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24 **UNITED STATES DISTRICT COURT**

25 **CENTRAL DISTRICT OF CALIFORNIA**

26 ABS ENTERTAINMENT, INC., an)
27 Arkansas corporation, BARNABY)
28 RECORDS, INC., a California corporation,)
BRUNSWICK RECORD CORPORATION,)
a New York corporation and MALACO,)
INC., a Mississippi corporation, each)
individually and on behalf of all others)
similarly situated.)

Plaintiffs,)

v.)

29 CBS CORPORATION, a Delaware)
30 corporation; CBS RADIO INC., a Delaware)
31 corporation; and DOES 1 through 10,)

Defendants.)

Case No. 2:15-cv-6257-PA (AGRx)

**PLAINTIFFS' OPPOSITION TO
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT OR, IN
THE ALTERNATIVE, PARTIAL
SUMMARY JUDGMENT**

Date: May 2, 2016
Time: 1:30 p.m.
Place: Courtroom 15 – Spring St.
Before: Hon. Percy Anderson

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1 **I. INTRODUCTION**

2 The “narrow factual question” that CBS raises in its motion—whether CBS
3 played Plaintiffs’ pre-1972 sound recordings—is an unequivocal “yes.” CBS publicly
4 performed Plaintiffs’ pre-1972 sound recordings, without Plaintiffs’ consent, over its
5 terrestrial radio stations and through its “Radio.com” website. Those sound
6 recordings capture performances that took place prior to February 15, 1972, for which
7 there is no federal copyright protection as derivative works or otherwise. Although
8 CBS played copies of Plaintiffs’ sound recordings—which were “remastered” from
9 the original analog format into digital formats and placed on compact disc (“CD”)
10 albums—those remastered copies are *also* not protected under federal copyright law
11 as derivative works or otherwise. Indeed, the undisputed facts show that no one has
12 ever claimed a federal copyright for the remastered copies of Plaintiffs’ pre-1972
13 works at issue in this case.

14 It is not just that federal law precludes new copyrights for the remastered copies
15 that CBS played; contract law precluded the creation of new works that would have
16 been copyrightable. The licenses authorizing the reproduction and distribution of
17 Plaintiffs’ original pre-1972 analog master recordings in digital formats did not
18 authorize any creative modifications that could have been separately copyrighted
19 under federal law. Paul Geluso, a Master Teacher of Music Technology at NYU and
20 recognized expert in sound recording, examined Plaintiffs’ pre-1972 recordings,
21 compared them with the audio files that CBS broadcast, and confirmed that no such
22 modifications were made. After performing his analysis, Mr. Geluso concluded that
23 in 202 of the 219 songs compared, the sound recording in CBS’s audio file copy
24 captured the identical pre-1972 performance in Plaintiffs’ original master recording.
25 Mr. Geluso further concluded that, of the 202 sound files that contain the identical
26 performances:

- 27 • None of the sound recordings contain any re-mixing of Plaintiffs’
28 original sound recordings.

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- 1 • None of the sound recordings contain any editing of Plaintiffs’ original
- 2 sound recordings.
- 3 • None of the sound recordings contain added sounds or had sounds that
- 4 were deleted.
- 5 • The sound recordings in the CBS sound files embody the original master
- 6 sound recordings owned by the Plaintiffs.

7 Declaration of Paul Geluso, ¶¶ 10-11.

8 CBS relies on irrelevant declarations from Dr. Begault and Mr. Inglot. Dr.

9 Begault performed four “tests” (applying his self-created pass/fail standards never

10 before used in a copyright analysis) to conclude that the remastered audio files CBS

11 played are not “identical” duplicates of Plaintiffs’ original master recordings. CBS

12 did not need an expert or any tests to say that. Remastering from an analog to digital

13 format alone necessarily results in processing changes to a sound recording, but does

14 not make the remastered copy a new creative work subject to a separate federal

15 copyright. Mr. Inglot testified that he remastered some of Plaintiffs’ pre-1972 sound

16 recordings from analog to digital format and, as part of the remastering, made

17 mechanical processing adjustments to the recorded sounds—just like one may adjust

18 bass and treble using stereo knobs. Even if CBS played sound recordings remastered

19 by Mr. Inglot—and CBS offers no evidence that it did—this too lacks any relevance.

20 Dr. Begault admittedly found no such changes in CBS’s copies and Mr. Inglot

21 testified that he did not remix, edit, add sounds to, or delete sounds from any of

22 Plaintiffs’ pre-72 sound recordings.

23 Federal law does not treat remastered sound recordings as separate

24 copyrightable works, particularly when only mechanical processing adjustments are

25 made to optimize the recording for a particular technological format. Without (at the

26 very least) remixing, editing, adding sounds to, or deleting sounds from the original

27 recording, federal law does not recognize the remaster as a newly protectable work.

28 The evidence shows that, at most, the remastered copies of Plaintiffs’ pre-1972 sound

1 recordings publicly performed by CBS were simply converted from analog to digital
 2 format and contain only mechanical processing without any remixing, editing,
 3 additions of sounds or deletions of sounds. Thus, the remastered sound recordings in
 4 CBS's possession not only lack federal copyrights, they are ineligible for federal
 5 copyright protection, and are only protected under Cal. Civil Code § 980(a)(2).

6 Finally, there is no dispute that CBS publicly performed (or at least made
 7 available) a substantial number of Plaintiffs' sound recordings in California. As to
 8 many other sound recordings belonging to Plaintiffs, material facts regarding CBS's
 9 performance in California remain disputed. Under these facts and the law, CBS's
 10 motion must be denied.

11 **II. STATEMENT OF FACTS**

12 **A. Plaintiffs Own Pre-1972 Sound Recordings**

13 Plaintiffs ABS Entertainment, Inc., Barnaby Records, Inc., Brunswick Record
 14 Corporation and Malaco, Inc. own sound recordings of musical performances that
 15 initially were fixed (*i.e.*, recorded) prior to February 15, 1972 ("pre-1972 sound
 16 recordings"). (*See* ECF 48 at 5-7 and 21-31; Wilson (ABS) Decl. ¶ 2; Kartiganer
 17 (Barnaby) Decl. ¶ 2; Tarnopol Decl. (Brunswick) ¶ 2; Couch (Malaco) Decl. ¶ 2.)
 18 These sound recordings capture the original studio performances by, among other
 19 artists, Al Green, Andy Williams, the Chi-Lites, Jackie Wilson, Ray Stevens, the
 20 Everly Brothers, the Chordettes and King Floyd. (*Id.*) For decades, Plaintiffs have
 21 been engaged in the business of distributing, selling and licensing the reproduction,
 22 distribution, sale and performance of sound recordings for use in (among other things)
 23 albums, CDs, audiovisual works, and for streaming and downloading over the Internet
 24 (Wilson Decl. ¶ 5; Kartiganer Decl. ¶ 5; Tarnopol Decl. ¶ 5; Couch Decl. ¶ 5.)

