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7 **UNITED STATES DISTRICT COURT**
8 **CENTRAL DISTRICT OF CALIFORNIA**
9 **WESTERN DIVISION—FIRST STREET COURTHOUSE**

10
11 **TAMARA EICHELBERGER,**
12 **Plaintiff,**

13 **v.**

14 **MARY HUDSON-MCKINNEY,**
15 **WESTERN UNIVERSITY OF HEALTH**
SCIENCES, and DOES 1 - 10, inclusive,
16 **Defendants.**

Case No. 2:22-cv-00663-MCS-SK
Hon. Mark C. Scarsi, Ctrm. 7C

**MEMORANDUM OF POINTS
AND AUTHORITIES IN
SUPPORT OF MOTION TO
DISMISS COMPLAINT FOR
FAILURE TO A STATE CLAIM
FOR RELIEF**

[Fed.R.Civ.Proc. 12(b)(6)]

Date: June 27, 2022
Time: 9:00 a.m.
Ctrm: 7C

Complaint filed: 1/31/2022
Trial date: Not set

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1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **1. INTRODUCTION**

3 This action involves a dispute between faculty members over the alleged
4 unauthorized use of teaching materials in the classroom. This case does not belong
5 in federal court and the plaintiff’s effort to invoke federal jurisdiction by suing for
6 copyright infringement and Lanham Act violations is entirely misguided. Beside the
7 questionable tactics, however, the allegations and judicially noticed facts clearly
8 demonstrate that no claim for relief is stated or can be stated. In a word, the action
9 has no merit. Therefore, the action should be dismissed without leave to amend.

10 **2. RULE 12(b)(6) STANDARD**

11 Under Federal Rule of Civil Procedure 12(b)(6), a defendant may move to
12 dismiss for failure to state a claim upon which relief can be granted. Fed. R. Civ. P.
13 12(b)(6). To overcome a Rule 12(b)(6) motion, a plaintiff must allege “enough facts
14 to state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v. Twombly*, 550
15 U.S. 544, 570 (2007). This standard derives from Rule 8(a), which requires that a
16 complaint contain “a short and plain statement of the claim showing that the pleader
17 is entitled to relief.” Fed. R. Civ. P. 8(a)(2).

18 In resolving a Rule 12(b)(6) motion, the Court must follow a two-pronged
19 approach. First, the Court must accept all well-pleaded factual allegations as true,
20 but “[t]hreadbare recitals of the elements of a cause of action, supported by mere
21 conclusory statements, do not suffice.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).
22 Second, assuming the veracity of well-pleaded factual allegations, the Court must
23 “determine whether they plausibly give rise to an entitlement to relief.” *Id.* at 679. A
24 claim has “facial plausibility” only if the factual content “allows the court to draw
25 the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.*
26 This determination is context-specific, requiring the Court to draw on its experience
27 and common sense. *Id.* There is no plausibility, however, “where the well-pleaded
28

1 facts do not permit the court to infer more than the mere possibility of misconduct.”
2 *Id.*

3 **3. DOCTRINE OF INCORPORATION BY REFERENCE**

4 “To prevent plaintiffs from surviving a Rule 12(b)(6) motion by deliberately
5 omitting documents upon which their claims are based, a court may consider a
6 writing referenced in a complaint but not explicitly incorporated therein if the
7 complaint relies on the document and its authenticity is unquestioned.” See *Swartz*
8 *v. KPMG LLP*, 476 F.3d 756, 763 (9th Cir. 2007). “[T]he ‘incorporation by
9 reference’ doctrine [applies] to situations in which the plaintiff’s claim depends on
10 the contents of a document, the defendant attaches the document to its motion to
11 dismiss, and the parties do not dispute the authenticity of the document, even though
12 the plaintiff does not explicitly allege the contents of that document in the
13 complaint.” *Knieval v. ESPN*, 393 F.3d 1068, 1076 (9th Cir. 2005); *Jackson v.*
14 *Netflix, Inc.*, 506 F. Supp. 3d 1007, 1012-13 (C.D. Cal. 2020), citing *Marder v.*
15 *Lopez*, 450 F.3d 445, 448 (9th Cir. 2006).

