

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW MEXICO

PRESIDENT AND FELLOWS
OF HARVARD COLLEGE,

Plaintiff,

v.

No.: 1:15-cv-00472 RB/KK

STEVE ELMORE, STEVE ELMORE
PHOTOGRAPHY, INC., D/B/A STEVE ELMORE
INDIAN ART, AND D/B/A SPIRIT BIRD PRESS,

Defendants.

MOTION FOR PARTIAL SUMMARY JUDGMENT

COMES NOW Defendant, Steve Elmore (“Mr. Elmore”), by and through his attorneys, Guebert Bruckner P.C. (Christopher J. DeLara and Jonathan A. Garcia), and files this Motion for Partial Summary Judgment as to Count I of Harvard’s Complaint. In support of this Motion, Mr. Elmore states as follows:

INTRODUCTION AND BACKGROUND

This case arises from the publication of a book by Spirit Bird Press, a subsidiary of Steve Elmore Photography, Inc., titled: *“In Search of Nampeyo: The Early Years, 1875-1892.”* Prior to publication of the book, Mr. Elmore had spent 20 years researching the work of Hopi artist Nampeyo at institutions throughout the country. Also during that time, Mr. Elmore had become one of the premier dealers in Native American pottery in Santa Fe, New Mexico. As a result of his research and knowledge, in 2009, Stephen LeBlanc, curator of the collections at the Peabody Museum of Archaeology and Ethnology (the “Peabody Museum”) at Harvard University personally asked Mr. Elmore to submit a book proposal to the

Peabody Museum Press (the “Press”) on Mr. Elmore’s research on Nampeyo’s unattributed ceramics in the Keam Collection at the Peabody.

As such, Mr. Elmore submitted a proposal to Joan K. O’Donnell, director of the Press. The book proposal was reviewed and “unanimously accepted by the board with enthusiasm.” All the while, Harvard, the Peabody and the Press (collectively, “Harvard”) knew Mr. Elmore was in the business of buying and selling Native American art.

On August 14, 2010, and before the book was published, Mr. Elmore and Harvard, on behalf of the Peabody Museum, entered into a Letter of Agreement (the “Letter of Agreement”) whereby Mr. Elmore contracted with Harvard to produce a book provisionally titled: “*In Search of Nampeyo: The Apprenticeship of a Great Hopi Artist.*”

Under the Letter of Agreement, the manuscript was considered a Work Made for Hire pursuant to the United States Copyright Act, and Mr. Elmore agreed to grant, assign, and transfer to the President and Fellows of Harvard College all publication rights to the manuscript and book, including all rights of copyright.

After numerous discussions concerning the content of the book and after Mr. Elmore submitted two (2) complete drafts of the manuscript to Harvard, including one entitled “*Nampeyo, The Early Years 1875 to 1892, A Photographic Art History of the Thomas Keam Collection of Hopi Pottery at the Harvard University’s Peabody Museum*”, Harvard returned all rights in and to the manuscript to Mr. Elmore by hand delivering a letter dated January 21, 2014 (the “Formal Notification”) to Mr. Elmore in Santa Fe, New Mexico.

The Formal Notification informed Mr. Elmore that all rights in the manuscript, and all versions of the manuscript were returned to Mr. Elmore as his sole property. The Formal Notification was delivered to Mr. Elmore after repeated representations from Harvard and the

Peabody that the book was expected to be published. There were no restrictions communicated to Mr. Elmore, either in the Formal Notification or orally, relative to Mr. Elmore's right to publish the manuscript. To the contrary, the Formal Notification encouraged Mr. Elmore to publish the manuscript elsewhere and recommended publishers.

Relying on the representations in the Formal Notification, Mr. Elmore published his work titled: "*In Search of Nampeyo: The Early Years, 1875-1892.*" On June 4, 2015, Harvard filed suit against Mr. Elmore and claims, among other things, that Mr. Elmore copied fifty (50) black and white photographs from *Historic Hopi Ceramics*, authored by Edwin L. Wade and Lea S. McChesney, and created and published unauthorized derivatives of the photographs from *Historic Hopi Ceramics* in *In Search of Nampeyo*. Despite Harvard's assertions, Mr. Elmore's book contains no photographs from *Historic Hopi Ceramics*, and instead includes independently created illustrations of designs created by Nampeyo before 1900, to which there are no copyrights. Although Harvard has claimed in this litigation that they are not claiming copyright to those original Nampeyo designs, in reality Harvard's actions show that they are indeed trying to assert ownership of those designs through illegitimate copyright claims to prevent publication of the independently created illustrations within Mr. Elmore's book.

Although Harvard has been able to withhold evidence that is critical to the defense of the claims asserted against Mr. Elmore¹, the facts and information that have come to light thus far show that the issue of copyrightability is ripe for decision.

