

No. _____

In the
Supreme Court of the United States

JAMES H. GRIFFITH, JR., DBA CJ'S SPORTS BAR AND
LISA LESLEY,
Petitioners,

v.

JOE HAND PROMOTIONS, INC.,
Respondent.

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

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

- I. Whether the plain language of the U.S. Copyright Act (“Act”) authorizes the exclusive licensing of rights under the Act in an idea of a work of authorship *before* that idea is fixed in a tangible medium.
- II. Whether the plain language of the U.S. Copyright Act permits the copyright owner to assign a bare right to sue for copyright infringement to a third party.
- III. Whether a federal court of appeals, in the course of *de novo* review of a grant of summary judgment for defendant under Rule 56, may *sua sponte* interpret and rely on evidence in the record to support its reversal for plaintiff when the parties did not discuss, argue the importance of, or even specifically cite this evidence to support their positions in either their 1) summary judgment filings or 2) written briefs on appeal.

CORPORATE DISCLOSURE

Petitioners are not corporate entities; the disclosure requirement is thus inapplicable.

RELATED PROCEEDINGS

Joe Hand Promotions, Inc. v. James H. Griffith Jr. dba CJ's Sports Bar and Lisa Lesley, No. 20-cv-00382 (E.D. Tenn.) (Oct. 20, 2021) (opinion issued and summary judgment granted)

Joe Hand Promotions, Inc. v. James H. Griffith Jr. dba CJ's Sports Bar and Lisa Lesley, No.21-6088 (6th Cir.) (Sept. 21, 2022) (opinion issued and reversal of judgment entered)

Joe Hand Promotions, Inc. v. James H. Griffith Jr. dba CJ's Sports Bar and Lisa Lesley, No. 21-6088 (6th Cir.) (Nov. 4, 2022) (petition for *en banc* rehearing denied)

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The district court's summary judgment decision, issued on October 20, 2021, is not published but can be found at 2021 U.S. Dist. LEXIS 202256 or 2021 WL 4899466 and is reproduced at App. 19. The Sixth Circuit Court of Appeals' decision on September 21, 2022, is reported at 49 F.4th 1018 and reproduced at App. 1.

JURISDICTION

The Sixth Circuit Court of Appeals issued its decision reversing the district court's judgment on September 21, 2022. App. 1. A Petition For *En Banc* Rehearing filed by Petitioners was denied on November 4, 2022. App. 35. This Court has jurisdiction under 28 U.S.C. § 1254(1). On January 25, 2023, this Court granted Petitioners a 60-day extension to file their Petition for Writ of Certiorari. That Petition is now due on or before April 3, 2023.

STATUTORY PROVISIONS INVOLVED

The relevant statutory provisions are reproduced at App. 37-58. Those statutory provisions are: 17 U.S.C. § 101 (App. 37); 17 U.S.C. § 102 (App. 50); 17 U.S.C. § 106 (App. 51); 17 U.S.C. § 201 (App. 52); 17 U.S.C. § 411 (App. 53); and 17 U.S.C. § 501 (App. 55).

INTRODUCTION

The U.S. Copyright Act ("Act") does not authorize the exclusive licensing of rights under the Act in an idea of a work of authorship before it is fixed in a tangible medium. The Seventh Circuit Court of Appeals agrees. The Sixth Circuit Court of Appeals, in this case, does not.

The Seventh Circuit in *Video View Inc. v. Studio 21 Ltd.* [925 F.2d 1010, 1018 (7th Cir 1991)] correctly interprets the Act and states that such a licensing agreement is of no effect; a license cannot create property rights enforceable under the copyright laws before they exist, *i.e.* before the work is fixed in a tangible medium. The Sixth Circuit, however, reaches the opposite conclusion in this case by relying on certain pre-fixation agreements, which the Sixth Circuit maintains provided Joe Hand Promotions, Inc., an exclusive license in the copyright of the work at issue. App. 3-4, 12. There is therefore a conflict among the courts of appeals that presents a compelling reason why this Court should exercise its discretion, grant a writ of certiorari, and ultimately resolve this issue in Petitioners' favor.

Similarly, the plain language of the Act does not authorize the assignment of a bare right to sue for copyright infringement. Here, the district court, in accord with the Second Circuit's decision in *John Wiley & Sons, Inc. v. DRK Photo* [882 F.3d 394 (2d Cir. 2018)] and the Ninth Circuit's decision in *Silvers v. Sony Pictures Entertainment Inc.* [402 F.3d 881 (9th Cir. 2005)], correctly held that the Act does not permit the assignment of a bare right to sue. App. 28. Arguably, this is now settled law.