25 Plaintiffs' pre-1972 recordings, recorded in the analog format—the digital
 26 format did not exist at the time— are the final mixed sound recordings of an artist's
 27 performance (commonly referred to as the "master recordings"). (Wilson Decl. ¶ 3;
 28 Kartiganer Decl. ¶ 3; Tarnopol Decl. ¶ 3; Couch Decl. ¶ 3). Plaintiffs (or their

1 predecessors) then applied the “mastering process” to each of the pre-1972 recordings
2 to create a copy optimized for the vinyl record format—sometimes referred to as the
3 “duplication master.” (*Id.*) The duplication master and the master recording are
4 identical in that both embody the identical performance and final mix of the musical
5 artist, as originally fixed. (*Id.*)

6 Plaintiffs had similar copies made from the master recording to serve as the
7 duplication master for other formats, including analog cassette tapes and 8-track tapes
8 (applying the “mastering process” again, sometimes referred to as “remastering”) in
9 order to optimize the pre-1972 sound recording for the applicable format. (Wilson
10 Decl. ¶ 4; Kartiganer Decl. ¶ 4; Tarnopol Decl. ¶ 4; Couch Decl. ¶ 4.) With the
11 advent of digital recording, Plaintiffs created a digital transfer copy of each of the pre-
12 1972 recordings. (*Id.*) Although advancements in recording technology allowed for
13 mechanical processing adjustments to optimize the recording for the new formats, the
14 remastering of Plaintiffs’ sound recordings did not include remixing, editing,
15 resequencing, adding new sound or removing sounds. (Geluso Decl. ¶¶ 10, 25.)
16 Thus, the “remastered” sound recordings remained identical to the originally mastered
17 recording in that the actual sounds of the artist’s performances fixed in the originally
18 mastered recording are the same as the actual sounds of the artist’s performances fixed
19 in the remastered recording—with only mechanical adjustments made to optimize the
20 sound in the new format. (Geluso Decl. ¶ 25.)

21 For some pre-1972 sound recordings, Plaintiffs granted licenses allowing for
22 the distribution of the recordings, including distribution as part of “compilation
23 albums” with other sound recordings. (Wilson Decl. ¶ 6; Kartiganer Decl. ¶ 6;
24 Tarnopol Decl. ¶ 6; Couch Decl. ¶ 6.) Such licenses, however, only allowed the
25 licensee to reproduce and distribute Plaintiffs’ recordings and not to create a
26 derivative work or to make any substantial, non-trivial changes to the sound of these
27 recordings. (Wilson Decl. ¶ 6, 12; Kartiganer Decl. ¶ 6, 12; Tarnopol Decl. ¶ 6, 12;
28 Couch Decl. ¶ 6, 12.) For example, Plaintiffs licensed sound recordings to Rhino

1 Entertainment Company (“Rhino”) for distribution, which, in some cases, Rhino may
 2 have remastered them for its compilation albums in digital formats, including CD.¹
 3 As explained by Robert Emmer, Rhino’s then Executive Vice President and Head of
 4 Business and Legal Affairs, Rhino was never authorized to create, nor claimed to have
 5 created, a derivative work from any of Plaintiffs’ pre-1972 sound recordings.²
 6 (Emmer Decl. ¶ 5.) Thus, Rhino never claimed any ownership or copyright interest in
 7 any of the remastered recordings of Plaintiffs’ works.³ (*Id.* at ¶¶ 5-7.)

8 Plaintiffs retained all right, title and interest in the ownership of their respective
 9 pre-1972 sound recordings. These ownership rights extend to all remastered
 10 _____

11 ¹ In his declaration accompanying CBS’s motion, William Inglot testifies that he
 12 did remastering for Rhino with respect to some of Plaintiffs’ pre-1972 sound
 13 recordings. (*See* Declaration of William Inglot, at ¶¶ 35-59.) But Mr. Inglot does not
 14 know whether any of Plaintiffs’ pre-1972 sound recordings that were remastered by
 15 him were the copies that CBS played over the air or through Internet streaming.
 (Inglot Dep., 32:4-12; Ex. 8 (all Deposition Exhibits are attached to the Block
 Declaration unless noted otherwise).)

16 ² In 1971, Congress amended the copyright act to include protection for sound
 17 recordings “fixed, published, and copyrighted or and after [February 15, 1972].”
 Sound Recording Act of 1971, Pub. L. No. 92-140, 85 Stat. 391, § 3 (1971). Sound
 18 recordings fixed prior to February 15, 1972 remained protected under state law. *See*
 19 17 U.S.C. § 301(c).

20 ³ Likewise, Mr. Inglot testified that he never claimed a federal copyright for any
 21 remastering work he did. (Inglot Dep., 30:16-31:5; Ex. 8) Mr. Inglot also testified
 22 that, in remastering Plaintiffs’ pre-1972 sound recordings, he never did any remixing,
 23 editing, resequencing, or adding sounds or deleting sounds. (Inglot Dep., 55:3-14;
 56:18-57:13, 77:23-78:20; Ex. 8) Nor does Mr. Inglot dispute Plaintiffs’ ownership
 24 claims in the sound recordings at issue. (Inglot Dep., 46:12-14; Ex. 8) In fact, Mr.
 25 Inglot readily admits that he used the sounds of Plaintiffs’ original master recordings
 26 in the remasters. (Inglot Dep., 57:25-58:12.) While Mr. Inglot declared that he made
 “significant and noticeable alternations and modifications” in the remastering process,
 (Inglot Decl. ¶ 34), he admitted that he could not recall any specific change to a
 27 particular recording (Inglot Dep., 98:18-99:6; Ex. 8) and that his alternations and
 28 modifications amounted to nothing more than “doing a good job” according to his
 subjective determination. (Inglot Dep., 103:12-23; Ex. 8.)

1 recordings distributed under license, whether by Rhino or others, and regardless of the
2 format onto which the recordings were remastered or the medium on which they were
3 stored. (Wilson Decl. ¶¶ 6, 9-12; Kartiganer Decl. ¶¶ 6, 9-12; Tarnopol Decl. ¶¶ 6, 9-
4 12; Couch Decl. ¶¶ 6, 9-12.)

5 CBS does not offer any admissible evidence that any other entity claims
6 ownership in a remastered copy of Plaintiffs’ pre-1972 sound recordings. To make up
7 for the lack of evidence, CBS offered declarations from two employees—Seth Neiman
8 and Jeff Sottolano—for facts those witnesses subsequently admitted they knew
9 nothing about. In sworn declarations written by CBS attorneys, these witnesses
10 testified that various entities claimed post-1972 “sound recording copyrights” in the
11 remasters of Plaintiffs’ pre-1972 sound recordings. (*See* Neiman Decl. ¶ 13 (“In many
12 cases the liner notes show that a separate copyright registration is being claimed for
13 the new sound recordings well after 1972”) and ¶¶ 14-63; Sottolano Decl. ¶ 10 (same)
14 and ¶¶ 11-28.) Yet, when confronted at deposition with the actual copyright
15 registrations for the CD compilation album (which show copyrights in the artwork,
16 liner notes and for the compilation album itself, *but not any copyrights in the included*
17 *sound recordings that are the subject of this action*),⁴ both witnesses were forced to
18 admit that they, in fact, had no knowledge as to whether “sound recording copyrights”
19 were claimed in any of the remastered copies of the works. (Neiman Dep., at 144:13-
20 146:3; 158:5-160:16; Ex. 4; Sottolano Dep., at 99:20-110:2; Ex. 5.) Worse, both
21 declarants were unfamiliar with copyright notices in general and conceded that they
22 never reviewed the actual copyright registrations for the CD compilation album at
23 issue before signing their declarations. (*Id.*) More troubling, neither Messrs. Neiman
24 nor Sottolano could explain why they testified under penalty of perjury that “sound
25 recording copyrights” existed in the remastered works when each admitted he had no
26

27 ⁴ Exemplary copyright registrations for the CD liner notes cited in the Neiman and
28 Sottolano declaration are attached as Exhibit 10 to the Block Decl.

