Joshua Weigensberg

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Joshua Weigensberg is a member of the Litigation and Media + Entertainment Groups, where he litigates copyright, trademark, and other complex commercial disputes for clients in a range of industries, including music, technology, art, and consumer goods.

Josh regularly represents IP owners seeking to enforce their rights, companies and creators accused of infringement, and parties engaged in disputes over licensing terms. Beyond litigating IP matters, he also assists clients with applying for and obtaining copyright and trademark registrations.

Josh has been working in the field of generative artificial intelligence (AI) for years, including commenting on the intersection of copyright and generative AI since 2020. He serves as a trusted resource for clients seeking to understand their risks, rights, and opportunities with regard to generative AI.

Josh's practice frequently involves representing clients involved in complex commercial litigations, including disputes over corporate control, breach of contract, fraud, and breach of fiduciary duty. On behalf of individual clients, he has also litigated numerous trust and estates disputes in Surrogate's Court.

Josh's many successful representations include:

- The *Phonorecords III* rate-setting proceeding that resulted in a landmark increase in royalty rates payable by music streaming companies for 2018-2022 of nearly 44%.
- The *Phonorecords IV* rate-setting proceeding that, after extensive litigation, resulted in an historic settlement for the rates payable by music streaming companies beginning in 2023.
- In a lawsuit alleging counterfeit marks, thwarting the plaintiff's efforts to resurrect claims against a distributor-client and obtaining dismissal of the entire action.
- Obtaining a summary judgment victory of over $8.5 million for a company against a former member for conversion of funds.
- In a litigation involving copyright infringement, trade secret misappropriation, and defamation, using successful motion practice to cause opponent to withdraw all claims.
- Obtaining dismissal with prejudice for a Grammy award-winning singer-songwriter in litigation alleging copying of lyrics for a hit song.
- Obtaining dismissal of all of opponent's claims in a copyright infringement dispute involving copying of software.

Services

- Litigation
- Intellectual Property

- Interactive + Gaming
- Media + Entertainment
- Music
- Music Litigation
- Copyright
- Trademark

Education

- University of California, Berkeley, School of Law (J.D., 2010)
    - Order of the Coif; Notes and Comments Editor, California Law Review; Assistant Editor, Berkeley Journal of International Law
- Columbia University (B.A., *magna cum laude*, 2006)

Admissions

- New York
- U.S. District Courts for the Southern and Eastern Districts of New York
- U.S. District Court for the Middle District of Tennessee

Professional Affiliations

- New York Intellectual Property Law Association (NYIPLA), Copyright Law & Practice Committee, Co-Chair
- The Copyright Society of the USA
- International Trademark Association

Publications

January 10, 2024
Weigensberg and Kohn Write About Copyright and AI in 2024
Law360

June 9, 2023
Risks That Generative AI Poses to Trade Secret Protections
LegalTech News

September 25, 2017
What to Expect in the Forex Fraud Trial of Mark Johnson

Michael Adelman

Content Protection Counsel, *Dow Jones & Company*

Michael Adelman currently serves Content Protection Counsel for Dow Jones & Company, Inc. As Content Protection Counsel, Michael ensures that Dow Jones's valuable intellectual property (including *The Wall Street Journal* and business-to-business products like the Factiva news database) are protected from misuse or unlicensed dissemination.

Michael is a graduate of Dartmouth College, *magna cum laude*, and Harvard Law School, *cum laude*. Michael began his legal career as a clerk for the Honorable Marilyn L. Huff in the United States District Court for the Southern District of California. Following his clerkship, Michael was an associate at Gibson Dunn & Crutcher in New York, and subsequently was an associate at Pryor Cashman LLP in New York. Michael joined Dow Jones as in-house counsel in 2021.

Henry Behnen

Vice President, Production Content Review, *Paramount*

Henry Behnen is Vice President in the Business & Legal Affairs, Production Content Review group. He regularly works on linear and digital shows across the Paramount cable, streaming and other brands, including Paramount+, MTV, Comedy Central, Nickelodeon, BET and BET+, VH1, and others.

At Paramount, Mr. Behnen specializes in legal advice concerning production and content issues, and counsels production teams on legal risks in copyright and fair use, trademark, defamation, publicity and other entertainment and media law areas. This includes discussing legal risks for generative AI use. Prior to joining Paramount, Mr. Behnen was an associate in the law firm Schiff Hardin in their IP and litigation departments, where he represented IP clients in both litigation and counseling matters. He has also appeared on and moderated panels regarding AI, virtual reality, self-driving cars, and other areas of emerging law.

Mr. Behnen is a graduate of the George Washington University Law School (JD, 2010) and Bard College (BA, Philosophy and BA, Music, 2004). He is a member of the New York bar, and has previously been a member and chair of the New York City Bar Science & Law Committee.

July 26, 2024 Hot Topics in Trademark & Copyright Law NYIPLA Event

<u>Outline for "Report from the Front Lines on AI" Panel</u>

1. Moderator introduction to panelists – 2 minutes

2. Moderator introduction to topic – 3 minutes

3. Overview of panelist roles and responsibilities – 5 minutes

4. Copyright Discussion (new cases and implications) – 10 minutes

5. In-House use of AI technology – 5 minutes

6. Risks of AI use by vendors, partners, and independent contractors – 5 minutes

7. How to protect and enforce rights in content in view of AI – 5 minutes

8. Complexities surrounding integration of AI into web search – 5 minutes

9. Licensing challenges – 5 minutes

10. Parting messages and Q&A – 5 minutes

July 26, 2024 Hot Topics in Trademark & Copyright Law
"Report from the Front Lines on AI" Panel Materials

1.   <u>Copyright Protectability</u>

    Copyright Office Refusal to Register SURYAST (Dec. 11, 2023)

2.   <u>Copyright Infringement</u>

    Kadrey v. Meta Platforms, Inc. – Order Granting Motion to Dismiss (Nov. 20, 2023)

