

# 18-2959

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**IN THE UNITED STATES COURT OF APPEALS  
FOR THE SECOND CIRCUIT**

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JAMES H. FISCHER,

*Plaintiff - Appellant,*

v.

STEPHEN T. FORREST, JR., SANDRA F. FORREST, SHANE R. GEBAUER,  
BRUSHY MOUNTAIN BEE FARM, INC.,

*Defendant - Appellees.*

On Appeal from the United States District Court  
for the Southern District of New York  
No. 1:14-cv-01307-PAE-AJP  
Hon. Paul A. Engelmayer, United States District Judge

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**APPELLANT'S OPENING BRIEF**

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## INTRODUCTION

This appeal raises an issue of first impression on the meaning of Section 1202(c)'s definition of copyright management information ("CMI"). Section 1202 is a portion of the 1998 Digital Millennium Copyright Act ("DMCA").

The broad definition of CMI in Section 1202 means that the plain text governs this appeal. Section 1202(c)(2) defines as CMI the name of the author of a copyrighted work. 17 U.S.C. § 1202(c)(2). In turn, Section 1202(c)(3) defines as CMI the name of the owner of a copyrighted work. 17 U.S.C. § 1203(c)(3). Here, Appellant James Fischer is both with respect to the relevant copyrighted materials. Thus, when he included his name in those copyrighted materials, his name is CMI.

The district court thought otherwise because it confused Section 1202's identifying purpose with separate provisions in the Copyright Act, 17 U.S.C. §§ 401-402, that are primarily intended to warn of a copyright claim. Thus, correcting the district court's confusion will help to restore Congress' intended purpose in its unambiguous definition of CMI.

## JURISDICTIONAL STATEMENT

(A) This appeal concerns intellectual property claims arising from federal statutes. 1304<sup>1</sup> Dkt. 89 at 9-31 ¶¶ 37-163 [2JA 184-206]. The district court had federal question jurisdiction. 28 U.S.C. § 1331.

(B) The district court entered final judgment below. Dkt. 194 at 1 [1JA 11] (clerk’s Rule 58(a) entry of judgment); Dkt. 218 at 4 [SA 8] (denying Rule 59 reconsideration); Dkt. 223 at 1 [1JA 10] (granting Rule 60 clarification). This Court has appellate jurisdiction. 28 U.S.C. § 1291.

(C) The district court entered judgment on Defendants’ Rule 60 motion on September 10, 2018. Dkt. 223 at 1 [1JA 10]; cf. FRCP 58(c)(1). Mr. Fischer timely filed a notice of appeal on October 2, 2018. Dkt. 224 at 1 [1JA 5]; 1304 Dkt. 230 at 1 [2JA 104]; see FRAP 4(a)(4)(A)(vi).

(D) This appeal is from a final order and judgment.

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<sup>1</sup> All citations are to the docket in Case No. 1:14-cv-01307-PAE-AJP, unless otherwise noted with a “1304.” All docket-entry page numbers are to CM/ECF docketing stamps. SA cites are to the special appendix. JA cites are preceded by a number indicating the volume. For example, a cite to “2JA 5” is a cite to the fifth page of the second volume of the Joint Appendix.

## REPRODUCTION OF RELEVANT STATUTORY SECTIONS

- Section 412 of Title 17 of United States Code reads, in pertinent part:

### **§ 412. Registration as prerequisite to certain remedies for infringement**

In any action under this title, [...] no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for—

- (1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or
- (2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

- Section 1202 of Title 17 of United States Code reads, in pertinent part:

### **§ 1202. Integrity of copyright management information**

[....]

#### (c) Definition.

As used in this section, the term “copyright management information” means any of the following information conveyed in connection with copies or phonorecords of a work or performances or displays of a work, including in digital form, except that such term does not include any personally identifying information about a user of a work or of a copy, phonorecord, performance, or display of a work:

- (1) The title and other information identifying the work, including the information set forth on a notice of copyright.
- (2) The name of, and other identifying information about, the author of a work.
- (3) The name of, and other identifying information about, the copyright owner of the work, including the information set forth in a notice of copyright.

- (4) With the exception of public performances of works by radio and television broadcast stations, the name of, and other identifying information about, a performer whose performance is fixed in a work other than an audiovisual work.
- (5) With the exception of public performances of works by radio and television broadcast stations, in the case of an audiovisual work, the name of, and other identifying information about, a writer, performer, or director who is credited in the audiovisual work.
- (6) Terms and conditions for use of the work.
- (7) Identifying numbers or symbols referring to such information or links to such information.
- (8) Such other information as the Register of Copyrights may prescribe by regulation, except that the Register of Copyrights may not require the provision of any information concerning the user of a copyrighted work.

[....]

## ISSUES PRESENTED

1. Copyright management information (“CMI”) includes names of authors and copyright owners when those names are conveyed with a work. 17 U.S.C. § 1202(c). Mr. Fischer is both the author and copyright owner of a work. He conveyed his name—“Fischer’s”—with that work. Is his name, as conveyed with that work, copyright management information?
2. Section 412 of the Copyright Act bars recovery of statutory damages and attorney’s fees for pre-registration copyright infringements. 17 U.S.C. § 412. Was the district court correct to bar recovery of all remedies, including declaratory relief under Section 412? Was it correct to apply Section 412 at summary judgment despite genuine issues of material fact regarding when infringement began?
3. Mr. Fischer proceeded *pro se* initially. Applying the liberal standard for *pro se* pleadings, the district court held

that Mr. Fischer had pled a trademark infringement claim. Then he retained counsel. After he retained counsel, his counsel was permitted to amend the defendants named in the complaint, but make no other changes. Was it appropriate for the district court to then hold that Mr. Fischer's complaint, as minimally amended by his attorney, failed to plead trademark infringement?

## STATEMENT OF THE CASE

### A. Procedural History

Appellant James Fischer commenced this action on February 27, 2014 in the United States District Court for the Southern District of New York. He brought claims for, *inter alia*, violations of the Digital Millennium Copyright Act (“DMCA”), copyright infringement, and federal trademark claims. On April 19, 2017, Defendant-Appellees moved for summary judgment. Dkt. No. 172 [1JA 218-219].

On July 14, 2017, U.S. Magistrate Judge Andrew Peck issued his Report and Recommendation, recommending that Defendants’ summary judgment motions be granted in their entirety. Dkt. 185 [SA 51-109]. On February 16, 2018, U.S. District Judge Paul A. Engelmayer, granted Defendants’ motions for summary judgment, adopting the R&R in full. Dkt. 193 [SA 9-50].

The district court entered final judgment when it granted Defendants’ Rule 60 motion on September 10, 2018. Dkt. 223 at 1 [1JA 10]. Mr. Fischer timely filed his Notices of Appeal on October 2, 2018. Dkt. 224 at 1 [1JA 5]; 1304 Dkt. 230 at 1 [2JA 104].

## **B. Summary of the Facts**

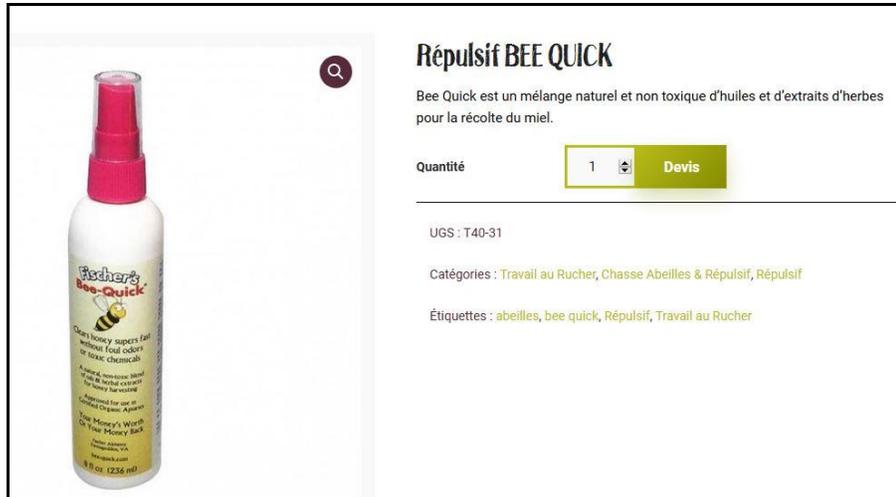
Mr. Fischer has developed a natural honey-harvesting aid for beekeepers, called Bee-Quick<sup>®</sup>. This trendsetting product was substantially better than its competitors. Bee-Quick was 100% natural, non-toxic, and, most importantly, pleasant smelling.

Its pleasant smell was a welcomed improvement for beekeepers. Many existing honey-harvesting products had an off-putting, foul-smell that was notorious among the beekeeping community.

Shortly after he released it, Mr. Fischer's product received glowing endorsements. *The Backyard Beekeeper* raved that the “product to use has the brand name of Bee-Quick<sup>®</sup> and is a pleasant-smelling (to humans) nontoxic concoction with a vanilla fragrance.” 1304 Dkt. 50 at 72 [2JA 295].

Mr. Fischer's product was also featured in *Beekeeping For Dummies*. Whereas traditional honey harvesting products had a stench that “is more than words can politely express,” Mr. Fischer's innovative product was praised for its “almond-vanilla scent” that smelled “good enough to be a dessert topping!” *Id.* at 71 [2JA 294].

Bee-Quick has been an international hit. For example, it's sold in many languages around the world:



In addition to being Bee-Quick's inventor, Mr. Fischer is also Bee-Quick's marketer. He has authored clever and playful advertising materials for his product that play on how bad the other products smell:

### **Fischer's Bee Quick™**

This 100% Natural, non-toxic blend of oils and herb extracts works just like Bee Go® and it smells good! Fischer's Bee Quick™ is a safe, gentle, and pleasant way to harvest your honey. *Are you tired of your spouse making you sleep in the garage after using Bee Go®? Are you tired of using hazardous products on the bees you love?*

Dkt. 185 at 36 [SA 86] (emphasis added).

Mr. Fischer owns the copyright in these advertising materials and has registered them with the U.S. Copyright Office. 1304 Dkt. 50 at 53 [2JA 276] (effective date of registration: Feb. 7, 2011).