Accordingly, Mr. Elmore seeks summary judgment as to Harvard's copyright claim (Count I) of Harvard's Complaint on the basis that Harvard's copyright registrations are invalid as to the photographs contained within *Historic Hopi Ceramics* because the photographs contained within *Historic Hopi Ceramics* are not subject to copyright protection under the

¹ See Motion to Compel filed on January 22, 2016 [Doc. 89].

controlling authority in this jurisdiction and under the Copyright Act. Mr. Elmore also seeks summary judgment as to Count I of Harvard's Complaint because, even if the photographs were entitled to copyright protection, Harvard's copyright claims fail as a matter of law because the photographs contained within *Historic Hopi Ceramics* are only protected from "verbatim copying," and the colorized illustrations in the book authored by Mr. Elmore, *In Search of Nampeyo*, are not verbatim copies. Lastly, Mr. Elmore seeks summary judgment as to Count I of Harvard's Complaint on the basis that Harvard is precluded from asserting its copyright infringement claim because Mr. Elmore was provided the exclusive and unrestricted right to all rights in and to the manuscripts previously submitted to Harvard when he was provided with the Formal Notification.

STATEMENT OF UNDISPUTED MATERIAL FACTS

1. On August 14, 2010, Mr. Elmore and Harvard entered into a Letter of Agreement whereby Mr. Elmore contracted with Harvard on behalf of the Peabody Museum of Archaeology and Ethnology to produce a book provisionally titled: "*In Search of Nampeyo: The Apprenticeship of a Great Hopi Artist*" on Nampeyo pottery in the Peabody Museum's Keam collection. Complaint [Doc. 1, ¶ 19]; Mr. Elmore's Answer and Counterclaim [Doc. 22 ¶ 5]; Harvard's Answer [Doc. 38 ¶ 5]; the Letter of Agreement, pp 1, **Exhibit A**.

2. Pursuant to the Letter of Agreement, "the work as used herein shall include all revisions, editions and versions thereof in all languages, forms and media, now or hereafter known or developed, including electronic publication and dissemination." Testimony of Kara Schneiderman, TR 71:15 - 21, Dec. 7, 2015, **Exhibit B**; the Letter of Agreement, pp 2, **Exhibit A**.

3. Pursuant to the Letter of Agreement, the manuscript was considered a Work Made for Hire pursuant to the United States Copyright Act, and Mr. Elmore agreed to grant, assign, and transfer to the President and Fellows of Harvard College all publication rights to the manuscript and book, including all rights of copyright, and Harvard was to be considered the author of the Work. The Letter of Agreement, pp 2, **Exhibit A**; Testimony of Joan K. O'Donnell, TR 111:14-20, Dec. 7, 2015, **Exhibit C** (“The book, the contract is a Work Made for Hire contract, actually, so he gave to the President and Fellows of Harvard College all rights to the manuscript, which was research being done as working for the museum. So he was giving us all publication rights, all rights of copyright. We would be considered the author of the work...”).

4. Pursuant to the Letter of Agreement, Mr. Elmore was producing a book for the Peabody Museum at Harvard. The Letter of Agreement, pp 2, **Exhibit A**; Testimony of Joan K. O'Donnell, TR 116:2-4, Dec. 7, 2015, **Exhibit C**.

5. The Letter of Agreement also provides that “The museum will handle all photography and produce any other needed artwork for the volume. The Press will manage editorial design and production work for the volume, which will be published in a style determined by the museum and Press.” However, these provisions only apply if the Peabody publishes the book, and not if Mr. Elmore published his book. Testimony of Kara Schneiderman, TR 70:9 - 72:11, Dec. 7, 2015, **Exhibit B**.

6. On January 10, 2011, Mr. Elmore visited the Keam Collection. During his visit, Mr. Elmore photographed various pieces of pottery maintained by the Peabody Museum and was supervised by Susan Haskell, Collections Steward for the Peabody Museum. Testimony of

Kara Schneiderman, TR 72:17-25; 73:1-3, Dec. 7, 2015, **Exhibit B.**; Affidavit of Steve Elmore (“Elmore Aff.”), [Doc. 13-1, ¶ 7].

7. In May, 2012, Mr. Elmore submitted his first draft of the manuscript. In November, 2013, Mr. Elmore submitted a second draft of the manuscript. Both versions contained numerous photographs of the pottery Mr. Elmore took while visiting the Keam Collection on January 10, 2011. Elmore Aff. [Doc. 13-1, ¶ 14-16].

8. The manuscript submitted by Mr. Elmore in November, 2013 was titled, “*Nampeyo, The Early Years 1875 to 1892, A Photographic Art History of the Thomas Keam Collection of Hopi Pottery at the Harvard University’s Peabody Museum.*” Testimony of Joan O’Donnell, TR 123:12-23, Dec. 7, 2015, **Exhibit C.**

9. Mr. Elmore’s book is a photographic art history, “so there would be very little value” to Mr. Elmore’s manuscript without photographs. Testimony of Joan O’Donnell, TR 124:12-17, Dec. 7, 2015, **Exhibit C.**

10. In January, 2014, Mr. Elmore was hand-delivered a letter dated January 21, 2014 (the “Formal Notification”) by Joan K. O’Donnell, Director of Publications for the Press, in Santa Fe, New Mexico. In that letter, Mr. Elmore was formally notified that all rights in the manuscript, and all versions of the manuscript were returned to him as his sole property. In particular, the Formal Notification provided:

This letter will serve as a formal notification that the Peabody Museum of Archaeology and Ethnology hereby returns to you all rights in the manuscript ‘In Search of Nampeyo: The Apprenticeship of a Great Hopi Artist,’ including all versions of the manuscript submitted to the Peabody Museum Press...

