narrowly limited since, although the work is unavailable, this is the result of a *deliberate choice* on the part of the copyright owner.” S.Rep. No. 94–473, p. 64 (1975) (emphasis added). A work that is only unpublished because it is unpublishable despite great efforts, however, is an atypical situation. Such a work is not unavailable to the public because of a deliberate choice by the copyright owner, but because it is not commercially viable. In this case, the unpublished nature of the Work does not overshadow its biographical nature. The Court finds that this factor weighs in favor fair use.

4. Substantiality Used in Relation to the Copyrighted Work as a Whole

After discounting those similarities based on

unprotected elements of the Work or where the corresponding element of the Play was original to the Play, the jury was permitted to consider 12 similarities between the Work and the Play. (*See* Jury Instr. No. 27, ECF No. 1076). As recounted in detail, *infra*, the amount of protectable, creative material potentially *1070 copied in relation to the Work as a whole is very small, less than 1%, even if the jury were to have applied “thick” as opposed to “thin” copyright protection.

a. Tommy DeVito’s Introduction

Tommy DeVito’s introduction in the Play concerning his background copies no creative words form the Work and accounts for approximately one minute of the Play from 5:09 to 6:50 (excluding a musical interlude from 5:30 to 6:07).¹ Chapter 1 of the Work is a five-page tale of a fourteen-year-old Tommy DeVito and four of his friends stealing a car for a joyride and their subsequent arrest. Before the story about the car begins, the first three sentences (consisting of 33 words) sets the scene of Tommy DeVito and his friends “hanging out on a Jersey Street Corner . . . puff[ing] on cigarettes and dar[ing] anyone to mess with [them] . . . cool beyond belief.” That is the copyrightable comparison – DeVito’s “voice, cool demeanor, and braggadocio” – allegedly copied from the Work as the DeVito character addresses the audience at the outset of the Play, after the opening musical performance. The Play does not recreate the

¹ The Court has painstakingly reviewed Exhibit 602 (a DVD of a Broadway performance of the Play) from the trial and compared it to Exhibit 13 (the Work).

scene of DeVito and his teenage friends on the street corner, however, and copies no words from the Work.

b. The Dialogue Surrounding the Song Title and Subject Matter of the Song “Walk Like a Man”

In the Play, DeVito argues with Gaudio over the title to the song, saying he doesn’t “get it.” “Walk like a man? As opposed to what? A woman?!” DeVito gives Gaudio a comical concerned look as if to imply the song has homosexual overtones. Gaudio explains that the message is not for young boys to act like men instead of girls but to act like men instead of boys. Band manager Bob Crewe then explains the song is “an anthem for any guy who’s ever been twisted around a girl’s little finger.” The scene then shifts to the band performing the song. Although the Work indicates that the band was only “kid [ding]” Gaudio, as opposed to it having been a legitimate argument with DeVito, and that Gaudio, not Crewe, made the comment about being twisted around a girl’s little finger, the dialogue is very similar. Assuming the jury believed the dialogue was not a historical recounting but a creation of DeVito and Woodard – a finding that is unlikely and perhaps not even permissible given the Work’s claim of historical accuracy – the closely copied dialogue consists of about 65 words.

c. The Beatles Line

The Work contains the protectable lines, “[T]he Beatles come to represent a whole social movement. We never aspire to be more than entertainers.”

In the Play, Gaudio says, “Around this time, there’s a little dust-up called the British Invasion.

Britannia's ruling the airwaves. So we start our own American Revolution. The battle begins on a Sunday night at eight o'clock, and the whole world is watching." The scene shifts to historical footage of Ed Sullivan introducing the band, and then to the band performing the song "Dawn" onstage. That is, the actors in the Play perform the song onstage with a studio camera crew, as if on the Ed Sullivan Show. The live footage, from the perspective of the camera crew, is displayed on a screen behind the band in black-and-white, mimicking what was presented to the TV audience of the time, along with what are presumably clips from the actual 1964 studio audience watching *1071 the actual 1964 performance. The band finishes the song, and Gaudio says:

We weren't a social movement like the Beatles. Our fans didn't sit and put flowers in their hair and try to levitate the Pentagon. Maybe they should have. Our people were the guys who were shipped overseas, and their sweethearts. They were factory workers, the truck drivers, the kids pumping gas, flipping burgers. The pretty girl with circles under her eyes behind the counter at the diner. They're the ones who really got us, who pushed us over the top.

The line about the Beatles being a "social movement" by contrast to the Four Seasons is arguably protectable as original expression in the Work beyond bare historical fact.

d. The Creative Expression Within the Description of the Rock & Roll Hall of Fame Induction Ceremony

In the Play, Crewe briefly introduces the band, noting that it had been over 20 years since they last played together onstage. The band rises up from below the stage, performing “Rag Doll.” They pause, and DeVito says, “Is this like bein’ in a fuckin’ time machine, or what?” Valli asks DeVito how Las Vegas is. DeVito gives his condolences to Valli about his daughter’s untimely death. Gaudio says Valli has a new family now, “three boys.” DeVito invites Valli and Gaudio to his room after the event. Valli accepts. Massi asks if they ever thought they’d be standing on the same stage, and DeVito responds that he never thought he’d be standing, “period.” DeVito explains that the Rock and Roll Hall of Fame is the best honor an artist can receive. Other awards, such as the Oscars or the Emmys, can be bought, but the Hall of Fame is an affirmation by the fans. The band then finishes performing “Rag Doll.”

In the Work, DeVito recalls how he took a phone call from Valli the morning of the ceremony (January 17, 1990, in New York City) and held a small gathering in his room. Family and friends attended, including Massi, but not Valli, whom DeVito didn’t see until the press conference. Before the press conference, DeVito was reunited in the same room with Valli, Massi, and Gaudio for the first time since 1965. “I felt like I was stepping from a time machine.” He recalled a “rush of good feelings and warm memories.” Crewe introduced the band at the ceremony. DeVito recalls playing a free-for-all “jam session” on stage but does

not recount the band having played “Rag Doll” or any other song together as a band at the ceremony.

The events recounted in both the Work and the Play, apart from the basic fact of the induction ceremony, include the gathering in DeVito’s room and the “time machine” line. The gathering in DeVito’s room, however, is a historical event that was not created by the authors of the Work, and the Court has already ruled that the “time machine” line is an ordinary phrase that is not protectable.

e. The Creative Expression Within the Description of the “Roman Orgy” Scene

In the Play, Gaudio sings the song “December, 1963 (Oh, What a Night)” while DeVito and Massi make out with one or more women (Valli is not present in the scene). Gaudio breaks to explain that the record company had set up a party in Chicago with some women around Christmastime during the band’s first nationwide tour. Gaudio explains that he was a virgin at the time, but he eventually takes a girl “downstairs” after DeVito tells him to “grab some Christmas cheer.” DeVito and Nick Massi look “downstairs” and report Gaudio’s progress play-by-play to the audience *1072 with comically obscene space travel metaphors. Gaudio returns “upstairs” and finishes the song.

In the Work, the record company sets up the party in Detroit. DeVito compares the scene to a “Roman orgy.” DeVito tells Gaudio to “Grab a girl and have a good time,” and Gaudio leaves with a girl. DeVito does not claim in the book that Gaudio was a virgin, but that he was a “naïve kid.” The only dialogue potentially copied from the Work into the Play is the

“[g]rab a girl” line, which is not reproduced exactly. Even assuming it were not a historical fact that DeVito said that line, the Play added creative elements to it. The word “grab” and the image of Gaudio bowed over with his hands on his knees are protectable if not meant to be historically accurate, about 20 words worth. The event itself is an unprotectable historical event.

f. The Creative Expression Regarding the Introduction of the Song “Sherry”

The Play, like the Work, recounts how Bob Gaudio arrived late to a rehearsal excited about a new song he just wrote. In the Play, contrary to Gaudio’s and Valli’s enthusiasm for the song, DeVito thinks the song is no good, “bullshit,” and that it was a “fuckin’ insult” Gaudio wrote it “fifteen minutes ago.” The band calls Crewe, who loves it. The scene shifts to disc jockey “Barry Belson” praising the record and announcing the band’s upcoming appearance on American Bandstand. The scene then shifts to the band performing “Sherry” on stage.

In the Work, Gaudio arrives late to the rehearsal and announces he thinks he wrote a hit. He plays “Sherry” on the piano. DeVito recalls he liked the song but “didn’t think [they] could get away with it,” because the song was about a girl much younger than the band members. Crewe, however, was at the rehearsal and heard “Sherry” the same time the band members did. He added it to the recording session because he thought it had potential. The band released the song on their album but didn’t yet perform it on stage. Disc jockey “Murry the K” played the song in New York City for a call-in poll, but the song came in

third. The band was dejected, but soon found out the record had sold 180,000 copies. They then play “Sherry” onstage, and the audience “goes nuts.”

The dialogue in the Play is not copied from the Work. Only the unprotectable historical facts of Gaudio having written the song at the last minute and the song being a hit are potentially copied from the Work. The dialogue is completely different, as is DeVito’s initial reaction to the song.

g. The Creative Expression Regarding the Introduction of the Song “Big Girls Don’t Cry”

In the Play, Gaudio recounts to the audience that he was wondering where his next hit would come from as he was watching a John Payne movie. Payne’s character slapped Rhonda Flemming’s character and asked her what she thought about it, to which she replied, “Big girls don’t cry.” In the Play, Gaudio finishes the story with the words, “and she says “ The line “Big girls don’t cry” is then sung by Valli as the band begins the song onstage.

In the Work, DeVito relates that it was Crewe who was inspired by the Rhonda Flemming line and that Crewe co-wrote the song with Gaudio. The only similarity is the unprotectable historical fact that the song was inspired by the Rhonda Flemming line.

h. The Creative Expression Regarding the Introduction of the Song “Walk Like a Man”

This issue is redundant with “The Dialogue Surrounding Song Title and Subject *1073 Matter of

the Song “Walk Like a Man.” *See supra*.

i. The Creative Expression Regarding the Introduction of the Song “Dawn”

The introduction of the song “Dawn” in the Play is described, *supra*, in connection with “The Beatles Line.” The Work recounts that Sandy Lindzer approached Gaudio with a partially written “Dawn,” and that Gaudio recognized its potential and finished it. The Work notes that the Beatles had “hit the public consciousness like a load of bricks” when “Dawn” was ready for release. The Work recounts the billboard competition between the Beatles and the Four Seasons for several pages, but the Play does not address this. In summary, the Court cannot identify any protectable expression in the Work concerning the release of “Dawn” that appears in the Play, apart from the “social movement” line noted *supra*.

j. The Creative Expression Regarding DeVito’s Introduction of Valli to Mary and the Characterization of Mary

In the Work, Valli’s introduction to Mary and his interest in her is recounted for about half a page on pages 58–59, and his further interest in her, as well as his mother’s disapproval stated to DeVito, is recounted for a little more than half a page on page 62. Valli’s first encounter with Mary in the Play is three minutes long from 17:05 to 20:05. In the Work, Valli inquires about Mary to DeVito as they drive home from a show where Valli had noticed her, and DeVito warns him away but ultimately agrees to help him with her. In the Play, Valli notices Mary at the show, and DeVito warns him away, but Valli ultimately leaves with

Mary on a date that comprises most of the three-minute scene. No dialogue appears to have been copied, only the unprotectable historical facts that Valli first noticed Mary at a show and that DeVito warned Valli away when Valli inquired about her.

In the Work, Valli's mother later calls DeVito and asks him to "get Frankie away from this whore." In the Play, DeVito recounts immediately after the date scene that Valli has now married Mary and that he wanted to buy her some jewelry, which leads into the fake murder scene, without any indication that Valli's mother asked DeVito to try to break up Valli and Mary.

On pages 67–71 of the Work, DeVito recounts how Mary took advantage of Valli's devotion to her and sometimes criticized and ridiculed Valli to his face, even in front of his friends, causing him to become more reserved and transforming him "into a different type of person." In DeVito's opinion, the change made Valli less likeable but also perhaps fueled his drive for perfection and success. Ultimately, DeVito was unable to "forgive Mary for her role in quenching the sparkle in his eye." He wrote that Mary, like some other women involved with rock band members, had "profoundly test[ed] the group." The Play depicts an argument between Valli and Mary where Mary complains that he is rarely home with the family, and Valli complains about her substance abuse. But apart from Mary once insulting Valli as "a dumb wop from Jersey who never even graduated high school," the only similarity is the fact of some sort of conflict. The Play does not depict Mary criticizing Valli into timidity or berating him in front of others. Gaudio, who is

narrating the Play at that point, does not indicate that Mary had changed Valli's personality through any kind of prolonged emotional abuse. To the contrary, he notes that Valli had told the band members that his divorce from Mary had been "for the best," but that they knew "that wasn't the whole story." The scene then shifts to Valli singing "My *1074 Eyes Adored You," with Mary watching from the side of the stage and eventually joining Valli in the song, followed by the other members of the band. It is a song about unrequited childhood love that does not perfectly fit the story, but which clearly enough expresses the Play's authors' message that Valli was unhappy about the divorce, had genuinely loved Mary, and perhaps still did. The Play's narrative is contrary to the Work's narrative about Valli having been beaten down emotionally by Mary.

In summary, the Play copied no creative expression from the Work in relation to Valli's introduction to or relationship with Mary. The Play used its own creative expression in telling the story of Valli's interest in Mary, DeVito having warned him away, and any conflict between Valli and Mary. The historical facts of these events are not protectable by copyright.

k. The Creative Expression Regarding DeVito's Intercession After Valli's Arrest at The Request of Valli's Mother

The Play recounts DeVito's intercession after Valli's arrest (excluding a musical interlude), for a total of about one minute. The Work recounts the incident for about one page. No creative expression from the Work relating to this event is copied into the

Play. In the Play, Valli's mother tells DeVito that Valli looks up to him, and DeVito promises to look out for Valli. Valli's interrogation by the police and release by the judge at DeVito's urging follows, and although Valli's mother appears as an observer in the courtroom scene, there is no indication she specifically asked DeVito to intercede after Valli's arrest, as recounted in the Work. Rather, she had only given DeVito a general admonition to look out for Valli. Valli's mother's only dialogue in the scene is original to the Play. She has no dialogue in the Work as to this incident.

In summary, there is nothing creative in the Work as to this scene that was copied into the Play, but only the unprotectable historical fact of DeVito's intervention. The Play does not even recount the details of the intervention accurately, but creates a slightly different scene in order to abbreviate the incident and merge it with a recounting of DeVito's return to prison. That is, the Work recounts DeVito's indirect intervention via a probation officer he knew, whereas the Play depicts DeVito directly intervening with the judge during a hearing, after which the judge gives DeVito his own sentence. Only the broad, unprotectable historical fact of intervention by DeVito on behalf of Valli is potentially copied from the Work.

