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## Billy-Bob Teeth Saves Porn Star: Coping with Defective Work-for-Hire Registrations

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## *Billy-Bob Teeth* Saves Porn Star: Coping with Defective Work-for-Hire Registrations

THOMAS G. FIELD, JR. \*

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### I. INTRODUCTION

When ownership of a particular copyright interest resides in but one of two or more people, defendants need to know who has standing as a plaintiff. But when all potential owners are joined, the cause for concern drops, presumably to zero. Under those circumstances, it is possible to overcome inadequate documentation or misstatements in registration certificates. Focusing on two recent opinions, *Billy-Bob Teeth, Inc. v. Novelty, Inc.*<sup>1</sup> and *Jules Jordan Video, Inc. v. 144942 Canada Inc.*,<sup>2</sup> this paper explores several rationales to that end.

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1. 329 F.3d 586, 592–94 (7th Cir. 2003) (reinstating a jury award despite inaccurate and inadequate documentation).

2. 617 F.3d 1146, 1149–50, 1160 (9th Cir. 2010) (reinstating a jury award despite registrations identifying an “adult movie actor,” rather than his employer, as owner) (emphasis added).

Before turning to those cases, the second part of this paper briefly reviews the statutory provisions that determine initial copyright ownership,<sup>3</sup> statutory provisions that establish prerequisites to alienating title<sup>4</sup> and litigating infringement claims,<sup>5</sup> and a statute that bars untimely suits.<sup>6</sup> It then examines the facts in the two cases of principal interest and explains how rationales applied by the Seventh Circuit to overcome title deficiencies<sup>7</sup> were applied by the Ninth Circuit.<sup>8</sup>

Turning briefly to other cases, the third part of this paper reviews the Ninth Circuit's use of,<sup>9</sup> and the Seventh Circuit's failure to use,<sup>10</sup> the copyright statute of limitations to resolve competing ownership claims.<sup>11</sup> With title established in plaintiffs, infringers have no need to fear double recovery and should be foreclosed from exploiting arguable flaws that might otherwise justify concern.<sup>12</sup>

Finally, this paper reconsiders support for the holdings in *Billy-Bob Teeth* and *Jules Jordan Video*. It then explains why one basis, appropriate for clearing title in the former case, was inappropriately used in the latter.<sup>13</sup> It also explains why, had it been pled in *Jules Jordan Video*, the statute of limitations could have warranted summary judgment on the issue of ownership and simplified issues on appeal.<sup>14</sup>

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3. 17 U.S.C. § 201(a)–(b) (2006).

4. *See id.* §§ 201(d), 204(a).

5. *See id.* § 411(a).

6. *See id.* § 507.

7. *See infra* Part II.B (discussing *Billy-Bob Teeth*).

8. *See infra* Part II.C (discussing *Jules Jordan Video*).

9. *See generally* *Zuill v. Shanahan*, 80 F.3d 1366 (9th Cir. 1996).

10. *See, e.g.,* *Hays v. Sony Corp. of Am.*, 847 F.2d 412 (7th Cir. 1988), *abrogated on other grounds by* *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384 (1990); *see also* Thomas G. Field, Jr., *From Custom to Law in Copyright*, 49 *IDEA* 125, 141–45 (2008).

11. *See* 17 U.S.C. § 507(b) (“No civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued.”).

12. *See* *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 36–37 (2d Cir. 1982).

13. *See infra* Part IV.

14. *See infra* Part IV.

## II. ADDRESSING THIRD-PARTY OWNERSHIP CHALLENGES

A. *Statutory Background*

Copyright ownership “vests initially in the author or authors of the work.”<sup>15</sup> Title can be alienated of course, but “[a] transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner . . . or . . . [an] agent.”<sup>16</sup> The reference to “note or memorandum” is typically construed to mean a document executed and signed some time after an oral agreement was made.<sup>17</sup>

If a work is “made for hire,”<sup>18</sup> however, the principal is regarded as the author “unless the parties have expressly agreed otherwise in a written instrument signed by *them*.”<sup>19</sup> It is difficult not to conclude that the stressed word manifests a need for signatures by transferees as well as transferors.<sup>20</sup> It matches a condition that must be satisfied for commissioned works to be treated as ones for hire.<sup>21</sup> Why Con-

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15. 17 U.S.C. § 201(a).

