

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

THE TRUSTEES OF COLUMBIA
UNIVERSITY IN THE CITY OF NEW
YORK,

Plaintiff,

vs.

ENCYCLOPAEDIA IRANICA
FOUNDATION,

Defendant.

Case No. 19-cv-07465

FIRST AMENDED COMPLAINT

DEMAND FOR JURY TRIAL

Plaintiff The Trustees of Columbia University in the City of New York (“Columbia” or the “Plaintiff”) by its attorneys, Reitler Kailas & Rosenblatt LLC, as and for its First Amended Complaint against Defendant Encyclopaedia Iranica Foundation (“EIF” or the “Defendant”) herein, alleges as follows:

PRELIMINARY STATEMENT

1. Plaintiff brings this declaratory action pursuant to 28 U.S.C. §§ 2201 and 2202 in order to prevent Defendant from (a) claiming to be the owner of copyright in a multi-volume scholarly encyclopedia (the “Work”) that Defendant did not create and for which it can show no written transfer of copyright ownership and for which Columbia owns the copyright; and (b) claiming to be the owner of exclusive trademark rights in the name of the Work and a logo that appears on the Work, which trademarks have been in continuous use by Columbia since long prior to Defendant’s claimed use; and (c) interfering with Plaintiff’s contractual relationships

with third parties regarding the distribution and other use of the Work. Plaintiff also seeks damages and an injunction for copyright infringement relating to EIF's publication of the Work on a website.

JURISDICTION AND VENUE

2. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§1331 and 1338. This Court has federal question jurisdiction in this matter in that the Plaintiff seeks a declaratory judgment against the defendant herein declaring Plaintiff's rights under, *inter alia*, the U. S. Copyright Act of 1976, 17 U.S.C. §§101 *et seq.* and damages for copyright infringement.

3. Venue lies within this judicial district pursuant to 28 U.S.C. §§ 1391(b)(1)(2)(3), 1391(c), and 1400(a) in that Defendant is a not-for-profit corporation organized and subsisting under the laws of the state of New York having a principal office in this judicial District, and a substantial part of the events or the omissions giving rise to Plaintiff's claims occurred in this judicial district.

PARTIES

4. Plaintiff is a not-for-profit tax exempt educational institution organized and subsisting under the laws of the State of New York.

5. Defendant Encyclopaedia Iranica Foundation is a not-for-profit corporation organized and subsisting under the laws of the state of New York having a principal office in this judicial district.

FACTUAL BACKGROUND

Professor Yarshater, the Center for Iranian Studies, and the Work

6. Historian Ehsan Yarshater (“Prof. Yarshater”) began to teach at Columbia in 1958, first as a Visiting Associate Professor from 1958-1960 and then as the Hagop Kevorkian Professor of Iranian Studies from 1960 until his retirement as a professor in 1999.

7. The Center for Iranian Studies at Columbia University, (the “Center”) was founded in 1949. The Center is not a separate legal entity but is a part of Columbia, which not only provides the facilities but also maintenance and utility costs free of charge and provides institutional support for the Center’s activities.

8. Prof. Yarshater became the Director of the Center in or about 1968. At that time, the Center was, as now, housed in a Columbia-owned building. The Center is currently housed at 450 Riverside Drive, near the Columbia campus. Prof. Yarshater remained as Director of the Center until 2016.

9. The Center has a library consisting of thousands of volumes of books, which are available for use by researchers and other academics.

10. In 1972, Prof. Yarshater began work on a Persian encyclopedia of Islam, a precursor to the Encyclopedia Iranica at issue here.

11. In 1979, Prof. Yarshater begin work on the Encyclopedia Iranica itself, an ongoing scholarly resource on Persian and Iranian history which has become the Center’s most prominent publication and is internationally regarded as the most comprehensive account of several millennia of Iranian history, language and culture in the Middle East, the Indian subcontinent and Central Asia.

