

(Doc. No. 34) is GRANTED. The Clerk is DIRECTED to enter judgment in favor of Defendant, dismissing all of Plaintiff's claims with prejudice and awarding Defendant its costs of the action. All other pending motions (Doc. Nos. 46, 47, 50, 51, 52, 53, 54) are DENIED as moot.

DONE and ORDERED.

Ory v. McDonald

U.S. District Court
Central District of California
No. CV 01-8177 NM (AIJx)
Decided August 5, 2003

COPYRIGHTS

[1] Infringement pleading and practice — Defenses — In general (§ 217.0601)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Defenses — Laches (§ 410.1803)

Plaintiff's claim for infringement of copyrighted musical composition is barred by laches, since record shows that plaintiff and her predecessor in interest knew of accused song no later than 1969, but made no demand on defendant until July 2001, since laches bars claim for instances of infringement committed within statutory limitations period, which are not alleged to have infringed plaintiff's rights differently than decades of prior alleged infringements, since plaintiff's relatively recent acquisition of copyright does not render delay reasonable, since delay has created evidentiary prejudice with respect to authorship and originality of allegedly infringed song, which are uncertain, and since delay has also created expectations-based prejudice to defendant in form of economic harm.

COPYRIGHTS

[2] Infringement pleading and practice — Willful (§ 217.10)

Defendant's assertion of laches defense in action for infringement of musical composition is not precluded by willful infringement,

since defendant's acknowledgment of some similarity between songs at issue, during course of litigation, does not establish that defendant willfully infringed copyrighted song when he wrote accused song some 36 years earlier, since there is no other evidence that defendant wrote accused song with knowledge or intention of infringing any existing copyright, and since defendant was not even on notice, before current litigation, that plaintiff claimed right in allegedly infringed song.

JUDICIAL PRACTICE AND PROCEDURE

[3] Procedure — Defenses — Laches (§ 410.1803)

REMEDIES

Non-monetary and injunctive — Equitable relief — Permanent injunctions — In general (§ 505.0709.01)

Defendant's laches defense in action for infringement of copyrighted musical composition bars plaintiff from obtaining prospective injunctive relief, since laches properly bars prospective injunction against future infringement if, as in present case, it is known in advance that defendant will be substantially prejudiced in its ability to defend against future claimed infringements in same manner that it was prejudiced with regard to prior alleged infringements.

[4] Monetary — Attorneys' fees; costs — Copyrights (§ 510.0909)

Defendant who successfully interposed defense of laches in action for infringement of copyrighted musical composition is entitled to award of attorneys' fees, since plaintiff's infringement claims, asserted after decades-long delay, were clearly unreasonable, since litigation appears motivated more by desire to "erase" defendant's song than by any concern with protecting plaintiff's recently acquired copyright, and since Copyright Act's purpose of promoting creativity for public good would be ill served by enjoining defendant from performing or profiting from accused song, which plaintiff concedes has become famous "American classic" over nearly four decades that defendant has been performing it.

Action by McDonald, Alcatraz Cornerment. On judgment. (

Neville J Los Angeles

Daniel Kusti, of Keq Norwood, Monica, Ca

Manella, J

On Sep ("Plaintiff" "Country Donald, ar copyright i Plaintiff fi against Del ment. Plair McDonald Die Rag," instrument: "Kid" Ory in 1926. C Defendant'

II. Fz

Kid Ory titled "Mudant's Sta ("UF") ¶ of Uncont Steven La. Ex. 2. Kid strong") c

1 Joe McI Music which publishing. Facts UF ¶¶ to "Country Alcatraz Cor dant."

2 The cou jections and ciding this n

3 In her F Kid Ory wrc fendant note in her Respc verted Facts that the corr

Action by Babette Ory against Country Joe McDonald, a/k/a Joe McDonald, d/b/a Alcatraz Corner Music Co., for copyright infringement. On defendant's motion for summary judgment. Granted.

Neville Johnson, of Johnson & Rishwain, Los Angeles, Calif., for plaintiff.

Daniel Kegan, Marc Fineman, and Jay Gusti, of Kegan & Kegan, Chicago, Ill.; Naomi Norwood, of Mandel & Norwood, Santa Monica, Calif., for defendant.

**Manella, J.**

### I. INTRODUCTION

On September 20, 2001, Babette Ory ("Plaintiff") initiated this action against "Country Joe McDonald," aka Joe McDonald, and Alcatraz Corner Music Co. for copyright infringement.<sup>1</sup> On January 2, 2002, Plaintiff filed a First Amended Complaint against Defendant alleging copyright infringement. Plaintiff alleges that a song written by McDonald in 1965, "I Feel Like I'm Fixin' to Die Rag," infringes "Muskrat Ramble," an instrumental written by her father, Edward "Kid" Ory in the early 1920s and copyrighted in 1926. Currently pending before the court is Defendant's motion for summary judgment.

### II. FACTUAL BACKGROUND<sup>2</sup>

Kid Ory wrote a Dixieland jazz melody titled "Muskrat Ramble" in 1921.<sup>3</sup> Defendant's Statement of Uncontroverted Facts ("UF") ¶ 1; Plaintiff's Response to Statement of Uncontroverted Facts ("UF Resp.") ¶ 1; Steven Lasker Declaration ("Lasker Decl."), Ex. 2. Kid Ory and Louis Armstrong ("Armstrong") collaborated in fathering Dixieland

<sup>1</sup> Joe McDonald does business as Alcatraz Corner Music which was established in 1972 for administrative publishing. Defendant's Statement of Uncontroverted Facts UF ¶¶ 184, 185. Hereinafter the court will refer to "Country Joe McDonald," aka Joe McDonald, dba Alcatraz Corner Music Co. as "McDonald" or "Defendant."

<sup>2</sup> The court considered Defendant's evidentiary objections and found it unnecessary to rule on them in deciding this motion.

<sup>3</sup> In her First Amended Complaint, Plaintiff alleges Kid Ory wrote "Muskrat Ramble" in 1924, a date Defendant notes as an alternate to the 1921 date. However, in her Response to Defendant's Statement of Uncontroverted Facts and Conclusions of Law, Plaintiff asserts that the correct date is 1921. UF Resp. ¶ 9.

music.<sup>4</sup> UF ¶ 4. "Muskrat Ramble" is an instrumental. UF ¶ 5. Kid Ory registered the melody of "Muskrat Ramble" with the Copyright Office in 1926. UF ¶ 9; Evidence Submitted in Support of Defendant's Motion for Summary Judgment ("Def. Evidence"), Ex. 54 (copyright record), Ex. 39 (First Amended Complaint ("FAC")) ¶ 5.<sup>5</sup> Kid Ory died in 1973. UF ¶¶ 6, 93. In October 2001, three-quarters of a century after the composition was copyrighted, Plaintiff obtained ownership of the United States copyright for "Muskrat Ramble" after filing the Complaint in this action. UF ¶ 8.<sup>6</sup> Plaintiff's predecessor in interest was George Simon Music Company. Mot. 3; Def. Evidence, Ex. 56 (George Simon Inc. Renewal Application), Ex. 35 (Termination Notice recorded at Copyright Office). Plaintiff has identified a reproduction of the "Muskrat Ramble" lead sheet by Kid Ory as the deposit copy in the Copyright Office. UF ¶ 35; Def. Evidence, Ex. 33.

Defendant created "I Feel Like I'm Fixin' to Die Rag" ("Fixin") in 1965, protesting the Vietnam War. UF ¶ 11; First Amended Complaint ("FAC") ¶ 7. "Fixin" was first published September 15, 1965. UF ¶ 12. Copyright registration 243,188 issued in 1968 for lyrics and music. *Id.* McDonald performed "Fixin" at the first Woodstock music festival in 1969. UF ¶ 13. Plaintiff alleges that

<sup>4</sup> One definition of Dixieland music is "[a] style of instrumental jazz associated with New Orleans and characterized by a relatively fast two-beat rhythm and by group and solo improvisations." Def. Evidence, Ex. 58 (American Heritage Dictionary, 3rd Ed. 1996). Plaintiff's expert Steven Lasker disagrees with this definition, asserting that many Dixieland songs contain lyrics and that can be played in a two-beat or four-beat rhythm. Lasker Decl. ¶ 4.

<sup>5</sup> Ray Gilbert created "Muskrat Ramble" lyrics in 1950, and the McGuire Sisters later did another version. UF ¶ 9; Def. Evidence, Ex. 55. The renewal certificate for the 1926 copyright of "Muskrat Ramble" notes that only a melody is claimed. UF ¶ 9; Def. Evidence, Ex. 56.

