

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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EDWYNA W. BROOKS d/b/a EW BROOKS :
BOOKS LLC, :
 : 19-cv-1944 (JSR)
Plaintiff, :
 :
-v- : FINDINGS OF FACT AND
 : CONCLUSIONS OF LAW
DAMON ANTHONY DASH and POPPINGTON LLC :
d/b/a DAME DASH STUDIOS, :
 :
Defendants. :
----- x

JED S. RAKOFF, U.S.D.J.

This copyright and trademark infringement case concerns the film "Mafietta," which is adapted from a book series of the same name. Plaintiff Edwyna Brooks is the author of the Mafietta book series, and defendant Damon Dash is a movie and music producer and the Chief Executive Officer of the co-defendant Poppington LLC, d/b/a Dame Dash Studios. In July 2015, Brooks and Dash started working on producing together a film version of Mafietta, but during the course of 2015 and 2016, their collaborative relationship fell apart. In 2017, defendants started marketing and selling the film on iTunes and on Dame Dash Studios' website, all without Brooks' consent.

On February 28, 2019, Brooks brought the instant action against defendants, claiming: (1) copyright infringement in violation of the Copyright Act ("Count One"); (2) trademark infringement in violation of the Lanham Act ("Count Two"); and

(3) common law trademark infringement ("Count Three"). See Pl. Ex. 1.¹ On March 19, 2019, the parties entered into a stipulated preliminary injunction, whereby defendants agreed not to market, advertise, promote, distribute, sell, or utilize the film in any fashion during the pendency of this litigation. On September 30, 2019, the Court granted summary judgment in favor of Brooks with respect to her trademark claims, but denied her motion with respect to the copyright claim as the Court found genuine disputes of material facts regarding that claim. See Memorandum Order dated 9/30/2019.

A bench trial of the copyright claim, as well as to determine damages for all three claims, commenced on January 21, 2020 and lasted for three days. The Court received 19 exhibits² and heard testimony from five witnesses: Brooks, Dash, Edwin Rush (attorney for Brooks in negotiating an unexecuted contract regarding the film), Eric Howard (attorney for Dash in

¹ "Def. Ex." refers to defendants' trial exhibits; "Pl. Ex." refers to plaintiff's trial exhibits; "Tr." refers to the trial transcript; and "JCO" refers to the stipulated facts in the parties' joint pre-trial consent order.

² During trial, defendants moved to admit Def. Ex. 15, a short video clip attached to Def. Ex. 14, an email from Brooks to Dash on May 9, 2016. See Tr. 1/23/2020, at 81:4-82:9. Brooks timely raised an objection based on relevancy, but the Court could not rule on the objection during trial as there were technological issues with playing the video. Id. After reviewing the video, the Court overrules the objection and admits Def. Ex. 15 into evidence.

negotiating the same unexecuted contract), and Alvin Williams (damages expert for Brooks). On March 30, 2020, the parties submitted post-trial memoranda in lieu of oral summations.

Having now carefully reviewed all of the materials, the Court hereby grants judgment in favor of Brooks on her copyright infringement claim, issues a permanent injunction against defendants, and awards Brooks \$300,000.00 in total damages, based on the findings of fact and conclusions of law set forth below. The Court's findings of fact are based on its assessment of the evidence received at trial, including its assessment of the credibility of the witnesses (based on their demeanor at trial, the consistency and internal logic of their accounts, and other pertinent factors). In particular, the Court finds generally credible the testimony of Brooks. In contrast, even disregarding the fact that Dash was throughout the trial disruptive and apparently incapable of exercising ordinary civility, the Court finds Dash's testimony to be unworthy of belief.³ To the extent there are conflicts between the testimony

³ To mention just a few of the many instances of Dash's disruptive behaviors, Dash repeatedly disrupted the trial testimony of Edwin Rush, shouting out answers to questions directed at the witness, loudly accusing the witness of "lying," and repeatedly making gestures and uttering unpleasant noises. Tr. 1/21/2020, at 51:21-52:5, 52:17-53:3. And by way of example of Dash's gross incivility, during cross-examination, Dash characterized plaintiff's attorney's breath as "doo-doo." Tr. 1/23/2020, at 49:23-50:2. (Dash had engaged in similar obscene

of Brooks and the testimony of other witnesses, the Court credits the former unless otherwise noted.

