

# Pre-1978 works require diligent record-keeping

By Nicholas Kanter

When an artist passes away, heirs often become responsible to protect a legacy and enforce intellectual property rights. Recently, the heir of rock-and-roll photographer James Marshall — famous for his iconic photos made in the 1960s and 1970s featuring Jimi Hendrix, Janis Joplin, the Rolling Stones, The Beatles, Jerry Garcia and other A-list musicians — learned the importance of collecting and maintaining proper records of intellectual property rights, especially those relating to works first published before 1978.

Jim Marshall Photography, LLC sued clothing designer John Varvatos, John Varvatos Enterprises, Inc. and Bloomingdale's for copyright infringement, for reproducing, without permission, photographs made by the late photographer. The case is *Jim Marshall Photography, LLC v. John Varvatos of California, et al.*, No. C-11-06702 DMR (N.D. Cal., June 10, 2013).

In 2008 Varvatos purchased 52 original proof sheets from Jim Marshall, each containing multiple individual photographs. Varvatos then reproduced and displayed the photos in Bloomingdales and other stores where his clothing was sold. Marshall died in 2010. The rights in his photographic works were ultimately assigned to Jim Marshall Photography, LLC.

Defendants moved for summary judgment on 29 of approximately 149 photographs at issue. Defendants claimed Marshall Photography could not maintain an infringement claim for photos first published before 1978, which did not comply with certain copyright formalities. Defendants argued that the photos were in the public domain, and therefore Marshall Photography lacked standing to pursue its claims (i.e., Marshall Photography did not own the copyrights in the photos, and therefore could not enforce rights therein).

Under the Copyright Act of 1909, failing to give a proper copyright notice with the original publication of a work (a notice with the word "copyright" or © symbol, the year of publication and name of the owner), placed the work "irrevocably into the public domain." *Twin Brooks Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1165 (9th Cir. 1996). The notice requirement of the 1909 act was omitted from the Copyright Act of 1976, but courts still apply the 1909 act's requirements to certain works first published before that act took effect.

Some of Marshall's photos published before 1978 lacked the required copyright notice. Marshall Photography tried to persuade the court that despite the lack of notices, they had not fallen into the public domain. The argument relied on an exception to the notice requirement, created

by the 2nd U.S. Circuit Court of Appeals, and adopted by the 9th Circuit, which stated: "Where a magazine publisher has purchased limited publication rights in a work 'under circumstances which show that the author has no intention to donate his work to the public, copyright notice in the magazine's name is sufficient to obtain a valid copyright on behalf of the beneficial owner, the author or proprietor [of the work]." *Abend v. MCA, Inc.*, 863 F.2d 1465 (9th Cir. 1988). Marshall Photography argued that magazines which published Marshall's photos before 1978 had set forth copyright notices in the publishers' names. But the court rejected Marshall Photography's argument noting that it could not produce evidence proving: (1) The magazine publishers purchased limited publication rights to Marshall's images, and (2) The publishers bought those rights "under circumstances which show that [Marshall had] no intention to donate his work to the public."

In granting summary judgment for the defendants, the court added: "this case presents an unfortunate situation. The individual with personal knowledge of the circumstances in which the works in question were created and published is no longer alive, and left behind no documentary evidence to shed light on agreements regarding these works."

This *Marshall Photography* deci-

sion reinforces the importance of maintaining records of publication, licenses and other agreements relating to copyrighted works, especially those published before 1978. If such records do not exist, efforts could be made to document transactions, either through affidavit by the copyright holder, or confirming understandings with licensees.

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