

IN THE  
UNITED STATES COURT OF APPEALS  
FOR THE THIRD CIRCUIT

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NO. 97-5610

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JAMES DAMIANO

*Appellant*

V.

SONY MUSIC ENTERTAINMENT INC.  
and BOB DYLAN,

*Appellees*

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Appeal From Order of the United States District Court  
for the District of New Jersey

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BRIEF FOR APPELLANT

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**Legislative History**

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## STATEMENT OF JURISDICTION

The United States Court of Appeals for the Third Circuit has jurisdiction to review this appeal as a final appeal from an order entered in the U.S. District Court for New Jersey. 28 U.S.C. §1291. The District Court had subject matter jurisdiction over the copyright claims (Count I) raised herein under 28 U.S.C. §1338. The Lanham Act claim (Count II) raised a federal question reviewable under 28 U.S.C. § 1331. The District Court had jurisdiction over the state claims under Counts III and IV since they are pendant to the federal claims, and they raise an amount in controversy in excess of \$75,000.00, exclusive of interest and costs, where the parties have a diversity of citizenship. 28 U.S.C. §1332.

## STATEMENT OF ISSUES PRESENTED<sup>1</sup>

- 1.) Whether the District Court erred by granting summary judgment on a copyright infringement claim supported by expert testimony establishing the similarity between two recorded songs?
- 2.) Whether the District Court erred as a matter of law in dismissing a copyright infringement claim based upon the work not being registered until after a motion for summary judgment had been filed?
- 3.) Whether Damiano's song lyrics have sufficient originality to support a copyright infringement claim?
- 4.) Whether Damiano's song lyrics are substantially similar to Dylans?
- 5.) Whether Damiano's state law claims for misappropriation, breach of confidence

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<sup>1</sup> For purposes of LAR 28.1(a)(i), all issues presented were raised on summary judgment and ruled upon in the attached Opinion and Order dated December 16, 1996.

and breach of an implied-in-fact contract are preempted by the Copyright Act?

- 6.) Whether New Jersey law provides Damiano relief for breach of an implied-in-fact contract where an agent of Dylan and Sony Music Entertainment solicited his songs and services for Dylan's benefit and use?
- 7.) Whether the Lanham Act provides Damiano the right to receive damages and a co-authorship credit and on Dylan's album sleeve as a remedy for lost advertising?

### **STATEMENT OF CASE**

James Damiano filed a six (6) count complaint naming Sony Music Entertainment, Inc. ("Sony") and Bob Dylan ("Dylan") as Defendants on September 15, 1995. In Count I, Damiano alleged copyright infringement, count II alleged violation of the Lanham Act, Count III alleged misappropriation of property, count IV alleged breach of confidence, count V alleged fraud and count VI alleged violations of the Racketeer Influenced Corrupt Organizations Act ("RICO").

Defendants' filed a motion for summary judgment in this action as to all counts on September 9, 1996. The Honorable Jerome Simandle granted Defendants motion as to all counts in an opinion and order dated December 16, 1996. Thereafter, Damiano filed a motion for reconsideration which was denied by Judge Simandle in an Opinion Upon Reconsideration dated August 8, 1997. Damiano filed a notice of appeal on September 8, 1997. Defendants filed a motion for award of attorneys' fees and sanctions under Fed. R. Civ. P. 11 on February 13, 1998. Appellant seeks review of the Orders dismissing Counts I, II, III and IV only.

## STANDARD OF REVIEW

When reviewing a motion for summary judgment, "an appellate court must apply the same test that the district court should have utilized initially, and must determine whether 'no genuine issue as to a material fact remains for trial, and the moving party is entitled to judgment as a matter of law.'" Koshatka v. Philadelphia Newspapers, Inc., 762 F.2d 329, 333 (3rd Cir. 1985)(quoting Goodman v. Mead Johnson & Co., 534 F.2d 566, 573 (3rd Cir. 1976), cert. denied, 429 U.S. 1038 (1977)). In deciding whether there is a disputed issue of material fact, the court must construe the facts and inferences in a light most favorable to the non-moving party. See Aman v. Cort Furniture Rental Corp., 85 F.3d 1074, 1080-81 (3rd Cir. 1996); Pollock v. American Tel & Tel. Long Lines, 794 F.2d 860, 864 (3rd Cir. 1986). The role of the court, however, is not "to weigh the evidence and determine the truth of the matter, but to determine whether there is a genuine issue for trial." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249 (1986).

When reviewing an appeal from a motion for reconsideration, an appellate court's review is generally limited to whether the trial court abused its discretion. Harsco Corp. v. Zlotnicki, 779 F.2d 906, 909 (3rd Cir. 1985); North River Ins. Co. v. Cigna Reinsurance, 52 F.3d 1194, 1219, (3rd Cir. 1995). The purpose of a motion or reconsideration is to correct manifest errors of law or fact or to present newly discovered evidence. Harsco, 779 F.2d at 909. When an appeal from a denial of a motion for reconsideration brings up the underlying judgment for review, the standard of review varies with the nature of the underlying judgment. North River Ins. Co., 52

F.3d at 1218. Where there is a mixed question of law and fact, "the reviewing court should separate the issue into its respective parts, applying the clearly erroneous test to the factual component, the plenary standard to the legal." Id. (quoting Ram Constr. Co. v. American States Ins. Co., 749 F.2d 1049, 1053 (3rd Cir. 1984).

### **STATEMENT OF RELATED CASES**

This case has not been before this Court prior to this appeal and there have not been nor is there pending any appeal from this proceeding other than this one. A motion has been filed in the District Court under Fed. R. Civ. P. Rule 11, and the issues of liability and damages have been bifurcated under Fed. R. Civ. P. Rule 42 (b). Therefore, another appeal may yet be raised in this case.

### **CERTIFICATION OF BAR MEMBERSHIP**

Counsel for Appellant, Robert D. Church, Esq. does hereby certify that he is a member of the Bar of this Court being duly admitted on January 5, 1998.

## STATEMENT OF FACTS

Bob Dylan ("Dylan") released a song in 1994 called "Dignity" which has a substantial similarity to a song recorded by James Damiano ("Damiano") in 1986 entitled "Steel Guitars." A re-recorded version of Damiano's song, "Steel Guitars" (hereinafter "Version II"), was registered with the U.S. Copyright Office in 1988. (A. 194-195). The 1986 version of Steel Guitars (hereinafter "Version I") was registered on December 5, 1996. (A. 160-161). When registering Version II, Damiano submitted a cassette tape of several songs to the U.S. Copyright Office. (A. 195). The songs were recorded in response to marketing assurances made by an employee of CBS Records to a Damiano investor.<sup>2</sup> (A. 141-142). Dylan's song "Dignity" is marketed and sold by Sony Music Entertainment, Inc. on two compilation recordings, "Bob Dylan's Greatest Hits Volume 3" (1994 studio recording) and "Bob Dylan MTV Unplugged" (live).

The only newly released song allegedly authored by Bob Dylan alone, in a span of six years, from 1991 to 1996, was "Dignity." Prior to the release of "Dignity", an employee of CBS Records, Anthony Tiller, arranged for Damiano to meet Dylan backstage at two concerts. (A. 33-34). The first meeting occurred at a Dylan concert at Jones Beach Long Island New York on July 1, 1988 (Damiano's wife, Pam, witnessed the meeting with Dylan himself). (A. 109-110). The second backstage meeting was at Dylan's concert in Waterloo Village, New Jersey in October, 1988 (Damiano and his friend, Brad Wright, met with a Dylan associate by the name of Mike Reed). (A. 112-113). At the first concert, Damiano handed Dylan his written and recorded songs.

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<sup>2</sup> CBS Records has been acquired by Sony Music Entertainment, Inc. since events described herein transpired.

(A. 109). Damiano also gave Mike Reed (Dylan's associate) songs at the second backstage meeting. (A. 112-113).

Damiano met Dylan after submitting substantial material to CBS Records in an attempt to secure a recording contract. (A. 145-146). Damiano's relationship with CBS Records began in the early 1980s when he auditioned for the legendary John Hammond Sr. Id. Mr. Hammond discovered and promoted some of the greatest songwriters of all time, including Bob Dylan. (A. 26). Songs written by Damiano in response to Hammond's interest were first registered with the U.S. Copyright Office in 1982.

Before registering Version I of Steel Guitars with the U.S. Copyright Office, Damiano gave a copy to Mikie Harris, John Hammond Sr's personal assistant. (A. 31). The song was recorded at a friend's home to featured guitar player, "Danny Gallagher." (A. 161). However, Mr. Hammond died on July 10, 1987, and Damiano's anticipated recording contract never materialized.

After Mr. Hammond died, Anthony Tiller, who served as a packaging manager but later became an Associate Director of Marketing Services for CBS Records, assisted Mr. Damiano in developing his material into a marketable format. (A. 141-144). An investor by the name of Mohammad Marhoumy insisted upon Tiller's assurances of a Dylan interest in the Damiano production prior to Marhoumy agreeing to invest \$10,000 into the venture. Id. Tiller gave Marhoumy the assurance of a Dylan connection at a meeting in New York City. Id.

A writer for the Associated Press, Kathryn Baker, interviewed Bob Dylan for an article written in October, 1988. (A. 24, 120-125) In the interview, Dylan confesses to having writer's block and having an interest in using other writer's material. Id. In Ms. Baker's article, she quotes Dylan as saying, "there is no rule that claims that anyone must write their own songs." Id. Dylan also says, "you could take another song somebody else has written and you can make it your own." Id. Dylan also confesses to not being as prolific in writing songs as he had been in the past. He says: "writing is like such an isolated thing. You're in such an isolated frame of mind. You have got to get into or be in that place. In the old days, I could get to it real quick. I can't get to it like that no more ... You're always capable of it in your youth and especially if you're an unknown and nobody cares. Like if your an anonymous person ..." Id.