12. The Work was first published in 1982.

13. In 1983 Prof. Yarshater established the Persian Heritage Foundation (“PHF”), originally called The Yarshater Fund, a U.S.-registered, non-political, non-governmental 501(c)(3) organization.

14. PHF supports and promotes research on all aspects of the Persianate world in the pre-Islamic as well as the Islamic period. Since its inception, PHF has provided funding for the Work and the Center, culminating in PHF’s endowment of the Center to rename it the Ehsan Yarshater Center of Iranian Studies in July of 2018.

15. Columbia has also received financial support for the Work, since the Work’s inception in the 1970s, from other significant sponsors, including the National Endowment for the Humanities (“NEH”), which supported it as a “major project” from 1979 to 2016.

16. Since at least 2007, the NEH applications listed the Work as a project of Columbia and named Columbia as both the applicant and the grant recipient. Prof. Yarshater was named as the project director and/or principal investigator, listing his title as “Director, Columbia University” or “Director, Center for Iranian Studies”.

17. On at least one occasion, in April 2013, Prof. Yarshater wrote to the NEH concerning the NEH grant to Columbia, confirming Columbia’s plan for the grant. There was no reference to Defendant in this letter. In fact, Prof. Yarshater signed the letter as

Kevorkian Professor Emeritus of Iranian Studies
Director, Center for Iranian Studies
Columbia University

18. The NEH grants provided part of the funding for the salaries of Columbia professors, scholars and administrators, work-study student reimbursements as well as supplies and other costs in connection with the Work.

19. Major support for the Work was also provided to Columbia from numerous donors including the International Union of Academies, the Iran Heritage Foundation (London), the Semnani Foundation, the Institute of Ismaili Studies (London), and the Les Amies de l'Encyclopedie Iranica (Paris), as well as individual benefactors.

20. Prof. Yarshater served as the Director of the Center and the Editor-in-Chief of all publications produced in the Center, including the Work, from about 1968 until 2016.

21. In connection with the publishing activities of the Center, Prof. Yarshater also established the Bibliotheca Persica Press, Inc. (“BPP”), which was incorporated in New York in 1998 as a not-for-profit entity, with initial funding from PHF. BPP was dissolved in 2003 and all its assets and interests were transferred to PHF.

22. The first fascicle of the Work was published in 1982 and was registered in the U.S. Copyright Office. A list of all copyright registrations for the Work is attached as Exhibit A hereto.

23. At all times, copyright in the Work has been owned by Columbia under Columbia’s official copyright policy (“Copyright Policy”).

24. The current version of the Copyright Policy, approved by the Trustees of the University and effective on June 3, 2000, provides at section I.B. as follows:

The University asserts copyright ownership in any work of authorship that is: (i) created with substantial use of University resources, financial support or non-faculty University personnel beyond the level of common resources provided to faculty; (ii) created or commissioned for use by the University; or (iii) created under the terms of a sponsored project where the terms of the sponsored project require that copyright be in the name of the University. Additionally, any work created by an officer of administration (including a faculty member or officer of research only when acting in his or her capacity as an officer of administration), or by a support staff member acting within the scope of his or her employment generally constitutes a “work made for hire” as defined by federal law [internal reference omitted], and the University asserts copyright ownership in such works.

25. The Work satisfies the above conditions. Notably, Prof. Yarshater was the Editor-in-Chief of the Work until 2016, and was the Director of the Center for the same period.

26. Columbia is the owner of the copyright in the Work under its Copyright Policy in effect prior to June 3, 2000.

27. Moreover, the copyright registrations from inception of the Work until 2003 named Columbia, BPP (whose rights were transferred to PHF) and/or PHF as the owner of the copyright in the Work. For example, the copyright registration #TX 5-022-282 for Volume VII, Fascicle 1 issued on July 12, 1999 states that that the copyright claimants are PHF and Columbia. The first publication date for that volume and fascicle was June 1994. Starting in 2003, EIF, without any right, without Columbia's knowledge and contrary to the Columbia Copyright Policy, began listing itself as the copyright owner on the copyright registrations for the Work.