Also, Mr. Fischer successfully registered a trademark for the Bee-Quick<sup>®</sup> mark in 2011. 1304 Dkt. 50 at 51 [2JA 274] (recognizing a first use in commerce dating back to 2000).

From 2002-2011, Mr. Fischer had a supplier-distributor relationship with Defendant Brushy Mountain Bee Farm, which was owned and operated by Defendants Stephen and Sandra Forrest with the help of Defendant Shane Gebauer (collectively “Defendants”).

Mr. Fischer had met the Forrests in the 1990s and for these years in the 2000s, the Forrests and Mr. Fischer worked together to bring Fischer’s pleasant-smelling Bee-Quick to a relieved honey-harvester community. Mr. Fischer’s advertising was used to sell Bee-Quick in Brushy Mountain’s annual print catalogs and on their website. See, e.g., id. at 56 [2JA 279].

In 2011, however, the Forrests started selling their own knock-off product to compete with Mr. Fischer and his successful product. On December 10, 2010, an email was sent indicating that Defendants had recently sent out backorders of Bee-Quick to customers, but that they anticipated discontinuing Bee-Quick in their upcoming 2011 Brushy Mountain print catalog. Id. at 52 [2JA 279].

Mr. Fischer’s vivid, playful advertisement, however, proved too good to pass up. To sell their knock-off product, Defendants continued to use Mr. Fischer’s advertising materials. To sell the competing, knock-off product that they

had devised, called Natural Honey Harvester, Defendants decided to use knock-off advertising materials as well. See, e.g., id. at 62 [2JA 285].

The Natural Honey Harvester advertisements touted the same benefits in nearly the exact same words as had been used for Bee-Quick in Mr. Fischer's advertising. Defendants simply cut out Fischer's name and the product name Bee-Quick, replacing them with the name Natural Honey Harvester. (They also impugned Mr. Fischer's reliability as a supplier.)

Defendants used Mr. Fischer's advertisement in their catalogs and their website. Even third-party sellers began to infringe Mr. Fischer's copyrights in the advertising materials. With the Forrests having removed Fischer's name from the advertisement, these third-party wholesale customers had no reason to suspect and no way of knowing that they were in fact using—and infringing—Mr. Fischer's advertising materials for his Bee-Quick.

After learning of Brushy's unauthorized use of his intellectual properties, Mr. Fischer reached out to Brushy and the Forrests. On April 5, 2011, he sent a cease-and-desist letter referencing, amongst other offenses, Brushy's use of his advertisements and intellectual property to sell Defendants' knock-off products. Id. at 65-66 [2JA 288-289].

Defendants didn't stop, however. They created new infringing publications year after year.

**C. Mr. Fischer Sued.**

Mr. Fischer sued Defendants to address and resolve this issue. He chose not to involve the unsuspecting, third-party wholesale customers in the matter— instead focusing his efforts on the source of the problem, Defendants.

## SUMMARY OF ARGUMENT

- I. Section 1202 sets forth an extremely broad definition of copyright management information (“CMI”). Its plain text clarifies that Mr. Fischer’s last name—“Fischer’s”—is encompassed within that definition with respect to any work for which he is the author or the copyright owner. Indeed, Section 1202’s purpose is to protect identifying information that would allow an interested party to trace the copyright in Mr. Fischer’s works to him. CMI does not need to warn about copyright infringement, but merely needs to provide identifying information about the author or owner of a copyrighted work. This Mr. Fischer’s name does. It does not matter under Section 1202 that Mr. Fischer’s name also identifies him as the maker of his product, Bee-Quick. To the contrary, his identity as the maker of his product is a good indicator that he is also the copyright owner in the advertising for that product. Finally, the district court’s concerns about overbroad CMI protection ignore the numerous limiting principles that Congress incorporated into Section 1202. Thus, the district court erred when it refused to honor the plain meaning of Section 1202’s definition of CMI.
  
- II. Section 412 bars statutory damages and attorney’s fees for copyright infringement if infringements predate copyright registration. The district

court erred in applying that statutory bar at summary judgment because there are genuine issues of material fact concerning when copyright infringement began. At summary judgment, the district court did not read a declaration in Mr. Fischer's favor and did not construe the reasonable time to wind down a contractual relationship in Mr. Fischer's favor. Furthermore, it ignored key precedent on how to differentiate a breach of a license agreement from copyright infringement. Simply put, Section 412 does not apply here because there was no infringement prior to copyright registration. Even if it did, the district court was wrong to deny declaratory relief based on Section 412.

III. Mr. Fischer's *pro se* complaint says on the first page that he is bringing a lawsuit about trademark infringement. The district court recognized as much when it held that he had pled a trademark infringement claim. Then, when Mr. Fischer retained counsel, his counsel was only permitted by the district court to change the parties named in the complaint. Nonetheless, the district court then held that, because there was now an attorney representing Mr. Fischer, the essentially unchanged *pro se* complaint no longer pled a trademark infringement claim. This was error because Mr. Fischer's *pro se* drafted complaint should have been read liberally, as it was initially.

## STANDARD OF REVIEW

All issues in this appeal are reviewed *de novo*.

This Court “review[s] the district court’s decision to grant summary judgment *de novo*, resolving all ambiguities and drawing all permissible factual inferences in favor of the party against whom summary judgment is sought.” FTC v. Moses, 913 F.3d 297, 305 (2d Cir. 2019) (internal quotation marks omitted); see also Auburn Hous. Auth. v. Martinez, 277 F.3d 138, 143 (2d Cir. 2002) (“Questions of statutory interpretation are reviewed *de novo*.”); Gayle v. Gonyea, 313 F.3d 677, 682 (2d Cir. 2002) (applying *de novo* review to a district court’s adoption of a magistrate’s R&R where the non-moving party timely filed objections to the R&R).

## ARGUMENT

### I. THE DISTRICT COURT ERRONEOUSLY DISMISSED MR. FISCHER'S COPYRIGHT MANAGEMENT INFORMATION CLAIMS.

This appeal raises an issue of first impression in the Second Circuit on the meaning of copyright management information (“CMI”) under 17 U.S.C. § 1202(c).

The Courts of Appeals have had few occasions to construe Section 1202. Although Section 1202 was enacted in 1998 as part of the Digital Millennium Copyright Act (“DMCA”), there are still “very few reported cases that examine the applicability of this section[.]” See Gordon v. Nextel Communs., 345 F.3d 922, 926 (6th Cir. 2003). For example, the Second Circuit “has not yet interpreted section 1202(b) in any fashion.” Mango v. BuzzFeed, Inc., 356 F. Supp. 3d 368, 376 (S.D.N.Y. 2019).

Although it is new, the legal issue here is not difficult. There “is nothing particularly difficult about the text of § 1202.” Murphy v. Millennium Radio Grp. LLC, 650 F.3d 295, 302 (3d Cir. 2011). Section 1202(c) defines CMI to include the name of either the “author of a work” or the “copyright owner of the work” when such a name is “conveyed in connection with” the work. 17 U.S.C. § 1202(c), (c)(2)-(3).

Here, Mr. Fischer is both the author and copyright owner of copyrighted advertising materials. He conveyed his name in connection with these materials by putting his name in the text of them. Thus, his name as included in this text is CMI.

The district court said as much initially, adopting the plain reading of Section 1202(c). Dkt. 65 at 14-16 [1JA 286-288]. Then, it reversed course, holding that Mr. Fischer's name could not be both CMI *and* an identifier of himself as the maker of his product. Dkt. 193 at 27-29 [SA 35-37].

The district court's later view was contrary to the statute's plain meaning. Section 1202(c)'s definition of CMI is "*extremely broad*, with no restrictions on the context in which such information must be used in order to qualify as CMI." Murphy, 650 F.3d at 302 (emphasis added).

Thus, the district court's reversal forced this appeal on whether Mr. Fischer's name is his name—whether "Fischer's" is the possessive form of Mr. *Fischer's* name.

- A. After initially holding that Mr. Fischer’s use of his own name was copyright management information, the district court contradicted itself.**

Mr. Fischer created copyrighted advertising materials that were used to sell his natural Bee Quick product. These materials read as follows:

**Fischer’s Bee Quick™**

This 100% Natural, non-toxic blend of oils and herb extracts works just like Bee Go® and it smells good! Fischer’s Bee Quick™ is a safe, gentle, and pleasant way to harvest your honey. Are you tired of your spouse making you sleep in the garage after using Bee Go®? Are you tired of using hazardous products on the bees you love? Then this is the product for you!

Dkt. 185 at 36 [SA 86]. Eventually, Defendants stopped shipping Bee Quick to favor a competing knock-off product that they had devised, called Natural Honey Harvester™. They also made a knock-off of Mr. Fischer’s advertising materials:

**Natural Honey Harvester™**

For years we have promoted the use of a natural product to harvest honey but an unreliable supply of such a product has forced us to come out with our own. This 100% Natural, non-toxic blend of oils and herb extracts works just like Bee Go® and it smells good! Natural Honey Harvester™ is a safe, gentle, and pleasant way to harvest your honey. Are you tired of your spouse making you sleep in the garage after using Bee Go®? Are you tired of using hazardous products on the bees you love? Then this is the product for you!

Id. (underlines added to indicate additions or changes). In other words, Defendants used his ad to promote their knock-off.

Mr. Fischer sued about this use of his copyrighted materials. 1304 Dkt. 1 [3JA 127-171]. He alleged that the removal of his name from the advertising—the removal of the word “Fischer’s”—violated the DMCA. 1304 Dkt. 23 at 19-23 [3JA 23-27]; see 17 U.S.C. § 1202.

The Forrests brought a Rule 12(b)(6) motion to dismiss. Dkt. 45 [2JA 102-103]. They disputed that Mr. Fischer’s use of his name in the ad constituted CMI as protected by the DMCA. Dkt. 47 at 16-18 [2JA 72-74]. While they admitted that “the text of section 1202 appears to define CMI quite broadly,” they asked the district court to fashion an extra-statutory narrowing of Congress’ meaning. Id. at 17 [2JA 73].