16. *Id.* § 204(a); *see also id.* § 101 (“transfer of copyright ownership”) (stating that nonexclusive licenses are excepted).

17. *See, e.g., Eden Toys, Inc.*, 697 F.2d at 36.

18. *See* 17 U.S.C. § 101 (“work made for hire”). Alternative definitions are provided; the first, denominated § 101(1), concerns works done by employees within the scope of their employment; the second, denominated § 101(2), provides that commissioned works may, under limited circumstances, also be for hire. With regard to the specific phrase, “work made for hire,” the Court in *Community for Creative Non-Violence v. Reid*, says, “[w]e use the phrase ‘work for hire’ interchangeably with the more cumbersome statutory phrase ‘work made for hire.’” 490 U.S. 730, 737 n.3 (1989). Here, the former phrase is used exclusively.

19. 17 U.S.C. § 201(b) (emphasis added). Whether a work is for hire has other consequences. First, under § 302(a), copyright lasts for the lifetime of the author, plus seventy years; under § 302(b), the term for joint works is seventy years beyond the death of the last surviving author; under § 302(c), however, copyright lasts 120 years from creation or ninety-five years from the first publication, “whichever expires first.” Also, of great significance for works of enduring value, transfers of works not for hire may be terminated after as few as thirty-five years. *See id.* §§ 203(a)(3), 304(c)(3).

20. *See, e.g., Forasté v. Brown Univ.*, 248 F. Supp. 2d 71, 81 (D.R.I. 2003).

21. For work performed by anyone other than an employee to be considered as work for hire, “the parties [must] expressly agree in a written instrument signed by

gress found it necessary to require two signatures in either instance is far from clear, but each can trap the unwary.<sup>22</sup>

Regardless of whether a work is for hire, “no civil action for infringement of the [rights of the author] in any United States work shall be instituted until preregistration or registration of the copyright claim has been made.”<sup>23</sup> If a mistake is made in applying for registration,<sup>24</sup> it may be corrected in accordance with Copyright Office regulations.<sup>25</sup> Moreover, inadvertent mistakes “on registration certificates do not . . . bar infringement actions, unless the alleged infringer has relied to its detriment on the mistake, or the claimant intended to defraud the Copyright Office by making the misstatement.”<sup>26</sup>

Finally, the window of opportunity for challenging defects is limited in that “[n]o civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued.”<sup>27</sup>

### B. *Billy-Bob Teeth*

Billy-Bob Teeth (“BBT”) makes and sells novelty teeth.<sup>28</sup> Those of interest to the Seventh Circuit were created by Jonah White, then the sole owner of the firm, in 1995 and 1997.<sup>29</sup> White’s 1999 applications to register copyright recited that he had created them as an

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*them* that the work shall be [so] considered.” 17 U.S.C. § 101(2) (“work made for hire”) (emphasis added).

22. See, e.g., Field, *supra* note 10, at 135–45.

23. 17 U.S.C. § 411(a); see also *id.* § 101 (“United States”) (also defining the term “United States work”). But see *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237, 1246 (2010) (stating that jurisdiction is unaffected by 17 U.S.C. § 411(a)).

24. See 17 U.S.C. § 409 (requiring specific information and authorizes the Register to require more).

25. See *id.* § 408(d).

26. *Urantia Found. v. Maaherra*, 114 F.3d 955, 963 (9th Cir. 1997).