16 **4. REQUEST FOR JUDICIAL NOTICE**

17 Under Federal Rule of Evidence 201(b), the court may take judicial notice of
18 “a fact that is not subject to reasonable dispute” because it “can be accurately and
19 readily determined from sources whose accuracy cannot reasonably be questioned.”
20 Fed. R. Evid. 201(b)(2). The court “must take judicial notice if a party requests it
21 and the court is supplied with the necessary information.” *Id.*, Rule 201(c)(2).
22 Pursuant to Rule 201, the Court can take judicial notice of copyright certificates
23 since they are maintained by the Register of Copyrights, a governmental agency.
24 *Warren v. Fox Family Worldwide, Inc.*, 171 F. Supp. 2d 1057, 1062 (C.D. Cal.
25 2001), *aff’d*, 328 F.3d 1136 (9th Cir. 2003).

1 **5. FACTUAL SUMMARY**

2 Plaintiff Tamara Eichelberger (Eichelberger) and Defendant Mary Hudson-
3 McKinney (McKinney) taught “similar classes” in neurology, physiology of the
4 human brain and introductory physical therapy at Western University of Health
5 Sciences (“Western”). (Compl., ¶¶ 9, 13.) Eichelberger claims she created “unique
6 teaching materials for her Clinical Neuroscience course . . . developed over years of
7 working with one of the top texts in the area of neurology, *Neuroanatomy through*
8 *Clinical Cases*, by Hal Blumenfeld, MD, PhD.” (Compl., ¶ 10.) The first edition of
9 *Neuroanatomy*, published in 2001, and the second edition, published in 2010, enjoy
10 copyright protection. (Reg. Nos. TX0005471559 and TX0007249087; RJN, Ex. 2
11 and 3.) Eichelberger “took the text of the book and distilled it down to a unique
12 series of video slides, outlines and graphics (the “Work”). (*Id.*, ¶ 11.) She registered
13 a copyright in the Work and attached the certificate of registration to her complaint.
14 (Compl. ¶ 11, Ex. A; RJN, Ex. 3.)

15 Eichelberger alleges that in 2017 and 2018, McKinney “copied verbatim all
16 of the materials in the Work and put her own name on them.” (Compl., ¶ 14.)
17 McKinney then “displayed the Work to her class without permission” and, on
18 information and belief, made copies for her personal use and “distributed or made
19 copies available to her class.” (*Id.*) Western paid McKinney the sum of “\$8,500 to
20 teach the class.” (*Id.* at ¶ 15.) In 2019, a student commented to Eichelberger that he
21 was able to study with his friend from Western because they had the same class
22 notes from a professor for Clinical Neuroscience. (*Id.* at ¶ 16.) McKinney was
23 contacted about whether she used the Work at Western; she denied any wrongdoing.
24 (*Id.* at ¶ 17.)

1 **6. PROCEDURAL HISTORY**

2 Eichelberger filed this action on January 31, 2022, asserting two claims for
3 relief: (1) copyright infringement under 17 U.S.C. § 501 et seq., and (2) reverse
4 passing off in violation of section 43 of the Lanham Act, 15 U.S.C. § 1125(a).
5 McKinney waived service of the summons and complaint. ECF No. 14.

6 **7. ARGUMENT**

7 **A. First Claim Barred By Three-Year Statute of Limitations**

8 The Copyright Act provides that “[n]o civil action shall be maintained under
9 the provisions of this title unless it is commenced within three years after the claim
10 accrued.” 17 U.S.C. § 507(b). A claim accrues “when the plaintiff has a complete
11 and present cause of action.” *Bay Area Laundry & Dry Cleaning Pension Trust*
12 *Fund v. Ferbar Corp.* (1997) 522 U.S. 192, 201. “Unless Congress has told us
13 otherwise in the legislation at issue, a cause of action does not become ‘complete
14 and present’ for limitations purposes until the plaintiff can file suit and obtain
15 relief.” *Id.*, citing *Reiter v. Cooper*, 507 U.S. 258, 267 (1993) (“While it is
16 theoretically possible for a statute to create a cause of action that accrues at one time
17 for the purpose of calculating when the statute of limitations begins to run, but at
18 another time for the purpose of bringing suit, we will not infer such an odd result in
19 the absence of any such indication in the statute.”).