1. The Creative Expression Regarding the Fake Murder in Valli's Car

The fake murder scene runs from 20:40 to 25:20 in the Play, approximately 1:20 for the fake murder itself in the car, 1:00 for DeVito's discussion with Valli explaining it was a scam, and 2:20 for the scene with Gyp DeCarlo, who had fixed the problem for Valli. In the Play, there are two men in the front of Valli's car,

with Valli in the back. The two men are ostensibly driving Valli to a jewelry store to buy gifts for Mary. The argument between the driver and the front passenger erupts based on a disagreement over driving directions. Ultimately, the passenger “shoots” the driver after they call one another “asshole,” then tells Valli to get out of the car and that he will take care of it and call him the next day. Valli leaves, and the two men laugh. The scene shifts to Valli telling DeVito that the passenger wants \$25,000 to get rid of the “body” and the car. DeVito tells Valli it was a scam and that he will take care of it without bothering Gyp DeCarlo, a local organized crime boss. DeVito then explains to the audience that he indeed called Gyp DeCarlo to fix the situation. *1075 The scene shifts to DeCarlo, DeVito, and Valli. After giving DeVito some tasks, DeCarlo asks Valli to sing “My Mother’s Eyes.” Valli says he doesn’t sing that song anymore but agrees after DeCarlo patiently explains that Valli owes him a favor because DeCarlo took care of the fake murder situation and got his car back. The scene implies that Valli didn’t initially realize DeCarlo was the one who had fixed the situation (because DeVito had previously told Valli that he would handle it himself without bothering DeCarlo).

In the Work, the scene comprises the entirety of Chapter 23, five pages. There are two men in the front of Valli’s car, but they pick up a third man who joins Valli in the back. The driver is ostensibly returning Valli’s car after having borrowed it. The plan is to pick up Valli, drive to the driver’s house, and have Valli drive his car back home. The argument between the driver and the front passenger erupts based on a disagreement over some unspecified illegal “business.”

The driver pulls over and calls the passenger a “mother-fucker,” and the passenger calls the driver an “asshole.” The driver then shoots the passenger, rejoins traffic, and tells Valli he’ll dump the car in the river and that he should report it stolen. Valli tells DeVito what happened, and DeVito tells Valli to wait for the driver’s call and to tell DeVito exactly what he says. The driver calls three days later and tells Valli that the man in the back seat is going to go to the police unless they pay him an unspecified amount. Valli tells DeVito, and DeVito goes directly to DeCarlo, who tells DeVito to tell Valli not to worry about it and to meet him on the golf course the next day. On the golf course, DeCarlo has Valli retell the whole story, then tells Valli everything will be fine. Valli’s car shows up at his house unharmed two days later.

There is very little creative expression here that may have been copied from the Work into the Play. The incident recounted is historical, which is not protectable. Many details are recounted differently, in any case, i.e., created by the authors of the Play (the number of people in the car, the reason for the trip, who shoots whom, the explanation of the need for money, whether DeVito told Valli he would not involve DeCarlo, the dialogue with DeCarlo, and whether Valli spoke to DeCarlo before or after the problem was fixed). The only protectable element that may have been copied is the “asshole” line. Assuming that line was fabricated in the Work (as opposed to having been recounted as a historical fact) and copied into the Play, it consists only of the ten words, “Well, asshole, what do you plan to do about it?” And only the gist of the line is copied – it is not copied word-for-word. The line

in the Play is, “Oh yeah, asshole, what are you gonna do about it?”

m. Summary of the Substantiality Factor

In summary, at most, the jury could have found about 145 creative words to have been copied from the Work into the Play, whether as dialogue or creative descriptions of events. Those 145 words constitute about 0.2% of the approximately 68,500 words in the Work (approximately 250 words per page times 274 pages). This factor strongly weighs in favor of a finding of fair use, at least where the “heart” of the Work was not infringed. *See Elvis Presley Enters., Inc. v. Passport Video*, 349 F.3d 622, 630 (9th Cir. 2003). Because the Work is biographical in nature, its “heart” consists of unprotected facts (in this case, those facts DeVito claimed in the Work had previously been hidden or distorted). It is that collection of uncopyrightable facts that was “the most likely to be newsworthy and important in licensing serialization.” *Id.* Woodard’s writing style, which is the only aspect of the Work producing *1076 protectable elements, although necessary to production of the Work, was not the heart of the Work. An author’s writing style could perhaps constitute the “heart” of a biographical work in an extreme case, for example where the facts of the subject’s life were already known to the reader or mostly uninteresting but where a highly skilled writer celebrated for his wit and commentary had written the biography. But that is not the case here. Here, the interest of a reader of the Work would be in the facts revealed by DeVito, not in Woodard’s writing skills. That is not to say that Woodard was not a good (or even excellent) writer, but there is no evidence that

there was any market for his writing in-and-of- itself. He was not a known author. The “heart” of the Work – that aspect of the Work likely to attract buyers—was the unprotected historical information conveyed by DeVito.

5. Transformation

Finally, “[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.” *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1174–75 (9th Cir. 2012) (quoting *Campbell v. Acuff–Rose Music, Inc.*, 510 U.S. 569, 579, 114 S.Ct. 1164, 127 L.Ed.2d 500 (1994)). That is, a work is “transformative” to the extent it adds a different purpose and/or character to the expression in an original work, e.g., a parody. *Id.* at 1173–75. Such a “transformation” of purpose or character is important to fair use because a parody, for example, is not likely to affect the market for the parodied work, the effect on the market for a work being the most important consideration under a fair use analysis. *Id.* at 1182 (citing *Campbell*, 510 U.S. at 591, 114 S.Ct. 1164).

The “transformation” in the present case is both a change of purpose and a change of character. The Play takes on a different purpose from the Work when the script (most of which was not taken from the Work) is incorporated into musical performances using material in which Plaintiff has no copyright. The purpose of the Work is primarily to inform. Tommy DeVito set out to vindicate his perspective and reveal hidden truths. Woodard’s writing skills made the Work readable, even if the material was ultimately not commercially publishable. The purpose of the Play, however, is

primarily to entertain. Even if the purpose of the Play were primarily to inform, the Play takes on a different character from the Work by the incorporation of Tommy DeVito's singular perspective into a more complete and balanced description of events based on competing perspectives of all four band members. The Play is structured around this concept, with the characters of DeVito, Gaudio, Massi, and Valli sequentially narrating the Play from their own perspectives during the respectively titled Spring, Summer, Fall, and Winter portions of the play, i.e., the figurative "four seasons" of the history of the band. And in doing so, the Play adds creative expression beyond mere republication. *See L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 939 (9th Cir. 2002). The transformative nature of the use in this case is significant. To the extent the character and purpose of the Play differ from the character and purpose of the Work, the importance of any factors counseling against a finding of fair use are diminished. *See Monge*, 688 F.3d at 1174–75.

In summary, the first factor weighs against fair use as in any typical case of commercial use, the second factor weighs in favor of fair use, the third factor weighs heavily in favor of fair use, the fourth (most important) factor weighs heavily in favor of fair use, and the transformative nature of the use diminishes the significance of the sole factor weighing against fair use. To permit a finding of no fair use *1077 based purely on the fact of commercial use where the importance of that factor is significantly diminished by the transformative nature of the use and the other factors weigh in favor of fair use (two of them heavily so, including the most important factor),

would be to impermissibly treat the first factor as conclusive. *See Campbell v. Acuff–Rose*, 510 U.S. 569, 585, 114 S.Ct. 1164, 127 L.Ed.2d 500 (1994). A finding of no fair use, where such a tiny part of the creative elements of a biographical work with little to no market value were copied, and where the use was significantly transformative, would hinder rather than further the purposes of copyright. *See id.* at 579, 114 S.Ct. 1164. The Court finds that Defendants are entitled to a judgment of fair use as a matter of law.²

The Court denies the renewed motion for judgment as a matter of law on the other grounds presented. There was evidence adduced at trial of direct copying and more than de minimis use. The evidence of access to the Work in January 2004; the February 2004 meeting at which Brickman, Elice, and McAnuff examined the Work; and the Krevolin Report's comparisons of the Work to the evolving scripts provided sufficient evidence to find direct copying. Next, the jury could have properly found that the

² Having heard the trial evidence and many times examined similar evidence submitted with pre- and post-trial motions over the last decade, the Court is of the overall impression that the only bad actor in this case was DeVito. He was deceitful with Plaintiff regarding his registration and licensing of the joint Work, and he was deceitful with New Defendants as to his alleged sole ownership of the Work. Plaintiff, however, has chosen to settle her claims against DeVito, basically allowing him to keep royalties and waiving any accounting against him. New Defendants were ignorant of DeVito's obligations to Plaintiff and were unaware of any potential copyright infringement via their use of the Work based on DeVito's representations in the 1999 Agreement and otherwise. New Defendants are as much victims of DeVito's actions as Plaintiff.

average audience familiar with the Work would recognize the protected, copied portions in the Play; audience recognition is the test for de minimis copying, regardless of how minimal the copying is in relation to the infringing work or the copyrighted work as a whole. *See VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 878 (9th Cir. 2016) (quoting *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004)).

C. Motion for a New Trial

After a jury trial, a district court may grant a new trial “for any reason for which a new trial has heretofore been granted in an action at law in federal court . . .” Fed. R. Civ. P. 59(a)(1)–(a)(1) (A). Although a court of appeals may only overturn a jury verdict on appeal for excessiveness if it is “grossly excessive or monstrous,” a trial court may grant a new trial if the verdict is against the clear weight of the evidence. *Siebrand v. Gosnell*, 234 F.2d 81, 94–95 (9th Cir. 1956) ; *Bradley Mining Co. v. Boice*, 194 F.2d 80, 83 (9th Cir. 1951) ; *S. Pac. Co. v. Guthrie*, 186 F.2d 926, 932 & n.10 (9th Cir. 1951). The Court is compelled to find this to be the case here. Specifically, the finding that 10% of the success of the Play was attributable to protected elements copied from the Work cannot be supported by the evidence adduced at trial.

As recounted in detail, *supra*, after subtracting those potential similarities based on unprotected elements of the Work or where the corresponding creative element was not copied from the Work but original to the Play, the Court permitted the jury to consider only 12 similarities between the Work and the Play. Those 12 similarities constituted approximately 0.4% of the Play’s script, which itself accounted for

*1078 less than half of the Play's running time, the remainder being comprised of music for which Plaintiff does not own the copyright. Therefore, assuming that the music that comprised roughly half of the running time of the Play accounts for roughly half of its success, a finding of 10% implies that the few words copied from the Work (which account for approximately 0.2% of the running time of the Play) account for roughly 20% of the success of the Play attributable to the dialogue. That assessment is unsupportable. Of course, determining the percentage of the Play attributable to infringement of the Work is not a strict, mathematical calculation. But the verdict must be supported by sufficient evidence, and the Court cannot find under the present circumstances that a figure of 10% could be reached based on the evidence adduced at trial.

The Court's analysis under the substantiality factor of the fair use test, *supra*, leads the Court to find that the verdict of 10% is against the clear weight of the evidence. Roughly 0.2% of the Work was both protectable by copyright and copied into the Play, and the copied portions accounted for no more than 1% of the running time of the Play. Importantly, there is no evidence that the copied creative elements were disproportionately important to the Play's success. Additionally, the jury appears to have disregarded the evidence of the limited effect on the success of the Play due to its use of parts of the Work. There was substantial evidence admitted at trial to the effect that many additional elements contributed to the worldwide success and profits of the Play: the additional inventive material in the script, the stagecraft used in live production, the use of

copyrighted music in the Play for which Plaintiff has no copyright, direction and production efforts (including the employment of world-renowned writers, directors, and producers), and advertising and promotion efforts, among other elements. The jury cannot have reached the conclusion it did without disregarding these elements that contributed to the success of the Play, even assuming the 10% figure were an accurate calculation of the amount of the infringed material as compared to the Play as a whole, a conclusion that itself is not supported by the evidence.

The jury also failed to focus on the relevant facts as to the remanded question of an implied nonexclusive license, although the Court accepts some responsibility for the error. In the Court's summary judgment analysis of an implied nonexclusive license, the Court had found an implied nonexclusive license based upon the sole factor of DeVito's delivery of the Work to the authors of the Play. The Court of Appeals reversed on that issue, clarifying that delivery may be considered but cannot be a sole basis for a finding of an implied nonexclusive license. The Court finds that the verdict of no implied nonexclusive license is against the clear weight of the evidence given DeVito's attendance at the Play and continued receipt of royalties therefrom.

The Court of Appeals' remand on the implied nonexclusive license issue cannot be construed as requiring jury consideration solely on the factor of delivery. There can be no implied license where an express license is given. In this case, an express license was given by DeVito in the 1999 Agreement, which

gave full license to use of the Work in creating and producing a play, but that express license terminated by its own terms on December 10, 2004, before the Play debuted. No implied license may be found during the period from the execution date of the 1999 Agreement until its termination, which time period includes DeVito's delivery of the Work to the writers of the Play in January 2004. The basis for an implied license therefore cannot be found in the circumstances surrounding *1079 delivery of the Work to the writers of the Play, but only in the facts that DeVito continued to receive royalty payments and personally attended productions of the Play after the 1999 Agreement had terminated without ever objecting to the (albeit minimal) use of the Work therein, which DeVito would have recognized. *See supra*, discussion concerning *de minimis* copying. When DeVito's delivery of the Work and his intent when doing so are discounted as irrelevant (because the express license was then in effect), the only evidence as to implied license was DeVito's attendance at the Play in La Jolla in 2004 and on Broadway in 2005 and his receipt of royalties without objection. These factors must be considered as part of the totality of the parties' conduct. *See* 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 10.03[A][7], at 10–55 (2015). Neither the Court's Instructions, nor the evidence, nor the parties' closing arguments, focused on these facts. The Court, the parties, and the jury therefore failed to focus on the factual issues directly relevant to implied license as directed by the Court of Appeals. For all of these reasons, the Court grants the motion for a new trial on the implied license issue, as well.

CONCLUSION

The Court appreciates the jury's service in this complex case. Comparisons of a several-hundred-page book to a several-hour play are tedious and complex. Those comparisons are made even more difficult when they must be guided by over 40 pages of technical legal instructions. Even for a court, such a task is difficult, because the law in this area is not totally clear in all respects. The Court therefore appreciates the difficulty of the task with which the jury was charged, but the law and evidence compels the result the Court reaches today. Defendants are entitled to a judgment as a matter of law on the fair use issue. Even if they were not, a new trial would be required on the implied nonexclusive license issue and the damages award.

IT IS HEREBY ORDERED that the Motion to Vacate (ECF No. 1108) is GRANTED.

IT IS FURTHER ORDERED that the Renewed Motion for Judgment as a Matter of Law (ECF No. 1112) is GRANTED IN PART as to fair use but is otherwise denied.