27. 17 U.S.C. § 507(b); see also, e.g., *Merchant v. Levy*, 92 F.3d 51, 56 (2d Cir. 1996) (“We hold that plaintiffs claiming to be co-authors are time-barred three years after accrual of their claim from seeking a declaration of copyright co-ownership rights and any remedies that would flow from such a declaration.”).

28. *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 589 (7th Cir. 2003).

29. *Id.*

employee of “Billy-Bob Teeth, Inc.”<sup>30</sup> Although he and a partner had previously done business as BBT, the firm was not incorporated until 1996.<sup>31</sup> It was therefore impossible for the teeth designed in 1995 to have been created by White as a corporate employee.

Nor, when suit was filed, had White transferred his rights to BBT or the corporation in accordance with 17 U.S.C. § 204(a).<sup>32</sup> He claimed to have made oral transfers prior to suit, but the trial judge regarded the supporting evidence as inadequate.<sup>33</sup> Therefore, a document executed in 2001 could not confirm a prior transfer.<sup>34</sup>

Finding that the corporation “could not show an ownership interest in the copyright,” under either § 201(a) or § 204(a), the district court set aside a jury award for copyright infringement.<sup>35</sup>

On appeal, the Seventh Circuit rejected the district court’s conclusion that the corporation did not have good title under § 204(a).<sup>36</sup> “In saying that this evidence [of a prior oral transfer] was not reliable, the district judge improperly weighed the evidence, judged the credibility of the witness, and therefore invaded the province of the jury.”<sup>37</sup> The appeals court agreed that the work was not for hire<sup>38</sup> but regarded mistaken statements to that effect in the registrations as not barring suit.<sup>39</sup>

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30. *Id.*

31. *Id.*

32. *Id.*; see 17 U.S.C. § 204(a) (stating the requirements to transfer rights).

33. *Billy-Bob Teeth*, 329 F.3d at 590.

34. *Id.* at 589–90.

35. *Id.* at 590. But the court did affirm a finding of trade dress infringement. *Id.*

36. *Id.* at 591–93.

37. See *id.* at 592. Not all courts are as accommodating. See, e.g., *Barefoot Architect, Inc. v. Bunge*, 632 F.3d 822, 830 (3d Cir. 2011) (“For a writing to ‘validate’ a past transfer, the past transfer must have actually occurred.”). Despite facts remarkably similar to those in *Billy-Bob Teeth*, the opinion concludes: “Other than the Memorandum of Transfer (which as we have said cannot stand on its own), none of the proffered evidence, such as it is, would permit a jury to conclude that an oral transfer took place . . . . Summary judgment was therefore appropriate . . . .” *Id.* at 833.

38. *Billy-Bob Teeth*, 329 F.3d at 592. The opinion, however, does not differentiate between the teeth created before 1995 and after the business was incorporated in 1996. See *id.* at 591–93.

39. *Id.* at 591 (quoting *Urantia Found. v. Maaherra*, 114 F.3d 955, 963 (9th Cir. 1997)).

The court also found, absent any ownership dispute among principals, that defendant “simply does not having [sic] standing under § 204.”<sup>40</sup> The court then quoted an Eleventh Circuit opinion holding, “it would be unusual and unwarranted to permit a third-party infringer to invoke section 204(a) to avoid suit for copyright infringement.”<sup>41</sup>

Indeed, the basic proposition seems ultimately to derive from a Second Circuit opinion stating:

[S]ince the purpose of [17 U.S.C. § 204(a)] is to protect copyright holders from persons mistakenly or fraudulently claiming oral licenses, the ‘note or memorandum of the transfer’ need not be made at the time when the license is initiated; the requirement is satisfied by the copyright owner’s later execution of a writing which confirms the agreement.<sup>42</sup>

Moreover, “[i]n this case, in which the copyright holder appears to have no dispute with its licensee on this matter, it would be anomalous to permit a third party infringer to invoke this provision against the licensee.”<sup>43</sup> To avoid any possibility of liability to more than one owner, the opinion also approves the possible introduction of a subsequent written memorial of the agreement as well as possible joinder of a copyright owner who had transferred an exclusive interest to the plaintiff.<sup>44</sup>

So the tables were turned. Defendants with no claim to title who contest, as third parties, that plaintiffs do not have standing may be found without standing, themselves, to assert a potentially significant defense.