Still, review of this issue by this Court is needed given the Fifth Circuit's decision in *Prather v. Neva Paperbacks, Inc.* [410 F.2d 698 (5th Cir. 1969)], which effectively held that a bare right to sue for accrued claims is permitted. Although the *Prather* decision was based on an agreement under the 1909 Copyright Act (not the current Act), dissenting opinions in the

Second and Ninth Circuit decisions cited above rely on *Prather* to justify a bare right to sue for accrued claims. There is therefore a compelling reason to grant a writ of certiorari in this case and resolve this important issue among the courts of appeals.

Finally, there is a third issue to be resolved in this matter. That issue is whether a federal appellate court, in reviewing summary judgment for defendant, should be allowed to unilaterally interpret and rely on an ambiguous non-party agreement to support its reversal for plaintiff when the parties did not discuss, argue the importance of, or even specifically cite this evidence to support their positions in either their 1) summary judgment filings or 2) written briefs on appeal.

In sum, there are compelling reasons under Rule 10 of the Supreme Court of the United States to grant a writ of certiorari. Petitioners therefore respectfully request that this Court grant their Petition.

STATEMENT OF THE CASE

This dispute concerns the live pay-per-view broadcast of the Mayweather vs. McGregor boxing match, which took place on August 26, 2017 (“Simulcast”). Dist. Ct. Dkt. 1, Page ID # 2. The Simulcast was produced and broadcast live by Showtime Networks, Inc. (“Showtime”). Dist. Ct. Dkts. 40-2, Page ID ## 227-28; 41-1, Page ID # 484. Showtime is both the copyright author and owner of the Simulcast. Dist. Ct. Dkts. 40-2, Page ID ## 217-18; 41-1, Page ID # 484. In fact, prior to the Simulcast, Showtime filed a copyright infringement lawsuit on August 15, 2017, against several John Does to prevent

the distribution of the Simulcast under Section 411(c) of the U.S. Copyright Act. Dist. Ct. Dkts. 40-2, Page ID ## 222-242; 41-1, Page ID # 484. Then, after the Simulcast, Showtime registered its copyright in the work with the U.S. Copyright Office. Dist. Ct. Dkts. 40-2, Page ID ## 217-18; 41-1, Page ID # 484. Showtime is the only listed copyright author and claimant of the Simulcast. *Id.*

On November 21, 2017, almost three months after the Simulcast, Showtime entered into an agreement with Joe Hand Promotions, Inc., (“JHP”) concerning the enforcement of the distribution and public performance of the “Event” live on August 26, 2017, to commercial and non-residential viewing locations. App. 94-98. “Event” is defined as, “The entire pay-per-view television broadcast of the August 26, 2017, Mayweather v. McGregor bout, including all undercard matches contained therein.” *Id.* No other agreements were entered into between Showtime and JHP that concern the Simulcast. *See* Dist. Ct. Dkt. 40-1 – 40-7.

On August 26, 2020, JHP (not Showtime) filed this copyright infringement¹ lawsuit against James H. Griffith Jr. and Lisa Lesley alleging their unauthorized distribution and public display of the live boxing match at James’ bar: CJ’s Sports Bar. Dist. Ct. Dkt. 1.

¹ JHP’s Complaint also brought a claim for “Satellite [47 U.S.C. § 605] and Cable Piracy [47 USC §553]”. This claim was dismissed by the district court as time-barred. Dist. Ct. Dkt. 31, Page ID # 142. The claim is no longer at issue in this case.

After cross summary judgment motions were filed and briefed, the district court entered judgment for James and Lisa and against JHP. App. 33. The district court had jurisdiction to enter judgment under Title 28, Sections 1331 and 1338(a) of the U.S. Code. 28 U.S.C. §§ 1331, 1338(a).

In its decision, the district court held that the agreement between Showtime and JHP was a disguised assignment of a bare right to sue and impermissible under the U.S. Copyright Act. App. 30-31. JHP appealed. Dist. Ct. Dkt. 57; CA6 Dkt. 1. The Sixth Circuit reversed and remanded the case to the district court with instructions to grant JHP's motion for partial summary judgment on the issue of copyright standing and for further proceedings consistent with its opinion. App. 18. The Sixth Circuit had jurisdiction to enter its reversal under Title 28, Section 1291 of the U.S. Code. 28 U.S.C. § 1291.

