

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

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DR. STEPHEN E. WILLIAMS,  
DR. JAMES P. LALLEY,  
DR. HILARY A. LOCHTE,  
DR. JAMIE N. DEWATERS,  
DR. NANCY KACZMAREK, AND  
DR. JULIE H. CARTER

Civil Action No.: 1:21-cv-01001

Plaintiffs,

vs.

D'YOUVILLE COLLEGE,  
JBCN EDUCATION, INC.,  
CHALKBOARD SCHOOL SOLUTIONS, LLP,  
NATION OF LEARNING EXCELLENCE,  
AND DOES 1-5,

Defendants.

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**NOTICE OF MOTION**

**MOVING PARTY:** Defendant D'Youville College.

**RELIEF REQUESTED:** An order, pursuant to Fed. R. Civ. Pro. 12(b)(6), dismissing the Complaint [Dkt. 1] with prejudice, and for such other and further relief as the Court deems just and proper.

**GROUND FOR MOTION:** Fed. R. Civ. Pro. 12(b)(6) and the authorities cited in Defendant's Memorandum of Law dated November 1, 2021.

**SUPPORTING PAPERS:** Defendant's Memorandum of Law dated November 1, 2021. Defendant intends to file and serve reply papers.

**DATE, TIME, AND PLACE OF HEARING:** To be scheduled by the Court. Moving Defendant respectfully requests oral argument.

Dated: Buffalo, New York  
November 1, 2021

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**MEMORANDUM OF LAW IN SUPPORT OF  
D'YOUVILLE COLLEGE'S  
MOTION TO DISMISS**

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**PRELIMINARY STATEMENT**

D'Youville College (the "College") submits this memorandum of law in support of its motion to dismiss the complaint under FRCP 12(b)(6).

Plaintiffs are former full-time faculty members in the College's Education Department. This case arises from their participation in the College's planned collaboration with JBCN and Chalkboard to offer a "Masters in Education" online degree program, for which the Plaintiffs allegedly developed "course materials" prior to the College discontinuing the Department for financial reasons in September 2018. Since their positions were eliminated at that time, Plaintiffs or their representatives have challenged their termination before the EEOC, this Court, and twice before the College's union grievance committee.

This time, Plaintiffs bring a host of disparate claims sounding in copyright infringement, violation of right to privacy, false designation of origin, deceptive business practice, unjust enrichment, and fraudulent inducement. Whichever way Plaintiffs style their causes of action, all are based on their central unfounded contention that the College continued using their "course materials," names, and likenesses to offer and promote the Masters program. Plaintiffs' claims are supported only by vague, conclusory, sweeping allegations that fail to satisfy even the most liberal pleading standards.

All of Plaintiffs' claims are subject to dismissal on the pleadings. Their copyright infringement claims fail to sufficiently identify the subject work, the portion allegedly copied, or the purported acts of infringement. The secondary infringement claims fail to identify any supporting act by the College or that the College had control over the other defendants.

Plaintiffs' remaining claims appear to be a "kitchen sink" approach designed to salvage the copyright claims, and must also be dismissed outright. The violation of privacy claim is either

time-barred or fails to allege conduct whose purpose is advertising or trade. Plaintiffs have no false designation of origin claim because they are not protected by the Lanham Act. Their N.Y.G.B.L. 349 claim fails because they only allege derivative injuries. Finally, their claims for unjust enrichment and fraudulent inducement are preempted by the Copyright Act, and in any event they fail to plead fraud with the required specificity. For the reasons set forth more fully below, the College respectfully requests that the Complaint be dismissed in its entirety.

### **STATEMENT OF FACTS**<sup>1</sup>

#### **A. The Parties**

Plaintiffs are former full-time faculty members in D’Youville’s Education Department; they were terminated from their positions on September 7, 2018. Complaint ¶¶ 3-20, 45.

D’Youville is an institution of higher education located in Buffalo, New York. Complaint ¶ 21. Defendants JBCN Education, Inc. and Chalkboard School Solutions, LLP are alleged to hold themselves out as educational institutions located in Mumbai, India. Complaint ¶¶ 22-23. Defendant “Nation of Learning Excellence” (“NLE”) is alleged to be a partnership comprised of D’Youville, JBCN, and Chalkboard. Complaint ¶ 24.

#### **B. The Department’s Financial Distress and the College’s Initiative to Generate Additional Revenue**

In 2017, the six Plaintiffs comprised the Education Department’s entire full-time faculty. Complaint ¶ 30. The Department faced financial difficulty, and the College determined that the Education program would have to be discontinued unless it could generate additional sources of revenue. Complaint ¶ 27. In furtherance of this goal, the College decided to create a Masters in Education degree program in an effort that Plaintiffs were allegedly led to believe was

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<sup>1</sup> The alleged facts presented herein are accepted as true only for purposes of this motion under Fed. R. Civ. P. 12(b)(6).

designed to create additional revenue and eliminate the possibility of reducing the Department and its operations. Complaint ¶¶ 28, 32. The College asked Plaintiffs to develop the “curriculum and materials” for the Masters program. Complaint ¶ 31. Plaintiffs allegedly worked on this “detailed curriculum” from about November 2017 until September 2018. Complaint ¶ 33.

For the first nine months of 2018, while Plaintiffs were still full-time employees, the College allegedly publicized the new program, sometimes with the assistance of Plaintiffs. For example, Plaintiffs Lochte and Carter attended a conference in Mumbai in January 2018. Complaint ¶ 42. On March 1, 2018, the College published an article on its website announcing the College’s “collaboration” with JBCN and Chalkboard to “launch India’s first ever online course for practicing teachers, titled, Professional Masters in Education.” Complaint ¶ 41. A video clip posted to the College’s YouTube channel on May 7, 2018 was entitled “D’Youville – JBCN ChalkBoard Partnership” apparently included Plaintiff Lochte. Complaint ¶ 44.