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40. *Id.* at 592.

41. *Id.* at 592–93 (quoting *Imperial Residential Design, Inc. v. Palms Dev. Grp., Inc.*, 70 F.3d 96, 99 (11th Cir. 1995)).

42. *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 36 (2d Cir. 1982).

43. *Id.*

44. *See id.* at 37.

*C. Jules Jordan Video*

As recounted by the Ninth Circuit, “Ashley Gasper is an adult movie actor who performs under the stage name Jules Jordan, and is the president and sole shareholder of Jules Jordan Video (‘JJV’), the creator of the videos in which Gasper appears.”<sup>45</sup> After Gasper discovered that counterfeit versions of thirteen DVDs were being sold, he, JJV, and a former business associate filed suits against several parties.<sup>46</sup>

The suits were later consolidated.<sup>47</sup> The third judge assigned to the case is said to have supervised a “lengthy and contentious” jury trial concerning claims based on rights of publicity and copyright.<sup>48</sup> Finding for Gasper on the right of publicity count, the jury awarded nearly \$3 million dollars, most as punitive damages; finding for Gasper/JJV on the copyright infringement count, it awarded \$2.6 million dollars in statutory damages.<sup>49</sup>

After a flurry of motions, the trial court affirmed the verdict based on right of publicity.<sup>50</sup> With respect to the copyright claims, however, Gasper and his firm were on the horns of a dilemma.

In the trial judge’s view, copyright in the DVDs was owned by JJV, Gasper’s employer.<sup>51</sup> Yet, the registrations were sought and granted in Gasper’s name, and, without registrations in its own name, JJV lacked standing.<sup>52</sup> The court therefore awarded defendants a judgment as a matter of law on the copyright claims.<sup>53</sup> The Ninth Circuit overruled both dispositions.<sup>54</sup>

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45. *Jules Jordan Video, Inc. v. 144942 Canada Inc.*, 617 F.3d 1146, 1149 (9th Cir. 2010). In context, it is clear that “adult” describes the films, not the age of the actor. *See id.*

46. *Id.* at 1150–51.

47. *Id.* at 1151.

48. *Id.* at 1150–51.

49. *Id.* at 1151. Statutory damages can range from \$200 to \$150,000 per infringement. 17 U.S.C. § 504(c) (2006).

50. *Jules Jordan Video*, 617 F.3d at 1152.

51. *See id.* at 1155.

52. *Id.* at 1150, 1155; *see* 17 U.S.C. § 411(a).

53. *Jules Jordan Video*, 617 F.3d at 1155.

54. *Id.* at 1150, 1160.



Despite regarding Gasper as an “adult film performer[] of some stature,”<sup>55</sup> the circuit court saw his claims for right of publicity as congruent with the scope of his and JJV’s copyright claims.<sup>56</sup> Suit on that theory was therefore preempted whether based on Gasper’s appearances in the videos<sup>57</sup> or, as belatedly argued, on the use of Gasper’s name and likeness on DVD covers.<sup>58</sup>

With regard to the copyright claims, the trial judge apparently did not appreciate that Gasper’s work as an employee could be for hire only if performed within the scope of his duties.<sup>59</sup> Concerning that, the opinion begins by noting, “[t]he problem with the district court’s analysis is that JJV was a one-man shop.”<sup>60</sup> Continuing, the court says:

It was all Gasper all the time. JJV as employer and Gasper as employee could certainly agree as to the scope of the employee’s employment, and could agree that Gasper should retain all copyrights. Since JJV was Gasper, JJV intended whatever Gasper intended, and if Gasper intended that his creative work be outside the scope of his employment with JJV, there was no one to disagree.<sup>61</sup>

Although § 201(b) requires a written document to transfer copyright from employers to employees, nothing mandates written terms of employment,<sup>62</sup> so that could have disposed of the matter.