28. The first volume of the Work published in 1982, like all subsequent volumes, bore the name ENCYLOPAEDIA IRANICA (the "Word Mark") and was marked with a distinctive visual design, a fleur-de-lis (the "Logo"). A copy of the cover page of a volume of the Work from the 1980's (years before EIF was formed) bearing both the Word Mark and the Logo is attached as Exhibit C.

29. As noted, all subsequent volumes of the Work bore the Word Mark and the Logo. These volumes were published periodically in the years after 1982 and publication has continued to the present.

30. Thus the Word Mark and the Logo have been in continuous use by Columbia since at least 1982.

The Encyclopaedia Iranica Foundation

31. In 1990, following the publication of Volume 4 of the Work, Prof. Yarshater established Defendant EIF to help ensure the continuation of the Work by providing financial support for the Work.

32. Upon information and belief, formed after a reasonable investigation, EIF was founded as a 501(c)(3) public charity to raise NEH matching funds for the creation of the Work at Columbia, and, separately from the grants received by Columbia, received one or more NEH challenge grants on that basis.

33. Prof. Yarshater was the President of EIF from its establishment until his death on September 2, 2018.

34. Beginning in 1993, after the publication of Volume 6 of the Work, Defendant EIF made periodic donations to the Center in support of the Work until 2017.

35. The mission of EIF, according to its Certificate of Incorporation of June 1990, is to “promote the cause of the Encyclopaedia Iranica and assure the continuation thereof”; “to establish an endowment fund for the Encyclopaedia Iranica”; and to “help others to publish, disseminate, and distribute the results of such research.”

36. Subsequent EIF documents, including the 2008 and 2009 Foundation reports to donors, confirmed that the Work is “a project of Columbia University’s Center for Iranian Studies” and that “the Center for Iranian Studies at Columbia carries out the academic functions of the Encyclopaedia, while the Foundation concentrates on raising funds for the project.”

37. These documents confirmed that the Foundation is “not involved in the academic and technical aspects of the project.”

38. A number of other documents created by Defendant confirm Columbia's ownership of the Work, including numerous Form 990 filings with the Internal Revenue Service, Defendant's 2008 Annual Report, a 2012 promotional brochure, and Defendant's 2017 financial statement.

39. Without Columbia's knowledge, and despite EIF's repeated public acknowledgements that it had no role in the "academic and technical" aspects of the Work, EIF began to list itself as the "claimant" on copyright registration filings for the Work starting with Volume 11 in 2003. EIF had no authority to list itself as the claimant.

40. As noted, all previous copyright registration filings for the Work had named Bibliotheca Persica Press, and/or Columbia and/or the Persian Heritage Foundation as the "claimants" of those registrations.

41. Columbia was not advised of this change Defendant made in the claimant designation on the copyright registration forms, and did not learn of it until early 2018.

42. In 2012, Professor Yarshater asked that Vahid Noshirvani, a Yale Professor Emeritus of Economics, be appointed to serve as the Associate Director of the Center effective February 23, 2012.

43. In 2014, while Professor Noshirvani was Associate Director, it came to Columbia's attention that Defendant was physically housed in the Center and was occupying portions of the Columbia owned building at 450 Riverside Drive.

44. In 2015, Defendant requested that Columbia transfer to Defendant all of Columbia's copyright ownership in the Work under clause II.D. of the University's Copyright Policy, thereby demonstrating Defendant's acknowledgment of Columbia's copyright ownership in the Work. The cited clause provides as follows:

If the University has determined that a work subject to University copyright ownership under this Policy has no likely commercial value, and subject to the terms of any applicable agreements with third parties under which the work was created, the University will consider a request by the creator to transfer copyright ownership in the work to the creator, subject to an irrevocable royalty-free license to the University to use the work for its own non-commercial purposes. Such a request must be approved by the Provost, and will be conditioned upon reimbursement of the University by the creator for out-of-pocket expenses the University has incurred in connection with the work, including legal and marketing expenses (if any). The University will act as expeditiously as reasonably possible in considering such requests by creators.