The district court denied the motion, refusing to endorse the Forrests’ “crimped definition of CMI” because it was “directly at odds with the broad definition set forth in the statutory text itself.” Dkt. 65 at 14 n.4 [1JA 286]. The district court conducted the following straightforward analysis to conclude that Mr. Fischer’s name as used in his advertising was CMI as a matter of law:

[T]he original text at issue contained the name “Fischer.” [...] Fischer’s name, although used to describe the product, also serves to identify the author of the work and therefore qualifies as CMI under the statute. [...] Moreover, these exhibits show that Brushy Mountain replaced the textual reference to “Fischer’s Bee-Quick” with the words “Natural Honey Harvester.” The exhibits therefore supply ample basis to state a claim under the DMCA.

Dkt. 65 at 15-16 [1JA 287-288] (emphasis added, citation omitted).

After the ruling, this legal aspect of Mr. Fischer's CMI claims seemed settled. Although Defendants later brought a motion for summary judgment on the CMI claims, Dkt. 172 [1JA 218-219], their arguments were limited to factual issues, Dkt. 177 at 26-29 [1JA 145-148]. Naturally, Mr. Fischer's opposition to summary judgment on the CMI claim was similarly focused on factual issues. Dkt. 179 at 26-29 [1JA 113-115].

Then, in their reply brief, Defendants resurfaced the legal issue, arguing that Mr. Fischer's name could not be CMI because they characterized his name in the advertising materials as a "product name[.]" Dkt. 181 at 9 [1JA 34]. Defendants cited no legal authority on this point. Id.

Nonetheless, this argument caught the eye of the magistrate judge who was tasked with issuing an R&R on the motion for summary judgment. Before oral argument, the magistrate asked the attorneys to "be prepared to discuss" what the district court had already decided, *i.e.*, whether CMI can also refer to a maker of a product. Dkt. 184 at 1 [1JA 25].

After oral argument, the magistrate judge recommended an about face. Dkt. 185 at 38-40 [SA 88-90]. In the R&R, the magistrate found it "inconceivable" that Mr. Fischer's use of his own name in the text of his ad could be CMI. Dkt. 185 at 39 [SA 89]. To the magistrate, Mr. Fischer's name in the ad

“is not a reference to the copyright owner[,]” but is “merely a reference to the product name[.]” Id.

Mr. Fischer timely objected to the R&R on both legal and factual grounds. Dkt. 188 at 6-8 [1JA 17-19]. But, the district court adopted the R&R. Dkt. 193 at 42 [SA 50].

The district court now reasoned that, to be CMI, a name must “connote” copyright ownership or authorship to the public. Id. at 28 [SA 36]. Mr. Fischer’s use of his name in the ad could not do so, it held, because Mr. Fischer’s name in the ad instead “conveys that Fischer is the owner and/or producer of that product.” Id.

In adopting the R&R, however, the district court directly contradicted its earlier ruling on the motion to dismiss. Years earlier, the district court had been clear: “Fischer’s name, although used to describe the product, *also* serves to identify the author of the work and therefore qualifies as CMI under the statute.” Dkt. 65 at 15 [1JA 287] (emphasis added).

Then, somehow, the district court thought that “[n]o reader” could read it this way—the very way the district court *itself* had read the advertising materials initially. Dkt. 193 at 27 [SA 35].

**B. Mr. Fischer’s name was copyright management information for his works.**

Mr. Fischer’s name as used in his advertising is plainly copyright management information (“CMI”). The text says so. See Section I.B.i, *infra*. Indeed, protecting Mr. Fischer’s name here furthers the Congressional purpose underlying Section 1202. See Section I.B.ii, *infra*. The fact that Mr. Fischer’s name happens to appear next to his product’s name does not matter, legally or pragmatically. See Section I.B.iii, *infra*.

Perhaps, the district court had policy concerns that CMI’s plain meaning would invite expansive liability. Such concerns are misplaced. They ignore Section 1202’s numerous limiting principles, and, furthermore, overlook how CMI functions to *avoid* copyright liability for unsuspecting third parties. See Section I.B.iv., *infra*.

i. Mr. Fischer’s name is copyright management information by the plain meaning of the statutory text.

CMI is defined in Section 1202(c). 17 U.S.C. § 1202(c). The definition is “***extremely broad***, with no restrictions on the context in which such information must be used in order to qualify as CMI.” Murphy, 650 F.3d at 302 (3d Cir. 2011) (emphasis added).

At issue here is whether the last name of a man, who is also the author and copyright owner of a work, is CMI when included on that work. His name plainly is. The statutory language here “has a plain and unambiguous meaning with regard to the particular dispute in the case.” See Robinson v. Shell Oil Co., 519 U.S. 337, 340 (1997).

For statutory interpretation, courts “begin with the text.” United States v. Rowland, 826 F.3d 100, 108 (2d Cir. 2016). Here, Section 1202(c) “enumerates eight categories” of information that count as CMI. 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 12A.09[A] (2018). Among those eight categories, two types of CMI plainly apply to Mr. Fischer’s name:

- (2) *The name of*, and other identifying information about, *the author* of a work.
- (3) *The name of*, and other identifying information about, *the copyright owner* of the work, including the information set forth in a notice of copyright.

17 U.S.C. § 1202(c)(2)-(3) (emphasis added). In other words, CMI “includes, *inter alia*, [...] the name of the author or copyright owner[.]” Playboy Enters. Int’l v. Mediatakeout.com LLC, No. 15 Civ. 7053 (PAE), 2016 U.S. Dist. LEXIS 29249, at \*10 (S.D.N.Y. Mar. 8, 2016).

Mr. Fischer’s name is the name of *both*. He is both the author and copyright owner of the pertinent copyrighted materials. Mr. Fischer is the author because he wrote the advertising materials, *i.e.*, because they owe their origin to *his* “act[s] of

authorship[.]” Cf. Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 347 (1991); see Dkt. 185 at 22 [SA 72] (recommending these advertising materials as copyrightable); Dkt. 193 at 42 [SA 50] (adopting the R&R in full).

Mr. Fischer is also the copyright owner. Because Mr. Fischer is the author, copyright ownership “vests initially” with him, 17 U.S.C. § 201(a), and he has not transferred his ownership, cf. 17 U.S.C. § 201(d)(1) (permitting transfer). Thus, Mr. Fischer’s name is both the name of the author and the name of the copyright owner with respect to the advertising materials.

Quite plainly then, Mr. Fischer’s name is CMI when conveyed with these advertising materials. See Rowland, 826 F.3d at 108 (2d Cir. 2016) (“If the meaning is plain, the inquiry ends there.”).

Below, Defendants attempted to introduce ambiguity into the meaning of a name. Defendants argued that the word “Fischer’s” in the advertisement was not Mr. Fischer’s name because it was not his full name, *i.e.*, James H. Fischer. Dkt. 181 at 9 [1JA 34]. They asked the district court to impute a full-name requirement. See id.

Neither the magistrate nor the district court adopted a full-name requirement. Yet both contrasted Mr. Fischer’s last name in the ad against his full name when recommending or granting summary judgment on CMI. Dkt. 193 at 27 [SA 35]; Dkt. 185 at 39 [SA 89].

The statute, however, says “name”—*not* full name. See 17 U.S.C. § 1202(c)(2)-(3). Indeed, it is not as though Congress is unaware of how to use the adjective “full” in the Copyright Act. Cf. 17 U.S.C. § 505 (allowing “recovery of *full* costs” (emphasis added)). Congress simply did not choose to require a full name.

Section 1202(c)(2)-(3) “does not forbid using abbreviations or short-form versions of the author’s [or copyright owner’s] name.” Bounce Exch., Inc. v. Zeus Enter., Ltd., No. 15cv3268 (DLC), 2015 U.S. Dist. LEXIS 165073, at \*10 (S.D.N.Y. Dec. 9, 2015).

To the contrary, Section 1202(c)(3), read in light of Sections 401-402, permits abbreviated names or even nicknames See 17 U.S.C. § 401(b)(3) (setting forth the name requirement for a notice of copyright); § 402(b)(3) (same).

This is because Section 1202(c)(3) “include[es] the information set forth in a notice of copyright.” 17 U.S.C. § 1202(c)(3). In turn, a name as included in a notice of copyright may be an “abbreviation” or a “generally known alternative designation” of a name. 17 U.S.C. §§ 401(b)(3), 402(b)(3). Therefore, Section 1202(c)(3) clearly does not require a full name because it incorporates other statutory sections—Sections 401 and 402—that expressly require less than a full name. Even a common nickname counts.

There is another statutory clue that CMI does not require a full name. Both Section 1202(c)(2) and Section 1202(c)(3) encompass “other identifying information” as part of the definition of CMI. 17 U.S.C. § 1202(c)(2)-(3); cf. Nimmer on Copyright § 12A.09[A][1]. Thus, Sections 1202(c)(2)-(3) hint at statutory purpose *in the text*: to protect “identifying information” about a copyright owner or author from removal. A last name is “identifying information” about the person named, after all.

Further still, the word “name” as used in Sections 1202(c)(2)-(3) is not used in some technical or formalistic sense. There is no “statutory definition” for the word name in Section 1202, so the word’s “common-sense meaning” applies. See Rowland, 826 F.3d at 108. By common sense, a last name is a name.

That common-sense meaning is why district courts have refused to invent an extra-statutory full-name requirement. For example, one company—“Empire Medical Review Systems, Inc.”—asserted that “Empire Medical” was its name and that use of those words in a work qualified as CMI. Empire Med. Review Serv’s v. CompuClaim, Inc., 326 F. Supp. 3d 685, 688, 693 (E.D. Wis. 2018). The district court agreed with the company, over the defendant’s contentions that “Empire Medical” was not “the author’s full name.” Id. at 393; see also Bounce Exch., Inc. 2015 U.S. Dist. LEXIS 165073, at \*10 (holding that the words “bounce” and

“bouncex” are “sufficiently linked to the plaintiff’s full corporate name[, Bounce Exchange, Inc.,] to constitute CMI”).

Beyond the plain text and context, it is clearer that a last name would suffice when read in light of the underlying purpose of protecting CMI. CMI is intended to be identifying information. See Section I.B.ii, *infra*. A last name is identifying information, even though it is not a full name.

There is no need to resort to excavating the statute’s purpose, however. Section 1202(c) is clear, so this Court should “enforce that language according to its terms.” See Arciniaga v. General Motors Corp., 460 F.3d 231, 236 (2d Cir. 2006).