20 To state a claim for copyright infringement, a plaintiff must allege “(1)
21 ownership of a valid copyright, and (2) copying of constituent elements of the work
22 that are original. *Feist Publ'ns, Inc. v. Rural Tele. Serv. Co.*, 499 U.S. 340, 361
23 (1991); *Unicolors, Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 984 (9th Cir. 2017).
24 Eichelberger alleges that McKinney copied an original work, created in 2016, and
25 displayed it to her class without permission in 2017 and 2018. Eichelberger owned
26 the copyright in her work “immediately upon the work’s creation.” *Fourth Estate*
27 *Pub. Ben. Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 887 (2019), citing *Eldred*
28

1 *v. Ashcroft*, 537 U. S. 186, 195 (2003); see also, 17 U.S.C. § 201(a) (“Copyright in a
2 work protected under this title vests initially in the author or authors of the work.”).

3 Eichelberger’s claim accrued in 2017 and again in 2018 when the Work was
4 allegedly used without permission. Yet, Eichelberger did not file suit until 2022.
5 The claim is time-barred unless Eichelberger can plausibly allege violations in 2019
6 (or later) or rely on the so-called “discovery rule.”

7 **1. No Discrete Violations Within Three Years**

8 As to the former, *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 671-
9 72 (2014) holds that “copyright infringement is actionable within three years, and
10 only three years, of its occurrence. And the infringer is insulated from liability for
11 earlier infringements of the same work. . . . Thus, when a defendant has engaged (or
12 is alleged to have engaged) in a series of discrete infringing acts, the copyright
13 holder’s suit ordinarily will be timely under § 507(b) with respect to more recent
14 acts of infringement (i.e., acts within the three-year window), but untimely with
15 respect to prior acts of the same or similar kind.”

16 Eichelberger fails to state any facts that allows the court to draw a reasonable
17 inference that “more recent acts of infringement” occurred within three years of the
18 filing, i.e., 2019 or later. Eichelberger is specific about the earlier acts, alleging that
19 “Western had confirmed that the materials had been used in 2017 and 2018.”
20 (Compl., ¶ 17.) But Eichelberger relies on sheer speculation as to post-2018. She
21 asserts that “her materials had been used (*and possibly still were being used*) at
22 Western without her permission.” (Compl., ¶ 16, emphasis added.) Eichelberger
23 does not provide a factual basis for this inference of continued use. She does not
24 allege, for example, that McKinney taught the same course at Western or another
25 educational institution in 2019 or used *Neuroanatomy* in 2019 or later. A mere
26 possibility of infringement is not sufficient to avoid the statute of limitations. *Iqbal*,
27 556 U.S. at 679.

1 The claim is time-barred unless Eichelberger can rely on the discovery rule.
2 Of course, as *Petrella* teaches, even if timely, she could only recover for infringing
3 acts that occurred within three years before filing. Nonetheless, as discussed below,
4 the discovery rule—which tolls accrual of the statute of limitations until the plaintiff
5 discovers, or reasonably should have discovered, the infringement—has been called
6 into question by recent Supreme Court decisions.

7 2. Discovery Rule Not Incorporated Into Copyright Act

8 In *TRW Inc. v. Andrews*, 534 U.S. 19, 27-28 (2001), the Supreme Court
9 rejected arguments the Fair Credit Reporting Act included a general discovery rule.
10 At the time, the statute required filing a claim “within two years from the date on
11 which the liability arises.” 15 U.S.C. § 1681p. The Court recognized that lower
12 federal courts, such as the Ninth Circuit, “generally apply a discovery accrual rule
13 when a statute is silent on the issue.” *Id.* at 27. The Court then stated: “But we have
14 not adopted that position as our own. And, beyond doubt, we have never endorsed
15 the Ninth Circuit’s view that Congress can convey its refusal to adopt a discovery
16 rule only by explicit command, rather than by implication from the structure or text
17 of the particular statute.” According to Justice Scalia, in a concurrence joined by
18 Justice Thomas, there was “little doubt” that a statute of limitations which says the
19 period runs from the date on which the cause of action “arose” incorporates the
20 “standard rule that limitations period commences when the plaintiff has a complete
21 and present cause of action.” *Id.* at 35-36, quoting *Bay Area Laundry*, *supra*, 522
22 U.S. at 201.