IT IS FURTHER ORDERED that the Motion for New Trial (ECF No. 1113) is GRANTED IN PART with respect to Questions 1 and 4 of the Verdict but is otherwise denied.

IT IS FURTHER ORDERED that the Clerk shall enter judgment and close the case.

IT IS SO ORDERED.

APPENDIX C
UNITED STATES DISTRICT COURT
District of Nevada

2:08-cv-00867-RCJ-PAL

DONNA CORBELLO,

Plaintiff,

v.

THOMAS GAETANO DEVITO, *et al.*,

Defendants.

Decided November 17, 2016

ROBERT C. JONES, United States District Judge

ORDER

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

for immediate appeal. The Court of Appeals reversed and remanded for further proceedings. At the close of Plaintiff's evidence, Defendants orally moved for judgment as a matter of law under Rule 50(a) on all issues, and the Court orally granted the motion in part and denied it in part. This written order follows.

*2

If a party has been fully heard on an issue during a jury trial and the court finds that a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue, the court may . . . resolve the issue against the party . . . and . . . grant a motion for judgment as a matter of law against the party on a claim or defense that, under the controlling law, can be maintained or defeated only with a favorable finding on that issue.

Fed. R. Civ. P. 50(a)(1)(A)-(B). The Court finds that sufficient evidence has been presented at trial of infringement for the jury to determine the question of infringement generally. The Court also finds that the defenses of implied license and fair use must be determined by the jury. The Court finds, however, that sufficient evidence has not been presented at trial for a reasonable jury to find infringement by Defendants Valli or Gaudio or willful infringement by any Defendant.

As to Valli and Gaudio, the evidence at trial was un rebutted that neither of them ever even saw the copyrighted Work until their depositions in this case. Plaintiff argued that Charles Alexander had testified (by deposition) that he had discussed the Work with

Gaudio in a July 2005 interview before the Broadway premier of *Jersey Boys* in November 2005. The transcript of the interview was admitted as Exhibit 183A. The Court reviewed the transcript with counsel on the record. It indicated that Gaudio was aware that DeVito had employed a “ghostwriter” to help him write a “[b]ook or something” and that he had sent it to Defendants Brickman and Elice. But there was no evidence from Alexander (or any other witness) that Gaudio (much less Valli) was ever aware that Brickman or Elice copied from that “book or something” to create the script for *Jersey Boys*, nor that Valli or Gaudio had the ability to exercise any control over that activity. As discussed on the record the following morning, although infringement does not require a willful intent to violate a copyright as required for enhanced damages, it still requires an intent to copy even if the copier does not realize that the copying violates a copyright. There was no evidence adduced at trial indicating that Valli or Gaudio knew that the writers had copied from the Work in creating *Jersey Boys*. *3

As to willful infringement, there was no evidence adduced at trial that any Defendant knew of or recklessly disregarded the possibility that any copying from the Work infringed a copyright. Tommy DeVito’s failure to object to any portion of the *Jersey Boys* script that may have been copied from the Work either before or after public performances began, after having given access to the Work for the purpose of helping write the script, not only strongly implies a license (a separate issue) but also obviates any claim that Brickman, Elice, or McAnuff (the Defendants who allegedly

actually copied from the Work) had reason to believe that any copying was wrongful.

CONCLUSION

IT IS HEREBY ORDERED that Defendants Frankie Valli and Robert Gaudio are entitled to judgment as a matter of law against the claims of copyright infringement, and all Defendants are entitled to judgment as a matter of law against enhanced damages for willful copyright infringement.

IT IS SO ORDERED. Dated this 17th day of November, 2016.

/s/ _____

ROBERT C. JONES
United States District Judge

APPENDIX D

**UNITED STATES DISTRICT COURT
District of Nevada**

2:08-cv-00867-RCJ-PAL

DONNA CORBELLO,

Plaintiff,

v.

THOMAS GAETANO DEVITO, *et al.*,

Defendants.

Decided Sep 29, 2015

ORDER

ROBERT C. JONES, United States District Judge

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

and remanded for further proceedings. The Court now determines whether, and to what extent, Defendants are entitled to summary judgment on the infringement issue under the extrinsic test. *2

I. FACTS AND PROCEDURAL HISTORY

A. Factual Background

1. The Work

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

Woodard kept in touch with DeVito and founding Four Seasons member Frankie Valli throughout the 1980s, and in November of 1988 Woodard flew to Las Vegas, Nevada for a series of interviews (the “1988 Interviews”) with DeVito that sowed the seeds of the present litigation. (*See id.* ¶ 31-32). During these interviews, DeVito explained to Woodard that except for Valli and final Four Seasons founding member

Robert “Bob” Gaudio, the members of the band (DeVito and Massi) had spent several years engaged in criminal enterprises and in prison and retained “underworld contacts” throughout the band’s era of popularity. (*See id.* ¶ 32). Because this revelation was in stark contrast to the clean-cut image of the band presented in the popular media, Woodard realized the journalistic value of the story, and DeVito offered Woodard the *3 opportunity to write his authorized biography with full credit and an equal share in any profits. (*See id.*).

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

December 1, 1988

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

Dear Tommy:

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

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

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

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

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

*4 Sincerely,

[signed Rex Woodard]
Rex Woodard

RW/ml Enclosures

APPROVED:

[signed Tommy DeVito]
TOMMY DEVITO

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

2. Woodard's and DeVito's Publication Attempts

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

UNTITLED

**TOMMY DEVITO/FOUR SEASONS
BIOGRAPHY**

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**TOMMY DEVITO
REX WOODARD**

©, January, 1991

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

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

3. Plaintiff's and Ceen's Publication Attempts

In accordance with Woodard's wishes, Plaintiff and Woodard's sister Cindy Ceen continued to seek publication after Woodard's death independently of DeVito; however, public interest in The Four Seasons had waned, making it difficult to find a publisher. (*Id.* ¶ 42). In September 2005, Ceen decided to contact DeVito for his assistance in publishing the Work. (*See id.*) Ceen first contacted a prominent member of an Internet Four Seasons fan group named Charles Alexander to facilitate contact with DeVito. (*See id.* ¶ 43). Alexander responded to Ceen on September 22, 2005 that he had met with DeVito the previous day, had told DeVito of Ceen's desire to publish the Work, and that DeVito had agreed to help. (*See id.*) Ceen called DeVito the same day at a telephone number provided by Alexander, and DeVito indicated that he wanted to update the Work with post-1990 events and restore some "obscene" language Woodard had omitted. (*Id.*) DeVito also claimed he had lost his copy of the Work and asked Ceen for a replacement, which she mailed to DeVito the next day, along with a letter memorializing their telephone conversation and

informing DeVito that Plaintiff was considering self-publishing the Work if a traditional publisher could not be found. (*Id.*). Neither Plaintiff nor Ceen heard from DeVito again. (*Id.* ¶ 44). DeVito's attorney Jay Julien left Ceen a voice mail message on November 2, 2005, and Ceen returned his call the next day, during which conversation Julien told Ceen that he had spoken with DeVito regarding the Work and concluded that it was "not *6 saleable." (*Id.*). Ceen was surprised by this conclusion, because the play *Jersey Boys* was scheduled to open on Broadway a few days later. (*Id.*). Julien did not disclose that the Work had been used or exploited in any way or that rights in the Work had been licensed or assigned. (*Id.*).

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

By late 2006, *Jersey Boys* had become a Broadway hit, earning four Tony Awards. (*Id.* ¶ 45). Plaintiff had not seen the show, but she and Ceen estimated that the show's success would revive interest in the band and make publication of the Work viable. (*Id.*). Plaintiff and Ceen engaged counsel to confirm the registration of Woodard's and DeVito's copyright in the Work, to register the copyright if not yet registered, and to contact Julien to see if DeVito had changed his mind about joint publication of the Work in light of *Jersey Boys's* success. (*Id.*). A January 3, 2007 search of the U.S. Copyright Office's online records indicated no registration of the Work to Woodard but showed that on January 11, 1991 (four months before Woodard's death) DeVito had registered a literary work entitled *Tommy DeVito - Then and Now*, Reg. No. Txu 454 118 (the "DeVito Work"). (*Id.* ¶ 46). Plaintiff's counsel ordered a copy of the registration

and discovered that DeVito had registered the DeVito Work in his own name only, claiming that the work was unpublished and that he wrote it in its entirety in 1990. (*Id.* ¶ 47). Plaintiff's counsel ordered a copy of the DeVito Work itself and discovered that the DeVito Work was identical to the Work, and in fact appeared to be a photocopy of the manuscript typed by Woodard's secretary Myrtle Locke, with two exceptions. (*Id.* ¶¶ 48-49). First, the original cover page from the January 1991 version of the Work had been replaced with a cover page in a different font and font size, reading:

TXu 454 118

....

*7 Tommy DeVito - Then and Now

by

Tommy DeVito

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

Plaintiff also soon discovered that the writers of and several actors in *Jersey Boys* had access to the Work and that DeVito had received royalties or other profits from *Jersey Boys*, and she concluded that the Work had "inspired the form, structure, and content of the musical . . ." (*See id.* ¶ 51). As support for this

conclusion, Plaintiff notes that Defendant Des McAnuff, the director of *Jersey Boys*, was quoted in a July 8, 2006 report in Backstage magazine as stating that Defendants Marshall Brickman and Eric Elice had relied in part on “an unpublished autobiography by DeVito” in creating the libretto. (*See id.* ¶ 52). Plaintiff notes that Christian Hoff, the first actor to play DeVito in *Jersey Boys*, stated in what appears to be an online interview that he was provided with a synopsis of the Work for his audition and a full copy for background research. (*See id.*). Plaintiff also cites to a Wikipedia entry for support that the Work served as a basis for the musical. (*See id.*). Plaintiff also notes an exchange on a Jersey Boys podcast website indicating that one fan had reported to another that the musical was based on DeVito’s unpublished biography. (*See id.*). Plaintiff also saw public reports of DeVito’s financial profits from the musical. (*See id.*). *8

5. Pre-Litigation Negotiations

On June 13, 2007, Plaintiff’s counsel wrote Julien by email and overnight courier demanding that DeVito execute an application for supplementary registration with the U.S. Copyright Office to add Woodard as a coauthor and co-claimant of the Work and demanding an accounting of profits in accordance with the Letter Agreement. (*Id.* ¶ 53). Counsel conferred with one another by email and telephone between June and October 2007, and Julien admitted at one point that DeVito had provided a copy of the Work “to Jersey Boys” and expressed interest in the possibility of a joint copyright infringement action against “Jersey Boys,” but later decided that Plaintiff’s only recourse was a suit against DeVito because he had authorized the use of the Work. (*Id.* ¶ 54). Although DeVito

initially considered filing a supplemental registration of the Work to credit Woodard, he later refused, claiming that he in fact was the sole author and that Woodard had been a mere scribe. (*Id.*).

On July 2, 2007, Plaintiff filed her own supplementary application with the U.S. Copyright Office to add Woodard as a coauthor and co-claimant of the Work, but the office rejected the application because DeVito, the original claimant, had not signed it. (*Id.* ¶ 55). The office could not under 17 U.S.C. § 201(a) permit a non-author, non-claimant as to an original registration, i.e., a “basic registration,” to supplement the basic application, but such a person could apply to register her own work, in which case the office would consider the new claim to be adverse to the existing claim if the claims purported to register the same work exclusively to different claimants. (*See* Copyright Office Letter, June 16, 2008, ECF No. 457-27, at 7). However, the Copyright Office Review Board granted Plaintiff’s appeal based on a closer examination of regulations and practices, determining that her supplemental registration could be accepted, and that a certificate of registration would be issued after processing. (*See* Copyright *9 Office Letter, Mar. 27, 2009, ECF No. 457-28). The amended certificate, Reg. No. TXu1 372-636, lists Woodard and DeVito as coauthors of the entire text of the Work and co-claimants thereto. (*See* Certificate of Registration TXu1 372-636, July 3, 2007, ECF No. 457-29).

Thereafter, further indication of the connection between *Jersey Boys* and the Work emerged through public sources such as public interviews of certain Defendants. (*See* Third Am. Compl. ¶ 56). Plaintiff alleges that the evidence that the musical was an

adaptation of the Work means that *Jersey Boys* is a “derivative work” of the Work under 17 U.S.C. § 101. (*See id.* ¶ 57). Plaintiff recounts various similarities between *Jersey Boys* and the Work. (*See id.*)

6. The “Cover-Up”

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

7. DeVito’s Licensing of the Work

Certain documents made public during Valli’s divorce proceedings in July 2008 revealed that DeVito had granted Valli and Gaudio an exclusive, irrevocable, perpetual, worldwide, assignable license (the “1999 Agreement”) freely to use and adapt certain “Materials,” including his “biographies,” for the purpose of creating a musical based on the “life and music” of The *10 Four Seasons. (*Id.* ¶ 59). The 1999 Agreement included the right to “ancillary and subsidiary exploitations thereof including, without limitation, cast albums, motion picture and televised versions, merchandise, and/or other works . . . in all

media now existing or later devised.” (*Id.*). The 1999 Agreement waived any claim of copyright infringement by DeVito, provided that DeVito would be entitled to 20% of any royalties Valli and Gaudio obtained through exploitation of the Materials, and provided that Massi would be entitled to 5% of any such royalties. (*See id.*). Plaintiff suspects that Valli and Gaudio further licensed the Materials, which included the Work, to one or more unknown authors in 1999 for adaptation into an early version of *Jersey Boys* called *Walk Like a Man*. (*See id.*). When the original producer rejected *Walk Like a Man*, Valli and Gaudio fired its authors, permitted their agreement with the original producer to lapse, and further licensed the Materials to Brickman and Elice, who used them to write *Jersey Boys*. (*See id.*). Plaintiff implies that Valli’s and Gaudio’s joint ventures related to their exploitation of the Materials constitutes a general partnership as a matter of law that Plaintiff refers to as “The Four Seasons Partnership.” (*See id.* ¶ 4-5).

8. *Jersey Boys*

The *Jersey Boys* foundational production agreement (the “*Jersey Boys Agreement*”) is dated May 1, 2004. (*See id.* ¶ 61; *Jersey Boys Agreement* 1, ECF No. 457-34, at 2). The *Jersey Boys Agreement* lists five parties: Valli and Gaudio as “Owner,” Brickman and Elice as “Bookwriter,” and Dodger Stage Holding Theatricals, Inc. (now known as DSHT, Inc.) as “Producer.” (*See Jersey Boys Agreement* 1). The copies of the signature page of the *Jersey Boys Agreement* attached to the Third Amended Complaint (“TAC”) include signatures by all of these parties except Brickman, and DSHT’s signature is typewritten, without the handwritten signature of any natural

person as an agent of DSHT. (*See id.* at 24, ECF No. 457-34, at 25-26). The *11 signatures are not dated. (*See id.*). The Jersey Boys Agreement is comprehensive and appears to govern the worldwide exploitation of *Jersey Boys*. (*See generally id.*). The details of the twenty-three-page agreement need not be recounted here, but will be noted where relevant to the determination of claims. The Jersey Boys Agreement includes a schedule and two exhibits as attachments, all of which the base agreement identifies. Schedule A is a table of musical compositions to be used in the musical along with details of authorship and copyright ownership. Exhibit A is the 1999 Agreement. Exhibit B is a list of “payment instructions” consisting of addresses for mailing payments to the signatories and other beneficiaries.