**C. The Copyrighted “Joint Work”**

According to Plaintiffs, their assistance with the attempted launch of the “Professional Masters” program allegedly resulted in the creation of a “joint work” entitled *A Professional Masters Degree in Education: A detailed guide from planning to implementation* (the “Subject Work”). Complaint ¶ 35. The Subject Work was allegedly registered with the United States Copyright Office effective August 29, 2020. *See*, Complaint Ex. G. The Plaintiffs allege that they own the Subject Work as joint authors. Complaint ¶ 37. Plaintiffs did not attach any portion of the Subject Work to the Complaint.

**D. The College’s Permanent License to Use Portions of the Subject Work**

Plaintiffs, as full-time faculty members until September 7, 2018, were represented by the D’Youville College Chapter of the American Association of University Professors (“AAUP”). *See* Complaint Exhibit H. AAUP and the College were at relevant times parties to a “Cooperative

Agreement” in effect from 2017-2021 (the “Union Contract”). *Id.* Article XX of the Union Contract concerns “Intellectual Property.” *Id.* at 73-75. Article XX was expressly designed to “set forth the rights and obligations of the parties hereto as to intellectual property rights of the College and of the members of the bargaining unit.” *Id.* at Article XX.A.

Article XX.B.1 defines “Copyright/Copyrightable” as “literary works,” “musical works,” “dramatic works,” “pantomimes and choreographic works,” “pictorial, graphic, and sculptural works,” “motion picture and other audiovisual works,” “sound recordings,” “architectural works,” and “computer programs.” *Id.* at 73.

Article XX.B.2 defines “Intellectual Property” to include, among other things, “tests,” “study guides,” “syllabi,” “tests and work papers,” “lectures,” and “programmed instruction materials.” *Id.*

Article XX.C.1 provides that intellectual property created by a covered employee is the employee’s sole and exclusive property, except as limited by Articles XX.C.2, 3 and 4. *Id.* at 74.

Article XX.C.2 provides that the College retains a permanent license in “syllabi” created by employees in the course of their duties. Specifically, it states:

Notwithstanding the foregoing, the College shall retain a permanent license to use for pedagogical purposes associated with teaching courses at the College, any and all syllabi created, made or originated by an employee in the course of his or her duties and responsibilities for the College... For the purposes of this Agreement, a syllabus includes the course description, the expected course learning outcomes, course objectives, integrity policy, grading percentages, and list of suggested texts and materials.

*Id.* Plaintiffs acknowledge this permanent license. Complaint ¶¶ 65.

Plaintiffs allege that the Subject Work “contains the materials used to register, teach, and promote the ‘Professional Masters in Education,’” and that Defendants, collectively, are promoting “educational products and services that use the Subject Work for commercial purposes.” Complaint ¶¶ 40, 51-52. Plaintiffs further allege, “upon information and belief and reasonable

suspicion,” that “course materials... included in the Subject Work have been and are still being used by the Defendants without permission.” Complaint ¶ 58. Plaintiffs further allege that the “NLE Partnership Brochure” attached to the Complaint as Exhibit I “lists courses that are delivered using materials from the Subject Work. Complaint ¶ 59. The referenced “Partnership Brochure,” while undated, contains an academic calendar beginning in August 2018, when Plaintiffs were still employed by the College. *See* Complaint Exhibit I at 12. Finally, Plaintiffs allege that all Defendants “have offered courses and programs whose materials incorporate the Subject Work or are substantially similar to it” every semester beginning Spring 2019, and employees of the Defendants generate, distribute or prepare derivative or substantially similar copies of the Subject Work to students. Complaint ¶¶ 60, 75-76.

**E. The Alleged Uses of Plaintiffs’ Names and Likenesses**

Plaintiffs allege that “Defendants are currently using the names, likenesses, and academic reputations of the Plaintiffs to promote” their educational “products.” Complaint ¶ 53. Plaintiffs further allege that Plaintiff Lochte is incorrectly still listed as the “School of Education Chair, D’Youville College” on JBCN’s website. Complaint ¶ 54. Plaintiffs further allege that the names and academic credentials of Plaintiffs DeWaters, Lalley, Lochte, Williams, Kaczmarek and Sister Nancy are incorrectly still listed as “Full-time Undergraduate Faculty” in the College’s 2021-22 undergraduate course catalog. Complaint ¶¶ 55-56. Based on this, Plaintiffs claim to have a “reasonable suspicion” that “their names, images, and academic reputations are also being used without authorization for marketing purposes by Defendants in direct marketing materials such as emails, targeted electronic advertisements, and mailed materials.” Complaint ¶ 57. Under Plaintiffs’ theory, students may therefore “enroll in the Partnership Masters program with a reasonable but mistaken belief that they will be learning from the Plaintiffs.” Complaint ¶ 72.

## ARGUMENT

“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 is facially plausible “when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* (citing *Twombly*, 550 U.S. at 556). The plaintiff must allege sufficient facts to show “more than a sheer possibility that a defendant has acted unlawfully.” *Id.* (citing *Twombly*, 550 U.S. at 557, 127 S.Ct. 1955).

As set forth more fully below, none of Plaintiffs’ causes of action plausibly states a claim.

### **I. PLAINTIFFS FAIL TO STATE A CLAIM FOR COPYRIGHT INFRINGEMENT**

“To prove a claim of copyright infringement, a plaintiff must establish three elements: ‘1) that his work is protected by a valid copyright, 2) that the defendant copied his work, and 3) that the copying was wrongful.’” *Logical Operations Inc. v. 30 Bird Media, LLC*, 354 F. Supp. 3d 286, 294 (W.D.N.Y. 2018) (citing *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 100 (2d Cir. 2014)). To meet the requirements of Rule 8(a), “a complaint must plead with specificity the acts by which a defendant has committed copyright infringement.” *Gayle v. Larko*, No. 18 CIV. 3773 (ER), 2019 WL 4450551, at \*3 (S.D.N.Y. Sept. 17, 2019) (citing *Marvullo v. Gruner & Jahr*, 105 F. Supp. 2d 225, 230 (S.D.N.Y. 2000)). “Specifically, a plaintiff must allege (1) which specific original works are the subject of the copyright claim; (2) that the plaintiff owns the copyrights in those works; (3) that the copyrights have been registered in accordance with the statute; and (4) by what acts during what time the defendant infringed the copyright.” *Id.* (citing *Kelly v. L.L. Cool J.*, 145 F.R.D. 32, 36 (S.D.N.Y. 1992), *aff’d sub nom. Kelly v. L.L. Cool J.*, 23 F.3d 398 (2d Cir. 1994)). At a minimum, Plaintiffs fail to meet the first and fourth *Kelly* factors.