Dylan's practice of plagiarizing material from other songwriter's is demonstrated by some of Dylan's prior works, including "Bob Dylan's Dream" and "Bertha Lou". In a declaration signed by Eric Von Schmidt on July 3, 1996, he states that he was present at a meeting in 1963 between Dylan and a British songwriter by the name of Martin Carthy. (A. 103). Von Schmidt states that Dylan questioned Carthy about his song called "The Franklin". When Von Schmidt heard the later released song called "Bob Dylan's Dream", he was surprised to find that it was almost a "note for note clone" of "The Franklin". Id.

A former Dylan guitar player, Rob Stoner, testified in a deposition regarding a conversation he had with Dylan about a song recorded by Johnny Burnett and his Trio in 1957 called "Bertha Lou". Stoner considered "Bertha Lou" to be similar to Dylan's

song "Rita Mae." According to Dylan biographer Bob Spitz, Dylan admitted to Stoner that he was familiar with "Bertha Lou." (A. 104). Damiano's expert, Dr. Paul Greene states in a written analysis of the two songs "Bertha Lou" and "Rita Mae" that "remarkable similarities are found in melody, rythm and structure of the two songs." (A. 83). In fact, Dr. Greene found that 87% of the melody of "Bertha Lou" to also be in "Rita Mae." (A. 85).

In another example of plagiarism, Eric Von Schmidt writes in his book, Baby Let Me Follow You Down, that Dylan used Von Schmidt's material when writing Baby Let Me Follow You Down. Dylan admitted to it. and later agreed to give Von Schmidt credit as co-author of the song.

Before releasing his album "Oh Mercy" in 1989, Dylan suffered from writer's block according to a reporter named Patrick Humphries. (A. 130). Humphries quotes Dylan as saying he needed to "get some other real good songwriters to write me some songs." Id. "Oh Mercy" is the first album on which Damiano finds lyrics similar to those he had submitted to CBS Records since 1982 and to Dylan himself in backstage meetings. (A. 15). The backstage meetings occured in 1988. (A. 34, 110).

None of the songs released by Dylan on his "Oh Mercy" album or his "Under the Red Sky Album" brought the acclaim and notoriety of the song released in 1994 called "Dignity." The song "Dignity" was the only new, previously unreleased, song of Dylan's on both his "Greatest Hits Volume III" album and his "MTV's Bob Dylan Unplugged" release.



Professor Paul D. Green, having a Ph.D in Ethnomusicology from the University of Pennsylvania, conducted a comparative analysis of Damiano's 1986 version of "Steel Guitars" to both Dylan releases of "Dignity." (A. 59-82). Professor Greene analyzes the similarities between the melodies of the songs and their structure. The melody in Steel guitars is played on a guitar. The melody in "Dignity" is sung.

Greene's analysis concludes that the melodies of Dignity and Steel Guitars are "strikingly similar." (A. 59, 65). While Greene discusses the melodies in the context of each phrase and subphrase in the songs, he gives careful attention to the main phrases. He calls the main phrases the "melodic arc" of the songs. (A. 59). The main phrases of both compositions share seven prominent pitches, arranged in the sequence 1-5-6-1 ...2-3-1. The ellipses (...) indicates that there is a short gap in the arc in which the two compositions do not share significant similarities. (A. 64). Greene opines the shared arc to embody the melodic shape or character of both compositions. Id. When played on its own, the arc sounds like both compositions. Id. Greene demonstrates the importance of the arc to both pieces in a re-recording of the arcs in each song as they are played on the same instrument for comparative purposes. (A. 81).

Greene also found a structural similarity between "Dignity" and "Steel Guitars". (A. 67). Greene found that 59% of the 100 measures of the structural pattern (order of verses and refrains) of the Greatest Hits Volume 3 version of "Dignity", to be based on the same pattern as "Steel Guitars." (A. 80). Greene found 55% of the 100 measures of the MTV Unplugged version of "Dignity" to be based on the same pattern as "Steel

Guitars." Id. In addition, Greene conducted a survey of over 100 songs in the rock, folk, and folk-rock idioms to determine the originality of the shared pattern between the songs. (A. 94). He found that the structural pattern frequently repeated in the two songs to be uncommon. Id.

Professor Greene analyzed the "creation tapes" for Bob Dylan's "Dignity" to determine whether Dylan may have independently created the melody and structure of the songs. (A. 107). He found that the tapes only document Dylan's experimentation with and creation of the lyrics, style and instrumentation of "Dignity", but not the creation of the structure. (A. 107) Greene also examined Dylans creation tapes--thirteen in all--for experimentation with the melodic arc. He found that since the melodic arc remained consistent on all tapes, they do not document independent creation. (A. 65). He also found the melodic arc shared by "Dignity" and "Steel Guitars" to be rare. Id.

Harold Frazee, a second expert for Damiano from the Berklee College of Music, makes the same conclusions regarding the melody of "Dignity" and "Steel Guitars" were made by Professor Greene. (A. 19-23). He finds that the main parts of Damiano's songs that appear distinctive to be the parts upon which Dignity's melody is based. (A. 21). He further states that it is extremely unlikely and uncommon that the melodic likeness and hook of Damiano's "Steel Guitars" and Dylan's "Dignity" could be so identical without a collaboration between the two co-writers. (A. 23).

The expert testimony of Dr. Green and Harold Frazee describes the musical similarity between Damiano's "Steel Guitars" and Dylan's "Dignity." However, the

remaining similarity claims by Damiano involve lyrics for songs published by Dylan on his albums "Oh Mercy", copyrighted in 1989, and "Under the Red Sky" copyrighted in 1990. As an example, the following lines from Damiano songs and Dylan's song "Most of the Time" are set forth below for a side-by-side comparison:

<u>©Year and Page</u>	<u>Damiano Lyrics</u> (from miscellaneous songs)	<u>Dylan Lyrics</u> (from "Most of the Time")	<u>Appendix Location.</u>
1982 L0002-11	<i>"<u>She stumbles</u> upon things I've never seen One word from <u>her lips</u> can color a dream"</i>	<i>"I can handle whatever I <u>stumble upon ...</u>" "Don't even remember what <u>her lips</u> felt like on mine."</i>	(A. 162, 163)
1982 L0002-16	<i>"Maybe I should just leave it <u>all behind ...</u> If she'd only learn to make up her <u>mind</u>"</i>	<i>"She ain't even on my <u>mind</u> I wouldn't know her if I saw her She's that far <u>behind</u>"</i>	(A. 163, 165)
1988 L0048	<i>"At the <u>time</u> I was alone Had no one by my side No one to <u>run</u> from And no reason to <u>hide</u>"</i>	<i>"Most of the time I know exactly where it went I don't cheat on myself I don't <u>run and hide</u>. Hide from the feelings that are buried inside</i>	(A. 164, 165)

The lyrics presented above illustrate Damiano's influence on Dylan's material for the two albums "Oh Mercy" and "Under the Red Sky". In similar fashion, Dylan demonstrates frequent use of lines from feature films when writing songs. (A. 105-106). Lines adopted by Dylan are set forth below:

COPYRIGHTED LINE

FILM

1. "I don't mind leaving, I'd just like it to be my idea"

Shane

- |  |   |
|--|---|
| 2. "You can trust me now"  | To Have and Not To Have                       |
| 3. "What's wrong with you? Nothing you can't fix"  | The Big Sleep                                 |
| 4. "What would a sweetheart like that Hamilton dame be doing in a dump like this?"               | All Through The Night                         |
| 5. "One day you'll be talking in your sleep and when you do I wanna be around"                   | I Wake Up Screaming                           |
| 6. "I figure we're even. Maybe I'm one up on ya."  | Bend Of The River                             |
| 7. "You don't know what love means. To you it's just another four-letter word."                  | Cat On A Hot Tin Roof                         |
| 8. "Do you know San Francisco" I've been there to a party once.                                  | Build My Gallows High                         |
| 9. "When you live outside the law, you have to eliminate dishonesty."                            | The Line-Up                                   |
| 10. "What happens here tommorrow is on your head not mine."                                      | The Big Country                               |
| 11. "The love of a lousy buck"   | On The Waterfront                             |
| 12. Sulu: "How far do we go along with this charade?"<br>Kirk: "Until we can think our way out." | The Squire of Gothos, an Episode of Star Trek |
| 13. "It's not a house, dear, it's a home"  | Mr. Blandings Builds His Dreamhouse           |
| 14. "No gentleman makes love to a servant in his mother's house."                                | Sabrina                                       |
| 15. "I've got to move fast-I can't with you around my neck."                                     | Sirocco                                       |
| 16. "I don't know whether I'm too good for you or you're too good for me."                       | Sirocco                                       |

## SUMMARY OF ARGUMENT

The District Court found a genuine issue of fact as to whether Bob Dylan had access to James Damiano's song "Steel Guitars" before the song "Dignity" was written by Dylan. (Opinion p.15)<sup>3</sup> Two versions of Damiano's song "Steel Guitars" were recorded. Version I was recorded in 1986, but not registered with the U.S. Copyright Office until December 5, 1996. (A. 160-161). The District Court dismissed Damiano's infringement claim as to Version I of Steel Guitars, which was said by an expert to bear a striking similarity to Dylan's song "Dignity", since the song had not been registered under the Copyright Act. (A. 65; Opin. p.14) Yet, the Act permits Damiano to file a copyright suit for an unpublished work without having a registration. Version II was recorded and registered with the U.S. Copyright Office in 1988. (A. 194-95). The District Court dismissed Version II of Steel Guitars after determining, without the aid of expert testimony, that the song did not sound similar to Dylan's Dignity. (Opin. p.16). The District Court committed reversible error by disregarding expert testimony on a motion for summary judgment as to these copyright claims.