Background

Brooks, d/b/a EW Brooks LLC, is the author of a four-part book series titled Mafietta, which is based on an aspiring female crime boss. JCO 8-9; Tr. 1/22/2020, at 71:1-5, 19-20. Her goal when writing the book series was to turn them into a film or a television series. JCO 8-9. Dash is the Chief Executive Officer of Poppington LLC, a New York limited liability company, and ran a "Poppington seminar" designed to help and mentor independent, aspiring entrepreneurs. JCO 9; Tr. 1/22/2020, at 156:10-157:5.

In mid-July 2015, Brooks paid \$50.00 to attend a Poppington seminar held in Albemarle, North Carolina. Tr. 1/22/2020, at

attacks on plaintiff's counsel during Dash's deposition. See, e.g., id. at 50:14-24 (quoting from deposition).

Substantively, Dash was repeatedly evasive and/or inconsistent. For example, he initially stated that he "always" entered into a 50/50 ownership arrangement at the outset with aspiring movie producers like Brooks, see Tr. 1/22/2020, at 156:15-17, 161:17-21, but when the Court inquired further, he admitted that the instant project with Brooks was the "first time" that he worked on such a project involving a movie, see id. at 163:21-164:8. In addition, he made hyperbolic statements such as that the Mafietta film did not reflect the script Brooks prepared "at all" and that he "had to improvise and make up the whole thing," which the Court finds extremely unlikely given that the actors did table reads based on, and the script editors worked off of, the script and rewrites that Brooks prepared. Tr. 1/22/2020, at 169:5-25; see also Tr. 1/23/2020, at 70:10-71:2.

71:21-72:1; JCO 9-10. Brooks and Dash discussed the book series Mafietta, and Brooks relayed to Dash that she had the necessary funding to shoot a movie version of Mafietta and that she needed "mentorship and a co-sign" to pursue the movie production. JOC 7; Tr. 1/22/2020, at 72:2-19. Dash agreed to provide directorial services. JOC 7; Tr. 1/22/2020, at 158:20-159, 168:21-23.

The filming began on August 3, 2015 and was completed by August 6, 2015. JCO 10; Tr. 1/22/2020, at 75:23-76:1. Prior to shooting the film, Dash, Brooks, and other actors of the film did a table read of the script that Brooks prepared and gave to Dash. Tr. 1/22/2020, at 72:20-73:3, 120:8-23. Brooks and Alicia Allen, who had been helping Brooks with adapting the book series to a film, issued rewrites of the script on the second day of the filming, and issued the final version of the script reflecting further rewrites on the last day of the filming. Pl. Ex. 19; Tr. 1/22/2020, at 74:22-75:2, 77:20-78:23, 120:24-121:9, 149:20-24. Brooks paid for the entire production cost of \$49,372.34. Pl. Exs. 12, 25; Tr. 1/22/2020, at 103:23-104:4, 105:21-106:5. In exchange for 50% of net profits of the film, Dash provided his Dragon Red camera, performed the directorial services, brought in certain celebrities as key cast members - including Chandra Davis a/k/a Deelishis and Jonathan Ancrum a/k/a Murda Mook - and promoted the film afterwards. Id.; Tr.

1/22/2020, at 79:6-10, 84:22-85:6, 85:12-21, 113:18-25, 118:11-13, 119:18-23, 132:15-20; Tr. 1/23/2020, at 4:1-6, 16-20.

On July 31, 2015, before the production began, Rush, counsel for Brooks, sent an email to Dash with a draft of the Mafietta Motion Picture Director's Agreement laying out the terms of Brooks and Dash's collaboration. Tr. 1/21/2020, at 8:1-2; JCO 8; Pl. Ex. 20. After finishing the shooting, the parties continued with their postproduction work, Tr. 1/22/2020, 79:24-80:3, but their collaborative relationship fell apart as Brooks and Dash could not agree on various aspects of the production. See, e.g., Pl. Ex. 27; Tr. 1/22/2020, at 80:6-90:18. Eventually, on November 11, 2015, Rush, on behalf of Brooks, sent a draft termination and release letter to Dash for his signature, and Brooks sent an email to Craig Thieman, a film editor, directing him to cease and desist all further contact with Dash regarding the film. Pl. Ex. 5; Tr. 1/21/2020, at 23:11-14; Tr. 1/22/2020, at 88:15-90:13, 166:16-22.