1 information on which to base that sworn testimony. (Neiman Dep., at 153:3-158:4;
2 Sottolano Dep., at 100:3-109:8; Ex. 5.)

3 **B. CBS Publicly Performed Remastered Copies of Plaintiffs' Pre-1972**
4 **Sound Recordings**

5 In the First Amended Complaint, Plaintiffs collectively identified 174
6 exemplary pre-1972 sound recordings owned by them, which they contend CBS
7 publicly performed without consent. (*See* ECF 48, at 21-31.) Plaintiffs contend that
8 CBS publicly performed these recordings in two ways:

9 *First*, CBS digitally streamed Plaintiffs' sound recordings over the Internet
10 from the CBS-owned website, Radio.com. CBS streams sound recordings on
11 Radio.com from two sources through servers maintained in New York City (Neiman
12 Dep., at 18:14-19:4; Ex. 4; Response to Interrogatory No. 4; Ex. 13.): One source
13 originates from CBS's own "exclusive," Internet-only stations—which CBS creates
14 and programs for Internet streaming. (Neiman Dep., at 25:16-25; Ex. 4.) The other
15 source originates from "simulcasts" of CBS terrestrial radio AM, FM and HD radio
16 broadcast stations located in the United States. Through the Radio.com website, a
17 user can listen to simulcasts of all 80 CBS-owned music radio stations from anywhere
18 in the United States. (Neiman Dep., at 25:19-27:9, 76:5-24; Ex. 4.) Every song that
19 CBS broadcasts from any CBS-owned radio station in the United States, as well as
20 every song played over CBS's "exclusive" Internet radio stations, are streamed from
21 New York, and can be accessed anywhere in the United States through a web browser
22 or smart phone application.

23 *Second*, CBS broadcasts Plaintiffs' pre-1972 recordings over terrestrial
24 airwaves from CBS-owned radio stations in California and elsewhere by traditional
25 AM and FM signals and by HD signals on HD Multicast stations. (Sottolano Decl. ¶
26 2).

27 CBS admits that it broadcast or streamed at least 57 sound recordings that
28 Plaintiffs' claim to own. Substantial evidence shows that CBS broadcast or streamed

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1 significantly more. CBS’s records of the sound recordings it publicly performed
2 demonstrate that it performed at least 100 of Plaintiffs’ pre-1972 sound recordings
3 during the period commencing four years prior to this litigation. (Block Decl. ¶¶ 5-
4 23.)

5 **C. CBS Lacked Authorization or the Legal Right to Broadcast or**
6 **Stream Copies of Plaintiffs’ Pre-1972 Sound Recordings**

7 CBS does not contend that Plaintiffs (or anyone else) licensed or authorized it
8 to publicly perform the remastered copies of Plaintiffs’ pre-1972 sound recordings.
9 Rather, CBS’s motion is premised on the assertion that the copies of Plaintiffs’ sound
10 recordings that CBS used to broadcast or stream is covered by federal copyright law,
11 not state law.

12 CBS’s assertion is wrong. Under the facts and law, federal copyright law does
13 not cover the remastered copies of Plaintiffs’ pre-1972 sound recordings. CBS’s self-
14 styled “threshold issue” has no legal relevance: Contrary to CBS’s issue, application
15 of federal copyright law does not turn on “whether any ‘remastered’ or ‘reissued’
16 recording is *identical* to the original pre-1972 recordings plaintiffs claim to own”—
17 and Plaintiffs never “acknowledged” so. (Mot. at 7 (emphasis added).) Converting
18 sound recordings from one format into another, along with mechanical sound
19 adjustment to optimize the copy for the new format, does not create a new derivative
20 work protectable under copyright law. Indeed, the U.S. Copyright Office’s Circular
21 No. 56—the same publication CBS relies on⁵—expressly states that the “preexisting
22 recorded sounds must have been rearranged, remixed, or otherwise altered in sequence
23 or character, or there must be some additional new sounds” before a new, derivative
24 work copyright will attach. If the law were otherwise, the owner of a sound recording
25

26 ⁵ Mot at 5 (citing U.S. Copyright Office, Library of Congress, Circular No. 56,
27 *Copyright Registration of Sound Recordings* (2014) at 3 (attached as Ex. 4 to Strabone
28 Decl.))

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1 could extend copyright protection indefinitely by continuing to remaster a work into
2 new formats.

3 CBS admits that remastered pre-1972 sound recordings are not subject to
4 federal copyright protection where the remastering process is “merely mechanical.”
5 (Mot. at 5.) Yet, to the extent that CBS publicly performed remastered copies of
6 Plaintiffs’ pre-1972 sound recordings, such remastered copies were simply digital
7 conversions optimized for the digital formats using only mechanical processing. CBS
8 does not offer any evidence that any of the remastered copies of Plaintiffs’ pre-1972
9 sound recordings in its possession have been remixed, edited, re-arranged, altered or
10 modified with new sounds. Thus, the remastered copies are not subject to federal
11 copyright protection.

12 **III. CBS IS NOT ENTITLED TO SUMMARY JUDGMENT**

13 CBS does not dispute that Plaintiffs own the sound recordings of performances
14 identified in Schedules A1-A4 of the First Amended Complaint. Nor does CBS
15 dispute that it maintains at least 57 of those sound recordings on its servers and has
16 broadcast or streamed those recordings. CBS’s sole defense—that it broadcast and
17 streamed “remastered” copies of Plaintiffs’ sound recordings in a digital format rather
18 than the “identical” pre-1972 recording in the original vinyl format—does not excuse
19 its unlawful exploitation. CBS’s copies of the performances are still pre-1972 sound
20 recordings—regardless of the conversion from the analog to digital and regardless of
21 mechanical remastering process to optimize the sound for that digital medium.

22 **A. Substantial Evidence Confirms that CBS Played Plaintiffs’ Sound**
23 **Recordings**

24 CBS contends that it is entitled to summary judgment because “plaintiffs have
25 no basis for claiming that CBS publicly performed [the vast majority of the songs that
26 plaintiffs have put at issue in this case].” (Mot. at 7.) Not true. Substantial evidence
27 exists, proving by a preponderance of the evidence (or at least creating a genuine issue
28 of material fact) that CBS publicly performed at least 57 of Plaintiffs’ pre-1972 sound

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1 recordings either over the Internet on CBS’s Radio.com website (via streaming
2 Internet-only stations or simulcasts of CBS’s U.S. terrestrial radio stations) and over
3 the airwaves on CBS’s terrestrial radio stations (FM, AM, and HD Multicast) during
4 the four years prior to Plaintiffs filing this lawsuit.