The Board recommends that you find a magazine or trade publisher that specializes in Southwest Indian art to publish the work. American Indian Art Magazine is one such venue, and I would support publication there.

See the Formal Notification, **Exhibit D** (*emphasis added*); Elmore Aff. [Doc. 13-1, ¶ 18]; Testimony of Joan K. O'Donnell, TR 112:18-21, Dec. 7, 2015, **Exhibit C** (“This was the letter that we wrote to both let Mr. Elmore know we were not going to be publishing the book and returning to him all rights that he had granted to us in the manuscript.”).

11. Joan O'Donnell drafted the Formal Notification letter, and Mr. Elmore did not have any part in drafting the Formal Notification letter. Testimony of Joan O'Donnell, TR 134:6-17, Dec. 7, 2015, **Exhibit C**.

12. Ms. O'Donnell could have included any language of her choosing in the Formal Notification. Testimony of Joan O'Donnell, TR 134:10-14, Dec. 7, 2015, **Exhibit C**.

13. In January, 2015, “*In Search of Nampeyo: The Early Years, 1875-1892*” was published. *In Search of Nampeyo* includes the photographs that were contained within both manuscript drafts of the pottery Mr. Elmore took while at the Peabody Museum. Complaint [Doc. 1, ¶30]; Elmore Aff. [Doc. 13-1, ¶ 21].

14. Harvard claims Mr. Elmore copied fifty (50) black and white photographs from *Historic Hopi Ceramics*, authored by Edwin L. Wade and Lea S. McChesney, and created and published unauthorized derivatives of the photographs from *Historic Hopi Ceramics* in *In Search of Nampeyo*. Complaint [Doc. 1, ¶ 31, and 33-34].

15. Harvard does not claim any copyright in the designs depicted in the photographs in *Historic Hopi Ceramics*. Complaint [Doc. 1, ¶ 35]. However, Harvard is claiming copyright infringement.

16. *Historic Hopi Ceramics* is a survey of historic Hopi ceramics from the Keam Collection. See *Historic Hopi Ceramics*, p. 2 Plaintiff's Exhibit 21 for Hearing on

Motion for Preliminary Injunction, **Exhibit E** to this Motion. (“This volume...is but a preliminary survey of historic Hopi ceramics from the Keam Collection.”)

17. *Historic Hopi Ceramics* is merely a basic reference book, and was not intended to offer any statements in either an artistic or theoretical sense. See *Historic Hopi Ceramics*, p. 1 Plaintiff’s Exhibit 21 for Hearing on Motion for Preliminary Injunction. (“It is intended as a basic reference book that very generally describes, aesthetically and technically, the stylistic development of Hopi pottery. It is not intended as a definitive statement of Hopi pottery in either an artistic or theoretical sense.”).

18. *Historic Hopi Ceramics* is “meant to be a catalog of the Keam Collection.” Testimony of Kara Schneiderman, TR 50:13-18, Dec. 7, 2015, **Exhibit B**.

19. Lea McChesney, co-author of *Historic Hopi Ceramics*, has referred to the record photos in *Historic Hopi Ceramics* as “mug shots.” Lea S. McChesney and Karen K. Charley, *Body Talk: New Language for Hopi Pottery Through Cultural Heritage Collaboration*, *Practicing Anthropology* Vol. 33, No 2. (Spring 2011), **Exhibit F** (“While both publications have inspired potters to reinterpret certain pieces in the collection, photographs are a poor substitute for the actual objects, especially when the images are technically inferior (**McChesney refers to the record photos in *Historic Hopi Ceramics* in none to flattering terms as ‘mug shots....’**)). (emphasis added)

20. A Certificate of Copyright Registration to *Historic Hopi Ceramics: The Thomas V. Keam Collection of the Peabody Museum of Archaeology and Ethnology, Harvard University* was issued to Harvard on December 3, 1981. See Certificate of Copyright Registration [Doc. 6].

21. The Certificate of Registration does not specify whether the Copyright Registration extends to the photographs contained within *Historic Hopi Ceramics*. *Id.*

22. Mark Diederichsen (“Mr. Diederichsen”) designed the layout of *In Search of Nampeyo* and created the colorized illustrations of pottery designs maintained in the Keam Collection for use in *In Search of Nampeyo*. Testimony of Mark Diederichsen, TR 182:12-14, Dec. 7, 2015 **Exhibit G**.

23. Mr. Diederichsen “traced the design elements” of the pottery Mr. Diederichsen was going to depict, removed the gray scale and filled each line with one of three chosen colors. Testimony of Mark Diederichsen, TR 182:19-25; 183:1; 183:21-24, **Exhibit G**.

24. None of the photographs from *Historic Hopi Ceramics* are reproduced within *In Search of Nampeyo*. Testimony of Mark Diederichsen, TR 184:5-10, **Exhibit G**.

25. Harvard is not the creator of the ceramics that are the subject matter of Mr. Elmore’s book and that are maintained in the public domain. Complaint [Doc. 1, ¶ 35]; Harvard’s Answer to Interrogatory No. 19, **Exhibit H** (“Harvard states it has never claimed to hold a copyright to any of Nampeyo’s works.”).