45. Columbia declined Defendant's request to transfer copyright ownership in the Work to Defendant.

46. Since its inception in 1979, more than a decade before Defendant was founded, and continuing until the present, the Work has at all times been a Columbia project, the copyright in which is owned by Columbia under the Copyright Policy. Throughout this period, Columbia has provided continuing financial, logistical, administrative and facilities support for the Work and the Center.

47. At no time did Prof. Yarshater have the authority to disregard the University's Copyright Policy or to transfer the University's copyright in the Work to EIF or to any other party, nor did Prof. Yarshater at any time advise Columbia that he had purported to make any such transfer.

48. The year following Defendant's request for Columbia to transfer copyright in the Work under Section II.D. of the Copyright Policy, Dr. Noshirvani resigned his position as Associate Director of the Center effective December 31, 2016.

49. Elton Daniel, a highly-regarded scholar of Middle Eastern and Islamic History, who had served during periods of academic leave as Associate Editor of the Work from 1997 to 2001, was appointed by Columbia on January 15, 2017, at Prof. Yarshater's request, to serve as the Interim Director of the Center and Editor-in-Chief of the Work.

50. Professor Yarshater's health prevented him from participating in the oversight of the Center at this time.

51. When Elton Daniel began his term as Interim Director in 2017, from January 1 until June 30, PHF was undergoing an internal reorganization and was temporarily unable to provide funding to the Center, which left Defendant as a principal source of funding for the Center during PHF's reorganization. Prior to this time, PHF and EIF, together with the NEH, had provided most of the non-Columbia funding for the Center.

52. The Center's increased reliance on Defendant for funding in 2017 gave rise to problems almost immediately. As documented in emails from Defendant to Dr. Daniel beginning in early 2017, Defendant insisted that none of the Center's funding could be used for any Center activity other than the Work. Defendant also interfered with the Center's other activities, such as by asking the Center to prevent certain scholars from chairing a panel at a University seminar, thinking the panel was funded by the Center rather than the University, and by demanding that the Center draw up a "business plan" for Defendant's Board of Directors to use.

53. Later in 2017, the successful reorganization of PHF and the Center's immediate need to cover expenses for another project, its History of Persian Literature, provided an opportunity for a new infusion of PHF funding to the Center, first through a gift donation and then through PHF's interest in funding an endowment, to honor Professor Yarshater and to institutionalize funding for the Work so that it could continue after his death.

54. Defendant repeatedly interfered with both. For example, in August 2017, Defendant demanded that any funding from PHF be donated to Defendant and not to the Center, which would have kept those funds from being used for PHF-related projects. Indeed,

Defendant asserted at this time that every contribution from PHF to the Center was instead a “donation” from PHF to Defendant, and insisted that Dr. Daniel provide an accounting to Defendant for all contributions to the Center from any source.

55. In December of 2017, at Defendant’s request, representatives of Columbia and Defendant met to discuss the funding relationship and to clarify related University policy.

56. At this meeting Columbia provided Defendant’s representatives with a standard gift agreement for Defendant’s continued financial support for the Center, which Defendant refused to sign. Instead, Defendant again requested that Columbia transfer its copyright in the Work to Defendant, again acknowledging Columbia’s copyright ownership in the Work.

57. Columbia again declined to make the requested transfer and explained the relevant Columbia policies that prohibited such a transfer.

58. Defendant ceased funding the Center, with its last contribution dated June 30, 2017.

Defendant’s Disruption of The Center’s Activities 2018-present

59. Since the funding relationship between Defendant and Columbia ended in 2017, Defendant has repeatedly disrupted the Center’s activities regarding the Work.

Defendant’s Assertion of Copyright Ownership

60. In early 2018, Defendant asserted to Columbia for the first time that it, and not Columbia, was the owner of copyright in the Work.

61. Columbia investigated the recent history of the Work and determined that Defendant had, beginning in 2015 and without informing Columbia, unilaterally changed the copyright assignment forms that individual scholars signed when submitting contributions to the Work.