5 **1. CBS Does Not Dispute That It Played 57 Of Plaintiffs’**
6 **Remastered Sound Recordings**

7 CBS does not dispute that it publicly performed at least 57 remastered copies of
8 Plaintiffs’ pre-1972 sound recordings during the relevant time period over the Internet
9 on Radio.com and terrestrial radio broadcasts.

10 In response to a request that CBS identify which of the pre-1972 sound
11 recordings identified in Schedules A1-A4 of Plaintiffs’ First Amended Complaint that
12 CBS publicly performed during the past four years, CBS’s counsel stated that, based
13 on their review of “the records produced,” “we believe that there are 57 songs that
14 may have been played by CBS.” (Email from A. Gressel of January 7, 2016; Block
15 Decl. ¶ 4; Ex. 2 to Block Decl.) CBS provided Plaintiffs with lists identifying those
16 57 songs. (*Id.*) In January 2016, when CBS provided this information, it had only
17 produced Mediabase records (Mediabase is a third party service that monitors
18 recordings performed by radio stations), identifying songs CBS publicly performed on
19 its terrestrial radio stations in New York and California and produced records
20 identifying the recordings publicly performed on Radio.com’s Internet stations and/or
21 stored on Radio.com’s database of recordings for the Internet stations. (Block Decl. ¶
22 4). CBS had not produced reports identifying all of the recordings that were simulcast
23 over Radio.com. (*Id.*)

24 CBS’s admission that there are 57 recordings that “may have been played by
25 CBS” is, at the very least, sufficient to create a genuine issue of material fact that CBS
26 publicly performed these 57 pre-1972 sound recordings in California during the
27 relevant time period. These facts preclude summary judgment as to these 57 sound
28 recordings.

1 Other facts provided by CBS *with its motion* prove that CBS publicly
2 performed 60 of Plaintiffs' sound recordings on Radio.com's exclusive Internet
3 stations and on terrestrial radio broadcasts. (Block Decl. ¶¶ 5-17). With respect to its
4 Internet stations, CBS's Director of Digital Audio, Seth Neiman, testified that every
5 recording that is played on Radio.com's exclusive streaming stations is tracked on
6 CBS's digital library system called Radio 2.0, and that CBS runs reports to collect this
7 information for reporting to SoundExchange for royalty payment purposes, as CBS is
8 legally required to do for post-1972 sound recordings. (Neiman Dep., at 13:14-19:24;
9 Ex. 4.) In his declaration, Mr. Neiman describes how CBS's employees reviewed
10 those records to determine which of the recordings listed on Plaintiffs' Schedules A1-
11 A4 were publicly performed on Radio.com (on the exclusive stations only) in the four
12 years prior to the filing of the complaint (Neiman Decl. ¶ 7). CBS's review
13 determined that there is no record of CBS publicly performing 114 (of the 174) of
14 Plaintiffs' recordings (Neiman Decl. ¶¶ 8-11), which means that there are records
15 produced by CBS showing that it publicly performed 60 of Plaintiffs' recordings on
16 CBS's exclusive Internet stations during the four years prior to the filing of the
17 complaint. (Neiman Decl. ¶ 12; Block Decl. ¶¶ 5-11). As discussed below, CBS
18 "made available" these performances in California. These facts preclude summary
19 judgment as to these sound recordings.

20 With respect to its terrestrial radio broadcasts, CBS's Vice President of
21 Programming, Jeffrey Sottolano, testified that CBS does not itself maintain any
22 records that would identify the sound recordings that are publicly performed by any of
23 its radio stations. (Sottolano Dep., at 42:14-16; Ex. 5.) Instead, Mr. Sottolano relies
24 on Mediabase reports to know which recordings CBS publicly performed on its radio
25 stations. (Sottolano Dep., at 36:11-14; Ex. 5.) Mediabase employs human listeners to
26 track and record the recordings that are publicly performed on the radio stations being
27 monitored by Mediabase. (Sottolano Dep., at 34:18-23; Ex. 5.) Mr. Sottolano
28 testified that he has no reason to believe that Mediabase's records for any particular

1 sound recording are wrong. (Sottolano Dep., at 80:23-81:8; Ex. 5.) In connection
 2 with its Motion, CBS's employees reviewed Mediabase reports for each of its
 3 California stations to determine which of the pre-1972 sound recordings listed in
 4 Plaintiffs' schedules CBS may have publicly performed in the four years before the
 5 filing of the complaint, and they determined that there is no record of CBS's
 6 California radio stations publicly performing 161 recordings (Sottolano Decl. ¶¶ 4-7),
 7 which means that Mediabase's records identified 13 of the recordings identified on
 8 Plaintiffs' Schedules that were publicly performed on CBS's California radio stations
 9 during the four years prior to the filing of the complaint. (Block Decl. ¶¶ 12-16).
 10 Again, these facts preclude summary judgment as to these 13 of Plaintiffs' sound
 11 recordings.

12 **2. Triable Issues Of Fact Exist As To CBS's Public Performance**
 13 **Of Plaintiffs' Other Sound Recordings**

14 Additional, substantial evidence supports the finding that CBS publicly
 15 performed another 40 of Plaintiffs' sound recordings, meaning that a material fact
 16 dispute exists as to whether CBS publicly performed a total of 100 of Plaintiffs' sound
 17 recordings during the four years prior to the filing of the complaint. (Block Decl. ¶¶
 18 20-23.)

19 Neither Mr. Sottolano nor Mr. Neiman address in their Declarations public
 20 performances by CBS of Plaintiffs' sound recordings on any of CBS's simulcast
 21 broadcasts. Mr. Neiman testified at his deposition on March 9, 2016 that CBS has
 22 records, created by a third party called Triton, identifying the songs that are publicly
 23 performed on its terrestrial radio station simulcasts over Radio.com.⁶ (Neiman Dep.,
 24 at 28:18-31:22; Ex. 4.) ("Triton Reports"). Despite having stipulated on November
 25 30, 2015 in the Joint Report of Rule 26 Meeting of Counsel (ECF 66) that it would

26 _____
 27 ⁶ CBS' statement that: "For its terrestrial radio service, no playlist records exist"
 28 (Mot. at 9) is therefore false.

1 collect and produce any such data and despite stating in a February 19, 2016 response
2 to Interrogatory No. 17 that Triton tracked CBS's Internet simulcasts of terrestrial
3 stations and that it was "in the process of gathering relevant documents," CBS did not
4 produce the Triton Reports to Plaintiffs until March 24, 2016, after Plaintiffs were
5 forced to raise this issue with the New York court. (Block Decl. ¶¶ 19-20; Ex. 13)

6 On March 24, 2016, CBS produced what it purports to be the Triton Reports for
7 CBS's simulcast stations on Radio.com for the time period from October 2011 to
8 August 2015. (Block Decl. ¶ 20.) CBS has represented that the Triton Reports are
9 compiled by Triton using CBS's data and then CBS submits the Reports to
10 SoundExchange. (Block Decl. ¶ 20) Plaintiffs' counsel conducted searches of the
11 Triton Reports produced by CBS and determined that 90 of Plaintiffs' sound
12 recordings were identified in the Triton Reports and therefore were either publicly
13 performed on a CBS terrestrial radio station (and simulcast by CBS over Radio.com to
14 listeners throughout the U.S.) or on an Internet-only station through Radio.com, or
15 both. (Block Decl. ¶ 21; Ex. 7). Thus, based on Messrs. Sottolano's and Neiman's
16 declarations and the Triton Reports, there is evidence that CBS has publicly
17 performed— on its terrestrial radio stations in California, simulcast on Radio.com
18 from its terrestrial radio stations nationwide, and/or streamed through its Internet-only
19 stations on Radio.com—at least 100 of Plaintiffs' pre-1972 sound recordings. (Block
20 Decl. ¶ 23.) The Triton Reports are substantial evidence of CBS's publicly
21 performing Plaintiffs' sound recordings, which precludes summary judgment.

