

Kenneth L. Steinthal

Partner

*Trial and Global Disputes / Intellectual
Property, Patent, Trademark and
Copyright Litigation*

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Kenneth Steinthal specializes in litigating matters in the intellectual property/media sector. His practice is focused on copyright, DMCA and antitrust/rate-setting cases involving the distribution of audio and audiovisual content, and includes counseling companies regarding the licensing implications of their product offerings. Ken has been recognized for his leadership and expertise, including by *National Law Journal*, as one of its 2016 IP Trailblazers, and by *Law360*, as one of five 2015 Media & Entertainment MVPs.

Ken has more than three decades of experience litigating matters spanning the IP/media sector, in jury and bench trial settings and before copyright tribunals in the U.S. and internationally.

Ken's practice is focused on copyright, DMCA and antitrust/rate-setting cases involving the distribution of audio and audiovisual content. His cases typically involve the defense of copyright infringement claims and the establishment of structures and rates for the exploitation of musical works and sound recordings in both traditional (e.g., cable, satellite, broadcast) and new media distribution environments.

In just the last three years, Ken has led teams on behalf of Google, the Radio Music License Committee (representing the interests of the U.S. broadcast radio industry), NPR and Pandora before different courts and tribunals (including the U.S. Copyright Royalty Board) to establish rate structures governing his clients' exploitation of music licensed by music publishers and labels (and their representative organizations).

In a constantly evolving media distribution environment, Ken and his team also counsel clients regarding the licensing implications of existing or contemplated product offerings spanning both traditional and new media.

Ken has been recognized by several organizations for his leadership and expertise in the media and entertainment sector, including by the *National Law Journal* (as one of its 2016 IP Trailblazers); by *Law360* (as one of five 2015 Media & Entertainment MVPs); by *The Daily Journal* (named to its

lists of Top 10 Copyright Lawyers and Leading IP Attorneys in California); and, repeatedly, by *Chambers* and *Legal 500* in their annual listings.

Matters

Representative Copyright Litigations/Matters

In re Determination of Rates and Terms for Making and Distributing Phonorecords. Ken is lead counsel for **Google** in the Phonorecords III Copyright Royalty Board proceedings against the music publishing industry that will determine the statutory license rates and terms (for the five-year period 2018–2022) for "mechanical" reproduction licenses associated with the distribution of interactive/on-demand streaming services and cloud locker services under section 115 of the Copyright Act. The trial of this matter took place in March–April 2017.

SESAC v. Radio Music License Committee. Ken is lead counsel for the **RMLC**, the representative body of the broadcast radio industry, in this first-ever arbitration proceeding to determine reasonable industry-wide rates and terms (during the three-year term 2016–2018) for some 7,000 radio stations' broadcasts and simulcasts of the musical works controlled by performing rights organization SESAC. The arbitration began in February 2017 and will conclude in May 2017.

In re Determination of Rates and Terms for Performance or Display of Nondramatic Musical Works ... By Public Broadcasting Entities. Ken is lead counsel for **NPR and PBS** in this Copyright Royalty Board proceeding against the music publishing industry that will determine the statutory license rates and terms (for the five-year period 2018–2022) for public broadcaster uses of musical works.

ESPN v. BMI. Ken is lead counsel for **ESPN** in this litigation against performing rights organization Broadcast Music, Inc. under the BMI antitrust consent decree. ESPN directly licenses from writers and publishers the vast majority of the music it performs; and it seeks a determination of reasonable license fee from BMI for the music in commercials or ambient music overheard in stadiums and arenas during sports telecasts, which ESPN is not in a position to directly license. This case is the first to challenge BMI's off-the-shelf license structure and rates for audiovisual programming based on evidence of competitive direct licensing transactions. It also could address whether performances of ambient music captured in connection with live sports broadcasts is fair use.

DOJ Investigation of ASCAP and BMI Consent Decrees. Ken is counsel for **a number of clients (including iHeartMedia, Netflix, Google, Rhapsody and Viacom)** and assumed an industry-leading role in connection with the Department of Justice's investigation of the ASCAP and BMI antitrust consent decrees governing the licensing of public performance rights in musical compositions. This investigation stemmed from King & Spalding's successful litigation in the Southern District of New York and before the Second Circuit Court of Appeals on behalf of Pandora Media, Inc. from 2013 to 2015. The DOJ's Closing Statement issued on Aug. 4, 2016 included the Government's conclusion that, contrary to the requests of music publishers and performing rights organizations to relax or sunset the consent decrees, the decrees should remain in place as valuable competitive protections for licensees.

