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Warner/Chappell Music, Inc. and

9 Summy-Birchard, Inc.

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11 **UNITED STATES DISTRICT COURT**
12 **CENTRAL DISTRICT OF CALIFORNIA**
13 **WESTERN DIVISION**

14 GOOD MORNING TO YOU
PRODUCTIONS CORP.; et al.,

15 Plaintiffs,

16 v.

17 WARNER/CHAPPELL MUSIC, INC.,
18 et al.,

19 Defendants.

Lead Case No. CV 13-04460-GHK
(MRWx)

**DEFENDANTS' OPPOSITION TO
PLAINTIFFS' EX PARTE
APPLICATION**

Judge: Hon. George H. King,
Chief Judge

Courtroom: 650

Fact Disc. Completion: July 11, 2014
MSJ Hearings: March 23 and
July 29, 2015

Pretrial Conference: N/A
Trial: N/A

1 Warner/Chappell does not oppose Plaintiffs’ *ex parte* request to supplement
2 the record with the documents Plaintiffs have submitted. Those documents,
3 however, do not show that Plaintiffs are entitled to summary judgment. At most, the
4 documents would create an issue of fact whether The Cable Company made a
5 publication in 1922 that could have divested the copyright owners—the Hill
6 Sisters—of their common law copyright in the *Happy Birthday to You!* lyrics. We
7 will be prepared to address these issues further at the July 29 hearing or at such
8 other time as the Court would prefer. Within 24 hours of having received Plaintiffs’
9 *ex parte* papers, the following is Warner/Chappell’s response to the *ex parte*.

10 **A. Plaintiffs’ New Evidence Does Not Answer The Question Whether**
11 **The Cable Company Made A 1922 Or Other Publication Of *Happy***
12 ***Birthday to You!* That Divested The Hills’ Common Law Copyright**
13 **In That Work**

14 The crux of Plaintiffs’ argument is that The Cable Company’s 1922
15 publication of *The Everyday Song Book* forfeited the Hill Sisters’ common law
16 copyright in *Happy Birthday to You!* and put the work into the public domain.
17 Ninth Circuit law is clear, however, that a divestive publication requires “consent of
18 the copyright owner.” *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir.
19 1981).¹ Plaintiffs’ evidence does not show the consent of the copyright owner.
20 Plaintiffs argue that, because The Cable Company’s 1922 publication contained the
21 statement, “Special permission through courtesy of The Clayton F. Summy Co.,” the
22 1922 publication must have had the necessary authorization from the copyright
23 owner to divest the common law copyright.

24 In 1922, however, the Clayton F. Summy Co. (“Summy”) did not own the
25 copyright to *Happy Birthday to You!* Summy likewise did not own the copyright to
26 *Good Morning to All*. In 1922, the copyrighted work *Song Stories for the*

27 ¹ See also *Dowdey v. Phoenix Films, Inc.*, No. 78 Civ. 699-CSH, 1978 WL 951, at
28 *4 n.10 (S.D.N.Y. July 24, 1978); 1 Nimmer on Copyright (“Nimmer”) § 4.03[A]
(2015) (publication under the 1909 act required “consent of the copyright owner”).

1 *Kindergarten*, which contained *Good Morning to All*, was in its renewal copyright
2 term. Joint App’x Exs. 5 (Dkt. No. 187), 16 (Dkt. No. 189-1). Jessica Hill, who had
3 inherited part of Mildred Hill’s interest in the renewal copyright term of *Song*
4 *Stories for the Kindergarten*, timely filed a registration for the renewal term on
5 September 3, 1921. Joint App’x Ex. 16 (Dkt. No. 189-1).² There is no evidence
6 that the Hill Sisters (Jessica or Patty) granted anyone the right to publish the *Happy*
7 *Birthday to You!* lyrics until 1935. The evidence instead shows that Summy sought
8 and obtained a license to publish the *Happy Birthday to You!* lyrics from Jessica Hill
9 in 1935. Joint App’x Ex. 50 at 668-69 (Dkt. No.189-3). Summy would not have
10 had to secure a license from Jessica Hill if it already had the rights to *Happy*
11 *Birthday to You!* or if the work had fallen into the public domain.

12 Plaintiffs’ proffered evidence does not show that The Cable Company’s 1922
13 publication was authorized by the copyright owners, *i.e.*, the Hill Sisters, or even
14 how it could have been authorized by the Hill Sisters. A publication of the *Happy*
15 *Birthday to You!* lyrics that was not authorized by the Hill Sisters could not have
16 divested their common law copyright in *Happy Birthday to You!*

17 Plaintiffs instead assert that it was Summy that authorized the 1922 and 1927
18 publications. Plaintiffs base this on the one-line statement that The Cable Company
19 included in *The Everyday Song Book*. But that statement does not say what the
20 “Special permission” was for—was it for *Good Morning to All* only? Was it for that
21 work in combination with the *Happy Birthday* lyrics? The statement also does not
22 say when such permission purportedly was provided or any other facts about that
23 would show authorization divesting the Hill Sisters’ copyright.