22 **B. CBS Is Liable For "Making Available" Plaintiffs' Sound Recordings**

23 CBS is also liable for making Plaintiffs' pre-1972 sound recordings available
24 for public performance through their availability for broadcast by each of terrestrial
25 radio stations and through streaming on Radio.com. Although pre-1972 sound
26 recordings are not subject to federal copyright law and instead are creatures of
27 common law and California statutory law, the "make available" test for liability under
28

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1 the federal copyright laws should apply with equal force to California state common
2 and statutory law.

3 Courts have held that making copyrighted works available violates the
4 copyright owner’s distribution rights. *Hotaling v. Church of Jesus Christ of Latter-*
5 *Day Saints*, 118 F.3d 199 (4th Cir. 1997). In *Hotaling*, a public library made several
6 unlawful copies of the plaintiff’s work available on microfiche. The library did not
7 keep records on the public’s use of the microfiche, so that plaintiff was unable to
8 prove that anyone had actually used the unlawful copies. *Id.*, at 203. Nonetheless,
9 the court held that sufficient evidence existed to establish that the library distributed
10 the work. “When a public library adds a work to its collection, lists the work in its
11 index or catalog system, and makes the work available to the borrowing or browsing
12 public, it has completed all the steps necessary for distribution to the public.” *Id.*
13 Were this not the case, “a copyright holder would be prejudiced by a library that does
14 not keep records of public use, and the library would unjustly profit by its own
15 omission.” *Id.*

16 The Ninth Circuit also has held that making works available constitutes
17 infringement. *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1014 (9th Cir.
18 2001) (“Napster users who upload file names to the search index for others to copy
19 violate plaintiffs’ distribution rights.”); *see also Perfect 10, Inc. v. Amazon.com, Inc.*,
20 508 F.3d 1146, 1162 (9th Cir. 2007) (recognizing the “‘deemed distribution’ rule” in
21 *Napster*); *Perfect 10, Inc. v. Rapidshare A.G.*, 2010 U.S. Dist. LEXIS 146053, at *9
22 (S.D. Cal. May 18, 2010) (“The *Amazon.com* decision implies that where an entity has
23 a collection of infringing materials and makes those materials available to the public,
24 it is deemed to have distributed those materials for purposes of 17 U.S.C. § 106(3).”);
25 2-8 Nimmer on Copyright § 8.11[D][5] (“[C]opyright infringement cases against
26 filesharing defendants should be construed to state a prima facie case for violation of
27
28

1 the distribution right simply by proof that the defendant in suit made the copyrighted
2 works available to the world in the peer-to-peer environment.”).⁷

3 The same rationale for making musical works available for reproduction or
4 distribution applies for public performance, which is also among the ownership rights
5 to sound recordings. The Central District of California has agreed—holding that the
6 possession of plaintiffs’ copyrighted works within the defendant’s publicly available
7 karaoke machines violated plaintiffs’ exclusive public performance rights, even
8 though the defendant kept no record of which works were actually performed. *Elohim*
9 *EPF USA, Inc. v. Total Music Connection, Inc.*, No. 14-CV-02496-BRO, ECF. No.
10 197 at 22 (C.D. Cal. Oct. 1, 2015)⁸ (“[I]f Plaintiffs do indeed possess the exclusive
11 right to publicly perform and display the musical compositions at issue, Defendants
12 violated those rights by making the works available to the public in the indexes and
13 songbooks of the karaoke machines placed within the private rooms in Defendants’
14 establishments.”).

15
16
17 ⁷ A number of district courts also have followed the “deemed distribution” rule in
18 finding liability when copyrighted material is merely made available to others. *See*
19 *TIMPCO, LLC v. Implementation Servs., LLC*, 2010 U.S. Dist. LEXIS 103668, at *9
20 (S.D. Ind. Sep. 29, 2010) (“The Seventh Circuit has held that merely making
21 copyrighted material available to others is an act of copyright infringement.”); *UMG*
22 *Recordings, Inc. v. Alburger*, 2009 U.S. Dist. LEXIS 91585, at *10 (E.D. Penn. Sep.
23 30, 2009) (“an individual violates the exclusive-distribution right by ‘making
24 available’ that illegally downloaded work to other internet users.”); *Capitol Records,*
25 *LLC v. Seydou Kouyate*, 2008 U.S. Dist. LEXIS 118536, at *17 (N.D. Ind. June 19,
26 2008) (“[U]nauthorized sharing of sound recordings by making them available to
27 others have been assumed by the Seventh Circuit and the United States Supreme
28 Court to be acts of reproduction and distribution”); *Atl. Recording Corp. v. Anderson*,
2008 U.S. Dist. LEXIS 53654, at *9 (S.D. Tx. Mar. 12, 2008) (“[M]aking copyrighted
works available for download via a peer-to-peer network contemplates ‘further
distribution,’ and thus constitutes a violation of the copyright owner’s exclusive
‘distribution’ right”).

⁸ Attached as Exhibit 11 to Block Decl.

1 CBS admittedly keeps a list of every sound recording contained in its “audio
2 vault” servers for each terrestrial radio station and for its Radio.com exclusive station
3 servers. (Neiman Dep., at 23:7-15; Ex. 4; Neiman Decl. ¶ 6; Sottolano Dep., at 17:9-
4 17; 25:14-26:22; 48:1-6; Ex. 5.) CBS also understands that people in California will
5 access recordings performed on Radio.com, as CBS includes on Radio.com specific
6 privacy information pertinent only to California residents (Block Decl. ¶ 24). Thus,
7 even if CBS lacked records showing which songs it actually broadcast from its
8 terrestrial radio stations, simulcast from those stations, or streamed through its
9 exclusive Radio.com stations (which is not the case), CBS is still liable for taking all
10 the steps necessary for public performance of each sound recording in its databases
11 belonging to Plaintiffs. *See Arista Records, Inc v. MP3Board, Inc.*, 2002 U.S. Dist.
12 LEXIS 16165, at *14 (S.D.N.Y. Aug. 29, 2002) (“a copyright holder may not be
13 required to prove particular instances of use by the public when the proof is
14 impossible to produce because the infringer has not kept records of public use”).