Soc'y for Testing & Materials et al. v. Public.Resource.Org, Inc. Ken is co-lead counsel for plaintiff **American Society of Heating, Refrigeration and Air-Conditioning Engineers (ASHRAE)** in this copyright infringement lawsuit filed in 2013 against Public.Resource.Org. The case presents key questions of copyright and public policy surrounding the issue of whether the incorporation by reference of copyrighted, privately developed industry standards into statutes and regulations

effectively nullifies the copyright owners' ability to enforce their copyrights. ASHRAE and its co-plaintiffs secured summary judgment in their favor from the federal district court in Washington, D.C.; and the case is pending appeal to the D.C. Circuit Court.

Pandora Media, Inc. v. ASCAP. Ken was lead counsel in this federal court trial and appeal on **Pandora's** behalf culminating in the Second Circuit's 2015 affirmance of rulings (i) upholding Pandora's challenge to the efforts of major ASCAP publisher members to "partially" withdraw from ASCAP in an effort to avoid rate oversight by the court overseeing the ASCAP antitrust consent decree, and (ii) establishing rates consistent with Pandora's position.

Pandora Media, Inc. v. ASCAP. Ken was lead counsel in this federal court trial and appeal on **Pandora's** behalf culminating in the Second Circuit's 2015 affirmance of rulings (i) upholding Pandora's challenge to the efforts of major ASCAP publisher members to "partially" withdraw from ASCAP in an effort to avoid rate oversight by the court overseeing the ASCAP antitrust consent decree, and (ii) establishing rates consistent with Pandora's position.

In re Determination of Royalty Rates and Terms For Ephemeral Recording and Webcasting Digital Performances of Sound Recordings (Web IV). Ken was lead counsel for **NPR** in connection with its participation in the "Web IV" statutory royalty proceedings before the Copyright Royalty Board to obtain a determination of royalty rates and terms for the public performance of sound recordings by entities eligible for the statutory license provided by sections 112 and 114 of the U.S. Copyright Act. After the filing of its direct case and discovery in the proceedings, NPR achieved a favorable settlement setting the rates and terms for Public Radio's streaming activities over the five-year term 2016–2020.

U.S. v. ASCAP, Application of MobiTV, Inc. Ken led the federal court trial before the judge supervising the ASCAP antitrust consent decree and ensuing successful Second Circuit appeal resulting in adoption of client **MobiTV's** proposal, establishing favorable rates and terms for mobile distribution of TV/radio content (and rejecting ASCAP's position that mobile/online content distribution entities should be subject to a far more onerous royalty structure than exists for entities distributing content via traditional media vehicles).

U.S. v. ASCAP, Application of RealNetworks Inc. and Yahoo!, Inc. Ken led the trial and argued the appeal leading to this **landmark Second Circuit decision** in September 2010 (and denial of *certiorari* by the U.S. Supreme Court in 2012) holding that transmissions of music downloads do not trigger public performance rights liabilities for entities engaged in content distribution (and rejecting the position of ASCAP and other copyright organizations to the contrary).

Arista Records, et al. v. Launch Media. Ken co-defended **Yahoo! Music** (f/k/a Launch Media) in a billion-dollar copyright infringement action brought by various record labels in the SDNY challenging the eligibility of Yahoo!'s Internet radio service for the statutory license under section 114 of the Copyright Act; Yahoo! secured a jury verdict in its favor (later affirmed by the Second Circuit).

"Napster II" (*UMG Recordings, et al. v. Bertelsmann AG, et al*). Ken led the defense of **Bertelsmann** against a series of music label and publisher copyright infringement claims brought in the SDNY and NDCA (asserting liability in excess of \$20 billion) based on alleged direct, contributory and vicarious liability of Bertelsmann arising from its investments in and relationship with the original Napster file-sharing service; rulings on motions led to favorable settlements shortly before trial.

EMI Music v. Multiply Inc. Ken represented this social network service in a lawsuit claiming copyright infringement of works in EMI's label and publisher catalogues asserting **Multiply** did not qualify for the DMCA safe harbor; representation enabled settlement shortly after lawsuit was filed.

Sony/ATV Songs LLC, et al. v. MusicNet, Inc. Ken led the defense of this **provider of on-demand streaming/conditional music downloads** against copyright infringement claims based on the alleged failure of the service to secure musical work reproduction rights licenses; representation enabled settlement not long after suit was filed.

Coleman, et al. v. ESPN. Ken led the defense of **ESPN** against claims of ASCAP members asserting copyright infringement based on ESPN's alleged unlicensed public performance of musical works audible in the background of ESPN's broadcasts of sports programming and challenging ESPN's assertion of the "fair use" defense to such uses; successfully defeated the publishers' summary judgment motion and secured a favorable settlement thereafter.

Angel Music, Inc. et al v. ABC Sports, et al. Ken led the defense of the local television industry in this putative dual plaintiff/defendant class action copyright infringement lawsuit claiming that the **ABC Television Network** had infringed the publishers' rights by failing to secure synchronization licenses for so-called "one time uses" of compositions that were used as background for Olympics sports "bio-pic" segments; successfully achieved dismissal of action.

