**17.25A Copyright—Affirmative Defense—Express License**

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

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

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

**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.* (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) (quoting *Worldwide Church of God v. Phila. Church of God, Inc*., 227 F.3d 1110, 1114 (9th Cir. 2000)), *rev’d on other grounds*, 139 S. Ct. 873 (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. Office Depot, Inc.*, 945 F.3d 1106, 1110 (9th Cir. 2019) (citation omitted). 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 thedefendant’s alleged copyright infringement. In a case in which the defendant claims to haveacted under an express license, it is likely that the trial court will need to construe the terms ofthe license for the jury. *See, e.g.*, *id*. at 955, 958. Federal courts “rely on state law to provide thecanons 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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