15 **C. The Remastered Copies That CBS Performed Are Pre-1972 Sound**
16 **Recordings Governed Under California, Not Federal, Law**

17 Cal. Civ. Code § 980(a)(2) provides: “The author of an original work of
18 authorship consisting of a sound recording *initially fixed* prior to February 15, 1972,
19 has an exclusive ownership therein until February 15, 2047, as against all persons . . .
20 .” (emphasis added.) CBS does not dispute that Plaintiffs’ master recordings capture
21 performances that were *initially fixed* before February 15, 1972. CBS also does not
22 dispute that the vast majority of the sound recordings at issue that it broadcasted and
23 streamed are remastered copies of the exact same pre-1972 performances. Instead,
24 CBS premises its motion on a legally-flawed argument that it played post-1972 sound
25 recordings rather than Plaintiffs’ pre-1972 sound recordings because the copies in its
26 audio files had been remastered to a digital format.

27 But remastering sound recordings from one format to another, along with
28 mechanical processing to optimize the recording for the new format, does not convert

1 a pre-1972 sound recording into a post-1972 sound recording. Converting a pre-1972
 2 sound recording into a derivative work governed under federal copyright law requires
 3 more than mechanical optimization—it requires, at the very least, remixing, editing,
 4 re-sequencing, or the addition of new sounds. CBS does not offer any evidence of
 5 such changes. Its expert only determined through his “tests” that the remastered
 6 sound recordings are not “identical” to Plaintiffs’ original. That is not enough to
 7 convert Plaintiffs’ pre-1972 sound recordings into post-1972 works—even if the law
 8 allowed the creation of federally-protected derivative works from pre-1972 sound
 9 recordings—which the Ninth Circuit has rejected.

10 ***1. Remastering pre-1972 Sound Recordings Does Not Convert***
 11 ***Them Into Post-1972 Sound Recordings***

12 CBS is wrong on the law. Remastering a pre-1972 sound recording does not
 13 convert it into a post-1972 sound recording or create a derivative work protectable
 14 under the federal copyright act—even if the remastered copy is not “identical” to the
 15 original master recording.

16 CBS fails to cite, much less acknowledge, the only case that addressed this
 17 exact issue and squarely held that remastering a pre-1972 sound recording does not
 18 convert it into a new sound recording subject to federal copyright law. *Capitol*
 19 *Records, Inc. v. Naxos of Am., Inc.*, 4 N.Y.3d 540, 564-65 (2005). The *Naxos* case
 20 began in 1999, when Naxos, without permission, began to reproduce and distribute
 21 restorations of Capitol Records’ original recordings of certain musical performances
 22 from the 1930s, which had been embodied in shellac phonorecords. Capitol Records
 23 sued Naxos in federal court for violation of its state common law rights in the original
 24 recordings. The parties agreed that the restorations were covered by state common
 25 law and not federal law even though the restorations “involved artistic choices and the
 26 use of the latest digital software,” for which “Naxos needed to employ significant
 27 effort to create an entirely new and commercially viable product,” and “Naxos worked
 28 to create a new product with superior sound.” *Capitol Records, Inc. v. Naxos of Am.*,

1 *Inc.*, 262 F. Supp. 2d 204, 208-09, 214, 215 (S.D.N.Y. 2003). But applying New
2 York common law, the court dismissed, rejecting Capitol’s claims.

3 On appeal, the Second Circuit certified to the New York Court of Appeals the
4 question of whether Naxos had independently created a “new product” from Capitol’s
5 original sound recordings when it converted from the shellac medium to digital.
6 *Capitol Records, Inc. v. Naxos of Am., Inc.*, 372 F.3d 471, 481 (2d Cir. 2004). In
7 response, the New York Court of Appeals held that Naxos’ digitally re-mastered
8 copies of Capitol’s recordings were “pre-1972 recordings” subject to protection under
9 the common law of New York State. *Naxos*, 4 N.Y.3d at 564. In so holding, the court
10 found that Capitol’s claims could not be defeated based on Naxos’ alleged creation of
11 a new product: “[T]he ‘[i]ndependent creation’ of a new product ‘[can]not consist of
12 actual copying’ of an entire work.” *Id.* at 564 (quoting *Durham Indus., Inc. v Tomy*
13 *Corp.*, 630 F.2d 905, 910 (2d Cir 1980)).⁹

14 *Naxos* follows a long line of decisions holding that a change in the medium of
15 expression of a work does not change its legal status, even if there are changes to
16 accommodate the new medium.¹⁰ Likewise, courts have consistently agreed that re-

18 ⁹ The court further found that even if the remastering had created a “new product”
19 subject to federal copyright, Capitol still maintained state common law rights in the
20 “performances embodied on the shellac records” to the extent Naxos’ remasters
21 “utilize[d] the original elements of the protected performances.” *Id.* at 564-65 & n.11.
22 Under this reasoning, CBS’s motion fails for an independent reason: Even if the
23 remastered copies of Plaintiffs’ sound recordings were subject to federal copyright
24 protection, Plaintiffs would still maintain a separate California property interest in the
performances embodied in the remastered copies, which CBS infringed when it
publicly performed them.

25 ¹⁰ See *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 502 (2001) (“the ‘transfer of a work
26 between media’ does not ‘alter the character of’ that work for copyright purposes”);
27 *Durham*, 630 F.2d at 909 (a change in medium does not affect a copyrighted work’s
28 status); *Entm’t Research Grp., Inc. v. Genesis Creative Grp., Inc.*, 122 F.3d 1211,
1219-20 (9th Cir. 1997) (“making decisions that enable one to reproduce or transform
an already existing work into another medium or dimension - though perhaps quite

1 recording a sound recording cannot meet the originality requirements necessary to
 2 constitute a derivative work.¹¹ As discussed, the U.S. Copyright Office also agrees
 3 that mechanically processing a pre-1972 sound recording into a new format, without
 4 substantively editing the underlying performance, does not create a post-1972
 5 derivative work.¹²

6 CBS relies on two inapposite cases, neither of which involved pre-1972 sound
 7 recordings. First, CBS cites *Maljack Productions v. UAV Corp.*, 964 F. Supp. 1416
 8 (C.D. Cal. 1997). *Maljack* did not involve remastered sound recordings and, contrary
 9 to CBS's assertions, the court did not hold that a soundtrack was eligible for copyright
 10 protection as a new work because it had simply been "remastered." Instead, *Maljack*
 11 involved a "pan and scan" edited version of the 1962 motion picture *McClintock!*,
 12 created to prepare the film for video distribution and television. In creating the 1993
 13 version, in addition to the "pan and scan" changes, plaintiff significantly edited and
 14 changed the film's soundtrack by remixing, resequencing, sweetening, equalizing,
 15 balancing and stereoizing it, and also adding entirely new sound material. *Id.* at 1418.
 16 In a challenge to the plaintiffs' copyright registration of the "pan and scan" version,
 17 the district court found the film, inclusive of the soundtrack, subject to federal

18
 19 difficult and intricate decisions - is not enough to constitute the contribution of
 20 something 'recognizably his own'); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486,
 21 489 (2d Cir. 1976) (plastic model copy of cast iron Uncle Sam bank did not alter the
 22 copyright in the bank, even though there were differences between them).