**A. Plaintiffs Fail to Allege which Portion of the Work is the Subject of their Claim**

Plaintiffs provide no information about the Subject Work beyond its title and authorization number. They neither attach it to the Complaint nor provide an explanation for its absence. Beyond calling it a “detailed curriculum,” and that it “contains the materials used to register, teach, and promote” the Professional Masters in Education program, they allege nothing else about it. They do not describe whether it contains, for example, a syllabus, reading lists, tests, grading criteria, teaching plans, lectures, or any of the other *specific* kinds of materials that one might expect to find in a “detailed curriculum.”

First, this lack of detail about the protected work is itself fatal to Plaintiffs’ infringement claim. District courts in the Second Circuit have routinely dismissed copyright infringement claims where the plaintiff fails to include or adequately identify the work at issue. *See, e.g., Gayle v. Hearst Commc’ns, Inc.*, No. 19 CV 4699-LTS-DCF, 2021 WL 293237, at \*2 (S.D.N.Y. Jan. 28, 2021) (dismissing copyright claim where plaintiff merely identified two registration numbers and a group of 13 photos: “[i]ndeed, his failure to disclose the visual images allegedly protected is fatal to his copyright claim.”); *Gayle v. Larko*, No. 18 CIV. 3773 (ER), 2019 WL 4450551, at \*3 (S.D.N.Y. Sept. 17, 2019) (granting motion to dismiss copyright infringement claim where plaintiff’s complaint failed to “provide the specific original works he used to register the copyrights” and, therefore, the court had “no original works to compare”). The College simply cannot respond to these vague allegations about a subject work; they cannot compare any materials used in their courses to those allegedly protected by copyright when the Plaintiffs have completely declined to identify what works have allegedly been copied.

Second, aside from failing to describe what the Subject Work actually contains, Plaintiffs make no allegations whatsoever about what specific portions of the work are the subject of their



claim. This is a pleading requirement where, as here, some portion of the Subject Work is likely covered by the College's license.

In this regard, "it is well established that use of a copyrighted work within the scope of a valid license is non-infringing as a matter of law, and a valid license, either exclusive or non-exclusive, immunizes the licensee from a charge of copyright infringement, provided that the licensee uses the copyright as agreed with the licensor." *Spinelli v. Nat'l Football League*, 96 F. Supp. 3d 81, 128–29 (S.D.N.Y. 2015) (citations and internal quotation marks omitted). "Where, as here, Defendants hold a license that authorizes some copying of the copyrighted material, **plaintiffs must plead acts outside the scope of the license.**" *Energy Intel. Grp., Inc. v. Jefferies, LLC*, 101 F. Supp. 3d 332, 338 (S.D.N.Y. 2015) (emphasis added) (citing *Marvullo v. Gruner & Jahr*, 105 F. Supp. 2d 225, 228 (S.D.N.Y. 2000) (a "licensor may bring a claim for infringement where [the] licensee uses copyrighted material beyond the scope of [the] license")).

Pursuant to the agreement between the College and AAUP,<sup>2</sup> the College holds a permanent license to use any "syllabus" Plaintiffs created during their employment. *See*, Complaint Exhibit H at 74, Article XX.C.2. For the purposes of the agreement, "a syllabus includes the course description, the expected course learning outcomes, course objectives, integrity policy, grading percentages, and list of suggested texts and materials." *Id.* Therefore, to the extent that the Subject Work includes such material, the College has a permanent license to use it and the license "immunizes" the College from a copyright infringement claim.

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<sup>2</sup> In considering the allegations on a motion to dismiss, "the Court may consider documents that are referenced in the complaint, documents that the plaintiff relied on in bringing suit and that are either in the plaintiff's possession or that the plaintiff knew of when bringing suit, or matters of which judicial notice may be taken." *Gym Door Repairs, Inc. v Young Equip. Sales, Inc.*, 206 F. Supp.3d 869, 886 (S.D.N.Y. Sept. 9, 2016) (citing *Chambers v. Time Warner, Inc.*, 282 F.3d 147, 153 (2d Cir. 2002)); *see also Sira v. Morton*, 380 F.3d 57, 67 (2d Cir. 2004) (same).

Yet despite acknowledging the existence of this license and incorporating the agreement into the Complaint, Plaintiffs make no specific allegation that the Subject Work falls outside the agreement's definition of "syllabus." They never allege that the portions at issue consist of things *other than* course descriptions, the expected course learning outcomes, course objective, integrity policy, grading percentages, and list of suggested texts and materials. Any such materials would be covered by the license and immune from suit. To the extent that the Subject Work contains *some* material that is within the definition of "syllabus," Plaintiffs must "plead acts outside the scope of the license." *Energy Intel. Grp.*, 101 F. Supp. 3d at 338. Because Plaintiffs have identified *no actual portions of the Subject Work that were copied*, let alone a more specific allegation as to how such works are outside the license, their Complaint fails to meet the well-settled requirements for pleading specificity of a copyright infringement claim, and must be dismissed.

**B. Plaintiffs Fail to Allege Infringing Acts with Specificity**

Beyond their failure to properly identify the subject work or make any specific allegations about what portions of it form the basis of their claims, Plaintiffs also fail to allege what the College *actually did* to infringe the copyright. Plaintiffs instead resort to vague, generalized, and repetitive allegations against all Defendants collectively that provide no information to the College about how and when it allegedly engaged in infringement. These "[b]road, sweeping allegations of infringement do not comply with Rule 8," *Marvullo*, 105 F. Supp. 2d at 230 (citing *Kelly*, 145 F.R.D. at 36), and must be dismissed.