<sup>6</sup> See Def. Evidence, Ex. 35 (Muskrat Ramble Copyright Termination Notices), Ory Dep. at 108:22-110:18, Ex. 57 (Copyright Title Search Report). In her declaration, Plaintiff contradicts her deposition testimony that her registration was effective October 5, 2001 by stating that in February 1, 2001, George Simon Music assigned to her all its rights in the United States copyright of "Muskrat Ramble." Ory Decl. ¶ 11. Plaintiff provides no evidence to support this assertion. Accordingly, the court will rely upon Plaintiff's deposition testimony and the evidence provided by Defendant to establish the effective date of her registration.

"Fixin" incorporates a "portion of the musical elements" of "Muskrat Ramble," specifically a hook or riff. UF ¶ 14; FAC ¶ 7.<sup>7</sup>

Plaintiff first heard of Joe McDonald when she heard him play "Fixin" on the radio in 1968. UF ¶ 103.<sup>8</sup> After hearing "Fixin" on the radio, Plaintiff went to a record store and bought the Country Joe & The Fish album with its recording of "Fixin." UF ¶ 104. Plaintiff brought the record home and played "Fixin" for her father. Her mother called George Simon at his company that day. UF ¶ 105.<sup>9</sup> George Simon Music Company decided not to pursue the matter. Plaintiff remembers that Kid Ory was told that he would be welcome to pursue it on his own. UF ¶ 106. George Simon Music Company was aware of McDonald and "Fixin" for three decades and did nothing. UF ¶ 107. Plaintiff watched the film "Woodstock" when it was first released in 1970 or 1971, and saw McDonald singing "Fixin" in the film. UF ¶¶ 114, 115. Plaintiff knew that McDonald was in the film when it was shown on cable in 1989. UF ¶ 117. By Plaintiff's own account, "Fixin" has become McDonald's "signature song," and is an "American classic." FAC ¶ 7.

Plaintiff's work history includes employment with A&R, United Artists record company, EMI-United Artists record company, and Island record company. UF ¶ 94. She worked at Island from early 1976 through the end of 1977 in an all purpose floating position. UF ¶ 95. Plaintiff was employed by EMI from fall 1979 through the end of 1980, and then with EMI-United Artists from 1980 to spring 1982. UF ¶ 96. Her position with these entities was assistant to the head of A&R Artists Relations. UF ¶ 97. Plaintiff's most recent

<sup>7</sup> Riff is defined as "[a] short rhythmic phrase, especially one that is repeated in improvisation." Hook is defined as "[a] catchy motif or refrain." UF 15; Def. Evidence, Ex. 58 (American Heritage Dictionary, 3rd Ed. 1996).

<sup>8</sup> Plaintiff objects to this and certain other of the Uncontroverted Facts as irrelevant. The court will not make individual rulings on Plaintiff's objections, but will include only those facts it deems relevant.

<sup>9</sup> It is unclear from Plaintiff's deposition testimony and her declaration whether she first heard "Fixin," brought the record home, and played it for her father in 1968 or in 1969. Def. Evidence, Ory Dep. at 44:13-21, 46:18-21; Ory Decl. ¶ 9. Regardless, it is undisputed that at least 32 years elapsed from the time she and her father became aware of "Fixin" and McDonald was first notified of alleged infringement.

promotional work for record companies was in December 2002. UF ¶ 99.

Plaintiff remembers that her father said the "Fixin" lyrics were rude, unpatriotic, and obscene. UF ¶ 110. She recalls that he also said he "wished he could have gotten the guy and gotten his copyright and gotten ["Fixin"] erased from the planet." Ory Dep. at 117:18-22. In 1971, Kid Ory told Plaintiff he was leaving her his royalties and asked her to protect his archives and his songs from infringers. Ory Decl. ¶ 16. Following Kid Ory's death in 1973, no attempt was made to terminate the assignment to George Simon Music of "Muskrat Ramble." Def. Evidence, Ory Dep. at 73:3-5. Nor was termination attempted in the five-year period after Kid Ory died. UF ¶ 122. Plaintiff's mother had legal representation handling the arrangements for Ory's estate. UF ¶ 123. In 1978, as part of the probate of Plaintiff's mother's estate, Plaintiff's lawyers sought—and failed—to have "Muskrat Ramble" copyrighted in Plaintiff's name by terminating the copyright registration of George Simon Music.<sup>10</sup> UF ¶ 121. Plaintiff did not have her attorneys challenge the Copyright Office rejection of her 1978 attempt to register Muskrat Ramble. UF ¶ 125.<sup>11</sup>

For 36 years, McDonald performed and licensed "Fixin" and sold musical sound recordings containing "Fixin" without copyright complaint or challenge by any third party. UF ¶ 131. McDonald was first contacted regarding a claim of copyright infringement with "Muskrat Ramble" in July 2001, when Bill Belmont, the administrator of "Fixin" since 1978, was contacted by Plaintiff's current counsel. UF ¶ 131. Until July 2001, neither Plaintiff nor her predecessors-in-interest had notified McDonald that they believed McDonald's "Fixin' to Die Rag" infringed "Muskrat Ramble." UF ¶ 133. Plaintiff's father, Kid Ory, her mother, and her immediate predecessor-in-interest, George Simon Music Company, all knew of McDonald and "Fixin" as early as 1968, but none made

<sup>10</sup> Plaintiff was the sole beneficiary of her mother's estate and received legal representation from the Los Angeles firm of Parker Milliken Clark & O'Hara. UF ¶ 18.

<sup>11</sup> The rejection was based on the grounds that Mrs. Ray Gilbert, the wife of the song writer who wrote lyrics for "Muskrat Ramble" in 1950, had registered a "Muskrat Ramble" composition with music and lyrics in 1985. UF ¶ 125.

any demand  
§ 134.

II

Summar  
"the plead  
rogatories,  
with the aff  
genuine iss  
the moving  
matter of  
mary judg  
disfavored  
an integra  
whole, whi  
speedy and  
ery action.  
477 U.S.  
(Civ.P. 1).

In a trio  
clarified th  
judgment.  
*Liberty La  
Matsushita  
Radio Cor  
ing party  
strating the  
terial fact.  
governing  
fact is mat  
come, it is  
ing party s  
spect to a  
bears the l  
isfy its b  
evidence.  
party bear  
defense, th  
by pointin  
mitted by  
party need  
*See Celote**

If the m  
the "adver  
allegation:  
pleadings,  
affidavits  
must set fi  
is a genui  
56(e). W  
moving p  
court mus  
justifiable  
vor. *Ande  
v. S.H. Ki  
(1970)).*

any demand or complaint to McDonald. UF § 134.

### III. LEGAL STANDARD

Summary judgment is appropriate when “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c). Summary judgment is “properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed ‘to secure the just, speedy and inexpensive determination of every action.’” *Celotex Corporation v. Catrett*, 477 U.S. 317, 327 (1986) (quoting Fed.R.Civ.P. 1).

In a trio of 1986 cases, the Supreme Court clarified the applicable standards for summary judgment. See *Celotex*, *supra*; *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *Matsushita Electrical Industry Co. v. Zenith Radio Corp.*, 475 U.S. 574 (1986). The moving party bears the initial burden of demonstrating the absence of a genuine issue of material fact. See *Anderson*, 477 U.S. at 256. The governing substantive law dictates whether a fact is material; if the fact may affect the outcome, it is material. See *id.* at 248. If the moving party seeks summary adjudication with respect to a claim or defense upon which it bears the burden of proof at trial, it must satisfy its burden with affirmative, admissible evidence. By contrast, when the non-moving party bears the burden of proving the claim or defense, the moving party can meet its burden by pointing out the absence of evidence submitted by the non-moving party. The moving party need not disprove the other party’s case. See *Celotex*, 477 U.S. at 325.

If the moving party meets its initial burden, the “adverse party may not rest upon the mere allegations or denials of the adverse party’s pleadings, but the adverse party’s response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial.” Fed. R. Civ. P. 56(e). When assessing whether the non-moving party has raised a genuine issue, the court must believe the evidence and draw all justifiable inferences in the non-movant’s favor. *Anderson*, 477 U.S. at 255 (citing *Adickes v. S.H. Kress and Co.*, 398 U.S. 144, 158-59 (1970)). Nonetheless, “the mere existence of

a scintilla of evidence” is insufficient to create a genuine issue of material fact. *Id.* at 252. As the Supreme Court explained in *Matsushita*,

[w]hen the moving party has carried its burden under Rule 56(c), its opponent must do more than simply show that there is some metaphysical doubt as to the material facts. . . . Where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no “genuine issue for trial.”

*Id.*, 475 U.S. at 586-87 (citations omitted).