In an apparent attempt to salvage the situation, the parties' respective lawyers, Rush and Howard, resumed negotiating the Mafietta Motion Picture Director's Agreement beginning on January 13, 2015. Pl. Ex. 26; Tr. 1/22/2020, at 90:14-17. On April 8, 2016, Rush sent to Howard an updated draft of the agreement incorporating various terms they had negotiated between January 13, 2015 and April 8, 2016. Pl. Ex. 26; Tr.

1/21/2020, at 16:19-23. After still further negotiations, Rush, on October 4, 2016, sent Howard a further updated draft of the agreement. Pl. Ex. 25. All three versions of the agreement contained identical work-for-hire and postproduction provisions (discussed in more detail below). Pl. Exs. 20, 25, 26. Dash, however, signed none of these three versions, and in the end there was no signed agreement between Brooks and Dash.⁴ Tr. 1/21/2020, at 8:14-16, 11:14-15; 14:3-14, 24:10-15.

Nonetheless in February and March of 2017, the defendants put numerous posts on the Instagram page of Dame Dash Studios promoting the film. Pl. Ex. 11; Tr. 1/22/2020, at 92:5-97:13. Also, in 2017, the defendants, without Brooks' consent, placed the 17-minute version of the film on the subscription-based platform of Dame Dash Studios⁵ and on iTunes. JCO 11; Tr. 1/22/2020, at 91:25-92:11, 97:15-17. Upon discovering this, Brooks, on December 29, 2017, reached out to iTunes, which took down the film from its platform in late January 2018. Id.; Pl.

⁴ Previously, the Court determined that, under applicable New York or North Carolina statute of frauds, there was no enforceable oral contract pursuant to which Dash had a co-ownership interest in net profits of the film, while clarifying that co-ownership in net profits of the film and co-authorship in the film are distinct concepts, where the former is an indicium of the latter. See Memorandum Order dated 9/30/2019, at 11-16.

⁵ Dame Dash Studio offers subscription options of either \$9.99/month or \$49.99/year. Pl. Ex. 6.

Ex. 1, Ex. E; see also Tr. 1/22/2020, at 97:19-100:22. On January 27, 2019, Brooks registered the film with the U.S. Copyright Office with the Registration No. Pau 003956394, and brought the instant action against defendants on February 28, 2019. Pl. Exs. 1, 14; JCO 11; Tr. 1/22/2020, at 107:10-20, 143:7-17.

Claim for Copyright Infringement

In order to establish copyright infringement, plaintiff must show "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).⁶ There is no dispute that Brooks owns a valid copyright over the film Mafietta: in January 2019, Brooks registered the film with the U.S. Copyright Office. Pl. Ex. 14; see also Fonar Corp. v. Domenick, 105 F.3d 99, 104 (2d Cir. 1997) ("A certificate of copyright registration is prima facie evidence that the copyright is valid."). Furthermore, there is no dispute that defendants "copied" - defined to include reproduction and distribution - the film Mafietta. See Arista Records LLC v. Doe, 604 F.3d 110, 117 (2d Cir. 2010).

⁶ Unless otherwise indicated, in quoting cases all internal quotation marks, alterations, emphases, footnotes, and citations are omitted.

Defendants' defense is that Dash co-owned the copyright in the film *Mafietta*, in which case Dash cannot be held liable. In the Second Circuit, when there is no written contract to address co-authorship (as is the case here), two or more contributors to a work are considered "joint authors" if each "(1) made independently copyrightable contributions to the work; and (2) fully intended to be co-authors." Thomson v. Larson, 147 F.3d 195, 200 (2d Cir. 1998). In its summary judgment order, the Court already determined that Dash has made independently copyrightable contributions to the film *Mafietta*. See Memorandum Order dated 9/30/2019, at 10. Therefore, the only issue at trial with respect to the liability portion of Count One was whether Brooks and Dash fully intended to be co-authors.