In its opinion, the Sixth Circuit primarily relied upon the existence of a non-party agreement entitled "Distribution Agreement" (App. 59) and an agreement among JHP and two non-parties entitled "Commercial Licensing Agreement" (App. 70) to support its holding that JHP possessed the necessary rights in the Simulcast and therefore had standing to sue James and Lisa. App. 3, 12. These agreements, however, were executed prior to the fixation of the Simulcast and prior to Showtime's lawsuit under Section 411(c) of the Act, where Showtime represented that it owned exclusive rights in the future Simulcast. App. 59, 70; Dist. Ct. Dkt. 40-2, Page ID ## 222, 228, 237 [C.D. Cal. No. 17-cv-6041 Dkt. 1 (Aug. 5, 2017)]. Also, the Distribution Agreement did not include, bind, or even

mention JHP. App. 59 – 69. And neither JHP nor James and Lesley discussed, argued the importance of, or even specifically cited the Distribution Agreement to support their positions in either their summary judgment filings with the district court or their written appellate briefs filed with the Sixth Circuit.

At the district court, JHP did not discuss, argue the importance of, or specifically cite the Distribution Agreement in its Memorandum of Law in Support of [JHP's] Motion for Partial Summary Judgment. Dist. Ct. Dkt. 40, Page ID ## 204 – 206. Notably, JHP did not cite or discuss the Distribution Agreement in section II, subsection B of the Memorandum entitled “Material Facts”. Dist. Ct. Dkt. 40. JHP also did not discuss, argue the importance of, or cite the Distribution Agreement in its response to James’ and Lisa’s Motion for Summary Judgment. Dist. Ct. Dkt. 49. JHP merely placed the document in the district court joint appendix (Dist. Ct. Dkt. 40-1 – 40-7) and vaguely stated in its summary judgment motion that it “...relies on the evidence in the joint appendix and supporting memorandum of law filed herewith” *without* providing any specific citation to the Distribution Agreement or argument as to why this document was material to this case. Dist. Ct. Dkts. 39, Page ID # 199; 40. James and Lisa also did not discuss, argue the importance of, or specifically cite this document in their summary judgment filings. Dist. Ct. Dkts. 41, 41-1, 47.

On appeal, neither JHP nor James and Lisa discussed, argued the importance of, or specifically cited the Distribution Agreement to support their

positions in their written appellate briefs. CA6 Dkts. 12, 14, 17. The only possible mention of the Distribution Agreement was a bare statement in a footnote in JHP's opening appellate brief mentioning that "SNI had a separate agreement with Mayweather Productions, LLC and MAYMAC LLC to distribute the Event broadcast to *non-commercial/residential consumers* and authored the copyright for the Event" CA6 Dkt. 12, p. 6, n. 1 (emphasis added). That footnote, however, failed to provide the Sixth Circuit with a citation to the record or the name or date of the agreement. *Id.* And JHP again did not discuss or argue the importance of this "separate agreement" in its brief. CA6 Dkt. 12. In fact, this "separate agreement" does not appear to be the Distribution Agreement relied upon by the Sixth Circuit since 1) MAYMAC LLC was not a party to the Distribution Agreement², and 2) according to the Sixth Circuit, the Distribution Agreement concerned both non-commercial and commercial consumers. App. 3, 12, 59. It is therefore implausible that this "separate agreement" was the Distribution Agreement relied upon by the Sixth Circuit. That said, if the document mentioned in JHP's appellate brief is in fact the Distribution Agreement, then, by JHP's own admission, it did not concern this case since it did not apply to commercial consumers and therefore should not have been considered by the Sixth Circuit at all.

Rather, since the beginning of this case, JHP has consistently argued that the document entitled

² This is why James and Lisa stated in their Response that this "separate agreement" was not in the record. CA6 Dkts. 14, p. 14; 29-1; App. 3-4.

“Agreement” (App. 94) and often referred to by JHP as “Copyright Assignment Agreement” provided JHP with the right to bring this lawsuit against James and Lisa, not the Distribution Agreement:

Statement by JHP	Citation to Record
By written agreement with the owner of the registered copyright [PA 2-066-333] of the Program, Plaintiff was assigned ownership of the right to distribute 17 U.S.C. § 106(3) and authorize the public performance 17 U.S.C. § 106(4) of the Program.	Dist. Ct. Dkt. 1, Page ID # 2
Plaintiff was assigned in writing the domestic commercial licensing rights in and to the Event broadcast. Therefore, Plaintiff has standing to bring this suit and its copyright infringement claims. See JA pp. 00046-00048 (Copyright Assignment Agreement)	Dist. Ct. Dkt. 40, Page ID # 204
Plaintiff has established that it was assigned a valid Copyright to the Event. See 17 U.S.C.A. § 101 (an assignment constitutes a “transfer of copyright ownership”); JA p. 00027 at ¶ 3 (Affidavit of Joe Hand, Jr.); JA pp. 00046-00048 (Copyright Assignment Agreement)); <i>Joe Hand Promotions, Inc. v. Dilone</i> , No. 19-CV-871 NGG RML, 2020 WL 1242757, at *6	Dist. Ct. Dkt. 40, Page ID # 208