Other "Rate Court" Proceedings against ASCAP and BMI. Ken is and/or has been lead trial counsel for numerous other **ASCAP/BMI licensees** engaged both in traditional and new media forms of content distribution; over the years, he has managed or co-managed the negotiations and, where necessary, trial teams in consent decree proceedings against ASCAP, BMI and SESAC on behalf of more than two dozen cable/satellite/broadcast television services (e.g., Showtime, ESPN, MTV Networks, Discovery, USA Networks, A&E Television Networks, Disney Channel, DirecTV, Lodgenet Entertainment/Sonifi, Univision, Fox, etc.) and numerous new media licensees (e.g., YouTube/Google, Netflix, etc.).

Antitrust litigation against ASCAP and BMI. Ken was deeply involved in the seminal antitrust cases brought by **the local television industry** in the early 1980s (*Buffalo Broadcasting Co., et al. v. ASCAP, et al.*) and the cable TV industry in the early 1990s (*NCTA, et al. v. BMI, et al.*), against both ASCAP and BMI, which set the framework for the consent decree litigations that have followed.

Other U.S. Statutory License Copyright Arbitration/Copyright Royalty Board Proceedings. Separate from the proceedings identified above, Ken has represented a number of **online content distributors (e.g., Amazon, Apple, Google, Microsoft and Rhapsody), "webcasters" and National Public Radio** in connection with the negotiation and/or litigation of rates and terms associated with the operation of services eligible for statutory licenses under 17 USC sections 112, 114 and 115 (in Copyright Arbitration Royalty Panel and then Copyright Royalty Board proceedings dating back to the early 2000s).

International Copyright Tribunal Matters. Ken has been granted "rights of audience" in the Copyright Tribunals of the UK and Hong Kong to litigate matters pertaining to the proper structure and rates for musical work public performances (and, in some cases, reproductions), on behalf of both **new media/online distributors of content and traditional cable/satellite television distributors**. For example, he was lead trial counsel in the precedent-setting UK Copyright Tribunal litigation on behalf of a consortium of music service providers (including AOL, Yahoo!, Apple, Napster LLC, RealNetworks and MusicNet) against the UK collective MCPS/PRS. Prior to that, he

represented a consortium of cable and satellite providers in proceedings before the Hong Kong Copyright Tribunal against the Composers and Authors Society of Hong Kong (CASH), which resulted in a favorable industry-wide settlement on the eve of trial.

Representative Other Media/Entertainment/Sports Litigation

iJaal.com, Inc., et al. v. baazee.com, Inc., et al. Ken was lead trial counsel in this SDNY jury trial defending **baazee.com** (the “eBay of India,” in which News Corp’s Star TV was the primary outside investor before acquisition by eBay after trial) and its principals against claims of breach of oral contract, misappropriation of partnership opportunity, misappropriation of trade secrets and related claims; won complete defense verdict.

Persky-Bright Organization, et al. v. Columbia Pictures Entertainment, Inc., et al. Ken was lead trial counsel in defense of two \$300 million actions brought in SDNY and CDCA, in which the plaintiff motion picture investment groups alleged a series of violations by **Columbia Pictures** of motion picture distribution agreements, together with RICO, fraud, antitrust/block booking and tax indemnity claims. The case spanned several years and included a mini-trial of non-jury issues that resulted in the substantial curtailment of issues to proceed before a jury, leading to a favorable settlement thereafter.

Robehr Films, Inc. v. American Airlines, Inc. Ken was lead trial counsel in this SDNY jury action brought by an in-flight film supplier alleging fraud and breach of contract by **American Airlines**. Plaintiff claimed American’s conduct had forced it out of business. A three-week jury trial resulted in a no-liability defendant’s verdict, which was affirmed on appeal to the Second Circuit.

European American Bank v. Film Finances, Inc., et al. Ken was lead counsel in defending this action brought by EAB under film loan agreements and a completion bond against clients **Film Finances and production/distribution entities**. After preliminary pre-trial proceedings and motion practice, the case was settled on a zero-liability basis.

North American Soccer League (NASL) v. National Football League. Ken assisted in representing the **NASL** in this antitrust trial in the SDNY in which the NASL successfully challenged the NFL’s “cross ownership” ban, which would have prevented “cross-owners” such as Lamar Hunt and Joe Robbie from maintaining their investments in the NASL.

New York Islanders Hockey Club LP v. SMG, et al. Ken was lead trial counsel for **the N.Y. Islanders** hockey team in federal and state court litigations against SMG and Nassau County seeking to terminate lease arrangements at the Nassau Coliseum on novel constructive eviction theories. After preliminary injunction trial proceedings and a series of appeals, the case settled on a favorable basis.