The Second Circuit has declined to define explicitly what kinds of proof are necessary to show such joint intent, because the test of co-authorship depends on specific factual circumstances. Nevertheless, a "specific finding of mutual intent [is] necessary," and, to assess this determination, courts have typically considered such factors, inter alia, as whether the parties intended to be credited or billed as co-authors, the parties' view of decision-making and creative control, and the right to enter into third party contracts. Thomson v. Larson, 147 F.3d 195, 202-04 (2d Cir. 1998).

Here, the Court finds that Brooks and Dash did not ever intend to be co-authors. To begin with, the Court credits the testimony of Brooks and Rush that Dash was employed under the doctrine of work for hire and that it was never intended that he be a co-author of the film. See generally Tr. 1/21/2020 at 9:18-23:20; Tr. 1/22/2020, at 79:6-152:19. Documentary evidence introduced at trial corroborates this assertion. For instance, although the Mafietta Motion Picture Director's Agreement was never executed, all three drafts - dated July 30, 2015, April 8, 2016, and October 4, 2016, respectively - contained the following identical work-for-hire provision:

Director's [(i.e., Dash's)] performance hereunder, including all suggestions, ideas, or screen business contributed to the screenplay or to the Film as made will be as an employee for hire, with the resulting film to be deemed a work made for hire as defined in the United States Copyright Act, and Producer [(i.e., Brooks)], or its designee, will be deemed the sole author thereof. Moreover, Director waives any so-called author's rights or droit moral that may accrue under any law throughout the world based on or deriving from his contributions to the Film.

Pl. Exs. 20, 26, 25. All three versions also contained the following identical postproduction clause:

Director will have the right to consult with Producer during postproduction of the motion picture, and Director will be available for consultation, but Producer will have the right to make all final decisions with respect to editing and postproduction work, release, and exploitation of the motion picture.

The fact that Dash and his counsel never objected to these provisions from July 30, 2015 through at least October 4, 2016 - while other provisions regarding reimbursement, merchandise, additional filming, additional investment, producer's credit, and more were actively revised during the negotiation process - strongly supports the finding that the parties did not intend Dash to be a co-author of the film. See Pl. Exs. 26, 25; Tr. 1/21/2020, at 12:16-13:2, 23:17-20; Tr. 1/22/2020, at 184:20-25, 187:24-189:19, 200:13-15, 201:16-18, 202:9-14.

Furthermore, in an email to Dash on September 22, 2015,

Brooks wrote:

I need to know that the 'Mafietta' brand is in tact [sic] as it was when I brought it to you. This is about women's empowerment at the end of the day. . . . I can't have you take it so far left or right that I don't recognize it. For that reason, I am not offering creative control. I am offering a chance for you to bring an edit to the table . . . I will maintain final approval.

I have no issue with paying out the 50% we discussed. However, I have a big issue with the word OWN as the book, sizzle, and script were complete when I met you.

Pl. Ex. 27. This email shows Brooks' clear intent to deny sharing any creative control with Dash. See also Tr. 1/22/2020, at 79:14-16.

In contrast, although Dash and Howard testified that the parties intended Dash to be a co-author,⁷ their self-serving testimony not only lacked credibility but also was not corroborated by a single piece of documentary evidence. See generally Tr. 1/22/2020, at 160:15-164:9, 167:11-25, 180:23-190:9; Tr. 1/23/2020, at 16:12-14. Rather, they could only point to documentary evidence showing that Brooks and Dash intended the profits to be split 50/50 (which is not contested), rather than that Brooks and Dash intended to co-own the copyright. Tr. 1/22/2020, at 185:23-186:9; Tr. 1/23/2020, at 23:1-8; Pl. Ex. 26; see also Tr. 1/21/2020, at 17:5-17. In fact, Dash admitted at one point that the word "copyright" "never came up" between him and Brooks, and he did not seem to demonstrate any understanding of the difference between ownership interest in profits and ownership interest in copyright. Tr. 1/23/2020, at 23:6-8, 29:21-30:2, 33:18-23.

⁷ After the close of evidence, Brooks made a Fed. R. Civ. P. 50 motion for judgment as a matter of law, arguing that a reasonable jury would not have a legally sufficient evidentiary basis to find for Dash on whether the parties intended Dash to be a co-author of the film. Tr. 1/23/2020, at 86:20-88:19. As this was bench trial, the motion should have been made pursuant to Fed. R. Civ. P. 52, rather than Fed. R. Civ. P. 50. Even assuming Brooks made the motion properly under Fed. R. Civ. P. 52, the Court hereby denies the motion, as this testimony by Dash and Howard provided some evidentiary basis - although the Court, as a fact finder, eventually found their testimony not credible - that the parties intended Dash to be a co-author.