“Fischer’s” is Mr. Fischer’s name. It’s his last name.<sup>2</sup>

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<sup>2</sup> To be CMI, information must also be “conveyed in connection with copies or phonorecords of a work[.]” 17 U.S.C. § 1202(c). This requirement is not at issue here because it was not raised below. Nor is this requirement subject to reasonable dispute with respect to the phrases that make up the advertising materials at issue in this appeal: “The term ‘conveyed’ in section 1202(c) is used in its broadest sense and [...] merely requires that the information be accessible in conjunction with, or appear with, the work being accessed.” Pierson v. Infinity Music & Entm’t, Inc., 300 F. Supp. 3d 390, 394 (D. Conn. 2018) (internal quotations omitted). Therefore, “by plain reading and common sense,” Mr. Fischer’s CMI met this requirement because it was embedded—quite literally “conveyed in”—the text of his advertising materials. See id. at 394-395; see also Gordon, 345 F.3d at 927 (6th Cir. 2003) (discussing CMI contained “within the individual illustrations”); ICONICS, Inc. v. Massaro, 192 F. Supp. 3d 254, 272 (D. Mass. 2016) (permitting CMI as “in-line references”).

ii. Mr. Fischer’s name fulfills the Congressional purpose underlying the statute because his name is identifying.

The DMCA’s legislative history further demonstrates why the name “Fischer’s” is CMI.

CMI is intended to serve a broad *identifying* function. CMI’s function is similar to the function of a “license plate.” Bruce A. Lehman et al., Intellectual Property and the National Information Infrastructure: The Report of the Working Group on Intellectual Property Rights, 235 (Sept. 1995) [*hereinafter* “White Paper”].<sup>3</sup>

A license plate by no means *warns* of the property rights in a car. Those property rights are presumed—as it is today presumed that most written materials are copyrighted. But, if you want to take a car for a joy ride, the license plate will help you to identify whom you had better ask first. CMI is similarly purposed. If you want to use a copyrighted work, CMI can help to *identify* rightsholders.

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<sup>3</sup> This source is essentially a form of legislative history for Section 1202: “Although many view the DMCA as implementing the WIPO treaties, in fact, §§ 1201 and 1202 were drafted prior to the treaties. President Clinton established the [...] Working Group on Intellectual Property Rights[.] [...] The Working Group held extensive hearings and wrote the Report of the Working Group on Intellectual Property Rights, just cited. Released in September, 1995, and known as the ‘White Paper,’ the Report presented a draft of §§ 1201 and 1202, and discussed the rationale for these sections[.]” IQ Group v. Wiesner Publ’g, Inc., 409 F. Supp. 2d 587, 594 (D.N.J. 2006).

CMI arose when policymakers were concerned about identifying owners and authors for the vast swathes of copyrighted materials on the internet. In the early 1990s, the Clinton Administration was concerned that that there was often no way for online users to *identify* a copyright owner because copyright notice and registration are optional. See White Paper 60-62.

Thus, in 1993, the Clinton Administration convened a blue-ribbon commission. White Paper 1-2. The blue-ribbon commission proposed that there be a sort of “license plate” to associate copyright holders with their works. White Paper 235. This license plate would help “consumers find and make authorized uses of copyrighted works.” Id.

These principles are applicable here. Mr. Fischer’s use of his name in his advertising materials furthers the CMI function. In addition to meeting the statutory definition of CMI, see Section I.B.i, *supra*, his name also fulfills the identifying *purpose* of CMI.

First, all else equal, the advertising materials conveyed in connection with the name “Fischer’s” will be more readily traced to Mr. Fischer himself than if his name was not on the work. With the CMI, someone trying to identify Mr. Fischer would have a last name to begin searching.

Second, the name “Fischer’s” serves an even more powerful identifying function when viewed in context. In context, a viewer of Mr. Fischer’s advertising

materials who wants to identify the copyright owner might try to search for “Fischer’s Bee Quick” at the Copyright Office’s website.

A keyword search for these words would return Mr. Fischer’s copyright registration. In turn, the Copyright Office’s records would show Mr. Fischer’s email, his phone number, and an address. Having the same name—“Fischer’s”—on the work would also serve to corroborate the Copyright Office’s records identifying him.

In these ways, the word “Fischer’s” serves CMI’s intended identifying purpose, clarifying who is and who is not the author and the copyright owner of Mr. Fischer’s advertising materials.

The district court failed to recognize this identifying purpose of Mr. Fischer’s CMI, however, because it confused CMI’s identifying purpose with the warning function of a notice of copyright.

Below, the district court erred when it held that CMI was about “notice.” Dkt. 193 at 27 [SA 35]. The district court erred because it conflated CMI’s identifying purpose with the function of a notice of copyright.

A notice of copyright is recognized in Sections 401-402. See 17 U.S.C. §§ 401-402. A notice of copyright serves a warning function. It is akin to a “no trespassing sign[.]” Paul Goldstein, Goldstein on Copyright §1.14.2 (2017 3d ed.).

The copyright notice is intended to “give reasonable notice of the claim of copyright.” 17 U.S.C. § 401(c).

Specifically, the © symbol itself is intended to warn of the copyright claim. That is why some courts have been sticklers that it be a © symbol, not merely a “c”. See, e.g., Holland Fabrics, Inc. v. Delta Fabrics, Inc., 2 U.S.P.Q.2d 1157, 1158 (S.D.N.Y. 1987).

At core, the magistrate and district court’s concern with Mr. Fischer’s CMI is that it did not fulfill this warning function. They were concerned that his CMI would not indicate Mr. Fischer’s claim of copyright in the advertising.

Section 1202’s CMI provisions, however, were not meant to simply regurgitate Sections 401-402 about notice of copyright.

Indeed, such a reading would make the definition of CMI superfluous: “Considering that the DMCA was passed expressly as an adjunct to preexisting copyright law, had Congress intended CMI to be equivalent to a notice of copyright, it could and would have said so.” Goldstein v. Metro. Reg’l Info. Sys., No. TDC-15-2400, 2016 U.S. Dist. LEXIS 106735, at \*25 (D. Md. Aug. 11, 2016). Congress didn’t.

Instead, Congress made clear the myriad ways that notice of copyright and CMI diverge.

A notice *must* have “three elements”—the © symbol, the year of first publication, and name of the copyright owner—so that it can *warn*. 17 U.S.C. §401(b). By contrast, CMI was not intended to have “standardized formats or content” because *identifying* information can take many forms—such as a possessive name like “Fischer’s”. See White Paper 236.

A notice of copyright must have a reasonably prominent placement so that it can *warn*. See 17 U.S.C. §§ 401(c), 402(c). That is why courts have been sticklers about a notice’s location. See, e.g., OA Bus. Publs., Inc. v. Davidson Publ. Co., 334 F.2d 432, 434 (7th Cir. 1964) (rejecting © notice placed on third page of publication). By contrast, CMI must merely be “conveyed in connection with” copies of a work. 17 U.S.C. § 1202(c). CMI can be subtly *identifying*, as Mr. Fischer’s CMI is.

Like a no trespassing sign, a notice’s prominent *warning* prevents copyright trespassers from claiming their infringement was innocent. 17 U.S.C. §§ 401(d), 402(d). By contrast, CMI has no such effect on the remedies of copyright infringement because Congress did not require all CMI to be prominent or even reasonably obvious. See generally 17 U.S.C. §§ 1202. That is why, even if few individuals notice “Fischer’s” is the author’s name, his name is still CMI.

Likewise, a copyright notice, to fulfill its function, must warn *directly*. It is not a successful warning system if it warns *after* the property right is infringed. By

contrast, CMI can be *indirectly* identifying. For example, the definition of CMI includes “[i]dentifying numbers or symbols *referring to* such information or *links to* such information.” 17 U.S.C. § 1202(c)(7) (emphasis added). Mere “links to such information”—URLs that need not contain any directly identifying information but instead link to identifying information—count as CMI.

This vast gulf between the statutory contours of Sections 401-402’s copyright notice and Section 1202’s CMI speaks to their different purposes and histories.

Notice of copyright originated in an era when only those publicly available materials bearing this © warning were protected under the 1909 Copyright Act. 2 *Nimmer on Copyright* § 7.02[C][1]. Under that rule, a *warning* function was imperative. There was no reason for anyone to assume that any work was copyrighted *unless* it bore a notice of copyright.

The situation has since changed. Today, a notice of copyright “*may* be placed” on copies of a work, but it is not necessary. 17 U.S.C. § 401(a); 17 U.S.C. § 402(a) (same). Today, even registering a copyright is *optional*. 17 U.S.C. § 408(a) (“Registration Permissive”). So, today, it is a good assumption that written materials are copyrighted unless one has determined that the materials are in the public domain.

The public policy problem today is not knowing whether materials are copyrighted. The problem is knowing who wrote them, who owns the copyright, and, from there, what the conditions of use are.

That's where CMI comes in.

The district court's understanding of CMI, however, would vitiate the DMCA's attempt to protect a wide plethora of copyright information by confining CMI to the formal requirements of copyright notice.

The district court's error is apparent in its own language. The district court stated that "CMI exists to inform the public that a work is copyrighted and by whom." Dkt. 193 at 27 [SA 35]. In that sentence, it conflates. Warning "that a work is copyrighted" is the job of a notice of copyright under Sections 401-402. Identifying "by whom" it is authored, and "by whom" the copyright is owned, is the purpose of CMI.

CMI, including Mr. Fischer's CMI, only needs to serve an identifying purpose. Thus, the district court erred in attempting to impose on Mr. Fischer's CMI a heightened warning function that is refuted by the broad definition in Section 1202(c).<sup>4</sup>

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<sup>4</sup> The statute is definite that notice of copyright is just one type of CMI. 17 U.S.C. § 1202(c)(1), (3) (CMI "include[es] the information set forth in a notice of copyright."). Indeed, copyright notice is a subset of the vast CMI definition.

iii. Mr. Fischer’s name is still his name, even though it is also used to describe himself as the maker of his product.

Below, the magistrate found it “inconceivable” that the name “Fischer’s” in the ad was CMI because the name was also used in relation to a product, *i.e.* Bee Quick. Dkt. 185 at 39 [SA 89].

