

17.24 Copyright—Affirmative Defense—Abandonment

The defendant [name] contends that a copyright does not exist in the plaintiff [name]'s work because the plaintiff [name] abandoned the copyright. The plaintiff [name] cannot claim ownership of the copyright if it was abandoned. To show abandonment, the defendant [name] has the burden of proving each of the following by a preponderance of the evidence:

First, the plaintiff [name] intended to surrender [ownership] rights in the work; and

Second, an act by the plaintiff [name] evidencing that intent.

Mere inaction [or publication without a copyright notice] does not constitute abandonment of the copyright; however, [this may be a factor] [these may be factors] for you to consider in determining whether the plaintiff [name] has abandoned the copyright.

If you find that the plaintiff [name] has proved [his] [her] [other pronoun] claim[s] in accordance with Instruction[s] [insert cross reference to the pertinent instructions on the plaintiff's theory of infringement], your verdict should be for the plaintiff [name], unless you find that the defendant [name] has proved each of the elements of this affirmative defense, in which case your verdict should be for the defendant [name].

Comment

Abandonment is an affirmative defense. *See, e.g., A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1026 (9th Cir. 2001); *Abend v. MCA, Inc.*, 863 F.2d 1465, 1482 n.21 (9th Cir. 1988). The Ninth Circuit adopted the doctrine of copyright abandonment in *Hampton v. Paramount Pictures Corp.*, 279 F.2d 100, 104 (9th Cir. 1960). *See Doc's Dream, LLC v. Dolores Press, Inc.*, 959 F.3d 357, 362 (9th Cir. 2020).

Abandonment of a right secured by the Copyright Act must be manifested by an overt act indicating an intention to abandon that right. *Micro Star v. Formgen, Inc.*, 154 F.3d 1107, 1114 (9th Cir. 1998). A copyright owner may abandon some rights and retain others. *Id.* at 1114 (holding that a license permitting creation of derivative works from software, but also prohibiting the licensees from distributing derivative works commercially, did not abandon the copyright holder's rights to profit commercially from derivative works).

The bracketed portion of the second paragraph pertaining to publication without copyright notice should be used if the copyright infringement action is brought under the 1909 Copyright Act. Under the Copyright Act of 1909, a federal copyright was secured by publishing a work with the proper notice. *La Cienega Music Co. v. ZZ Top*, 53 F.3d 950, 953 (9th Cir. 1995). Before publication, common law copyright protected a work from the time of its creation. *Id.*

Under the 1909 Copyright Act, if a work was published without notice, the author (1) failed to obtain a federal copyright, and (2) lost the common law copyright. *See Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1165 (9th Cir. 1996). When a copyright owner loses its rights in its work by publication without proper notice, the resulting loss is an involuntary forfeiture as opposed to abandonment. *See* William F. Patry, 2 *Patry on Copyright*, § 5:155 (2023) (“Abandonment refers to deliberate acts taken by the copyright owner to disclaim its interest in a protected work. . . . Forfeiture occurs by operation of law, without regard to the copyright owner’s intent.”); *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1026-27 (9th Cir. 1981) (citing *Nat’l Comics Publ’ns, Inc. v. Fawcett Publ’ns*, 191 F.2d 594, 599 (2d Cir. 1951), *supplemented sub nom. Nat’l Comics Publ’ns v. Fawcett Publ’ns*, 198 F.2d 927 (2d Cir. 1952)).

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