

**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF FLORIDA
PENSACOLA DIVISION**

GENESIS MOVIE LLC)	
)	
Plaintiff,)	
)	
v.)	CASE NO: 3:20-cv-5097
)	
SEVENFOLD FILMS, LLC and)	
RALPH STREAN,)	
)	
Defendants.)	
)	

MOTION TO DISMISS

COMES NOW Defendants, Sevenfold Films, LLC and Ralph Strean, by and through undersigned Counsel, and move this Honorable Court to dismiss the complaint herein pursuant to Federal Rule of Civil Procedure 12(b), and if said motion is not granted in certain counts, moves in the alternative for a more definite statement under Rule 12(e), stating:

1. The complaint should be dismissed under Rule 12(b) for improper venue, as the proper venue for this action is in the Middle District Court for the State of Florida.
2. Count I (Cybersquatting) of the complaint should be dismissed under Rule 12(b) for failure to state a claim upon which relief can be granted, and if said motion is not granted Defendants move in the alternative for a more definite statement under Rule 12(e).

3. Count II (Copyright Infringement) and Count III (Copyright Ownership) of the complaint should be dismissed under Rule 12(b) for failure to state a claim upon which relief can be granted, and if said motion is not granted Defendants move in the alternative for a more definite statement under Rule 12(e).

4. Count IV (Breach of Production Agreement), and Count V (Conversion) of the complaint should be dismissed under Rule 12(b) for lack of subject matter jurisdiction if Counts I, II and III are dismissed, as Counts IV and V set forth Common Law causes of action under state law and could only be within the court's supplemental jurisdiction due to the presence of federal jurisdiction arising under Counts I - III under the extant pleadings.

MEMORANDUM OF LAW

It is the position of the Defendants that the instant case is filed in the wrong court and in the wrong venue. This is in fact a case based on breach of contract and other related allegations and causes of action arising out of state/common law (on both sides). Plaintiff has, however, sought to have it heard in federal court by claiming the court's pendent jurisdiction over these causes of action based on a flawed attempt to raise issues justiciable under the court's federal question jurisdiction.

In this regard it is noteworthy that Plaintiff has not sought to invoke federal jurisdiction by contesting authorship. Instead it does not dispute authorship in its pleadings but seeks ownership of the copyright arguing that it should belong to Plaintiff

as a “work-for-hire” under 17 USC 101 or via contract as further discussed under subheading III, below. (*See, also*, Plaintiff’s “Prayer for Relief” in Paragraphs (2) and (3) of the Complaint). However, none of these touch the current state of the matter.

Plaintiff admits that Defendant is owner of the copyright to the movie in question which would include rights over all derivatives thereto and use of the movie’s name. (*See, e.g.*, Complaint Paragraphs 35-37, 83, and 85). Notwithstanding Plaintiff’s accusations and allegations to the contrary, registration establishes a presumption of ownership and validity in Defendants favor under 17 USC 410. As stated in subsection (c) of this statute: “In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. . . .” (Emphasis added). This would include authorship and ownership. Thus, if anyone would have a right to the remedies sought by Plaintiff under Counts I and Count II of the complaint at the present time, it would be Defendants, not Plaintiff.

With the foregoing as a preamble, the following sections will cover, in turn, the basis for motions to dismiss and/or for a more definite statement related to:

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|------|--|---------|
| I. | Improper Venue | page 4 |
| II. | Count I (Cybersquatting) | page 6 |
| III. | Count II (Infringement) and Counts III (Ownership) | page 11 |
| IV. | Counts IV and V (Common Law) | page 14 |
| V. | Certification Under Local Rule 7.1 | page 15 |

I. The Complaint Should be Dismissed for Improper Venue

In the instant case, the facts do not support venue in the Northern District, but in the Middle District. The Complaint should, therefore, be dismissed as being brought in an improper venue.

A. Venue Allegations in the Complaint

Plaintiff's Complaint makes no allegations in support of venue other than paragraphs 1-3 related to the physical location of the Defendants. However, the facts of record establish the physical location of both Defendants to be in the Middle District.

1. Defendant Locations Alleged

In support of venue in the Northern District, Plaintiff alleges only that "Defendant Streaan is a resident of Florida" (Paragraph 2 of Complaint) and that "Defendant Sevenfold Films LLC was a limited liability company with a principle place of business in Gulf Breeze, Florida." (Emphasis added, Paragraph 3 of Complaint).