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55. *Id.* at 1150.

56. *Id.* at 1155.

57. *Id.* at 1152–53 (relying primarily on *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134 (9th Cir. 2006)).

58. *Id.* at 1154 (“Gasper’s face appears nowhere on any of the DVD covers, and whether his ‘persona’ appears in the form of some other part of his anatomy is unknown. What is known . . . is that the pictures on the covers of the DVDs are ‘still shots’ of the copyrighted video performance.”).

59. *See* 17 U.S.C. § 101(1) (2006) (“work made for hire”); *see also* *Comty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 n.3 (1989) (preferring “work for hire” over “work made for hire”).

60. *Jules Jordan Video*, 617 F.3d at 1156.

61. *Id.*

62. Indeed, the lack of a written description of the parties’ relationship in *Community for Creative Non-Violence* did not dispose of the dispute; rather, the dispute arose through lack of common understanding. *See* 490 U.S. at 734 (“The parties did not sign a written agreement. Neither party mentioned copyright.”).

Perhaps concerned about the difficulty in proving the occurrence of such soliloquies, the court takes a second approach to the case: “[I]nadvertent mistakes on registration certificates do not invalidate a copyright and thus do not bar infringement actions, unless . . . the alleged infringer has relied to its detriment on the mistake, or the claimant intended to defraud the Copyright Office by making the misstatement.”<sup>63</sup>

Bringing the facts to bear, the court says:

Defendants obviously did not rely on the mistake (if there was one) to their detriment. The evidence presented demonstrates that they pirated the DVDs without a care to whether the DVDs were copyrighted and, if so, who owned the copyright. Nor did Gasper or JJV ever intend to defraud the Copyright Office. . . . In the instant case, the only two parties with any possible claim to ownership, JJV and Gasper, both believed and intended that Gasper own the copyright.

Indeed, there was no need to defraud anyone with respect to ownership. If Gasper had really believed that JJV owned the copyright[s], as defendants argue on appeal, he had no need to lie . . . . If he knew that JJV was the owner and wanted to own them himself, he needed only to transfer them to himself . . . . A simple written note or memorandum of transfer signed by himself on behalf of JJV would have been sufficient, 17 U.S.C. § 204(a), and an earlier oral assignment can be confirmed later in a writing.<sup>64</sup>

Finally, offering a confirming, if not a third, basis for overturning the trial judge’s decision, the court refers once again to *Billy-Bob*

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63. *Jules Jordan Video*, 617 F.3d at 1156 (quoting *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1145 (9th Cir. 2003)) (internal quotation marks omitted).

64. *Id.* (internal citations omitted). The last paragraph of the quotation refers to *Billy-Bob Teeth* and 17 U.S.C. § 204(a). That section was appropriately used in *Billy-Bob Teeth* because the work was not for hire. See 329 F.3d 586, 592 (7th Cir. 2003). Because *Jules Jordan Video* involved a work for hire, however, § 201(b), not § 204(a), was applicable. Although § 204(a) makes explicit reference to a confirming “note or memorandum of the transfer,” § 201(b) does not. It is therefore doubtful that a subsequently executed document, even if signed by both employer and employee, would validate a prior oral transfer under § 201(b).

*Teeth* and to its approval of the proposition that infringers, as third parties, should be precluded from invoking § 204(a) to avoid liability.<sup>65</sup>

### III. THE COPYRIGHT STATUTE OF LIMITATIONS

Section 507(b) states, “[n]o civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued.”<sup>66</sup> That section is more apt to be applied to infringement claims, but opinions in several circuits have found it equally useful for quieting title.