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

B. Procedural History

1. The Present Lawsuit

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

and Getting Home); (17) contributory copyright infringement under 17 U.S.C. § 502 (Valli, Gaudio, Brickman, Elice, McAnuff, Michael S. David, DSHT, Dodger Theatricals, Jersey Boys Broadway, and Jersey Boys Records); (18) copyright infringement under § 16(2) of the Copyright, Designs, and Patents Act of 1988 (U.K.) (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway); (19) copyright infringement under § 27(1) of the Copyright Act, R.S.C. 1985 (Can.) (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway); and (20) copyright infringement under §§ 115(1), 36, and 39 of the Copyright Act of 1968 (Cth) (Austl.) (Valli, Gaudio, Brickman, Elice, McAnuff, DSHT, Dodger Theatricals, and Jersey Boys Broadway). *13

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

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

it as to infringement for the same reasons the Court denied DeVito's motion.

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

The Court denied Brickman's, Elice's, McAnuff's, DSHT's, Dodger Theatricals', and JB Viva Vegas, LP's other motion to dismiss counts 15-17 for copyright infringement. Movants argued that the alleged similarities were unprotectable under copyright law, that many alleged similarities were not similarities, and that there was no "bodily appropriation" or "wholesale *14 appropriation" of the Work by the *Jersey Boys* script. The Court found the claims to have been sufficiently alleged.

The Court denied Valli's, Gaudio's, DSHT's, and Dodger Theatricals' motion to dismiss counts 13-14 for declaratory judgment and an equitable accounting. The Court denied the motion, finding that Corbello had sufficiently alleged in the alternative that DeVito

had assigned his copyright in the Work via the 1999 Agreement such that movants could authorize others to use it but would owe Corbello, a joint owner, an accounting for any profits thereby obtained.

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

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

On October 27, 2011, the Court granted in part and denied in part two summary judgment motions. Corbello and Defendants Valli, Gaudio, DSHT, Dodger Theatricals, and Jersey Boys Broadway filed cross motions for summary judgment as to counts 12-14 for declaratory judgment and an equitable accounting. As to count 12 for a declaration that DeVito as a joint owner of the Work lacked the legal ability to grant Valli and Gaudio an exclusive license and that the 1999 Agreement was therefore either void, a nonexclusive license, or a transfer of DeVito's rights in the Work, the Court denied summary judgment, ruling that the 1999 Agreement was not a transfer but a license that was exclusive as against DeVito but nonexclusive as against Corbello. As to count 13 for an alternative declaration that the 1999 Agreement permitted Valli and Gaudio to further transfer or license the Work, that they did transfer or license it to DSHT and/or Dodger Theatricals via the Jersey Boys Agreement, and that Dodger Theatricals thereafter transferred or licensed to Jersey Boys Broadway, the Court granted summary judgment to Plaintiff in part, ruling that the 1999 Agreement permitted further *15

assignment and that Valli and Gaudio had further assigned the rights in the Work to DSHT via the Jersey Boys Agreement, but that it was not clear whether there had been any further assignment. The Court granted summary judgment to Defendants as to count 14 for an accounting because there had been no transfer of the Work and the relevant agreements included no duty to account.

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

On January 31, 2012, the Court adjudicated seven of the seventeen claims then remaining and entered judgment in favor of all Defendants except DeVito and David. Jersey Boys Records had moved for summary judgment based on personal jurisdiction and failure to state a claim. The Court found that it had jurisdiction over Jersey Boys Records but granted the motion on the merits, ruling that Plaintiff had adduced no evidence that Jersey Boys Records had control over any other Defendant, that there was no allegation that Jersey Boys Records was aware of any infringement, so it could not be liable for contributory infringement, and that the album at issue did not pass the extrinsic test as to substantial similarity to the Work. The Court denied two motions for summary judgment based on the statute of limitations. The Court denied David's motion for summary judgment based on personal jurisdiction.

The Court denied a motion for summary judgment on the merits of the infringement issue (Motion No. 626) as moot because it granted another motion based on the Defendants' having licenses to use the Work. The Court granted a motion for summary judgment as

against the claims of infringement under foreign law, following the Second Circuit's persuasive ruling that the Berne Convention did not provide choice-of-law rules for copyright claims, and finding that U.S. law governed issues of copyright ownership and licensing in this case even if foreign law governed substantive infringement claims, and that the licenses under U.S. law protected Defendants from the foreign infringement¹⁶ claims. The Court granted Corbello's motion for summary judgment as to declarations that the Work was a joint work, that Woodard was a co-owner of the Work, and that DeVito held a 50% interest in the DeVito Work in constructive trust for Corbello, as successor-in-interest to Woodard.

5. Further District Court Proceedings

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

6. The Appeal and Remand

Corbello appealed Orders 780 and 809. On February 10, 2015, the Court of Appeals reversed, ruling that the 1999 Agreement was a transfer of ownership such that Valli and Gaudio became joint owners with Corbello in 1999, *Corbello v. DeVito*, 777 F.3d 1058, 1064 (9th Cir. 2015), and that although Valli and Gaudio could not be liable for infringement while they were joint owners, there remained a genuine issue of material fact whether the 1999 Agreement's reversionary clause had later been triggered such that Valli and Gaudio might be liable for infringement for their use of the Work thereafter,

id. at 1066-67. The Court of Appeals also ruled there remained a genuine issue of material fact as to whether DeVito granted Valli and Gaudio an implied nonexclusive license. *Id.* at 1067-68.

7. The Present Order

The case will now proceed to trial, but the parties have requested that the Court first determine certain issues as a matter of law, i.e., whether certain parts of the Work are protected at all, whether certain parts of the Work are entitled to “thick” versus “thin” copyright protection, and whether Defendants are entitled to summary judgment on the infringement issue under the *17 extrinsic test. As the Court has noted, it has already received all the briefing it requires on these issues in previous proceedings. Furthermore, as the Court noted at a recent status conference, it intends to bifurcate the trial into infringement and damages phases, as the lengthy and complex determination of damages will be unnecessary if the jury finds no infringement. Finally, if any Defendants are found to be liable for an accounting, the Court intends to hold accounting proceedings without a jury.

II. LEGAL STANDARDS

A court must grant summary judgment when “the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). Material facts are those which may affect the outcome of the case. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute as to a material fact is genuine if there is sufficient evidence for a reasonable jury to return a verdict for the nonmoving party. *See id.* A principal purpose of summary judgment is “to

isolate and dispose of factually unsupported claims.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In determining summary judgment, a court uses a burden-shifting scheme:

When the party moving for summary judgment would bear the burden of proof at trial, it must come forward with evidence which would entitle it to a directed verdict if the evidence went uncontroverted at trial. In such a case, the moving party has the initial burden of establishing the absence of a genuine issue of fact on each issue material to its case.

C.A.R. Transp. Brokerage Co. v. Darden Rests., Inc., 213 F.3d 474, 480 (9th Cir. 2000) (citations and internal quotation marks omitted). In contrast, when the nonmoving party bears the burden of proving the claim or defense, the moving party can meet its burden in two ways: (1) by presenting evidence to negate an essential element of the nonmoving party’s case; or (2) by demonstrating that the nonmoving party failed to make a showing sufficient to establish an *18 element essential to that party’s case on which that party will bear the burden of proof at trial. *See Celotex Corp.*, 477 U.S. at 323-24. If the moving party fails to meet its initial burden, summary judgment must be denied and the court need not consider the nonmoving party’s evidence. *See Adickes v. S.H. Kress & Co.*, 398 U.S. 144 (1970).

If the moving party meets its initial burden, the burden then shifts to the opposing party to establish a genuine issue of material fact. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586

(1986). To establish the existence of a factual dispute, the opposing party need not establish a material issue of fact conclusively in its favor. It is sufficient that “the claimed factual dispute be shown to require a jury or judge to resolve the parties’ differing versions of the truth at trial.” *T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors Ass’n*, 809 F.2d 626, 631 (9th Cir. 1987). In other words, the nonmoving party cannot avoid summary judgment by relying solely on conclusory allegations unsupported by facts. *See Taylor v. List*, 880 F.2d 1040, 1045 (9th Cir. 1989). Instead, the opposition must go beyond the assertions and allegations of the pleadings and set forth specific facts by producing competent evidence that shows a genuine issue for trial. *See Fed. R. Civ. P. 56(e); Celotex Corp.*, 477 U.S. at 324.

At the summary judgment stage, a court’s function is not to weigh the evidence and determine the truth, but to determine whether there is a genuine issue for trial. *See Anderson*, 477 U.S. at 249. The evidence of the nonmovant is “to be believed, and all justifiable inferences are to be drawn in his favor.” *Id.* at 255. But if the evidence of the nonmoving party is merely colorable or is not significantly probative, summary judgment may be granted. *See id.* at 249-50.

III. ANALYSIS

A. Analytical Framework *19

“A plaintiff bringing a claim for copyright infringement must demonstrate ‘(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.’” *Funky Films, Inc. v. Time Warner Entm’t Co., L.P.*, 462 F.3d 1072, 1076 (9th Cir. 2006) (quoting *Feist Pubs., Inc. v. Rural*

Tel. Serv. Co., 499 U.S. 340, 361 (1991)). Defendants do not appear to dispute that Corbello is a joint owner of the Work. They dispute whether they copied any protectable portions of the Work, whether they had access to the Work, and whether *Jersey Boys* is substantially similar to the Work.

Direct copying is sufficient but not necessary to establish the second element; it can also be established by showing that the defendant had access to the copyrighted work and that the accused work is substantially similar to the copyrighted work. *Id.* (citing *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000)). Summary judgment is appropriate on a substantial similarity theory if no reasonable jury could find “substantial similarity of *ideas and expression.*” *Id.* (quoting *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994)) (emphasis added). In other words, just as direct copying of unprotected parts of a work does not constitute infringement, *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 208 (9th Cir. 1989) (vacating a jury verdict and remanding for a new trial where the jury instructions permitted a finding of infringement based on the direct copying of unprotected material), access plus substantial similarity does not constitute infringement if the substantial similarity relates only to unprotected aspects of a work, see *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 207-08 (9th Cir. 1988) (citing *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987)) (“To determine whether similarities result from unprotectable expression, analytic dissection of *similarities* may be performed. If this demonstrates that all similarities in expression arise from use of

common ideas, then no substantial similarity can be found.”). *20 Although summary judgment on the substantial similarity issue is disfavored, it is permitted, and the Court of Appeals has frequently affirmed such rulings. *Funky Films*, 462 F.3d at 1076-77 (collecting cases).

“The substantial-similarity test contains an extrinsic and intrinsic component. At summary judgment, courts apply only the extrinsic test; the intrinsic test, which examines an ordinary person’s subjective impressions of the similarities between two works, is exclusively the province of the jury.” *Id.* at 1077 (citing *Shaw v. Lindheim*, 919 F.2d 1353, 1360-61 (9th Cir. 1990)).

For summary judgment, only the extrinsic test is important. A plaintiff avoids summary judgment by satisfying the extrinsic test which makes similarity of the works a triable issue of fact. In contrast, a plaintiff who cannot satisfy the extrinsic test necessarily loses on summary judgment, because a jury may not find substantial similarity without evidence on both the extrinsic and intrinsic tests.

Kouf, 16 F.3d at 1045 (citations omitted).

Extrinsic analysis is objective in nature. [I]t depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed. The extrinsic test focuses on articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events in the two works. In applying the extrinsic test, this court compares, not the basic plot ideas for stories,

but the actual concrete elements that make up the total sequence of events and the relationships between the major characters.

[P]rotectable expression includes the specific details of an author's rendering of ideas. However, *scenes à faire*, which flow naturally from generic plot-lines, are not protectable. We must take care to inquire only whether the *protectable elements, standing alone*, are substantially similar. In so doing, we filter out and disregard the non-protectable elements in making [our] substantial similarity determination.

Funky Films, 462 F.3d at 1077 (citations and internal quotation marks omitted; alterations in original). Scenes-a-faire are "situations and incidents that flow necessarily or naturally from a basic plot premise," and their copying does not constitute infringement. *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 624-25 (9th Cir. 2010) (quoting *Cavalier v. Random House, Inc.*, *21 297 F.3d 815, 823 (9th Cir. 2002)). "Familiar stock scenes and themes that are staples of literature are not protected." *Id.* at 624 (quoting *Cavalier*, 297 F.3d at 823). Nor are historical facts protected by copyright. *Id.* at 625 (citing *Narell v. Freeman*, 872 F.2d 907, 910-11 (9th Cir. 1989)).

The Court of Appeals recommends a three-step analysis: (1) the plaintiff must identify similarities between the copyrighted work and the accused work; (2) of those similarities, the district court must disregard any that are based on unprotectable material or authorized use; and (3) the district court must determine the scope of protection ("thick" or

“thin”) to which the remainder is entitled “as a whole” and instruct the jury accordingly for its subjective analysis under the intrinsic test. *See Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir.1994).

Regular or “thick” protection is the norm, but when there are very few articulable, concrete similarities based on protected aspects of a work and a limited number of ways in which the underlying ideas could be expressed differently, or where the only protectable aspect of a work is the “unique selection and arrangement” of otherwise unprotectable elements, a work is entitled only to “thin” protection, where “virtually identical copying” is required to support a finding of infringement. *See id.* at 1442, 1446; *see also Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003) (holding that an artist’s copyright in his jellyfish sculptures was “thin” and therefore protected only from virtually identical copying of his original contributions as to “the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes’ bells” because the shape of a jellyfish and the effects of the glass-in-glass medium were not protectable). *22

Historical works are entitled to lesser protection than are works of fiction. *See Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1524 (9th Cir. 1992) (citing *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1263 (2d Cir. 1986) (citing *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966))) (“Works of fiction receive greater protection than works that have strong factual elements, such as historical or biographical works”); *see also Hoehling v. Univ. City Studios, Inc.*, 618 F.2d 972, 974

(2nd Cir. 1980) (“ [T]he scope of copyright in historical accounts is narrow indeed, embracing no more than the author’s original expression of particular facts and theories already in the public domain. [A]bsent wholesale usurpation of another’s expression, claims of copyright infringement where works of history are at issue are rarely successful.”).

Biographies, of course, are fundamentally personal histories and it is both reasonable and customary for biographers to refer to and utilize earlier works dealing with the subject of the work and occasionally to quote directly from such works This practice is permitted because of the public benefit in encouraging the development of historical and biographical works and their public distribution, e.g., so “that the world may not be deprived of improvements, or the progress of the arts be retarded.”