26. Concurrence of opposing counsel in this Motion has been sought, but not obtained.

LEGAL STANDARD

Under Federal Rule of Civil Procedure 56(c), summary judgment is proper “if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c); *see Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.3d 1193, 1196 (10th Cir. 2005).

“The burden of showing the absence of a genuine issue of material fact, and an entitlement to judgment as a matter of law is upon the movant, but a party opposing summary judgment must do more than simply show that there is some metaphysical doubt as to the material facts.” *Palladium Music, Inc.*, 398 F.3d at 1196 (citing *Matsushita Electric Industrial Co. v. Zenith Radio Corporation*, 475 U.S. 574, 586, 89 L. Ed. 2d 538, 106 S. Ct. 1348 (1986)).

“[T]he plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial.” *Id.* (internal quotations omitted).

ARGUMENT

I. HARVARD'S COPYRIGHT CLAIM FAILS AS A MATTER OF LAW.

“The issue of copyrightability is typically resolved by motion for summary judgment.” *Magic Mktg., Inc. v. Mailing Servs. of Pittsburgh, Inc.*, 634 F. Supp. 769 (W.D. Pa. 1986); *see also Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 853 (6th Cir. 1991) (“Copyrightability is often resolved on summary judgment.”).

A. Copyright Does Not Protect Slavish Copies of Ceramics in the Public Domain.

Copyright protection subsists “in original works of authorship.” 17 U.S.C. § 102(a). “[T]o establish infringement, two elements must be shown: (1) ownership of a valid copyright; and (2) copying of constituent elements of the work that are original.” *Feist Publications, Inc. v. Rural Tel. Serv. Co. Inc.*, 499 U.S. 340, 361 (1991).

A certificate of registration from the U.S. Copyright Office can establish *prima facie* evidence of a valid copyright. *Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.3d 1193, 1196 (10th Cir. 2005). However, even if a work is copyrighted, the copyright may not protect

“every element of the work.” *Feist Publications, Inc.*, 499 U.S. at 348. Copyrights only protect “original works of authorship....” 17 U.S.C. § 102. The requirement for originality “seeks to strike a delicate balance—rewarding (and thus encouraging) those who contribute something new to society, while also allowing (and thus stimulating) others to build upon, add to, and develop those creations.” *Meshwerks, Inc. v. Toyota Motor Sales U.S.A.*, 528 F.3d 1258, 1262, 2008 U.S. App. Lexis 12774. Originality requires that the work is “independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Feist Publications, Inc.*, 499 U.S. at 345. Copyrights may protect photographs, but “only to the extent of their *original* depiction of the subject.” *Meshwerks, Inc.*, 528 F.3d at 1264.

If a photograph lacks “decisions regarding lighting, shading, angle, background, and so forth,” it is not copyrightable. *Id.* at 1265 (internal quotations omitted). To determine whether a photograph can be protected by a copyright, the courts “filter out” objects not subject to a copyright and determine whether any “copyrightable expression remain[s].” *Id.* at 1266.

In this case, the 50 black and white photographs contained within *Historic Hopi Ceramics* that Harvard alleges Mr. Elmore has created “unauthorized derivatives” of do not fall under the Copyright Act. The photographs are lacking in the originality required as a condition of obtaining copyright protection and mere depictions of existing physical characteristics are not original works of authorship. Thus, all of the designs depicted within the 50 black and white photographs contained within *Historic Hopi Ceramics* are not protected by copyright, are in the public domain, and summary judgment as to Harvard’s copyright claim is required.

Other courts have denied copyright protection in analogous cases, involving copies of facts in the world, as well as copies of prior works of art. For example, the Court in *Sparaco v.*

Lawler, Matusky, Skelly, Engineers LLP, 303 F.3d 460, 467 (2d Cir. 2002), relied on *Feist* in denying copyright protection to that portion of an architectural drawing setting forth “the existing physical characteristics of the site, including its shape and dimensions, the grade contours, and the location of existing elements, [as] it sets forth facts; copyright does not bar the copying of such facts.” *Id.*

The same is true in this case. As this Court has already stated, “other than this imagery [on the pottery itself], the pictures [in *Historic Hopi Ceramics*] depict no originality.” See Memo and Order [Doc. 75. at 16] “The pictures in *Historic Hopi Ceramics* depict only the pots and include no background.” *Id.* In essence, the photographs are merely depictions of existing elements—existing physical characteristic—that merely set forth facts as they existed at the time the photographs were taken. This is supported by the testimony of Harvard’s own Director of Collections who testified *Historic Hopi Ceramics* is only “meant to be a catalog of the Keam Collection.” See Material Fact No. 18.

In *Bridgeman Art Library, Ltd v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998), the court granted summary judgment to defendant Corel on the copyright infringement claim brought by the Bridgeman Art Library on the basis that the Bridgeman Art Library held no copyrightable interest in its microfiche copies of important works of art that Corel purportedly digitized. 25 F. Supp. 2d at 423. In granting summary judgment, the Court held that, under the copyright law of both the U.K and the U.S., plaintiff’s photographic images were “substantially exact reproductions of public domain works...albeit in a different medium,” and were not subject to copyright. *Id.* at 426.

