

17.27 Copyright—Affirmative Defense—Express License

The defendant [name] contends that [he] [she] [other pronoun] is not liable for copyright infringement because the plaintiff [name] granted [him] [her] [other pronoun] an express license to [copy] [distribute] [use] the plaintiff [name]'s copyrighted work. The plaintiff [name] cannot claim copyright infringement against a defendant [name] who [copies] [distributes] [uses] the plaintiff [name]'s copyrighted work if the plaintiff [name] granted the defendant [name] an express license to [copy] [distribute] [use] the work.

To show the existence of an express license, the defendant [name] has the burden of proving that [he] [she] [other pronoun] received an express license to [copy] [distribute] [use] the plaintiff [name]'s copyrighted work.

If the defendant [name] proves this, the burden shifts to the plaintiff [name] to show that the defendant [name]'s [copying] [distribution] [use] of the plaintiff [name]'s copyrighted work exceeded the scope of the license.

[I have separately instructed you on the scope of the license agreement between the parties.]

If you find that the defendant [name] has proved that the plaintiff [name] granted [him] [her] [other pronoun] an express license to [copy] [distribute] [use] the copyrighted work, your verdict should be for the defendant [name] [on that portion of the plaintiff's copyright infringement claim], unless the plaintiff [name] proves the defendant [name]'s [copying] [distribution] [use] of the plaintiff [name]'s copyrighted work exceeded the scope of the license. If the plaintiff [name] proves this, your verdict must be for the plaintiff [name].

Comment

“An applicable license may be dispositive of an infringement claim.” *Oracle Am., Inc. v. Hewlett Packard Enter. Co.*, 971 F.3d 1042, 1051 (9th Cir. 2020). “Anyone who is authorized by the copyright owner to use the copyrighted work in a way specified in [the Copyright Act] . . . is not an infringer of the copyright with respect to such use.” *Id.* (alterations in original) (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984)). “Thus, ‘[t]he existence of a license creates an affirmative defense to a claim of copyright infringement.’” *Oracle USA, Inc. v. Rimini St., Inc.*, 879 F.3d 948, 954 (9th Cir. 2018) (alteration in original) (quoting *Worldwide Church of God v. Phila. Church of God, Inc.*, 227 F.3d 1110, 1114 (9th Cir. 2000)), *rev’d on other grounds*, 586 U.S. 334 (2019). A claim for copyright infringement fails “if the challenged use of the work falls within the scope of a valid license.” *Great Minds v. Off. Depot, Inc.*, 945 F.3d 1106, 1110 (9th Cir. 2019). But a licensee is liable for infringement if its use of the work “exceeds the scope of the license granted by the copyright holder.” *Oracle USA, Inc.*, 879 F.3d at 954 (quoting *LGS Architects, Inc. v. Concordia Homes of Nev.*, 434 F.3d 1150, 1156 (9th Cir. 2006)).

The trial court should modify this instruction as necessary to reflect the nature of the defendant's alleged copyright infringement. In a case in which the defendant claims to have acted under an express license, it is likely that the trial court will need to construe the terms of the license for the jury. *See, e.g., id.* at 955, 958. "Federal courts 'rely on state law to provide the canons of contractual construction, but only to the extent such rules do not interfere with federal copyright law or policy.'" *Great Minds*, 945 F.3d at 1110 (quoting *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1088 (9th Cir. 1989)).

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