Maxtone-Graham, 803 F.2d at 1263 (quoting *Rosemont Enters., Inc.*, 366 F.2d at 307 (quoting *Sayre v. Moore*, 105 Eng. Rep. 138, 139 (K.B. 1801))) (ruling that although the creation of a nonfiction work entails some creativity, where a work is essentially factual in nature, even verbatim quotation “within reason” is permitted).

In arguing that the Work is entitled only to “thin” protection, Defendants rely on *Narell v. Freeman*, 872 F.2d 907 (9th Cir. 1989), *Hoehling*, and two reported cases from the Southern District of New York. In *Narell*, the author of a non-fiction book about the immigration of European Jews to California sued the author of a work of fiction who had admitted using the

historical events depicted in the first work to write portions of her novel. *Id.* at 909. The district *23 court granted summary judgment to the defendant based on, *inter alia*, a lack of substantial similarity. *Id.* The Court of Appeals affirmed, because “[Plaintiff’s] copyright does not protect the facts and ideas [Defendant] took from [the copyrighted work]. Summary judgment is proper. [Defendant] did not copy substantial protected portions of [Plaintiff’s] work.” *Id.* at 915. In its analysis, the Court of Appeals noted:

Copyright law protects only an author’s expression. Facts and ideas within a work are not protected. Historical facts and theories may be copied, as long as the defendant does not bodily appropriate the expression of the plaintiff. [T]he scope of copyright in historical accounts is narrow indeed, embracing no more than the author’s original expression of particular facts and theories already in the public domain.

Id. at 910-11 (citations and internal quotation marks omitted; alteration in original). The defendant in that case “largely took unprotected factual information” from the plaintiff’s work, such as reasons for the immigration, details of Adolph Sutro’s journey, the character of San Francisco’s streets, and the conduct of social and religious activities in the Jewish communities. *Id.* at 911. The defendant also copied eight specific phrases, such as “rekindle old memories,” “staggering network,” and “hordes of gold seekers,” but the Court of Appeals ruled that such “ordinary phrases are not entitled to copyright protection” because they were “commonly-used expressions.” *Id.* Still, a

“sequence of creative expression” including an ordinary phrase can be protected. *See id.* (quoting *Salinger v. Random House*, 811 F.2d 90, 98 (2d Cir. 1987)).

B. Analysis

1. Access and Substantial Similarity

a. Access

Corbello has produced enough evidence of Defendants’ access to the Work to avoid summary judgment on the issue. She provides evidence that DeVito informed Brickman of the Work and offered to lend him a copy for limited purposes and a limited time and without *24 permission to show it to anyone or to copy any part of it. (*See DeVito Dep.* 354-62, May 11, 2011, ECF No. 748- 1). She also provides evidence that despite DeVito’s instructions to Brickman not to show the Work to anyone else or to copy it, Brickman emailed David and Elice on January 22, 2004 informing them of the Work and that he would soon have a copy of it. (*See Brickman Email*, Jan. 22, 2004, ECF No. 748-39). Brickman forwarded a copy of the email to McAnuff. (*See McAnuff Email Reply*, ECF No. 749-2). Even before Brickman had obtained the Work from DeVito, McAnuff had planned the early February 2004 meeting at which McAnuff, Elice, Brickman, and perhaps other writers constructed an outline for a play based upon the Work and marked up at least one of the two copies of the Work that Elice had made from Brickman’s original copy from DeVito. (*See Elice Dep.* 84, 111, 115-16, 128-30, June 24, 2011, ECF No. 748-21). There is more evidence of Defendants’ access to the Work adduced, but the evidence already recounted is sufficient for Corbello to avoid summary judgment on the issue.

b. Substantial Similarity

The Court will conduct the extrinsic test under the *Apple Computer* framework, i.e., it will determine which alleged similarities are in fact articulable and concrete, which of those are based on protectable aspects of the Work, and the scope of protection to which the collection of articulable, concrete, protectable similarities may be entitled as a whole for the purposes of the jury's application of the intrinsic test. Exhibit 8, the expert report of Richard Krevolin (the "Krevolin Report"), is the most comprehensive piece of evidence as to substantial similarity, and the Report is sufficient, without more, for Plaintiff to avoid summary judgment on the substantial similarity theory of infringement, at least as to "thin" protection.

The Court is satisfied Krevolin is an expert on adapting other media into screenplays. (*See* Krevolin Report 1-3, ECF No. 748-8 (noting *inter alia* that Krevolin has master's degrees *25 in both screenwriting and playwriting and fiction from UCLA and USC, respectively; that he has worked for over 20 years as a writer, playwright, screenwriter, lecturer, consultant, and professor; and that he has published a book entitled *How to Adapt Anything Into a Screenplay*)). Although not dispositive, his expertise will be helpful to the Court's and jury's comparisons of the scripts to the Work. Even if he were not admitted as an expert witness for his opinions, his report is a useful guideline as to various alleged similarities.

Krevolin identifies many similarities between the Work and several versions of the script and pre-script materials. For the purposes of substantial similarity, the relevant comparisons are those of the Work to the

La Jolla *Jersey Boys* Script and the *Jersey Boys Broadway* Script. (*See id.* 52-138, ECF No. 748-8). Krevolin opines that the scripts for the London, Las Vegas, Toronto, Melbourne, Chicago, First National Tour, and (based on his understanding that no separate script was created for the Sydney production) the Sydney productions of *Jersey Boys* contain no material differences as between themselves or with the *Jersey Boys Broadway* Script. (*See id.* at 139).

As to the La Jolla *Jersey Boys* Script, Krevolin identifies 68 similarities with the Work. (*See id.* 54-59). As to the *Jersey Boys Broadway* Script, Krevolin identifies 90 similarities with the Work. (*See id.* 62-70). Krevolin ultimately opines that at least thirty percent (30%) of *Jersey Boys* is attributable to the Work. (*See id.* at 148). As to *Jersey Boys* products apart from the performances, he opines that the Libretto beginning on page 86 of the *Jersey Boys Book* is an abridged version of the *Jersey Boys Broadway* Script that shares all of the *Jersey Boys Broadway* Script's similarities to the Work but three, (*see id.* at 140), and that the *Jersey Boys Cast* *26 Recording contains little dialogue from *Jersey Boys* but does contain elements from the Work, (*see id.* at 140-41).³

The Court has examined each of the similarities and determined that a reasonable jury could find most of them to be concrete, articulable similarities, but that most of them are based on historical fact or ordinary phrases without any creative element having

³ The Court has already granted summary judgment on the infringement issue as to the *Jersey Boys Cast Recording*, (*see* Third Summ. J. Order 20-21, ECF No. 780), and the Court of Appeals did not upset that ruling.

been supplied by the Work and reproduced in the scripts. Where the similarities are based on more than historical fact or ordinary phrases, the creative elements in the scripts are typically not those that appear in the Work. The following similarities⁴ are based on historical fact, with any creative element having been provided by the accused work(s), not the Work: LJ4-7, LJ10-19, LJ21-25, LJ27-30, LJ32- 42, LJ44-47, LJ50-57, LJ61-62, LJ64, LJ66, B4-8, B11, B13-25, B27-31, B33-51, B53-58, B60, B62-76, B81-84, B86, and B88.⁵ The following similarities, to the extent

⁴ The similarities are not numbered in the Krevolin Report but listed as “bullet” points. The Court will refer to the similarities in the order Krevolin lists them as LJ1, LJ2, etc. for the similarities between the La Jolla *Jersey Boys* script and the Work and as B1, B2, etc. for the similarities between the *Jersey Boys Broadway* script and the Work.

⁵ DeVito’s recollected perceptions of other real person’s characteristics and personalities, as well as recollections of real places where real events are alleged to have occurred, are still claims of historical fact, not creative elements. Events, persons, and places depicted as historical fact are simply not protected by copyright except to the extent a historical work may be entirely appropriated; characterizing aspects of a work as setting, plot, character, etc. does not make unprotectable elements such as claims of historical fact protectable no matter how concrete and articulable the similarities are. Of course, wholesale appropriation of even a historical work is infringement, but that is “thin” protection. Moreover, in this case, many of the similarities, particularly settings and characterizations of persons, are repeated in Krevolin’s analysis more than once, and many historical similarities that could be characterized as single events are characterized as multiple events. The numbers 68 and 90 are therefore inflated even if the Court were to rule that each of the similarities represented a concrete, articulable similarity based on a protected aspect of the Work. Next, the fact that the scripts

they are not *27 based on historical accounts, are based on ordinary phrases: LJ3, LJ8, LJ20, LJ31, LJ49, LJ58-60, LJ63, LJ65, LJ 67-68, B3, B9-10, B26, B61, B77-80, B85, B87, and B89-90. The following similarity is based on a stock scene: LJ1. The following similarities are not based on concrete, articulable aspects of plot, theme, etc: LJ2, B2, and B32.

The remaining similarities are: LJ9 (dialogue, theme), LJ26 (mood), LJ43 (dialogue), LJ48 (theme), B1 (mood), B12 (dialogue, theme), B52 (dialogue), and B59 (theme). These concrete, articulable similarities based on protectable material are not enough for the Work to have “thick” copyright protection. As a whole, the Work is entitled to “thin” copyright protection—at least Corbello is entitled to argue that to the jury. The Work is a work of historical fact, as recounted by DeVito with the assistance of Woodard’s writing skills. The creative aspects of the Work do not generally concern things like character, plot, and setting, but rather writing style and presentation. Neither DeVito nor Woodard created or even claimed to have created

contradict the Work in some places tends to show that the scripts were created at least in part from other, contradictory sources or that the authors of the script chose their own creative additions over the Work’s historical representations in the relevant places, not that the Work was intended to be fiction. Nor do Valli’s and others’ deposition testimony that parts of the Work are false make the Work fiction for the purposes of copyright where DeVito explicitly presents it as his earnest interpretation of historical events. It is not unusual for historical works to contradict one another, particularly where the events occurred during the lifetimes of the authors, and especially where the authors were themselves involved in the events and therefore may have personal motivations to recount the events differently from one another.

any characters, plot lines, settings, etc. The Prologue of the Work is emphatic that previous biographies about The Four Seasons are “bogus” and that the Work represents “the whole story,” i.e., the truth as DeVito sees it. (Work i, ECF No. 629-5, at 3). DeVito simply recounted the historical facts as he perceived them, and Woodard contributed his writing style. Interpretations of historical events, like the facts of history themselves, are uncopyrightable ideas. *Hoehling*, 618 F.3d at 978. After all, every relation of a historical fact beyond direct observation is tainted to some degree by some person’s interpretation, so distinguishing between *28 historical facts and “interpretations” of those facts in the context of copyright would destroy the rule that historical facts are unprotected. That does not mean the Work is unprotected by copyright. Clearly, DeVito and Woodard created something that did not exist before their collaboration. The overall expression of the Work as a whole is protected, and Defendants were not entitled to copy the Work wholesale.

2. Direct Copying

Defendants are not entitled to summary judgment on a direct copying theory. A reasonable jury could find direct copying from the evidence of access to the Work in late January 2004, the early February 2004 meeting at which Brickman, Elice, and McAnuff poured over, annotated, and began to adapt the Work, and the Krevolin Report’s comparisons of the Work to the evolving scripts, i.e., the February 13, 2004 Outline, the March 11, 2004 Outline, the March 19, 2004 Outline, the April 7, 2004 Outline, the May 28, 2004 Draft Script, the July 7, 2004 Draft Script, the La Jolla *Jersey Boys* Script of October 2004, and the Broadway

Jersey Boys Script of November 2005. (*See id.* at 13-138). The jury must be instructed, of course, that even if the Work was directly copied, it is only the *expression* of the authors of the Work that is protected from copying, and in this case that expression consists of the overall presentation of the Work as a whole. *See Narell*, 872 F.2d at 910-12.

C. Summary of Ruling

Under the law of the case, the jury must be instructed that the 1999 Agreement was a transfer of ownership whereby Valli and Gaudio became joint owners with Corbello, and that Valli and Gaudio cannot be liable for infringement while they were joint owners. The jury must determine whether the 1999 Agreement's reversionary clause was ever triggered such that Valli and Gaudio might be liable for infringement thereafter. If that occurred, the jury must also *29 determine whether DeVito granted Valli and Gaudio an implied nonexclusive license such that they cannot have been liable for infringement even after their ownership interest reverted to DeVito. Finally, the jury must determine infringement under direct copying or substantial similarity theories. Under the latter theory, the jury must first perform the extrinsic test. The Court has granted summary judgment in part as to the extrinsic test, finding that regular, "thick" copyright protection does not apply as a matter of law, so the jury must be instructed that if the Work passes the extrinsic test, it must apply "thin" protection under the intrinsic test.⁶

⁶ The Court will not instruct the jury using the legal jargon of "thin," which could be confusing or prejudicial, but

CONCLUSION

IT IS HEREBY ORDERED that the Motion for Summary Judgment (ECF No. 626) is GRANTED IN PART and DENIED IN PART. The Work is entitled to “thin” copyright protection as against the La Jolla *Jersey Boys* Script, the *Jersey Boys Broadway* Script, and the Libretto in the *Jersey Boys Book*.

IT IS SO ORDERED. Dated this 29th day of September, 2015.

/s/ _____

ROBERT C. JONES
United States District Judge

rather with the relevant legal standards the word denotes.

APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

Nos. 12-16733, 13-15826

D.C. No. 2:08-cv-00867-RCJ-PAL

DONNA CORBELLO,

Plaintiff-Appellant,

v.

THOMAS GAETANO DEVITO,

Defendant,

and

FRANKIE VALLI; ROBERT J. GAUDIO; MARSHALL
BRICKMAN; ERIC S. ELICE; DES MCANUFF;
DSHT, INC., FKA DODGER STATE HOLDING
THEATRICALS, INC.; DODGER THEATRICALS, LTD.;
JB VIVA VEGAS, LP; MICHAEL S. DAVID; JERSEY BOYS
BROADWAY LIMITED PARTNERSHIP; JERSEY BOYS
RECORDS LIMITED PARTNERSHIP; SKUNK, INC.;
GETTING HOME, INC.,

Defendants- Appellees.

DONNA CORBELLO,

Plaintiff-Appellant,

v.

121a

THOMAS GAETANO DEVITO,
Defendant,

and

FRANKIE VALLI; ROBERT J. GAUDIO; MARSHALL
BRICKMAN; ERIC S. ELICE; DES MCANUFF;
DSHT, INC., FKA DODGER STATE HOLDING
THEATRICALS, INC.; DODGER THEATRICALS, LTD.;
JB VIVA VEGAS, LP; MICHAEL S. DAVID; JERSEY BOYS
BROADWAY LIMITED PARTNERSHIP; JERSEY BOYS
RECORDS LIMITED PARTNERSHIP; SKUNK, INC.;
GETTING HOME, INC.,
Defendants- Appellees.