Similarly in this case, the 50 black and white photographs in *Historic Hopi Ceramics* are just that: substantially exact reproductions of public domain works. As the very text of the book

provides, the book is merely a survey of historic Hopi ceramics from the Keam Collection that is intended to only be a reference book, not any statement in either an artistic or theoretical sense. *See* Material Facts Nos. 16-17. In fact, Harvard—by its own admission—does not own the copyright to the ceramics that are maintained in the public domain or to the designs featured on the ceramics. *See* Material Fact Nos. 15, 25. Thus, as Harvard concedes, it did not create the pottery depicted in *Historic Hopi Ceramics* and to photograph a mere piece of pottery to accurately portray the pottery as it existed at the time does not bring the photographs within the realm of copyright protection. Further, no photographs from *Historic Hopi Ceramics* were reproduced within *In Search of Nampeyo*.

In *ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 712-13 (6th Cir. 2005), the court held that illustrations in a transmission parts catalog were not copyrightable because they were merely “slavish copying.” In so holding the court pointed out that:

The illustrations were intended to be as accurate as possible in reproducing the parts shown in the photographs on which they were based, a form of slavish copying that is the antithesis of originality. *See J. Thomas Distributors v. Greenline Distributors*, 100 F.3d 956 (table), 1996 WL 636138 (6th Cir. 1996) (unpublished opinion) (“Plaintiff’s spindle bearing was drawn with the express intention of duplicating on paper the appearance of an actual spindle bearing. Its reproduction involved absolutely no creative spark whatsoever.”)...[thus] the illustrations...[are] unprotected by copyright because they represent nothing but a compilation of facts in a realistic manner.” *See Sparaco v. Lawler, Matusky & Skelly Eng’rs LLP*, 303 F.3d 460, 462 (2d Cir.2002) (holding that aspects of a site map that simply depict the site as it exists are unprotected by copyright).

Whatever It Takes, 402 F.3d at 712.

In this case, the undisputed evidence leaves no question that Harvard set out to copy the ceramics maintained in the Keam Collection, rather than to create or even add any original

expression. See Material Fact No. 16 (“This volume...is but a preliminary survey of historic Hopi ceramics from the Keam Collection.”) Harvard’s own representatives have admitted as such. See Material Fact No. 18 (*Historic Hopi Ceramics* is “meant to be a catalog of the Keam Collection.”). Indeed, the co-author of *Historic Hopi Ceramics*, Lea McChesney, refers to the photographs in the book as unflattering “mug shots.” See Material Fact No. 19. It is therefore clear that Harvard intended the photographs in *Historic Hopi Ceramics* to be as accurate as possible in demonstrating the various pieces of pottery as they existed in the real world and at the time the photographs were taken. Or, in other words, slavish copying which is the antithesis of originality. The law is clear: “one possesses no copyright interest in reproductions...when these reproductions do nothing more than accurately convey the underlying image.” Mary Campbell Wojcik, *The Antithesis of Originality: Bridgeman, Image Licensors, and the Public Domain*, 30 Hastings Comm. & Ent. L. J. 257, 267 (2008).

To the extent Harvard will claim its copyright claim as to the Kayenta jar photograph contained in *In Search of Nampeyo*, the same fails as a matter of law. See Supp. Ex. 1 at 182. Harvard has not offered any evidence that it holds a copyright to the photograph, and the mere fact that the photograph exists on Harvard’s website does not establish the photograph is copyrighted, and Harvard has offered no evidence that it holds the copyright to the photo. Thus, much like the 50 black and white photographs in *Historic Hopi Ceramics*, the photograph of the Kayenta jar is substantially an exact reproduction of a public domain work that is not subject to copyright protection.

Harvard’s claims to copyright of any images contained within the manuscripts submitted by Mr. Elmore to Harvard also fail based upon the unambiguous language of the Formal Notification letter, and the Letter of Agreement. See Material Facts Nos. 1-5, and 10-12.

As set forth further below, as a “work made for hire” under the Copyright Act, Harvard owned any and all rights in copyright to the manuscripts submitted by Mr. Elmore. However, Harvard also claims individual ownership to the copyrights for photographs within the manuscripts submitted by Mr. Elmore. The Letter of Agreement unambiguously provides, “the work as used herein shall include all revisions, editions and versions thereof in all languages, forms and media, now or hereafter known or developed, including electronic publication and dissemination.” See Material Fact No. 2. The Formal Notification unambiguously provides:

This letter will serve as a formal notification that the Peabody Museum of Archaeology and Ethnology hereby returns to you all rights in the manuscript ‘In Search of Nampeyo: The Apprenticeship of a Great Hopi Artist,’ including all versions of the manuscript submitted to the Peabody Museum Press.

See Material Fact No. 10 (emphasis added). The Formal Notification does not reserve any of Harvard’s rights to any part of the manuscripts whatsoever, and instead conveys “all rights in the manuscript...including all versions of the manuscript submitted to the Peabody Museum Press.” Harvard owned the complete copyright to the manuscripts, including the claimed copyright to all photographs within all versions of the manuscripts, and conveyed those copyrights to Mr. Elmore without reservation. Hence, their copyright claims fail as a matter of law.