Damiano has a claim under New Jersey law for breach of an implied-in-fact contract with Dylan. The District Court dismissed Damiano's state claims after finding they were preempted by the Copyright Act. (opin. 18-19). However, the elements of misappropriation (Count III) and breach of confidence (Count IV) change the nature of Damiano's claim to preclude preemption. Since Dylan adopted and made use of

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<sup>3</sup> References to the Opinion and Order entered on December 16, 1996 shall hereinafter be designated by abbreviation under FRAP 28(e) to "Opin.;" e.g (Opin. 15). References to the Opinion Upon Reconsideration dated August 20, 1997 shall be abbreviated to "Opin. Recon." Appendix shall be designated: "A."

unpublished songs written by Damiano for the benefit of Sony, both Defendants must compensate Damiano under the principle of unjust enrichment.

Damiano presents a claim under the Lanham Act for "reverse passing off". By denying Damiano credit on Dylan's album sleeve as a co-author to the songs at issue, Dylan violates the Lanham Act. The District Court erred in dismissing this claim since Dylan used Damiano's material.

## ARGUMENT

### **I. Damiano's Copyright Claims Satisfy the Test For Summary Judgment.**

The District Court found only one element of Damiano's musical copyright claims absent when rendering summary judgment for Defendants' Sony and Dylan: however, that was established by an affidavit submitted by Damiano's expert witness prior to summary judgment. (A. 54). The Court analyzed whether Damiano owned a valid copyright in his material, whether the Defendants copied a protectible expression and whether the copying went so far as to constitute an improper appropriation of the plaintiff's work. See Whelan Assoc. v. Jaslow Dental Lab., Inc., 797 F.2d 1222, 1231 (3rd Cir. 1986), cert. denied, 479 U.S. 1031 (1987); Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3rd Cir.) cert. denied, 423 U.S.863 (1975). The ownership and copying elements to Damiano's infringement claim are established by Damiano's submission of valid registrations with the U.S. Copyright Office on the infringed songs and by an expert analysis showing a substantial similarity between Dylan's song Dignity and the songs submitted to CBS Records by Damiano. See Ford Motor Co.v.

Summit Motor Products, Inc. 930 F.2d 277, 290-291 (3rd Cir. 1991). The issue of improper appropriation belongs to the jury. Smith v. Jackson, 84 F.3d 1213, 1218 (9th Cir. 1996).

**A. The District Court Erred By Disregarding Expert Testimony Showing Substantial Similarity Between the Melodies for Damiano's "Steel Guitar's" and Dylan's "Dignity".**

Since the 1986 version of "Steel Guitars" (hereinafter "Version I") was registered for copyright on December 5, 1996, and the post 1986 version of "Steel Guitars" registered in 1988 ("Version II") was found by Damiano's expert to bear melodic similarities to Version I and Dylan's "Dignity", the District Court erred in dismissing Damiano's copyright claims on summary judgment. When an issue of "striking similarity" of two copyrighted works is raised by conflicting opinions of experts, the issue presents a genuine dispute of material fact precluding summary judgment. Repp v. Webber, 132 F.3rd 882 (2nd Cir. 1997). The District Court dismissed Damiano's copyright claims after finding no "substantial similarity" between Damiano's Version II of Steel Guitars and Dylan's Dignity, but the Court refused to consider both parties' expert opinions on the matter. (Opin. p. 15; Opin. Recon. p. 5-8). Damiano's expert, Dr. Paul Greene, first analyzed Version I of Steel Guitars which had not been registered at the time motions for summary judgment were filed. Id. Version II of Steel Guitars is the version that was registered with the U.S. Copyright Office prior to suit being filed. See 17 U.S.C. §411(a) Dylan had access to both songs before writing Dignity. Dr. Greene stated in an affidavit supplementing Damiano's motion for reconsideration that Version

II of Steel Guitars also contains melodic similarities to Version I and Dylan's Dignity. (A. 197). The District Court did not consider Dr. Greene's second analysis upon a motion for reconsideration.

The facts needed proven in a copyright infringement action are "ownership of a valid copyright, and ... copying of constituent elements of the work that are original." Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 361 (1991). A certificate of registration by the U.S. Copyright Office establishes ownership of a valid copyright, and the copying test for an infringement action is met by proof of either direct copying or "inferentially proven by showing that the Defendant had access to the allegedly infringed work and that the allegedly infringed work is substantially similar to the copyrighted work." Ford Motor Co.v. Summit Motor Products, Inc. 930 F.2d 277, 290-291 (3rd Cir. 1991). The District Court found that Damiano had a valid copyright in Version II of Steel Guitars. (Opin. p.13-14). The District Court also found that Damiano presented a genuine issue of material fact as to whether Dylan and Sony had access to Versions I and II of Steel Guitars. (Opin. p.14-15). However, in deciding whether the allegedly infringed work, i.e. Dignity, is "substantially similar" to Version II of Steel Guitars, the District Court refused to consider the expert analysis of Version I of Steel Guitars because it had not been registered. Id. The District Court found Version I of Steel Guitars to be irrelevant since the two versions are themselves "different." (Opin. p. 15). Dr. Greene disagrees. (A. 197).

The Opinion of the District Court does not cite to any Third Circuit case or other authority in dismissing its duty to consider expert analysis when determining whether



two musical works are substantially similar.<sup>4</sup> (Opin. p. 15). However, indicating a reliance upon the "extrinsic" test in copyright law, the District Court stated that "expert testimony is permitted, and often useful, in establishing substantial similarity" under the test. (Opin. p. 15). The Ninth Circuit holds that analytic dissection of a musical work and expert testimony are appropriate to the extrinsic test. Smith v. Jackson, 84 F.3d 1213, 1218 (9th Cir. 1996). In the Opinion Upon Reconsideration, the District Court refused to consider the expert analysis as to both Versions I and II of Steel Guitars by explaining that in its original decision, the Court found that Version II differed in "total concept and feel" to Dignity. (Opin. Recon. p.7). However, reviewing the "total concept and feel" of an allegedly infringed work is part of the "intrinsic" test. See Baxter v. MCA Inc., 812 F.2d 421, 424 (9th Cir. 1987). In Smith, the Ninth Circuit held that the "intrinsic test's subjective inquiry must be left to the jury" and that summary judgment must be denied where plaintiff satisfies the extrinsic test." Smith, 84 F.3d at 1218.

Most recently, the Second Circuit clarified that summary judgment is reversible error where expert testimony establishes the similarity of two works at issue. See Repp, 132 F.3d at 891. In Repp, the Court found that a District Court disregarding expert testimony as to the similarity of two works, attempted to resolve material issues

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<sup>4</sup> When discussing the substantial similarity issue as it relates to the "intrinsic" analysis, the District Court cites Whelan Associates, 797 F.2d 1222, 1234. Whelan explains the extrinsic test, but the analysis for substantial similarity between the extrinsic test and the intrinsic test are different. E.g. Ford Motor Co., 930 F.2d 277, 294 (applying extrinsic test to prove copying, but concluding that unlawful appropriation goes to copying); compare Jarvis v. A&M Records, 827 F.Supp 282 (D.N.J. 1993)(applying "intrinsic" test to determine "unlawful appropriation" after finding direct evidence on "copying" issue). See Alan Latman, "Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 Colum.L.Rev. 1187 (1990)(distinguishing the extrinsic and intrinsic test).

of fact rather than identify them for purposes of summary judgment. Id. at 890. The Court stated:

" In the face of plaintiffs' expert testimony, the district court, relying upon its own 'aural examination' as well as the expert testimony put forth by the defendants, found 'that the two songs do not share a striking similarity sufficient to justify a finding of copying in the absence of access to the copyrighted work.' It was not for the district court to make this factual finding where such strong competing evidence was before it." Id. at 891. (citation omitted)."

After copying is established in the Third Circuit, the test for unlawful appropriation is determined by reviewing the quantitative amount of copying and/or its qualitative importance to the Defendant's work. See Universal Athletic Sales Co. v. Salked, 511 F.2d 904 (3rd Cir) cert. denied 423 U.S. 863 (1975); Jarvis v. A & M Records, 827 F.Supp. 282 (D.N.J. 1993). In reviewing these components of a work, the quantitative aspect of a work can be measured on a "de minimus" standard. See Ringgold v. Black Entertainment Television, 126 F.3d 70 (2nd Cir. 1997)("de minimus" can mean that copying has occurred to such a trivial extent that it falls below the quantitative threshold). An appropriation of the "heart" of a creative work satisfies the qualitative test. See Educational Testing Services v. Katzman, 793 F.2d 533 (3rd Cir. 1986); Harper & Rowe Publishers v. Nation Enterprises, 471 U.S. 539 (1985). In reviewing a claim for musical infringement, copying the constituent elements of the melody from a song will satisfy the test for unlawful appropriation. Nimmer on Copyright §2.05 [D] (1997); see also e.g. Campbell v. Acuff-Rose Music, Inc., 114 S.Ct. 1164, 1169 (1994)(parties conceded that rap group's rearrangement of the basic melody of a song constituted an infringement but for a finding of fair use through parody). The melody is the heart of a song, and Damiano's expert has said, in effect,

that the melody of Steel Guitars has been copied for use in Dylan's Dignity. (A. 54, 59, 197).