To be admissible for purposes of summary judgment, declarations or affidavits must be based on personal knowledge, must set forth “such facts as would be admissible in evidence,” and must show that the declarant or affiant is competent to testify concerning the facts at issue. Fed.R.Civ.P. 56(e). Declarations on information and belief are insufficient to establish a factual dispute for purposes of summary judgment. *Taylor v. List*, 880 F.2d 1040, 1045 (9th Cir. 1989).

### IV. ANALYSIS

“And it’s one, two, three, what are we fighting for?”<sup>12</sup> These words, penned by Country Joe McDonald some 38 years ago to protest the Vietnam War, could well apply to the action before the court today. It is undisputed that more than three decades elapsed from the time Plaintiff and her father first became aware of “Fixin” and Defendant received his first notice of alleged infringement. If ever there were a case that should be barred by the doctrine of laches, this would appear to be it.

The doctrine of laches is an equitable defense that prevents suit by a plaintiff who, with full knowledge of the facts, sleeps upon his rights. See *Danjaq LLC v. Sony Corp.*, 263 F.3d 942, 950-51 [59 USPQ2d 1880] (9th Cir. 2001) (affirmed barring by laches of copyright infringement counterclaim where a delay of 19 to 36 years between release of allegedly infringing movies and filing of infringement counterclaim). As Judge Learned Hand explained in *Haas v. Leo Feist, Inc.*, 234 F. 105 (S.D.N.Y. 1916):

It must be obvious to every one familiar with equitable principles that it is inequi-

<sup>12</sup> Kegan Decl., Ex. 22 (sheet music for “I Feel Like I’m Fixin’ to Die Rag,” words and music by Joe McDonald) at 20.

table for the owner of a copyright, with full notice of an intended infringement, to stand inactive while the proposed infringer spends large sums of money in its exploitation, and to intervene only when his speculation has proved a success. Delay under such circumstances allows the owner to speculate without risk with the other's money; he cannot possibly lose, and he may win.

*Id.* at 108. "To demonstrate laches, the 'defendant must prove both an unreasonable delay by the plaintiff and prejudice to itself.'" *Danjaq*, 263 F.3d at 951 (quoting *Couveau v. Am. Airlines, Inc.* 218 F.3d 1078, 1083 (9th Cir. 2000)). The three elements of laches are (1) delay, (2) unreasonableness of delay, and (3) prejudice. *Id.* at 952-55; see also 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 12.06[B] (2002).

### 1. Delay

Delay in filing suit is the first element of a laches defense. *Danjaq*, 263 F.3d at 952. "[D]elay is to be measured from the time that the plaintiff knew or should have known about the potential claim at issue." *Kling v. Hallmark Cards, Inc.*, 225 F.3d 1030, 1036 [56 USPQ2d 1025] (9th Cir. 2000). "[T]he law is well settled that where the question of laches is in issue[,] the plaintiff is chargeable with such knowledge as he might have obtained upon inquiry, provided the facts already known by him were such as to put upon a man of ordinary intelligence the duty of inquiry." *Johnson v. Standard Mining Co.*, 148 U.S. 360, 370 (1893).

[1] It is undisputed that Plaintiff's father, Kid Ory, her mother, and her predecessor-in-interest, George Simon Music Company, knew of McDonald and his song "I Feel Like I'm Fixin' to Die Rag" no later than 1969, but made no demand or complaint to McDonald. UF ¶¶ 103-105, 134; Ory Decl. ¶ 9. It is equally clear that Plaintiff herself knew of "Fixin" no later than 1969 and made no demand on Defendant until July 2001. UF ¶¶ 103, 131. By any measure, this delay is "more than enough" to satisfy the first element of laches. *Danjaq*, 263 F.3d at 952, citing *Jackson v. Axton*, 25 F.3d 884, 889 [31 USPQ2d 1037] (9th Cir. 1994) (delay of 19 years more than sufficient).

Plaintiff does not attempt to argue that a delay of over three decades is insufficient to trig-

ger the defense of laches. Instead, she argues that laches is not a valid defense because Defendant has purportedly infringed within three years of the date of Plaintiff's filing of her Complaint. Opp. at 11.<sup>13</sup> Plaintiff asserts that her claim is not barred by laches because it is only for infringements committed in the past three years, within the statutory limitations period. Opp. at 13. However, the Ninth Circuit has recognized that laches may bar a statutorily timely claim. *Danjaq*, 263 F.3d at 954 (citing *Kling*, 225 F.3d at 139; *Jackson*, 25 F.3d at 888). As the Ninth Circuit observed in *Danjaq*, "Where, as here, the allegedly infringing aspect of the DVD is identical to the alleged infringements contained in the underlying movie, then the two should be treated identically for purposes of laches." *Id.* at 953.

Here, Defendant's alleged performance and recording of "Fixin" within the three years prior to the filing of the Complaint is not alleged to have infringed Plaintiff's rights differently than the decades of prior alleged infringements. Indeed, McDonald's conduct during the three years prior to the filing of the Complaint—performing and licensing "Fixin" and selling musical sound recordings—was entirely consistent with his conduct during the previous 29 years. UF ¶ 231. As the Ninth Circuit noted in *Danjaq*, allowing a claim for infringement based on recent infringements where the same claim regarding the original work would be barred by laches, would "effectively swallow the rule of laches, and render it a spineless defense." *Id.* at 953. "Without the availability of the application of laches to a claim arising from a continuing wrong, a party could, theoretically delay filing suit indefinitely.' We decline to reach such a result here." *Id.* at 953-54 (citing *Hot Wax Inc. v. Turtle Wax, Inc.*, 191 F.3d 813, 821-22 [52 USPQ2d 1065] (7th Cir. 1999)). This court likewise declines to reach such a result.

### 2. Unreasonableness of Delay

Where there is delay, the next question is whether the delay was reasonable. *Danjaq*,

<sup>13</sup> Plaintiff alleges that McDonald has infringed in the last three years both in live performances and at least one sound recording that has been sold on his website. Opp. at 11, Johnson Decl., Ex. 2. Plaintiff also alleges, and Defendant confirms, that he has performed the song since the filing of the lawsuit. Opp. at 11; UF ¶ 233.

263 F.3d at 11083). For example if the defendant's inactivity reasonably have was so minor right was no *Nimmer on The Seventh Co.*, 886 F.2 Cir. 1989) stating filing an act infringement constitute laches of the specter suffice. 3 *Nimmer* (citing *Danjaq* 19 to 36 years of laches

Plaintiff is able because of the defendant's ownership of the company, and she has rights to the Plaintiff cite that a change breathe new otherwise be la authority is to signee [can have been a *mer on Cop Bong v. Alfr* 236 (1909) a right unavish the def infringement the plaintiff did not asse *Joplin Tho Inc.*, 592 F. Cir. 1978) (denying the of copyright sue, in absence predecessor their rights of patent

<sup>14</sup> Whether ment from Ge she alleges (C asserted by D result is the assignor or pi

263 F.3d at 1887 (citing *Couveau*, 218 F.3d at 1083). For example, delay may be held excusable if the work was not being exploited by the defendant during the period of the claimant's inactivity, or if the plaintiff might reasonably have concluded that the infringement was so minor that enforcement of the copyright was not worth the cost of litigation. 3 *Nimmer on Copyright* § 12:06[B][2] (2002). The Seventh Circuit in *Roulo v. Russ Berrie & Co.*, 886 F.2d 931 [12 USPQ2d 1423] (7th Cir. 1989) stated that "[a] two year delay in filing an action following knowledge of the infringement has rarely been held sufficient to constitute laches." *Id.* at 942. At the other end of the spectrum, decades of delay will plainly suffice. 3 *Nimmer on Copyright* § 12:06[B][2] (citing *Danjaq*, 263 F.3d at 654-55) (delay of 19 to 36 years sufficient to satisfy delay element of laches)).