At a minimum, promissory estoppel prohibits Harvard from asserting copyright claims against Mr. Elmore.

The theory of promissory estoppel provides:

A promise which the promisor should reasonably expect to induce action or forbearance on the part of the promisee or a third person and which does induce such action or forbearance is binding if injustice can be avoided only by enforcement of the promise. The remedy granted for breach may be limited as justice requires.

Restatement (Second) of Contracts § 90(1) (1981); *see also Eavenson v. Lewis Means, Inc.*, 105 N.M. 161, 162, 730 P.2d 464, 465 (1986) (citing the Restatement and discussing elements of promissory estoppels).

[T]he essential elements of promissory estoppel are: (1) An actual promise must have been made which in fact induced the promisee's action or forbearance; (2) The promisee's reliance on the promise must have been reasonable; (3) The promisee's action or forbearance must have amounted to a substantial change in position; (4) The promisee's action or forbearance must have been actually foreseen or reasonably foreseeable to the promisor when making the promise; and (5) enforcement of the promise is required to prevent injustice. *See* 1A Corbin, *supra*, § 200, at 84-96; 1 Perillo, *supra*, § 2.31; 4 Richard A. Lord, *Williston on Contracts* § 8:5 (1992); Restatement (Second) on Contracts § 90.

Strate Prod. Co. v. Mercury Exploration Co., 1996-NMSC-016, ¶ 17-20, 121 N.M. 622, 627-28.

All of the elements of promissory estoppel are present in this matter and, thus, Harvard is precluded from asserting its copyright claims. First, Harvard's Formal Notification letter conveyed an actual promise to Mr. Elmore when it gave Mr. Elmore "all rights" in the manuscripts, and recommended that he publish the work elsewhere. Second, Mr. Elmore, relying on the Formal Notification, published the book elsewhere, and publication was reasonable based upon Harvard's representations— or promises—within the Formal Notification that "all rights" in the manuscripts were being provided to Mr. Elmore and the specific recommendation that Mr. Elmore publish the manuscript elsewhere. *See* Material Fact No. 10. Third, Mr. Elmore's publication of the book elsewhere was a substantial change in position because Mr. Elmore and Harvard had been working on the manuscript for publication by Harvard for almost four years, with a great deal of work going into preparation of the manuscripts for publication by Harvard. Prior to the Formal Notification, Mr. Elmore expected the book to be published with Harvard as the author, and Mr. Elmore as the co-author of the book. *See* Material Fact No. 3. When the

Formal Notification was delivered to Mr. Elmore and when Mr. Elmore relied on the Formal Notification by publishing *In Search of Nampeyo*, however, the result was a substantial change in positions. Fourth, Mr. Elmore's publication of the book elsewhere was foreseeable to Harvard based upon all of the work put into the book by Mr. Elmore, as evidenced by the manuscripts submitted by Mr. Elmore to Harvard, and also based upon Harvard's statement within the Formal Notification letter that Mr. Elmore publish his work elsewhere. *See* Material Fact No. 10 ("The Board recommends that you find a magazine or trade publisher that specializes in Southwest Indian art to publish the work. American Indian Art Magazine is one such venue, and I would support publication there."). Fifth, allowing Harvard to argue that they hold a "copyright" to any part of the book is unjust because Mr. Elmore put a significant amount of work, time and money into development of the book on behalf of Harvard, and Mr. Elmore relied upon Harvard's Formal Notification letter to publish the book. However, Harvard, after having created the situation of which they now complain, seems to suffer no consequences whatsoever all to Mr. Elmore's detriment. Thus, enforcing the promise that Mr. Elmore was being provided with "all rights" to the manuscripts, which necessarily included all rights of copyright, when the Formal Notification letter was delivered to Mr. Elmore is required to prevent the injustice of Mr. Elmore being precluded from advancing the research and the substantial amount of work he put forth in developing and publishing *In Search of Nampeyo*.

For all these reasons, Harvard's copyright claim must fail as a matter of law and summary judgment must be entered.

B. Even If the Photographs are Protected by Copyright, the Colorized Illustrations in *In Search of Nampeyo* Are Not the Photographs to Which Harvard Claims A Copyright.

Even assuming the photographs in *Historic Hopi Ceramics* are copyrightable, the color illustrations Harvard claims are “unauthorized derivatives” are color illustrations of the ceramics created by Nampeyo that were created at Mr. Elmore’s direction by Mr. Diederichsen. They are not the “photographs” to which Harvard claims a copyright, and Harvard concedes that it cannot claim copyright protection for the imagery on the pottery itself. *See* Material Fact No. 25. Moreover, the illustrations created at the direction of Mr. Elmore are of ceramics which were created prior to 1900 for which no copyright exists, and are contained within the public domain.

In fact, the illustrations in Mr. Elmore’s book that were created by Mr. Diederichsen necessarily lack the lighting from the mug shots in *Historic Hopi Ceramics* because Mr. Diederichsen merely traced the design elements on the pottery, which were not created by Harvard, removed the gray scale and filled each line with one of three chosen colors. *See* Material Facts No. 22 and 23. In addition, none of the photographs in *Historic Hopi Ceramics* are reproduced in *In Search of Nampeyo*. *See* Material Fact No. 24. The undisputed facts thus show that Harvard’s copyright claim must fail as a matter of law. The Tenth Circuit Court of Appeals has stated that in a case similar to this there is no copyright violation.