(E.D.N.Y. Mar. 16, 2020) (parenthetical omitted)	
In the Copyright Assignment Agreement, the author and original copyright claimant, Showtime Networks, Inc., unequivocally conveyed to Plaintiff certain exclusive rights under the Copyright Act including those violated by Defendants.	Dist. Ct. Dkt. 49, Page ID # 554

Nonetheless, the Sixth Circuit considered, interpreted, and relied heavily, *sua sponte*, on the Distribution Agreement to 1) support its holding that JHP already owned the necessary copyright in the work prior to the Simulcast and 2) establish Showtime's and JHP's intent when entering into the Agreement (App. 94) after the Simulcast. App. 3, 12, 17.

For clarity, the following chart identifies the agreements that the Sixth Circuit considered (including relevant event dates of import in this case):

Date	Document Title	Entities Identified	Citation to Record
June 20, 2017	Distribution Agreement	SHOWTIME NETWORKS INC.	App. 59 – 69
		SHOWTIME PAY-PER-VIEW	Dist. Ct. Dkt. 40-

		MAYWEATHER PROMOTIONS, LLC ("MayMac" is identified in the agreement but not a party to the agreement)	4/40-5, Page ID ## 347- 382
August 1, 2017	Commercial Licensing Agreement	Mayweather Promotions, LLC MAYMAC LLC JOE HAND PROMOTIONS, INC.	App. 70 – 93 Dist. Ct. Dkt. 40- 2, Page ID ## 247-261
August 15, 2017	Showtime Networks Inc. files lawsuit under Section 411(c) of the Act against several John Does (C.D. Cal 17-cv-06041 Dkt. 1 (Aug. 5, 2017))		
August 26, 2017	Mayweather v. McGregor boxing match		

November 21, 2017	Agreement	Showtime Networks Inc.	App. 94 – 98
(SNI draft 11/30/2017)		Joe Hand Promotions, Inc. (MayMac LLC and Mayweather Promotions LLC are not parties to the Agreement but signed the agreement under “accepted and agreed”)	Dist Ct. Dkt. 40-2, Page ID ## 262-264

After the Sixth Circuit issued its decision reversing the district court’s judgment (App. 1), James and Lisa filed a Petition For *En Banc* Rehearing. CA6 Dkt. 32. The Sixth Circuit denied this petition on November 4, 2022. App. 35. This Petition follows.

REASONS FOR GRANTING THE PETITION

- I. **This Court should grant certiorari to resolve a conflict between the Sixth and Seventh Circuits concerning whether the plain language of the U.S. Copyright Act (“Act”) authorizes the exclusive licensing of rights under the Act in an idea of a work of authorship before the work is fixed in a tangible medium.**

The U.S. Copyright Act (“Act”) does not authorize the exclusive licensing of rights under the Act in an idea of a work of authorship before it is fixed in a tangible medium. The Seventh Circuit Court of Appeals agrees. The Sixth Circuit Court of Appeals, in this case, does not.

Instead, according to the Sixth Circuit, rights in an idea can be exclusively licensed under the Act. App. 12. This interpretation of the plain language of the Act is incorrect and in conflict with the Seventh Circuit’s interpretation of that same plain language. The Sixth Circuit’s decision should therefore be reversed and the conflict among the Circuits resolved.

As this Court has stated, a valid copyright extends only to copyright subject matter. *Star Athletica, L.L.C v. Varsity Brands, Inc.*, 580 US 405, 411 (2017). The Act defines copyright subject matter as “original works of authorship *fixed in a tangible medium.*” *Id.*; 17 U.S.C § 101 (emphasis added). According to the Act, fixation is a necessary requirement for there to be a copyright. *Id.* That copyright must first exist before

ownership in the copyright can be transferred.³ 17 U.S.C. 201(a),(d).

But who is the copyright owner of a work when it is created? According to the Act, a valid copyright vests initially in the author or authors of the work. 17 U.S.C. § 201(a). Here, the author of the Simulcast of the Mayweather v. McGregor boxing match is Showtime Network Inc. (“Showtime”). That is not in dispute. This fact is evidenced by Showtime’s U.S. Copyright Registration No. PA 2-066-333. Dist. Ct. Dkts. 1, Page ID # 2; 40-2, Page ID ## 217-18. JHP is not the author of the work and is not identified as an author in the Copyright Registration. As a result, Showtime was the copyright owner of the Simulcast at the time of its creation and enjoyed all of the applicable exclusive rights identified in Section 106 of the Act.⁴ 17 U.S.C. §§ 106, 201(a).