Plaintiff argues that her delay was reasonable because "Muskrat Ramble" was previously owned by George Simon Music Company, and she did not obtain ownership of the rights to the song until 2001.<sup>14</sup> Opp. at 11. Plaintiff cites no authority for the proposition that a change in ownership of a copyright may breathe new life into a claim that would otherwise be laid to rest by laches. Indeed, authority is to the contrary: "[a copyright] assignee [cannot] claim rights that would not have been available to his assignor." 1 *Nimmer on Copyright* § 5.01[B] (1999); see also *Bong v. Alfred S. Campbell Art Co.*, 214 U.S. 236 (1909) (copyright assignee may not claim a right unavailable to his assignor). To establish the defense of laches to a copyright infringement claim, a defendant must show that the plaintiff (or her predecessors in interest) did not assert her rights diligently. See *Lottie Joplin Thomas Trust v. Crown Publishers, Inc.*, 592 F.2d 651, 655 [199 USPQ 449] (2d Cir. 1978) (plaintiff not barred by laches from denying that one defendant's alleged assignor of copyrights had owned the copyrights at issue, in absence of showing that Plaintiff or her predecessors in interest had not asserted her or their rights diligently). As stated in the context of patent law, "a successor-in-interest is

<sup>14</sup> Whether Plaintiff acquired her rights by assignment from George Simon Music and by termination, as she alleges (Ory Decl. ¶ 11), or by termination only, as asserted by Defendants (UF ¶ 8 and cited evidence), the result is the same. Plaintiff stands in the shoes of her assignor or predecessor-in-interest.

charged with the knowledge and dilatory conduct of its predecessors." *Baker Hughes, Inc. v. Davis-Lynch, Inc.*, 2000 WL 33993301, at \*9 (S.D. Tex. 2000) (citing *Chisum on Patents* § 19.05[2][a][i] (Mathew Bender 1998)).

Plaintiff acknowledges the relevance of the prior copyright owners' delay when she asserts that the delay was reasonable because when Kid Ory first learned of "Fixin" he was in poor health and incompetent to handle his business affairs. Opp. at 11; Ory Decl. ¶ 9. While that may be, it is undisputed that since 1968, Plaintiff's predecessor-in-interest to "Muskrat Ramble" acquiesced in McDonald's use of "Fixin." UF, Conclusions of Law ¶ 20.<sup>15</sup> Moreover, there is no evidence that Plaintiff or her mother made any effort to seek assistance in the management of Ory's business affairs. It is undisputed that not a single letter was sent to McDonald until Plaintiff's current counsel called Bill Belmont, the administrator of "Fixin," in July 2001 about the alleged infringement that Plaintiff and her predecessor-in-interest had known about since at least 1969.<sup>16</sup>

Moreover, Plaintiff's declaration that during this time she was ignorant of the music business and copyright law is belied by her longstanding involvement in the music recording industry and representation by legal counsel on matters including intellectual property. See Ory Decl. ¶ 17. *But see* UF ¶¶ 16-19, 95-99, 118, 125, 128.<sup>17</sup> Since at least the 1970s, Plaintiff has used a number of attorneys regarding Kid Ory's music and her own musical interests, and has been actively involved in litigation with various counsel. UF ¶¶ 17,

<sup>15</sup> Defendant asserts that Kid Ory assigned his Muskrat Ramble copyright to Melrose Music, predecessor of George Simon Music Company, which retained it until Plaintiff's termination became effective October 5, 2001. Reply at 3. A copyright title search report shows initial transfer to Melrose Brothers Music Company, Inc. in 1937. Def. Evidence, Kegan Decl. ¶ 18, Ex. 59.

<sup>16</sup> Plaintiff's own deposition testimony is that at no time before 2001 did she consider asking George Simon Music to take any action against McDonald. Ory Dep. 91:3-11 (Q. Did you ever consider it? A. It didn't even cross my mind.).

<sup>17</sup> Plaintiff also now asserts that George Simon died in the 1970s (or in the 1980s, according to UF Resp. ¶ 107), and that his son John Simon, when administering the song "had no awareness that McDonald had infringed the song." Ory Decl. ¶ 12. Any statements regarding the state of mind of George Simon's son are irrelevant and hearsay.

121.<sup>18</sup> In short, Plaintiff has provided no viable justification for the three-decade delay in asserting her claim.

### 3. Prejudice

The third element of a laches defense is a showing that the plaintiff's unreasonable delay has prejudiced the defendant. 3 *Nimmer on Copyright* § 12:06[B][3]. There are two primary forms of prejudice—evidentiary and expectations-based. *Danjaq*, 263 F.3d at 955. “Evidentiary prejudice includes such things as lost, stale, or degraded evidence, or witnesses whose memories have faded or who have died.” *Id.* (citations omitted). A defendant may show expectations-based prejudice where he took actions or suffered consequences that he would not have if the plaintiff had promptly brought suit. *Id.* (citing *Jackson*, 25 F.3d at 889). “[I]f only a short period of time has elapsed since the accrual of the claim, the magnitude of prejudice require[d] before the suit should be barred is great, whereas if the delay is lengthy, prejudice is more likely to have occurred and less proof of prejudice will be required.” *Hot Wax*, 191 F.3d at 824 (citations omitted).

Defendant asserts that severe evidentiary prejudice exists with respect to a determination of the authorship and originality of “Muskrat Ramble.” Mot. at 4. It is undisputed that “Muskrat Ramble” was registered by Kid Ory in 1926.<sup>19</sup> It is thus protected under the 1909 Copyright Act. Section 209 of the 1909 Act created a presumption of validity as to “all facts stated” in the registration certificate. 3 *Nimmer on Copyright* § 12.11[b][1] (2002). The presumption of validity likewise creates a

<sup>18</sup> Entertainment lawyer Jerome Cohen of Beverly Hills represented Plaintiff in 1985. UF ¶ 19. In 1989, attorneys represented Plaintiff in granting licenses for videos of Kid Ory in Europe. UF ¶ 118. Plaintiff also hired a New York City firm to defend her in a 1994 lawsuit, *Song Writers Guild v. Ory*, concerning royalties for the tune “Ipanema.” UF ¶ 17. Since that litigation, Plaintiff has been represented by attorney Steve Lowry and her current attorney, Neville Johnson, who has represented her since 1995. *Id.*; Ory Decl. ¶ 13.

<sup>19</sup> See Def. Evidence, Ex. 54. Defendant describes Exhibit 54 as a copy of the Copyright Office registration of “Muskrat Ramble.” It does not, however, appear to be a certificate of registration issued to Plaintiff, but rather a record of the filing of copyright deposits by various claimants. Nonetheless, Defendant does not dispute that “Muskrat Ramble” was validly registered and that there is a legitimate deposit copy in the Copyright Office. Mot. at 18, n. 2.

presumption of originality under the 1909 Act, that may be rebutted by Defendant. *Id.*

The authorship and originality of “Muskrat Ramble” is uncertain. Defendant has submitted evidence that “Muskrat Ramble” was written by Louis Armstrong, with whom Ory closely collaborated. Armstrong stated in a 1965 interview with *Down Beat* magazine that “I wrote *Muskrat Ramble*. Ory named it, he gets the royalties. I don’t talk about it.” Def. Evidence, Ex. to Belmont Decl.; Orrin Keepnews (“Keepnews”) Decl. ¶ 24.<sup>20</sup> On the other hand, Plaintiff points to two occasions where Armstrong publicly stated that “Muskrat Ramble” was written by Ory. UF Resp. ¶ 77; Notice of Lodging Audio and Video Evidence, Exs. 2, 3.<sup>21</sup> Whether Kid Ory or Louis Armstrong authored “Muskrat Ramble” would now be difficult to ascertain, as both have been dead for decades. Both were still alive some six years after McDonald created “Fixin.” UF ¶ 82; Def. Evidence, Ex. 59 (Plaintiff’s Expert Witness Disclosures), Report of Lasker at unnumbered page 2. It is thus “quite clear that [Defendant] will be hamstrung by the absence of key witnesses. . . . That there are a few survivors to tell part of the story does nothing to erase the prejudice caused by the unavailability of most of the key players.” *Danjaq*, 263 F.3d at 956.<sup>22</sup>

Plaintiff asserts that McDonald’s argument that Armstrong may have written “Muskrat Ramble” proves the existence of triable issues of fact. Opp. At 10. While the existence of triable issues of fact would prevent summary

<sup>20</sup> Belmont also asserts that liner notes for a current compact disc set of the group Louis Armstrong and his Hot Five containing “Muskrat Ramble” suggest that Armstrong originally created the “Muskrat Ramble” music. Belmont Decl. ¶¶ 10, 11. However, the liner notes are not included with Belmont’s declaration.

<sup>21</sup> These are recordings of a broadcast that aired in 1961 entitled “The Wonderful World of Disney—Disneyland After Dark,” where Ory and Armstrong performed the song, and Armstrong’s spoken introduction to the song on a 4-LP set recorded in or about January 1957. Opp. at 9.