62. The revised forms purported to assign the authors' contributions to Defendant rather than to Columbia or to the Editor of the Work, as had been the practice prior to 2015. Notably, the copyright assignment forms included in the headers the names "Columbia University" and "Center for Iranian Studies." Thus authors receiving the forms would still associate their assignments with Columbia and the Center.

63. Upon information and belief, formed after a reasonable investigation, the managing editor of the Work was responsible for sending the revised forms to authors of contributions, and that managing editor was also at the time an employee of the Center and *ex officio* member of the board of directors of Defendant EIF.

64. The assignment forms unilaterally revised by Defendant cover numerous contributions to the Work, a complete list of which is attached as Exhibit B ("Improperly Assigned Contributions").

65. Columbia has since confirmed with all but a few of the authors of the Improperly Assigned Contributions that these authors did not intend for copyright in their contributions to be assigned to Defendant, and all authors whom Columbia has been able to contact have executed corrected assignments, conveying the authors' copyrights in such contributions to Columbia.

66. Defendant's outside counsel have repeatedly threatened Columbia with legal consequences for distributing the Work without Defendant's consent and Defendant has, since the filing of the initial Complaint herein, sued Columbia and its publisher for trademark infringement.

USPTO Actions

67. In an opposition proceeding in the U.S. Patent and Trademark Office, Opposition No. 91245273, Defendant has contested PHF's application for trademark registration of the

Logo, which has been in continuous use by Columbia, the Center and PHF in connection with the Work and its precursor since approximately 1975, *i.e.*, for more than fifteen years before Defendant existed.

68. For example, the Logo was used in the Center's letterhead prior to publication of the Work. Moreover, the Logo appeared on every volume of the Work since 1982.

69. The common-law trademark rights in the Logo, if any, are owned by the party or parties whose goodwill was first, and is still, associated with such Logo in connection with the goods at issue, namely Columbia and/or PHF.

70. Defendant is not such party, having only adopted the Logo, if at all, many years after the Logo's initial and continuing use by Columbia and/or PHF in connection with the Work.

71. This USPTO proceeding is still pending, and, upon information and belief, has been stayed by the USPTO pending resolution of the dispute before this Court.

72. Separately, Defendant registered the Word Mark with the USPTO in 2018, which recently issued the registration for the Word Mark. Columbia, which has been using the Word Mark since 1982, has filed a petition to cancel the issuance of the trademark with the USPTO, tracking number ESTTA1012580. That proceeding is pending.

Electric Pulp and Brill

73. Prior to June 2018, Columbia and the Center had exclusive access to the website connected to the Work, iranicaonline.org (the "Website").

74. In June 2018, an employee working for both the Center and the Defendant erroneously turned over administrative control of the Website to the Defendant.

75. At Columbia's request, the web management company that hosts the Website, Electric Pulp, Inc. ("Electric Pulp"), restored Website access to Columbia on February 4, 2019, but concluded that it could not determine who owns the Website.

76. Electric Pulp advised Columbia at that time that Electric Pulp would require joint approval from both Columbia and Defendant before Electric Pulp would take any action, including making any changes, with respect to the Website.

77. On or about July 19, 2019, the Website went offline for a brief period, without any explanation from Electric Pulp and without any instructions or approval to Electric Pulp from Columbia.

78. Until August 8, 2019 Electric Pulp continued to allow both Columbia and Defendant to have administrative access to the Website.

79. On or about August 8, 2019, Electric Pulp completely blocked Columbia's administrative access to the Website, prompting an investigation into the matter by Columbia.

80. On August 12 and 13, 2019, Columbia exchanged emails with counsel for Electric Pulp demanding to know why Columbia's administrative access to the Website had been blocked.

81. Electric Pulp responded that Defendant had "proved" to Electric Pulp that Defendant owned the domain, so Columbia could no longer have access.

82. By email dated August 13, 2019, Columbia asked counsel for Electric Pulp what sort of "proof" Defendant had provided, to which Electric Pulp's counsel replied later that day by email, saying "I'm not in a position to discuss that."