The District Court erred by refusing to consider Damiano's expert comparative analysis for Version I of Steel Guitars before entering summary judgment on the grounds of it not being registered. Registration of a copyright is only relevant to damages.<sup>5</sup> Upon finding that a dispute of fact exists as to Dylan's access to both versions of Steel Guitars, the District Court should have considered the expert analysis of the Version I melody. Smith, 84 F.3d at 1218. Since both versions of Steel Guitars contain the protected expression (melody) allegedly infringed by Dignity, only one version needed to be copyrighted. See Twin Peaks Productions v. Publications International, 996 F.2d 1366, 1371-1372 (2nd Cir. 1993)(a registered version of a protected expression may be infringed where an unregistered version has been copied so long as the protected expression is found in both versions). The District Court further refused to consider an expert comparative analysis of the Steel Guitars Version II melody with Dignity's melody upon a motion for reconsideration. (Opin. Recon. p.7-8). The District Court also disregarded proof that Version I received a copyright registration when denying Damiano's motion for reconsideration. (Opin. Recon. 5-7).

In a case remarkably similar to the instant case, the Ninth Circuit reversed a District Court summary disposition of a copyright claim where the Judge could hear no similarity between the songs at issue. E.g. Baxter v. MCA, 812 F.2d 421 (9th Cir. 1987). In Baxter, the Judge had disregarded expert testimony showing a six (6) note sequence in the melody of the two songs at issue. Id. Damiano has produced more

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<sup>5</sup> See section IB of Appellants brief.

evidence of similarity than found in Baxter. His comparative analysis from Dr. Paul Greene shows a similar seven (7) note sequence in the melody of the two songs "Steel Guitars" and "Dignity." (A. 59-62) His expert also found the melodic sequence to be unique. (A. 65).

Greene opines the shared arc to embody the melodic shape or character of both compositions. (A-64). When played on its own, the arc sounds like both compositions. Greene demonstrates the importance of the arc to both pieces in a re-recording of the arcs in each song as they are played on the same instrument for comparative purposes. Id.

Professor Greene calls the melodic arc (main phrase) of each song the A-Phrase in his analysis. (A. 59). Greene considers the A-Phrase in Dignity to be the songs building block. (A. 64). He says that it makes up half the song. Id. However, Greene acknowledge that the A-Phrases (main melody) are varied slightly throughout Dignity creating at times, a significant difference to the comparable A-Phrase for Steel Guitars. Id. The result is that Greene finds a full 55 of the 170 measures in Bob Dylans "Greatest Hits Volume 3 version of "Dignity" to bear striking similarities to "Steel Guitars." Id. This means that 32% of the song is strikingly similar to "Steel Guitars." He finds that 37 of the 181 measures in MTV's Bob Dylan Unplugged version of "Dignity" to bear a striking similarity to "Steel Guitars" or about 20%. (A. 64-65).

Greene also found a structural similarity between "Dignity" and "Steel Guitars". Greene found that 59% of the 100 measures of the structural pattern (order of verses and refrains) of the Greatest Hits Volume 3 version of "Dignity", to be based on the

same pattern as "Steel Guitars." (A. 80). Greene found 55% of the 100 measures of the MTV Unplugged version of "Dignity" to be based on the same pattern as "Steel Guitars." Id. In addition, Greene conducted a survey of over 100 songs in the rock, folk, and folk-rock idioms to determine the originality of the shared pattern between the songs. (A. 94). He found that the structural pattern frequently repeated in the two songs to be uncommon. Id.

Courts have repeatedly refused to grant summary judgment in music plagiarism cases where parties proffer opposing affidavits of musical experts. Gaste v. Kaiserman, 1987-88 CCH Copyr. Law Decisions d26,138 (SDNY 1987) at 21,207, aff'd, 863 F.2d 1061 (2d Cir. 1988); Levine v. McDonald's Corp., 735 F.Supp. 92, 96-98 (SDNY 1990); Testa v. Jansen, 492 F.Supp. 198 (W.D. Pa. 1980)(summary judgment for defendants denied based upon the affidavits of plaintiff's musicologists who expressed their conclusions based on analysis of the songs); see also Blumcraft of Pittsburgh, Inc. v. Newman Bros.Inc., 373 F.2d 905, 907 (6th Cir. 1967)(summary judgment reversed in light of conflicting expert opinions on similarity: "the case could not be decided without weighing this conflicting evidence and accepting the view of one or the other of these expert witnesses").

Both parties in the instant case produced expert affidavits on Version I of Steel Guitars prior to the District Court's entry of summary judgment. Defendants never contended that the melody, harmony or structure of Version II of Steel Guitars differed in any respect from Version I. Hence, the Court should have considered Dr. Greene's report on Version I(the version registered after summary judgment) as applicable to

Version II. By finding the two versions to be different, the District Court engaged in fact finding. Repp, 132 F.3rd at 890. The findings of the District Court contradict the findings of Dr. Greene (as presented before summary judgment as to Version I and on a motion for reconsideration as to Version II) that state both Versions I and II of Steel Guitars contain the same melody which is a protectible expression under U.S. Copyright law. (A. 197). The District Court further had no authority to engage in fact finding on a motion for summary judgment. See Anderson, 477 U.S. at 249.

The District Court should have accepted the expert comparative analysis submitted in a Supplement in Support of Motion for Reconsideration. (A. 197) In addition to producing the supplemental expert analysis, Damiano produced a registration for Version I of Steel Guitars and attached proof of the registration as an exhibit to his Motion for Reconsideration. (A. 160) With proof showing that Version I of Steel Guitars had been filed for registration as proffered prior to summary judgment and that the registration had not been effected until after the summary judgment motions deadline had expired, the District Court should have rendered a decision as to validity of the dispute presented by the expert affidavits in the Opinion Upon Reconsideration. Both the supplemental affidavit and the receipt for registration was evidence which could not have been presented prior to summary disposition (they didn't exist); therefore, the evidence should have been given due account upon reconsideration. See Harsco, 779 F.2d at 909 (purpose of motion for reconsideration is to present newly discovered evidence); see also Wilson v. Mr. Tees, 855 F.Supp. 679, 682083)(D.N.J. 1994)(rejecting contention that District Court lacked subject matter

jurisdiction over a copyright claim where plaintiff attached to a motion to amend his complaint a receipt from the Copyright Office that it received plaintiff's application, fee and deposit for registering the work in dispute).

The record contains ample evidence to demonstrate that both Versions I and II of Damiano's Steel Guitars contain a unique melody which has been infringed by all of Dylan's published versions of "Dignity." The expert affidavit of Dr. Greene states that the seven (7) note melodic arc found in Version I and Version II of "Steel Guitars" is unique. Dylan's use of the same "melodic arc" in his song Dignity creates a genuine dispute of fact as to whether Dylan copied the melody of Steel Guitars when he wrote Dignity. The "substantial similarity" test is met by the comparative analysis presented by Damiano's expert Dr. Greene as to Version I and Version II. Therefore, summary judgment must be denied as to Damiano's musical infringement claims for both Versions I and II of his song "Steel Guitars." See Smith, 84 F.3d at 1218.

**B. Damiano's Copyright Claim For the Steel Guitars Version Registered on December 5, 1996 Survives Summary Judgment Under the 1976 Revisions to the Copyright Act.**

Congress revised the Copyright Act in 1976 to permit authors to proceed with infringement actions for unregistered and unpublished songs. The Copyright Act now provides only that an author of an unregistered and unpublished work may not collect statutory damages and attorney's fees in an action for infringement. 17 U.S.C. § 412; see also 17 U.S.C. §411(a). Federal Courts have jurisdiction to grant relief for infringement of a common law copyright claims since the Copyright Act was amended in

1976 to preempt such state law actions. See Rosciszewski v. Arete Associates, Inc., 1 F.3d 225, 232 (4th Cir. 1993). Therefore, the District Court committed reversible error by stating that Version I of Steel Guitars could not be the basis for an infringement action. (Opin. p. 14). The District Court further erred by refusing to determine whether Version I met the requisite "substantial similarity" test required to prove infringement on the grounds that the work had not been registered. (Opin. p. 14). The District Court should have merely allowed Plaintiff leave to amend the complaint under Federal Rule of Civil Procedure 15(b) to state whether statutory damages and attorneys' fees were sought through a post-complaint registration. See Apple Barrel Productions v. R.D. Beard, 730 F.2d 384 (5th Cir. 1984)(plaintiff's had standing to seek preliminary injunction on copyright registration obtained after the petition was filed); see also Conan Properties Inc. v. Mattel, Inc., 601 F.Supp 1179 (S.D.N.Y. 1984)(registration defect may be cured by filing amended complaint stating that the defect has been cured).

The pertinent provisions of the Copyright Act, as revised in 1976, on the issue of registration are 17 U.S.C. §§408(a), 411(a) and 412. First, the Act provides that "no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title."<sup>6</sup> §411(a). While at first glance §411(a) appears to mandate registration for all copyright actions, the scope of this provision can only be understood in the context of §412:

**§ 412 Registration as prerequisite to certain remedies for infringement**

In any action under this title, other than an action brought for a violation of the rights of the author under section 106A(a) or an action instituted under section

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<sup>6</sup> Only the quoted provision of 17 U.S.C. §411 has relevance for this appeal.