<sup>22</sup> Further calling Ory’s authorship into question, Sidney Bechet, a New Orleans jazz artist, was reported to have claimed that “Muskrat Ramble” was based on an old folk tune, “The Old Cow Died.” Belmont Decl. ¶ 30; Def. Evidence, Ex. 59 (Lasker Report). Bechet died in 1959, and there is no substantiation of this claim in the record. As Ory is no longer alive, he can neither verify nor deny that “Muskrat Ramble” was based on this song.

judgment on ports a findir pute over ori witnesses an dence after McDonald’s

Kid Ory’s “Muskrat R: cerning its c ated “Muskr a saxophone lished a stat ing [the sax one day, rur gios and just of a sudden a melody. I and adding until I final ¶ 44; Def. E (record alb Wrote Musl edges that 1 her father to another pub

Ironically ten by a phone ex of studyi was read one day phone. F shifted t tune grev

Def. Eviden ness Discl unnumbere

Plaintiff Ory’s publ phone bool one sectio professing that from 0 meter arou the “A” se us if it al Resp. ¶ 45 little assis whether tl claimed to

<sup>23</sup> Plaintiff section of b “B” section similarities l ¶¶ 5, 39.

the 1909 Act,  
t. *Id.*

of “Muskrat  
has submit-  
mble” was  
whom Ory  
stated in a  
magazine that  
named it, he  
out it.” Def.  
ecl.; Orrin  
¶ 24.<sup>20</sup> On  
two occa-  
stated that  
by Ory. UF  
Audio and  
her Kid Ory  
“Muskrat  
to ascertain,  
ades. Both  
McDonald  
vidence, Ex.  
disclosures),  
page 2. It is  
nt] will be

key wit-  
urvivors to  
to erase the  
ility of most  
63 F.3d at

s argument  
a “Muskrat  
iable issues  
ence of tri-  
t summary

for a current  
trong and his  
suggest that  
rat Ramble”  
ver, the liner  
laration.

that aired in  
of Disney—  
d Armstrong  
ken introduc-  
in or about

to question,  
was reported  
was based on  
elmont Decl.  
ort). Bechet  
ation of this  
alive, he can  
amble” was

judgment on the issue of originality, it supports a finding of laches. Indeed, the very dispute over originality makes the lack of critical witnesses and the difficulty in obtaining evidence after decades severely prejudicial to McDonald’s defense.

Kid Ory’s own account of how he created “Muskrat Ramble” also raises questions concerning its originality. Ory stated that he created “Muskrat Ramble” while practicing from a saxophone study book. UF ¶ 42. Ory published a statement that “[i]t was while learning [the saxophone] that I was sitting there one day, running the scales and doing arpeggios and just sort of noodling around, when all of a sudden it seemed to me that I had hold of a melody. I started putting it down on paper and adding here and there to fill in the gaps until I finally had the meter worked out.” UF ¶ 44; Def. Evidence, Kegan Decl. ¶ 48, Ex. 36 (record album cover text entitled “How I Wrote Muskrat Ramble”). Plaintiff acknowledges that for as long as she can remember, her father told her this same story. UF ¶ 48. As another published account explained:

Ironically, the most famous tune ever written by a jazz trombonist began as a saxophone exercise! Ory, who did a great deal of studying during his Los Angeles years, was reading some exercises out of a book one day while he was practicing the saxophone. He changed a note here and there, shifted the meter around a little, and the tune grew out of this almost accidentally.

Def. Evidence, Ex. 59, Plaintiff’s Expert Witness Disclosures, Ex. 3 (Report of Lasker) at unnumbered page 2.

Plaintiff asserts that one can conclude from Ory’s published remarks only that the saxophone book provided inspiration for “at least one section of Muskrat Ramble.” Without professing to be an expert, Plaintiff asserts that from Ory’s comments about shifting the meter around, one can infer that he refers to the “A” section of the song, but “does not tell us if it also inspired the ‘B’ section.” UF Resp. ¶ 45.<sup>23</sup> Plaintiff’s personal opinion is of little assistance in resolving the question whether the section of “Muskrat Ramble” claimed to be infringed by “Fixin” was origi-

nal with Ory or copied from a saxophone study book. On the other hand, a piece of evidence that could have helped resolve this issue—the study book itself—is purportedly no longer available.<sup>24</sup> Here too, loss of evidence and the death of Ory result in evidentiary prejudice to Defendant.

In addition to his challenge to Ory’s authorship and the originality of “Muskrat Ramble,” Defendant asserts that Plaintiff’s predecessor-in-interest, George Simon Music Company, and its auditing agent MCPS, acquiesced in McDonald’s use of “Fixin.” Mot. at 6; Reply at 3; Defendant’s Conclusions of Law (“Law”) ¶ 20. As set forth in trademark law, “[i]n situations in which consent is inferred from conduct, courts sometimes state that the trademark owner is estopped by its “acquiescence” from obtaining relief. . . . [W]hen acquiescence is inferred . . . from affirmative conduct . . . fairly implying consent, the actor may have a defense . . . without regard to the lack of reasonable diligence on the part of the trademark owner necessary to establish laches.” Restatement 3d of Unfair Competition § 29, Comment c. “Principles of estoppel applicable elsewhere in the law are equally applicable in copyright infringement actions.” 4 Nimmer on Copyright § 13.07 (2003). “In order to prevail on the defense, the accused infringer must demonstrate that (1) the plaintiff knew of and manifested acquiescence in the defendant’s infringing conduct, actual or proposed, (2) the plaintiff intended that the defendant rely on its conduct, and (3) the defendant reasonably relied to its detriment on the plaintiff’s actions.” *Cherry River Music Co. v. Simitar Entertainment, Inc.*, 38 F.Supp.2d 310, 318 [51 USPQ2d 1897] (S.D.N.Y. 1999).

Defendant asserts that MCPS, the auditing agent in England for George Simon Music Company, studied “Fixin” and determined that it was sufficiently original that George Simon and MCPS declined to seek any royalties when “Fixin” was published in England in 1970. Mot. at 23; UF ¶ 215; Chris Strachwitz (“Strachwitz”) Dep. at 11:3-19, 59:17-22.<sup>25</sup> Defendant argues that MCPS’s significant du-

<sup>23</sup> Plaintiff’s expert Joel Leach identifies a 16-bar section of both “Fixin” and “Muskrat Ramble” as the “B” section and asserts that it is in that section that similarities between the two songs occur. Leach Decl. ¶¶ 5, 39.

<sup>24</sup> In her deposition testimony, Plaintiff stated that she still had Ory’s saxophone music books. Ory Dep. at 147:16-18. Plaintiff now asserts she does not have these books. UF Resp. at 50.

<sup>25</sup> Strachwitz published “Fixin” from 1965 to 1977. UF Resp. ¶ 215.

ties with “Muskrat Ramble’s” copyright impute the agent’s knowledge and consent to its principal. Mot. at 23 (citing *Guardian Life Ins. Co. of America v. American Guardian Life Assurance Co.*, 943 F.Supp. 509, 520 (E.D. Pa. 1996), *abrogated on other grounds by A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198 [57 USPQ2d 1097] (3rd Cir. 2000) (agent must have some duties with respect to trademark matters to impute agent’s knowledge to principal)). Defendant contends that McDonald’s agent Strachwitz reasonably understood MCPS’s declination to seek royalties as consent, thus barring Plaintiff’s claim on the ground of acquiescence. Mot. at 23, 24.

Strachwitz recalls an initial contact from MCPS raising the possibility that “Fixin” was in conflict with some other copyrighted item, followed by a letter from MCPS saying it had decided that “Fixin” was indeed original. Strachwitz Dep. at 11:3-19. However, Strachwitz does not recall whether MCPS named the other song, nor does he have any documents related to this interchange. Strachwitz Dep. 12:5-13, 25:8-13.<sup>26</sup> Bill Belmont called MCPS in 2002 and was informed that MCPS had looked for records but could not locate adequate paper records for that period. UF ¶ 225. In November 2002, Strachwitz wrote to MCPS at Bill Belmont’s behest to attempt to locate copies of the two letters. Strachwitz Dep. 25:19-26:6, Ex. 9. The effort was unsuccessful.

Plaintiff contends that there never was any correspondence. UF Resp. ¶¶ 217-220. Given the length of time that has passed and the lack of substantiating documents, it is impossible to know with certainty what did—or did not—transpire in the purported MCPS investigation. To the extent Defendant would have been able to show that George Simon Music Company, through its agent, actually determined there was no conflict between “Fixin” and “Muskrat Ramble,” he is severely prejudiced by Plaintiff’s delay in bringing this action.