A Second Circuit opinion initially found otherwise.<sup>67</sup> Yet, the Ninth Circuit, despite finding it unnecessary to distinguish that earlier case, noted that it has been based on “highly idiosyncratic facts.”<sup>68</sup> In any event, the Ninth Circuit went on to hold, “that claims of co-ownership . . . accrue when plain and express repudiation of co-ownership is communicated to the claimant, and are barred three years from the time of repudiation.”<sup>69</sup> Addressing policy considerations, the opinion says:

Plaintiffs argue that this construction . . . creates something like adverse possession to copyright ownership. . . . An express or implicit ouster of a cotenant by an unequivocal act of ownership starts the adverse possession statute of limitations running. We see nothing wrong with this resemblance. Copyright, like real estate, lasts a long time, so stability of title has great economic importance. . . .

Plaintiffs further argue the desirability of allowing putative co-owners to wait to see whether there is pecuniary value to a law suit, before cluttering the courts. But the court’s administrative gain . . . is offset by the burden and deterrent

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65. *Jules Jordan Video*, 617 F.3d at 1157 (citing *Billy-Bob Teeth*, 329 F.3d at 592).

66. 17 U.S.C. § 507(b).

67. See generally *Stone v. Williams*, 970 F.2d 1043, 1048–52 (2d Cir. 1992).

68. *Zuill v. Shanahan*, 80 F.3d 1366, 1370 (9th Cir. 1996) (quoting 1 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT § 12.05 n.2.2 (1992)).

69. *Id.* at 1369.

to development and marketing by a co-owner. It is inequitable to allow the putative co-owner to lie in the weeds . . . while large amounts of money are spent developing a market for the copyrighted material, and then pounce on the prize after it has been brought in by another's effort. . . .

A claim for a declaratory judgment of co-ownership and the relief ancillary to such a claim is a civil action, and no civil action shall be maintained . . . unless it is commenced within three years after the claim accrued.<sup>70</sup>

Soon thereafter, the Second Circuit distinguished its earlier opinion, saying, “[w]e hold that plaintiffs claiming to be co-authors are time-barred three years after accrual of their claim from seeking a declaration of copyright co-ownership rights and any remedies that would flow from such a declaration.”<sup>71</sup> Although a jury had found no merit to the challenged claim,<sup>72</sup> and plaintiffs had pled fraud and duress, the court “remanded with directions to dismiss the complaint.”<sup>73</sup>

Likewise, a Fourth Circuit opinion held, “[b]oth coauthorship and infringement claims are subject to a three-year statute of limitations. . . . A coauthorship claim accrues only once, and if an action is not brought within three years of accrual, it is forever barred.”<sup>74</sup>

Although each of these cases concern co-ownership disputes, nothing seems to provide any clear basis for distinguishing any claimant who, aware of a conflicting claim, fails to act to refute it. Thus, the bar should apply, for example, when works are commissioned but parties do not satisfy conditions requisite to qualifying them as for hire.<sup>75</sup> Likewise, full-time employees should own copy-

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70. *Id.* at 1370–71 (internal quotation marks and citations omitted).

71. *Merchant v. Levy*, 92 F.3d 51, 56 (2d Cir. 1996) (citing *Zuill*, 80 F.3d at 1369); *see also* *Kwan v. Schlein*, 634 F.3d 224, 226 (2d Cir. 2011) (affirming summary judgment on an infringement claim because it failed once an ownership claim was found to be time-barred).

72. *Merchant*, 92 F.3d at 56. That the jury had found no merit to the claim challenged by plaintiffs would seem to minimize, if not dispose of, the need for a barred claim to be based on color of title.

73. *Id.* at 53, 57.

74. *Davis v. Meridian Films, Inc.*, 14 Fed. Appx. 178, 181 (4th Cir. 2001).