    Andersen v. Stability AI Ltd. – Tentative Rulings (May 7, 2024)

3.   <u>Name, Image and Likeness Legislation</u>

    Tennessee ELVIS Act (Ensuring Likeness, Voice and Image Security Act of 2024)

July 26, 2024 Hot Topics in Trademark & Copyright Law

"Report from the Front Lines on AI" Panel Materials

<u>Copyright Protectability</u>

Copyright Office Refusal to Register SURYAST (Dec. 11, 2023)

December 11, 2023

Alex P. Garens, Esq.
Day Pitney, LLP
One Federal Street, 29th Floor
Boston, MA 02110

Re: **Second Request for Reconsideration for Refusal to Register SURYAST
        (SR # 1-11016599571; Correspondence ID: 1-5PR2XKJ)**

Dear Mr. Garens:

The Review Board of the United States Copyright Office ("Board") has considered Ankit Sahni's ("Mr. Sahni") second request for reconsideration of the Office's refusal to register a two-dimensional artwork claim in the work titled "SURYAST" ("Work"). After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program's denial of registration.

I.   DESCRIPTION OF THE WORK

The Work is a two-dimensional artwork and is reproduced below:
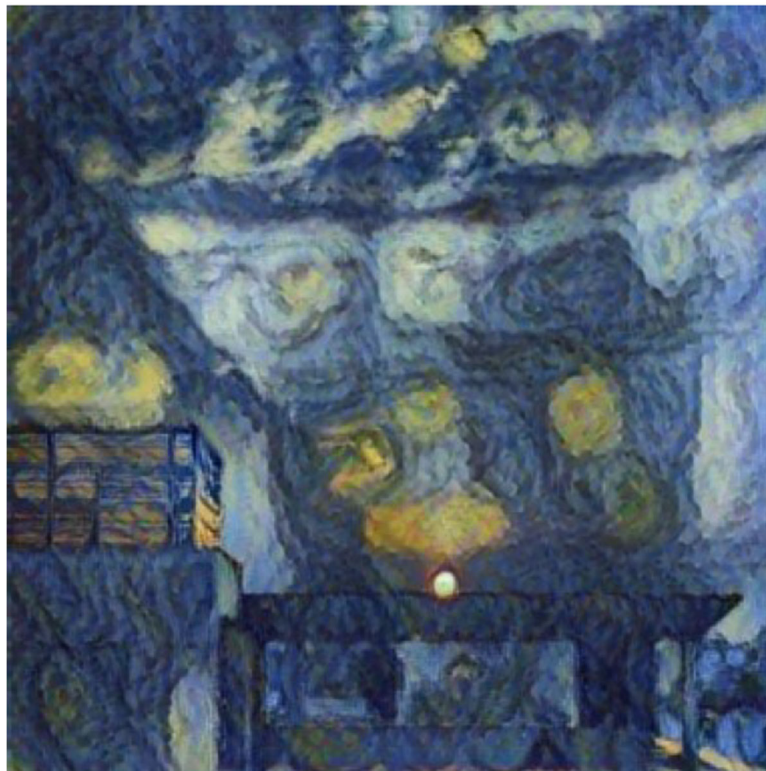
II.   ADMINISTRATIVE RECORD

On December 1, 2021, Mr. Sahni filed an application to register a claim in the Work. In the application, he listed two authors: himself as the author of "photograph, 2-D artwork" and "RAGHAV Artificial Intelligence Painting App" ("RAGHAV") as the author of "2-D artwork."[1] Mr. Sahni was identified as the sole copyright claimant. Because the application identified an artificial intelligence ("AI") "app" as an author of the work, the Copyright Office registration specialist assigned to the application requested additional information from Mr. Sahni about his use of the RAGHAV painting app in the creation of the Work. Email from U.S. Copyright Office to Ankit Sahni (Feb. 28, 2022). In response, Mr. Sahni submitted a 17-page document describing how RAGHAV's technology functions and how he used the technology to create the Work. Email from Ankit Sahni to U.S. Copyright Office, Attach. (Apr. 14, 2022) ("Sahni AI Description"). As explained in the Sahni AI Description, Mr. Sahni generated the Work by taking an original photograph that he authored, inputting that photograph into RAGHAV, then inputting a copy of Vincent van Gogh's *The Starry Night* into RAGHAV as the "style" input to be applied to the photograph, and choosing "a variable value determining the amount of style transfer." *Id.* at 10–11. Mr. Sahni further explained that he named RAGHAV as a co-author because its "contribution is distinct, disparate and independent" from his contribution to the Work. *Id.* at 14.

After considering the deposit, the application, and the Sahni AI Description, the Office refused to register the Work because it "lack[ed] the human authorship necessary to support a copyright claim." Initial Letter Refusing Registration from U.S. Copyright Office to Ankit Sahni at 1 (June 29, 2022). Responding to Mr. Sahni's assertion that the Work included some human creative input, the Office explained that "this human authorship cannot be distinguished or separated from the final work produced by the computer program." *Id.*

On September 27, 2022, Mr. Sahni requested that the Office reconsider its initial refusal to register the Work, arguing that "the human authorship requirement does not and cannot mean a work must be created entirely by a human author." Letter from Alex Garens to U.S. Copyright Office at 1 (Sept. 27, 2022) ("First Request") (arguing the Work was registrable because it was "the result of the creative and artistic choices and expressions of [a] human author").[2] After reviewing the Work in light of the points raised in the First Request, the Office reevaluated the claim and concluded that the Work could not be registered "because the work deposited is a derivative work that does not contain enough original human authorship to support a registration." Second Refusal at 1. The Office found that the Work was a "classic example[] of derivative authorship" because it was a digital adaptation of a photograph. *See id.* at 3 (citing U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 507.1 (3d ed. 2021) ("COMPENDIUM (THIRD)"); *see also* COMPENDIUM (THIRD) § 909.3(A) ("us[e of] digital editing software to produce a derivative photograph"). The Office analyzes derivative works by