Defendant also asserts that Plaintiff’s delay caused expectations-based, specifically, economic prejudice. “Fixin” is primarily known

<sup>26</sup> Contrary to the suggestion of Plaintiff’s counsel at oral argument, Strachwitz did not withdraw or contradict this statement. He simply stated that he did not specifically recall that the song at issue was “Muskrat Ramble.” Strachwitz Dep. at 22:3-26:6.

for its lyrics, which have shock value and political value. UF ¶ 196. “Fixin” is an anti-war protest song and is played primarily in a political-social context. UF ¶¶ 199, 203. The lyrics are more important than the music. UF ¶ 204. Permission to use “Fixin” lyrics is requested many times a year. The lyrics have been quoted in numerous novels and history books. UF ¶ 205. McDonald does not separately license the musical portion of “Fixin.” Belmont Decl. ¶ 20; FAC ¶ 9. Defendant asserts that had there been a valid copyright claim against “Fixin” and had he been notified soon after Plaintiff and her predecessors learned of his song, he could have devised alternate music as background to his lyrics. Mot. at 6. Instead, he continued to record and perform “Fixin” for more than three decades, while Plaintiff and her predecessors did nothing. Consequently, Plaintiff’s delay has prejudiced Defendant economically, as well as evidentially. As Plaintiff admits, “Fixin’ To Die Rag” has become a world famous “American Classic,” widely regarded as Joe McDonald’s “signature song.” FAC ¶ 7; UF ¶ 173. The time to bring an infringement suit against Defendant has long since past.

Where delay is lengthy, prejudice is more likely to have occurred and less evidence of prejudice is required. *See Hot Wax*, 191 F.3d at 824. Delay here is lengthy—at least 32 years. While less proof of prejudice is required, Defendant has nonetheless demonstrated ample evidentiary and expectations-based prejudice. In short, Defendant has established all three elements of the laches defense.

#### 4. Exception for Willful Infringement

Plaintiff alleges that Defendant willfully infringed and therefore the defense of laches is not available to him. Opp. at 13. Guided by the maxim that “he who comes into equity must come with clean hands,” courts have developed the principle that laches does not bar a suit against a deliberate infringer. *Danjaq*, 263 F.3d at 956. The “piracy” or “willfulness” exception to the laches defense is applied in this circuit. *Id.* at 957. In *Danjaq*, the Ninth Circuit defined “willful” as conduct that occurs “with knowledge that the defendant’s conduct constitutes copyright infringement.” *Id.* (citations omitted). *See also 3 Nimmer on Copyright* § 12:06[B][5] (“[A] party accused of infringement, who reasonably and

in good faith b ful.”).

In *Danjaq*, t ful infringement there was no e ment and no n *jaq*, 263 F.3d a Donald receive fringement fro 1965 until July three decades, and sold sound without a copy party. Then, in view of McD to file suit. U evant section

And I reme song [Who chair and g song is over going just, kinda a l Ramble the Dixieland t all of a su grabbed m three, what me and in Fixin To D

Def. Evidenti Ex. 29 (trans Defendant’s a Audio and Vi dio interview

[2] Plaintiff McDonald ‘ Muskrat Ram disagrees. An credit “Musk “Fixin.” Plai admits on hi concert in 19 “an old Dixi that the melo rat Ramble.” however, is 1 ment. Plainti ten by McD Plaintiff’s ex passed on to In this respon

My conten the way m

in good faith believes the contrary, is not willful.”).

In *Danjaq*, the Ninth Circuit found no willful infringement as a matter of law, where there was no evidence of deliberate infringement and no notice of a copyright claim. *Danjaq*, 263 F.3d at 958. It is undisputed that McDonald received no notice of any alleged infringement from the time he wrote “Fixin” in 1965 until July 2001. UF ¶ 133. For more than three decades, McDonald performed, licensed, and sold sound recordings containing “Fixin” without a copyright complaint from any third party. Then, in 2001, Plaintiff heard an interview of McDonald on the radio and decided to file suit. UF ¶ 126. Following is the relevant section of the interview:

And I remember distinctively finishing the song [Who Am I] and sitting back in my chair and going, ugh, gug, I’m glad that song is over with that was so hard to do and going just, just [strum] on my guitar. It was kinda a Dixieland riff from Muskrat Ramble that I used to play when I had a Dixieland band when I was a teenager and all of a sudden I just reached over and grabbed my pen and I wrote one, two, three, what are we fighting for, don’t ask me and in twenty minutes I had written Fixin To Die Rag[.]

Def. Evidentiary Objections, McDonald Dep., Ex. 29 (transcript of interview prepared by Defendant’s attorney); Pl. Notice of Lodging Audio and Video Exhibits, Ex. 1 (copy of radio interview on cassette tape).

[2] Plaintiff asserts that in this interview McDonald “admitted infringing the [sic] Muskrat Ramble.” Ory Decl. ¶ 10. The court disagrees. At most, McDonald appears to credit “Muskrat Ramble” as inspiration for “Fixin.” Plaintiff also asserts that McDonald admits on his own sound recording from a concert in 1999 that “Fixin” was based on “an old Dixieland melody.” Plaintiff asserts that the melody must “of course” be “Muskrat Ramble.” Opp. at 4. Plaintiff’s assumption, however, is not evidence of willful infringement. Plaintiff also points to a response written by McDonald to the musical analysis of Plaintiff’s expert Joel Leach, that had been passed on to him by Bill Belmont. Opp. at 14. In this response, McDonald stated, *inter alia*:

My contention is that there is a similarity in the way my melody line progresses and his

composition accents certain chords, in that spot but that is all. And my use is quite distinctly different than Mr. Ory’s use. As for the rest of the song as I mentioned before the two songs do not fit together.

Whether Ms. Ory owns that riff or not I cannot say. But I do know that certain riffs have been around for perhaps hundreds of years and it takes more than a 2 measure riff that is strikingly similar with regard to melody and melodic rhythm to make plagiarism.

Opp., Johnson Decl., Ex. 1.

An acknowledgment of some similarity between the two songs at issue—in the course of litigation—is a far cry from establishing that McDonald willfully infringed “Muskrat Ramble” some 36 years earlier when he wrote “Fixin.” Indeed, the bulk of McDonald’s response addressed the *dissimilarity* of the two songs. McDonald also clearly stated “[i]t is not my intention at all to rip off KID ORY in any way.” *Id.*

In *Danjaq*, the plaintiff, McClory, claimed that certain elements first developed in his materials made their way into the script of the film “Dr. No,” commissioned by the alleged infringer, *Danjaq*. The Ninth Circuit found that “even assuming this allegation to be true, McClory could show at most infringement, not *willful* infringement.” *Danjaq*, 263 F.3d at 958 (emphasis in original). The Ninth Circuit reached this finding notwithstanding evidence of a history of litigation between the parties and a flurry of public accusations by McClory, including full page ads in “Variety” magazine. *Id.* at 949, 958. Here, by contrast, there was only the sound of silence. As in *Danjaq*, there is no evidence that McDonald wrote “Fixin” with the knowledge or intention of infringing any existing copyright. “Indeed, [defendant] was not on notice before the current litigation that [plaintiff] claimed a right in the [composition]. . . . Given that lack of notice and the absence of evidence of willfulness, a jury could not find willful infringement.” *Id.* As the evidence fails, as a matter of law, to demonstrate deliberate infringement, Plaintiff’s suit is barred by laches.

### 5. Scope of Order

[3] Defendant seeks an order granting summary judgment, costs, and reasonable attorneys’ fees. While laches typically does not bar

prospective injunctive relief, this principle “does not apply where, as here, the feared future infringements are subject to the same prejudice that bars retrospective relief. *Dan-jaq*, 263 F.3d at 959. Where “the feared future infringements are identical to the alleged past infringements[,]” any prospective claims will suffer from the very same evidentiary defects that bar the older claims. Laches properly bars a prospective injunction against future infringement “when we know in advance that the defendant will be substantially prejudiced in its ability to defend future claimed infringements in just the same way that it was prejudiced with regard to prior alleged infringements.” *Id.* Accordingly, Defendant’s laches defense bars Plaintiff from obtaining either damages or injunctive relief.

**6. Attorneys’ Fees**

Defendant requests an award of reasonable attorneys fees and costs. Mot. at 25. Section 505 of the Copyright Act provides:

In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney’s fee to the prevailing party as part of the costs.

17 U.S.C. 505.

In *Fogerty v. Fantasy*, 510 U.S. 517 [29 USPQ2d 1881] (1994), the Supreme Court rejected the Ninth Circuit’s “dual” standard for awarding attorneys’ fees to plaintiffs and defendants under section 505, and held that prevailing plaintiffs and prevailing defendants must be treated alike in awarding attorneys’ fees under the Copyright Act. *Id.* at 534. In determining attorneys’ fees, the Supreme Court directed that courts are to exercise equitable discretion “in light of the considerations we have identified.” *Id.* (citing *Hensley v. Eckerhart*, 461 U.S. 424, 436-37 (1983). “Such considerations include, but might not be limited to, the degree of success obtained, . . . frivolousness; motivation; objective unreasonableness (both in the factual and legal arguments in the case); and the need in particular circumstances to advance considerations of compensation and deterrence.” *Jackson*, 25 F.3d at 890 (citing *Hensley*, 461 U.S. at 436; *Fogerty*, 501 U.S. at 535 n. 19). “Courts should keep in mind the purposes of

the Copyright Act (to promote creativity for the public good) and apply the factors in an evenhanded manner to prevailing plaintiffs and prevailing defendants alike.” *Id.* (citations omitted).

