

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CIVIL MINUTES – GENERAL

Case No. **2:22-cv-00663-MCS-SK**

Date July 25, 2022

Title ***Eichelberger v. Hudson-McKinney***Present: The Honorable Mark C. Scarsi, United States District JudgeStephen Montes Kerr

Deputy Clerk

Not Reported

Court Reporter

Attorney(s) Present for Plaintiff(s):

None Present

Attorney(s) Present for Defendant(s):

None Present

Proceedings: (IN CHAMBERS) ORDER RE: MOTION TO DISMISS (ECF No. 20)

Defendant Dr. Mary Hudson-McKinney moves to dismiss the claims in Plaintiff Dr. Tamara Eichelberger’s Complaint. (Mot., ECF No. 21.) Dr. Eichelberger opposes the motion, and Dr. Hudson-McKinney filed a reply. (Opp’n, ECF No. 24; Reply, ECF No. 25.) Defendant Western University of Health Sciences (“Western”), having answered the Complaint, did not participate in the motion briefing. The Court deems the motion appropriate for decision without oral argument. Fed. R. Civ. P. 78(b); C.D. Cal. R. 7-15.

I. BACKGROUND

Dr. Eichelberger and Dr. Hudson-McKinney are university professors who taught similar classes in neurology. (Compl. ¶ 13, ECF No. 1.) Eichelberger took the text of *Neuroanatomy through Clinical Cases* by Hal Blumenfeld and created an arrangement of video slides, outlines, and graphics (“the Work”). (*Id.* ¶¶ 10–11.) The Work is registered with the United States Copyright Office. (*Id.* ¶ 11 & Ex. A.) Dr. Hudson-McKinney contacted Dr. Eichelberger in 2017 to inquire about teaching a class on clinical neuroscience at Western. (*Id.* ¶ 13.) In 2017 and 2018, Dr. Hudson-McKinney displayed the materials in the Work to her class and put her name on the

Work without Dr. Eichelberger’s permission. (*Id.* ¶ 14.) In 2019, a student commented to Dr. Eichelberger that he was able to study for her class because he had class notes from Dr. Hudson-McKinney’s fall 2018 class at Western, leading Dr. Eichelberger to discover that Dr. Hudson-McKinney used her materials without permission. (*Id.* ¶ 16.)

Dr. Eichelberger asserts two claims: (1) copyright infringement under 17 U.S.C. § 501, and (2) reverse passing off under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). (*Id.* ¶¶ 18–29.) Dr. Eichelberger seeks an injunction and damages. (*Id.*, Prayer for Relief.)

II. LEGAL STANDARDS

A. Rule 12(b)(6)

Federal Rule of Civil Procedure 12(b)(6) allows an attack on the pleadings for “failure to state a claim upon which relief can be granted.” “To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Iqbal*, 556 U.S. at 678.

The determination of whether a complaint satisfies the plausibility standard is a “context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Id.* at 679. Generally, a court must accept the factual allegations in the pleadings as true and view them in the light most favorable to the plaintiff. *Park v. Thompson*, 851 F.3d 910, 918 (9th Cir. 2017); *Lee v. City of Los Angeles*, 250 F.3d 668, 679 (9th Cir. 2001). But a court is “not bound to accept as true a legal conclusion couched as a factual allegation.” *Iqbal*, 556 U.S. at 678 (quoting *Twombly*, 550 U.S. at 555).

B. Rule 12(b)(1)

Federal Rule of Civil Procedure 12(b)(1) authorizes a party to seek dismissal of an action for lack of subject-matter jurisdiction. “Because standing and ripeness pertain to federal courts’ subject matter jurisdiction, they are properly raised in a Rule 12(b)(1) motion to dismiss.” *Chandler v. State Farm Mut. Auto. Ins. Co.*, 598

F.3d 1115, 1122 (9th Cir. 2010). In the context of a Rule 12(b)(1) motion, the plaintiff bears the burden of establishing Article III standing to assert the claims. *Id.*

Rule 12(b)(1) jurisdictional challenges can be either facial or factual. *Safe Air for Everyone v. Meyer*, 373 F.3d 1035, 1039 (9th Cir. 2004). When a motion to dismiss attacks subject-matter jurisdiction on the face of the complaint, the court assumes the factual allegations in the complaint are true and draws all reasonable inferences in the plaintiff’s favor. *Doe v. Holy See*, 557 F.3d 1066, 1073 (9th Cir. 2009). Moreover, the standards set forth in *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007), and *Ashcroft v. Iqbal*, 556 U.S. 662 (2009), apply with equal force to Article III standing when it is being challenged on the face of the complaint. *See Terenkian v. Republic of Iraq*, 694 F.3d 1122, 1131 (9th Cir. 2012) (applying *Iqbal*). Thus, in terms of Article III standing, the complaint must allege “sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Iqbal*, 556 U.S. at 678 (quoting *Twombly*, 550 U.S. at 570).

