

No. 17-1033

In The
Supreme Court of the United States

OKSANA BAIUL AND OKSANA LTD.,

Petitioners,

v.

NBC SPORTS, a division of NBC UNIVERSAL
MEDIA LLC; ON ICE INC.; BARRY MENDELSON,

Respondents.

**On Petition For A Writ Of Certiorari
To The United States Court Of Appeals
For The Second Circuit**

**MOTION FOR LEAVE TO FILE BRIEF *AMICUS*
CURIAE AND BRIEF *AMICUS CURIAE* OF
REITER, DYE & BRENNAN, LLP AND
THE LINDE LAW FIRM IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI**

LORIN BRENNAN, ESQ.
REITER, DYE & BRENNAN, LLP
12100 Wilshire Boulevard, Suite 650
Los Angeles, California 90025-1166
(310) 481-6701 – Fax: (310) 481-6720
E-mail: lebreannan@msn.com
Counsel for Amicus Curiae
February 22, 2018

MOTION TO FILE BRIEF

Pursuant to Rule 37.2(b), *amicus curiae* respectfully request leave to file the within brief on the following grounds:

1. On January 29, 2018, counsel for *amici* sent letter by e-mail to counsel for all parties of the intent to file this *amicus curiae* brief. A written version of this was sent by regular mail several days later.

2. On January 29, 2018, counsel for *amici* received an e-mail from Petitioner indicating no objection to filing this brief.

3. On January 29, 2018, counsel for *amici* received a call from counsel for On Ice, Inc. and Barry Mendelson inquiring about the interest of *amici* in the case but not indicating an objection to filing.

4. On February 8, 2018, counsel for NBC Sports sent an e-mail indicating no objection to filing this brief.

5. As of this writing counsel for *amici* has not received notice from counsel for any party objecting to the filing of this brief.

6. As discussed below, *amici* believe they have specialized knowledge that will assist the Court in considering this petition.

Respectfully submitted,

LORIN BRENNAN, ESQ.
REITER, DYE & BRENNAN, LLP
12100 Wilshire Boulevard, Suite 650
Los Angeles, California 90025-1166
(310) 481-6701 – Fax: (310) 481-6720
E-mail: lebreannan@msn.com

TABLE OF CONTENTS

	Page
MOTION TO FILE BRIEF	1
TABLE OF AUTHORITIES	ii
INTEREST OF <i>AMICUS CURIAE</i>	1
SUMMARY OF ARGUMENT	1
ARGUMENT	3
CONCLUSION	11

TABLE OF AUTHORITIES

	Page
CASES	
<i>Armstrong v. Eagle Rock Entertainment Inc.</i> , 655 F. Supp. 2d 779 (E.D. Mich. 2009)	9
<i>Fleet v. CBS, Inc.</i> , 50 Cal. App. 4th 1911, 58 Cal. Rptr. 2d 645 (1996)	9
<i>Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.</i> , 772 F.2d 505 (9th Cir. 1985)	10
<i>Jules Jordan Video, Inc. v. 144942 Canada Inc.</i> , 617 F.3d 1146 (9th Cir. 2010)	9
<i>Kiss Catalog, Ltd. v. Passport Int’l Prods., Inc.</i> , 405 F. Supp. 2d 1169 (C.D. Cal. 2005)	6
<i>Montz v. Pilgrim Films & Television, Inc.</i> , 649 F.3d 975 (9th Cir. 2011)	8
<i>O’Bannon v. National Collegiate Athletic Associ- ation</i> , 802 F.3d 1049 (9th Cir. 2015)	8
<i>Ray v. ESPN, Inc.</i> , 783 F.3d 1140 (8th Cir. 2015)	9
<i>U.S. ex rel. Berge v. Board of Trustees of Univ. of Ala.</i> , 104 F.3d 1453 (4th Cir.), <i>cert. denied</i> , 522 U.S. 916, 118 S.Ct. 301, 139 L.Ed.2d 232 (1997)	5
<i>Whitman v. Am. Trucking Associations</i> , 531 U.S. 457, 121 S.Ct. 903, 149 L.Ed.2d 1 (2001)	7
STATUTES	
17 U.S.C. § 101	5
17 U.S.C. § 301(a)	4, 5

TABLE OF AUTHORITIES – Continued

	Page
17 U.S.C. § 301(b).....	4
17 U.S.C. § 301(b)(1)	4
17 U.S.C. § 1101	6
Pub. L. No. 103-465, title V, § 512(a) December 8, 1994	6

OTHER AUTHORITIES

Beijing Treaty on Audiovisual Performances of 2012, http://www.wipo.int/treaties/en/ip/beijing/	7
--	---