For the foregoing reasons, the Court finds that the parties did not mutually intend Dash to be a co-author of the film and therefore Dash did not co-own the copyright in the film. The Court further finds that Brooks was the dominant author between the two.⁸ See 16 Casa Duse, LLC v. Merkin, No. 12-cv-3492 (RJS), 2013 WL 5510770, at *9 (S.D.N.Y. Sept. 27, 2013), aff'd in part, rev'd in part on other grounds, 791 F.3d 247 (2d Cir. 2015) (“When the Second Circuit finds that there is no mutual intent to be co-authors, it holds that whoever was the ‘dominant’ author is the sole author.”). Accordingly, the Court concludes that defendants infringed Brooks’ copyright by reproducing and distributing the film on iTunes and Dame Dash Studios without her permission.

Remedies and Damages

⁸ As discussed above, Brooks was the author of the book series that was turned into the film, paid for the entire production and post-production, paid the actors, provided the scripts and re-writes, and so forth. Pl. Exs 12, 19, 25; Tr. 1/22/2020, at 71:1-5, 19-20, 74:22-75:2, 77:20-78:23, 103:23-104:4, 105:21-106:5, 120:24-121:9, 149:20-24; JCO 8-9. Furthermore, the documentary evidence discussed above also strongly supports finding Brooks to be the dominant author. Tellingly, Dash did not even recognize almost all of the crew who were working on shooting the film. Tr. 1/23/2020, at 59:24-60:22. In addition, as discussed above, the Court entirely discredits Dash’s hyperbolic statements that the film did not reflect the script Brooks prepared “at all” and that he “had to improvise and make up the whole thing.” Tr. 1/22/2020, at 169:5-25; see also Tr. 1/23/2020, at 70:10-71:2.

Given that defendants are liable to Brooks on the claims for copyright infringement and trademark infringement, the Court hereby issues a permanent injunction enjoining defendants, and each of them, from marketing, advertising, promoting, distributing, selling, or copying the film Mafietta without Brooks' consent. See 17 U.S.C. § 502(a); 15 U.S.C. § 1116(a).

In addition to injunctive relief, Brooks seeks the following monetary damages: (1) \$557,372.84 for copyright infringement (consisting of \$49,372.84 for the cost of producing the film, \$8,000.00 for the cost of marketing, and \$500,000.00 for future income loss), (2) \$557,372.84 for trademark infringement (consisting of the same), (3) \$375,500.00 in discretionary damages relating to infringement, (4) costs and attorney's fees, and (5) treble damages.⁹ The Court concludes, however, that only damages in the total amount of \$300,000.00 are warranted, for the following reasons.

Damages Under Count One. Under the Copyright Act, Brooks may elect to seek either actual damages and profits or statutory damages, and Brooks elected the former at the end of the trial. 17 U.S.C. § 504(c)(1); Tr. 1/23/2020, at 86:16-19. The relevant

⁹ In contrast, in the joint pre-trial consent order, she sought, without distinguishing damages under the copyright claim from those under the trademark claims: (1) \$49,372.84 for the cost of producing the film, (2) \$500,000.00 for future income loss, (3) attorney's fees, and (4) treble damages.

statutory provision states: "The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. . . ." 17 U.S.C. § 504(b).

Here, as noted, Brooks seeks recovery based on actual damages (including loss of future income) suffered by her, rather than defendants' profits.¹⁰

In assessing actual damages she suffered, the Court makes the following findings of fact. In 2016, Brooks submitted the film to an international film festival held in Nashville, TN, where the film won an award. Tr. 1/22/2020, at 104:9-11, 146:15-19. However, once defendants placed the film on Dame Dash Studios and iTunes in 2017, which constituted a commercial release, the film no longer became eligible for submissions to many other film festivals, effectively eliminating any chance of further marketing of the film through festivals. Id.; id. at 147:4-12; Tr. 1/21/2020, at 38:12-39:3, 46:4-16. Also, placement of the film on commercial platforms, as well as the dispute over