23 ¹¹ See *Agee v. Paramount Communs.*, 853 F. Supp. 778, 788-789 (S.D.N.Y. 1994),
 24 *aff'd in part on other grounds, rev'd in part on other grounds*, 59 F.3d 317 (2d Cir.
 25 1995) ("Plaintiff has offered no evidence that the sounds in his recording were
 26 remixed, or that additional lyrics or musical variations were added, or that defendant
 27 took his recording and transformed it into a new original work."); *United States v.*
 28 *Taxe*, 380 F. Supp. 1010, 1013 (C.D. Cal. 1974) ("Obviously, the re-recording of a
 previously fixed song cannot meet the originality requirements . . .")

¹² U.S. Copyright Office, Library of Congress, Circular No. 56, *Copyright
 Registration of Sound Recordings* (2014) at 3 (attached as Ex. 4 to Strabone Decl.)

1 copyright protection because (taking into account the copyright registration’s
2 presumption of validity) it was part of a new audio-visual work. But the court did not
3 find that the copyright registration extended to original elements of McClintock!.
4 Rather, the court found only that the “pan and scan” version and “the sound
5 enhancements are new material protected by copyright.” *Id.* at 1428. In marked
6 contrast to the *Maljack Productions* case, this case involves no new creative
7 contribution to a work deserving of copyright protection.

8 Second, CBS cites *Pryor v. Jean*, 2014 U.S. Dist. LEXIS 143515 (C.D. Cal.
9 Oct. 8, 2014). That case concerned a 1974 sound recording of David Pryor’s
10 “Bumpin’ Bus Stop” originally contained on a “Gold Future Record” and later
11 licensed for remastering as a derivative work to Private Stock Records. Consistent
12 with the license, Private Stock, after remastering, obtained a copyright registration that
13 included the “Bumpin’ Bus Stop” musical composition. Private Stock later licensed
14 its sound recording of “Bumpin’ Bus Stop” to defendants for sampling in movies and
15 television. *Id.* at *3-5. Pryor’s heirs sued defendants for copyright infringement, but
16 the district court dismissed because heirs could not show that the samples came from
17 Pryor’s performance on the Gold Future Record (on which the heirs allegedly held a
18 copyright) as opposed to the Private Stock album— on which Private Stock held the
19 copyright and had licensed defendants. *Id.* at *11-12.¹³ Like *Maljack*, *Pryor* has no
20 application here: It is undisputed that Plaintiffs’ original master recordings and CBS’s
21 copies capture the same performance and nobody has licensed any remaster to CBS.

22 The law precluding separate copyright protection for remastered sound
23 recordings mechanically processed for optimization into a new format preserves the
24

25 ¹³ Indeed, it was undisputed that the “actual sounds” of David Pryor’s voice saying
26 the words “Step Up!,” fixed in the Gold Future recording and the Private Stock
27 recording were different. *See* Motion to Dismiss Third Amended Complaint, *Pryor v.*
28 *Jean*, No. 13-cv-02867-DDP (C.D. Cal. Dec. 13, 2013), ECF No. 36 at 8:26-9:4
(attached as Ex. 12 to Block Dec.).

1 integrity of the copyright system. If a derivative work could be created without some
 2 substantial, creative modification of the sound recording itself—through mixing,
 3 editing, resequencing, or adding/deleting sounds—the copyright duration could be
 4 extended indefinitely by continuing to remaster into new formats as technology
 5 changes. Today, an owner of a pre-1972 sound recording has rights under state law
 6 until 2067. 17 U.S.C. § 301(c). If that owner were able to claim a new copyright by
 7 remastering it in a digital format after 2000, then the copyright owner would have
 8 rights protectable under federal copyright law for the life of the author plus 70 years.
 9 17 U.S.C. § 302(a). But the scope and duration of copyright cannot be extended.
 10 *Taxe*, 380 F. Supp. at 1013 (“[A] common sense reading of the sound recording
 11 amendment of 1971 yields the same result, since the restriction of protection to works
 12 fixed after February 15, 1972, would be meaningless if works fixed before that date
 13 could gain protection simply by being re-recorded in new albums.”).

14 **2. CBS Performed Plaintiffs’ Remastered Pre-1972 Sound**
 15 **Recordings, Not New Post-1972 Sound Recordings**

16 Mr. Geluso examined each sound recording file containing a remaster of
 17 Plaintiffs’ pre-1972 works in CBS’s audio files and compared each to Plaintiffs’
 18 original sound recording. In examining the files, Mr. Geluso conducted critical listing
 19 tests, waveform analysis, and spectral analysis. From these tests, Mr. Geluso reached
 20 two dispositive conclusions: First, for 202 of the 219 sound recordings, Mr. Geluso
 21 concluded that CBS’s remastered copy contained the same performance captured in
 22 Plaintiffs’ original master sound recording. (Geluso Dec. ¶¶ 10-11, 39-55.) Second,
 23 Mr. Geluso concluded that the CBS remastered copy—while converted from an
 24 analog to digital format and optimized for the digital format—contained no remixing
 25 or editing, and that no sounds had been added or deleted sounds when compared to
 26 Plaintiffs’ original recordings. (*Id.*) To the contrary, Mr. Geluso found that Plaintiffs’
 27 original master recordings were fully embodied in the CBS remasters. (*Id.*) Mr.
 28 Geluso’s testimony in this regard is not contradicted by CBS’s declarants. Mr.

1 Geluso’s conclusions alone distinguish this case from both *Maljack* and *Pryor*, and
2 defeats CBS’s motion.

3 Even if CBS’s expert (Dr. Begault) disagreed with Mr. Geluso, that would only
4 raise a triable issue of fact precluding summary judgment. But Dr. Begault does not
5 disagree with Mr. Geluso. Indeed, Dr. Begault, after performing his tests, reached the
6 same conclusions: Plaintiffs’ original master recordings and the corresponding
7 remastered copies capture the same, pre-1972 musical performances. (Begault Dep.
8 28:12-17, 29:5-14, 112:11-24; Ex. 9; *see also* Inglot Dep. 58:5-12, 83:6-10; Ex. 8.)
9 None of Plaintiffs’ original master recordings were remixed, edited, resequenced, or
10 had sound added or deleted when remastered from the analog to digital format.
11 (Begault Dep., 114:21-25, 116:8-117:17; Ex. 9.)¹⁴ Finally, Dr. Begault agreed that the
12 performances captured in Plaintiffs’ original master recordings were embodied in the
13 remasters used by CBS. (Begault Dep., 125:20-126:18; Ex. 9.)

14 Dr. Begault reached additional conclusions with those tests, but those
15 conclusions are entirely irrelevant to whether the remastered sound recordings are
16 subject to federal copyright protection as derivative works. Dr. Begault admitted that
17 CBS’s lawyers assigned him the task to determine whether Plaintiffs’ original master
18 recordings “contain the same sound recording that CBS used.” (Begault Decl. ¶ 15;
19 Begault Dep., 13:7-15; Ex. 9.) To determine whether the files contained the “same
20 sound recording,” Dr. Begault created tests to determine whether the songs compared
21 were “recorded at the same time and with the same application of recording
22 engineering techniques” (Begault Dep., at 26:8-15; Ex. 9)—in other words, the same
23 purely mechanical process that CBS admits will not convert a pre-1972 recording into
24

25
26 ¹⁴ Dr. Begault’s testimony is not surprising in that both he and Mr. Inglot
27 conceded that “remastering” does not involve remixing, rearranging, editing, re-
28 sequencing or the addition of new materials to the original sound recording. (Begault
Dep. 114:3-25, 115:8-117:17; Ex. 9; Inglot Dep. 55:3-57:13; Ex. 8.)