TREATISES

J. Thomas McCarthy, THE RIGHTS OF PUBLICITY AND PRIVACY § 11:54 – <i>Federal preemption</i> , vol. 2 (2017)	8
Lorin Brennan, Holly K. Towle, Joel Rothstein Wolfson, <i>Commercial Information Law: The Complete UCITA</i> (2004).....	1
Melville & David Nimmer, NIMMER ON COPY- RIGHT §1.01[B][2][a] (2017)	4
Paul Goldstein, INTERNATIONAL COPYRIGHT § 2.2 <i>et seq.</i> (2001).....	6

INTEREST OF *AMICUS CURIAE*¹

Reiter, Dye & Brennan, LLP and The Linde Law Firm are law firms in Los Angeles, California with experience in international copyright practice and copyright litigation and who represent unrelated parties who may be involved in similar situations. One of the firm's members is co-author of the treatise, Lorin Brennan, Holly K. Towle, Joel Rothstein Wolfson, *Commercial Information Law: The Complete UCITA* (2004). *Amici* believe that they can add additional insight to the issues raised by the petition.



SUMMARY OF ARGUMENT

This case raises an important question of copyright law:

Does the Copyright Act preempt all state law claims for unauthorized fixation of a live audiovisual performance?

Allegedly, defendant NBC Sports made an unauthorized tape (“audiovisual fixation”) of plaintiff Baiul’s live performance of *Nutcracker on Ice*. This involved two creative components: Baiul’s live performance,

¹ Pursuant to Supreme Court Rule 37.6, *Amici* state that no counsel for either party has authored any portion of this brief and no person or entity, other than *Amici*, has made any monetary contribution to the preparation or submission of this Brief. As indicated in the motion to file this Brief, counsel for parties were given timely written notice of intent to file this Brief more than 10 days before the filing of this Brief and no party has objected.

which is not copyrightable subject matter; and NBC's taping, which did involve copyrightable elements in lighting, scene selection, *etc.* Apparently, Baiul is not making any claim to original elements added by NBC in making its tape. Baiul is only seeking remedies for unauthorized fixation of her performance.

Section 301 of the Copyright Act preempts state law claims essentially involving copyrightable subject matter and rights "equivalent to the exclusive rights in Section 106." However, Section 106 does not contain a fixation right.

International practice distinguishes "author's rights" (copyright) and "neighboring rights." The latter includes a right of performers to consent to initial fixation of their live performance. To fulfill certain international obligations, in 1994 Congress added Section 1101 to the Copyright Act. It provides rights against unauthorized fixation of live musical performances and says these rights do not preempt state law. This indicates Congressional understanding that the fixation right is not included in Section 106 and does not annul available state law remedies.

Live audiovisual performances are the subject of the more recent Beijing Treaty of 2012. The United States signed the treaty and President Obama submitted it for ratification. It would be curious if despite signing the treaty the United States had already decided Section 106 preempts a fixation rights for live audiovisual performance and then effectively eliminates any remedies to the performer for impairment of

that right. It is suggested the better view is that, unless and until Congress says otherwise, Section 301 does not preempt state law remedies for unauthorized fixation of any live performance.

The decision below could be at odds with other circuit cases which provide the Copyright Act does not preempt state law claims for breach of implied contract or certain rights of publicity claims. However, even in these cases, it appears the precise issue of preemption of state law claims for unauthorized fixation has not been fully raised. Evidently, Baiul is not seeking remedies (e.g., damages, injunction) against NBC Sports' exploitation of its tape. But she is seeking remedies under state law for unauthorized fixation (e.g., contract fee for permission to tape). To the extent those state law remedies do not interfere with NBC's exercise of its exclusive rights under Section 106 of the Copyright Act, they should not be preempted.

◆

ARGUMENT

According to the decision below and the facts recited in the Petition for Certiorari, in 1994 petitioner Oksana Baiul ("Baiul") gave a figure skating performance of *Nutcracker on Ice* that was taped ("fixed") by respondent NBC Sports, a division of NBC Universal Media LLC ("NBC Sports") without her permission. Baiul asserted state law claims including for unauthorized fixation of her performance that were removed to the federal district court due to Copyright Act

preemption. This brief does not address the merits of the state law claims. It only addresses whether it was proper to treat Oksana’s unauthorized fixation claim as preempted.

The Copyright Act, 17 U.S.C. § 301(a), preempts certain state law claims involving copyrightable subject matter. The test has two parts: (i) a “works test” – the subject matter is a “work of authorship fixed in a tangible medium of expression within the subject matter of copyright”; and (ii) a “rights test” – the state law rights are “equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.” The Copyright Act, 17 U.S.C. § 301(b), makes clear that preemption does not apply to: (i) “works of authorship not fixed in a tangible medium of expression (17 U.S.C. § 301(b)(1)); or (ii) “activities violating rights not equivalent to any of the exclusive rights specified by section 106.”