[4] Defendant has fully prevailed on the basis of his laches defense. In considering the factors outlined by *Fogerty*, the court finds that Plaintiff’s decades-long delay in bringing suit weighs heavily toward the granting of attorneys’ fees to Defendant. The court has found Plaintiff’s claim of infringement at this late date to be unreasonable. Indeed, the instant litigation appears to have been motivated more by a desire to “erase” Defendant’s song from the planet, than concern with protecting Plaintiff’s recently acquired copyright in “Muskrat Ramble.” Additionally, the Copyright Act’s purpose of promoting creativity for the public good would be ill served by enjoining Defendant from performing or profiting from a song that Plaintiff concedes has become an “American classic” over the nearly four decades Defendant has been performing it. Accordingly, Defendant’s request for attorneys’ fees is granted.

**V. CONCLUSION**

In short, Plaintiff knew of Defendant’s composition for at least 30 years. Over three decades, neither she nor anyone else acted to assert copyright infringement. The delay was both lengthy and unreasonable. Defendant’s ability to mount colorable defenses of lack of originality and acquiescence has been indisputably compromised by the passage of time, the corresponding death of knowledgeable parties, and the uncertain disposition of contemporaneous documents. Plaintiff has failed to counter the overwhelming evidence of inexcusable delay and genuine prejudice with a showing of knowing and intentional infringement. Because Defendant has satisfied the elements of laches, and the record cannot support a finding of willful infringement, Defendant is entitled to judgment as a matter of law.

Accordingly, the court GRANTS Defendant’s motion for summary judgment. The court awards reasonable attorneys’ fees to Defendant, pursuant to the Copyright Act, 17 U.S.C. § 505. Defendant may submit a fee petition within fourteen (14) days of this order. As the prevailing party, Defendant may also file a bill of costs with the Clerk, pursuant to Local Rule 54-3.

On May 9, motion for su sideration of ties, and th granted Defe ing been duly been duly rei

It is Orde take nothing.

**Highmark Inc.**

U

Dec

**TRADEMA PRACTIC**

[1] Unfair ham Ac

**JUDICIAL PROCED**

**Jurisdiction —**

Defendant newspaper comparison tiff’s health employees, commerce, a jurisdiction claim, since Pennsylvania gency care 1 since plaintil siding outsid may be refe Pennsylvania ties outside 1

## JUDGMENT

On May 9, 2003, Defendant filed the instant motion for summary judgment. Upon full consideration of the papers, the relevant authorities, and the entire file herein, the court granted Defendant's motion. The issues having been duly reviewed, and a decision having been duly rendered,

It is Ordered and Adjudged that Plaintiff take nothing.

---

### Highmark Inc. v. UPMC Health Plan Inc.

U.S. Court of Appeals  
Third Circuit

No. 01-1377

Decided December 21, 2001

## TRADEMARKS AND UNFAIR TRADE PRACTICES

[1] Unfair and false advertising — Lanham Act Section 43(a) (§ 390.05)

## JUDICIAL PRACTICE AND PROCEDURE

Jurisdiction — Subject matter jurisdiction — Federal question (§ 405.0702)

Defendant insurer's allegedly deceptive newspaper advertisement, which presents comparison between defendant's and plaintiff's health plans for Allegheny County, Pa., employees, substantially affects interstate commerce, and thus gives rise to Lanham Act jurisdiction over plaintiff's false advertising claim, since newspaper is distributed outside Pennsylvania, since health plans offer emergency care to patients outside Pennsylvania, since plaintiff's plan applies to subscribers residing outside Pennsylvania, since subscribers may be referred to medical facilities outside Pennsylvania, and since ad might impact parties outside Pennsylvania.

## TRADEMARKS AND UNFAIR TRADE PRACTICES

[2] Unfair and false advertising — Lanham Act Section 43(a) (§ 390.05)

## JUDICIAL PRACTICE AND PROCEDURE

Jurisdiction — Subject matter jurisdiction — Federal question (§ 405.0702)

Defendant insurer's advertising activity constitutes part of "business of insurance," such that McCarran-Ferguson Act, 15 U.S.C. §§ 1011-1015, which prohibits application of federal laws that invalidate, impair, or supersede state regulation of insurance business, applies to defendant's activity, since advertisement at issue dealt with services offered by insurers to subscribers.

## TRADEMARKS AND UNFAIR TRADE PRACTICES

[3] Unfair and false advertising — Lanham Act Section 43(a) (§ 390.05)

## JUDICIAL PRACTICE AND PROCEDURE

Jurisdiction — Subject matter jurisdiction — Federal question (§ 405.0702)

McCarran-Ferguson Act, 15 U.S.C. §§ 1011-1015, which prohibits application of federal laws that invalidate, impair, or supersede state regulation of insurance business, does not bar federal cause of action for false advertising under Lanham Act's Section 43(a), 15 U.S.C. § 1125(a)(1)(B), stemming from newspaper advertisement comparing defendant's and plaintiff's health insurance plans for Allegheny County, Pa., employees, even though Lanham Act does not relate to business of insurance, and Pennsylvania's Unfair Insurance Practices Act, 40 Pa. Cons. Stat. Ann. §§ 1171.1-15, regulates insurance business, since UIPA, which is enforceable only by state's insurance commissioner and confers no private right of action, is not exclusive regime for regulating insurance advertising within state, and in light of availability of common law causes of action, Lanham Act's different standard of liability and stronger remedies would not render UIPA ineffective for purposes of McCarran Act analysis.

remained. Gen-Probe's brief to this court, supported by the record, and unrefuted by Enzo, makes that clear. While it is, to say the least, regrettable that a party with a remaining counterclaim that it wishes to pursue, as well as its opponent, leaves a trial judge with the impression that no claims remain in the case, we have no choice but to take cognizance of the nonfinality created by the unquestioned existence of that counterclaim.

In *Pandrol*, we were faced with a different posture on appeal, wherein the district court had expressly determined that the defendants had waived their defenses and, in effect, had waived their counterclaims relating to patent invalidity as well. *Id.* at 1362. Indeed, we stated that the district court, "after having held that the defendants had waived the issue of patent invalidity, evinced a clear intent to resolve or dispose of all claims and end the case." *Id.* at 1363 (emphasis added). Here, in contrast, although the district court may have indicated its intent that its order "will enable you to proceed with dispatch in the Federal Court of Appeals," Summary Judgment Hearing at 35, it did not address at any time Gen-Probe's unresolved counterclaim of unenforceability. At no time was the counterclaim waived, and, whether through inadvertence or not, the parties should not have let the trial court conclude its deliberations under that false impression. Because Gen-Probe's counterclaim remains adjudicated, the judgment is nonfinal.

We also disagree with Enzo that the only issue remaining is Gen-Probe's claim for attorney fees. Enzo's argument under Federal Rule of Civil Procedure 58(c) that a pending motion for attorney fees will not render an otherwise final judgment unappealable, is relevant only when all other claims have been adjudicated. More litigation lay ahead than awarding fees. To be eligible for attorney fees on the basis of inequitable conduct, Gen-Probe still has to establish that Enzo actually engaged in such conduct, an issue that remains unresolved in the district court.

Despite the jurisdictional defect in the instant appeal, we have held that "a premature notice of appeal ripens upon subsequent action of the district court," *Pause*, 401 F.3d at 1295 (citing *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1367 [67 USPQ2d 1947] (Fed. Cir. 2003) and *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 830

[66 USPQ2d 1545] (Fed. Cir. 2003)). Accordingly, inasmuch as the appeal has been briefed and argued on the merits, in the interest of judicial economy we grant Enzo leave to seek remedial action in the district court and thereafter reinstate the appeal if and when the judgment becomes final.

## CONCLUSION

For the aforementioned reasons, we dismiss the instant appeal for lack of jurisdiction. A party may appeal from the entry of a final judgment in the entire case by the district court without payment of an additional filing fee if the appeal is filed within thirty days of the date of this opinion. If so filed, the case will be reinstated and decided on the merits by the present panel, based on the parties' briefs already filed and the June 7, 2005 oral argument.

## DISMISSED

## COSTS

Costs to Appellant.