75. *See* 17 U.S.C. § 101(2) (2006) (“work made for hire”).

rights in their work three years after unambiguous claims of title become known to their employers.<sup>76</sup> That seems particularly appropriate when employers not only have full knowledge of such claims but also actively encourage them.<sup>77</sup>

#### IV. ANALYSIS AND CONCLUSIONS

As discussed above, *Billy-Bob Teeth* applies well-established precedents to hold that § 204(a) permits written transfers of exclusive interests to be effectively back dated to the time of oral conveyances that would otherwise be effective only to transfer nonexclusive interests.<sup>78</sup> It is also but one of several cases to permit copyright owners to pursue infringers who have not relied on inadvertent mistakes and to look askance at third-party infringers who attempt to invoke § 204(a) when all who have potential claims are, or may be, joined.<sup>79</sup>

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76. *See id.*

77. *See* Field, *supra* note 10, at 140, n.109 (quoting a university policy that said “[a]s a general premise, ownership of copyrightable property which results from performance of one’s University duties and activities will belong to the author or originator,” and referencing similar policies adopted elsewhere); *see also Merchant*, 92 F.3d at 56 (concerning the need for color of title).

78. *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 591–93 (7th Cir. 2003); *see also* 17 U.S.C. § 101 (“transfer of copyright ownership”) (stating that nonexclusive licenses are excepted). Although the point seems not to have been contested, it is noteworthy that validating memoranda in *Jules Jordan Video*, *Billy-Bob Teeth*, and *Eden Toys* either were or could have been signed after litigation was initiated. *See Jules Jordan Video, Inc. v. 144942 Canada Inc.*, 617 F.3d 1146, 1156 (9th Cir. 2010); *Billy-Bob Teeth*, 329 F.3d at 589; *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 37 (2d Cir. 1982). This contrasts starkly with the approach of the Federal Circuit in a recent patent case. *See Abraxis Bioscience, Inc. v. Navinta LLC*, No. 2009-1539, 2011 WL 873298, at \*1 (Fed. Cir. Mar. 14, 2011) (per curiam order denying rehearing and rehearing en banc) (“The panel, following Federal Circuit law, [correctly] concluded that a party has no standing under Article III to bring an action if it does not own the patents when it files the action.”). Judge O’Malley, joined by Judge Newman, dissented. *Id.* at \*9 (“As a consequence, parties may lose standing to bring infringement actions with respect to patents that they indisputably own under state law.”).

79. *See, e.g., Billy-Bob Teeth*, 329 F.3d at 591–93; *Eden Toys*, 697 F.2d at 36–37; *see also* 17 U.S.C. § 501(b) (requiring notice to others “whose interest is likely

Aside from initial resort to the virtual identity of employer and employee as a potential determinant of the scope of employment, *Jules Jordan Video*<sup>80</sup> relies on all of those holdings.

Yet, it finds that, “had Gasper’s testimony been sufficient to support an oral agreement between JJV and himself that any copyright technically owned by JJV was to be conveyed to him, defendants would have had no standing to complain that the agreement was never put in writing.”<sup>81</sup> Thus, the court overlooks the fact that *Billy-Bob Teeth* and like cases focus on works that do not qualify as for hire, whereas it faced essentially the opposite scenario.

To the extent that BBT could not hold copyright in the 1995 teeth as White’s employer, it was appropriate to accept written confirmation of an earlier oral transfer.<sup>82</sup> Taking the same tack, *Jules Jordan Video* says, “[i]f [Gasper] knew that JJV was the owner and wanted to own them himself, he needed only to transfer them to himself . . . . A simple written note or memorandum of transfer signed by himself on behalf of JJV would have been sufficient . . . .”<sup>83</sup>

Such an approach is problematic, however. Transfers from employer to employee are governed by § 201(b).<sup>84</sup> Lack of text in 17 U.S.C. § 201(b) equivalent to that in § 204(a)<sup>85</sup> seems unlikely to garner support elsewhere and might even induce the Ninth Circuit to recant at some point.

The third strategy mentioned in *Jules Jordan Video*, barring an infringer from invoking § 204(a),<sup>86</sup> is likewise facially inapplicable. Yet, because denial of standing to third parties does not depend on statutory language, the same logic might apply to § 201(b).<sup>87</sup>

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to be affected by a decision in the case,” as well as permitting their intervention and allowing courts to require joinder).