According to the Sixth Circuit, however, before the Simulcast was created, JHP already owned exclusive

³ An existing copyright is also normally a prerequisite to enforcement of that copyright unless an exception exists under Section 411 of the Act. 17 U.S.C. §§ 101; 411(c); 501(b). For a simulcast, the work at issue in this case, Congress detailed in Section 411(c) an enforcement exception to the fixation requirement for the “copyright owner”. According to 411(c), the copyright owner of a simulcast can bring a lawsuit before the work is fixed in a tangible medium. 17 U.S.C § 411(c). Clearly, Congress knew when to provide protection prior to fixation for simulcasts and to whom.

⁴ Showtime also filed a lawsuit under Section 411(c) against several entities to enforce its exclusive rights under the Act prior to the Simulcast. Dist. Ct. Dkt. 40-2 , Page ID ## 222-242. This not only evidences Showtime’s copyright ownership in the Simulcast but JHP’s lack thereof. *Id.*

rights to distribute and publicly display that Simulcast to commercial establishments on the day of the boxing match. App. 12, 14, 17. In its decision, the Sixth Circuit found that JHP was an exclusive licensee of these rights through a series of agreements executed *before* the Simulcast existed: the Distribution Agreement and the Commercial Licensing Agreement.⁵ App. 3-4, 12-13, 17, 59, 70. Based on a plain reading of the Act, the Sixth Circuit's reliance on these pre-fixation agreements to determine copyright ownership in this case was in error. The Act does not provide for a pre-fixation transfer of exclusive rights under the Act. 17 U.S.C. §§ 106, 201.

The Seventh Circuit agrees. In its opinion in *Video View Inc. v. Studio 21 Ltd.*, the Seventh Circuit, in reviewing an exclusive licensing agreement, correctly interpreted the Act and stated that "...a licensing agreement cannot create property rights enforceable under the copyright laws." 925 F.2d 1010, 1018 (7th Cir 1991) abrogated on other grounds by *Budget Cinema v. Watertown Assocs.*, 81 F.3d 729 (7th Cir. 1996) *citing* 17 U.S.C. § 201(d)(2). This means that only preexisting copyrights (works of authorship fixed in a tangible medium) can be exclusively licensed, not an idea of a work not yet in existence. *See Recht v. MGM Studio, Inc.*, 580 F. Supp. 2d 775, 784 (W.D. Wis. 2008) (works of authorship not yet in existence at time of a copyright transfer agreement cannot be transferred under that agreement) *citing Video View*

⁵ These agreements were also executed before Showtime filed its lawsuit under 411(c) of the Act. Dist. Ct. Dkt. 40-2, Page ID ## 222-242

Inc., 925 F.2d at 1018. Under the Seventh’s Circuit’s correct interpretation of the Act, these pre-fixation agreements relied upon by the Sixth Circuit could not provide JHP with an exclusive copyright license in the Simulcast since the copyright did not yet exist. JHP is thus not the copyright owner and cannot prevail in its claim against James and Lisa under the Act.

As a result, the Sixth Circuit’s holding in this case conflicts with the Seventh Circuit’s interpretation of the Act and effectively creates a circuit split on an issue of federal law. Under Rule 10(a) of the Supreme Court of the United States, this is a compelling reason to grant a writ of certiorari in this case. Petitioners, James and Lisa, therefore, respectfully request that this Court grant their Petition.

II. This Court should grant certiorari to confirm that the U.S. Copyright Act does not permit the assignment of a bare right to sue and, in doing so, dispel any doubt among the federal courts of appeals that it does.

Under the plain language of the U.S. Copyright Act (“Act”), a party who is assigned the bare right to sue cannot maintain a copyright cause of action against an alleged infringer without ownership of an existing underlying right identified in Section 106 of the Act. 17 U.S.C. §§ 106, 501.

Here, the district court correctly applied the law and held that the Agreement between Showtime and JHP on November 21, 2017, was a “...thinly-veiled attempt to evade the carefully drawn congressional boundaries delineating the right to sue for copyright

infringement.” App. 29. As a result, judgment should once again be entered in favor of James and Lisa.

Unfortunately, the Sixth Circuit chose not to directly address this issue in its opinion and instead decided to rely on certain agreements executed prior to the Simulcast to support its reversal. App. 12, 17, 59, 70. The reliance on these pre-fixation agreements was in error as discussed in this Petition. *Supra* at Section I. As a result, this Court is still left with an important issue to resolve, both in this case and among the courts of appeals. That issue is whether the Act permits a copyright owner (Showtime) to assign to a third party (JHP) a bare right to sue.