23 In *Gabelli v. SEC*, 568 U.S. 442, 447-448 (2013), the Court again rejected
24 applying the discovery rule for a civil enforcement action under the Investment
25 Advisers Act of 1940. The statute at issue stated that “an action . . . for the
26 enforcement of any civil fine, penalty, or forfeiture . . . shall not be entertained
27 unless commenced within five years from the date when the claim first accrued.” ,
28

1 28 U.S.C. §2462. This language is identical to the statute of limitations in the
2 Copyright Act, 17 U.S.C. § 507(b) (suit must be “commenced within three years
3 after the claim accrued.”).

4 In a unanimous decision, the Court agreed with petitioners that the “most
5 natural reading of the statute” meant “a claim based on fraud accrues—and the five-
6 year clock begins to tick—when a defendant’s allegedly fraudulent conduct occurs”
7 for that is when the plaintiff has “a complete and present cause of action.” *Id.* at
8 447-48. The Court refused to liken the Government bringing an enforcement action
9 for civil penalties to a defrauded victim seeking recompense. *Id.* at 449.

10 Most recently, *Rotkiske v. Klemm*, 140 S.Ct. 355, 360-361 (2019) rejected
11 application of the discovery rule where a *private* litigant sought damages for
12 violation of the Fair Debt Collection Practices Act. The FDCPA stated that an action
13 “may be brought . . . within one year from the date on which the violation occurs.”
14 15 U.S.C. § 1692k(d). Justice Thomas, writing for the Court, rejected application of
15 the discovery rule as a principle of statutory interpretation:

16 This expansive approach to the discovery rule is a ‘bad wine of recent
17 vintage.’ (quoting *TRW Inc. v. Andrews*, *supra*, 534 U. S. at 37)
18 (Scalia, J., concurring in judgment). It is a fundamental principle of
19 statutory interpretation that ‘absent provision[s] cannot be supplied by
20 the courts.’ A. Scalia & B. Garner, *Reading Law: The Interpretation*
21 *of Legal Texts* 94 (2012). To do so ‘is not a construction of a statute,
22 but, in effect, an enlargement of it by the court.’

23 *Id.* at 360-61.

24 The Court noted that “[a] textual judicial supplementation is particularly
25 inappropriate when, as here, Congress has shown that it knows how to adopt the
26 omitted language or provision.” *Id.* at 361. The Court cited a number of statutes that
27 contained discovery tolling provisions when Congress enacted the FDCPA, such as
28

1 15 U.S.C. §77m; 19 U. S. C. §1621; 26 U. S. C. §7217(c); and 29 U. S. C. §1113.
2 “The length of a limitations period reflects a value judgment concerning the point at
3 which the interests in favor of protecting valid claims are outweighed by the
4 interests in prohibiting the prosecution of stale ones. It is Congress, not this Court,
5 that balances those interests. We simply enforce the value judgments made by
6 Congress.” *Id.* (citation and internal quotation omitted).

7 *Rotkiske* and *Gabelli* impliedly overrule any lower court decision that adopted
8 a default discovery rule, and this includes *Polar Bear Prods., Inc. v. Timex Corp.*,
9 384 F.3d 700, 706 (9th Cir. 2004). *Polar Bear* found no discovery provision in the
10 text of the Copyright Act, but nonetheless held that a copyright infringement claim
11 accrues—and the statute of limitations begins to run—when a party discovers, or
12 reasonably should have discovered, the alleged infringement. This Court is not
13 bound to follow *Polar Bear*.

14 **3. This Court Not Bound to Follow Circuit Decision**
15 **Impliedly Overruled By Intervening Supreme Court**
16 **Decision**

17 In *Galbraith v. County of Santa Clara*, 307 F.3d 1119 (9th Cir. 2002), the
18 Ninth Circuit took a “more flexible approach” to the doctrine of stare decisis. The
19 Court “recognized that circuit precedent, authoritative at the time that it issued, can
20 be effectively overruled by subsequent Supreme Court decisions that ‘are closely on
21 point,’ even though those decisions do not expressly overrule the prior circuit
22 precedent.” *Id.* at 1123. In *Miller v. Gammie*, 335 F.3d 889, 900 (9th Cir. 2003), the
23 Court held that “issues decided by the higher court need not be identical in order to
24 be controlling. Rather, the relevant court of last resort must have undercut the theory
25 or reasoning underlying the prior circuit precedent in such a way that the cases are
26 clearly irreconcilable.”