Each of Plaintiffs' allegations of alleged infringement is essentially the same. They claim that Defendants — without differentiation between the College and the other Defendants — have offered courses that use the Subject Work. *See, e.g.*, Complaint ¶¶ 52 ("Defendants are currently promoting other educational products and services that use the Subject Work for commercial purposes."); 75 ("Students... who enroll in the Partnership Masters Program have used and will

be provided with copies of Plaintiffs' Subject Work... while enrolled in and attending the courses offered that incorporate the Subject Work."); and 76 ("[E]mployees and associates of Defendants... have generated, distributed, and prepared derivative copies of the Subject Work, or works substantially similar to the Subject Work, to teach the Courses offered by all named Defendants.").

In an apparent attempt to address this lack of specificity, Plaintiffs also claim to cite three "examples" of "ongoing unauthorized use," but these purported examples are still just non-specific allegations that the Subject Work is being used for courses. *See* Complaint ¶¶ 59-61. Two of these "examples" reference lists of courses taught in the Masters Program, (*see* Complaint ¶¶ 59, 61; Exhibits I, M), but those allegations are no more specific about what portion of the work is used, how, when, or anything other than the same conclusory allegation that Defendants are using the Subject Work as course materials.

These allegations fail to allege "by what acts during what time the defendant infringed the copyright." They provide no information about what portion of the subject work has been used, in which course, by whom, and when. District courts within the Second Circuit routinely dismiss similar infringement allegations or even those that contain considerably more detail than this. *See, e.g., Palmer Kane LLC v. Scholastic Corp.*, No. 12 CV 3890, 2013 WL 709276, at \*3 (S.D.N.Y. Feb. 27, 2013) (dismissing broad assertions that the defendant "exceeded the licenses," "reused [plaintiff's] works without a license" and used the images "without permission" or "prior to obtaining permission" as insufficient allegations, absent any further factual support); *Cole v. John Wiley & Sons, Inc.*, No. 11 CIV. 2090 DF, 2012 WL 3133520, at \*13 (S.D.N.Y. Aug. 1, 2012) (dismissing allegations that the defendant published certain of plaintiff's photos in publications that were identified in another case as containing unlicensed photographs, where the plaintiff did

not detail any infringing “acts”); *Mahnke v. Munchkin Prod., Inc.*, No. 99CIV.4684(LTS)(THK), 2001 WL 637378, at \*5 (S.D.N.Y. June 7, 2001) (dismissing infringement claims and “accept[ing] defendant’s assertion that it is difficult to respond to plaintiff’s generic references to an infringing ‘baby soda bottle,’ which fail to identify those specific ... products, or particular elements of the products, that are allegedly infringing”); *Marvullo v. Gruner & Jahr*, 105 F. Supp. 2d 225, 228 (S.D.N.Y. 2000) (finding “unadorned allegation” that defendants have published a photograph “‘beyond the scope ... of the limited license,’ absent any factual support, merely states a legal conclusion insufficient to withstand a motion to dismiss.”); *Lindsay v. Wrecked & Abandoned Vessel R.M.S. TITANIC*, No. 97 CIV. 9248 (HB), 1999 WL 816163, at \*4 (S.D.N.Y. Oct. 13, 1999) (dismissing copyright claim that merely alleged, “SCI did knowingly and willfully infringe upon Plaintiff’s copyright ... by unlawfully purchasing and/or otherwise obtaining copies of the Subject Work” and has and will “exploit and profit from the Subject Work.”).

Unlike the unsuccessful plaintiffs in *Palmer* and *Marvullo*, Plaintiffs here do not even allege in conclusory fashion that the subject work at issue “exceeds” or “goes beyond” the license. Like the plaintiff in *Cole*, Plaintiffs have not actually detailed any infringing acts. Like the defendant in *Mahnke*, the College will have difficulty responding to Plaintiffs’ “generic references to infringing.”

Moreover, “[n]ot all copying constitutes copyright infringement, and as the Second Circuit has repeatedly stated, ‘[i]t is an axiom of copyright law that the protection granted a copyrightable work extends only to the particular expression of an idea and never to the idea itself.’” *Schleifer v. Berns*, No. 17 CIV. 1649 (BMC), 2017 WL 3084406, at \*2 (E.D.N.Y. July 19, 2017) (citing *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976)). “Furthermore, ‘[s]imply because a work is copyrighted does not mean every element of that work is protected.’” *Id.* (citing

*Boisson v. Banian, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001)). “Therefore, dismissal is appropriate where the similarity concerns only non-copyrightable elements of plaintiff’s work or if no reasonable factfinder could find the works substantially similar.” *Id.*

Plaintiffs’ generalized, vague allegations that the College used the Subject Work “or works substantially similar thereto” for its Masters program courses are actually a claim that the College is using Plaintiffs’ nonprotected *ideas* for the program in their absence. Without any specific allegations about the Subject Work and what portions of it are protected, the portions of it that were copied, the portions of it that the College is using that are “substantially similar” to the protected portions, or the particular acts of infringement, neither this Court nor the College can compare the original to the allegedly improper copies. Such an inquiry would be appropriate on this motion to dismiss, had Plaintiffs properly identified the materials at issue. *See, e.g., id.* at \*3 (“District courts may evaluate substantial similarity at the pleadings stage on a motion to dismiss”); *Effie Film, LLC v. Pomerance*, 909 F. Supp. 2d 273, 290-91 (S.D.N.Y. 2012) (“Although substantial similarity analysis often presents questions of fact, where the court has before it all that is necessary to make a comparison of the works in question, it may rule on substantial similarity as a matter of law on a Rule 12(b)(6) motion to dismiss.”) (internal quotation marks omitted).