**Appeal from the United States
District Court for the District of Nevada
Robert Clive Jones, District Judge, Presiding**

DECIDED FEB 10. 2015

Before: DIARMUID F. O'SCANNLAIN, ROBERT D.
SACK^{*****}, and CARLOS T. BEA, Circuit Judges

Opinion by Judge O'SCANNLAIN; Concurrence by
Judge SACK.

OPINION

O'SCANNLAIN, Circuit Judge:

^{*****} The Honorable Robert D. Sack, Senior Circuit Judge
for the U.S. Court of Appeals for the Second Circuit, sitting by
designation.

We must decide whether a contractual grant of the exclusive right to use an individual's "biographies" to create a Broadway musical stage play also constitutes a transfer of a copyright ownership interest in that individual's unpublished autobiography.

I

A

In 1988, Rex Woodward, a lawyer, journalist, and "Four Seasons" devotee, entered into a written agreement to ghostwrite the autobiography (the "Work") of Thomas DeVito, one of the original members of the band (later known as "Jersey Boys"). Pursuant to this agreement, Woodward and DeVito would split the proceeds from publishing or otherwise exploiting the manuscript. After completing the Work but before securing publication, Woodward succumbed to lung cancer in 1991. Unbeknownst to Woodward's widow and heir, Donna Corbello, DeVito had registered the Work with the U.S. Copyright Office solely under his own name in 1991, four months before Woodward's death.

In 1999, DeVito and another former Four Seasons band member, Nicholas Macioci, executed an agreement (the "1999 Agreement") with two of their former bandmates, Frankie Valli and Bob Gaudio. Pursuant to this agreement, DeVito and Macioci granted to Valli and Gaudio the "exclusive right to use" "aspects of [their lives] related to The Four Seasons including, by way of example, [their] creative contributions, biographies, events in [their lives], names and likenesses (the 'Materials')" to develop a musical stage performance (the "Play") about the "Four Seasons." DeVito and Macioci further waived all

claims in connection with the Materials, including any claim for violation of copyright.

After an abortive attempt to create the Play with an initial producer, Valli and Gaudio entered into a twenty-four page letter agreement dated May 1, 2004 (the “2004 Agreement”) to produce the Play 1061*1061 with another production company. Pursuant to this agreement, Valli and Gaudio granted the right to use the band, the band’s music, and the band members’ names, likenesses, and life stories. In exchange for these rights, Valli and Gaudio would receive certain specified advances and royalties calculated as a percentage of gross box-office receipts from future productions. While the contract was printed on the letterhead of Dodgers Theatricals, Ltd., and reserved a space on the signature page for that same entity, the text of the agreement defines a different entity, Dodger Stage Holding Theatricals, Inc., as the “Producer.” Pursuant to the 1999 Agreement, Valli and Gaudio were to distribute – and did in fact so distribute – a portion of any such payments received to DeVito. The musical “Jersey Boys,” produced pursuant to this Agreement, opened on Broadway in late 2005 to popular and critical acclaim, and has enjoyed continued international success.

B

Corbello first discovered arrangements made by DeVito and his bandmates after she and her sister-in-law renewed their efforts to publish the Work on the eve of the “Jersey Boys” debut. Supposing that the Broadway musical might rekindle interest in the band, she approached DeVito who, after a month of correspondence, rejected her overtures, concluding

that the Work was “not saleable.” In 2006, the success of “Jersey Boys” prompted Corbello and her sister-in-law to confirm the copyright in the Work in the hope of future exploitation, when they discovered that DeVito had already registered – solely in his own name – a manuscript virtually identical to the Work. Corbello subsequently filed a supplementary application with the U.S. Copyright Office to add Woodward as a coauthor and co-claimant of the Work, which prompted the Office to amend the certificate of registration to list Woodward and DeVito as coauthors of the Work and co-claimants thereto.

Based on such revelation, and further accounts from writers, actors, and others involved in the Play that attributed inspiration in part to the unpublished autobiography, Corbello initially brought suit against DeVito for equitable accounting, declaratory judgment, and breach of contract. Valli’s divorce proceedings in 2008 brought to public light further documents, including the 1999 Agreement, regarding DeVito’s involvement in producing the Play. Corbello filed a Third Amended Complaint in May 2011, alleging twenty causes of action, including equitable accounting, declaratory judgment, and copyright infringement under both U.S. and foreign law, not only against DeVito but also against Valli and Gaudio, as well as the writers, directors, and producers of the Play and various related entities.

Corbello alleges that the Play constitutes, at least in part, a “derivative work” of the DeVito autobiography, the right to create which resides exclusively in the copyright-holders of the underlying work, and their lawful successors, assignees, and licensees. Corbello thus concludes that she, as legatee

of Woodward's joint copyright in the Work, deserves to share in the profits reaped by the various Appellees' licensing and assignment, or infringement, as the case may be, of the underlying rights.

Facing dueling motions for summary judgment on several of the counts, the district court issued two orders, incorporated into the judgment from which Corbello here appeals, granting summary judgment to all Appellees on Corbello's claims for equitable accounting, declaratory judgment, and copyright infringement. In so ruling, the district court concluded that (1) the 1999 Agreement constituted not an assignment of DeVito's copyright *1062 interest in, but rather a "selectively exclusive license" to use, the Work; (2) the 1999 Agreement, the 2004 Agreement, and DeVito's subsequent conduct sufficiently licensed Appellees to use the Work in developing the Play; and (3) because United States law governs whether the Appellees possessed a valid license to use the Work, Corbello's claims for copyright infringement under foreign law must also fail.

Corbello timely appealed, disputing all of these conclusions as well as the district court's taxation of costs against her.¹

¹ We have jurisdiction pursuant to 28 U.S.C. § 1291.

II

Corbello first contends that the 1999 Agreement constituted a transfer of DeVito's copyright interest in the Work, rather than a selectively exclusive license, and that she, as the legatee of Woodward – a duly registered co-author and co-claimant of the Work – is therefore entitled to a portion of the proceeds resulting from Valli and Gaudio's exploitation of that ownership interest.

“A co-owner of a copyright must account to other co-owners for any profits he earns from licensing or use of the copyright.” *Oddo v. Ries*, 743 F.2d 630, 633 (9th Cir.1984). Copyright law considers both exclusive licenses and assignments to be “transfer[s] of copyright ownership.” 17 U.S.C. §101. The statute enumerates various rights that copyright owners hold, including the right “to prepare derivative works based upon the copyrighted work.” *Id.* § 106(2). Copyright owners may transfer “[a]ny of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106,” *id.* § 201(d)(2), so long as the transfer is evidenced by a signed writing, *id.* § 204(a).

The parties do not dispute that Corbello succeeded to her husband's interest in the copyright of the Work. Thus, Corbello's claims for declaratory relief and equitable accounting turn on whether DeVito effectively transferred some quantum of his copyright co-ownership interest to Appellees.

A

Pursuant to the 1999 Agreement, DeVito “grant[ed] to [Valli and Gaudio] the exclusive right to use and incorporate the Materials in one or more theatrical productions, and any and all ancillary and subsidiary exploitations thereof.” As defined in the Agreement, “Materials” includes, *inter alia*, DeVito’s “biographies.” The 1999 Agreement also contains a provision by which DeVito agreed to “waive any claim in connection with the Materials or Works including . . . any claim that the Works . . . violate any right of . . . copyright.”

Despite concluding that the Agreement’s inclusion of “biographies” in the definition of “Materials” sufficiently included the Work so as to grant Valli and Gaudio an exclusive license to use it in producing the Play, the district court nevertheless found that the Work fell outside of the Agreement’s use of “biographies” for the purpose of transferring ownership of a copyright interest in the Work. We are not persuaded by the district court’s interpretation.

The 1999 Agreement is governed by New York law. Under New York law, a contract is unambiguous if “on its face[,it] is reasonably susceptible of only one meaning.” *Greenfield v. Philles Records, Inc.*, 98 N.Y.2d 562, 750 N.Y.S.2d 565, 780 N.E.2d 166, 171 (2002). If a contract is unambiguous, the court may not consider extrinsic evidence of the parties’ intent. *Id.*, 750 N.Y.S.2d 565, 780 N.E.2d at 170.*1063

In the context of the 1999 Agreement, the term “biographies” is not ambiguous. Standard dictionary definitions emphasize that biographies generally include both a formal and substantial written

component: a “biography” is a “history of a person’s life” (the substance) that is “usually written” (the form). Merriam–Webster’s Collegiate Dictionary (10th ed.1998); *accord* Oxford English Dictionary (3rd ed.2010) (“The process of recording the events and circumstances of another person’s life, esp. for publication . . . ; the documenting of individual life histories . . . considered as a genre of writing or social history.”) (first listed definition); *id.* (“A written account of the life of an individual.”) (second listed definition). As an account of DeVito’s life that has been reduced to writing, the Work, on its face, qualifies under these straightforward definitions as a “biography.”

Nor are we persuaded by Appellees’ argument that “biography,” as used in the 1999 Agreement, refers not to documented life histories, but rather to the general story of one’s life. First, this definition, even when offered by dictionaries, takes a subsidiary position to the more common definition of a documented history. *See* Oxford English Dictionary (3rd. ed.2010) (third and final listed definition); *cf.* Merriam–Webster’s Collegiate Dictionary (10th ed.1998) (“an account of the life of something (as an animal, a coin, or a building)”) (third and final listed definition). Moreover, under New York law, courts may not choose to interpret a contractual provision so as to render another term superfluous. *See Sayers v. Rochester Telephone Corp. Supp. Mgmt. Pension Plan*, 7 F.3d 1091, 1095 (2d Cir.1993); *see also* Antonin Scalia & Bryan A. Garner, *Reading Law: The Interpretation of Legal Texts* 174–79 (2012) (discussing surplusage cannon). Here, to read “biography” as referring to DeVito’s general life story would do just that, as

“Materials” is defined to include not only biographies, but also “creative contributions, . . . *events in your life*, names and likenesses.” Thus, Appellees’ proposed definition cannot be squared with New York’s rules governing proper contract interpretation.

Further, to read “biographies” as Appellees urge would largely defeat the overarching purpose of the Agreement. Under New York law, courts should consider individual contract provisions in light of “the entirety of the agreement in the context of the parties’ relationship and circumstances.” *In re Riconda*, 90 N.Y.2d 733, 665 N.Y.S.2d 392, 688 N.E.2d 248, 252 (1997). Here, as the Agreement clearly states and uncontradicted by the evidence in the record, the goal of the parties in executing the Agreement was to develop a theatrical adaptation of their own and their band’s own histories.² DeVito cannot plausibly claim to have retained his privilege as a copyright co-owner to create derivative theatrical works of any biographical manuscript he owns, yet surrendered exclusively to others his generic “life story,” along with his name and likeness, to create a play. Relinquishing one’s right to exploit creatively his or her “life story,” while at the same time retaining a corresponding right over one’s written biography, would be a self-defeating endeavor.

² The fact that Macioci may never have had a written biography, the rights to which he could have transferred via the 1999 Agreement, is perfectly in keeping with such a goal. The ability to use freely a written biography, if such biography existed, would help Valli and Gaudio create a Play chronicling the history of the band and its members. The fact that one of the band members may not have actually had such a biography does not negate the fact that, had he had such a biography, it would have assisted Valli and Gaudio in their goal of developing the Play.

We decline to impute such an incompatible *1064 purpose to the definition of “biographies” in the 1999 Agreement.

Pursuant to the 1999 Agreement, DeVito granted Valli and Gaudio the “exclusive right to use” his “biographies,” unambiguously including the Work, to create a play. Such play constitutes a “derivative work,” the right to create which resides in each copyright holder of the underlying work and may be transferred by that holder to a third party.³ Thus, in granting this exclusive right to create, whether classified as an exclusive license or an assignment, the 1999 Agreement constitutes a transfer of ownership of DeVito’s derivative-work right in the Work to Valli and Gaudio.

B

Appellees argue that our precedent, *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137 (9th Cir.2008), prohibits a co-owner of a copyright, such as DeVito, from transferring that right without permission from his co-owner, in this instance, Corbello. But that argument stretches *Sybersound’s* holding too far.

³ Despite the concerns expressed by the concurrence, including the Work in the definition of “biographies” does not restrict DeVito from exercising those other statutory rights of copyright ownership identified in 17 U.S.C. § 106 (assuming, of course, that DeVito has not independently transferred those rights to third parties). *See infra*, at 1069-71 (Sack, J., concurring). The Agreement simply restricts DeVito from alone using the Work to create a theatrical production.

Copyright “is a creature of statute, and the only rights that exist under copyright law are those granted by statute.” *Silvers v. Sony Pictures Entm’t, Inc.*, 402 F.3d 881, 883–84 (9th Cir.2005) (en banc). Specifically, “[a] copyright consists of a bundle of six statutorily created rights, currently codified at 17 U.S.C. § 106.” *Sybersound*, 517 F.3d at 1145 n. 3.⁴ While § 106 identifies what rights are included in a copyright, § 201(d) describes how an owner can transfer a

⁴ The six statutorily created rights created by 17 U.S.C. § 106 include the right:

- “(1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.”

17 U.S.C. § 106.

copyright and its component parts. *See* 17 U.S.C. § 201(d). Section 201(d)(1) provides that “[t]he ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law[.]” *Id.* § 201(d)(1). And § 201(d)(2) states that “[a]ny of the exclusive rights comprised in a copyright, including any subdivision of the rights specified in section 106, may be transferred as provided by [§ 201(d)(1)] and owned separately.” *Id.* § 201(d)(2).

We had several occasions prior to *Sybersound* to interpret § 201(d)’s broad language authorizing the alienability of copyrights. In *Bagdadi v. Nazar*, we explained, “[i]t is important to note that the various rights included in a copyright are divisible and that ‘any of the exclusive rights comprised in a copyright . . . may be transferred . . . and owned separately.’” 84 F.3d 1194, 1197 (9th Cir.1996) (citing 17 U.S.C. § 201(d)(2)). In *1065 *Gardner v. Nike, Inc.*, we added, “[s]ection 201(d)(1) enables the owner to transfer any fraction of his or her ownership interest to another party, thereby making that party a whole or joint owner.” 279 F.3d 774, 779 (9th Cir.2002). And in *Silvers v. Sony Pictures*, an en banc panel explained that the six component parts of a copyright “may be chopped up and owned separately, and each separate owner of a subdivided *exclusive* right may sue to enforce that owned portion of an *exclusive* right, no matter how small.” 402 F.3d at 887 (emphasis added). In short, we made clear prior to *Sybersound* that copyrights are divisible and that a copyright owner can freely transfer any portion of his ownership interests in that copyright; after all, the plain language of § 201(d) commands as much.