411(b), no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for --  
(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or  
(2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after first publication of the work. 17 U.S.C.S § 412 (West 1994)(emphasis added).

The jurisdiction of federal courts over copyright infringement actions is not affected by the registration mandate in §411. See Rosciszewski v. Arete Associates, Inc., 1 F.3d 225, 232 (4th Cir. 1993)(removing pre-empted state law claims to federal court). Federal Court jurisdiction over matters of copyright law has been conferred under 28 U.S.C.A. §1338(a)(West 1976), which provides that "district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to ... copyrights ... Such jurisdiction shall be exclusive of the courts of the states in copyright cases." Id.

Registration of a Copyright is not a condition for copyright protection. 17 U.S.C. § 408(a)<sup>7</sup>. When Congress amended the Copyright Act in 1976 to limit statutory damages under 17 U.S.C. § 412, it had no intention of precluding common law relief to an author of an unpublished and unregistered work. The objective of the amendment was to provide greater protection for songwriters such as Mr. Damiano and not to deprive them of their common law protections. The objectives for the amendment are made clear in the statute's legislative history, providing:

"The need for section 412 arises from two basic changes the bill will make in the present law.

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<sup>7</sup> The full text of §408(a) is set forth in an addendum to this brief to permit compliance with FRAP 28(f) and LAR 32.1(c).

(2) The great body of unpublished works now protected at common law would automatically be brought under copyright and given statutory protection. The remedies for infringement presently available at common law should continue to apply to these works under the statute, but they should not be given special statutory remedies unless the owner has, by registration, made a public record of his copyright claim.

Under the general scheme of the bill, a copyright owner whose work has been infringed before registration would be entitled to the remedies ordinarily available in infringement cases: an injunction on terms the court considers fair, and his actual damages plus any applicable profits not used as a measure of damages. "

Act of October 19, 1976, Pub. L. No. 94-553, H.R. Conf. Rep. No. 94-1733, 94th Cong., 2d Sess, (1976) reprinted in 1976, 5 U.S. Code Cong. & Admin. News, 5774 (emphasis added).

The legislative history further states that when "providing that statutory damages and attorney's fees are not recoverable for infringement of unpublished, unregistered works, clause (1) of section 412 in no way narrows the remedies available under present law..." Id.

After finding that Damiano had not registered Version I of Steel Guitars, the District Court erred by determining that Version I could not be the basis of an infringement claim. (Opin. p. 14). Regarding Version I, the District Court said that it "cannot be the basis of an infringement claim because plaintiff is unable to show that the work was registered with the Copyright Office. Thus, he has failed to establish a prima facie case of musical infringement for that version of 'Steel Guitars.'" Id. That is simply and unquestionably reversible error

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8      " \* \* \*" represents omitted text reproduced in the Statutory Addendum.

The District Court dismissed Damiano's infringement claim as to Version I of Steel Guitars, finding no dispute of fact as to "ownership". (Opin. p. 13). The Court determined that Damiano could not prove ownership without producing a valid registration on the song with the U.S. Copyright Office. (Opin. Recon. p. 5).

The question of ownership is determined not by registration of a work, but by its "authorship." 17 U.S.C. §201(a).<sup>9</sup> The Third Circuit has acknowledged that "the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection." Andrien, 927 F.2d at 134 (quoting Community for Creative Non-Violence, v. Reid, 490 U.S. 730, 109 S.Ct., 2166, 2171 (1989)).

Damiano's authorship of Version I of Steel Guitars has not been contested by Defendants. When Damiano recorded Version I of his song Steel Guitars, he invoked the protection of the Copyright Act against any infringement of the song. 17 U.S.C. §102(a); Andrien, 927 F.2d at 135 (dictum).<sup>10</sup> The registration of Damiano's song merely entitles him to select statutory damages under 17 U.S.C. §504, and attorney's fees under §505. 17 U.S.C. §412. Even without having registered his song, Damiano is still entitled to seek common law damages for infringement of his song. Common law damages include the profits earned on the compilation recordings which infringe Damiano's songs. See Thomas Trust v. Crown Publishers, Inc., 456 F.Supp. 531 (SDNY 1977) aff'd 592 F.2d 651 (2d Cir. 1978); Nimmer on Copyright §14.03 [B],[C].

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<sup>9</sup> The statute reads under §201:

"(a) **Initial ownership.** Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work." 17 U.S.C. §201(a).

<sup>10</sup> Works of authorship include "sound recordings" under §102(a)(7).

Damiano's authorship of Version I of Steel Guitars, being uncontested, permits him to receive copyright protection under the 1976 revisions to the Copyright Act from the moment the song was created. See Hasbro Bradley, Inc. v. Sparkle Toys, Inc., 780 F.2d 189 (2nd Cir. 1985)(Japanese toy manufacturer entitled to copyright protection from creation date for works published in Japan before U.S. corporation had been assigned the rights to register and publish the toys in the United States); see also Hagendorf v. Brown, 699 F.2d 478 (9th Cir.) aff'd on rehearing, 707 F.2d 1018 (1983)(noting that the 1976 revisions to the Copyright Act provide that registration of a copyright is no longer the act that creates federal protection). Damiano's December 5, 1996 registration of copyrights validate his ownership of those works. He is, therefore, entitled to any relief which he can prove for infringement of the copyrights. Moore's Federal Practice, §54.70 (3rd ed. 1997). Relief is determined by the merits of the case, not by the pleadings. Feldman v. Philadelphia Housing Authority, 43 F.3d 823 (3rd Cir. 1994). Therefore, summary judgment should have been denied Defendants for infringement claims dismissed for reasons of registration inadvertance Damages may be resolved after trial on the liability issues.

**C. Dylan "Cherry-Picked" Damiano's Original Lyrics Which Were Registered For Protection At the U.S. Copyright Office.**

The District Court erred by dismissing Damiano's claims for infringement of his song lyrics on the grounds that the lyrics lacked "originality." (Opinion p. 13). A valid certificate of registration from the U.S. Copyright Office creates a presumption that a work is "original" which may only be overcome by the Defendant offering proof to the

contrary. Masquerade Novelty v. Unique Industries, 912 F.2d 663, 668-669 (3rd Cir. 1990). The Register of Copyrights has issued certificates to Damiano for the lyrics at issue, but only fragments of the registered lyrics were used by Dylan. Nevertheless, Damiano's song lyrics are protected under the Copyright Act. See ABKCO Music v. Stellar Records, 96 F.3d 60 (2nd Cir. 1996).

To refute "originality" in Plaintiff's work, Defendants' must show that the Copyright Office erroneously applied the copyright laws in registering plaintiff's work.

Id. The U.S. Supreme Court explains the "originality" test as follows:

"To qualify for copyright protection, a work must be original to the author ...Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity ...To be sure, the requisite level of creativity is extremely low, even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be ...Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence copyrightable. Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 345-346 (1990)(citations omitted)(emphasis added).

The Supreme Court adds an important limitation to the protection of literary works in Feist Publications. The Court further noted: "'No author may copyright facts or ideas. The copyright is limited to those aspects of the work--termed 'expression'--that display the stamp of the author's originality.'" Id. at 350 (quoting Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 547-548 (1985)).

The following lines from Damiano's lyrics were presented to the District Court, having valid copyright registrations, in opposition to Defendant's motion for summary judgment for side-by-side comparison to lines credited to Dylan on the albums "Oh Mercy" and "Under A Red Sky":<sup>11</sup>

<u>©Year and Page</u>	<u>Damiano Lyrics</u> (from miscellaneous songs)	<u>Dylan Lyrics</u> (from "Most of the Time")	<u>Appendix Location.</u>
1982 L0002-11 &L2009	<b><i>"She <u>stumbles</u> upon things I've never seen One word from <u>her lips</u> can color a dream"</i></b>	<b><i>"I can handle whatever I <u>stumble</u> upon ..." "Don't even remember what her lips felt like on mine."</i></b>	(A.162, 165 )
1982 L0002-16	<b><i>"Maybe I should just leave it all <u>behind</u> ... If she'd only learn to make up her <u>mind</u>"</i></b>	<b><i>"She ain't even on my <u>mind</u> I wouldn't know her if I saw her She's that far <u>behind</u>"</i></b>	(A. 163, 165)
1988 L0048	<b><i>"At the <u>time</u> I was alone Had no one by my side No one to <u>run</u> from And no reason to <u>hide</u>"</i></b>	<b><i>"Most of the time I know exactly where it went I don't cheat on myself I don't <u>run and hide</u>. Hide from the feelings that are buried inside"<sup>12</sup></i></b>	(A. 164, 165)

<sup>11</sup> The full text of the paraphrased lyrics are set forth in the appendix on the pages indicated. In the lower Court, Defendant's took issue with the layout of Damiano's lyrics in his complaint. Therefore, Defendant's side-by-side comparisons are reproduced in the appendix.

<sup>12</sup> Damiano wrote a lyric "Buried deep down inside".

<u>©Year and Page</u>	<u>Damiano Lyrics</u> (from miscellaneous songs)	<u>Dylan Lyrics</u> (from miscellaneous songs)	<u>Appendix Location.</u>
1988 L0024	<b><i>"What good is a man"</i></b>	<b><i>"What good am I"</i></b> <sup>13</sup>	(A. 169-170)
1988 L0006	<b><i>"Truer words Have not been spoken And once again the truce Is broken"</i></b>	<b><i>"Truer words Have not been spoken or broken ..."</i></b>	(A. 172, 174)
1988 L0035	<b><i>"No one deserves anything more than what they need"</i></b>	<b><i>"You dont get anything you don't deserve"</i></b>	(Opin. p. 9; A. 174)
1982 L2038	<b><i>"On the door to heaven There ain't no bell Probably the same way On the door to hell"</i></b>	<b><i>"Listen to the engine, listen to the bell As the last fire truck from hell goes rolling by"</i></b>	(A. 176, 178)

The District Court dismissed all of the above listed lyrics for not having sufficient "originality" to be copyrightable. (Opinion p. 9-13). The District Court also found that the lyrics "when taken as a whole" are not "substantially similar" to Dylan's work. (Opin. p.13).