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[1] The application listed RAGHAV's authorship as a work made for hire and RAGHAV's "year born" as 2020.
[2] In the First Request, Mr. Sahni requested to amend the application to list only Ankit Sahni as the author of "photograph, 2-D artwork," and to remove RAGHAV as the work made for hire author of "2-D artwork." First Request at 1. However, as the Office's refusal of the First Request noted, even if it had granted this request, doing so "would not alter [the] conclusion that [the Work] does not contain a sufficient amount of human authorship to warrant copyright protection." Refusal of First Request for Reconsideration from U.S. Copyright Office to Alex Garens at 1 n.2 (Apr. 10, 2023) ("Second Refusal").

examining whether "the new authorship that the author contributed" meets the statutory requirements for protection. Second Refusal at 4 (citing *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994); COMPENDIUM (THIRD) §§ 311.2, 507.1). Because the new aspects of the Work were generated by "the RAGHAV app, and not Mr. Sahni—or any other human author," the Office found that the "derivative authorship [wa]s not the result of human creativity or authorship" and therefore not registrable. *Id.* at 5.

In a letter dated July 10, 2023, Mr. Sahni requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. Letter from Alex Garens to U.S. Copyright Office (July 10, 2023) ("Second Request"). The Second Request presented three arguments. First, Mr. Sahni argued that RAGHAV served merely as an "assistive software tool[]," subject to creative decisions by Mr. Sahni in selecting his original photo, the *The Starry Night* image as the style input, and setting the variable value for the amount of style transfer. *Id.* at 2. Second, Mr. Sahni pointed to elements in the Work that he claims are human-authored. *Id.* at 3. According to Mr. Sahni, he "provided the traditional elements of authorship for both the original photograph and the Work" by taking the original photograph and "direct[ing] the RAGHAV tool to make changes to the colors, shapes, and style in a particular manner." *Id.* Mr. Sahni argues that his creation of the initial photograph and subsequent use of RAGHAV gave him control of the work and resulted in the Work containing elements such as a sunset and a building, depicted in a style of his choosing. *Id.* at 3–4. Third, Mr. Sahni argued that the Work is not a derivative work because the Work is not "substantially similar" to the original photograph. *Id.* at 4–5. Rather, the original photograph is "an early stage of what would ultimately become the Work." *Id.* at 5. Mr. Sahni contended that he "intentionally took the original photograph as part of his process for creating the Work . . . akin to a painter making a sketch before completing a painting, or a sculptor assembling clay before finalizing the form." *Id.* Therefore, the "human author's total creative input in both the original photograph and the Work should be considered together, and the Work should be analyzed for all the traditional elements of authorship present therein." *Id.*

III.   DISCUSSION

After carefully examining the Work and considering the arguments made in the First and Second Requests, the Board finds that the Work does not contain sufficient human authorship necessary to sustain a claim to copyright.

A. Legal Background

The Copyright Act protects, and the Office registers, "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). Courts have interpreted the statutory phrase "works of authorship" to require human creation of the work. *See Thaler v. Perlmutter*, No. 22-cv-1564, 2023 WL 5333236, at *4 (D.D.C. Aug. 18, 2023) (stating that "human authorship is a bedrock requirement of copyright" in affirming the Office's refusal to register a work "autonomously" created by AI). For this reason, courts have uniformly rejected attempts to protect the creations of non-humans through copyright. For example, the Ninth Circuit held that a book containing words "'authored' by non-human spiritual beings" can only gain copyright protection if there is "human selection and arrangement of the revelations." *Urantia Found. v. Kristen Maaherra*, 114 F.3d 955, 957–59 (9th Cir. 1997) (holding that "some

element of human creativity must have occurred in order for the Book to be copyrightable" because "it is not creations of divine beings that the copyright laws were intended to protect"). Similarly, copyright does not protect photographs taken by a monkey because the Copyright Act's terms "imply humanity and necessarily exclude animals." *Naruto v. Slater*, 888 F.3d 418, 426 (9th Cir. 2018), *decided on other grounds*. Recently, in *Thaler v. Perlmutter*, the U.S. District Court for the District of Columbia explained:

> By its plain text, the 1976 Act . . . requires a copyrightable work to have an originator with the capacity for intellectual, creative, or artistic labor. Must that originator be a human being to claim copyright protection? The answer is "yes."

2023 WL 5333236, at *4 (footnote omitted). Because copyright protection is only available for the creations of human authors, "the Office will refuse to register a [copyright] claim if it determines that a human being did not create the work." COMPENDIUM (THIRD) § 306.

When analyzing AI-generated material, the Office must determine when a human user can be considered the "creator" of AI-generated output. In March 2023, the Office provided registration guidance to the public for works created by a generative-AI system. The guidance explained that, in considering an application for registration, the Office will ask:

> [W]hether the 'work' is basically one of human authorship, with the computer [or other device] merely being an assisting instrument, or whether the traditional elements of authorship in the work (literary, artistic, or musical expression or elements of selection, arrangement, etc.) were actually conceived and executed not by man but by a machine.

Copyright Registration Guidance: Works Containing Material Generated by Artificial Intelligence, 88 Fed. Reg. 16,190, 16,192 (Mar. 16, 2023) (quoting U.S. COPYRIGHT OFFICE, SIXTY-EIGHTH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR ENDING JUNE 30, 1965, 5 (1966)); *see also id.* (asking "whether the AI contributions are the result of 'mechanical reproduction' or instead of an author's 'own original mental conception, to which [the author] gave visible form.'") (quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884)). This analysis is "necessarily . . . case-by-case" because it will "depend on the circumstances, particularly how the AI tool operates and how it was used to create the final work." *Id.*[3]

To enable the Office to conduct such an analysis, registration applications must disclose AI-generated content that is "more than *de minimis*." *Id.* at 16,193. Applicants may disclose and exclude such material by placing a brief description of the AI-generated content in the "Limitation of the Claim" section on the registration application. The description may be as brief and generic as "[description of content] generated by artificial intelligence." *Id.*

If all of a work's "traditional elements of authorship" are generated by AI, the work lacks human authorship, and the Office will not register it. *Id.* If, however, a work containing AI-

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[3] This case-by-case analysis yields varying outcomes. In 2023 to date, the Copyright Office has granted approximately 100 applications to register works containing AI-generated material, where the AI-generated contributions are disclaimed.

generated material also contains sufficient human authorship to support a claim to copyright, then the Office will register the human's contributions. *Id.* at 16,192–93.