III. DISCUSSION

A. Copyright Infringement

1. Timeliness

Dr. Hudson-McKinney contends the copyright infringement claim is barred by the three-year statute of limitations. (Mot. 4–9.) Dr. Eichelberger responds that she first discovered the infringement in 2019,¹ so under the discovery rule, her claim did not accrue until then. (Opp’n 4–6.) As recently confirmed by the Ninth Circuit, “the three-year limitations period begins only when the copyright holder knows or should know of the infringing act.” *Starz Ent., LLC v. MGM Domestic TV Distrib., LLC*, ___ F.4th ___, 2022 U.S. App. LEXIS 19422, at *25 (9th Cir. July 14, 2022).

The discovery rule analysis is a factual one generally not suitable for resolution on a motion to dismiss. *See Polar Bear Prods v. Timex Corp.*, 384 F.3d 700, 707 (9th Cir. 2004); *Michael Grecco Prods., Inc. v. BDG Media, Inc.*, 834 F.

¹ In her brief, Dr. Eichelberger submits that she learned of the infringement in July 2019. (Opp’n 4.) The month of her discovery is not pleaded in her Complaint, and the Court cannot rest its decision on this unpleaded fact. *See Schneider v. Cal. Dep’t of Corr.*, 151 F.3d 1194, 1197 n.1 (9th Cir. 1998). Notwithstanding, the Court declines to dismiss the claim as untimely for the reasons discussed below.

App’x 353, 354 (9th Cir. 2021). Here, Dr. Eichelberger alleges that she first learned of the infringement in 2019. (Compl. ¶ 16.) Under the discovery rule, the claim may have accrued within three years of the commencement of this action in January 2022. Given that the Complaint does not contain any other facts to suggest that Dr. Eichelberger knew or should have known about the infringement before 2019, the claim may not be dismissed at this juncture. *See Syed v. M-I, LLC*, 853 F.3d 492, 507 (9th Cir. 2017) (“[A] complaint cannot be dismissed [for untimeliness] unless it appears beyond doubt that the plaintiff can prove no set of facts that would establish the timeliness of the claim.” (alterations in original) (quoting *Supermail Cargo, Inc. v. United States*, 68 F.3d 1204, 1207 (9th Cir. 1995))).

2. Remedies

Dr. Hudson-McKinney argues that the copyright claim fails on the basis that Dr. Eichelberger does not allege a plausible basis for damages because she does not allege that Dr. Hudson-McKinney used the Work commercially. (Mot. 9.) Dr. Eichelberger is not required to plead damages resulting from copyright infringement to state a claim. *See Unicolors, Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 984 (9th Cir. 2017) (articulating elements of copyright claim); *Blizzard Ent., Inc. v. Joyfun Inc. Co.*, No. SACV 19-1582 JVS (DFMx), 2020 U.S. Dist. LEXIS 74722, at *21–22 (C.D. Cal. Feb. 7, 2020) (denying motion to dismiss copyright infringement claim when plaintiff pleaded infringement but did not plead “specific damages”); *Idema v. Dreamworks, Inc.*, 162 F. Supp. 2d 1129, 1142 (C.D. Cal. 2001) (“A Rule 12(b)(6) motion will not be granted merely because a plaintiff requests a remedy to which he or she is not entitled.” (cleaned up)). The Court rejects this argument.

Dr. Hudson-McKinney also contends that Dr. Eichelberger fails to show any factual allegations of continued infringement, imminent threats of infringement, or irreparable harm to support a claim for injunctive relief because she “can only speculate whether the Work was used after 2018.” (Mot. 10.) Although Dr. Hudson-McKinney brings her motion under Rule 12(b)(6), she raises a standing issue requiring application of the Rule 12(b)(1) standard.²

“A plaintiff must demonstrate constitutional standing separately for each form of relief requested.” *Davidson v. Kimberly-Clark Corp.*, 889 F.3d 956, 967 (9th Cir. 2018) (citing *Friends of the Earth, Inc. v. Laidlaw Env’tl. Servs. (TOC) Inc.*, 528 U.S.

² Alternatively, the Court on its own motion raises this jurisdictional issue. *See Gonzalez v. Thaler*, 565 U.S. 134, 141 (2012).