## **II. PLAINTIFFS FAIL TO STATE CLAIMS FOR SECONDARY LIABILITY FOR INFRINGEMENT**

Plaintiffs second and third causes of action — for “contributory” and “vicarious” infringement, respectively — allege that the College is liable for the infringing acts of the other Defendants. These claims should be dismissed because, for the reasons stated above, Plaintiffs fail to state a claim for primary infringement. *See, e.g., Arista Recs. LLC v. Lime Grp. LLC*, 784 F. Supp. 2d 398, 423 (S.D.N.Y. 2011) (“To recover on a claim based on secondary liability, a plaintiff first must establish direct infringement by the relevant third party, *i.e.* the party that received the

infringement-enabling device.”); *Marvullo v. Gruner & Jahr*, 105 F. Supp. 2d 225, 229 (S.D.N.Y. 2000) (“[T]o adequately plead contributory copyright infringement plaintiff must initially plead a direct infringement.”). Even if Plaintiffs had adequately stated their claim for direct infringement, however, they still fail to state claims for contributory and vicarious infringement against the College.

**A. Plaintiffs Fail to State a Claim for Contributory Infringement**

To establish a claim for contributory copyright infringement, a plaintiff must allege that the defendant “with knowledge of the infringing activity, induce[d], cause[d], or materially contribute[d] to the infringing conduct of another.” *Brought to Life Music, Inc. v. MCA Recs., Inc.*, No. 02 CIV. 1164 (RWS), 2003 WL 296561, at \*2 (S.D.N.Y. Feb. 11, 2003) (quoting *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2d Cir.1971)). “A plaintiff must allege that the defendant knew of, and substantially participated in, the alleged direct infringement, for a claim of contributory infringement to stand.” *Id.*

“Significantly, with regard to the participation prong, an allegation that a defendant ‘merely provid[ed] the means to accomplish an infringing activity’ is insufficient to establish a claim for contributory infringement.” *Id.* (citation omitted); *see also Quiroga v. Fall River Music, Inc.*, 1998 WL 851574, at \*37 (S.D.N.Y. Dec.7, 1998) (“[a] mere allegation that the defendant provided the third party with the opportunity to engage in wrongful conduct would not even be enough to survive a motion to dismiss”). Rather, participation in the infringement must be “substantial” and the “authorization or assistance must bear a direct relationship to the infringing acts, and the contributory infringer must have acted in concert with the direct infringer.” *Id.* (citation omitted).

Here, there is no allegation that the College provided the Subject Work to any of the other Defendants, let alone with the requisite level of knowledge and “substantial participation” necessary to adequately plead this claim. Beyond their conclusory allegations of a “partnership,”

which the Complaint itself shows to actually be an informal “collaboration,” Plaintiffs make no specific allegations about the College’s conduct that can support this claim. Plaintiffs make no allegations about how the other Defendants — JBCN, Chalkboard, and the “NLE Partnership” — committed any infringing acts that are different from the acts alleged to have been committed by the College. As explained above, each of those allegations amounts to nothing more than that the College used the Subject Work for Masters program courses. There are no allegations of *any other* acts of direct infringement for which the College could be secondarily liable.

**B. Plaintiffs Fail to State a Claim for Vicarious Infringement**

To plead a cause of action for vicarious infringement, Plaintiffs must plausibly allege that the College “(1) had the right and ability to supervise the infringing conduct and (2) received a financial benefit directly attributable to the infringing conduct.” *Capitol Recs., LLC v. Escape Media Grp., Inc.*, No. 12-CV-6646 AJN, 2015 WL 1402049, at \*41 (S.D.N.Y. Mar. 25, 2015) (citing *Capitol Records, Inc. v. MP3tunes, LLC*, 07 Civ. 9931(WHP), 2013 WL 1987225, at \*9 (S.D.N.Y. May 14, 2013)). A defendant is not liable for vicarious infringement where it “cannot control the conduct of the direct infringer.” *Matthew Bender & Co. v. W. Pub. Co.*, 158 F.3d 693, 707, fn 22 (2d Cir. 1998) (affirming summary judgment on vicarious infringement claim in part because alleged infringing party could not control conduct of the direct infringer); *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir.1963) (holding that vicarious infringement requires that defendant possess the right and ability to supervise the infringing conduct).

Here, the Complaint’s vague and conclusory allegations are insufficient to allege that the College had any ability to control the other defendants. The Complaint merely refers to an alleged “partnership.” Complaint ¶¶ 39; 41 (referencing a news article on the College’s website stating that the College is “partnering” with JBCN and Chalkboard, and also referring to it as a

“collaboration.”); 42. In paragraph 43 of the Complaint, Plaintiffs allege that the “Nation of Learning Excellence” is “consistently referred to as a ‘partnership,’” and paste a screenshot of a document they allege is “the brochure published on Defendant NLE’s website.” Yet, the word “partnership” appears nowhere in the portion of the “brochure” pasted into that paragraph of the Complaint. *Id.* ¶ 43.

District courts in this Circuit routinely dismiss vicarious infringement claims that have far more detailed allegations than Plaintiffs’ here. In *Lopez v. Bonanza.com, Inc.*, No. 17 CIV. 8493 (LAP), 2019 WL 5199431, at \*23 (S.D.N.Y. Sept. 30, 2019), for example, the plaintiff alleged that the defendant had “direct control over the products sold from its website and has the ability to monitor and control the infringing activity.” The court dismissed the claim for vicarious infringement because the allegation “says nothing” about “the scope of [defendant’s] control, if any, over the allegedly infringing activity.” *Id.* (citing *Premier Fabrics, Inc. v. Woodland Trading Inc.*, 42 F. Supp. 3d 549, 555 (S.D.N.Y. 2014)). The allegation was “simply too vague, conclusory, and unintelligible to allow a finding that the control element of a vicarious copyright infringement claim has been met, and thus it falls well short of the pleading standards set forth in *Twombly*.” *Id.* (citing *Gench v. HostGator.com LLC*, No. 14 Civ. 3592(RA)(GWG), 2015 WL 3757120, at \*11 (S.D.N.Y. June 17, 2015); *Bell Atlantic v. Twombly*, 550 U.S. 544, 555 (2007)). Moreover, the Court found that Plaintiff’s vague allegation that the plaintiff and defendant had an “an actual partnership and business relationship” and that “both have the authority to bind one another in transactions that control the infringing products and activities” was likewise insufficient, because the plaintiff did not allege any “right to supervise,” and therefore “fail[ed] to plead the control element.” *Id.* at \*24 (citing *Wolk v. Kodak Imaging Network, Inc.*, 840 F. Supp. 2d 724, 751 (S.D.N.Y. 2012) (granting summary judgment dismissing vicarious infringement claim where



“Plaintiff has presented no evidence that [Defendant] had any ‘right and ability to supervise’ any alleged infringing activity”).