¹⁰ Except for defendants' advertisement revenue figures from the first quarter of 2017 to May 2019 associated with the Mafietta trailer placed on YouTube, no evidence was presented during trial regarding how much profit defendants made from streaming the film on iTunes or Dame Dash Studios, other than Dash's self-serving testimony that there was no revenue from iTunes or Dame Dash Studios associated with the film. Tr. 1/23/2020, at 20:19-22:25, 25:23-26:12, 51:17; Def. Ex. 32.

the chain of title, largely erased the possibility that the film would be acquired by a media platform. Id.; id. at 39:4-19; Tr. 1/22/2020, at 104:1-9, 138:5-11, 139:2-8; Pl. Ex. 16.

The Court finds that Brooks thereby lost approximately \$300,000.00 in potential future income as a result of defendants' infringing conduct. According to the expert testimony by Williams,¹¹ the 17-minute film could have been transformed into a TV series or a back-door pilot. Pl. Ex. 16; see generally Tr. 1/21/2020, at 34:11-62:16. Mafietta could well have been acquired as such by cable networks or streamlining video on-demand services ("SVODs"), given that there have been high demands for organized crime TV series and series produced by, written by, and starring people of color. Id. Furthermore, the cast for the film involved an identifiable female talent with a solid fan base - with over two million followers on her Instagram account - and a male lead with a strong underground hip hop fan base. Id. If the 17-minute film had been acquired as

¹¹ During trial, defendants objected to the admissibility of Williams as an expert witness, on the ground that Williams was allegedly not an expert in film and sale acquisition. See Tr. 1/21/2020, at 32:22-33:19. The Court reserved its decision. See id. After examining all relevant evidence - including Williams' resume and his testimony, all of which show his expertise and experience in acquisition of films for distribution as well as licensing films for various media platforms - the Court hereby overrules the objection to the admissibility of Williams as an expert witness. See, e.g., Pl. Ex. 16; Tr. 1/21/2020, at 31:2-32:5, 41:3-42:9. It also finds his testimony credible.

such by cable networks, each episode would have had a production budget from \$50,000.00 to \$250,000.00 per episode, and possibly higher if acquired by premium pay channels or SVODs, id., thus implicitly reflecting the potential profitability of the series.¹²

For damages calculation, Williams assumed that ten episodes would be produced based on the 17-minute version of the film, but he provided no explanation as to how he arrived at the ten episode figure. Pl. Ex. 16; Tr. 1/21/2020, at 58:12-15; see also id. at 39:20-40:3. However, he testified that typically networks would make a minimum of six episodes, because they need at least six episodes to qualify for an Emmy Award. Tr. 1/21/2020 at 37:17-23. Therefore, the Court finds that conservatively six episodes would have come out of this film, and thus finds that Brooks lost about \$300,000.00 in future income.

While Brooks is therefore entitled to \$300,000.00 in actual damages for lost income, she is not entitled to damages for the costs of producing and marketing the film in the amount of, respectively, \$49,372.84 and \$8,000.00,¹³ because she would have

¹² Any cost associated with marketing the show or back-door pilot - conservatively, at least \$200,000.00 according to Williams' testimony, Tr. 1/21/2020, at 50:22-51:12 - would be borne by the network, rather than by Brooks. Id. at 60:20-61:11.

¹³ In her post-trial closing memorandum, Brooks asserts for the first time that she is entitled to \$8,000.00 in relation to

spent those amounts regardless of whether defendants subsequently infringed her copyright. Moreover, Brooks has not put forth any reason why treble damages are warranted, nor does the Court find a reason to award treble damages. While Dash may be a difficult and intemperate person, and one lacking in credibility, there is no evidence that he entered into this arrangement for the purpose of committing a blatant fraud. Lastly, under the relevant statutory provisions, Brooks is not entitled to attorneys' fees, because the infringement at issue started before the registration of her copyright.¹⁴ 17 U.S.C. §

marketing the film after it was produced, based on her testimony during trial. See Plaintiff's Post-Trial Memorandum, ECF No. 64, at 12; Tr. 1/22/2020, at 126:17-23.