When examining claims for derivative works, the Office focuses on whether "[t]he new authorship that the author contributed" meets the statutory requirements for protection. COMPENDIUM (THIRD) § 311.2. A derivative work is "a work based upon one or more preexisting works, such as … abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted, . . . which, as a whole, represent[s] an original work of authorship." 17 U.S.C. § 101 (defining "derivative work"). Accordingly, a derivative work contains "two distinct forms of authorship:" the authorship in the preexisting work that was recast, transformed, or adapted, and the new authorship as a result of recasting, transformation, or adaption. COMPENDIUM (THIRD) § 507.1. The Office's examination of derivative works focuses on the new authorship that the derivative author contributed to that work — rather than the authorship from the preexisting work that may have been incorporated into the derivative work, *see id.* § 311.2, because copyright "in a compilation or derivative work" is "independent of . . . any copyright protection in the preexisting material." 17 U.S.C. § 103(b).

B. Application of Legal Standards to the Work

Under the Copyright Act, Mr. Sahni's original photograph is a separate work of authorship because it was fixed separately from the Work. *See id.* § 101 ("a work is 'created' when it is fixed in a copy or phonorecord for the first time"); COMPENDIUM (THIRD) § 512 (similar). Because the Work here contains AI-generated material, the Board starts with an analysis of the Work's creation, including Mr. Sahni's use of RAGHAV. According to Mr. Sahni, RAGHAV is an "AI-powered tool" that uses machine learning to perform "Neural Style Transfer," which entails "generat[ing] an image with the same 'content' as a base image, but with the 'style' of [a] chosen picture." Second Request at 2; Sahni AI Description at 4, 6.[4] According to Mr. Sahni, RAGHAV was created[5] by training a neural network for image recognition using a dataset of 14 million images, called ImageNet,[6] and then training the neural network on another dataset of "content and style images" so that it learns how to transfer styles from the latter to the former. Sahni AI Description at 7. Mr. Sahni informed the Office that the model operates by taking two image inputs—one image in the desired style (the "style image"),

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[4] RAGHAV was built based on a method described in a Google Brain research paper titled "Exploring the structure of a real-time, arbitrary neural artistic stylization network." *See* Sahni AI Description at 6 (citing Golnaz Ghiasi et al., *Exploring the structure of a real-time, arbitrary neural artistic stylization network* (Aug. 2017), https://arxiv.org/abs/1705.06830). The Sahni AI Explanation includes a number of figures from the underlying research paper to illustrate the technology. *See generally id.*

[5] There is no evidence in the administrative record as to the details of how RAGHAV was created or by whom and whether Mr. Sahni was involved in that process. While Mr. Sahni has stated that RAGHAV was "built with a variant of Neural Style Transfer using [a] research paper" from Google, *id.* at 6, he does not claim to have developed RAGHAV. For this reason, the Board does not consider the development of RAGHAV or selection of the materials it was trained on as bases for Mr. Sahni's creative control over the Work. *Cf.* Defs.' Resp. to Pls.' Mot. for Summ. J. and Cross-Mot. for Summ. J. at 5 n.1, Thaler v. Perlmutter, No. 1:22-cv-1564 (D.D.C. Feb. 7, 2023), ECF No. 17 (explaining that the Office could not determine whether AI-generated work was sufficiently original to receive copyright protection because "among other potentially relevant facts, the Office does not know what preexisting works the Creativity Machine was trained on").

[6] ImageNet is a large collection of images commonly used for training AI systems. *See* Dave Gershgorn, *The data that transformed AI research—and possibly the world*, QUARTZ (July 26, 2017), https://qz.com/1034972/the-data-that-changed-the-direction-of-ai-research-and-possibly-the-world.

and a second image to which the style will be applied (the "base image"), as well as a numerical value indicating the amount or strength of style transfer. *See id.* at 10–12. RAGHAV then produces an output based on its interpretation of these three inputs. *Id.* at 8. In other words, according to Mr. Sahni, RAGHAV does not simply layer the style image on top of the base image like a visual filter applied to a photograph. RAGHAV instead generates a new image based on the features it learns from the base and style images. *Id.* at 6 (RAGHAV uses a technique that "allows us to *generate* an image with the same 'content' as a base image, but with the 'style' of our chosen picture") (emphasis added).[7]

Turning to creation of the Work here, Mr. Sahni states he provided RAGHAV with a base image (Mr. Sahni's original photograph), a style image (Vincent van Gogh's *The Starry Night*), and an undisclosed numerical value for the strength of the style transfer. *Id.* at 9–12. RAGHAV then generated the Work, and Mr. Sahni does not claim to have modified the Work after it was generated. Each of the image contributions are depicted below alongside the resulting output image:
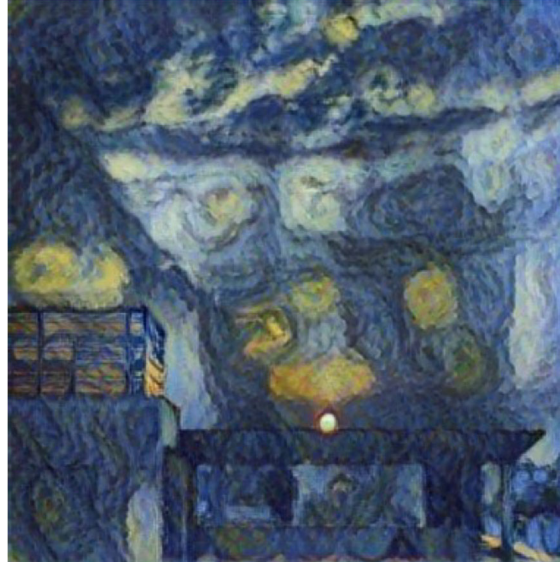