167, 185 (2000)). For injunctive relief, the threatened injury must be certainly impending to constitute injury in fact, and allegations of possible future injury are not sufficient. *Clapper v. Amnesty Int’l USA*, 568 U.S. 398, 409 (2013). Here, Dr. Eichelberger offers no factual allegations that Defendants used the Work after fall 2018. (See Compl. ¶¶ 16–17.) Dr. Eichelberger lacks standing to pursue injunctive relief because she fails to allege Defendants will or are likely to use the Work in the future. Because Dr. Eichelberger only alleges the mere possibility of future infringement, she fails to allege facts sufficient to establish standing to pursue injunctive relief. The Court therefore dismisses Dr. Eichelberger’s claim insofar as she seeks injunctive relief.

3. Valid Copyright

“To prove copyright infringement, a plaintiff must demonstrate (1) ownership of the allegedly infringed work and (2) copying of the protected elements of the work by the defendant.” *Unicolors*, 853 F.3d at 984 (9th Cir. 2017) (quoting *Pasillas v. McDonald’s Corp.*, 927 F.2d 440, 442 (9th Cir. 1991)).

Dr. Hudson-McKinney contends that Dr. Eichelberger has no valid copyright ownership of the Work and that Dr. Eichelberger’s certificate of registration does not entitle her to a presumption of copyright validity because she does not allege the Work was published. (Mot. 10–12.) “A certificate of registration raises the presumption of copyright validity and ownership.” *Dream Games of Ariz., Inc. v. PC Onsite*, 561 F.3d 983, 987 n.2 (9th Cir. 2009). Dr. Hudson-McKinney offers no authority that a plaintiff must plead publication of a Work to raise this presumption. The statute upon which she rests her argument requires registration to be made “before or within five years after *first publication of the work*” to raise the presumption of validity, indicating publication is not a prerequisite for the presumption to arise. 17 U.S.C. § 410(c) (emphasis added).

Dr. Eichelberger attaches to her Complaint a certificate of registration for the Work effective as of April 21, 2021, about five years after the Work’s “[c]ompletion” in the year 2016. (Compl. Ex. 1.) Viewing the facts in the light most favorable to Dr. Eichelberger, the Court infers that Dr. Eichelberger could have obtained the certificate before or within five years after publication of the Work and that the certificate thus may raise a presumption of validity and ownership. Accordingly, the Court declines Dr. Hudson-McKinney’s invitation to look beyond the pleadings and scrutinize the facts to resolve whether Dr. Eichelberger owns a valid copyright in the Work. (See Mot. 10–11; Reply 2–5.) Dr. Eichelberger pleads that she had permission

to adapt the text of *Neuroanatomy through Clinical Cases* and that she created “a unique arrangement of video slides, outlines and graphics.” (Compl. ¶¶ 10–11.) The claim survives Dr. Hudson McKinney’s challenge to the ownership element.

B. Reverse Passing Off

Section 43(a) of the Lanham Act forbids a person from using “in commerce any word, term, name, symbol, or device, or any combination thereof” that is likely to cause confusion or mistake as to the origin of the person’s goods, services, or commercial activities. 15 U.S.C. § 1125(a). Reverse passing off occurs when a “producer misrepresents someone else’s goods or services as his own.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 27 n.1 (2003).

Dr. Hudson-McKinney first argues that because the Work is a communicative product, it cannot support a reverse passing off claim under *Dastar*. (Mot. 12–13.) In *Dastar*, the Supreme Court held that reading Section 43 of the Lanham Act as creating a federal cause of action for plagiarism would render other sections of the Copyright Act superfluous. 539 U.S. at 34–36. Thus, the Court found that an original creator of a communicative product valued for the “intellectual content” it conveys rather than for its “physical qualities” could not maintain a reverse passing off claim because it would conflict with the limitations of federal copyright law. *Id.* at 33–34. Here, the Work consists of video slides, outlines, and graphics intended to convey lessons about neuroanatomy. It is a communicative product whose value rests in its intellectual content. That Dr. Hudson-McKinney may have generated a tangible copy of the Work, as Dr. Eichelberger suggests in her brief, (Opp’n 8), is immaterial. Dr. Eichelberger’s claim concerns confusion over the content of the lecture materials, not the source of the digital or physical media in which the materials are presented. (See, e.g., Compl. ¶ 14 (alleging Dr. Hudson-McKinney “copied verbatim all of the materials in the Work,” made copies, and distributed the materials to her class); *id.* ¶ 27 (“[S]tudents believed that these materials originated with Defendants.”).) Cf. *Slep-Tone Ent. Corp. v. Wired for Sound Karaoke & DJ Servs., LLC*, 845 F.3d 1246, 1250 (9th Cir. 2017) (“[A]lthough Defendants may, in some sense, have created a new good by copying Plaintiff’s CD-Gs [containing karaoke music tracks Plaintiff produced] to hard drives, it is still not a *relevant* good under the Lanham Act. . . . Karaoke patrons who see Defendants’ performances of Plaintiff’s karaoke tracks will not be confused about the source of the tangible good sold in the marketplace. Consumers are not aware of the new, media-shifted digital files about which Plaintiff asserts confusion.”).