This Court reached the issue of originality when dealing with a copyright action brought by a maker of "nose masks" configured to resemble the noses of a pig, elephant, and a parrot. Masquerade Novelty v. Unique Industries, 912 F.2d 663 (3rd Cir. 1990). The District Court had dismissed the copyright claims on summary judgment on the grounds that the sculptural elements of the masks could not be separated from their utilitarian function of allowing people to humorously masquerade

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<sup>13</sup> At his deposition, Damiano quoted from memory a second passage from his lyrics which is similar to another line from Dylan's song "What Good am I." However, the line was not presented to the District Court for analysis. Appellant addresses the lyric in Part IIB of this brief.

as humans with an animal feature. Id. at 666-667. The Third Circuit reversed the District Court. Id. at 668-669. Damiano's copyrights establish the "originality" of his lyrics. The burden for Damiano to bear is establishing actual infringement by Dylan. See Id. at 671. He proves this by showing Dylan copied "recognizable paraphrases" of his literary works. See Educational Testing Services v. Katzman, 793 F.2d 533, 542 (3rd Cir. 1986).

Damiano has produced strong evidence of Dylan having access to his lyrics before writing the material for "Oh Mercy" and "Under the Red Sky." Damiano handed his material to Dylan directly while backstage at a concert held at Jones Beach in New York on July 1, 1988. (A. 109-110). The meeting had been pre-arranged by an employee of CBS Records, Anthony Tiller. (A. 33-34). Damiano also handed lyrics to a Dylan associate, Mike Reed, at a concert held at Waterloo Village, New Jersey in October, 1988. (A. 112-113). In the same month, Dylan confessed a need for other writer's material in a newspaper article published by Kathryn Baker. (A. 120). Dylan had writer's block. (A. 120). The District Court found that Damiano had established a dispute of fact as to whether Dylan had access to his material. (Opin. p. 15).

This Court determines de novo whether Damiano's lyrics are "substantially similar" to Dylan's. See Universal Athletic Sales Co, 511 F.2d 904. The Court must determine whether there has been a taking of the independent work of the copyright owner which is entitled to statutory protection. Id. at 909. Statutory protection is evaluated in terms of the owner's independent effort and creativity in creating a work. Id. "The smaller the effort (e.g. two words) the greater must be the degree of creativity



in order to claim copyright protection." Id. at 908 (quoting Nimmer on Copyright §10.2). Therefore, in finding "substantial similarity", the Court must make an ad hoc determination that an "ordinary reasonable person" would conclude that the defendant unlawfully appropriated the plaintiff's protectible expression. Educational Testing Services, 793 F.2d at 541.

Damiano's lyrics exhibit the creativity necessary to meet the "originality" test for protection under copyright law. The registrations he has on his lyrics establish their originality and creativity. Dylan's use of these lyrics in a substantially similar form of expression as found in Damiano's song constitutes a factual issue as to copyright infringement.

The "total concept and feel" of Dylan's song "Most of the Time" is captured in Damiano's previously written lyrics. In Jarvis v. A & M Records, 827 F.Supp. 282 (D.N.J. 1993), a District Court found that the phrases "ooh", "move" and "free your body" used together made up a copyrightable expression of an idea given the "precise relationship of the phrases vis a vis each other". Jarvis, 827 F.Supp at 292(emphasis added). The "total concept and feel" of the lyrics to "Most of the Time" can be found in the lyrics Damiano submitted to Dylan while backstage. See Baxter v. MCA, 812 F.2d 421, 424 (9th Cir.1987)(similarity of expression is determined by an "intrinsic" analyses by asking whether Defendant's captured the "total concept and feel" of plaintiff's work); see also Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970)(similarity in "total concept and feel" of greeting cards constituted infringement of tangible expressions).. Damiano's copyright claims are based upon Dylan's use of

words and phrases in a similar expression as Damiano. See Jarvis, 827 F.Supp at 292;

Viewing the evidence in a light most favorable to Damiano, the Court must find a genuine dispute of fact as to whether Dylan copied Damiano's registered lyrics. See Adickes v. S.H. Kress & Co., 398 U.S. 144 (1970).

## **II. Damiano's State Law Claims Prevail Over The Preemptive Reach Of Copyright Law**

The District Court erred by dismissing Counts 3 and 4 of Damiano's complaint which seek relief for Breach of Confidence and Missappropriation of Property. The District Court found these claims preempted under federal copyright law. (Opin. p. 18). However, both claims establish the necessary elements of "confidence" and "misappropriation" to remove a claim from the scope of copyright preemption. In addition, Damiano's has established a breach of an implied-in-fact contract since the music and lyrics that Damiano delivered to Dylan was at the request of an employee of CBS Records acting on behalf of both Sony and Dylan. The music and lyrics were adopted and made use of by Dylan.

### **A. The Scope Of Copyright Preemption Does Not Reach A Breach In Confidence Through Misappropriation Of An Idea.**

The District Court erred in finding that Damiano's state law claims alleging breach of confidence and misappropriation for Dylan's unauthorized use of his material were preempted by federal copyright law. (Opin. p. 18-19). When Congress amended the Copyright Act in 1976 to preempt state common law claims, it expressly exempted

rights and remedies available under State law which do not come within the subject matter of the statute. 17 U.S.C. §301(b). The U.S. Supreme Court has held that state actions for breach of confidence do not conflict with the federal objectives in regulating copyrights. See Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1973). The Supreme Court has further held that contractual rights affecting intellectual property and arising under state law, are also not preempted by copyright laws. See Aronson v. Quick Point Pencil Co., 440 U.S. 257 (1978). Therefore, New Jersey law protecting quasi-contractual relationships arising out of disclosure of novel ideas does not conflict with the scheme of federal Copyright law. E.g. Fleming v. Ronson Corp., 258 A.2d 153 (N.J.Super.L.D. 1969), aff'd, 275 A.2d 759 (N.J.Super.AD 1979)(misappropriation of a novel idea communicated with the intent of compensation creates liability in contract); see also Capital Films Corp. v. Charles Fries Productions, 628 F.2d 387 (5th Cir. 1980)(disclosure of a novel idea creates a "confidential relationship").

The preemptive reach of federal copyright law after Congress amended the statute in 1976 is set forth in 17 U.S.C. §301 and its legislative history. The statute provides in pertinent part:

**"§ 301. Preemption with respect to other laws.**

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under common law or statutes of any State with respect to --

- (1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or
- (2) any cause of action arising from undertakings commenced before January 1, 1978; or
- (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106." 17 U.S.C.S. §301(a),(b) (West 1997).

Congress provided in the legislative history of §301 that State causes of action for misappropriation and breach of confidence are not preempted. The legislative history to §301(b)(3) (quoted above) provides in clear unmistakable language: "The examples in clause (3), while not exhaustive, are intended to illustrate rights and remedies that are different in nature from the rights comprised in a copyright and that may continue to be protected under State common law or statute. The evolving common law rights of 'privacy,' 'publicity,' and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement. Nothing in the bill derogates from the rights of parties to contract with each other and to sue for breaches of contract... 'Misappropriation' is not necessarily synonymous with copyright infringement, and thus a cause of action labeled as 'misappropriation' is not preempted if it is in fact based neither on a right within the general scope of copyright as specified by section 106 nor on a right equivalent thereto. For example, state law should have the flexibility to afford a remedy (under traditional principles of equity) against a consistent pattern of unauthorized appropriation by a competitor of the facts (i.e. not the literary expression) consisting 'hot' news..." Act of

October 19, 1976, Pub. LNo. 94-553, H.R. Conf. Rep. No. 94-1733, 94th Cong., 2d Sess, (1976) reprinted in 1976, 5 U.S. Code Cong. & Admin. News, 5748 (emphasis added).

State law is preempted where it protects a right "equivalent" to rights related to reproduction, derivative work preparation, distribution, performance or display of a work.<sup>14</sup> People v. Borriello, 588 N.Y.S.2d 991, 994, 155 Misc.2d 261 (1992). State law is also preempted if it applies to a "work of authorship 'within the subject matter of copyright as defined in the Act.'" Id. (quoting §301). If other elements are required by the state statute the right does not lie "within the general scope of copyright and there is no preemption. Id. Thus, if the nature of a common law or statutory right protects an "extra element" making it "qualitatively" different to rights protected by the Copyright Act, the common law right is not preempted. See Id. at 994.

Distinguishing rights that are and are not preempted is done by evaluating the elements of the right or statute in question. For example, the Ninth Circuit Court of Appeals analyzed a California statute under §301 punishing the piracy or "misappropriation" of recorded music for commercial gain. See Anderson v. Nidorf, 26 F.3d 100 (9th Cir. 1994). The Court found no preemption since the statute did not just protect the copyright owner; it protected consumers from a deceptive commercial practice. Id. at 102. Using the same analysis, the New York Supreme Court found State crimes prohibiting the false labelling of a recording and the possession of a forged instrument to survive the preemption test. 588 N.Y.S..2d at 995.

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<sup>14</sup> These are the exclusive rights listed under 17 U.S.C. § 106.