**Mr. Sahni's Original
Photograph
(base image)**

**Vincent Van Gogh's *The Starry Night*
(style image)**

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[7] The Second Request describes the RAGHAV tool as a "filter" tool, which contradicts Mr. Sahni's initial description. As discussed below, even if the Board accepted the Second Request's description of RAGHAV, the Board's conclusion would be the same because selecting the strength of a visual filter, by itself, is not sufficiently creative to be protected by copyright.

**The Work
(output)**

Mr. Sahni argues that the decisions he made are sufficient to make him the "author" of the Work in its entirety. The Second Request asserts that "conceiving, creating and selecting an original [base] image," "selection of the style image," and "selecting a specific variable value determining the amount and manner of style transfer" "cumulatively resulted in the [Work], which is the direct outcome of [Mr. Sahni's] creative expression and contribution." Sahni AI Description at 11–12; *see also* Second Request at 4. As evidence of his creative control, Mr. Sahni claims his decisions resulted in the Work containing 1) "a sunset," 2) "clouds," 3) the "contours of a building," 4) a composition in which "the sky accounts for the upper two thirds of the work," and 5) "a precise and deliberate style of Van Gogh's [The] Starry Night." Second Request at 3–4.

After considering the information provided by Mr. Sahni regarding his creation of the Work, including his description of RAGHAV, the Board concludes that the Work is not the product of human authorship. Specifically, the Board finds that the expressive elements of pictorial authorship were not provided by Mr. Sahni. As Mr. Sahni admits, he provided three inputs to RAGHAV: a base image, a style image, and a "variable value determining the amount of style transfer." Sahni AI Description at 11. Because Mr. Sahni only provided these three inputs to RAHGAV, the RAGHAV app, not Mr. Sahni, was responsible for determining how to interpolate the base and style images in accordance with the style transfer value. The fact that the Work contains sunset, clouds, and a building are the result of using an AI tool that "generate[s] an image with the same 'content' as a base image, but with the 'style' of [a] chosen picture." *Id.* at 6. But Mr. Sahni did not control where those elements would be placed, whether they would appear in the output, and what colors would be applied to them—RAGHAV did.[8]

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[8] While not the basis for our conclusion, the Board notes that Mr. Sahni has stated elsewhere that "Raghav chooses and creates the brush strokes and colour palette." Govind Kumar Chaturvedi, *A.I. Paintings: Registrable*

The Board is not convinced by Mr. Sahni's description of RAGHAV as "an assistive tool" that works similarly to "a camera, digital tablet, or a photo-editing software program." Second Request at 2–3. In his Second Request, Mr. Sahni now describes RAGHAV as merely "mechanically appl[ying] the colors, shapes, and style as directed, which is not any different from, for example, Adobe Photoshop applying red and blue shades to a photograph based on a user's command." *Id.* at 4. This description inaccurately minimizes RAGHAV's role in the creation of the Work and conflicts with other information in the record. As Mr. Sahni stated in his initial explanation, RAGHAV operates by "generat[ing]" a new pictorial image based on features learned from user-provided images. *See* Sahni AI Description at 8 (operation of RAGHAV causes "new stylizations [to] be generated"). The underlying research that RAGHAV was built on is premised on the same functionality: it is the AI model, not its user, that "predict[s] stylizations for paintings and textures never previously observed," and that predictive function is tied to "the proximity of the [style image] to styles trained on by the model." Golnaz Ghiasi et al., *supra* note 4 at 5, 9. Here, RAGHAV's interpretation of Mr. Sahni's photograph in the style of another painting is a function of how the model works and the images on which it was trained on—not specific contributions or instructions received from Mr. Sahni. While Mr. Sahni selected the numerical variable for the "strength" of the style, that choice alone is insufficient to warrant copyright protection. As noted above, selecting a single number for a style filter is the kind of *de minimis* authorship not protected by copyright. *See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359 (1991) (copyright does not protect "works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent"); *see also* COMPENDIUM (THIRD) § 909.3(A) (providing example of digital edits that "improve[] the color, tone, and temper" of a photograph and remove noise as ineligible for copyright protection).
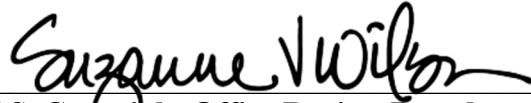
Mr. Sahni's remaining arguments do not alter the Board's conclusion. While Mr. Sahni emphasizes his specific choices of image inputs and filter strength as one choice "from nearly infinite permutations and possibilities of specific inputs," these choices only constitute an unprotectable idea for the Work, that is: an altered version of his photograph in the style of *The Starry Night*. Second Request at 2. But copyright does not protect the concept reflected in a work—"protection is given only to the expression of the idea—not the idea itself." *Mazer v. Stein*, 347 U.S. 201, 217 (1954); *see also, e.g.*, *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (copyright in bee jewelry was not infringed by other bee jewelry because "[a] jeweled bee pin is … an 'idea' that defendants were free to copy"). Nor does the Board agree with Mr. Sahni that his original photograph was "not a preexisting work" and that its expressive elements that also appear in the Work are therefore a basis for registration. Mr. Sahni is welcome to apply to register his photograph, assuming it meets all statutory requirements, but he cannot register the AI-modified version before the Board.[9] Because Mr. Sahni exerted insufficient creative control over RAGHAV's creation of the Work, he cannot register it.