Initially, it should be noted that here there are *two* creative contributions involved. The first is Oksana’s live performance. This is plainly not a “work of authorship fixed in a tangible medium of expression.” Melville & David Nimmer, NIMMER ON COPYRIGHT §1.01[B][2][a] at 1.68.1 (2017) (“One prominent example fitting this category is a live performance.”).

The second is NBC Sports’ video tape. That includes original expression such as lighting, scene selection, editing, and color commentary. There is no dispute NBC Sports may claim copyright protection in those contributions. Evidently, Baiul makes no claim

for any interest in those contributions nor does she seek to prevent any exploitation of these rights.

As indicated in 17 U.S.C. § 101, a work is only “fixed in a tangible medium of expression” if done “under the authority of the author.” If Baiul did not in fact consent to fixation of her performance, then her performance – as a separate creative endeavor – should not be incorporated (and disappear) into the wholly separate creative contribution of NBC Sports such that she loses all rights. It is said that “the shadow actually cast by the Act’s preemption is notably broader than the wing of its protection.” *U.S. ex rel. Berge v. Board of Trustees of Univ. of Ala.*, 104 F.3d 1453, 1463 (4th Cir.), *cert. denied*, 522 U.S. 916, 118 S.Ct. 301, 139 L.Ed.2d 232 (1997) (“ideas and methods” in doctoral dissertation within subject matter of copyright.). This makes it especially important to consider precisely the “protection” asserted in each creative component.

The Copyright Act only preempts state rights “equivalent to the exclusive rights in Section 106” of the Copyright Act. 17 U.S.C. § 301(a). Section 106 does not include a fixation right. The reproduction right in Section 106(1) applies to the right to “*reproduce* the copyrighted work in copies.” This means for the reproduction rights there must already be a copyrightable work – and original work of authorship already *fixed* with authorization in a tangible medium of expression. Initial fixation is different.

In international practice, protection is accorded for “authors’ rights” (copyright) and “neighboring

rights.” “Neighboring rights” are “in the neighborhood of copyright” and provide separate protection for certain creative interpretations of copyrighted works, including allowing performers to consent to initial fixation of their live performance. *See* Paul Goldstein, INTERNATIONAL COPYRIGHT § 2.2 *et seq.* (2001). In the Uruguay Round Agreements Act (Pub. L. No. 103-465, title V, § 512(a) December 8, 1994), to fulfill certain treaty obligations Congress provided a remedy for unauthorized fixation of live musical performance by adding an “anti-bootlegging” provision to the Copyright Act, 17 U.S.C. § 1101. It says in relevant part:

“(a) Unauthorized Acts. Anyone who, without consent of the performer or performers involved –

(1) fixes the sound or sounds and images of a live musical performance in a copy or phonorecord . . .

. . . shall be subject to the remedies provided in sections 502 through 505, to the same extent as an infringer of copyright.

. . .

(d) State Law Not Preempted. – Nothing in this section may be construed to annul or limit any rights or remedies under the common law or statutes of any State.”

See Kiss Catalog, Ltd. v. Passport Int’l Prods., Inc., 405 F. Supp. 2d 1169, 1170 (C.D. Cal. 2005) (holding statute valid under Commerce Clause). The statute indicates Congress’s understanding that the “fixation” right is

not included in the exclusive rights in Section 106 – otherwise there would be no need for Section 1101(a)(1). In addition, Section 1101(d) states that its fixation right does not preempt comparable state law rights.

Of course, Section 1101 only applies to live musical performances. Unauthorized fixation of live audiovisual performances is addressed in the newer Beijing Treaty on Audiovisual Performances of 2012. (See <http://www.wipo.int/treaties/en/ip/beijing>) The United States signed the Treaty on June 26, 2016. (See http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=841) President Obama submitted to the Senate for ratification on February 10, 2016. (See https://www.foreign.senate.gov/imo/media/doc/Treaty_114-8.pdf) It would be unexpected if despite signing the treaty the United States had already decided that Section 301(a) of the Copyright Act preempted all state law rights for unauthorized fixation of a live audiovisual performance and then eliminated any remedies available to a performer for such conduct. Congress does not “hide elephants in mouseholes.” *Whitman v. Am. Trucking Associations*, 531 U.S. 457, 468, 121 S.Ct. 903, 910, 149 L.Ed.2d 1 (2001). It is suggested that the better view is that the exclusive rights in Section 106 do not cover unauthorized initial fixation of a live audiovisual performance and, unless and until Congress decides otherwise, nothing in the Copyright Act should “annul or limit any rights or remedies under the common law or statutes of any State” for such conduct.