Representative Other Engagements

David Wilson et al. v. Airborne, Inc. Ken was lead counsel in representation of the **Airborne defendants** in this consumer class action (removed to Central District of CA under CAFA) alleging, *inter alia*, false advertising and violations of California consumer protection laws; led to a favorable class settlement.

In re CA Title Insurance Litigation. Ken was lead trial counsel for a **national title insurance company** in this putative class action alleging violations of CA UCL §17200; oversaw successful motion practice leading to dismissal and 2012 order compelling individual claim arbitration.

NNN Britannia Business Center, et al v. Grubb & Ellis Co., et al. Ken was lead trial counsel for

defendants in these CA state court actions alleging violations of CA UCL §17200, fraud, etc., associated with the syndication of certain commercial real estate investments; successful motion practice resulted in substantial curtailment of claims at issue.

Risko v. First Aviation Services, Inc., et al. Ken was lead trial counsel in this jury trial in Oakland, CA Superior Court alleging fraud and breach of contract against **First Aviation and its principals**. The case was brought by a former First Aviation principal alleging, among other things, entitlements under an oral agreement, and threatened the continued viability of the client group. A two-week jury trial resulted in a no-liability defendants' verdict.

PIA v. UBS Securities, Inc. Ken was lead trial counsel in defending lender liability, fraud and breach of contract claims brought in New York State Supreme Court by the owners of the Roosevelt Hotel in New York City against **UBS**, stemming from UBS' termination of an agreement to finance the renovation of the hotel. A three-week bench trial resulted in a no-liability defendant's verdict. Appellate proceedings in the New York Appellate Division and Court of Appeals affirmed the lower court rulings in defendant's favor.

Overnight Partners, et al. v. Ritz Carlton Hotel Co. Ken was lead counsel in defense of this \$300 million "kitchen sink" action brought in the SDNY by the owners of the Ritz Carlton hotel properties located in New York, Washington D.C., Houston and Aspen CO, against client **Ritz Carlton**. The case involved fraud, breach of contract, RICO, trademark and other claims brought by the Saudi group owners of those properties. After protracted pre-trial proceedings, the case settled on a favorable basis, whereby plaintiffs were stripped of their right to operate Ritz Carlton hotels.

In re Hylsa, S.A. v. M.W. Kellogg Co. Ken was lead trial counsel for **Grupo Industrial Alfa's steel company, Hylsa, SA**, in ICC arbitration involving hundreds of millions of dollars in claims and technology issues relating to construction of "HYL Process" steel plants for SIDOR in Venezuela. After a series of ICC hearings, case was settled on a zero-liability basis to Hylsa.

Credentials

EDUCATION

J.D., Fordham University, cum laude

B.A., Williams College, cum laude

ADMISSIONS

Supreme Court of the United States

U.S. Court of Appeals for the Second Circuit

U.S. Court of Appeals for the Ninth Circuit

U.S. Court of Appeals for the D.C. Circuit

U.S. District Court for the Eastern District of New York

U.S. District Court for the Southern District of New York

U.S. District Court for the Central District of California

U.S. District Court for the Northern District of California

California

New York

Recognition

IP Trailblazers

NATIONAL LAW JOURNAL, 2016

One of Five Media & Entertainment MVPs
LAW360, 2015

Top 10 Copyright Lawyers
THE DAILY JOURNAL

Leading IP Attorneys: California
THE DAILY JOURNAL

Leading Lawyer: IP/Media & Entertainment
CHAMBERS USA AND CHAMBERS GLOBAL

Legal 500 USA

Northern California Super Lawyer
SUPER LAWYERS

Law Dragon

Power Lawyers: Top 100 Outside Counsel
HOLLYWOOD REPORTER

Outstanding Antitrust Litigation Achievement in Private Law Practice: Finalist
AAI, 2014

Insights

CLIENT ALERT

May 4, 2020

COVID-19 Impacts on Businesses and Their Intellectual Property Rights

March 27, 2020

COVID-19 Impacts on Businesses and Their Intellectual Property Rights

Events

SPEAKING ENGAGEMENT

November 10, 2018

Kenneth Steinthal to Speak at North American Law Summit

News

IN THE NEWS

October 2, 2020 • Source: Law.com

Steven Rizzi, Ramy Hanna and Kenny Steinthal represent LSI in its patent dispute with Carnegie Mellon University

August 11, 2020 • Source: Bloomberg Law, Law.com and Law360

Ken Steinthal earns a win on behalf of Google before federal appeals court, which found in favor of Google and other streaming services that had challenged a Copyright Board decision

RECOGNITION

October 15, 2020

Benchmark Litigation Recognizes King & Spalding as a Leading Litigation Firm

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