Nowhere have Plaintiffs alleged at all, let alone alleged plausibly, that the College ever had any actual ability to control JBCN or Chalkboard. There is no allegation about the formal relationship, its structure, or anything about direction, control or authority. Plaintiffs identify one news article the College published on its website using the word “partner” as a verb to describe what it referred to in the same article as a “collaboration.” These informal and colloquial uses of the words “partner” and “collaboration” certainly do not allege that a legally cognizable “partnership” existed, let alone that the College had any ability whatsoever to control or direct the activities of JBCN or Chalkboard.

### **III. PLAINTIFFS FAIL TO STATE A CLAIM FOR VIOLATION OF RIGHT TO PRIVACY UNDER NEW YORK CIVIL RIGHTS LAW §§ 50 AND 51**

Civil Rights Law § 51 authorizes a civil action for injunctive relief and damages where the name or likeness of any living person is used for advertising or trade purposes without the written consent of that person, in violation of Civil Rights Law § 50. To establish liability under Section 51, a plaintiff “must demonstrate each of four elements: (i) usage of plaintiff’s name, portrait, picture, or voice, (ii) within the state of New York, (iii) for purposes of advertising or trade, (iv) without plaintiff’s written consent.” *Electra v. 59 Murray Enterprises, Inc.*, 987 F.3d 233, 249 (2d. Cir. 2021) (citing *Molina v. Phx. Sound Inc.*, 297 A.D.2d 595 (1st Dep’t 2002)).

Plaintiffs allege four instances of such use: (1) the March 1, 2018 article on the College’s website announcing the “collaboration” between the College, JBCN and Chalkboard (Complaint ¶ 42); (2) the “NLE Partnership Brochure,” which contains the names and photos of Plaintiffs Lochte and Carter (Complaint ¶ 43; Exhibit I); (3) the video titled “D’Youville – JBCN Chalkboard Partnership” uploaded to the College’s YouTube channel on May 7, 2018 (Complaint ¶ 44); and

(4) that Plaintiffs' names appear in the College's 2021-22 Undergraduate Catalog, which is available on the College's website (Complaint ¶¶ 55-56). None of these alleged uses sufficiently pleads a claim under the statute.

First, three of these four "uses" are time-barred. Under CPLR 215(3), "an action to recover damages for... libel, slander... or a violation of the right to privacy under section fifty-one of the civil rights law" must be brought within one year. Claims under the statute accrue upon first publication, under the "single publication rule." *Nussenzweig v. diCorcia*, 9 N.Y.3d 184, 188 (2007). The Complaint in this case was filed on September 6, 2021. (Dkt. 1). Therefore, the March 1, 2018 article (Complaint ¶ 42) and the May 7, 2018 video (Complaint ¶ 44), whose publication dates are on the face of the screenshots pasted into the Complaint, are clearly time-barred. The "NLE Partnership Brochure," incorporated into the Complaint as Exhibit I, contains an academic calendar with dates from August 2018 to August 2019, meaning that it was likely published three years before the Complaint was filed, and at least two years before. *See* Exhibit I at 12. These three alleged "uses" therefore cannot serve as the basis for this claim.

Second, the alleged uses are not for the purposes of advertising or trade. "A name, portrait or picture is used 'for advertising purposes' if it appears in a publication which, taken in its entirety, was distributed for use in, or as part of, an advertisement or solicitation for patronage of a particular product or service... and is used for purposes of trade if it involves use which would draw trade to the firm." *Electra*, 987 F.3d at 249 (internal citations and quotation marks omitted). "Because the statute was drafted narrowly to encompass only the commercial use of an individual's name or likeness and no more... the statute's terms are to be narrowly construed and strictly limited to nonconsensual commercial appropriations of the name, portrait or picture of a living person." *Id.* (internal quotation marks and citation omitted).

The only timely alleged “use” in the Complaint — Plaintiffs’ names appearing in the 2021-22 undergraduate catalog — fails to allege a use for “advertising” or “trade” purposes. Nowhere does the Complaint allege that the catalog is intended or used for “solicitation” of potential students to the College, nor that it has a use to “draw” students to the College. The Complaint does not allege how it is distributed or transmitted to potential students, if at all, let alone the context that would sufficiently allege that is for advertising. The catalog merely appears on the College’s website and contains the names of dozens of faculty members in alphabetical order, and apparently serves as source of information for existing students rather than an advertisement. This is insufficient to state a claim. *See, e.g., Kane v. Orange Cty. Publications*, 232 A.D.2d 526, 527 (2d Dep’t 1996) (affirming dismissal of claims under Sections 50 and 51 where paid open letter “advertisement” in newspaper was not alleged to be for purpose of soliciting customers to author’s firm).

Third, any such use of Plaintiffs’ names in the undergraduate faculty catalog was incidental. “New York courts have refused to impose liability under §§ 50 and 51 for ‘incidental’ uses of a person’s name or photograph, so as not to impose an undue burden on publishers... ‘isolated’ or ‘fleeting and incidental’ uses... are insufficient to establish an invasion of privacy claim.” *D’Andrea v. Rafla-Demetrious*, 972 F. Supp. 154, 157 (E.D.N.Y. 1997), *aff’d*, 146 F.3d 63 (2d Cir. 1998) (citations omitted). Here, the mere listing of Plaintiffs’ names (not photos) on a website amongst the names of dozens of other faculty members is “isolated,” and “fleeting and incidental.” *See, e.g., Netzer v. Continuity Graphic Assocs., Inc.*, 963 F. Supp. 1308, 1326 (S.D.N.Y. 1997) (“isolated use of [plaintiff’s] previous name and current surname” in a twenty-four page comic book is not actionable); *University of Notre Dame Du Lac v. Twentieth Century–*

*Fox*, 22 A.D.2d 452 (1st Dep’t 1965) (holding that two isolated references to plaintiff’s name in a 143–page book do not offend the Civil Rights Law). The claim must be dismissed.