83. On or about August 20, 2019, pursuant to the "take-down" provisions of 17 U.S.C. § 512(c), Columbia sent Notices of Claimed Infringement to the online addresses given

for the Website for such purposes through WHOIS searches, as well as to a different hosting service (“Liquid Web”) that was listed for the IP address of the Website.

84. Upon information and belief, neither Defendant nor Liquid Web responded in any way to the Notices of Claimed Infringement.

85. Columbia investigated the Website and determined that a substantial portion of the Contents of the Work had been made available on the Website by Defendant without Columbia’s consent.

86. On October 29, 2019, Vaudra International (“Vaudra”), as agent for Columbia, accessed the Website and downloaded digital copies of over 326 articles from the Work that were covered by copyright registrations in the name of Columbia and PHF and/or BPP. As an example, one of the articles that Vaudra downloaded, titled “Darband”, had been published in Volume VII, Fascicle 1 of the Work, whose copyright registration (TX-5-022-282) names PHF and Columbia as the copyright owners.

87. Columbia’s lack of access to data from the Website interferes with Columbia’s continuing ability to publish the Work through Brill Publishers (“Brill”), a Dutch international academic publisher specializing in Middle East and Islamic studies, through which Columbia has chosen to continue publication of the Work.

88. Defendant’s interference with the relationship between Electric Pulp and Columbia and Defendant’s control of the Website have rendered it almost impossible for Columbia to correct already published contributions, and interferes with the ability of editors of the Work to make edits to current online contributions to the Work.

89. As a result of Defendant’s above-described actions, the editors of the Work have been unable to post new contributions to the Website since June 2018.

90. Consequently, authors of these contributions have complained to the Center and questioned why their articles have not been published, despite the fact that their articles went through the formal editing and production process of the Center, including the meeting of deadlines by both authors and editors, and the payment of honoraria.

91. Defendant's actions have also caused confusion in the marketplace as to the ownership of the Work because the Work is being distributed online and only Defendant is able to make changes. This confusion will worsen when Columbia publishes new contributions to the Work online with Brill (delayed by Defendant's actions outlined herein), as there will be two separate websites containing different portions of the Work.

92. Currently, Columbia has in place two contracts with Brill, one to publish in print Fascicle 4 of Volume 16 of the Work, which was issued in October 2018, and another to publish in print Fascicle 5 of Volume 16, which was published recently. Columbia is preparing to enter into a contract with Brill for publication of the entire Work, both in print and on-line.

93. Knowing of Columbia's contracts with Brill, Defendant wrote Brill on February 23, 2018 claiming that "discussions and negotiations with regards to the publishing rights for the Encyclopaedia Iranica need to be conducted with EIF representatives" rather than with Columbia.

94. Defendant sent a subsequent letter to Brill dated April 1, 2019 alleging as follows about Volume 16, Fascicle 4, which was published in October 2018:

"EIF has not authorized or consented to the use of its mark ENCYCLOPAEDIA IRANICA on this unauthorized Encyclopaedia Iranica fascicle published and distributed by Brill. Furthermore, the publication and sale of this unauthorized Encyclopaedia Iranica fascicle is likely to result in consumer confusion as to its source or origin and falsely suggests EIF's affiliation or endorsement with such publication. EIF therefore demands that Brill immediately cease from advertising, publishing, and/or distributing copies of the unauthorized Encyclopaedia Iranica fascicle, both online and in print, and that Brill provide immediate written notice to EIF's undersigned counsel confirming that Brill:

(1) has removed all references to the unauthorized Encyclopaedia Iranica fascicle from the Brill website and any other websites controlled, operated, or sponsored by Brill or any other third party it may be working with;

(2) has ceased publishing, distributing, and/or selling copies of this unauthorized Encyclopaedia Iranica fascicle and any other fascicle(s) using EIF's ENCYCLOPAEDIA IRANICA mark;

(3) has provided to EIF's undersigned counsel an accounting of the number of any fascicles that it has sold using EIF's ENCYCLOPAEDIA IRANICA mark and certification that it has destroyed any such fascicles remaining in Brill's possession or control; and

(4) has not and will not publish any further fascicles (or volumes) of the Encyclopaedia Iranica on behalf of Columbia University or any other third party without EIF's prior written consent."