The magistrate’s rationale was that most persons wouldn’t think of common household product names—Orville Redenbacher’s Popcorn or Kellogg’s Corn Flakes—as also having “any CMI significance.” *Id.*

The district court made largely the same point in adopting the R&R. Dkt. 193 at 27-28 [SA 35-36]. The district court held that the word “Fischer’s” conveys that Mr. Fischer is the “owner and/or producer of that product” but does not convey “authorship or copyright ownership” in the copyrighted works. *Id.* at 28 [SA 36].

Both erred. The definition of CMI has “no restrictions on the context in which such information must be used in order to qualify as CMI.” *Murphy*, 650 F.3d at 302 (3d Cir. 2011).

Information can certainly serve multiple roles. It can both identify who made a product while *also* identifying—for the onlooker with an eye toward copyright—the author or copyright owner of the advertising materials.

Other district courts have said as much, holding that trademarks are CMI if they meet Section 1202(c)’s definition. For example, one district court held that a

plaintiff “identified its authorship by including a trademark logo on its artwork.”  
GC2 Inc. v. Int’l Game Tech. PLC, 255 F. Supp. 3d 812, 822 (N.D. Ill. 2017).

To another, “some combination of a trade or brand name, a logo, and a website address” was CMI. Aaberg v. Francesca’s Collections, Inc., No: 17-CV-115 (AJN), 2018 U.S. Dist. LEXIS 50778, at \*20 (S.D.N.Y. Mar. 27, 2018). To a third, the defendant futilely argued that an in-line reference was unclear as to “whether the files are copyrighted, trade secrets, or both.” ICONICS, Inc., 192 F. Supp. 3d at 272 (D. Mass. 2016). Given that the work “could contain ***both*** trade secrets and copyrighted material, however, it [wa]s not clear why the inclusion of a trade secret marker negates the header’s status as CMI.” Id. (emphasis added).

The same is true here. Mr. Fischer’s name is both his name as copyright owner and his name as the person who makes the product.

Nothing about the trademarked product name—Bee Quick—negates the fact that Mr. Fischer’s name is his name. Nothing in the statutory text suggests that a name in possessive form is not a name or that a personal name near a product name is not a name. Instead, the statute broadly protects “identifying information” like Mr. Fischer’s name. See Section I.B.i, *supra*.

Indeed, the statute’s broad purpose to protect identifying information is still fulfilled when a name is placed near a product name. Thus, when the district court concluded that “[n]o reader” would understand Mr. Fischer’s name as a warning

of copyright, the district court implicitly imposed an extra-statutory requirement on CMI that Congress never intended to require. It is enough that the CMI be identifying. See Section I.B.ii, *supra*. And, CMI can be identifying while adjacent to a product name.

In sum, there is nothing mutually exclusive about one name identifying both advertising material and the maker of a product. The district got this right initially: “Fischer’s name, although used to describe the product, also serves to identify the author [and owner] of the work and therefore qualifies as CMI under the statute.” Dkt. 65 at 15 [1JA 287] (emphasis added). Then, at summary judgment, the district court erred.

Even if the primary meaning of “Fischer’s” is to identify Mr. Fischer as the maker of Bee Quick, Mr. Fischer’s status as maker of the product, in fact, makes Mr. Fischer more likely to be the owner of the copyright in the advertising for that product. Stated differently, the district court’s underlying distinction between product source and copyright owner is largely illusory in the advertising context. Often, a product’s source is the copyright owner for advertisements of that product.

Almost all advertisements’ text will be owned and authored by the individual or company that is the source of the product. Natural persons who write

advertisements for their own products, like Mr. Fischer did, will be both the product source and the copyright owner and author.

The same goes for companies that have their own employees develop the advertising materials, as a work for hire. See 17 U.S.C. §§ 101(1) (defining “work made for hire”), 201(b) (construing the “employer” as the legal “author” of copyright). In fact, the same would usually go for persons or companies who hire an outside ad agency to write the advertisement, if the company includes a work-made-for-hire clause or otherwise contracts for the transfer of copyright. See 17 U.S.C. §§ 101(2) (second definition of “work made for hire”), 201(d)(1) (transfer of copyright).<sup>5</sup>

Often, the company doing the advertising, not the ad agency, owns the copyright. Mad Men’s Don Draper may own the board room, but his clients own the ads.

Here, the district court differentiated product source and copyright source. However, it never took the extra step to consider whether they are meaningfully

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<sup>5</sup> In the rare situation where the product’s source never obtained copyright ownership (either initially or by transfer), the name of the product source would not be CMI. That situation is not present here. Regardless, there are important reasons to protect CMI broadly where it appears. CMI helps to identify owners. See Section I.B.ii, *supra*. And, that identifying function is important. See Section I.B.iv, *infra*.

different concepts *as applied here*. They aren't because product source is also often itself a *signal* of the advertisement's source.

Take the following excerpt of a promotional offer from the 1960s, the golden age of advertising:

**Collect 25¢ for 2 “Milk Pitcher Seals,” or 50¢ for 4 “Pitcher Seals”**

This year you can DOUBLE your Free Milk Money from [REDACTED]. Collect 25¢ from any two different color “Milk Pitcher Seals” specially-marked packages of [REDACTED], [REDACTED], [REDACTED], [REDACTED], [REDACTED] (see the full sample in this ad).<sup>6</sup>

Any guess as to the copyright owner in the ad? Without the pertinent name, it would be nearly impossible to know.

With a product source name—*Kellogg's*—the task of identifying the copyright owner is much easier:

**Collect 25¢ for 2 “Milk Pitcher Seals,” or 50¢ for 4 “Pitcher Seals”**

This year you can DOUBLE your Free Milk Money from *Kellogg's*. Collect 25¢ from any two different color “Milk Pitcher Seals” specially-marked packages of *Kellogg's* [REDACTED], [REDACTED], [REDACTED], [REDACTED] (see the full sample in this ad).<sup>7</sup>

Kellogg's is the maker of the products in the ad, like Mr. Fischer is in this case.

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<sup>6</sup> By separate motion, Mr. Fischer will seek judicial notice of this Google books link to the advertisement in *LIFE* Magazine: <http://tinyurl.com/y5gsfm5m> (redactions added).

<sup>7</sup> *Id.* (emphasis and redactions added).

Because Kellogg's is the company behind the products, it is also a good guess that it is the company behind the advertisement as well.

Likewise, it is a good guess that Mr. Fischer is behind the advertising because his name identifies him as the maker of Bee Quick.

Going further, because Kellogg's created or commissioned the advertisement, it is, in turn a good guess that Kellogg's owns the copyright in the advertisement. Likewise, it is a good guess that Mr. Fischer owns the advertising materials.

Ultimately, these guesses turn out to be correct. Try a keyword search of the Copyright Office's online records for "double your milk money kellogg":

The screenshot shows a web browser window with the URL <https://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First>. The page is titled "Copyright" and is the United States Copyright Office's Public Catalog. The search results are displayed under the "Basic Search" tab, showing 25 records per page for the query "double your milk money kellogg". The search criteria are: Search for: double your milk money kellogg; Search by: Keyword. The search results are currently empty. Below the search form, there are buttons for "Begin Search", "Reset", and "Set Search Limits".

**Public Catalog**  
Copyright Catalog (1978 to present)

**Basic Search** Other Search Options

Search for: double your milk money kellogg

Search by: Title (omit initial article A, An, The, El, La, Das etc.)  
Name (Crichton Michael; Walt Disney Company)  
Keyword  
Registration Number (for VAu 598-675 type vau000598675)  
Document Number (for V2606 P87 type v2606p087)  
Command Keyword

25 records per page Begin Search Reset Set Search Limits

**Search Hints**

- Works registered prior to 1978 may be found only in the [Copyright Public Records Reading Room](#).
- Can't find what you're looking for? Try our "Other Search Options".
- Search terms are not case sensitive.
- Search limits can be used with all "Search by:" options.

The above image shows a keyword search at the Copyright Office's website.<sup>8</sup> The top results are relevant:

**Copyright**  
United States Copyright Office

Help Search History Titles Start Over

### Public Catalog

Copyright Catalog (1978 to present)  
Search Request: Keyword = double your milk money kellogg  
Search Results: Displaying 1 through 25 of 10000 entries.

◀ previous 1 26 51 76 101 126 ... 9976 next ▶

*Your search retrieved more records than can be displayed. Only the first 10,000 will be shown.*

Resort results by: Relevance

#	Relevance	Full Title	Copyright Number	Date
[ 1 ]	■■■■	<a href="#">Double your milk money compliments of Kellogg. By Leo Burnett Company, Inc.</a>	RE0000744433	1968
[ 2 ]	■■■■	<a href="#">Double your milk money compliments of Kellogg / (In Life, June 14, 1968) KK207602 (1965)</a>	V2722P208	1991
[ 3 ]	■■	<a href="#">Free milk money, compliments of Kellogg's Corn Flakes, milk'n cereal. Ad no. M-2703. By Leo Burnett Company, Inc.</a>	RE0000705378	1967
[ 4 ]	■■	<a href="#">Free milk money, Corn Flakes. No. M-2628. By Leo Burnett Company, Inc.</a>	RE0000674841	1966
[ 5 ]	■■	<a href="#">Free milk money, Milk'n cereal. By Leo Burnett Company, Inc.</a>	RE0000643723	1965
[ 6 ]	■■	<a href="#">Free milk money, corn flakes [bowl of cereal in cow bank] By Leo Burnett Company, Inc.</a>	RE0000600689	1964
[ 7 ]	■■	<a href="#">Free milk money from Kellogg's Rice Krispies. Author of renewable matter: Leo Burnett Company, Inc.</a>	RE0000585207	1963
[ 8 ]	■■	<a href="#">Free milk money, get 50 cents cash to pay for more milk for your Kellogg's Corn Flakes / (In Ladies' Home Journal, Oct. 1969, p. 107) KK214716 (1969)</a>	V2722P208	1991
[ 9 ]	■■	<a href="#">Free milk money, get 50 cents cash to pay for more milk for your Kellogg's corn flakes. By Leo Burnett Company, Inc.</a>	RE0000770019	1969
[ 10 ]	■■	<a href="#">Swear your love / K. Loggins.</a>	PA0000156356	1982
[ 11 ]	■■	<a href="#">Swear your love / words &amp; music by Kenny Loggins.</a>	PAu000433107	1982
[ 12 ]	■■	<a href="#">All the way &amp; 82 other titles; musical compositions / written by Kenny Loggins and co-writers as noted.</a>	V3534D868	2006
[ 13 ]	■■	<a href="#">Milk money / Written by Bruce Lund.</a>	V3515D479	2004
[ 14 ]	■■	<a href="#">Milk money.</a>	V3481D422	2002
[ 15 ]	■■	<a href="#">Milk money.</a>	V3477D017	2001
[ 16 ]	■■	<a href="#">Milk money.</a>	V3466D247	2001

<sup>8</sup> Judicial notice will be requested for the existence of this search and its results by separate motion. No link to this search is directly possible because Copyright Office search links expire.