Dr. Eichelberger also contends that her reverse passing off claim is not barred by *Dastar* because that case was intended to prevent copyright infringement from being overtaken by trademark law, which is not the case here. (Opp’n 7.) However, *Dastar* controls here given that the Work is a communicative product to which copyright protection may apply. *See Lions Gate Ent., Inc. v. TD Ameritrade Servs. Co.*, No. 2:15-05024 DDP-E, 2017 U.S. Dist. LEXIS 170935, at *10 (C.D. Cal. Oct. 16, 2017) (“[T]he advertising campaign involved a communicative product to which *Dastar*’s reasoning may apply.”).

Further, Dr. Hudson-McKinney contends that Dr. Eichelberger has not alleged commercial use of the Work. (Mot. 13–14.) Dr. Eichelberger does not address this argument in her opposition brief. (Opp’n 8.) The Court deems it conceded. *See, e.g., John-Charles v. California*, 646 F.3d 1243, 1247 n.4 (9th Cir. 2011) (deeming issue waived where party “failed to develop any argument”); *City of Arcadia v. EPA*, 265 F. Supp. 2d 1142, 1154 n.16 (N.D. Cal. 2003) (“[T]he implication of this lack of response is that any opposition to this argument is waived.”). While commercial use is not a requirement to maintain a claim for violation of 15 U.S.C. § 1125(a), *see Henley v. Devore*, No. SACV 09-0481-JVS, 2009 U.S. Dist. LEXIS 141037, at *11 n.2 (C.D. Cal. July 8, 2009), the Work still must have some connection with activities within the ambit of the Commerce Clause to support a violation, *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005). No such activities are alleged here.

The Court declines to reach Dr. Hudson McKinney’s other arguments for dismissal of the Lanham Act claim and dismisses the claim for the reasons described above. On its own motion, the Court dismisses the claim against Western on the same bases it dismisses the claim against Dr. Hudson-McKinney. *See Abagninin v. AMVAC Chem. Corp.*, 545 F.3d 733, 742–43 (9th Cir. 2008).

C. Leave to Amend

As a general rule, leave to amend a dismissed complaint should be freely granted unless it is clear the complaint could not be saved by any amendment. Fed. R. Civ. P. 15(a); *Manzarek v. St. Paul Fire & Marine Ins. Co.*, 519 F.3d 1025, 1031 (9th Cir. 2008).

Dr. Eichelberger may be able to provide additional allegations demonstrating she has standing to pursue an injunction remedy for her copyright claim. Given the Ninth Circuit policy of granting leave to amend with “extreme liberality,” *Brown v.*

Stored Value Cards, Inc., 953 F.3d 567, 574 (9th Cir. 2020) (internal quotation marks omitted), the Court gives Dr. Eichelberger leave to add new allegations to this end.

The Court denies leave to amend the Lanham Act claim because amendment would be futile. *See Rutman Wine Co. v. E. & J. Gallo Winery*, 829 F.2d 729, 738 (9th Cir. 1987) (affirming denial of leave to amend where amended complaint failed to cure defects identified in order dismissing prior complaint). *Dastar* precludes Dr. Eichelberger from pursuing a reverse passing off claim over her Work, which is a communicative product. The Court infers from Dr. Eichelberger's decision not to respond to Dr. Hudson-McKinney's commercial use argument that Dr. Eichelberger can plead no facts to support commercial activities relating to the university lecture materials at issue in this action.

IV. CONCLUSION

The motion is granted in part and denied in part. The Court dismisses the copyright claim for injunctive relief with leave to amend. The Court dismisses the reverse passing off claim without leave to amend. The motion is denied in all other respects.

Within 14 days, Plaintiff shall file either (1) an amended complaint providing additional allegations supporting her standing to pursue injunctive relief or (2) a statement indicating she will proceed on the basis of the Complaint subject to the dismissals effected by this Order. Failure to file a timely amended complaint or statement will result in dismissal under Rule 41(b). Leave to add new defendants or claims must be sought by a separate, properly noticed motion.

IT IS SO ORDERED.