95. On September 13, 2019, after the commencement of this action, Defendant sued Columbia, Brill and Elton Daniel alleging, among other allegations, unfair competition and trademark infringement.

Interference With Clarivate

96. On October 16, 2018, Columbia entered into a contract with Clarivate Analytics ("Clarivate"), the company that hosts the ScholarOne software that the Center uses to manage publication of the Work, engaging Clarivate to provide such hosting services (the "Clarivate Contract"). Defendant was not a party to the Clarivate Contract.

97. On April 5, 2019, the Center learned that (1) Defendant falsely informed personnel of Clarivate that Defendant owns the Work and (2) Defendant asked Clarivate to turn over copies of all of the Work's manuscripts and data housed in the Center's Clarivate platform.

98. Defendant is not in privity with Clarivate with respect to the Work, but Clarivate nonetheless turned over all Work-related contents of the Center's ScholarOne platform to Defendants as Defendants demanded on or about April 4, 2019.

99. The Center's managing editor noticed Columbia files were moved from the Clarivate computer system on the morning of April 5, 2019 and immediately filed a case inquiry to Clarivate.

100. The Center also called ScholarOne customer service to be connected to the person listed in ScholarOne's logs as the individual who exported the files to Defendant.

101. When that person returned the Center's call later that day, the Center asked that ScholarOne immediately stop sending data to Defendant, and informed that person that the contract for ScholarOne was signed by Columbia, not Defendant, and that Columbia owns copyright in the Work.

102. Upon information and belief, formed after a reasonable investigation, the file transfer from Clarivate to Defendant cannot be undone.

FIRST CLAIM

103. Plaintiff repeats and re-alleges each and every allegation in paragraphs 1 through 102 above as if fully set forth herein.

104. By reason of the foregoing, an actual and justiciable controversy of sufficient immediacy and reality has arisen and now exists between Plaintiff and Defendant, under federal copyright law, 17 U.S.C. §§101 *et seq.* concerning their respective rights and interests in the Work.

105. Plaintiff contends that Defendant is not a copyright owner of the Work or any part thereof. Plaintiff is the copyright owner in the Work.

106. Defendant contends that it is the owner of copyright in the Work.

107. Declaratory relief from this Court is necessary pursuant to the Declaratory Judgment Act, 28 U.S.C. §§2201 *et seq.*, so that the parties may know their respective rights and obligations with respect to the Work.

108. By reason of the foregoing, Plaintiff is entitled to a declaratory judgment and related relief, declaring that Defendant is not an owner of copyright in the Work and that Columbia is the copyright owner.

109. Plaintiff has no adequate remedy at law.

SECOND CLAIM

110. Plaintiff repeats and re-alleges each and every allegation in paragraphs 1 through 102 above as if fully set forth herein.

111. By reason of the foregoing, an actual and justiciable controversy of sufficient immediacy and reality has arisen and now exists between Plaintiff and Defendant under federal trademark law, 15 U.S.C. §1051 *et seq.* concerning their respective rights and interests in the Word Mark and Logo (collectively, the “Marks”).

112. Plaintiff contends that Defendant is not an owner of exclusive trademark rights in the Marks.

113. Defendant contends that it is the owner of exclusive trademark rights in the Marks, and on that basis has demanded that Columbia cease and desist from making use of the Marks.

114. The Marks have been in continuous use by Columbia, BPP and PHF since at least 1982.

115. Declaratory relief from this Court is necessary pursuant to the Declaratory Judgment Act, 28 U.S.C. §§2201 et seq., so that the parties may know their respective rights and obligations with respect to the Marks.

