Lawyers Should Be Cautious When Copying Other Lawyers' Work

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Many attorneys will find Pham v. Jones, 2006 WL 1342826 (S.D.Tex. 2006) instructive. As recounted there, since 2001 Michael Pham has used arrest records to identify prospective clients. He has then mailed to such persons a form letter and brochure describing their rights and his legal services (as permitted by the First Amendment).

In 2005, however, Pham noticed a twenty-five percent decline in business. Investigation revealed that Raymond Jones, a new criminal lawyer was using slightly modified copies of his letter and brochure to the same end. Despite protest, Jones continued, so Pham filed applications to register his copyrights.

Having thereby satisfied the jurisdictional requirement in 17 U.S.C. § 411(a), Pham later sued for infringement. Jones, defending pro se, was eventually assessed over $54,000 for profits, attorney fees and costs. Jones was also permanently enjoined from using Pham's materials and warned that any violation would be punishable by contempt of court; 2006 WL 1342826 *7.

Earlier, Michael Whiteman addressed what might be seen as the other end of a potential liability spectrum in *Appellate Court Briefs on the Web: Electronic Dynamos or Legal Quagmire?* 97 Law Libr. J. 467 (2005). At 478, he notes that no court has addressed possible copyright liability for unauthorized copying of briefs, but, at 479, he also notes that even private publishers have long gone unchallenged for republishing them online.

As with Pham's solicitation package, it seems indisputable that lawyers (or their firms) would, upon creation of a brief, hold copyright and be permitted to sue following registration. Yet, for those and other documents, courts seem to have de facto licenses equivalent to those of newspapers that publish letters to the editor. Moreover,

most private copying would seem to be permissible on the same grounds or as a matter of fair use under 17 U.S.C. § 107 — at least when authors have been credited. Although some private copying of briefs might also be technically impermissible, protest, particularly in light of costs, seems unlikely to be worthwhile.

Judge Stanley F. Birch, Jr. furnishes a counter example in *Copyright Protection for Attorney Work Product: Practical and Ethical Considerations,* 10 J. Intell. Prop. L. 255, 256 (2003). As related there, one law firm lifted "hundreds of pages of land restrictions and covenants" from another. When the originating firm protested, however, compensation was forthcoming; *id.* at 262. Had it not been, as in *Pham,* registration and suit would likely have been warranted.

A similar situation is described by Janet L. Conley in *Milberg Weiss Tries to Nail Class Action Imitators,* Fulton County Daily Report, Nov. 20, 2002, online at, e.g., http://www.law.com/jsp/article.jsp?id=1036630458145 (visited Oct. 27, 2006). She interviewed me before that was written and reported, "Though [Field] didn't say the Milberg Weiss copyright theory won't pass the laugh test, he burst into laughter again and again during a 20-minute conversation on the subject."

I laughed mostly because the novel suit seemed to buck what I then regarded as a well-established convention among lawyers. Despite doubts about copyright, I nevertheless suggested possible recovery under a misappropriation theory discussed in National Basketball Association v. Motorola, 105 F.3d 841 (2nd Cir. 1997).

Having since had far more time to reflect, I've concluded that copyright, besides possibly preempting most misappropriation claims, is both viable and superior. Nor would I be dissuaded by evidence that lawyers commonly copy others' documents without protest or reprisal. Such practices, even if widespread, are no more relevant than claims offered by people who justify copying software, music and other digital content on the basis that "everybody does it."

Custom might be relevant were that the sole, or most likely, reason that suits

protesting one lawyer's copying another's work are rare at best. Other considerations surely predominate. First, copying must be discovered. Following discovery, lawyers who know nothing of copyright may assume that they have no rights. Further, well-informed lawyers will understand that 17 U.S.C. § 412(a) severely limits remedies for infringement of unpublished and previously unregistered documents — precluding both attorney fees and statutory damages up to $150,000.

Reconsider *Pham* in light of the last point. Had the court been aware of the preclusion in § 412(a), it seems improbable that $29,100 in attorney fees would have been awarded. Subtracting that sum from Pham's $54,000 recovery leaves an amount that is about $4000 less than the attorney's bill. Had Pham been required, in effect, to spend $4000 for an injunction, he might have sued anyway. Still, vindication would have been much less worthwhile.

Other lawyers who create original documents with continuing income potential should not hesitate to assert copyright. They should also protect themselves by providing notice and registering promptly.

Notice is unnecessary to have copyright or to sue. Under § 401(d), however, notice is helpful to rebut claims of innocent infringement — whether based on alleged professional custom or something else.

Although registration is also unnecessary to have rights, it is required under § 411(a) before suit can be filed, and the fee is only $45.00. Moreover, when registration is or may be warranted, it seems foolish to delay.

Indeed, when it makes economic sense to register, applications should be filed at the same time that documents to be protected are made public. Registration once granted is effective as of the date a complete application was filed; § 410(d). With § 412(a) satisfied, protests about others' copying will be highly credible, and, if necessary, suits will be worth filing.