#### IV. PLAINTIFFS FAIL TO STATE A CLAIM FOR FALSE DESIGNATION OF ORIGIN

Plaintiffs’ claims for false designation of origin under 15 U.S.C. § 1125(a) are brought under the Lanham Act, which was “intended to make ‘actionable the deceptive and misleading use of marks,’ and ‘to protect persons engaged in ... commerce against unfair competition.’” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 (2003) (citing 15 U.S.C. § 1127).

Plaintiffs are not within the class of persons protected by the Lanham Act. “[T]he Lanham Act protects only ‘the producer of the tangible goods that are offered for sale, and not ... the author of any idea, concept, or communication embodied in those goods.’” *Clark v. Childs*, 416 F. Supp. 3d 221, 224 (E.D.N.Y. 2017) (citing *Dastar*, 539 U.S. at 37). Here, like the plaintiff in *Clark*, Plaintiffs are not “producers of tangible goods,” and “therefore cannot assert a cognizable claim under the Lanham Act.” *Id.* Also just like in *Clark*, Plaintiffs are attempting to “us[e] the Lanham Act as an impermissible safeguard against a potential failure of [their] copyright claim. This kitchen-sink approach to litigation is of no help to Plaintiff in this case.” *Id.* See also, *Fioranelli v. CBS Broad. Inc.*, 232 F. Supp. 3d 531, 541 (S.D.N.Y. 2017) (dismissing Lanham Act claim where “Plaintiff is the originator, not the ‘producer of tangible goods’ protected by the Lanham Act. Plaintiff’s Lanham Act claim amounts to nothing more than a copyright infringement claim disguised as a Lanham Act claim. Stated differently, Plaintiff seeks to add additional protection to his copyrighted work through the Lanham Act. *Dastar* prevents claims of this nature.”).

Because Plaintiffs appear to be trying to “add additional protection to their copyrighted work” with another copyright infringement claim disguised as Lanham Act claim, and they are not in the class of persons protected by the Lanham Act, their fifth cause of action must be dismissed.

**V. PLAINTIFFS FAIL TO STATE A CLAIM UNDER NEW YORK GENERAL BUSINESS LAW SECTION 349**

Section 349 of New York’s General Business Law (the “GBL”) prohibits “[d]eceptive acts or practices in the conduct of any business, trade or commerce or in the furnishing of any service in this state.” N.Y.G.B.L. § 349. To assert a claim under the section, “a plaintiff must allege that a defendant has engaged in (1) consumer-oriented conduct that is (2) materially misleading and that (3) plaintiff suffered injury as a result of the allegedly deceptive act or practice.” *Voters for Animal Rts. v. D’Artagnan, Inc.*, No. 19-CV-6158 (MKB), 2020 WL 9209257, at \*3 (E.D.N.Y. July 15, 2020), *report and recommendation adopted*, No. 19-CV-6158 (MKB), 2021 WL 1138017 (E.D.N.Y. Mar. 25, 2021) (citing *Orlander v. Staples, Inc.*, 802 F.3d 289, 300 (2d Cir. 2015)). With respect to the injury element, a plaintiff may not bring suit under § 349 to redress derivative injuries, *i.e.*, those that arise “solely as a result of injuries sustained by another party.” *City of New York v. Smokes-Spirits.Com, Inc.*, 12 N.Y.3d 616, 621 (2009).

Here, Plaintiffs primarily allege injuries only to “potential” customers who are not parties to this action. *See, e.g.*, Complaint ¶ 70 (“Defendants’ unauthorized... uses... conveys a false impression to any potential customer”); 71 (“Students... may enroll... and be deceived regarding who will offer instruction and leadership of the program”); 72 (students may enroll “with a reasonable but mistaken belief that they will be learning from the Plaintiffs”). These allegations do not allege injury to Plaintiffs at all. The only alleged injuries to Plaintiffs are that their professional reputations have purportedly been damaged, and that the “ongoing violation of being falsely associated with the offering” of the degree programs causes “hurt, distress, and is an ongoing source of frustration.” Complaint ¶¶ 73-74.

Plaintiffs fail to allege how these injuries are distinct from, and not derivative of, the alleged injuries to “potential customers.” The only reputational harm that could plausibly arise

from the alleged deceptive practice would come *as a result* of the fact that customers had been deceived and harmed. That Plaintiffs allegedly suffer emotional distress and frustration as a result of this does not change the fact that they do so only after the alleged potential customers have been injured. The fatal flaw in Plaintiffs’ potential claim for damages on this theory is that injuries to the consumers necessarily happen *first*, and are a prerequisite to any of the injuries allegedly suffered by Plaintiffs — in other words, had the allegedly deceived customers not been improperly induced to enroll in the program, Plaintiffs would have no reputational harm or emotional distress. *See, e.g., Smoke-Spirits*, 12 N.Y.3d at 622 (dismissing GBL 349 claim because “[q]uite simply, had the allegedly deceived consumers not been improperly induced to purchase defendants’ cigarettes then the City would have no claim to lost tax revenue”); *Blue Cross & Blue Shield of N.J., Inc. v. Philip Morris USA Inc.*, 3 N.Y.3d 200, 207 (2004) (“An injury is indirect or derivative when the loss arises solely as a result of injuries sustained by another party.”).

#### **VI. PLAINTIFFS’ UNJUST ENRICHMENT CLAIM IS PREEMPTED BY THE COPYRIGHT ACT**

“The Copyright Act preempts a state law claim when (1) the particular work to which the claim is being applied falls within the type of works protected by the Copyright Act under 17 U.S.C. §§ 102 and 103, and (2) the claim seeks to vindicate legal or equitable rights that are equivalent to one of the bundle of exclusive rights already protected by copyright law under 17 U.S.C. § 106.” *Baiul v. NBC Sports, a division of NBCUniversal Media LLC*, 708 F. App’x 710, 712 (2d Cir. 2017) (citing *Briarpatch Ltd. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 305 (2d Cir. 2004)).