Copyright? Lessons from Ankit Sahni, IP OSGOODE (Mar. 31, 2023), https://www.iposgoode.ca/2023/03/a-i-paintings-registrable-copyright-lessons-from-ankit-sahni/.

[9] To register the original photograph, Mr. Sahni would need to submit the photograph as the deposit along with an application claiming that photographic authorship. *See* 17 U.S.C. § 408(b)(1), (2) (registration deposits must consist of at least one "complete copy"); 37 C.F.R. § 202.20(b)(2)(1), (2) (depending on a work's publication status, the "complete copy" must "represent[] the entire copyrightable content of the work" or "include[] all elements comprising the applicable unit of publication of the work").

IV.   CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action.

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U.S. Copyright Office Review Board
Suzanne V. Wilson, General Counsel and
    Associate Register of Copyrights
Maria Strong, Associate Register of Copyrights and
    Director of Policy and International Affairs
Mark T. Gray, Assistant General Counsel

July 26, 2024 Hot Topics in Trademark & Copyright Law

<u>"Report from the Front Lines on AI" Panel Materials</u>

<u>Copyright Infringement</u>

Kadrey v. Meta Platforms, Inc. – Order Granting Mot. to Dismiss (Nov. 20, 2023)

Andersen v. Stability AI Ltd. – Tentative Rulings (May 7, 2024)

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

RICHARD KADREY, et al.,

Plaintiffs,

v.

META PLATFORMS, INC.,

Defendant.

Case No. 23-cv-03417-VC

ORDER GRANTING MOTION TO DISMISS

Re: Dkt. No. 23

Meta has moved to dismiss all claims except the one alleging that the unauthorized copying of the plaintiffs' books for purposes of training LLaMA constitutes copyright infringement. The motion is granted. The remaining theories of liability, at least as articulated in the complaint, are not viable. This order assumes familiarity with the facts of the case, the parties' arguments, and the relevant law.

1. The plaintiffs allege that the "LLaMA language models are themselves infringing derivative works" because the "models cannot function without the expressive information extracted" from the plaintiffs' books. This is nonsensical. A derivative work is "a work based upon one or more preexisting works" in any "form in which a work may be recast, transformed, or adapted." 17 U.S.C. § 101. There is no way to understand the LLaMA models themselves as a recasting or adaptation of any of the plaintiffs' books.

2. Another theory is that "every output of the LLaMA language models is an infringing derivative work," and that because third-party users initiate queries of LLaMA, "every output from the LLaMA language models constitutes an act of vicarious copyright infringement." But the complaint offers no allegation of the contents of any output, let alone of one that could be

understood as recasting, transforming, or adapting the plaintiffs' books. Without any plausible

allegation of an infringing output, there can be no vicarious infringement. *See Perfect 10, Inc. v.*

Amazon.com, Inc., 508 F.3d 1146, 1169 (9th Cir. 2007).

The plaintiffs are wrong to say that, because their books were duplicated in full as part of

the LLaMA training process, they do not need to allege any similarity between LLaMA outputs

and their books to maintain a claim based on derivative infringement. To prevail on a theory that

LLaMA's outputs constitute derivative infringement, the plaintiffs would indeed need to allege

and ultimately prove that the outputs "incorporate in some form a portion of" the plaintiffs'

books. *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984); *see also Andersen v.*

Stability AI Ltd., No. 23-CV-00201-WHO, 2023 WL 7132064, at *7-8 (N.D. Cal. Oct. 30, 2023)

("[T]he alleged infringer's derivative work must still bear some similarity to the original work or

contain the protected elements of the original work."); 2 Melville B. Nimmer & David Nimmer,

Nimmer on Copyright § 8.09 (Matthew Bender Rev. Ed. 2023) ("Unless enough of the pre-

existing work is contained in the later work to constitute the latter an infringement of the former,

the latter, by definition, is not a derivative work."); 1 Melville B. Nimmer & David Nimmer,

Nimmer on Copyright § 3.01 (Matthew Bender Rev. Ed. 2023) ("A work is not derivative unless

it has substantially copied from a prior work." (emphasis omitted)). The plaintiffs cite *Range*

Road Music, Inc. v. East Coast Foods, Inc., 668 F.3d 1148 (9th Cir. 2012), but that case is not

applicable here. In *Range Road*, the infringement was the public performance of copyrighted

songs at a bar. *Id.* at 1151-52. The plaintiffs presented evidence (namely, the testimony of

someone they sent to the bar) that the songs performed were, in fact, the protected songs. *Id.* at

1151-53. The defendants presented no evidence of their own that the protected songs were not

performed. Nor did they present evidence that the performed songs were different in any

meaningful way from the protected songs. *Id.* at 1154. The Ninth Circuit held that, under these

circumstances, summary judgment for the plaintiffs was appropriate. And the Court rejected the

defendants' contention that the plaintiffs, under these circumstances, were also required to

present evidence that the performed songs were "substantially similar" to the protected songs.

That contention made no sense, because the plaintiffs had already offered unrebutted evidence that the songs performed at the bar *were* the protected songs. *Id.* at 1154. Of course, if the defendants had presented evidence at summary judgment that the songs performed at the bar were meaningfully different from the protected songs, then there would have been a dispute over whether the performances were infringing, and the case would have needed to go to trial. At that trial, the plaintiffs would have needed to prove that the performed songs (or portions of the performed songs) were "substantially similar" to the protected songs. That's the same thing the plaintiffs would need to do here with respect to the content of LLaMA's outputs. To the extent that they are not contending LLaMa spits out actual copies of their protected works, they would need to prove that the outputs (or portions of the outputs) are similar enough to the plaintiffs' books to be infringing derivative works. And because the plaintiffs would ultimately need to prove this, they must adequately allege it at the pleading stage.