The district court correctly held in this case that the Act does not permit such a transfer in accord with the Ninth Circuit’s decision in *Silvers v. Sony Pictures Entertainment Inc.* and the Second Circuit’s decision in *John Wiley & Sons, Inc. v. DRK Photo*. App. 28, 30-31. The Fifth Circuit’s decision in *Prather v. Neva Paperbacks, Inc.*, however, creates doubt as to whether or not a mere right to sue can be assigned without any accompanying exclusive rights. Effectively, there is again a conflict among the courts of appeals that needs to be resolved. Ultimately, James and Lisa request that this Court confirm that bare right to sue is impermissible under the Act and based on the facts of this case reinstate the district court’s judgment in their favor.

Section 501(b) of the Act provides that, “The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed *while he or she is*

the owner of it.” 17 U.S.C. § 501(b) (emphasis added). The Act defines “copyright owner” as the owner of any one of the exclusive rights comprised in a copyright. 17 U.S.C. § 101.

The right to sue is not one of the exclusive rights identified in the Act. 17 U.S.C. § 106. As a result, the Second and Ninth Circuits correctly interpreted the Act and held that copyright holders cannot elect third parties to bring suits on their behalf without the transfer of any of the exclusive rights detailed in Section 106 of the Act. 17 U.S.C. §§ 106, 501(b); *John Wiley & Sons, Inc. v. DRK Photo*, 882 F.3d 394, 403-07 (2d Cir. 2018) (photographers’ agent did not have standing under the Act since it only had a bare right to sue without any exclusive right under Section 106); *Silvers v. Sony Pictures Entm’t Inc.*, 402 F. 3d 881, 883-86 (9th Cir. 2005) (*en banc*) (copyright owner’s assignment of the bare right to sue without any exclusive rights under the Act is insufficient to give original author standing to bring lawsuit). These circuits agree that a copyright owner cannot merely assign its right to sue. *Id.* And there does not appear to be any court of appeals opinion that interprets the Act otherwise; arguably, this is settled law.

Still, this Court’s review is necessary given the Fifth Circuit’s decision in the case *Prather v. Neva Paperbacks, Inc.* In *Prather*, the Fifth Circuit held that an assignee of the right to sue for accrued causes of action had standing to bring suit under the Copyright Act of 1909 even though the entire copyright was not transferred in that agreement. 410 F.2d 698, 700 (5th Cir. 1969). Under the 1909 Copyright Act, it was all or nothing when transferring a copyright, and therefore

Prather effectively approved the assignment of a bare right to sue for accrued claims since not all the copyright was assigned in that case. *Id.*; *See Silvers*, 402 F. 3d at 889.

Dissenting opinions in both the Ninth Circuit's *Silvers* case and the Second Circuit's *John Wiley & Sons* case rely on *Prather* to support the contention that the current Act also allows a bare right to sue for accrued causes of action so long as they are sufficiently detailed in the agreement. *Silvers*, 402 F.3d at 897, 901, 907 – 909 (Bea, J. dissenting); *John Wiley & Sons*, 882 F.3d at 416 (Parker, J. dissenting). As a result, this Court's review of the issue is necessary to dispel any doubt among the courts of appeals and confirm that a plain reading of the current Act does not authorize the transfer of the bare right to sue (with or without accrued claims).

Again, in the current Act, Congress specifically detailed the copyright owner's exclusive rights, which do not include the mere right to sue. 17 U.S.C. § 106. If Congress wanted to provide a mere right to sue under the Act, it would have provided for such a right within the language of the Act. It did not. 17 U.S.C. § 101 *et seq.* Therefore, a bare right to sue is not permitted under the Act unless it is accompanied by an existing exclusive right. 17 U.S.C. §§ 106, 501(b); *John Wiley & Sons*, 882 F.3d at 404-07; *Silvers*, 402 F. 3d at 883-86.

Here, Showtime was the owner of the copyright in the Simulcast when the alleged infringement occurred. Dist. Ct. Dkt. 40-2, Page ID ## 217, 228; App. 95. Although Showtime and JHP executed an agreement concerning the Simulcast after the fact,

that agreement did not grant JHP any valid exclusive rights under the Act. App. 30-31; 94-98.⁶

According to the district court, the “exclusive right” purportedly assigned to JHP was in reality a sham; unless JHP had a time machine, it could not exploit the right to distribute and publicly perform live the pay-per-view broadcast of a boxing match 2 months and 26 days in the past. App. 30-31; 94-95. As the district court intuitively wrote, “...allowing [JHP] to maintain this suit would ignore the plain language of the Copyright Act and would invite parties to frustrate Congress’s intent with mere clever drafting, no matter how metaphysically impossible it is to retroactively obtain an exclusive right to something that could only have existed in the past: the right to display the Event ‘live.’” App. 30-31. Since JHP did not own any valid exclusive right in the Simulcast, it was not the copyright owner in this case. *Id.* The district court thus correctly entered judgment in James’ and Lisa’s favor. App. 33. The Sixth Circuit erred when it reversed that judgment. App. 1.