Sybersound dealt with a plaintiff's standing to sue for owned the copyright to nine songs. 517 F.3d at 1144. One such owner attempted to transfer to Sybersound the exclusive right to use those songs for karaoke purposes. *Id.* at 1142. Sybersound later filed a lawsuit against other third parties, alleging those parties were infringing on Sybersound's right to use the songs for karaoke purposes. *Id.* at 1145.

We held that when one co-owner independently attempts to grant an exclusive license of a particular copyright interest, that licensee – in this case, Sybersound – does not have standing to sue alleged third-party infringers. *Id.* at 1146. After all, one co-owner, acting independently, “may not limit the other co-owners’ independent rights to exploit the copyright.” *Id.* Such a conclusion stems from the self-evident principle that a joint-owner cannot transfer more than he himself holds; thus, an assignment or exclusive license from one joint-owner to a third party cannot bind the other joint-owners or limit their rights in the copyright without their consent. In other words, the third party's right is “exclusive” as to the assigning or licensing co-owner, but not as to the other co-owners and their assignees or licensees. As such, a third-party assignee or licensee lacks standing to challenge the attempted assignments or licenses of other copyright owners.

The *Sybersound* court grounds this venerable principle of copyright law deeply in the statutory text, citing the definition of a “transfer of ownership” as including an assignment or license of any of the “*exclusive rights comprised in a copyright . . . but not including a non exclusive license,*” *id.* (quoting 17 U.S.C. § 101), and a provision that permits subdivision

and alienation of “[a]ny of the *exclusive* rights comprised in a copyright,” *id.* (quoting 17 U.S.C. § 201(d)). But the Court’s emphasis on the word “exclusive” in these provisions cannot mean that only sole owners possess “exclusive” rights, as such a rule would run directly contrary to another well-settled principle of copyright law: the right of one joint owner to sue third-party infringers without joining any of his fellow co-owners, a right *Sybersound* itself expressly recognizes. *See id.* at 1145 (noting that “co-owners may bring suit for copyright infringement without joining other co-owners” (citing *Davis v. Blige*, 505 F.3d 90, 99 (2d Cir.2007))). After all, the copyright statute permits infringement suits only if brought by owners of an “*exclusive* right” against alleged violators of such “*exclusive* right.” 17 U.S.C. § 501 (emphasis added). If an “exclusive right” could only be possessed by a sole owner of a copyright, a co-owner would be unable to bring an infringement action to protect his interest.

Moreover, such a limitation would contradict the principle of the free transferability of copyright ownership interests – a *1066 principle reflected in both the express language of § 201(d) and our Circuit precedent, neither of which treat transferability differently based on whether the original copyright owner is a sole owner or a co-owner. *See, e.g., Silvers*, 402 F.3d at 887; *Gardner*, 279 F.3d at 779; *Bagdadi*, 84 F.3d at 1197.⁵ Thus, *Sybersound* merely imposes a

⁵ In fact, we have suggested quite the opposite. We implicitly held prior to the Copyright Act of 1976 that a co-owner of a copyright can transfer its interests in a copyright without the permission of the other co-owners. *See Piantadosi v. Loew’s Inc.*, 137 F.2d 534, 536–37 (9th Cir.1943). Because the Copyright Act

standing limitation on copyright assignees and licensees that reflects the basic principle that one cannot give away more than one's share in a copyright – it need not, and should not, be extended to limit a co-owner's ability to transfer unilaterally any exclusive copyright interests that he himself possesses.

Therefore, *Sybersound* presents no obstacle to DeVito's exclusive transfer of his derivative-work right to Valli and Gaudio under the 1999 Agreement. Because the Agreement unambiguously transfers DeVito's derivative-work right to Valli and Gaudio, and copyright co-owners must account to one another for any profits earned by exploiting that copyright, the district court erred in rejecting Corbello's claims for accounting and declaratory relief.

III

The district court granted summary judgment in favor of Appellees with respect to Corbello's infringement claims based on its finding that Valli and Gaudio held a license to use the Work in the production of the Play. *See Worldwide Church of God v. Phila. Church of God, Inc.*, 227 F.3d 1110, 1114 (9th Cir.2000) ("The existence of a license creates an

of 1976 removed prior restrictions on dividing and transferring the component parts of copyrights, *see Gardner*, 279 F.3d at 777–79, it stands to reason that if co-owners could unilaterally and severally transfer their copyright interests before 1976, co-owners could do the same after 1976. Indeed, § 201(a) specifically contemplates the existence of copyright co-owners. 17 U.S.C. § 201(a) ("The authors of a joint work are coowners of copyright in the work."). Yet nothing in § 201(d) purports to authorize broad alienability to sole owners of a copyright while simultaneously withholding that same right from co-owners of a copyright.

affirmative defense to a claim of copyright infringement.”). We have concluded, however, that the 1999 Agreement constituted a transfer of DeVito’s derivative-work interest in the copyright, rather than a license. Therefore, Appellees have necessarily failed to establish the existence of a license as an affirmative defense to Corbello’s infringement action.

A

Our conclusion that the 1999 Agreement constituted a transfer of ownership of DeVito’s derivative-work right in the Work to Valli and Gaudio would ordinarily preclude Corbello’s infringement claims against Valli and Gaudio, as “[a] co-owner of a copyright cannot be liable to another co-owner for infringement of the copyright.” *Oddo v. Ries*, 743 F.2d 630, 632–33 (9th Cir.1984). But a material issue of fact remains as to whether the Agreement’s reversionary clause later terminated Valli and Gaudio’s ownership right, resulting in the Appellees’ subsequent infringement upon Corbello’s copyright interest.

The Agreement provided that the rights granted therein would continue perpetually either (i) if they merged with the Play pursuant to a contract with an initial producer or (ii) pursuant to a contract into which Valli and Gaudio might enter with a second producer within two years of the initial producer’s rights lapsing.*1067

Corbello argues that Valli and Gaudio did not execute the 2004 Agreement (the second production contract) within that two-year period. Specifically, she points to evidence in the record which suggests that the initial producer’s rights expired on December 10, 2002, and that the 2004 Agreement, though dated May

1, 2004, was not in fact fully executed until October 27, 2005. If true, the reversionary clause of the 1999 Agreement would have terminated Valli and Gaudio's ownership right as of December 10, 2004, and any subsequent exploitation by Appellees of the Work may have infringed upon Corbello's copyright interest. Appellees counter with testimony of Michael David, president of Dodger Theatricals, which suggests that the parties to the 2004 Agreement may have reached an oral agreement prior to December 10, 2004. In the face of such contradictory evidence regarding whether the reversionary clause terminated Valli and Gaudio's derivative-work right, disputed material facts preclude summary judgment as to Corbello's infringement claims based on Valli and Gaudio's ownership of the copyright interest.⁶

B

Appellees argue alternatively that DeVito's conduct resulted in a grant to them of an implied nonexclusive license to use the Work, effective regardless of the reversionary clause in the 1999 Agreement. In support of their argument, they cite DeVito's delivery of the Work to the writers of the Play

⁶ The district court also held that 17 U.S.C. § 203(a)(4) required DeVito to give Valli and Gaudio written notice before he could terminate their rights via the reversionary clause. But § 203(a)(4) is inapplicable in this case. The Ninth Circuit has held that when "the contract at issue is of a definite duration, neither Section 203, nor any other provision of the Copyright Act, governs [a copyright owner's] right to terminate or rescind the license [or assignment]." *Scholastic Entm't Inc. v. Fox Entm't Grp., Inc.*, 336 F.3d 982, 988 (9th Cir.2003). In light of the reversionary clause, the 1999 Agreement was of definite duration, and therefore the notice requirement of § 203 does not apply.

with the apparent intention that they would use the Work to create the Play, along with DeVito's attendance at performances of, and acceptance of royalty checks from, the Play.

While we may consider delivery of a copyrighted object as “a relevant factor” to determine the existence of an implied license, *Asset Marketing Sys., Inc. v. Gagnon*, 542 F.3d 748, 755 n. 4 (9th Cir.2008), the copyright statute forbids courts from inferring a transfer of copyright or a license from mere delivery of the material object in which the work is embodied. 17 U.S.C. § 202. Rather, courts should focus primarily on “the licensor’s objective intent at the time of the creation and delivery of the software as manifested by the parties’ conduct.” *Gagnon*, 542 F.3d at 756. For instance, the Ninth Circuit “ha[s] held that an implied license is granted when (1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee-requestor copy and distribute the work.” *Gagnon*, 542 F.3d at 754–55 (internal quotation marks and footnote omitted).

Here, DeVito’s intentions in delivering the Work to the writers are unclear at best. Appellees did not ask DeVito to create the Work. In fact, the creation of the Work long predated any specific effort on DeVito’s part to parlay his life into a Broadway musical. *Cf. Gagnon*, 542 F.3d at 755 (finding an implied license when, among other things, the licensor created the copyrighted work at the licensee’s request). Moreover, DeVito specifically denied that he ever licensed the Work to Appellees. DeVito initially provided the *1068 Work to the writers for the purpose of providing

background information on DeVito's friend, Raymond Gyp DeCarlo. In doing so, DeVito gave explicit instructions that the writers should not duplicate or circulate the Work and that the Work should remain confidential, because DeVito wanted to publish the Work in the future. The writers then returned the Work to DeVito a mere few days later. DeVito's apparent lack of familiarity with the content of the Work as reflected in the Play further undercuts any potential connection between his support of the Play and his support of the Appellees' use of the Work in its production. Finally, the express provisions in the 1999 Agreement governing the use of the Work further controvert any apparent expectation that Valli and Gaudio might have had in otherwise using the Work.

In light of such contradictory facts regarding DeVito's intent in delivering the Work, the district court's grant of summary judgment on the ground of an implied license – to the extent it rested on such a ground – was inappropriate.

IV

Relying on its conclusion that the 1999 Agreement constituted a license of DeVito's copyright interest, rather than a transfer of ownership, the district court granted summary judgment to Appellees on Corbello's claims of infringement under foreign law. Because we here conclude that the Agreement instead constituted a transfer of ownership, summary judgment on such foreign law grounds must be reversed as well.

V

Corbello appeals the district court's assessment of costs against her. Because we reverse the district

court's grant of summary judgment, we vacate the award of costs and remand for reconsideration after other proceedings on remand. *See, e.g., Cusano v. Klein*, 264 F.3d 936, 951 (9th Cir.2001).

VI

We reverse the district court's grant of summary judgment in favor of Appellees, vacate its assessment of costs against Corbello, and remand for further proceedings consistent with this opinion. We award costs on appeal to Corbello as the substantially prevailing party. *See* Fed. R.App. P. 39(a)(4) (“[I]f a judgment is affirmed in part, reversed in part, modified, or vacated, costs are taxed as the court orders.”).

REVERSED IN PART, VACATED IN PART, AND REMANDED.

Concurrence by JUDGE SACK.**SACK, Senior Circuit Judge, concurring in the judgment:**

I agree that we must remand this case to the district court for further proceedings. I disagree, however, that the word “biographies” in the 1999 Agreement *unambiguously* includes the manuscript of the autobiography of DeVito ghost written by Corbello’s decedent Woodward for DeVito (“the Work”), completed some eight years earlier, and that the 1999 Agreement therefore transferred certain derivative rights in the Work to the counter-parties to the Agreement—Valli and Gaudio. First, I would conclude that the language is ambiguous under New York law and remand on that basis for the district court to decide as a matter of fact whether the 1999 Agreement included a transfer of rights with respect to the ghost-written autobiography. But second, even if the 1999 Agreement unambiguously transfers DeVito’s interest in the Work, I think *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137 (9th Cir.2008), compels us to conclude that the transfer effected only a nonexclusive, rather than an exclusive, license*1069 to use the Work for “the creation of a musical stage play.”

I

The majority offers a plausible – but not the only plausible – reading of the language of the 1999 Agreement. Because the language at issue “is susceptible to more than one reasonable interpretation,” *Brad H. v. City of New York*, 17 N.Y.3d 180, 186, 928 N.Y.S.2d 221, 951 N.E.2d 743, 746 (2011), I agree with the district court that the 1999 Agreement is ambiguous under New York law. I

think the following account of why the 1999 Agreement does *not* include the transfer of or license in all or part of the Work is also reasonable:

The parties – DeVito/Nicholas “Massi” Macioci,¹ on the one side, and Valli/Gaudio on the other – entered into the 1999 Agreement to “authorize the creation of a musical stage play based on the life and music of ‘The Four Seasons,’” the singing group of which all four were members, and the story of which ultimately was reflected in the highly successful musical “Jersey Boys.” The 1999 Agreement explains that “the authors of the play [anticipated by the 1999 Agreement] may wish to use or incorporate certain aspects of your [*i.e.*, DeVito’s and Macioci’s] life related to The Four Seasons including, by way of example, your creative contributions, *biographies*, events in your life, names and likenesses (the ‘Materials’).” (Emphasis added). DeVito and Macioci accordingly granted to Valli and Gaudio “the exclusive right to use and incorporate the Materials in one or more theatrical productions.”

In other words, Valli and Gaudio purchased from DeVito and Macioci the right to use “certain aspects” of their lives, a category that is then illuminated by several “example[s],” including “biographies.” In this

¹ Nicholas “Massi” Macioci, an early member of “The Four Seasons,” was also a signatory to the 1999 Agreement. He died in 2000, *Nick Massi, Low Man in the Four Seasons, Dies at 73*, N.Y. Times, Jan. 8, 2001, <http://www.nytimes.com/2001/01/08/national/08MASS.html>, however, and has no role in the current litigation.

light, and taking the document as a whole as we must, *S. Rd. Assocs., LLC v. Int'l Bus. Machs. Corp.*, 4 N.Y.3d 272, 277, 793 N.Y.S.2d 835, 826 N.E.2d 806, 809 (2005), the term “biographies” is perhaps most naturally read to refer to a “[p]ersonal history,” or “the events or circumstances of a person’s life, viewed collectively.” *Oxford English Dictionary* (3d ed.2010), available at www.oed.com/view/Entry/19219.² “[B]iographies,” like “names and likenesses,” may constitute aspects of both DeVito’s and Macioci’s lives, rather than particular recordings of their lives.³ This reading does not, as the majority suggests, Maj. Op. at 1062–63, threaten to offend the canon against superfluity. *1070 “[T]he events or circumstances of a person’s life, *viewed collectively*” are, by definition, distinct from the events or circumstances themselves.

² I would hesitate to give dispositive effect to the order in which dictionary editors choose to rank their definitions, Maj. Op. at 1062. *Cf. Mastrovincenzo v. City of New York*, 435 F.3d 78, 107 (2d Cir.2006) (Sack, J., concurring in part and dissenting in part) (“I am generally reticent to invoke dictionary definitions, at least in contexts perhaps unforeseen by their [anonymous] writers.”). In any event, I note that the first listed definition in *Merriam–Webster’s* refer to a biography as “usually” written, suggesting that there are other appropriate uses of the term. *Merriam–Webster’s Collegiate Dictionary* (11th ed.2003), available at <http://www.merriam-webster.com/dictionary/biography>.