¹⁴ After the close of evidence, defendants made a motion for judgment on the merits regarding damages under Count One, arguing that there was no evidence that Brooks' copyright was infringed after it was registered in January 21, 2019. Tr. 1/23/2020, at 89:18-90:9. The motion is granted with respect to the issue of whether Brooks is entitled to attorney's fees as discussed above, but denied in all respects. Although registration of a work with the Copyright Office is a precondition to filing a suit for infringement under the Copyright Act, see 17 U.S.C. § 411(a), such registration "is not a condition of copyright protection." 17 U.S.C. § 408(a); see also Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp., 210 F. Supp. 2d 147, 157 (E.D.N.Y. 2002), aff'd sub nom., 354 F.3d 112 (2d Cir. 2003). However, plaintiff may not recover statutory damages and attorneys' fees for infringement that occurred before registration. See 17 U.S.C. § 412; Argentto Sys., Inc. v. Subin Assocs., LLP, No. 10-cv-8174 (RWS), 2011 WL 2534896, at *2 (S.D.N.Y. June 24, 2011). Therefore, Brooks is not entitled to attorneys' fees related to the copyright infringement claim, but she properly seeks actual damages for pre-registration infringement. See also Renna v. Queens Ledger/Greenpoint Star

412; see also Ez-Tixz, Inc. v. Hit-Tix, Inc., 919 F. Supp. 728, 735-36 (S.D.N.Y. 1996).

Damages Under Counts Two (and Three¹⁵). Under the Lanham Act, Brooks is entitled to recover "(1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action." 15 U.S.C. § 1117(a). As discussed above, Brooks seeks actual damages she suffered, rather than defendants' profits. To the extent these are based on her lost future income that would have resulted from turning the film into a TV series, the damages sought under Counts Two and Three are duplicative of the damages awarded under Count One. Otherwise, Brooks puts forth no evidence that her Mafietta mark and brand were harmed or tarnished by defendants' infringing activities (e.g., evidence showing a decrease in her book sale revenue). Furthermore, she is not entitled to additional \$375,000.00 in discretionary damages, as the Court does not find that the amount of the recovery in the amount of \$300,000.00 is inadequate. See 15 U.S.C. § 1117(a).

Inc., No. 17-cv-3378 (DRH) (SIL), 2019 WL 1061259, at *4 (E.D.N.Y. Feb. 13, 2019), report and recommendation adopted, 2019 WL 1062490 (E.D.N.Y. Mar. 6, 2019).

¹⁵ During trial, plaintiff conceded that the claim for common law trademark infringement (Count Three) should, for damage calculation purposes, be dismissed as being duplicative of the claim for trademark infringement in violation of the Lanham Act (Count Two). See Tr. 1/21/2020, at 63:11-64:10.

Lastly, this is not an “exceptional case” warranting an award of attorney’s fees under the claims for trademark infringement. Under the Lanham Act, the Court may award, in “exceptional cases,” reasonable attorney fees to the prevailing party. 15 U.S.C. § 1117(a). Based on the totality of circumstances, the Court does not find “there is an unusual discrepancy in the merits of the positions taken by the parties” with respect to the claims for trademark infringement, as exemplified by the arguably colorable, albeit ultimately defeated, argument raised by defendants during this action that Brooks had acquiesced to defendants’ use of the trademark at issue. Georgia-Pacific Consumer Products v. Von Drehle, 781 F.3d 710 (4th Cir. 2015); see also Octane Fitness, LLC v. ICON Health & Fitness, Inc., 134 S. Ct. 1749 (2014). Nor did defendants “litigate[] the case in an unreasonable manner” with respect to the claims for trademark infringement. Id.

In sum, the Court concludes that no additional damages are warranted under the trademark claims on top of damages awarded under the copyright claim.

Conclusion

The Clerk is directed to enter final judgment in favor of plaintiff Edwyna Brooks, and against both defendants, jointly and severally, in the amount of \$300,000.00, plus post-judgment interest at a rate of 0.22% per annum accruing from the date

hereof, see 28 U.S.C. § 1961, and to close the case.

Furthermore, defendants are permanently enjoined from marketing, advertising, promoting, distributing, selling, or copying the film without Brooks' consent.

SO ORDERED.

Dated: New York, NY
April 13, 2020



JED S. RAKOFF, U.S.D.J.