1 Relying on the flexible approach, Judge Percy Anderson declined to follow a
2 circuit court holding on grounds it had been impliedly overruled by an intervening
3 Supreme Court decision. *Garcia v. Gateway Hotel L.P.*, No. CV 20-10752 PA
4 (GJSx), 2021 U.S. Dist. LEXIS 199500, at *6 (C.D. Cal. Aug. 4, 2021) (“Although
5 the Ninth Circuit has not recognized that *Marx* has impliedly overruled *Brown v.*
6 *Lucky Stores, Inc.*, this Court must nevertheless follow the Supreme Court’s
7 intervening decision in *Marx* rather than the Ninth Circuit’s earlier precedent.”) This
8 Court should do the same.

9 **B. First Claim Fails to Allege Basis For Damages or Injunction**

10 Even if timely, the complaint fails to allege a plausible basis to obtain any
11 legal or equitable remedy. Eichelberger cannot recover—and has not requested—
12 statutory damages or attorney fees—because the alleged infringement occurred prior
13 to registration. 17 U.S.C. § 412(1). Eichelberger cannot recover actual damages
14 because she has not alleged the Work was ever used commercially. 17 U.S.C. § 504.
15 Eichelberger did not license or sell the Work, and neither did McKinney. There is no
16 basis to recover the profits lost by the copyright holder or the profits made by the
17 infringer. *Frank Music Corp v. Metro Goldwyn-Mayer, Inc.*, 772 F.2d 505, 512 (9th
18 Cir.1985). Since no commercial use occurred, and since only a copy was allegedly
19 made, Eichelberger did not allege—and cannot allege—any diminution in value.

20 Eichelberger may argue that since Western paid McKinney \$8,500 to teach
21 the class, she was unjustly enriched or that this stipend would have been paid to
22 Eichelberger. But there is no basis to link the stipend to use of the infringing work,
23 i.e., no causation. There is no allegation that Western hired or paid McKinney
24 because she planned to use the infringing materials. There is no factual allegation
25 that but for Hudon-McKinney’s use of the materials, Western would have hired
26 Eichelberger to teach the class.

1 This leave injunction as the only remedy. 17 U.S.C. § 502. An injunction
2 requires factual allegations of continued infringement or imminent threats of
3 infringement, that irreparable harm will occur, and the public interest will be served
4 by limiting likely future copyright infringement. *eBay Inc. v. MercExchange, L.L.C.*,
5 547 U.S. 388, 391 (2006); *MGM Studios, Inc. v. Grokster, Ltd.*, 518 F. Supp. 2d
6 1197, 1211 (C.D. Cal. 2007). Eichelberger makes no such allegations and, indeed,
7 can only speculate whether the Work was used after 2018. Eichelberger learned of
8 the alleged infringement in 2019, but could not allege any specific acts showing
9 continued infringement (or threats of infringement) in the following 3 years.

10 In a similar situation, this Court granted a motion to dismiss, and denied leave
11 to amend, when the plaintiffs “inexplicably fail[ed] to provide cogent details”
12 concerning the infringement. See, *Jackson v. Netflix*, supra, 506 F. Supp. 3d at 1017.

13 C. First Claim Fails to Allege A Valid Copyright

14 Even if timely, the complaint fails to allege ownership of a valid copyright.
15 “A copyright infringement claimant bears the burden of proving copyright
16 ownership.” *Jackson v. Netflix*, supra, 506 F. Supp. 3d at 1017 (cite and internal
17 quotes omitted). Eichelberger “took the text of the book [*Neuroanatomy*] and
18 distilled it down to a unique series of video slides, outlines and graphics (the
19 “Work”). (*Id.*, ¶ 11.) Eichelberger is unclear whether she created a “compilation” or
20 a “derivative work.” 17 U.S.C. § 101. The certificate of copyright references the
21 “new material” as the text. There was no copyright for a compilation, only for the
22 written word. If that is indeed true, as the Court must assume, then Eichelberger
23 cannot prevail as a matter of law because she failed to allege the author of the
24 preexisting material granted her permission to create the derivative work.

1 “The owner of a copyright has the exclusive right to prepare derivative works,
2 17 U.S.C. § 106(2), and to grant or withhold authorization to create such derivative
3 works.” *ABS Entm’t, Inc. v. CBS Corp.*, 900 F.3d 1113, 1133 (9th Cir. 2018), citing
4 *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 522 (7th Cir. 2009). When an
5 author authorizes a third party to create a derivative work, the copyright extends
6 “only to the material contributed by the author of such work, as distinguished from
7 the preexisting material employed in the work, and does not imply any exclusive
8 right in the preexisting material.” 17 U.S.C. § 103(b).