Then, clicking the top result identifies Kellogg's as the copyright owner, even though an ad agency drafted the promotional ad:

The screenshot shows a web browser window with the URL `cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?v1=1&ti=1,1&Search_Arg=double%20your%20milk%2...`. The page header features the Copyright Office logo and navigation buttons: Help, Search, History, Titles, and Start Over. The main content area is titled "Public Catalog" and displays search results for the keyword "double your milk money kellogg". It shows "Search Results: Displaying 1 of 10000 entries" and includes "previous" and "next" navigation buttons. A "Labeled View" button is also present. The search result details include:  
**Title:** *Double your milk money compliments of Kellogg. By Leo Burnett Company, Inc.*  
**Relevance:** ■■■■  
**Type of Work:** Visual Material  
**Registration Number / Date:** RE0000744433 / 1996-12-20  
**Renewal registration for:** KK0000207602 / 1968-06-10  
**Title:** Double your milk money compliments of Kellogg. By Leo Burnett Company, Inc.  
**Copyright Claimant:** Kellogg Company (PWH)  
**Copyright Note:** C.O. correspondence.  
**Variant title:** Double your milk money compliments of Kellogg.  
**Names:** [Leo Burnett Company, Inc.](#)  
[Kellogg Company](#)  
Below the details are another set of "previous" and "next" buttons, and a "Save, Print and Email (Help Page)" section with a dropdown menu for "Full Record" and "Format for Print/Save", and an email input field with an "Email" button. The footer contains navigation links: Help, Search, History, Titles, Start Over, and a list of links including Contact Us, Request Copies, Get a Search Estimate, Frequently Asked Questions (FAQs) about Copyright, Copyright Office Home Page, and Library of Congress Home Page.

To the magistrate, it was “inconceivable” that a product source, like Kellogg’s, could have any CMI significance. Respectfully, the Kellogg’s example shows exactly how this might work.

There is nothing mutually exclusive about being a source identifier for a product and an advertisement. A name is capable of fulfilling both roles. Even if the product source seems like a primary role, that role also signals the CMI role.

The district court erred in holding otherwise.

iv. There are important policy reasons to protect copyright management information broadly and the statute contains meaningful limiting principles to avoid overbroad liability.

It is possible that the magistrate and district court were concerned that fidelity to the text of Section 1202 would invite over-expansive liability. Both intimated at such concerns.

In fact, the magistrate seemed possibly exasperated by a hyperbolic understanding of Mr. Fischer's DMCA claims:

The DMCA's expansive definition of CMI cannot trigger liability any time a person's name is contained in a copyrighted work without reference to how that information was used and displayed on the work itself.

Dkt. 185 at 38 [SA 88].<sup>9</sup> Both judges somehow saw Mr. Fischer's claim—which is anticipated by the plain text—as “inconceivable.” Id.; Dkt. 193 at 28 [SA 36].

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<sup>9</sup> The magistrate was hyperbolic because Mr. Fischer's claim is not about any name. It's about removal of an author's or copyright owner's name plus all the other § 1202 elements, including two mental states and underlying infringement.

The district court need not have worried because the definition of CMI is a threshold matter. There are meaningful limiting principles that Congress included in Section 1202(b). If CMI’s definition is the liability onramp, there are a multitude of offramps.

First, Section 1202(b) only creates liability for *unauthorized* acts. See 17 U.S.C. § 1202(b) (“without the authority of the copyright owner or the law). As a result, parties could contract to obtain authorization, presumably including through contracts of adhesion and terms of use.

Second, Section 1202(b) also has *a double scienter requirement* that is a far cry from copyright’s strict liability. This Court has already recognized the “double scienter requirement” of Section 1202. Krechmer v. Tantaros, 747 F. App’x 6, 9 (2d Cir. 2018). Each subsection of Section 1202(b) has a high knowledge requirement itself—requiring “intentionally” or “knowing” acts. 17 U.S.C. § 1202(b)(1)-(3). Then, there is a catch-all additional mental state requirement that applies to all three violations:

knowing, or, with respect to civil remedies under section 1203, having reasonable grounds to know, that it will induce, enable, facilitate, or conceal

17 U.S.C. § 1202(b). Thus, two types of mental states are required for a Section 1202(b) violation.

Third, the second mental state requirement is with respect to an underlying copyright infringement. In a way then, Section 1202(b) is cabined just like secondary copyright liability: the underlying infringement must be proven. See generally Stevens v. CoreLogic, Inc., 899 F.3d 666, 673-676 (9th Cir. 2018) (discussing this requirement).

Fourth, there is a nexus requirement between the underlying copyright infringement and the CMI violation in Section 1202(b). The 1202(b) violation must “induce, enable, facilitate, or conceal an infringement.” 17 U.S.C. § 1202(b) (after 1202(b)(1)-(3)).

These four limiting principles exist in addition to the CMI definition, among others. In sum, ruling for Mr. Fischer here would not be opening Pandora’s Box to liability for any removal of any name.

There is an additional upside to these limiting principles: they don’t contradict the plain meaning (as well as the underlying purpose) of Section 1202. Rather, they show fidelity to the text and to CMI’s purpose, unlike the district court’s ruling below.

There is also a grand irony in the district court’s worry about overbroad liability. CMI helps to avoid liability by ensuring accurate tracing of works to rightsholders. This role is especially important because copyright notice and

registration are permissive. 17 U.S.C. §§ 401-402, 408(a). A broad protection of CMI, therefore, helps to prophylactically *avoid* copyright infringements.

This case is a prime example. Third-party sellers—the Honey Hole and C&T Bee Supply—used Mr. Fischer’s ad to sell Defendants’ knock-off product. Dkt. 50 at 46, 48 [2JA 50, 52]. The Honey Hole continues to unwittingly infringe to this day.<sup>10</sup> Likely, these third parties would not have infringed had the word “Fischer’s” been allowed to serve its identifying function, *i.e.*, had Defendants not removed it. Robust CMI protection helps to limit downstream copyright infringement by easing identification of copyright owners and authors. This public protection feature of CMI is crucial because “strict liability is the rule in copyright cases.” 3 Goldstein, Goldstein on Copyright §7, at 7:0:1.

By contrast, with its double scienter requirement, Section 1202(b) only hits the deserving, like Defendants here.

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<sup>10</sup> See The Honey Hole, Natural Honey Harvester, 8oz, <http://www.the-honey-hole.com/Extra-Pages/Gifts/Natural-Honey-Harvester,-8oz> (accessed Apr. 2, 2019).

## **II. THE DISTRICT COURT ERRONEOUSLY DISMISSED MR. FISCHER'S COPYRIGHT INFRINGEMENT CLAIMS.**

Section 412 bars statutory damages for infringements that “commenced” before a work’s registration. 17 U.S.C. § 412.

Here, no pre-registration infringements occurred. *Factually*, there are genuine issues of material fact regarding when infringement began. See Section II.B.i, *infra*. *Legally*, Defendants’ pre-registration actions are not infringements of copyright because there was a license. See Section II.B.ii, *infra*.

In addition, Section 412 does not bar all remedies. Therefore, the district court should *not* have barred all relief under Section 412. See Section II.C, *infra*.

### **A. The district court granted summary judgment on Mr. Fischer’s copyright infringement claims due to Section 412.**

Relying on Section 412, Defendants urged dismissal of Mr. Fischer’s copyright infringement claims at summary judgment. Dkt. 177 at 17-19 [1JA 136-138]. The magistrate then recommended that Section 412 bar Mr. Fischer from *any* recovery for Defendants’ years of infringements. Dkt. 185 at 23-30 [SA 73-80]. Mr. Fischer objected. Dkt. 188 at 2-6 [1JA 13-17].

Over his objections, the district court adopted the R&R in full. Dkt. 193 at 11-22 [SA 19-30]. This was error.

**B. Section 412 does not apply here.**

Section 412 only applies if there were pre-registration infringements. 17 U.S.C. § 412. Here, however, no pre-registration infringements occurred.

i. The record does not support any infringing activity prior to Mr. Fischer's registration.

The effective date of Mr. Fischer's copyright registration is February 7, 2011. 1304 Dkt. 50 at 53 [2JA 276]. The district court found that there were two types of infringements prior to this date:

- (1) Public Distribution: Defendants purportedly infringed before Mr. Fischer's registration by distributing the 2011 product catalog. See Dkt. 193 at 14-19 [SA 22-27].
- (2) Public Display: Defendants also purportedly infringed before Mr. Fischer's registration by continuing to use Mr. Fischer's copyrighted advertising materials on Brushy Mountain websites after December 10, 2010. See id.

Each purported infringement will be addressed in turn.

**First**, the district court erroneously found that Defendants publicly distributed their 2011 product catalog before registration.

This finding was based *entirely* on the declaration and exhibits of Ms. Amanda Twete. See Dkt. 185 at 5 [SA 55] (relying on Twete Declaration);

Dkt. 193 at 12-14 [SA 20-22] (same). Ms. Twete was a mailroom supervisor at the company that printed Defendants' 2011 product catalogs. Dkt. 177-7 at 2-7 [1JA 162-167].

The district court did not view Ms. Twete's declaration and exhibits with the summary judgment standard in mind. It did not "resolve all ambiguities and draw all permissible inferences in favor of the non-moving party," *i.e.*, in favor of Mr. Fischer. Dillon v. Morano, 497 F.3d 247, 251 (2d Cir. 2007) (internal quotations omitted).