Therefore, based on the Ninth Circuit’s decision in *Silvers*, the Second Circuit’s decision in *John Wiley & Sons*, and the Fifth Circuit’s decision in *Prather*, discussed above, there is a compelling reason under Rule 10(a) of the Supreme Court of the United States for this Court to grant a writ of certiorari to resolve the issue of whether there is a bare right to sue under the Act. Petitioners, James and Lisa, therefore, respectfully request that this Court grant this Petition

⁶ This agreement also did not sufficiently detail the accrued claims purportedly assigned (if any), which would still have been required even under *Prather*. App. 95 – 96.

and ultimately reinstate the district court's judgment in their favor.

III. This Court should grant certiorari to confirm the historical division of responsibilities between federal courts of appeals and district courts and ultimately find that a federal court of appeals, in the course of *de novo* review of a grant of summary judgment for defendant, may not *sua sponte* interpret and rely on evidence in the record to support its reversal for plaintiff when the parties did not discuss, argue the importance of, or even specifically cite this evidence to support their positions in either their 1) summary judgment filings or 2) written briefs on appeal.

This Court has long recognized the fundamental tenet of appellate jurisprudence that “factfinding is the basic responsibility of district courts, rather than appellate courts, and . . . the Court of Appeals should not have resolved in the first instance a factual dispute which had not been considered by the District Court.” *Pullman-Standard v. Swint*, 456 U.S. 273, 291 (1982) *quoting DeMarco v. United States*, 415 U.S. 449, 450 (1974) (even though the standard of review in *Pullman* was clearly erroneous and not *de novo*, the principal outlined by this Court should remain true in the review of a grant of summary judgment).

Following this fundamental tenet, federal appellate courts have correctly held that evidence and related arguments supporting summary judgment must first be adequately presented to the district court

for its consideration. *Grogan v. Kumar*, 873 F.3d 273, 277 (5th Cir. 2017) (“We typically will not consider evidence or arguments that were not presented to the district court for its consideration in ruling on the motion”); *Adler v. Wal-Mart Stores*, 144 F.3d 664, 672 (10th Cir. 1998) (the appellate court’s review is “...from the perspective of the district court at the time it made its ruling, ordinarily limiting [its] review to the materials adequately brought to the district court by the parties”); *Box v. A&P Tea Co.*, 772 F.2d 1372, 1376 (7th Cir. 1958) (grounds asserted at the summary judgment stage must be adequately presented to the trial court first so that the other side may have the opportunity to present refuting facts to contest the issue, and only if a new ground is encompassed therein and asserted on appeal should it be considered).

Relatedly, district courts do not have the duty to sort through evidence contained in the record, which is not adequately presented or relied upon by a party, to support that party’s arguments either for or against summary judgment, i.e. make that party’s case on its behalf. Fed. R. Civ. Pro 56(c)(3); *Wimbush v. Wyeth*, 619 F.3d 632 n. 4 (6th Cir. 2010), *reh’g en banc denied*, *Wimbush v. Wyeth*, 2010 U.S. App. LEXIS 21662 (6th Cir. Oct. 14, 2010) (A party cannot “drop[] a pile of evidence on the district court’s desk and expect[] him to sort it out”); *Adler*, 144 F.3d at 672 (appellate and district courts “...have a neutral and limited role in the adversarial process, and are wary of becoming advocates who comb the record of previously available evidence and make a party’s case for it”). Otherwise, attorneys would have an incentive to “stuff” the record, i.e. include reams of irrelevant

papers in the lower court record, in hopes that the trial court will sort through the documents to find a kernel of evidence to support or avoid summary judgment. *See id.* This is fundamentally unfair to the opposing party, here James and Lisa.

Even more unfair is to permit a federal appellate court to unilaterally interpret and rely on evidence to reverse a district court's entry of summary judgment for defendant when that evidence was not discussed, used in arguments, or even specifically cited by the parties in their summary judgment filings or in their written appellate briefs. To do so deprives the defendant of an opportunity to meaningfully challenge the evidence or the appellate court's interpretation of it. *See Adler*, 144 F.3d at 672.