2. Actual Defendant Locations

In fact, Defendant Streaan's residence and the principle place of business of Defendant Sevenfold Films LLC has been 5741 SW 172nd Loop, Ocala, Florida, for approximately nine months and is therefore in the Middle District of the State of Florida and was there well before the time the complaint was filed or served. This is further established by the returns of service for the Defendants in this matter, which are part of the court record and also recite the above location. Moreover, the address of the resident agent for Sevenfold Films LLC was at all times relevant hereto located in Orange Park,

Florida, also in the Middle District for the State of Florida. (All of the aforesaid addresses can likewise be confirmed by reference to the records of Sevenfold Films, LLC online and available at website for the Florida Department of State).

B. Proper Venue Under the Applicable Federal Statutes

In paragraph 4 of the complaint, Plaintiff cites to the Lanham Act, 15 USC 1125(d), and the Copyright Act, 17 USC 101 et seq. in invoking the Court's jurisdiction and venue. The applicable venue statute under the Lanham Act provides that a civil action may be brought in "a judicial district in which any defendant resides, if all defendants are residents of the State in which the district is located." (28 USC 391(b)(1)). Likewise, for copyright actions 28 USC 1400(a) provides for venue "in the district in which the defendant or his agent resides or may be found."

C. Summary and Conclusion

On a Federal Rule of Civil Procedure 12(b)(3) motion, once a defendant raises the issue of improper venue, the Plaintiff has the burden to prove that the chosen venue is proper. (See, *International Truck and Engine Corp. v. Quintana*, 259 F.Supp2d 553, 558 (N.D. Tex. 2003). In resolving a Rule 12(b)(3) motion, "the court is permitted to look at evidence beyond simply those facts alleged in the complaint and its proper attachments," *Ambraco, Inc. v. Bossclip B. V.*, 570 F.3d 233, 238 (5th Cir. 2009). Thus, Defendant believes this court may take cognizance of relevant facts readily available and kept in the ordinary course of business in the public records of the State of Florida as well as the court records for this case. Likewise, by leave of the court, the Defendants can provide

utility bills and other everyday proof of residence at the aforesaid address. As is abundantly clear from these facts, venue under both of the cited statutes belongs in the Middle District. This action should, therefore, be dismissed under Federal Rule of Civil Procedure 12(b)(3).

II. Count I (Cybersquatting) Should be Dismissed for Failure to State a Claim

In the instant case, Count I fails to state a claim upon which relief can be granted as the statute requires and anticipates the presence of a valid “mark” that is “owned” by the plaintiff. Both of these must be present. Neither of these are presented on the facts pled. However, a curious statement/allegation in Count I will also be treated at the end of this discussion on the off chance that Plaintiff seeks to claim under statute terminology normally thought to be reserved for the names of individuals rather than under those in the usual trademark categories.

A. Factors Required Under the Statute

The requirements for a valid claim under this statute are analyzed at length in *DaimlerChrysler v. The Net Inc.*, 388 F. 3d 201 (6th Circuit 2004):

In 1999, Congress passed the ACPA as an amendment to the Trademark Act of 1946 ("Lanham Act") to prohibit "cybersquatting." . . . A trademark owner asserting a claim under the ACPA must establish the following: (1) it has a valid trademark entitled to protection; (2) its mark is distinctive or famous; (3) the defendant's domain name is identical or confusingly similar to, or in the case of famous marks, dilutive of, the owner's mark; and (4) the defendant used,

registered, or trafficked in the domain name (5) with a bad faith intent to profit.

Ford Motor Co. v. Catalanotte, 342 F.3d 543, 546 (6th Cir. 2003). . . .

The district court first considered whether plaintiff's DODGE and 4ADODGE marks were entitled to trademark protection. Under the Lanham Act, a trademark is defined as "any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods, including a unique product from those manufactured or sold by others and to indicate the source of goods, even if that source is unknown." 15 U.S.C. 1127. A trademark need not be registered to be entitled to protection under the ACPA. See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209, 120 S.Ct. 139, 146 L.Ed. 182 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992). Rather, "the general principles qualifying a mark for registration under [the act] are for the most part applicable in determining whether an unregistered mark is entitled to protection." *Two Pesos*, 505 U.S. at 768, 112 S.Ct. 2753.

(Id. 204-205; emphasis added).

B. Lack of a Valid or Qualifying Mark

In terms of presenting a valid trademark under 15 USC 1125(d), as defined above, the phrase "Genesis Movie" does not qualify. First, due to the fact that the titles of single books and movies (or portions thereof) cannot be trademarked. Second, because the phrase is merely descriptive of the product which the alleged mark is said to cover. i.e., a

“Genesis Movie.”