The elements for Damiano's claims under Count 3 (misappropriation of property), Count 4 (breach of confidence) and breach of an implied-in-fact contract, add the requisite extra elements necessary to change the nature of his copyright claim into a cause of action for unjust enrichment under New Jersey law. See Fleming, 258 A.2d at 156-157. Where a novel idea, which may or may not be copyrightable, is submitted to someone in confidence, New Jersey law will imply a contractual and/or fiduciary duty upon the recipient to pay restitutionary damages for any beneficial use made of the idea. Id. While the nature of the action brought is in contract, the elements of the action arise out of the tort of misappropriation of an idea. Thus, where an advertising agency submitted a promotional idea to a casino for a sweepstakes called "The Treasure of Atlantis", a cause of action was found for misappropriation when the casino later sponsored a sweepstakes called "The Treasure of Atlantis Sweepstakes." See In Re Elsinore Associates, 102 B.R. 958 (Bkrcty D.N.J. 1989). In Damiano's case, he submitted solicited material to Dylan himself, who used the material on albums sold by Sony Music Entertainment. By pleading the elements for misappropriation and breach of confidence, Damiano has pled a cause of action for unjust enrichment under New Jersey law. See Rannels v. S.E. Nichols, Inc., 591 F.2d 242 (3rd Cir 1979)(notice pleading requires only a short and plain statement); accord Jersey Shore S & L v. Edelstein, 530 A.2d 1320 (N.J.Super.Ch. 1987)(unjust enrichment found given the general nature of the claim); see also Schott v. Westinghouse Electric Corp., 259 A.2d 443, 450 (PA 1969)(novelty need not be alleged in a claim for misappropriation of an idea).

The elements for a State cause of action relating to a breach of confidence or misappropriation of a novel idea are the type of elements that remove a cause of action from the preemptive reach of U.S. patent law or copyright law. See Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1973)(trade secrets claim not preempted); see also Aronson v. Quick Point Pencil Co., 440 U.S. 257 (1978)(contractual right affecting unpatented idea not preempted).

The District Courts mistake of law in finding preemption under §301 for Damiano's claims of misappropriation of property and breach of confidence could not be clearer. The District Court found that insofar as Damiano's misappropriation claim is based upon the alleged unauthorized use of plainiff's material by Bob Dylan it is equivalent to a copyright claim. (Opin. p. 18-19). Yet, the District Court found (contrary to law) that all of Damiano's lyrical infringement claims were deficient on the grounds of "originality." (Opin. p. 13) While it is true that the subject matter of copyright does not protect facts and ideas (see Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 350 (1990)), New Jersey law protects the misappropriation of even an uncopyrightable idea when it is adopted and made use of. Fleming, 258 A.2d at 156-157. The confidential relationship supporting Damiano's State claim is established by the District Court finding a genuine dispute of fact as to whether Dylan had access to Damiano's novel lyrics. See Capital Films Corp. v. Charles Fries Productions, 628 F.2d 387 (5th Cir. 1980).

The fundamental question the District Court could not address at summary judgment is whether Dylan misappropriated Damiano's lyrics. Whether the lyrics are

copyrightable or not, Damiano is entitled to have a jury answer the question. Federal law does not deprive Damiano of his day in Court.

**B. New Jersey Law Provides Damiano Relief For Misappropriation of Ideas and Breach Of A Contract Implied-In-Fact By Dylan and Sony Music Entertainment**

Damiano presents a strong claim under New Jersey law for breach of an implied-in-fact contract. By submitting the novel ideas in his songs to Dylan, he created a confidential relationship by which he can recover damages for misappropriation. See Capital Films Corp. v. Charles Fries Productions, 628 F.2d 387 (5th Cir. 1980); accord Fleming, 258 A.2d 153. (recognizing unjust enrichment based upon misappropriation in New Jersey); see also Hirsch v. Travelers Insurance Co., 341 A.2d 691 (N.J.Super. 1975)(imposing a constructive trust against an estate which had been unjustly enriched). Dylan has demonstrated a pattern of plagiarizing novel phrases from popular feature films when writing songs. Dylan has also been accustomed to stealing the melodies and rhythm from other musicians' material. The music and lyrics he stole from Damiano were submitted by Damiano with an expectation for compensation. Dylan admitted an interest in using material from "anonymous writer's" in a newspaper interview at the very time he solicited Damiano's material. (A. 24, 120-125). Dylan's use of Damiano's material without permission created a contract implied-in-fact. See Effects Associates v. Cohen, 908 F.2d 555, 15 U.S.P.Q.2d 1559 (9th Cir. 1990).

New Jersey law provides three elements to claims for misappropriation of an idea: (1) that the idea was novel; (2) that the idea was made in confidence; and (3) that



the idea was adopted and made use of. Fleming, 258 A.2d at 157. Where a person communicates a novel idea to another party with the intention that the latter may use the idea and compensate him for such use, the other party is liable for such use and must pay compensation if he actually appropriates the idea and employs it in connection with his own activities. Id. When a promise is said to be implied-in-fact, the promise is found by interpretation of a promisor's words or conduct. 3 Corbin §561.

Damiano began submitting material to CBS Records in the early 1980s through the office of John Hammond Sr. (A. 145-146). Damiano acquired the assistance of a CBS employee, Anthony Tiller, in securing the funds necessary to produce a studio recording of his music. (A. 141-144). Mr. Tiller met with Mohammed Marhoumy to give assurances that Bob Dylan would receive the recording if Mr. Marhoumy invested \$10,000 into the production. Id. In addition, Mr. Tiller arranged for Damiano to meet Dylan backstage at two concerts to deliver additional lyrics and material to Dylan's for his considered use. (A. 33-34).

Dylan gave a revealing interview to a reporter for the Associated Press during the same month that his associate, Mike Reed, received material from Damiano at a backstage meeting at Dylan's concert at Waterloo Village, New Jersey. (A. 24, 120-125) In October, 1988, Kathryn Baker published an article about Dylan's writer's block. Id. She wrote that Dylan said the following: "there is no rule that claims that anyone must write their own songs." Id. Dylan also said "you could take another song somebody else has written and you can make it your own." Id.

Until Damiano's material enters the public domain, Dylan and CBS (i.e. Sony Music Entertainment) are bound to keep his ideas in confidence or compensate him for any commercial use of the ideas. See Capital Films Corp. v. Charles Fries Productions, 628 F.2d 387 (5th Cir. 1980); accord Fleming, 258 A.2d 153.

The ideas embodied in Damiano's material are indeed, novel. For example, Damiano presented similarities between his lyrics and Dylan lyrics found in three songs. The Defendant's contested the copyright allegations as to these lyrics in the lower court, but regarding the State claims, the Defendants' only contested the issue as to whether they were given to Dylan in confidence.<sup>15</sup> The disputed lyrical allegations involve the Dylan songs "Dignity", "Disease of Conceit" and "What good am I".

Damiano registered a song with the U.S. Copyright Office containing the lyric "give up your dignity." The ideas embodied in Dylan's song "Dignity" may have been adopted from this lyric in Damiano's song registered for copyright in 1982. In one line, Dylan says, "Lookin into the lost, forgotten years, For Dignity." Damiano contends this lyric was misappropriated from a song he registered for copyright in 1991 containing the line "Long lost days, Forgotten Years." The idea of a "year" being "lost" is novel.

The District Court erroneously deemed Damiano's claims for relief as to the lyric "Lost and forgotten years" to be abandoned at summary judgment. (Opin. p. 6, note 6). Damiano clarified in a motion for reconsideration that he had not abandoned this claim. (Opin. Recon. p. 13). Given that Damiano submitted argument on the misappropriation claim as to "Dignity", Defendants have suffered no prejudice regarding the claim and an

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<sup>15</sup> The preemption argument as to the State claims is addressed under section II.A, above.

amendment to the pleadings under Federal Rule of Civil Procedure 15(b) is appropriate. See Apple Barrel Productions v. R.D. Beard, 730 F.2d 384 (5th Cir. 1984)(reversible error for District Court to not consider unplead misappropriation claim where Defendant's suffered no prejudice). The relevant inquiry for the Court on an unjust enrichment claim is measuring the amount of labor and services Damiano contributed to develop marketable ideas for use by Defendants. Cf. D'Federico Inc. v. New Bedford Redevelopment Authority, 723 F.2d 122 (1st Cir 1983)(contractor subjected to additional labor was entitled to relief under doctrine of unjust enrichment); In Re Meyertech Corp., 831 F.2d 410 (3rd Cir. 1987)(post-judgment amendment to pleadings permitted for issue "fairly adjudicated" under FRCP 15(b))<sup>16</sup>. All of Damiano's lyrics written for Dylan during the time of negotiations (or disclosures of ideas) are relevant. The lyrics have all been produced in discovery (i.e. those not lost).

Damiano also submitted the lyric "Disease of Conceit" as a claim for relief in this proceeding. The District Court dismissed the federal claim on this lyric since it had not been registered with the U.S. Copyright Office. (Opin. Recon. p.10). Damiano's lyric is substantially similar to Dylan's lyric "Disease of Conceit". Damiano's lyric is clearly novel and contested as to whether it has been adopted and made use of. Indeed, "Conceit is a Disease" meets the originality test under copyright law. Universal Athletic Sales, 511 F.2d at 908 (two words highly creative). However, if Damiano is not entitled to relief for the misappropriation under copyright law, he is certainly entitled to damages under State law.<sup>17</sup> Apple Barrel Productions v. R.D. Beard, 730 F.2d 384

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<sup>16</sup> The Third Circuit cites D'Federico inaccurately in In Re Meyertech as a Third Circuit case.