A state law claim regarding a work of the type protected by the Copyright Act may proceed only if the claim contains “extra elements that make it qualitatively different from a copyright infringement claim.” *Id.* “The subject matter requirement is satisfied if the claim applies to a work

of authorship fixed in a tangible medium of expression and falling within the ambit of one of the categories of copyrightable works.” *Briarpatch*, 373 F.3d at 305. “The general scope requirement is satisfied only when the state-created right may be abridged by an act that would, by itself, infringe one of the exclusive rights provided by federal copyright law... [i]n other words, the state law claim must involve acts of reproduction, adaptation, performance, distribution or display.” *Id.* (internal citations omitted).

Here, Plaintiffs’ unjust enrichment claim is preempted. In the Complaint, the claim is fashioned as an “alternative cause of action to copyright infringement.” *See* Complaint at 22; ¶ 109. Plaintiffs allege that the College “directed Plaintiffs to generate certain materials... and continues to use those materials without the Plaintiffs’ authorization.” Complaint ¶ 107. This allegation implicates the subject matter of the Copyright Act, because it concerns the allegedly unauthorized use of protected materials. It also implicates the scope of the Copyright Act, because it involves acts of “reproduction” or “distribution.” This claim must be dismissed. *See, Patrick v. Francis*, 887 F. Supp. 481, 484 (W.D.N.Y. 1995) (“Plaintiff’s unjust enrichment cause of action is similarly preempted. The claim that the unauthorized copying of plaintiff’s work unjustly enriched defendants is equivalent to exclusive rights within the general scope of copyright.”).

#### **VII. PLAINTIFFS’ CLAIM FOR FRAUDULENT INDUCEMENT IS PREEMPTED AND IN ANY EVENT FAILS TO STATE A CLAIM**

The elements of a claim for fraudulent inducement under New York law are “(1) the defendant made a material false representation, (2) the defendant intended to defraud the plaintiff thereby, (3) the plaintiff reasonably relied upon the representation, and (4) the plaintiff suffered damage as a result of such reliance.” *Capax Discovery, Inc. v. AEP RSD Invs., LLC*, 285 F. Supp. 3d 579, 586 (W.D.N.Y. 2018) (citing *Bridgestone/Firestone, Inc. v. Recovery Credit Servs., Inc.*, 98 F.3d 13, 19 (2d Cir. 1996)).

Like their unjust enrichment claim, Plaintiffs' claim for fraudulent inducement is fashioned as an alternative to their copyright infringement claims. Complaint ¶ 114. In support of the claim, Plaintiffs allege that they were induced to generate the materials and participate in events by Defendants' material misrepresentation that they would be the individuals to teach and lead certain courses and programs. Complaint ¶ 111. Plaintiffs further allege that they reasonably relied on this representation. Complaint ¶ 112.

First, this claim is preempted for the same reasons as the unjust enrichment claim. The subject is again the "certain materials" that Plaintiffs allege they created and which the College used without their participation. The scope of the claim involves the reproduction or distribution of the work, which Plaintiffs allege is improperly taking place in their absence. Any alleged injury to the Plaintiffs is their lack of credit for work on the materials, which is exactly the same injury for which they seek redress under the copyright claims. The claim must be dismissed on this ground. *See, Johnson v. Arista Holding, Inc.*, No. 05 CIV. 9645 (LBS), 2006 WL 3511894, at \*7 (S.D.N.Y. Dec. 5, 2006) (dismissing fraudulent inducement claim as preempted by Copyright Act where "Plaintiff claim[ed] that he was fraudulently induced to work on [the project] because he expected to receive producer credit and royalties for his contribution to [the project and its exploitation.>").

Second, Plaintiffs fail to plead their fraud claim with the requisite specificity. Pursuant to Fed. R. Civ. P. 9(b), a "party must state with particularity the circumstances constituting [the] fraud..." "To satisfy this requirement, a plaintiff should specify the time, place, speaker, and content of the alleged misrepresentations. In addition, the complaint should explain how the misrepresentations were fraudulent and plead those events which give rise to a strong inference that the defendant had an intent to defraud, knowledge of the falsity, or a reckless disregard for the



truth.” *Grice v. McMurdy*, 498 F. Supp. 3d 400, 410 (W.D.N.Y. 2020) (citing *Caputo v. Pfizer, Inc.*, 267 F.3d 181, 191 (2d Cir. 2001) (internal quotations, citation, and alterations omitted)).

Plaintiffs do none of these things. They instead merely “list[] the elements of a fraud claim without any additional supporting allegations, such as when the alleged fraud occurred, when or how [they] discovered the fraud, or the extent of the fraud.” *Grice*, F.Supp.3d at 410. They do not allege the time, place, or speaker of the allegedly fraudulent misrepresentations made by the College. They have failed to allege, nor can they prove, that the College knew that the statements were false when made. *See, e.g., Downey v. Adloox Inc.*, 238 F. Supp. 3d 514, 525 (S.D.N.Y. 2017) (dismissing fraudulent inducement claim where “there is no suggestion that promise was false, let alone false when it was made.”). Moreover, statements of future hopes or aspirations are not actionable. *See, e.g., Cacchillo v. Insmmed, Inc.*, 551 F. App’x 592, 595-96 (2d Cir. 2014) (dismissing claims for fraudulent and negligent misrepresentation based on promise of future conduct). Rather, the Complaint describes an academic department in financial distress, and efforts by the College to develop an additional source of revenue to address it. Plaintiffs do not identify any statements that can be construed as anything other than a future hope or aspiration that the new initiative would generate enough new revenue to allow the department to continue.

**CONCLUSION**

Based on the foregoing, it is respectfully requested that the Court issue an Order granting the College's motion to dismiss the Complaint in its entirety pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

Dated: November 1, 2021

Respectfully submitted,

**BOND, SCHOENECK & KING PLLC**

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