
Pa. Fed. Dist. Ct. Awards Single Statutory Damage for Copyright Infringement of Multiple Works in Compilation

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The case of *Ackourey v. Mohan's Custom Tailors, Inc.*¹ concerns allegations of copyright infringement of a registered compilation and certain copyrighted drawings that are part of the compilation. In granting in part and denying in part defendants' motion for partial summary judgment, the United States District Court for the Eastern District of Pennsylvania held that plaintiff is precluded from seeking statutory damages or attorney's fees for the untimely registered compilation, but is entitled to pursue a single statutory damage award for infringement of preexisting copyrights on the individual drawings.

FACTS OF THE CASE

Plaintiff “produces, displays, and distributes stylebooks containing copyrighted drawings and graphic representations of men's and women's clothing styles.”² In 2004, Graphic Fashions, Inc. (“Graphic”) licensed to plaintiff the “right[]

to reproduce, display, distribute and create derivatives of all copyrighted work owned by” it.³ In 2006, plaintiff published a stylebook titled “Styles International Best of Seasons 2006” (“2006 Stylebook”), which contains 160 to 260 drawings.⁴ Some of the drawings were reproduced from prior stylebooks published by Graphic, while others were original.⁵ “By 2007, Graphic assigned all ownership rights in its copyrights to [p]laintiff.”⁶

Defendants received a copy of the 2006 Stylebook in March or April 2006 and, in 2008, created and printed 1000 copies of Mohan's Custom Tailors Catalog (“Catalog”).⁷ In 2009, plaintiff received a copy of the Catalog and filed suit against defendants, alleging infringement under the Copyright Act of 1976⁸ for “publishing the Catalog with 123 images copied directly from 2006 Stylebook without authorization.”⁹ “The

3. *Id.*

4. *Id.*

5. *Id.*

6. *Id.*

7. *Id.*

8. 17 U.S.C. §§ 101-810.

9. *Ackourey* at *1.

1. No. 09-CV-5454, 2011 WL 3862301 (E.D. Pa. September 1, 2011).

2. *Id.* at *1 (omitting internal citation and quotation marks).

2006 Stylebook was registered with the United States Copyright Office . . . under registration number TX 6-956-762, effective January 30, 2009.”¹⁰ Among other relief, plaintiff seeks statutory damages and attorney's fees.¹¹

Defendants seek summary judgment on the issue of statutory damages and attorney's fees.¹² They assert that statutory damages and attorney's fees are barred by 17 U.S.C. § 412 because their alleged copyright infringement is based on material from the 2006 Stylebook, which was not registered within three months of first publication, but after the alleged infringement began.¹³ Plaintiff argues, contrarily, that the 2006 Stylebook contains images reproduced from stylebooks previously registered by Graphic prior to commencement of the infringement, entitling it to statutory damage awards for each infringed stylebook.¹⁴

COURT'S ANALYSIS

Under the Copyright Act, a copyright owner is entitled to: “(a) recoup his or her actual damages and the infringer's profits attributable to the infringement or (b) collect special statutory damages.”¹⁵ However, pursuant to 17 U.S.C. §

412, an owner must first register her copyright with the Copyright Office in two instances to be eligible for statutory damages. In pertinent part, § 412 states:

“[N]o award of statutory damages or of attorney’s fees, as provided by sections 504 and 505, shall be made for —

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.”¹⁶

The 2006 Stylebook was first published on May 1, 2006, but was not registered until January 30, 2009.¹⁷ Defendants began to produce the Catalog in 2008.¹⁸ Hence, under § 412, plaintiff is precluded from statutory damages or attorney's fees for infringement of the stylebook, number TX 6-956-762.¹⁹

10. *Id.*

11. *Id.*

12. *Id.* at *2.

13. *Id.*

14. *Id.*

15. *Id.* (citing 17 U.S.C. §§ 504(a)-(b)).

16. *Id.*

17. *Id.*

18. *Id.*

19. *Id.*

In papers opposing defendants' motion, plaintiff ignores the statutory damages issue with respect to the compilation, but instead alleges that defendants infringed 27 copyrighted images reproduced in the 2006 Stylebook.²⁰ Of the 27 copyrights, twelve were registered prior to the publication of the stylebook.²¹ The court states that, under 17 U.S.C. § 103(b), the copyright in a compilation extends only to material contributed by the author and not to the preexisting material used in the work.²² Further, the copyright in a compilation is independent of, and does not impact, any copyright in the preexisting material.²³ Although § 412 bars plaintiff from seeking statutory damages and attorney's fees for copyright infringement of the stylebook, there is no such bar with respect to the twelve registered images, which the court notes were promptly registered after their initial publication.²⁴

Also in dispute is whether plaintiff may seek one or several statutory damage awards.²⁵ Section 504(c)(1) of the Copyright Act provides for damages, “with respect to any one work,” of between \$750 and \$30,000.²⁶ If more than one work has been infringed, then the minimum

statutory damages are multiplied by the number of works.²⁷ Defendants contend that, as a compilation, under § 504(c)(1), all parts of the 2006 Stylebook are considered one work.²⁸ Plaintiff argues that in containing multiple, previously published and copyrighted images, the stylebook comprises multiple works.²⁹ The court, however, had little trouble finding that the stylebook is a compilation: (1) both parties admit that it is a compilation in their pleadings or motion papers, (2) the copyright registration certificate indicates that it is a compilation, and (3) the work meets the statutory definition³⁰ of a compilation.³¹ Thus, the court ruled that plaintiff is entitled to one statutory damage award for infringement of the stylebook under § 504(c)(1).³²

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20. *Id.* at *3.

21. *Id.*

22. *Id.*

23. *Id.*

24. *Id.*

25. *Id.*

26. *Id.* (omitting internal quotation marks).

27. *Id.* (citing *Rodgers v. Eighty Four Lumber Co.*, 623 F. Supp. 889, 890-92 (W.D. Pa. 1985), in which plaintiff was awarded damages of \$2500 for each of 49 copyright infringements, for a total of \$122,500).

28. *Id.* at *4.

29. *Id.*

30. “Compilation” is defined in 17 U.S.C. § 101 as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.”

31. *Id.*

32. *Id.*