9 The copyright claimant (the rights holder) for the preexisting material was
10 Sinauer Associates, Inc., the publisher of *Neuroanatomy*. (RJN, Exh. 1 and 2.)
11 Through artful pleading, Eichelberger skirts the issue of permission. Eichelberger
12 alleges she “had permission to create these material,” but does not state whether this
13 permission was from Western, Blumenfeld, or Sinauer Associates. (Compl., ¶ 10.)
14 This Court cannot plausibly infer that Eichelberger obtained the required permission
15 in light of possible scenarios where the permission was not authorized.

16 Eichelberger may argue she is entitled to a presumption of validity based on
17 her certificate of registration. 17 U.S.C. § 410(c). The presumption only arises when
18 the certificate registration was made “before or within five years after first
19 publication of the work.” *Id.* The Work was unpublished. No publication was
20 identified in the certificate. The complaint does not allege facts to show publication.
21 The term “publication” is defined as “the distribution of copies or phonorecords of a
22 work to the public by sale or other transfer of ownership, or by rental, lease, or
23 lending.” Moreover, a “public performance or display of a work does not of itself
24 constitute publication.”

1 Eichelberger may cite *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142
2 S.Ct. 941 (2022), where the Supreme Court held that inadvertent mistakes on the
3 registration certificate, whether mistakes of law or fact, do not invalidate the
4 copyright and bar infringement actions under 17 U.S.C. § 411(a). *Id.* at 947-48. The
5 Court did not discuss or even mention the presumption of validity under § 410(c).
6 Likewise, the Court never discussed rebutting the presumption. Here, the statute is
7 clear. A copyright infringement claimant is not entitled to a presumption of validity
8 based on a certificate of registration for unpublished works. *Unicolors* offer no
9 assistance.

10 **D. Second Claim Fails To State a Claim For Relief**

11 Eichelberger alleges reverse palming off in violation of the Lanham Act, 15
12 U.S.C. § 1125(a). Eichelberger alleges that use of the infringing course materials
13 “created a likelihood of confusion as to source because they imply that they
14 originate from McKinney in connection with a class taught at Western.” (Compl., ¶
15 25.) Eichelberger alleges the materials were marked: Mary Hudson-McKinney, PT,
16 DPT, NCS.” (*Id.*, ¶ 26.) The Second Claim fails for three main reasons.

17 **1. Copyright Act Provides Exclusive Remedy**

18 As a matter of law, the Second Claim for Relief is barred because it conflicts
19 with the Copyright Act. In 2003, the Supreme Court ruled that the original creator of
20 communicative products—“products that are valued not primarily for [their]
21 physical qualities, such as a hammer, but for the intellectual content [they convey]
22 such as a book or video”—could not support a reverse palming off claim under
23 Section 43(a) of the Lanham Act because such a claim would conflict with federal
24 copyright law. *Dastar v. Twentieth Century Fox*, 539 U.S. 23, 33-34 (2003).

1 *Dastar* provided at least three reasons for its holding:

2 *First*, allowing a cause of action under § 43(a) for false reverse palming off
3 “would create a species of mutant copyright law that limits the public’s federal right
4 to ‘copy and to use,’ expired copyrights.” *Id.* at 34, citing *Bonito Boats, Inc. v.*
5 *Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989).

6 *Second*, recognizing a cause of action for misrepresentation of authorship
7 under § 43(a) would render superfluous other sections of the Copyright Act
8 concerning works of visual art. *Id.* at 35.

9 *Third*, “reading § 43(a) of the Lanham Act as creating a cause of action for, in
10 effect, plagiarism—the use of otherwise unprotected works and inventions without
11 attribution—would be hard to reconcile with our previous decisions.” *Id.* at 36.
12 Those decisions denied protection under § 43(a) without a showing that the product
13 had acquired “secondary meaning,” which occurs when, “in the minds of the public,
14 the primary significance of a mark is to identify the source of the product rather than
15 the product itself.” *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 211 (2000).
16 Here, the Work was unpublished. There was no sale, licensing, or distribution to the
17 public for commercial purposes. Eichelberger has not—and cannot—allege her
18 Work, used in a classroom setting, acquired “secondary meaning” under the Lanham
19 Act.