1 a post-1972 derivative work. (Mot. at 5.)¹⁵ Thus, Dr. Begault’s findings that the
 2 comparisons “failed” his tests made no difference to whether CBS publicly performed
 3 Plaintiffs’ pre-1972 sound recordings.

4 Aside from Mr. Geluso’s analysis, Plaintiffs’ pre-1972 sound recordings have
 5 not been converted into post-1972 sound recording based on four additional, legally-
 6 compelling reasons:

7 *First*, a pre-1972 sound recording cannot be converted into a post-1972
 8 derivative work under Ninth Circuit law. “Under the Copyright Act, a work is not a
 9 ‘derivative work’ unless it is ‘based upon one or more preexisting works’ and, in order
 10 to qualify as a ‘preexisting work,’ the underlying work must be copyrightable.” *Ets-*
 11 *Hokin v. Skyy Spirits Inc.*, 225 F.3d 1068, 1078 (9th Cir. 2000); 1-3 Melville B.
 12 Nimmer & David Nimmer, *Nimmer on Copyright*, § 3.01. None of Plaintiffs’ original
 13 recordings are copyrightable under the Copyright Act because they were all fixed
 14 before February 1972. Thus, they are not a “pre-existing work” that can be used to
 15 create a derivative work. 17 U.S.C. § 301(c).

16 *Second*, even if a pre-1972 recording could be a “pre-existing work,” any
 17 changes during the remastering process are not independent and original expression
 18 entitled to protection. “In order for a work to qualify as a derivative work it must be
 19 independently copyrightable.” *Wood v. Bourne Co.*, 60 F.3d 978, 990-91 (2d Cir.
 20 1995); *McCormick v. Cohn*, 1992 U.S. Dist. LEXIS 21187, at *39 (S.D. Cal. July 31,
 21 1992) (“A derivative work, however, must be ‘substantially different from the
 22 underlying work to be copyrightable.’” (*quoting Gracen v. Bradford Exchange*, 698
 23 F.2d 300, 305 (7th Cir. 1983))). “Independent creation, in turn, means that a work

24
 25 ¹⁵ Tellingly, Dr. Begault also conceded that his “tests” (which were designed to
 26 prove that remastering the sound recordings into a new format involved the use of
 27 mechanical processing to digitally optimize the sounds) had never been used, to his
 28 knowledge in determining issues of copyright infringement or even described in a
 publication for such use. (Begault Dep., 102:24-104:25; Ex. 9.)

1 must not consist of actual copying.” *Durham*, 630 F.2d at 910 (quoting *L. Batlin*, 536
 2 F.2d at 490). Additionally, “there must be at least some substantial variation (from
 3 the underlying work), not merely a trivial variation.” *Id.* (quoting *Batlin*, 536 F.2d at
 4 491). Further, “the requirement of originality [cannot] be satisfied simply by the
 5 demonstration of ‘physical skill’ or ‘special training’ . . .” *Id.* (quoting *Batlin*, 536
 6 F.2d at 491). Here, CBS offers no evidence of independent and original expression,
 7 entitled to protection, in the remastered sound recordings. Both Dr. Begault and Mr.
 8 Ingot agreed that removing Plaintiffs’ original sound recording from the remastered
 9 copy would leave nothing to perceive, thus confirming that any mechanical optimizing
 10 in the format conversion process could not be independently copyrightable. (Begault
 11 Dep. 161:19-162:25; Ex. 9; Ingot Dep. 67:12-68:1; Ex. 8.)

12 *Third*, even if a pre-1972 sound recording could be a “pre-existing work” and
 13 the mechanical optimizations in the engineered copy were sufficient to constitute
 14 original and independent expression, Plaintiffs never authorized a remastering
 15 engineer to make any such alterations. 17 U.S.C. § 103(a) (“protection for a work
 16 employing preexisting material in which copyright subsists does not extend to any
 17 part of the work in which such material has been used unlawfully.”). The exclusive
 18 rights in a copyrighted work include the right to prepare derivative works based upon
 19 the copyrighted work. 17 U.S.C. § 106(2). Without the owner’s consent, however,
 20 the preparer of a derivative work cannot create a work protectable by copyright. *U.S.*
 21 *Auto Parts Network, Inc. v. Parts Geek, LLC*, 692 F.3d 1009, 1016 (9th Cir. 2012).
 22 Plaintiffs never granted a license to create derivative works when converting the pre-
 23 1972 sound recordings from analog to digital format, and CBS does not offer any
 24 evidence to the contrary. (Wilson Decl. ¶¶ 6, 9-12; Kartiganer Decl. ¶¶ 6, 9-12;
 25 Tarnopol Decl. ¶¶ 6, 9-12; Couch Decl. ¶¶ 6, 9-12; Emmer Decl. ¶¶ 3-5; Johnson
 26 Decl. ¶ 3.) Thus, none of the remastered recordings can be derivative works under
 27 federal copyright law.
 28

1 *Fourth*, even if the remastered copies of the original sound recordings
 2 constituted a derivative work under the Copyright Act, any copyright would only
 3 protect the new original and independent expression. 17 U.S.C. § 103(b) (The
 4 copyright in a derivative work “extends only to the material contributed by the author
 5 of such work, as distinguished from the preexisting material employed in the work.”);
 6 *Durham*, 630 F.2d at 909 n.6. The unauthorized use of the pre-existing material as
 7 contained in a derivative work is an infringement of the pre-existing material: “[i]t is
 8 irrelevant whether the pre-existing work is inseparably intertwined with the derivative
 9 work.” *Stewart v. Abend*, 495 U.S. 207, 223 (1990); *Gilliam v. American*
 10 *Broadcasting Cos.*, 538 F.2d 14, 20 (2d Cir. 1976) (“[C]opyright in the underlying
 11 script survives intact despite the incorporation of that work into a derivative work”).
 12 Contrary to CBS’s contentions (which its supporting witnesses disavowed in
 13 deposition), neither the distributors nor the Plaintiffs have attempted to register a
 14 federal copyright for any of the remastered copies of Plaintiffs’ pre-1972 sound
 15 recordings. (Wilson Decl. ¶¶ 13-14; Kartiganer Decl. ¶¶ 13-14; Tarnopol Decl. ¶¶ 13-
 16 14; Couch Decl. ¶¶ 13-14; Emmer Decl. ¶ 6; Johnson Decl. ¶¶ 8-9.) While some of
 17 the distributors have registered copyrights for the compilations in the album and the
 18 liner notes, the registrations confirm they do not extend to the sound recordings
 19 themselves. (*See e.g.*, Ex. 10). Thus, Plaintiffs would still retain their common law
 20 rights in the performance embedded in any derivative works.

21 **IV. CONCLUSION**

22 For the foregoing reasons, Plaintiffs respectfully request that CBS’s motion be
 23 denied.

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DATED: April 4, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 4, 2016 to all counsel of record who are deemed to have consented to electronic service via the Court’s CM/ECF system. Any other counsel of record will be served by electronic mail, facsimile, U.S. Mail and/or overnight delivery.

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