3. The plaintiffs' Digital Millennium Copyright Act Section 1202(b) claims must also be dismissed. There are no facts to support the allegation that LLaMA ever distributed the plaintiffs' books, much less did so "without their CMI." This is fatal to the Section 1202(b) claims. *See Free Speech Sys., LLC v. Menzel*, 390 F. Supp. 3d 1162, 1175 (N.D. Cal. 2019). The allegation that Meta violated Section 1202(a)(1) of the DMCA also fails because the plaintiffs have not plausibly alleged that LLaMA is an infringing derivative work.

4. The UCL claim must also be dismissed. To the extent it is based on the surviving claim for direct copyright infringement, it is preempted. *See* 17 U.S.C. § 301(a); *Maloney v. T3Media, Inc.*, 853 F.3d 1004, 1010 (9th Cir. 2017). To the extent it is based on allegations of fraud or unfairness separate from the surviving copyright claim, the plaintiffs have not come close to alleging such fraud or unfairness.

5. The last two claims, for unjust enrichment and negligence, must also be dismissed as preempted. The complaint alleges the use of the plaintiffs' books to train LLaMA unjustly enriched Meta, but this claim relies on the same rights contained in the Copyright Act. *See Del Madera Props. v. Rhodes & Gardner, Inc.*, 820 F.2d 973, 977 (9th Cir. 1987). Similarly, the

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plaintiffs allege Meta breached a duty of care "to act in a reasonable manner toward others" by copying the plaintiffs' books to train LLaMA. Again, the duty alleged (to the extent it could be thought to exist) is premised on the rights protected by the Copyright Act and thus any claims for breach of this duty are preempted. Even if the negligence claim was not preempted, the "economic loss doctrine" would apply. *See Kalitta Air, LLC v. Cent. Tex. Airborne Sys., Inc.*, 315 Fed. App'x 603, 605-06 (9th Cir. 2008).

<div align="center">* * * *</div>

All the claims are dismissed with leave to amend except for the negligence claim which is dismissed with prejudice. The plaintiffs may file an amended complaint within 21 days of this ruling. Any response to the complaint is due 21 days after the complaint is filed.

IT IS SO ORDERED.

Dated: November 20, 2023

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VINCE CHHABRIA
United States District Judge

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4   UNITED STATES DISTRICT COURT

5   NORTHERN DISTRICT OF CALIFORNIA

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7   SARAH ANDERSEN, et al.,   Case No. 23-cv-00201-WHO

        Plaintiffs,
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9   v.   **PROCEDURES AND TENTATIVE**
                                                 RULINGS FOR MAY 8, 2024 HEARING
10   STABILITY AI LTD., et al.,

        Defendants.
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12   To focus the parties' arguments for tomorrow's hearing, below are tentative rulings on the

13   claims in dispute. Each defendant will have 10 minutes to argue the issues most significant to it.

14   Plaintiffs will have 40 minutes in total to argue the issues most significant to them.

15   Tentative Rulings

16   Plaintiffs should have sought leave before adding additional named plaintiffs and the

17   Unjust Enrichment claim. However, had they asked, leave would have been freely given.

18   Therefore, following the final order on the pending motions, I am inclined to allow plaintiffs to

19   file a Second Amended Complaint adding the new plaintiffs. With respect to the new Unjust

20   Enrichment claims – as alleged in the First Amended Complaint based on use of plaintiffs'

21   "works" – leave to amend would be DENIED as futile, because those claims are preempted by the

22   Copyright Act. Plaintiffs will be allowed one final attempt to allege non-preempted Unjust

23   Enrichment claims against specific defendants. An amended Unjust Enrichment claim may be

24   included in the Second Amended Complaint.

25   I am inclined to DENY all motions to dismiss the direct and induced infringement claims

26   under the Copyright Act. Beyond the Training Images theory (that suffices for direct infringement

27   as to Stability, Runway, and Midjourney), plaintiffs have plausibly alleged facts to suggest

28   compress copies, or effective compressed copies albeit stored as mathematical information, of

United States District Court
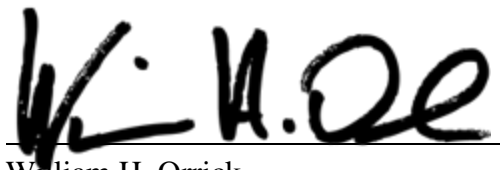Northern District of California

1   their works are contained in the versions of Stable Diffusion identified. At this juncture, plaintiffs

2   should be allowed to proceed with discovery. The facts regarding how the diffusion models

3   operate, or are operated by the defendants, should be tested at summary judgment against various

4   direct and induced infringement theories and precedent under the Copyright Act.

5   I am inclined to GRANT the motions to dismiss all DMCA claims. Under (a), the license

6   disclosures were not made "in connection with" plaintiffs' works. Under (b), the Court is inclined

7   to follow the decision in *Doe 1 v. GitHub, Inc.*, No. 22-CV-06823-JST, 2024 WL 235217, at *8

8   (N.D. Cal. Jan. 22, 2024), regarding the identicality requirement.

9   I am inclined to DENY Midjourney's motion to dismiss the false endorsement and trade

10   dress claims.

11   I am inclined to GRANT DeviantArt's motion to dismiss the contract claim for express

12   breach and breach of the implied covenant of good faith and fair dealing, consistent with my

13   analysis from the October 2023 Order.

14   Dated: May 7, 2024

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17   William H. Orrick
                                             United States District Judge
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United States District Court
Northern District of California

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July 26, 2024 Hot Topics in Trademark & Copyright Law

<u>"Report from the Front Lines on AI" Panel Materials</u>

<u>Name, Image and Likeness Legislation</u>

Tennessee ELVIS Act (Ensuring Likeness, Voice and Image Security Act of 2024)

By Representatives Lamberth, Cochran, Burkhart, White, Freeman, Gloria Johnson, Greg Martin, Jones, Davis, Camper, Todd, Hardaway, Powell, Hemmer, Leatherwood, Sherrell, Cepicky, Chism, Zachary, Terry, Russell, Howell, Hawk, Towns, Hurt, Williams, Richey, Baum, Brock Martin, Eldridge, Dixie, Shaw, Slater, Ragan, McKenzie, Powers, Raper, Bricken, Parkinson, Love, Rudder, Butler, Capley, Hakeem

Substituted for: Senate Bill No. 2096

By Senators Johnson, Crowe, Campbell, Akbari, Bailey, Bowling, Haile, Hensley, Jackson, Reeves, Rose, Stevens, Walley, Yarbro

AN ACT to amend Tennessee Code Annotated, Title 39, Chapter 14, Part 1 and Title 47, relative to the protection of personal rights.