As Professor Nimmer has commented in connection with the predecessor technology of photography, “[a]s applied to a photograph of a pre-existing product, that bedrock principle [of originality] means that the photographer manifestly cannot claim to have originated the matter depicted therein.... The upshot is that the photographer is entitled to copyright solely based on lighting, angle, perspective, and the other ingredients that traditionally apply to that art-form.” Nimmer on Copyright § 3.03[C][3]....

The primary case on which Meshwerks asks us to rely actually reinforces this conclusion. In *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000)(*Skyy I*), the Ninth Circuit was faced

with a suit brought by a plaintiff photographer who alleged that the defendant had infringed on his commercial photographs of a Skyy-brand vodka bottle. The court held that the vodka bottle, as a “utilitarian object,” a fact in the world, was not itself (at least usually) copyrightable. *Id.* at 1080 (citing 17 U.S.C. § 101). At the same time, the court recognized that plaintiff’s photos reflected decisions regarding “lighting, shading, angle, background, and so forth,” *id.* at 1078, and to the extent plaintiff’s photographs reflected such original contributions the court held they could be copyrighted. In so holding, the Ninth Circuit reversed a district court’s dismissal of the case and remanded the matter for further proceedings, and Meshwerks argues this analysis controls the outcome of its case.

But *Skyy I* tells only half the story. The case soon returned to the court of appeals, and the court held that the defendant’s photos, which differed in terms of angle, lighting, shadow, reflection, and background, did *not* infringe on the plaintiff’s copyrights. *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 765 (9th Cir. 2003) (*Skyy II*). Why? The only constant between the plaintiff’s photographs and the defendant’s photographs was the bottle itself, *id.* at 766, and an accurate portrayal of the unadorned bottle could not be copyrighted. Facts and ideas are the public’s domain and open to exploitation to ensure the progress of science and the useful arts. Only original expressions of those facts or ideas are copyrightable, leaving the plaintiff in the *Skyy* case with an admittedly “thin” copyright offering protection perhaps only from exact duplication by others. *Id.*; *see also SHL Imaging, Inc.*, 117 F. Supp. 2d at 311 (“Practically, the plaintiffs [photos] are only protected from verbatim copying.”).

The teaching of *Skyy I* and *II*, then, is that the vodka bottle, because it did not owe its origins to the photographers, had to be filtered out to determine what copyrightable expression remained. And, by analogy -- though not perhaps the one Meshwerks had in mind -- we hold that the unadorned images of Toyota’s vehicles cannot be copyrighted by Meshwerks and likewise must be filtered out. To the extent that Meshwerks’ digital wire-frame models depict only those unadorned vehicles, having stripped away all lighting, angle, perspective, and “other ingredients” associated with an original expression, we conclude that they have left no copyrightable matter.

Meshwerks, Inc. v. Toyota Motor Sales USA, 528 F.3d 1258, 1265-66 (10th Cir. 2008).

As this Court stated, “[a]lthough [Mr. Deiderchsen’s] process was not significant, it certainly was more than ‘verbatim copying.’” *See* Memo and Order [Doc. 75. at 16]. *See Meshwerks*, 528 F.3d at 1265-66 (“Only original expressions of those facts or ideas are copyrightable, leaving the plaintiff in the *Skyy* case with an admittedly “thin” copyright offering protection perhaps only from exact duplication by others.”); *see also SHL Imaging, Inc.*, 117 F. Supp. 2d at 311 (“Practically, the plaintiffs [photos] are only protected from verbatim copying.”). Thus, the colorized images in *In Search of Nampeyo*, which are illustrations of pottery in the public domain, are not derivatives of photographs allegedly copyrightable by Harvard, and Harvard’s copyright claim fails as a matter of law.

C. The Work Made For Hire Precludes Harvard From Asserting Copyright Infringement.

As stated above, Mr. Elmore and Harvard entered into the Letter of Agreement whereby the parties agreed to produce a book provisionally titled: “*In Search of Nampeyo: The Apprenticeship of a Great Hopi Artist*” on Nampeyo pottery in the Peabody Museum’s Keam collection. *See* Material Fact. No. 1. Pursuant to the Letter of Agreement, Mr. Elmore was producing a book for the Peabody Museum. *See* Material Fact. No. 4. The manuscript was considered a “Work Made for Hire,” included all revisions, editions and versions thereof in all languages, form and media, and Mr. Elmore granted, assigned, and transferred all rights in the manuscripts, including all rights of copyright to Harvard. *See* Material Fact Nos. 2-3. Thus, by virtue of the plain language of the Letter of Agreement and Harvard’s own admission, Mr. Elmore was producing a book for the Peabody Museum as a work made for hire.

On January 10, 2011, and when the Letter of Agreement was in effect, Mr. Elmore visited the Keam Collection. During his visit, he photographed various pieces of pottery

maintained by the Peabody Museum and was supervised by Susan Haskell, Collections Steward for the Peabody Museum. *See* Material Fact No. 6.