There are important ambiguities in Ms. Twete's declaration. Ms. Twete's declaration does not state *to whom* her company initially shipped the 2011 catalogs. This is important because, if the 2011 catalog was not publicly distributed *before* February 7, 2011, then Section 412 does not apply.

Ms. Twete is clear that the printer would have shipped wherever Defendants had instructed. Dkt. 177-7 at 3 ¶ 4 [1JA 163] ("These catalogs would have been mailed to individuals or entities contained on a mailing list provided by Brushy Mountain Bee Farm, Inc."). But, Ms. Twete does not specify *to whom* Defendants had instructed the 2011 catalogs be *initially* shipped. Her declaration provides no details.

One possibility is that Defendants instructed that the first shipment(s) of catalogs be shipped *to them* in North Carolina. This shipment to Defendants would

*not* be a public distribution, and so would not be a *pre*-registration infringement. See 17 U.S.C. § 106(3) (*public* distribution right). On this possibility, Section 412 would not apply.

Ms. Twete’s exhibits support this possibility. Her first exhibit is an Excel shipment log. Dkt. 177-7 at 5 [1JA 165]. In the field for the “Customer / Job Name” (Column B), the spreadsheet identifies the customer as “BRUSHY MOUNTAIN BEE FARM” and the job as “2011 CATALOG” (Cell B156). *Id.*

Ms. Twete’s second exhibit is the “job ticket” that gives some details regarding where the catalogs were sent. Dkt. 177-7 at 3 ¶ 5 [1JA 163]. Towards the bottom center, this job ticket indicates that the catalogs were sent from the “Printing Plant” to “Customer”. *Id.* at 7 [1JA 167].

The printing company’s “Customer” was “BRUSHY MOUNTAIN”, as Ms. Twete’s first exhibit confirms. This second exhibit suggests, therefore, that the initial shipments of catalogs were sent *to Defendants* in North Carolina.<sup>11</sup>

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<sup>11</sup> Perhaps, one could argue that “Customer” is ambiguous. One might read it as *Ms. Twete’s* customer, *i.e.*, Brushy Mountain. Or, one might read it as *Brushy Mountain’s* customers, *i.e.*, the public. The first reading is better because the word “Customer” is singular and because one would think that the word “Customer” is consistent between exhibits. Regardless, even if the word “Customer” is ambiguous, it must be read in favor of Mr. Fischer at summary judgment. Additional potential ambiguity *supports*, rather than hinders, Mr. Fischer.

Thus, reading Ms. Twete’s declaration and exhibits closely, they suggest that Defendants had not publicly distributed the 2011 catalogs before February 7, 2011. Instead, read in Mr. Fischer’s favor, they indicate that the printing company, Ms. Twete’s employer, printed the catalogs and shipped them directly to its customer, *i.e.*, to Brushy Mountain. Critically, shipping directly to Defendants at Brushy Mountain is not an infringement. 17 U.S.C. § 106(3).

As such, only later distributions, *i.e.*, post-registration distributions, would be infringing distributions to the public. Such post-registration public distributions would infringe Mr. Fischer’s copyrights but would not trigger Section 412.

There is a further ambiguity in Ms. Twete’s declaration and exhibits about when the 2011 catalogs arrived to wherever they were sent.

There are two possible readings. One possible reading is that the catalogs arrived pre-registration. Ms. Twete declares that some of the 2011 catalogs were initially “shipped on January 21, 2011.” Dkt. 177-7 at 3 ¶ 5 [1JA 163]. She expected that some catalogs would have been received “within 7-14 days from the shipment date[.]” Id. at 3 ¶ 6.

On this reasoning, the initial catalog shipments would have arrived, at the latest, on February 4, 2011—fourteen days after January 21. This reading would result in the 2011 catalogs arriving prior to Mr. Fischer’s copyright registration.

There is another possible reading, however. Ms. Twete’s second exhibit shows two potential shipment dates. There is the “Ship Date: 1/24/2011 16:00” and the “Ship Actual: 1/21/2011 00:00”. Dkt. 177-7 at 7 [1JA 167]. Ms. Twete nowhere clarifies the distinction between these two dates. See generally id. at 2-3 [1JA 162-163].

This Court need only recognize that these two dates on Ms. Twete’s exhibit introduce ambiguity regarding when the shipment actually occurred, January 21 or January 24.<sup>12</sup> And, this later shipment date—January 24, 2011—is important.

Reading the ambiguity in favor of Mr. Fischer, the shipment would have occurred on January 24, 2011. Then, considering Ms. Twete’s fourteen-day window for the shipment to arrive at its destination(s), the catalogs did not arrive to wherever they were going until February 7, 2011—the effective date of Mr. Fischer’s copyright registration.

On this reading, the 2011 catalogs would not have arrived anywhere until the very date that Mr. Fischer’s works were registered. For that reason also, Section 412 does not apply here.

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<sup>12</sup> The declaration also misidentifies where the catalogs shipped from. Ms. Twete says the catalogs shipped from Aberdeen, North Dakota. Dkt. 177-7 at 3 ¶ 6 [1JA 163]. There is no Aberdeen, North Dakota. It’s Aberdeen, South Dakota. Minor details matter because the minutiae of shipment are key to this issue.

In sum, there are two material ambiguities in Ms. Twete's declaration and exhibits: *to whom* the catalogs were initially sent and *when*. Each ambiguity is independently material. Under the appropriate application of the summary judgment standard, the district court could not hold that Section 412 applies based on Ms. Twete's declaration and exhibits because they do not establish any pre-registration public distribution of infringing copies.

**Second**, the district court held that Defendants' failure to remove Mr. Fischer's copyrighted materials from Brushy Mountain websites after December 10, 2010, amounted to infringing public displays that pre-dated the copyright registration. This was a factual error.

The district court's analysis stems from a December 10 email by one of Defendants' employees to Mr. Fischer. 1304 Dkt. 50 at 52 [2JA 275]. The email reads:

From: Betsy [betsy@brushymountainbeefarm.com]  
Sent: Friday, December 10, 2010 10:45 AM  
To: James Fischer; James Fischer  
Subject: Bee-Quick Return

Hi Jim,  
Regretfully, I am the messenger informing you (per Steve & Shane) that we are returning the BEE QUICK (7oz and Gallon). We sent out customer backorders and are returning the remainder to you.

I was not informed that we were discontinuing Bee-Quick in our 2011 catalog, nor previously requested to cancel my order with you.  
Please provide the address you need to have the Bee-Quick sent to.

Thanks,  
Betsy

Id.

Assuming *arguendo* that the email was a rescission or termination of the distributor-supplier relationship, there was still no pre-registration infringement. A termination of the contract does not entail immediate unwinding of the contractual relationship (and associated intellectual-property rights).

Contract law does not move so fast. Instead, when the timeframe is not expressly laid out in a contract, contract law infers a “reasonable time”:

When a contract does not specify time of performance, the law implies a reasonable time. What constitutes a reasonable time for performance depends upon the facts and circumstances of the particular case.

Savasta v. 470 Newport Assocs., 623 N.E.2d 1171, 1172 (N.Y. 1993) (internal citations omitted); see also Schwartz v. Nat’l Comput. Corp., 345 N.Y.S.2d 579, 582 (App. Div. 1973) (“Prompt action in rescinding does not mean immediately, but within a reasonable time[.]”).

What is true of performance of a contract is also true of ending one. For termination, without “any controlling contract provision fixing the duration of a contract, the law will deem the contract to be terminable within a ‘reasonable’ period of time.” U.S. Surgical Corp. v. Or. Med. & Surgical Specialties, Inc., 497 F. Supp. 68, 71 (S.D.N.Y. 1980).

Critically here, what constitutes “a reasonable time is a fact question.” Lerner v. Lerner Corp., 750 A.2d 709, 714 (Md. Ct. Spec. App. 2000). What is reasonable “depends on the facts and circumstances.” Schwartz, 345 N.Y.S.2d at

582. Various factual aspects of a case mean “reasonableness” must “by its very nature be determined on a case-by-case basis.” Rodrigues NBA, LLC v Allied XV, LLC, 83 N.Y.S.3d 650, 652 (App. Div. 2018) (internal citations and quotations omitted, emphasis added).

Therefore, what is a reasonable time “is clearly an issue of fact, which can be resolved only at trial.” Landow-Luzier Co. v. Grey, 34 Misc. 2d 1061, 1066 (N.Y. Sup. Ct. 1962).

This appeal, however, is not an appeal of a trial. It is an appeal of summary judgment. And, at summary judgment, Mr. Fischer was the non-movant, meaning the district court “must accept his version of the facts.” Schmidt v. McKay, 555 F.2d 30, 38 (2d Cir. 1977).

Particularly, the summary judgment standard would mean accepting Mr. Fischer’s version of the facts about the wind-down period. On this issue, that would mean accepting a reasonable interpretation of December 10, 2010, to February 7, 2011 as a reasonable wind-down period for Defendants’ and Mr. Fischer’s supplier-distributor relationship after it was terminated.

A two-month wind-down is a reasonable period. In contract law, a reasonable time period can certainly be “a few months.” Boone Assocs., L.P. v. Leibovitz, 786 N.Y.S.2d 518, 519 (App. Div. 2004). In a case like this one involving an “oral distributorship agreement,” it was reasonable to infer “a three-

*month* wind-down period” after notice of termination of the relationship. UMS Solutions, Inc. v Biosound Esaote, Inc., No. 11590/10, 2010 N.Y. Misc. LEXIS 7106, \*65 (N.Y. Sup. Ct. July 15, 2010) (emphasis added).

Thus, viewing the wind-down period in Mr. Fischer’s favor, there remains a genuine issue of material fact about the reasonable length of a wind-down period, even if termination happened on December 10, 2010.

Moreover, there are three case-specific reasons why it is particularly reasonable to view this December 10-February 7 period as included in a wind-down period:

- The parties appeared to continue the supplier-distributor relationship during December 10-February 7. Defendants continue to exclusively stock, sell, and ship Bee Quick in this product category until at least the end of February 2011. See Dkt. 180-5 at 12 [1JA 85].
- The type of property purportedly infringed at that time—advertising materials—was used to *further* Mr. Fischer’s interest in selling off remaining inventory pursuant to the supplier-distributor relationship during the wind-down period.
- Another reason to view the wind-down period as at least a few months is that Mr. Fischer did not insist on a sooner take-down. In response to the email, Mr. Fischer made no immediate insistence regarding the use of his

works online. He acquiesced in a wind-down period for his work—  
acquiescing in the public display of his works for that timeframe.