24 In short, the record does not show that The Cable Company’s 1922
25 publication of “Good Morning and Birthday Song”—whether with Summy’s

26 ² Jessica Hill was entitled to file the renewal application in her name because she
27 was one of Mildred Hill’s heirs. *See* Joint App’x Ex. 50 at 664 (Dkt. No. 189-3);
28 Nimmer § 9.05.

1 authorization or not—caused a divestive publication. The actions of the parties
2 directly involved with the facts over 80 years ago show that no such divestive
3 publication occurred. Jessica Hill or the Hill Foundation relied on Jessica’s 1921
4 renewal of *Good Morning to All* in the lawsuits that the Foundation filed in the
5 1930s and 1940s. This indicates that Jessica and Patty Hill were not even aware of
6 *The Everyday Song Book*, much less that they authorized any publication of the
7 *Happy Birthday to You!* lyrics other than in sheet music by Summy in 1934-35.³
8 Patty Hill testified in 1942 that she was not aware of any publication, other than by
9 Summy, that contained *Good Morning to All* “[w]ith [her] permission.” Joint App’x
10 Ex. 87 at 1018 (Dkt. No. 191-1). Summy’s own publication and registration of
11 *Happy Birthday to You!* in 1935, and Summy-Birchard’s renewal of the copyright in
12 that work in 1962, shows that those companies did not believe there to have been a
13 pre-1935 publication of the lyrics with the authority of the copyright owners.

14 We are not aware of any other documents that might shed light on these
15 issues. It is possible that The Cable Company’s applications and/or deposit copies
16 to the Copyright Office might have some further information bearing on these
17 matters, although we have not seen those. We do not know if Plaintiffs’ counsel
18 have additional documents on this matter that they have not provided. The
19 correspondence attached to Plaintiffs’ *ex parte* papers suggest that counsel received
20 and reviewed an earlier version of *The Everyday Song Book*, but they have not
21 provided that to us. If there are other documents that bear on these or other issues
22 that Plaintiffs’ counsel have but have not produced, we would ask that they produce
23 them, just as Warner/Chappell has produced documents from its counsel’s factual
24 investigation, a subject that we discuss in the Section immediately below.

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27 ³ Joint App’x Exs. 32 at 581-82 (Dkt. No. 189-2), 50 at 662-65 (Dkt. No. 189-3), 52
28 at 692-94 (Dkt. No. 189-3).

1 **B. Warner/Chappell’s Supplemental Production**

2 Warner/Chappell made a supplemental production earlier this month that
3 included the document that Plaintiffs say caused them to locate the 1927 and 1922
4 copies of *The Everyday Song Book*. Warner/Chappell was not hiding that or other
5 documents or proceeding in bad faith.⁴

6 In late 2013, Warner/Chappell’s counsel conducted a fact investigation
7 concerning Plaintiffs’ contention—first raised at the hearing on Warner/Chappell’s
8 motion to dismiss—that the copy of *Happy Birthday to You!* that the Clayton F.
9 Summy Co. deposited in December 1935 with the application for the E51990
10 copyright registration might not contain the “familiar lyrics.” Oct. 7, 2013 Hr’g Tr.
11 at 48 at 7-11 (“You will find out soon enough that what [E]51990 says is a mystery
12 to the entire world. No one—no one knows, because no one has a deposit copy for
13 that copyright—not the copyright office, and we believe not the defendants.”). As
14 part of that investigation, in or around December 2013, counsel was given access to
15 files maintained on microfilm by a third party, Alfred Publishing (“Alfred”). Alfred
16 publishes sheet music. In 2005, Warner Music Group sold its sheet music printing
17 business—Warner Bros. Publications—to Alfred, and Warner/Chappell entered into
18 long-term print licenses with Alfred covering Warner/Chappell’s existing and future
19 sheet music repertoires. The purpose of obtaining this access was to determine
20 whether Alfred might have anything related to the *Happy Birthday to You!* deposit
21 copy, in which case Warner/Chappell would subpoena Alfred for its documents.
22 We did not find anything related to the deposit copy or any other issue for which we
23 might want to subpoena the documents for use in litigation. And, to be clear, we did
24 not notice the blurred text on the sheet music printed by The Cable Company that
25 now turns out to have said “Special permission by courtesy of The Clayton F

26 ⁴ If the Court would like to have a declaration from counsel on these matters, we of
27 course will submit one. We are submitting this written opposition now so that the
28 Court has our discussion of the factual background within the short time-frame for
responding to the *ex parte* application.