<sup>17</sup> It is not conceded that Damiano's lyric is not protected under U.S. Copyright law.

(5th Cir. 1984)(adoption of the title "Kids 'n Country" by competing program "The Country Kids Show" raised a triable issue of fact on claim for misappropriation).

When testifying at his deposition, Damiano, raised a second contention of misappropriation regarding Dylan's song "What Good Am I?" (A. 170, 187-189). In addition to the lyric "What good is a man?" (raised as an infringement claim)<sup>18</sup>, Damiano found a similarity between another lyric in the song and a song he wrote in or about the year 1982. A comparison between Damiano's lyric and Dylan's is set forth below:

**Damiano's Lyric**

***"Guitars strumming,  
angels humming,  
the child fast asleep.  
Not involved, nothing resolved,  
in the night you could hear  
his soul weep"***

**Dylan's Lyric**

( from "What Good Am I?" )

***"What Good Am I  
While you softly weep  
and I hear in my head  
what you say in your sleep  
And I freeze in the moment  
like the rest who don't try  
What good am I"***

The lyrics in both these songs paint a picture of a person avoiding involvement with someone in need (highlighted by their being "asleep"). In Dylan's song he asks "What good am I? (for lack of involvement). In another Damiano song, he asks "What good is a man?" The issue for a jury to decide is whether Dylan adopted and made use of Damiano's ideas by writing the song "What good am I?"

Damiano's claims for misappropriation cannot be dismissed with evidence of independent creation on a motion for summary judgment. Repp, 132 F.3rd 882. If any

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<sup>18</sup> See Section I.C, above.

evidence of independent creation exists, it is for the trier of fact to weigh its credibility in light of all the evidence. See e.g. In Re Elsinore Associates, 102 B.R. 958 (Bkrcty. D.N.J. 1989).

By demonstrating that Damiano submitted his ideas directly to Dylan at Defendants' request, and by showing Dylan's use of the idea submitted, Damiano has presented a triable issue of fact for a jury. Schott v. Westinghouse Electric Corp., 259 A.2d 443 (Pa 1969). In Schott, a Westinghouse employee had submitted an idea to a suggestion committee to make gauge steel panels for circuit breakers as opposed to cast aluminum panels. Id. at 445. The idea had been submitted in response to a campaign offering money for profitable ideas. Id. However, the employees' idea was rejected on three occasions. Id. Regarding the third rejection, the employee pled in his complaint that a letter had been mailed to him stating that the idea had been used but developed independently without knowledge of the employee's suggestion. Id. The Pennsylvania Supreme Court reversed an order from the trial court dismissing the complaint. Id. The Court found that the letter (attached to the complaint as an exhibit) raised a triable issue of fact for a jury since it appeared the company had applied the "same basic idea." Dismissing a claim for unjust enrichment on the grounds of independent creation is reversible error. Id.

The ideas and lyrics submitted by Damiano are at least as novel as the phrases "The Trial of Lee Harvey Oswald", Capital Films Corp., and "Kids 'n Country", Apple Barrel Productions. His disclosure of his lyrics to CBS Records and Bob Dylan created a confidential relationship. Capital Film Corp, 628 F.2d at 394. Dylan's custom of

plagiarizing other writer's material and his public comments about songwriting demonstrate a clear intent on his part to consider Damiano's lyrics for commercial advantage. Why did he take Damiano's lyrics at a backstage meeting? When Dylan ultimately used Damiano's lyrics, he became subject to liability for misappropriation and breach of confidence. The District Court erred as a matter of law in dismissing these claims.

Damiano may recover for breach of an implied in fact contract even if it has not been properly pled. Relief is determined by the merits of the case, not by the pleadings. Feldman v. Philadelphia Housing Authority, 43 F.3d 823 (3rd Cir. 1994).

### **III. Damiano Deserves Credit As Co-Author To Dylan's Material Under the Lanham Act and An Accounting Under Copyright Law.**

The Copyright Act and the Lanham Act provide Damiano indispensable remedies for his contributions to Dylan's songs. Summary Judgment may not be granted on a copyright claim where evidence shows that a party has made a creative contribution to a work which is being exploited by another. Community for Creative Non-Violence v. Reid, 846 F.2d 1485 (D.C. Cir. 1988) aff'd 490 U.S. 730 (1989); Andrien v. So. Ocean County Chamber of Commerce, 927 F.2d 132 (3rd Cir. 1991). The Lanham Act entitles the co-author of a published song to credit on the album sleeve for his contribution. Lamothe v. Atlantic Recording Corp., 847 F.2d 1403 (9th Cir. 1988). In a case such as Damiano's, a joint authorship may be found based upon the parties collaborative effort in writing the songs at issue. E.g. Reid, 846 F.2d 1485. Summary judgment is not appropriate where an issue of fact exists as to each author's individual contribution to a

work. Andrien, 927 F.2d at 136. Therefore, the District Court erred by dismissing Damiano's co-authorship claims.

Damiano seeks an accounting as to the profits earned by Dylan from the song "Dignity" under copyright law. He also seeks an accounting for profits arising under an implied-in-fact contract for misappropriation of his lyrics. Dylan wrote the music for the songs "Most of the Time", "What good Am I", and "Disease of Conceit." However, Damiano made a significant contribution to the lyrics of these songs. His contributions certainly exceed the "de minimus" test enunciated by Justice Ginsburg in Reid. Since his contributions were written with the intent on his part and Dylan's for publication by CBS Records, Damiano is, at the very least, a co-author to those three songs. See Erickson v. Trinity Theatre, 13 F.3rd 1061 (7th Cir. 1994). Therefore, Damiano is entitled to maintain his copyright actions on the Dylan songs which incorporate Damiano's lyrics (not just music). Andrien, 927 F.2d at 136.

In Lamothe, the Ninth Circuit found that a co-author to a song has a "reverse palming off" case against a co-author who publishes a joint work without giving credit to the co-author. Lamothe, 847 F.2d 1407. The harm to the co-author deprived of credit is that he is "involuntarily deprived of the advertising value of [his] name and the goodwill that otherwise would stem from the knowledge of the true source of the satisfactory product." Id.; Gilliam v. American Broadcasting Co., 538 F.2d 14, 24 (2d Cir. 1976); Smith v. Montoro, 648 F.2d 602 (9th Cir. 1981).

The lost advertising value to Damiano is significant in this case. Crediting him as the source of Bob Dylan's ideas for songs will add value to his material and give him

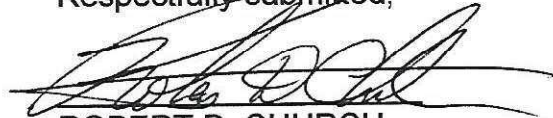
leverage to negotiate future recording contracts. When Dylan made use of Damiano's material, he added value to the songs in the same way John F. Kennedy added value to his ordinary set of golf clubs.

Can anyone dispute that receiving credit as a co-author to a song published by Bob Dylan has significant value in the entertainment industry? Dylan's deprivation of this title of honor to Damiano violates the Lanham Act. In addition, Dylan's infringement of Damiano's song lyrics creates a joint authorship remedy for damages under the Copyright Act. Therefore, the District Court's dismissal of these claims on summary judgment must be overturned.

### **CONCLUSION**

For the foregoing reasons, Appellant respectfully requests that the judgment entered below be reversed and vacated as to Counts I, II, III and IV and that the case be remanded to the District Court for trial on the issues raised.

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY on this 16<sup>th</sup> day of April, 1998, that two (2) copies of the foregoing Brief of Appellant was mailed First Class, postage prepaid to:

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## STATUTORY ADDENDUM

The Copyright Act provides in pertinent part under 17 U.S.C. §408 as follows:

**"(a) Registration permissive.** At any time during the subsistence of the first term of copyright in any published or unpublished work in which the copyright was secured before January 1, 1978, and during the subsistence of any copyright secured on or after that date, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708. Such registration is not a condition of copyright protection." 17 U.S.C.S. §408(a) (West 1994).

The legislative history for 17 U.S.C. §412 provides in pertinent part:

"The need for section 412 arises from two basic changes the bill will make in the present law.

- (1) Copyright registration for published works, which is useful and important to users and the public at large, would no longer be compulsory, and should therefore be induced in some practical way.
- (2) The great body of unpublished works now protected at common law would automatically be brought under copyright and given statutory protection. The remedies for infringement presently available at common law should continue to apply to these works under the statute, but they should not be given special statutory remedies unless the owner has, by registration, made a public record of his copyright claim.

Under the general scheme of the bill, a copyright owner whose work has been infringed before registration would be entitled to the remedies ordinarily available in infringement cases: an injunction on terms the court considers fair, and his actual damages plus any applicable profits not used as a measure of damages. However, section 412 would deny any damage award of the special or 'extraordinary' remedies of statutory damages or attorney's fees where infringement of copyright in an unpublished work began before registration or where, in the case of a published work, infringement commenced after publication and before registration (unless registration has been made within a grace period of three months after publication). These provisions would be applicable to works of foreign and domestic origin alike. In providing that statutory damages and attorney's fees are not recoverable for infringement of unpublished, unregistered works, clause (1) of section 412 in no way narrows the remedies available under present law..." Act of October 19, 1976, Pub. L. No. 94-553, H.R. Conf. Rep. No. 94-1733, 94th Cong., 2d Sess, (1976) reprinted in 1976, 5 U.S. Code Cong. & Admin. News, 5774 (emphasis added).