116. By reason of the foregoing, Plaintiff is entitled to a declaratory judgment and related relief, declaring that Defendant is not an owner of exclusive trademark rights in the Marks.

117. Plaintiff has no adequate remedy at law.

THIRD CLAIM

118. Plaintiff repeats and re-alleges each and every allegation in paragraphs 1 through 102 above as if fully set forth herein.

119. At all relevant times, a valid agreement subsisted between Columbia and Clarivate regarding the storage of the Work on Clarivate's Scholar One platform.

120. At all relevant times, Defendant had knowledge of the Clarivate Contract.

121. Defendant's interference with the above-referenced contract as set forth above caused Clarivate to breach the Clarivate Contract by transferring Columbia data to Defendant without Columbia's consent.

122. The above-described acts of Defendant were intentional.

123. Columbia has suffered irreparable harm as result of Clarivate's breach of the Clarivate Contract.

124. Columbia seeks an order requiring Defendant to permanently delete or otherwise destroy the Columbia data that was sent to Defendant by Clarivate, including but not limited to all Work-related contents of the Center's ScholarOne platform, certify such

destruction or permanent deletion, and no longer seek to obtain such data or contents from any source.

125. Columbia has no adequate remedy at law.

FOURTH CLAIM

126. Columbia repeats and re-alleges each and every allegation in paragraphs 1 through 125 above as if fully set forth herein.

127. As noted, on or about August 8, 2019, Electric Pulp completely blocked Columbia's administrative access to the Website.

128. The Work, or substantial portions of it, remains accessible to the public through public display on, and public distribution through, the Website, without the consent of Columbia.

129. Defendant has publicly displayed, and publicly distributed, all or a substantial portion of the Work by means of the Website, without the consent of Columbia.

130. The above-described acts of Defendant were willful, and constitute infringement of Columbia's exclusive rights in the Work under the U.S. Copyright Act, 17 U.S.C. §101 *et seq.*

131. Columbia seeks damages for copyright infringement, attorneys' fees and an injunction that Defendants have the administrative access to the Website transferred back to Columbia.

JURY DEMAND

Pursuant to Fed. R. Civ. P. Rule 38(b), Plaintiff demands a trial by jury on all issues properly triable.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that this Court enter judgment as follows:

- A. On the First Claim, declaring that Defendant is not an owner of copyright in the Work, and entering an Order directing Defendant to transfer to Columbia the following copyright registrations, which improperly list Defendant as claimant:
- TX0006247285, TX0006843795, TX0006843797, TX0006843798,
TX0006902459, TX0006902490, TX0006978790, TX0007040264,
TX0007040276, TX0007258027, TX0007338068, TX0007399199,
TX0005730181, TX0005402206, TX0005482116, TX0005873032,
TX0005873033, TX0006020061, TX0005926144, TX0008723423,
TX0008723438, TX0008723442.
- B. On the Second Claim, declaring that Defendant is not an owner of exclusive trademark rights in the Marks;
- C. On the Third Claim, that the Court enter an Order directing Defendant to permanently delete or otherwise destroy the Columbia data that it received from Clarivate as a result of inducing Clarivate to breach the Clarivate Contract with Columbia, including but not limited to all Work-related contents of the Center's ScholarOne platform, certify such destruction or permanent deletion, and no longer seek to obtain such data or contents from any source;
- D. On the Fourth Claim, that the Court enter an Order preliminarily and permanently enjoining Defendant from violating Columbia's exclusive rights in the Work, including without limitation by public display or distribution of the Work or the preparation of derivative works thereof and requiring Defendant to transfer the

administrative access to the Website to Columbia, and awarding Columbia such statutory or actual damages as the Court may determine;

- E. Awarding Plaintiff its costs and disbursements, including reasonable attorneys' fees, incurred in prosecuting this action; and
- F. Awarding Plaintiff such other and further equitable and legal relief as this Court may deem necessary, just and proper.

DATED: October 31, 2019

Respectfully Submitted,

REITLER KAILAS & ROSENBLATT, LLC

/s/ Robert W. Clarida
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