It is clearly reasonable to think that a nearly decade-long supplier-distributor relationship might have taken some time to wind-down. The district court erred in holding otherwise.<sup>13</sup>

ii. Regardless, any potentially infringing activities were breaches of contract, not infringement.

Under this Court’s jurisprudence, conduct that might be considered copyright infringement in the absence of a non-exclusive license between parties, is treated as breach of contract where such a license exists. See Graham v. James, 144 F.3d 229, 236 (2d Cir. 1998). Thus, given the then-existing license between parties, there could be no pre-registration copyright infringement that triggers Section 412.

The district court’s grant of summary judgment under Section 412 was misplaced as a legal matter, due to this Circuit’s rule established in Graham. Breach of contract, not copyright infringement, is the result where the copyright

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<sup>13</sup> The district court suggested that Mr. Fischer kept changing his legal theories. He did not. He pled a breach of contract claim in the alternative with his complaints.

owner has granted to defendant a “a nonexclusive license” to use his copyrighted material. Graham, 144 F.3d at 236. The general rule is that the presence of such a license *precludes* copyright infringement. Id.

The district court did not properly conduct an analysis to determine the scope of that license between the parties. It did not look to state law as it should have. Cf. Bartsch v. Metro-Goldwyn-Mayer, Inc., 391 F.2d 150, 153 (2d Cir. 1968). As such, it did not engage the fact that under New York law there is “a presumption” that the terms of a contract are covenants rather than conditions. Graham, 144 F.3d at 237 (citing Grand Union Co. v. Cord Meyer Dev. Co., 761 F.2d 141, 147 (2d Cir. 1985)).

That oversight is imperative because violations of covenants will “give rise only to contract remedies[.]” 3 Paul Goldstein, Goldstein on Copyright § 5 at 5:3.5. Graham itself found that the “inclusion of a notice crediting [licensor’s] authorship” was to be considered a covenant, not a condition. 144 F.3d at 237.

Yet, the district court did not differentiate between conditions and covenants. Had the district court conducted that analysis, after Mr. Fischer repeatedly raised the issue below, it would have mattered. As in Graham, here, the parties “orally agreed to the licensing agreement and did not clearly delineate its conditions and covenants.” Id.

Moreover, “rescission d[oes] not occur automatically without some affirmative steps” by the *licensor*. Id. at 237-238. Prior to February 7, however, Mr. Fisher did not take any affirmative steps to rescind the license. Thus, any purportedly infringing acts were, at most, breaches of contract. Section 412 would not be implicated. The district court erred in employing Section 412 to preclude statutory damages, below.<sup>14</sup>

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<sup>14</sup> The district court refused to address Mr. Fischer’s Graham v. James objections to the R&R, viewing them as a new argument. Dkt. 193 at 18 n.7 [SA 26]. Respectfully, the district court lost sight of its labyrinthian docket here. The parties had discussed Graham v. James much earlier in the case. See 1304 Dkt. 14 at 13 [3JA 113] (citing Graham); 1304 Dkt. 20 at 15 [3JA 90] (same). Therefore, the district court erred in refusing to reach the merits of this argument. Mr. Fischer clearly at least pled this argument in the alternative insofar as he repeatedly asserted claims for breach of contract. The only contract here was an oral license.

**C. Even if Section 412 applied, Mr. Fischer is still entitled to declaratory relief.**

Section 412 by its plain terms only bars statutory damages and attorney's fees. 17 U.S.C. § 412.

Below, the magistrate and district court denied all relief on the copyright infringement claims. Dkt. 185 at 24-30 [SA 74-80]; Dkt. 193 at 14-22 [SA 22-30]. Their theory was that Mr. Fischer had elected to receive statutory damages, and that he had foreclosed all other forms of monetary relief.

This was error. Defendants stipulated to cease using Mr. Fischer's copyrighted materials. See Dkt. 185 at 31 [SA 81]. In other words, Mr. Fisher obtained what is functionally a consent decree forbidding Defendants from further infringement of his works. It was this functional consent decree that explains why the magistrate judge considered injunctive relief to be moot: Defendants had already agreed to voluntarily change their legal position with respect to Mr. Fischer to end the lawsuit.

In such a situation, the most the district court should have done is grant partial summary judgment. Section 412 certainly does not bar all forms of relief, and Mr. Fischer, as the prevailing party who obtained a functional consent decree, should have been entitled to receive declaratory relief, to tax costs (and preclude Defendants from asserting any recovery of costs and fees).

Emphatically, the *only* way that Section 412 applies is if Defendants are infringing, albeit too early to be subject to statutory damages. Thus, Defendants have all but conceded that they have infringed.

Respectfully, if this Court does not fully reverse summary judgment applying Section 412, this Court should, in the alternative, partially reverse the grant of summary judgment and remand for entry of judgment in Mr. Fischer's favor on the copyright infringement claims regardless of how this Court decides on Section 412.

This would permit Mr. Fischer to tax costs, to avoid litigating fees, and to obtain the subjective satisfaction of a judgment rendered in his favor, declaratory relief.

### III. THE DISTRICT COURT ERRONEOUSLY DISMISSED MR. FISCHER'S TRADEMARK CLAIMS.

Below, the magistrate decided that Mr. Fischer had not sufficiently pled a trademark infringement claim. Dkt. 185 at 40-42 [SA 90-92]. The district court did not separately address the matter, adopting the R&R in full. Dkt. 193 at 42 [SA 50].

Initially, Mr. Fischer had proceeded *pro se* and had pled his trademark infringement claims in his *pro se* capacity. The district court ruled that Mr. Fischer's First Amended Complaint had "stated a claim for trademark infringement[.]" Dkt. 65 at 19 [1JA 291].

Later, Mr. Fischer retained counsel.

Mr. Fischer's counsel sought to amend, for a Third Amended Complaint. However, Mr. Fischer's counsel was permitted only to amend the parties named and was not at liberty to amend or repackage the legal theories. Dkt. 109 at 2 [1JA 224] ("Plaintiff's motions [to amend] are granted to the extent that they seek to add Brushy Mountain Bee Farm, Inc. as a defendant in both actions."). As such, Mr. Fischer's counsel did not alter the *pro se* pleadings of Mr. Fischer's trademark infringement claims.

Subsequently, a separate magistrate deemed that Mr. Fischer failed to plead trademark infringement. Dkt. 185 at 41 n.26 [SA 91]. Although the magistrate noted that Mr. Fischer had successfully pled trademark infringement in his *pro se* pleadings, the magistrate then held that Mr. Fischer was not entitled to a liberal *pro se* pleading after his counsel's appearance, even though his counsel had not drafted those pleadings. Mr. Fischer had. Id.

This was error.

When Mr. Fischer's counsel inherited the case, he also inherited Mr. Fischer's existing *pro se* pleadings about trademark. No matter how "inartfully pleaded," a *pro se* complaint "must be held to less stringent standards than formal pleadings drafted by lawyers[.]" Erickson v. Pardus, 551 U.S. 89, 94 (2007) (emphasis added); cf. FRCP 8(e) ("Pleadings must be construed so as to do justice.").

Respectfully, the Erickson standard would have served justice here.

The magistrate applied a heightened pleading standard to dismiss what was in effect a *pro se* pleaded claim of trademark infringement—notably, a *pro se* pleading which the district court had previously held sufficiently pleaded that claim. Dkt. 65 at 19 [1JA 291].

The magistrate deemed that change in standard to be outcome determinative regarding Mr. Fischer’s trademark infringement claim. Dkt. 185 at 41 n.26 [SA 91].

This is no harmless procedural error: “Summary judgment in a trademark action may be appropriate [...] where the undisputed evidence would lead only to one conclusion as to whether confusion is likely.” Cadbury Beverages, Inc. v. Cott Corp., 73 F.3d 474, 478 (2d Cir. 1996) (emphasis added).

Respectfully, the facts of both trademark infringement and trademark counterfeiting were pled below. In fact, all three amended versions of the complaint expressly state on their first page that “[t]his is an action for: (1) copyright infringement, trademark infringement, false designations of origin, false descriptions, and unfair competition under Federal law[.]” 1304 Dkt. 23 at 1 [3JA 5] (emphasis added); 1304 Dkt. 50 at 1 [2JA 5] (same); 1304 Dkt. 89 at 1 [2JA 176] (same).

Instead of barring Mr. Fischer’s claims through pleadings practice, the district court should have applied Polaroid to see whether there was a genuine issue of material fact. See Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961) (trademark infringement factors).

In that analysis, Tiffany and Co. v. Costco Wholesale Corp., 127 F. Supp. 3d 241 (S.D.N.Y. 2015), would be closely on point. Tiffany involved similar facts to those here: (1) defendants who use identical marks to plaintiffs; (2) point-of-sale displays that make the goods appear identical; and (3) weeks-long delivery timeframes before customers realize. Thus, Tiffany is closely on point.

Moreover, Tiffany would go a long way toward demonstrating that the district court erred in its analysis of the trademark counterfeiting claims. Defendants were using a photo of Mr. Fischer's own product to sell a deliberate knock-off of his product. Tiffany should have controlled this case.

Thus, the district court erred in many ways on Mr. Fischer's trademark claims. It erred in how it construed the pleadings. And, it erred in how it applied the law. It should be reversed.

## CONCLUSION

This Court should reverse and remand.

Date: August 19, 2019

Respectfully submitted,

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## CERTIFICATE OF COMPLIANCE

This Brief contains **12,086** words, excluding the parts of the brief exempted by court rule.

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## CERTIFICATE OF SERVICE

I hereby certify that on August 19, 2019, I electronically filed the foregoing APPELLANT'S OPENING BRIEF with the Clerk of the Court for the United States Court of Appeals for the Second Circuit by using the appellate CM/ECF system.

Participants in the case who are registered CM/ECF users will be served by the appellate CM/ECF system.

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