80. See *Jules Jordan Video*, 617 F.3d at 1156.

81. *Id.* at 1157.

82. See *Billy-Bob Teeth*, 329 F.3d at 591–92.

83. See *Jules Jordan Video*, 617 F.3d at 1156.

84. See, e.g., *Forasté v. Brown Univ.*, 248 F. Supp. 2d 71, 81 (D.R.I. 2003); *Field*, *supra* note 10, at 135–45.

85. Compare 17 U.S.C. § 201(b) (2006), with *id.* § 204(a).

86. *Jules Jordan Video*, 617 F.3d at 1156–57.

87. It could have also been applied in the three Seventh Circuit cases discussed in *Field*, *supra* note 10, at 140–43.

An opinion written many years earlier<sup>88</sup> expressed essentially the same view when it discounted a third-party claim that the University of California, Los Angeles (UCLA) should be regarded as the owner of its faculty members' notes: "No one but defendant, an outsider as far as the relationship between plaintiff and UCLA is concerned, suggests that such a state of the law is desirable."<sup>89</sup> The opinion also finds it significant that no one in defendant's position had ever advanced such an argument.<sup>90</sup>

When title is needed to prevent infringers from escaping liability altogether, variations on that theme can be expected to inspire creative solutions.<sup>91</sup> When the copyright statute of limitations can more directly serve that end, however, it should be used instead.<sup>92</sup>

The statute of limitations, however, would have been unhelpful in *Billy-Bob Teeth*. The trial was underway in 2001, but BBT did not secure registration until 1999,<sup>93</sup> leaving title open to challenge through 2002. Lacking registration for more than three years when defendant "started flooding the market with shoddy teeth,"<sup>94</sup> BBT needed other ways to quiet title. Fortunately for BBT and White, its owner, the Court found them.<sup>95</sup>

In *Jules Jordan Video*, however, it would have been possible to bring the statute of limitations to bear.<sup>96</sup> A business associate "prepared Gasper's copyright registration paperwork" and presumably filed it in 2001.<sup>97</sup> By 2005, when Gasper discovered that the returned merchandise consisted of low quality counterfeits,<sup>98</sup> the three

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88. *Williams v. Weisser*, 78 Cal. Rptr. 542 (Cal. Ct. App. 1969).

89. *Id.* at 546; *see also id.* at 550 (finding federal law not to apply for lack of "divestive publication").

90. *Id.* at 547; *see also* Field, *supra* note 10, at 138.

91. *See* Field, *supra* note 10, at 144–45.

92. *See supra* Part III (discussing the statute of limitations for copyright infringement suits).

93. *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 589 (7th Cir. 2003).

94. *Id.* at 590.

95. *See id.* at 591–93.

96. *See Jules Jordan Video, Inc. v. 144942 Canada Inc.*, 617 F.3d 1146, 1150 (9th Cir. 2010). Further, that seems particularly appropriate when the first and possibly leading opinion on use of 17 U.S.C. § 507 to quiet title, is one from the same circuit. *See Zuill v. Shanahan*, 80 F.3d 1366, 1370 (9th Cir. 1996).

97. *Jules Jordan Video*, 617 F.3d at 1150.

98. *Id.*

years required by § 507(b) had already run. At that point, regardless of his employment status, Gasper clearly owned copyright in the DVDs by virtue of good faith claims made in his registration certificates.<sup>99</sup> Fraud aside, that should be true even if, without separate copyright transfers, Gasper later sold JJV to someone else. Indeed, had Gasper pled the statute of limitations, any question of title would have been appropriate for summary judgment, obviating the need for the court to resort to hypothesized soliloquies<sup>100</sup> and the application of inappropriate statutory authority.<sup>101</sup>

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99. *Id.* at 1156.

100. *Id.* at 1156.

101. *Id.* at 1152–57.