³ It may be worth noting, in this connection, that as far as we are aware there was no written Macioci biography or autobiography ever produced the rights to which could have been included, although as a one-time member of the group, he was likely mentioned in DeVito’s ghost-written autobiography. Insofar as Macioci’s “biography” is concerned, then, it would seem likely that “biography” meant the story of his life.

A collective viewing may entail characterizing events to form a trajectory or story arc, rather than a mere collection of individual events.

Another definition of the word “biography,” moreover, suggests that the parties did not necessarily intend to include the Work in the rights granted under 1999 Agreement. A “biography,” or “bio,” may (and in my experience in being asked for a “biography” or “bio” in connection with some panel discussion, moot court, or the like, very often does) refer to “a brief summary of a person’s life and work.” *Oxford English Dictionary* (3d ed.2010), *available* at www.oed.com/view/Entry/19187; *see also, e.g., Doe v. Merck & Co.*, 283 A.D.2d 543, 543, 725 N.Y.S.2d 356, 357 (2d Dep’t 2001) (discussing a pharmaceutical company’s educational brochure “which contained photographs and biographies of HIV-positive individuals”); *Charney v. Sullivan & Cromwell LLP*, 15 Misc.3d 1128(A), 841 N.Y.S.2d 217 (N.Y.Sup.Ct.2007) (discussing a law firm website’s use of “biographies of [certain partners], which list the partners’ clients and some of the deals they have worked on”). This type of “brief summary,” which a playwright might well draw upon, does not seem to me to envision or require a manuscript of a detailed biography that is hundreds of pages long.

In the absence of the manifestation of a contrary intent among the parties, it may be preferable to apply either of the foregoing definitions, rather than those referring to written manuscripts, which might inappropriately enlarge the general category of “aspects of your life.” “When a particular class [*i.e.*, “aspects of your life”] is spoken of, and general words [*i.e.*, “biographies”] follow, the class first mentioned is to be taken as the most comprehensive.” *Bers v. Erie*

R.R. Co., 225 N.Y. 543, 546, 122 N.E. 456, 457 (1919) (internal quotation marks omitted). Indeed, as a general matter, we should be “extremely reluctant to interpret an agreement as impliedly stating something which the parties have neglected to specifically include.” *Rowe v. Great Atl. & Pac. Tea Co.*, 46 N.Y.2d 62, 72, 412 N.Y.S.2d 827, 385 N.E.2d 566, 572 (1978).

In short, the word “biographies” has here at least three plausible meanings, only one of which covers the Work. And the majority’s preferred reading is not the only one that makes sense. *See* Maj. Op. at 1063–64. The purpose of the 1999 Agreement was to facilitate the creation and production of a theatrical work based on DeVito’s or Macioci’s life story. Having transferred his right in a single kind of derivative work, DeVito may well have sought to retain the right to publish or otherwise distribute other accounts of his life through books, film, or other media. *Cf.* 17 U.S.C. § 106 (listing, beside the right to prepare derivative works, the copyright owner’s rights to reproduce, distribute copies of, publicly perform, publicly display, or transmit the copyrighted work). If under these circumstances, however, DeVito creates a theatrical production based on his life, he runs afoul of the 1999 Agreement and may be liable to Valli and Gaudio.

In this context, leaving the Work outside the scope of the 1999 Agreement makes a great deal of practical sense. Having said nothing in the Agreement explicitly about the Work, which had been in existence for more than eight years, DeVito remained and remains free to do with his autobiography (subject of course to his obligations to the widow of Woodward, the person who actually wrote it) what people normally try to do with their memoirs (if anything): He can publish it,

distribute copies, sell it, *1071 read excerpts at public events, license movies and audiobooks, and so on, all without worrying about breaching the Agreement. However, if and only if he attempts to create a play or other theatrical work based on his manuscript, he would be hard-pressed to do so without including events in his life, his life story, etc. He might then be liable to Valli and Gaudio under the Agreement for encroaching on the rights he gave them.

I would, therefore, agree with the district court that the contract's language is ambiguous. I think that court erred, however, in admitting extrinsic evidence to interpret the contract's ambiguous language. The question of ambiguity is a question of law to be resolved by the court, but "[i]f there is ambiguity in the terminology used, [] and determination of the intent of the parties depends on the credibility of extrinsic evidence or on a choice among reasonable inferences to be drawn from extrinsic evidence, then such determination is to be made by the jury." *Hartford Accident & Indem. Co. v. Wesolowski*, 33 N.Y.2d 169, 172, 350 N.Y.S.2d 895, 305 N.E.2d 907, 909 (1973). I would remand this case to the district court for trial.

II

Assuming, despite the foregoing discussion, that the 1999 Agreement does unambiguously include the Work (or were a jury to find the Agreement includes the Work despite the Agreement's facial ambiguity), the question arises: What kind of interest in the Work does the 1999 Agreement transfer to Valli and Gaudio? The majority concludes that the Agreement confers an exclusive license or assignment. Maj. Op. at 1066. I think *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d

1137 (9th Cir.2008), compels the conclusion, however, that the Agreement would then confer a nonexclusive license.⁴

In that case, TVT Music Publishing, a co-owner of the copyright of certain songs, attempted to make Sybersound, a karaoke record producer, the “exclusive assignee and licensee of TVT’s copyrighted interests for purposes of karaoke use, and also the exclusive assignee of the right to sue to enforce the assigned copyright interest.” *Id.* at 1142 (internal quotation marks omitted). The other original co-owners of the copyright, several record companies, did not join in granting rights to Sybersound. *Id.* at 1146. When other karaoke record producers used songs under license from TVT to Sybersound without Sybersound’s permission, Sybersound brought suit against the producers for infringement. *Id.* at 1142. This Circuit affirmed the district court’s dismissal of the complaint, concluding that Sybersound lacked standing to sue third-party infringers. *Id.* at 1146.

I agree with the majority’s analysis of *Sybersound* except to the extent it concludes that DeVito was legally capable of transferring to Valli and Gaudio an exclusive license of any kind or description. According to *Sybersound*, one co-owner of a copyright cannot confer an exclusive license on a licensee because she or he has no exclusive right to confer. *Sybersound*, 517 F.3d at 1146 (“[U]nless all the other co-owners of the copyright joined in granting an exclusive right to

⁴ We are in accord, however, that the 1999 Agreement confers the right to use the ‘Materials’ to create only one type of derivative work, a theatrical production, *Maj. Op.* at 1064; the only question is whether that right is exclusive or nonexclusive.

Sybersound, TVT, acting solely as a co-owner of the copyright, could grant only a nonexclusive license to Sybersound because TVT may not limit the other co-owners' independent rights to exploit the copyright.") This conclusion may be in tension with other elements of copyright law, as the majority *1072 avers, Maj. Op. at 1065–66, but courts and commentators appear to be in universal agreement that *Sybersound* stands for the proposition that “a co-owner of a copyright cannot unilaterally alienate [its] share of the intellectual property and instead can ‘only grant a nonexclusive license’ to a third party.” *Brownmark Films, LLC v. Comedy Partners*, 800 F.Supp.2d 991, 996 (E.D.Wis.2011) (quoting *Sybersound*, 517 F.3d at 1146), *aff’d on other grounds*, 682 F.3d 687 (7th Cir.2012); *see also, e.g., Amaretto Ranch Breedables v. Ozimals Inc.*, 907 F.Supp.2d 1080, 1084 (N.D.Cal.2012) (similarly reading *Sybersound*).

The facts of *Sybersound* are in an important respect indistinguishable from those before us. Here, as in *Sybersound*, a single co-owner (here, DeVito; there, TVT) of a particular interest attempted to grant an exclusive license to use a particular part of the co-owner's derivative work right (here, the right to create a derivative theatrical work; there, the right to create a derivative karaoke record) to third parties (here, Valli and Gaudio; there, Sybersound). Here, as in *Sybersound*, the single co-owner attempted to effect this transfer without the consent of the other co-owner(s) (here, Corbello; there, the record companies).

Sybersound seems to me to mean that the transfer from DeVito to Valli and Gaudio, like the transfer from

TVT to Sybersound, effected a nonexclusive license. DeVito, like TVT, “succeeded only in transferring what [he] could under 17 U.S.C. § 201(d), a non-exclusive license.” *Sybersound*, 517 F.3d at 1146. This application of *Sybersound* does not “limit a co-owner’s ability to transfer unilaterally any exclusive copyright interests that he himself possesses.” Maj. Op. at 1066. It does no more than recognize that DeVito had no exclusive copyright interest in the derivative-work right to a theatrical production to transfer in the first place. Therefore, Valli and Gaudio had a nonexclusive license, and Corbello’s sole accounting remedy lies against DeVito. *See* 2 William F. Patry, *Patry on Copyright* § 5.9 (2014) (“Where only one joint author grants a nonexclusive license, the nongranteeing joint author may not obtain an accounting from the nonexclusive licensee since that licensee is not a joint copyright owner. Instead, the nongranteeing joint author must obtain the accounting from the granteeing joint author.”).

Commentators have expressed some dissatisfaction with this aspect of *Sybersound*’s holding.⁵ As a three-judge panel, we of course are bound by circuit precedent.⁶ *Miller v. Gammie*, 335

⁵ For criticism of *Sybersound*, see *Amaretto Ranch Breedables v. Ozimals Inc.*, 907 F.Supp.2d 1080, 1084 (N.D.Cal.2012) (citing III *Goldstein on Copyright* § 15.5 (3d ed.2011); 4 *Nimmer on Copyright* § 6.10 [A][2][d] (rev. ed.2012); 2 *Patry on Copyright* § 5:103 (2012)), in which it was noted that the district court there had to, as we must, follow *Sybersound* nonetheless.

⁶ The majority correctly observes that the circuit’s pre-*Sybersound* precedent supports the conclusion “that copyrights

F.3d 889, 899 (9th Cir.2003) (en banc). Nor can we ignore the substantial similarity between the facts of *Sybersound* and those of this case. We are, in my view, required to treat Valli and Gaudio's copyright interest as a nonexclusive license.⁷ Just as this *1073 Court rejected *Sybersound*'s claim against those who used karaoke versions of songs contrary to *Sybersound*'s purported exclusive right to do so because the purported licensor (TVT) had no right to grant such exclusive use to *Sybersound* in the first place, we should reject the plaintiff's accounting claim against Valli and Gaudio.

III

are divisible and that a copyright owner can freely transfer any portion of his ownership interests in that copyright." Maj. Op. at 1064. But *Sybersound* reasoned that those ownership interests are limited in the case of a co-owner, who "is not the exclusive owner" of the copyright and thus can transfer only a nonexclusive license. *Sybersound*, 517 F.3d at 1146.

⁷ I would reject the district court's apparently newly coined term "selectively exclusive license." The court's description of the practical effects of DeVito's failed attempt to transfer an exclusive license seems to me correct under *Sybersound*. But, under the principle of *numerus clausus*, I would avoid risking the creation of a new form of copyright interest. See Thomas W. Merrill & Henry E. Smith, *Optimal Standardization in the Law of Property: The Numerus Clausus Principle*, 110 Yale L.J. 1, 3-4 (2000). If we were to fully describe the transaction between DeVito and Valli and Gaudio, which we need not do in this case, I think that transaction is better described in terms of an already existing form of copyright interest (a nonexclusive license), plus a contract-based promise by DeVito not to re-license the same rights to anyone else.

In sum, then, I would decide that the contract is ambiguous as to whether the Work is included within the Materials. Because the contract is ambiguous, the district court erred by determining the meaning of the contract on the basis of parol evidence at summary judgment. I would therefore remand to the district court for further proceedings. But it would vastly simplify matters, I think, if in that case the district court first decided the defendants' summary judgment motion arguing that *Jersey Boys* does not infringe the Work as a matter of law in any event, *see, e.g., Funky Films, Inc. v. Time Warner Entm't Co., L.P.*, 462 F.3d 1072, 1076–77 (9th Cir.2006), an issue which it previously avoided by granting summary judgment on contract grounds, *Corbello v. DeVito*, 844 F.Supp.2d 1136, 1154–55 (D.Nev.2012). That might be the end of the matter as far as “Jersey Boys” Valli and Gaudio are concerned irrespective of the difficult issues that the majority and we address here.

Even if the 1999 Agreement unambiguously included the Work, as the majority conclude, I would decide that DeVito granted Valli and Gaudio only a nonexclusive license to use the Work toward a theatrical production. Corbello's accounting action properly lies, then, against DeVito, not Valli and Gaudio, and the latter action must be rejected.

APPENDIX F

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

DONNA CORBELLO,

Plaintiff-Appellant,

v.

FRANKI VALLI, *et al.*,

Defendants- Appellees.

No. 17-16337

**D.C. No. 2:08-cv-00867-RCJ-PAL
District of Nevada, Las Vegas**

**FILED NOV 13 2020
Molly C. Dwyer, Clerk
U.S. Court of Appeals**

ORDER

Before: TASHIMA, W. FLETCHER, and BERZON,
Circuit Judges.

The panel has voted to deny appellant's petition for rehearing and petition for rehearing en banc.

The full court has been advised of the petition for rehearing en banc, and no judge has requested a vote on whether to rehear the matter en banc. Fed. R. App. P. 35.

The petition for rehearing is denied and the petition for rehearing en banc is rejected.

APPENDIX G
STATUTORY PROVISIONS INVOLVED

The relevant provisions of the Copyright Act of 1976, as amended, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified at 17 U.S.C. §§ 101, *et seq.*), are as follows:

17 U.S.C. § 101

§ 101. Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

* * * *

A “compilation” is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term “compilation” includes collective works.

* * * *

“Copies” are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term “copies” includes the material object, other than a phonorecord, in which the work is first fixed.

* * * *

“Copyright owner,” with respect to any one of the

exclusive rights comprised in a copyright, refers to the owner of that particular right.

* * * *

A work is “created” when it is fixed in a copy or phonorecord for the first time; where the work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

* * * *

A “derivative work” is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work.”

* * * *

“Literary works” are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

* * * *

To “perform” a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible.

* * * *

“Publication” is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords 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.

* * * *

A “transfer of copyright ownership” is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.

* * * *

17 U.S.C. § 102

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated,

156a

either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

* * * *

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

* * * *

17 U.S.C. § 106

§ 106. Exclusive rights in copyrighted works

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform

157a

the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly;

* * * *

17 U.S.C. § 107

§ 107. Limitations on exclusive rights: Fair Use

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include-

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

158a

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

* * * *

17 U.S.C. § 204

§ 204. Execution of transfers of copyright ownership

(a) A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent.

* * * *

17 U.S.C. § 501

§ 501. Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 or of the author as provided in section 106A(a), or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be