20 **2. No Allegation of Use in Commerce**

21 “Reverse passing off” occurs when “a person removes or obliterates the
22 original trademark, without authorization, before reselling goods produced by
23 someone else.” *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981). “Reverse
24 passing off is accomplished ‘expressly’ when the wrongdoer removes the name or
25 trademark on another party’s product and sells that product under a name chosen by
26 the wrongdoer.” *Id.* However, the fundamental basis for the claim is the use of
27 interstate commerce to confuse or deceive consumers.

28

1 Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), forbids the use of false
2 designations of origin and false descriptions or representations in the advertising and
3 sale of goods and services. The statute provides in pertinent part as follows: “Any
4 person who, on or in connection with any goods or services, . . . uses *in commerce*
5 any word, term, name, symbol, or device, or any combination thereof, or any false
6 designation of origin, false or misleading description of fact, or false or misleading
7 representation of fact, which—(A) is likely to cause confusion, or to cause mistake,
8 or to deceive as to the affiliation, connection, or association of such person with
9 another person, or as to the origin, sponsorship, or approval of his or her goods,
10 services, or commercial activities by another person, . . . shall be liable in a civil
11 action by any person who believes that he or she is or is likely to be damaged by
12 such act.” Congress noted that the “intent of this chapter [Chapter 22—Trademarks]
13 is to regulate commerce within the control of Congress by making actionable the
14 deceptive and misleading use of marks in such commerce; to protect registered
15 marks used in such commerce from interference by State, or territorial legislation;
16 [and] to protect persons engaged in such commerce against unfair competition. . . .”
17 15 U.S.C. § 1127.

18 Eichelberger does not have standing to sue since she did not use the Work in
19 commerce. Her Work was used solely in a classroom setting. Moreover, even if she
20 could assert standing, Eichelberger did not allege that McKinney used the Work in
21 commerce. While noncommercial (i.e., political) use may support a violation, there
22 must be some connection with activities regulated by the Commerce Clause. *United*
23 *We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92 (2d Cir.
24 1997) (“The history and text of the Lanham Act show that ‘use in commerce’
25 reflects Congress’s intent to legislate to the limits of its authority under the
26 Commerce Clause.”). The Lanham Act cannot be stretched so far as to invade the
27 college classroom.

28

1 **3. No Allegation That Work Acquired Secondary Meaning**

2 Section 43(a) requires a showing of “secondary meaning.” *Dastar*, 539 U.S.
3 at 36. Secondary meaning occurs when, “in the minds of the public, the primary
4 significance of a mark is to identify the source of the product rather than the product
5 itself.” *Id.*, citing *Wal-Mart*, 529 U.S. at 211. “General allegations of secondary
6 meaning or distinctiveness are inadequate to state a plausible trademark claim.”
7 *McGurr v. N. Face Apparel Corp.*, No. 2:21-cv-00269-SB (PDx), 2021 U.S. Dist.
8 LEXIS 196568, at *7 (C.D. Cal. Aug. 27, 2021), internal quotes omitted. Here, the
9 Work was unpublished. There was no sale, licensing, or distribution to the public.
10 The complaint is devoid of allegations of extensive sales and marketing or any basis
11 to conclude the relevant consuming public recognizes the source of the Work. In
12 sum, Eichelberger has not—and cannot—allege that her Work, used exclusively in a
13 classroom setting, acquired “secondary meaning” under the Lanham Act.

14 **8. CONCLUSION**

15 Disputes over plagiarism should be resolved in the academic setting, not in
16 federal court using copyright and trademark laws. It appears this action was
17 designed to publicly embarrass and humiliate the defendants. Another purpose was
18 to gain leverage to extract an unreasonable monetary settlement. The laws were not
19 designed to be used in this manner. Notwithstanding the improper use and purpose,
20 this lawsuit fails on the merits. For all the reasons set forth above, McKinney
21 respectfully request that the Court grant this motion and dismiss the complaint for
22 failing to state a claim for relief.

23 Dated: 5/23/2022

KRONGOLD LAW CORP., P.C.

24 /s/ Steven L. Krongold
25 By: _____
26 Steven L. Krongold
27 Attorney for Defendant
28 MARY HUDSON-MCKINNEY