In this case, both parties filed with the district court motions for summary judgment and supporting memoranda. Dist. Ct. Dkts. 39, 40, 41, 41-1. Although the Distribution Agreement was placed in the record by JHP, neither party discussed, argued the importance of, or even specifically cited the Distribution Agreement to support their positions in these filings. *Id.* Notably, the Distribution Agreement was neither cited nor discussed in section II, subsection B entitled "Material Facts" in JHP's supporting memorandum. Dist Ct. Dkt. 40, Page ID ## 204-206. The Distribution Agreement was also neither cited nor discussed in JHP's response to James' and Lisa's Motion for Summary Judgment. Dist. Ct. Dkt. 49.

Even so, the Sixth Circuit saw fit to consider the Distribution Agreement, determine that it was material to the case, and find that it granted another

non-party exclusive rights under the U.S. Copyright Act that were then purportedly transferred to JHP. App. 3-4, 12. JHP, however, never pointed to the Distribution Agreement as a necessary link in the chain of copyright ownership.

Rather, from the beginning of this case, JHP consistently argued that another document entitled “Agreement” (App. 94) provided JHP with the right to bring this lawsuit against James and Lisa. Dist. Ct. Dkts. 1, Page ID # 2; 40, Page ID ## 204, 208; 49, Page ID # 554. Clearly, JHP never considered the Distribution Agreement material to support its case and therefore did not rely on this document to support its written summary judgment and appellate brief arguments. Dist. Ct. Dkts. 39, 40, 49; CA6 Dkts. 12, 17. Neither did James and Lisa. Dist. Ct. Dkts. 41, 41-1, 47; CA6 Dkt. 14. Yet, the Sixth Circuit made the document a star witness in its reversal. App. 3, 12. This was in error.

Permitting federal appellate courts to take, *sua sponte*, both the fact-finding and the lawyering role into their purview fundamentally weakens the American system of advocacy, blurs the functions of the trial and appellate courts, and unjustifiably prejudices the party that is blind-sided (or as some jurists have suggested, “sandbagged”) on appeal – *after its written arguments have been made*. The dangers of permitting such a practice is made clear even in this one instance, and writ large, this practice constitutes a grave risk to the jurisprudence defining the roles of the various federal appellate and district courts.

In this instance, the Sixth Circuit rendered its opinion upon heavy consideration of the Distribution Agreement⁷ even though, as mentioned above, this evidence was never discussed, used in argument, or specifically cited by the parties to support their positions in either their summary judgment filings or written appellate briefs. App. 12, 17. Nevertheless, the Sixth Circuit felt it appropriate to consider the Distribution Agreement, determine that it was unambiguous, interpret it (incorrectly), and adduce from the document Showtime (a non-party) and JHP's *intent* for a later drafted agreement. App. 17. ("By viewing the Copyright Agreement in a vacuum and ignoring the parties' earlier agreements and conduct, Defendants ignore Showtime and JHP's intent when entering the contract.")

The Sixth Circuit thus acted unilaterally and without prompting to determine the meaning and effect of a complicated multi-party agreement executed by non-parties to the litigation months before the issues at bar arose. And further, the Sixth Circuit determined that such agreement was sufficiently clear and unambiguous to adduce *both a non-party's* and a *party's* intent and concomitant rights under the U.S. Copyright Act. In doing so, the Sixth Circuit did not invite or permit any meaningful opportunity for James and Lisa to argue the contrary, which is the foundation of our adversary system.

Permitting a federal appellate court to both make factual determinations and also to take the reins of the legal arguments is fundamentally unfair, and

⁷ Again, this agreement was *between non-parties to the suit*. App. 59.

immeasurably undermines the American adversarial system of advocacy and jurisprudence. If permitted to stand, the Sixth Circuit's practice encourages parties to stuff the record at the trial court level and if they lose, file an appeal and cross their fingers in hopes that the appellate court will unilaterally comb through the record and craft legal arguments in their favor that were never adequately presented to the finder of fact or made available for challenge. Such a policy would not only overburden the appellate courts, but also would raise the specter that the appellate courts have the unfettered right to act not only as judge and jury but also as *attorney* for one side over the other.⁸

This cannot be the proper scope of a *de novo* review. Thus, the Court should grant *certiorari* not only on the novel copyright issues before the Court in this matter, but also to prevent the grave risk to the adversary system posed by federal appellate courts who take on the role of party attorney and fact finder, *sua sponte*.

CONCLUSION

For the reasons stated therein, Petitioners respectfully pray that this Court grant their Petition for Writ of Certiorari.

⁸ This is not an instance of taking judicial notice of, or even conducting independent legal research into, a fact such as the day of the week on which a particular date falls or whether gravity generally causes objects to fall towards earth.

Respectfully submitted,

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