## Ory v. McDonald

U.S. Court of Appeals  
Ninth Circuit

Nos. 03-56586, 04-55858

Decided July 29, 2005

(Unpublished)

## COPYRIGHTS

[1] Infringement pleading and practice —  
Defenses — In general (§ 217.0601)

Infringement pleading and practice —  
Willful (§ 217.10)

## JUDICIAL PRACTICE AND PROCEDURE

Procedure — Defenses — Laches  
(§ 410.1803)

Federal district court properly granted summary judgment that claim for infringement of musical composition is barred by laches, since plaintiff failed to bring suit until 30 years af-

ter discovery of alleged infringement, and defendant's 1999 recording did not constitute new infringing activity, since plaintiff is successor-in-interest of copyright at issue, and delay was therefore unreasonable despite plaintiff's argument that she did not acquire copyright ownership until 2001, since defendant has demonstrated both evidentiary and expectation-based prejudice, and since plaintiff failed to raise genuine issue of willful infringement by defendant that would render laches defense inapplicable.

## REMEDIES

### [2] Monetary — Attorneys' fees; costs — Copyrights (§ 510.0909)

Federal district court did not abuse its discretion by awarding attorneys' fees to defendant who successfully raised defense of laches to bar action for infringement of musical composition, since court correctly found that defendant fully prevailed on laches defense, that lateness of plaintiff's claim was unreasonable, and that plaintiff's suit serves none of Copyright Act's purposes, since there is no legal support for plaintiff's argument that fees should not be awarded because record does not support defendant's motion for sanctions under Fed. R. Civ. P. 11, and since plaintiff has failed to produce evidence that fee award would cause her significant financial hardship.

Appeal from the U.S. District Court for the Central District of California, Manella, J.; 68 USPQ2d 1812.

Action by Babette Ory against Country Joe McDonald, a/k/a Joe McDonald, d/b/a Alcatraz Corner Music Co., for copyright infringement. Plaintiff appeals from grant of summary judgment and award of attorneys' fees to defendant. Affirmed.

Neville L. Johnson, of Johnson & Rishwain, Los Angeles, Calif.; Anthony Kornarens, of Spellberg & Kornarens, Santa Monica, Calif., for plaintiff-appellant.

Naomi Norwood, of Mandel & Norwood, Los Angeles; Marc E. Fineman and Daniel L. Kegan, of Kegan & Kegan, Chicago, Ill., for defendant-appellee.

Before Farris, D.W. Nelson, and Tallman, circuit judges.

## MEMORANDUM\*

Babette Ory appeals the district court's order granting the defendant. Country Joe McDonald, summary judgment on Ory's claim of copyright infringement and awarding McDonald his attorneys' fees. We affirm.

### I

McDonald moved for summary judgment arguing that Ory's claim — that McDonald's song *Fixin' to Die Rag* ("Fixin'") infringed on Ory's copyright to the song *Muskrat Ramble* — was precluded by the doctrine of laches. To prove laches, the defendant must prove that there was a delay in bringing the action, that the delay was unreasonable, and that the alleged infringer was prejudiced by that delay. *Danjaq LLC v. Sony Corp.*, 263 F.3d 942, 951 [59 USPQ2d 1880] (9th Cir. 2001). We review the district court's award of summary judgment on the issue of laches *de novo*. *Soules v. Kauaians for Nukolii Campaign Committee*, 849 F.2d 1176, 1180 (9th Cir. 1988).

[1] Here, all three elements of the laches defense are properly met. First, Ory's failure to bring suit until thirty years after the discovery of McDonald's alleged infringement constitutes the delay for the purposes of laches. *See, e.g., Danjaq*, 263 F.3d at 952 (failure to bring claim for infringement for nineteen years constituted "delay" for laches purposes).

We reject Ory's argument that McDonald's 1999 recording was a new infringing activity. *See Danjaq*, 263 F.3d at 952. Ory's admission that "every version [of *Fixin'*]" contains the portion that infringes" demonstrates that there is no new infringing activity. Moreover, her mere assertion that the 1999 recording is a new instance of infringement and bare allegations that the 1999 recording is "qualitatively" different are not enough to defeat summary judgment.

Second, the delay here was unreasonable. Ory cannot claim that the delay was reasonable because she did not obtain ownership of the copyright until 2001. As a successor in interest, Ory stands in the shoes of her predecessor; she cannot claim the right to sue where that right would have been unavailable to her

\* This disposition is not appropriate for publication and may not be cited to or by the courts of this circuit except as provided by Ninth Circuit Rule 36-3.

predecessor/assignee *Entm't, Inc* USPQ2d 1065] (against the assignee, who stood as signor") (internal

Finally, McDonald was sufficient to bring her claim to death of all three or another asset *Ramble* constituted *e.g., Danjaq*, 263 figures in creation was sufficient prejudice). More books that may *Muskrat Ramble* prejudice. *Id.* a scripts and draft lish evidentiary

There is also McDonald's uninvested time at to establish *exp jaq*, 263 F.3d at had invested situation, development was sufficient to

We reject Ory's argument that the laches defense is inapplicable to fully infringed McDonald's statements view are insufficient of material infringement. The summary judgment

The decision broad discretion *ment Researc. Group, Inc.*, USPQ2d 170; court's determination *ter alia*, sever of success obstacle suit, and "the stances, to advancement and determination to a Copyright Act viewed for an *v. Walking M.* 814 [69 USPQ

predecessor/assignor. See *Silvers v. Sony Picture Entm't, Inc.*, 402 F.3d 881, 897 [74 USPQ2d 1065] (9th Cir. 2005) (“all defenses against the assignor were valid against the assignee, who stood in the shoes of the assignor”) (internal quotation marks omitted).

Finally, McDonald has demonstrated that he was sufficiently prejudiced by Ory's failure to bring her claim in a timely fashion. The death of all three individuals who at one time or another asserted authorship of *Muskrat Ramble* constitutes evidentiary prejudice. See, e.g., *Danjaq*, 263 F.3d at 955 (death of “key figures in creation of James Bond movies” was sufficient for establishing evidentiary prejudice). Moreover, the loss of saxophone books that may have been used in creating *Muskrat Ramble* also constitutes evidentiary prejudice. *Id.* at 955-56 (absence of movie scripts and draft scripts was sufficient to establish evidentiary prejudice).

There is also expectation-based prejudice. McDonald's uncontradicted testimony that he invested time and money in *Fixin'* is sufficient to establish expectation-based prejudice. *Danjaq*, 263 F.3d at 956 (evidence that defendant had invested substantial money into production, development, and marketing of movie was sufficient to establish prejudice).

We reject Ory's claim that the laches defense is inapplicable because McDonald willfully infringed Ory's copyright. *Id.* at 957. McDonald's statements during his 2001 interview are insufficient to create any genuine issue of material fact as to whether he willfully infringed. The district court properly entered summary judgment.

## II

The decision to award fees is left up to the broad discretion of the trial court. *Entertainment Research Group v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1229 [43 USPQ2d 1705] (9th Cir. 1997). The district court's determination should be guided by, *inter alia*, several factors, including the degree of success obtained, the motivation for filing suit, and “the need, in particular circumstances, to advance considerations of compensation and deterrence.” *Id.* The district court's decision to award attorney's fees under the Copyright Act, 17 U.S.C. §§ 101 *et seq.*, is reviewed for an abuse of discretion. *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 814 [69 USPQ2d 1257] (9th Cir. 2003).

[2] We agree with the district court that McDonald “fully prevailed” in his laches defense, that the lateness of Ory's claim was unreasonable, and that the suit serves none of the purposes of the Copyright Act. We see no abuse of discretion. Ory provides no legal support for her argument that fees should not be awarded because the record does not support McDonald's motion for sanctions under Fed. R. Civ. P. 11. Ory's alternate argument, that an award of fees is unreasonable because it places her in significant financial hardship, fails because Ory did not provide the district court with the evidence it had requested, despite four extensions of time to supply the requested evidence demonstrating financial hardship.

**AFFIRMED.**

## Westbrook v. Gray

### U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Interference No. 105,207

Decided November 8, 2004

(Nonprecedential)

## PATENTS

### [1] Practice and procedure in Patent and Trademark Office — Interference — Motions (§ 110.1717)

Request of senior party in interference to file motion suggesting declaration of additional interference between senior party's newly filed application and additional patent of junior party is denied, since examination of new application is not complete, and thus it is premature to consider declaring interference involving that application; senior party may pursue interference before examiner during *ex parte* prosecution of new application.

### Particular patents — Chemical — Detection of chromosomal aberrations

6,576,421, Westbrook, methods and compositions for the detection of chromosomal aberrations, request for leave to file motion suggesting interference against patent denied.