BE IT ENACTED BY THE GENERAL ASSEMBLY OF THE STATE OF TENNESSEE:

SECTION 1. Tennessee Code Annotated, Section 47-25-1101, is amended by deleting "Personal Rights Protection Act of 1984" and substituting "Ensuring Likeness, Voice, and Image Security Act of 2024".

SECTION 2. Tennessee Code Annotated, Section 47-25-1102(4), is amended by inserting "individual," before "firm,".

SECTION 3. Tennessee Code Annotated, Section 47-25-1102, is amended by adding the following as a new subdivision:

( ) "Voice" means a sound in a medium that is readily identifiable and attributable to a particular individual, regardless of whether the sound contains the actual voice or a simulation of the voice of the individual;

SECTION 4. Tennessee Code Annotated, Section 47-25-1103, is amended by deleting subsection (a) and substituting:

(a) Every individual has a property right in the use of that individual's name, photograph, voice, or likeness in any medium in any manner.

SECTION 5. Tennessee Code Annotated, Section 47-25-1104, is amended by deleting subdivision (b)(2) and substituting:

(2)

(A) The exclusive right to commercial exploitation of the property rights is terminated by proof of the non-use of the name, photograph, voice, or likeness of an individual for commercial purposes by an executor, assignee, heir, or devisee to the use for a period of two (2) years subsequent to the initial period of ten (10) years following the individual's death.

(B) For purposes of subdivision (b)(2)(A), "use" includes the commercial availability of a sound recording or audiovisual work in which the individual's name, photograph, voice, or likeness is readily identifiable.

SECTION 6. Tennessee Code Annotated, Section 47-25-1105, is amended by deleting subsection (a) and substituting:

(a)

(1) Any person who knowingly uses or infringes upon the use of an individual's name, photograph, voice, or likeness in any medium, in any manner

directed to any person other than such individual, for purposes of advertising products, merchandise, goods, or services, or for purposes of fundraising, solicitation of donations, purchases of products, merchandise, goods, or services, without such individual's prior consent, or, in the case of a minor, the prior consent of such minor's parent or legal guardian, or in the case of a deceased individual, the consent of the executor or administrator, heirs, or devisees of such deceased individual, is liable to a civil action.

(2) A person is liable to a civil action if the person publishes, performs, distributes, transmits, or otherwise makes available to the public an individual's voice or likeness, with knowledge that use of the voice or likeness was not authorized by the individual or, in the case of a minor, the minor's parent or legal guardian, or in the case of a deceased individual, the executor or administrator, heirs, or devisees of such deceased individual.

(3) A person is liable to a civil action if the person distributes, transmits, or otherwise makes available an algorithm, software, tool, or other technology, service, or device, the primary purpose or function of such algorithm, software, tool, or other technology, service, or device is the production of a particular, identifiable individual's photograph, voice, or likeness, with knowledge that distributing, transmitting, or otherwise making available the photograph, voice, or likeness was not authorized by the individual or, in the case of a minor, the minor's parent or legal guardian, or in the case of a deceased individual, the executor or administrator, heirs, or devisees of such deceased individual.

SECTION 7. Tennessee Code Annotated, Section 47-25-1106(a), is amended by deleting "photograph, or likeness" and substituting "photograph, voice, or likeness".

SECTION 8. Tennessee Code Annotated, Section 47-25-1106, is amended by inserting the following as a new subsection:

(f) Where a person has entered into a contract for an individual's exclusive personal services as a recording artist or an exclusive license to distribute sound recordings that capture an individual's audio performances, an action to enforce the rights set forth in this part may be brought by the person or the individual.

SECTION 9. Tennessee Code Annotated, Section 47-25-1107, is amended by deleting "photograph, or likeness" wherever it appears and substituting "photograph, voice, or likeness".

SECTION 10. Tennessee Code Annotated, Section 47-25-1107, is amended by deleting subsection (a) and substituting:

(a) To the extent such use is protected by the First Amendment to the United States Constitution, it is deemed a fair use and not a violation of an individual's right, for purposes of this part, if the use of a name, photograph, voice, or likeness is:

(1) In connection with any news, public affairs, or sports broadcast or account;

(2) For purposes of comment, criticism, scholarship, satire, or parody;

(3) A representation of the individual as the individual's self in an audiovisual work, as defined under 17 U.S.C. § 101, unless the audiovisual work containing the use is intended to create, and does create, the false impression that the work is an authentic recording in which the individual participated;

(4) Fleeting or incidental; or

(5) In an advertisement or commercial announcement for a work described in this subsection (a).

SECTION 11. Tennessee Code Annotated, Section 47-25-1107(c), is amended by deleting "had knowledge of the unauthorized use" and substituting "had knowledge or reasonably should have known of the unauthorized use".

SECTION 12. Tennessee Code Annotated, Section 39-14-152(g), is amended by deleting "Personal Rights Protection Act of 1984" and substituting "Ensuring Likeness, Voice, and Image Security Act of 2024".

SECTION 13. This act takes effect July 1, 2024, the public welfare requiring it.

HOUSE BILL NO. ___2091___

PASSED: ___March 7, 2024___

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CAMERON SEXTON, SPEAKER
HOUSE OF REPRESENTATIVES

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RANDY MCNALLY
SPEAKER OF THE SENATE

APPROVED this _21st_ day of __March__ 2024

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BILL LEE, GOVERNOR