As a result, the decision below appears incongruous with decisions in other circuits regarding the scope of Copyright Act preemption.

One area of concern is “implied contract” claims, which this case presents. *Montz v. Pilgrim Films & Television, Inc.*, 649 F.3d 975, 980 (9th Cir. 2011) held that: “The creation of an implied-in-fact contract between an author, on the one hand, and an agent, producer, or director, on the other hand, is of such a personal nature that it is effective only between the contracting parties.” Under this decision, to the extent Baiul’s claims involve a viable state law implied-in-fact contract to pay for initial fixation of her performance, those claims should not be preempted.

Another area involves “right of publicity” claims, which Baiul evidently also maintains. As a leading treatise puts it, “[d]etermining the proper boundary between federal copyright law and state right of publicity law concerning the non-advertising use of recorded performances is extremely difficult. The cases are in conflict, leading to what the Ninth Circuit characterized as ‘a murky body of case law.’” J. Thomas McCarthy, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 11:54 – *Federal preemption*, vol. 2 (2017) (citing *O’Bannon v. National Collegiate Athletic Association*, 802 F.3d 1049, 1068 (9th Cir. 2015)). Without trying to address all the permutations here, it may be noted that Prof. McCarthy tries to reconcile the cases depending on whether the unpermitted use of the recorded performance was “in an expressive, non-advertising medium” (preemption) or “for advertising” (no preemption). *Id.*

This distinction is not stated in Section 301. Moreover, a close reading of the cases cited show that in the non-advertising cases the plaintiff was typically seeking remedies for unauthorized reproduction, distribution or performance – rights within the ambit of Section 106. *E.g. Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 58 Cal. Rptr. 2d 645 (1996) (actor alleged licensee did not have right to distribute film because actor was not paid); *Jules Jordan Video, Inc. v. 144942 Canada Inc.*, 617 F.3d 1146, 1155 (9th Cir. 2010) (“The essence of [plaintiff’s] claim is that the . . . defendants reproduced and distributed the DVDs without authorization.”); *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1144 (8th Cir. 2015) (“the crux of Ray’s case is that ESPN retelecast Ray’s filmed performances”). The cases do not appear to address specifically a claim based solely on unauthorized fixation. An unusual decision in this regard is *Armstrong v. Eagle Rock Entertainment Inc.*, 655 F. Supp. 2d 779, 790 (E.D. Mich. 2009). Noting that “[p]laintiff’s claim is based on the premise that Defendant reproduced the Plaintiff’s [live musical] performance in the form of a DVD without his permission,” the court held that claim preempted. But on reconsideration, the court allowed plaintiff to amend to state a claim under Section 1101. *Id.* 655 F. Supp. 2d 794, fn. 1 (further details on the case not reported). It would seem that Prof. McCarthy’s distinction applies specifically when a plaintiff seeks remedies (*e.g.*, injunction, damages) for the defendant’s exercise of exclusive rights in Section 106. But, according to the petition, Oksana does not seek such remedies. Her claim is for unauthorized fixation.

In copyright cases it is possible to make an allocation between the separate contributions of the parties. For example, *Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.*, 772 F.2d 505, 516 (9th Cir. 1985) involved a claim in which songs from plaintiff's play (*Kismet*) were used in the defendant's play (*Hallelujah Hollywood*). At issue was the proper allocation of defendant's revenue and expenses between the infringing and non-infringing components. *Id.* 772 F.2d 516 ("Because a theoretically perfect allocation is impossible, we require only a reasonably acceptable formula.") Also *Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.*, 772 F.2d 505, 516 (9th Cir. 1985) (further discussion of allocation issues). As such, where the claim involves creative contributions by both a plaintiff and a defendant, an allocation to the respective contributions is not inappropriate.

The point here is not to decide what state law remedies, if any, Baiul has for unauthorized fixation. Certainly, a recovery enjoining or measured by NBC Sports' exercise of any of the exclusive rights in Section 106 (e.g. distribution, broadcast) in its tape program should be excluded. But Baiul may be entitled to some recovery under state law solely for the unauthorized fixation (e.g., contract fee that would have been paid for proper authorization). That claim should not be preempted.



CONCLUSION

Review should be granted to resolve the open issues in this important area of law for the reasons stated.

Respectfully submitted,

LORIN BRENNAN, ESQ.
REITER, DYE & BRENNAN, LLP
12100 Wilshire Boulevard, Suite 650
Los Angeles, California 90025-1166
(310) 481-6701 – Fax: (310) 481-6720
E-mail: lebreannan@msn.com