In May, 2012, Mr. Elmore submitted his first draft of the manuscript. In November, 2013, Mr. Elmore submitted a second draft of the manuscript. Both versions contained numerous photographs of the pottery Mr. Elmore took while visiting the Keam Collection on January 10, 2011, and a copy of the Kayenta jar Harvard claims a copyright to. *See* Material Fact No. 7; Supp. Ex. 5 at 6; Supp. Ex. 8 at 12. In fact, the manuscript submitted by Mr. Elmore in November, 2013 was titled, “*Nampeyo, The Early Years 1875 to 1892, A Photographic Art History of the Thomas Keam Collection of Hopi Pottery at the Harvard University’s Peabody Museum.*” *See* Material Fact No. 8.

In January, 2014, Mr. Elmore was hand-delivered the Formal Notification by Ms. O’Donnell. In that letter, Mr. Elmore was formally notified that all rights in the manuscript, and all versions of the manuscript were returned to him as his sole property. In particular, the Formal Notification provided:

This letter will serve as a formal notification that the Peabody Museum of Archaeology and Ethnology hereby returns to you all rights in the manuscript ‘In Search of Nampeyo: The Apprenticeship of a Great Hopi Artist,’ including all versions of the manuscript submitted to the Peabody Museum Press.

See Material Fact No. 10.

Ms. O’Donnell drafted the Formal Notification letter, and Mr. Elmore did not have any part in drafting the Formal Notification letter. *See* Material Fact No. 12. By her own admission, Ms. O’Donnell could have included any language of her choosing in the Formal Notification. *See* Material Fact No. 12.

Harvard claims it would not be possible for the copyright to the photographs Mr. Elmore took while at the Peabody Museum to be returned to him, because Harvard never held the right the copyright to the photos. *See* Testimony of Joan K. O'Donnell, TR 112:1-4, Dec. 7, 2015, **Exhibit C** (“Q. And how do you know that you only returned rights that he gave you? A. Well, because it’s not possible for me to return rights that were never granted to me, so....”). However, Harvard’s position is contrary to well settled and fundamental principles of copyright law.

In particular, the Copyright Act states that copyright ownership vests initially in the author of the works. 17 U.S.C. § 201(a). In the case of “works made for hire,” however, the employer is considered the author of the works, and therefore owns all the rights comprised in the copyright, “unless the parties have expressly agreed otherwise in a written instrument signed by them.” 17 U.S.C. § 201(b). “In short, the Copyright Act provides that an employer is considered the author and owner of “works made for hire” unless the parties otherwise agree in writing.” *Rogers v. Yonce*, No. 07-CV-704-GKF-PJC, 2008 U.S. Dist. LEXIS 55307, at *17-18 (N.D. Okla. July 21, 2008).

Under the Letter of Agreement, Mr. Elmore and Harvard expressly agreed that Harvard was to be considered the author of the book. Although Mr. Elmore now owns the copyright to all of the photographs he took at the Peabody Museum, those rights were initially vested in Harvard, the author of the book, when the Letter of Agreement was in effect. In addition, the parties agreed the relationship during the development of the book was to be characterized as a “work made for hire.” Thus, as a part of the “work made for hire,” *all rights* in and to the manuscripts, the photographs, and the copyright to each were all owned by Harvard at all times when the Letter of Agreement was in effect. *See Heimerdinger v. Collins*,

No. 2:07CV00844 DN (consent), 2009 U.S. Dist. LEXIS 51758, at *7-8 (D. Utah June 17, 2009) (Because the employer is the author, copyright vests initially in the employer.).

Because the rights to the manuscripts were initially vested in Harvard, the Formal Notification, which says all rights in the manuscript “*In Search of Nampeyo: The Apprenticeship of a Great Hopi Artist*,” including all versions of the manuscript submitted to the Peabody to Mr. Elmore were being provided to Mr. Elmore, provided Mr. Elmore with all rights in and to the manuscripts. Thus, under the Copyright Act, Mr. Elmore has the exclusive right to do and to authorize others to display, perform, reproduce or distribute copies of the work and to prepare derivative works. 17 U.S.C. § 106. This is even supported by Harvard’s own admissions that the book is a photographic art history “so there would be very little value” to Mr. Elmore’s manuscript if he was not provided the right to the photographs he took to support his argument in the manuscripts, one of which being titled: “*Nampeyo, The Early Years 1875 to 1892, A Photographic Art History of the Thomas Keam Collection of Hopi Pottery at the Harvard University’s Peabody Museum.*” See Material Fact No. 9.

Thus, based on the undisputed facts of this case and the relevant authority, Harvard is precluded from asserting any copyright claim because Harvard transferred all copyrights in the work to Mr. Elmore, and Mr. Elmore was provided the exclusive and unrestricted right to control the work pursuant to the Formal Notification delivered to him by Ms. O’Donnell. For these reasons, Harvard’s copyright claim is subject to summary judgment and must be dismissed accordingly.

This is to certify that on this 2nd day of February, 2016, the foregoing Motion for Partial Summary Judgment was filed electronically through the CM/ECF system, which caused the following to be served by electronic means, as more fully reflected on the Notice of Electronic Filing:

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