1 Summy Co.,” or anything else that would have caused us to question whether
2 Summy or anyone else might have purported to grant rights in *Happy Birthday to*
3 *You!* to any third party prior to the 1935 copyright registration of *Happy Birthday to*
4 *You!* Because the Alfred documents had been reviewed as part of counsel’s work
5 product factual investigation, we did not believe that they were subject to discovery,
6 and therefore we did not review them for possible production in response to
7 Plaintiffs’ discovery requests.

8 In the wake of the March 23, 2015 summary judgment hearing,
9 Warner/Chappell’s counsel again conducted a review of third-party files to
10 determine if there were documents Warner/Chappell might want to subpoena in the
11 event the Court were to find open historical issues and order a trial. As part of that
12 review, and with the assistance of Warner/Chappell’s United Kingdom affiliate,
13 counsel obtained documents relating to *Happy Birthday to You!* from Sony/ATV
14 Music Publishing (U.K.), a third party that has the rights to publish *Happy Birthday*
15 *to You!* in the U.K. Counsel also obtained documents from the Filson Historical
16 Society, located in Louisville Kentucky, which houses papers associated with Patty
17 Hill. Warner/Chappell also obtained certified copies of Summy’s December 6, 1935
18 deposit of *Happy Birthday to You!* with the British Museum. That 1935 deposit
19 contains the exact “familiar lyrics” that Warner/Chappell contends Summy
20 deposited with the E51990 registration also on December 6, 1935. Warner/Chappell
21 had previously attempted to obtain the British Museum’s 1935 deposit copy back in
22 2013, but was told by the British Library (custodian of the Museum’s deposit
23 records) that they could not locate those files at that time. Warner/Chappell has
24 filed a motion to supplement the record with that deposit copy, Dkt. No. 223.

25 Upon receiving the third-party documents in 2015, counsel again considered
26 whether its possession of the documents for purposes of its work product
27 investigation meant that those documents were discoverable. Although there are
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1 cases that have found otherwise, the stronger argument from the decided cases
2 appears to be that counsel’s possession, even for purposes of a work product
3 investigation of facts relevant to the client’s case, are subject to discovery.⁵ After
4 making that determination, we supplemented Warner/Chappell’s production. In our
5 letter accompanying the production, we told Plaintiffs’ counsel that, if after
6 reviewing the documents they wanted to supplement the summary judgment record
7 with one or more of these documents, Warner/Chappell would enter into a joint
8 stipulation making such a request. Plaintiffs’ written response to us, on July 15,
9 stated that Plaintiffs did not want to supplement the record. We did not hear further
10 from Plaintiffs’ counsel regarding this matter until last Friday, when they said they
11 intended to file the instant *ex parte* application.

12 **C. Conclusion**

13 For the foregoing reasons, Warner/Chappell respectfully submits that
14 Plaintiffs’ submitted evidence does not warrant the grant of summary judgment in
15 their favor. At most, the evidence would create an issue of fact. If the Court is
16 inclined to consider Plaintiffs’ argument further, we would request the opportunity
17 to obtain from the Copyright Office whatever applications, registrations, and/or

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19 //
20 //

21 ⁵ Compare *Sporck v. Peil*, 759 F.2d 312, 316 (3d Cir. 1985) (“[T]he selection and
22 compilation of documents by counsel in this case in preparation for pretrial
23 discovery falls within the highly-protected category of opinion work product.”); *Am.
24 Soc’y For Prevention of Cruelty To Animals v. Ringling Bros. & Barnum & Bailey
25 Circus*, 233 F.R.D. 209, 212 (D.D.C. 2006) (“[D]ocuments gathered by defendants’
26 counsel for impeachment constitute traditional work product.”), and *Golden Trade,
27 S.r.L. v. Jordache*, 143 F.R.D. 508, 511 (S.D.N.Y. 1992) (“The search [for prior art]
28 was made to aid in current and anticipated litigation, and hence its fruits come
squarely within the ambit of the work-product doctrine.”), with Order Granting
Motion to Compel, *Allen v. Lickman*, No. 2:13-cv-13401-AJT-PTM (E.D. Mich.
Oct. 31, 2014), Dkt. No. 39 (surveying precedent and finding work product claim
inapplicable); *Kartman v. State Farm Mut. Auto. Ins. Co.*, 247 F.R.D. 561, 565 (S.D.
Ind. 2007) (distinguishing *Ringling Bros.* and rejecting work product claim).

1 deposit copies that office may have of the various versions of *The Everyday Song*
2 *Book* to determine whether those materials contain additional relevant evidence.

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4 DATED: July 28, 2015

MUNGER, TOLLES & OLSON LLP

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By: /s/ Kelly M. Klaus
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