1. A Single Movie Title Cannot be a Trademark

As to the first, the law related to movie titles is well stated in the Trademark Manual of Examining Procedure TMEP 1202.08 (with supporting case citations):

The title, or a portion of a title, of a single creative work must be refused registration under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127, unless the title has been used on a series of creative works. The title of a single creative work is not registrable on either the Principal or Supplemental Register. *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (“the title of a single book cannot serve as a source identifier”); *In re Cooper*, 254 F.2d 611, 615-16, 117 USPQ 396, 400 (C.C.P.A. 1958) , (“A book title . . . identifies a specific literary work . . . and is not associated in the public mind with the publisher, printer or bookseller”); *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) (holding the title of a live theater production unregistrable); *In re Hal Leonard Publ’g Corp.*, 15 USPQ2d 1574 (TTAB 1990) (holding INSTANT KEYBOARD, as used on music instruction books, unregistrable as the title of a single work); *In re Appleby*, 159 USPQ 126 (TTAB 1968) (holding the title of single phonograph record, as distinguished from a series, does not function as mark).

As noted in *In re Cooper*, there is a compelling reason why the name or title of a book cannot be a trademark, which stems from copyright law. Unlike a

copyright that has a limited term, a trademark can endure for as long as the trademark is used. Therefore, once copyright protection ends, and the work falls in the public domain, others must have the right to call the work by its name. *G. & C. Merriam Co. v. Syndicate Publ'g Co.*, 237 U.S. 618, 622 (1915); *In re Cooper*, 254 F.2d at 616, 117 USPQ at 400; *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1144 (TTAB 2011). Moreover, if the work sought to be registered is not copyrighted, the public may copy it at once and would be as clearly entitled to call it by its name. *In re Cooper*, 254 F.2d at 616, 117 USPQ at 400.

There is no series of creative works at issue here using the same title. (*See, also*, Paragraphs 20 and 21 of Complaint). Thus, the mark “Genesis Movie” cannot serve as a trademark and a “mark” to which the Cybersquatting statute applies.

2. A Name/Phrase that is Merely Descriptive of the Goods Cannot Normally be a Trademark

The law related to “Descriptiveness” is well stated in the Trademark Manual of Examining Procedure TMEP 1202.09 (interpreting 15 U.S.C. §1052), where it is stated that:

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. As noted in *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978) :

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular

goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

In the instant case, the name that Plaintiff alleges is being violated is definitely descriptive of the goods to be covered. The goods or product are/is a “Genesis Movie.” Consequently, the alleged mark is in fact identical to and descriptive of the goods to be covered by the mark.

C. Plaintiff Does Not Own and/or Cannot Control Use of the Movie Name

As noted in Section B.1., above, the title of the movie is covered by copyright (which belongs to the Defendant Sevenfold), and notwithstanding trademark law, “others must have the right to call the work by its name”--this would include the owner/author of the copyright in its original form as well as derivatives thereof such as “Genesis Movie”.

D. Some Curious Allegations by Plaintiff

In the usual course of things the foregoing should dispose of Count I. However, as stated above, Plaintiff’s complaint contain an allegation that makes the undersigned concerned that Plaintiff has a more unusual argument in mind. 15 USC 1125(d), states in pertinent part that:

(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section,

Plaintiff discusses “Genesis Movie” as a mark in the general and usual sense in which

that term is used up to and including paragraph 67 of the Complaint, where it states that “Plaintiff owns the rights in the mark GENESIS MOVIE.” However, in Paragraph 68, Plaintiff briefly and rather off-handedly mentions that “GENESIS MOVIE” is the personal name of Plaintiff. It is an unusual insertion and an unusual usage if intended to bring Plaintiff’s claims under the “personal name” language recited above. A corporation may be considered a person under the law, but its name is usually termed a “business name” or “corporate name” rather than a personal name. To the best of the undersigned’s knowledge and belief, the term “personal name” is also used elsewhere in the Lanham Act and in the law generally to refer to an individual’s name. For example, in TMEP 1211.01(b)(iii) it is used extensively as a term referencing and related to the names of individuals. In addition, Defendants believe that Plaintiff’s pleading on this point, if intended to support a claim under the “personal name” protections provided by the statute is confusingly pled. If Defendants’ motion to dismiss Count I is not sustained, Defendants hereby move the court to order a more definite statement of Plaintiff’s claims in this regard.

III. Count II (Copyright Infringement) and Count III (Copyright Ownership) Should be Dismissed for Failure to State a Claim

A copyright infringement case as well as one seeking a declaration of Plaintiff’s ownership require proof of Plaintiff’s ownership of a valid exclusive copyright. (17 USC 501(b)). At this point, Plaintiff’s Complaint fails to allege facts supporting this requirement as to either count. As a matter of fact, it conclusively supports the fact that

Defendant Sevenfold has registered the copyright and is its present owner. Plaintiff may dispute the Defendant's right to register the copyright as a breach of contract, but that will of course be opposed by Defendants who will also be asserting Plaintiff's own breach of contract and other bad acts—the litigation of which does not require or trigger federal court jurisdiction.

In lieu of this, or perhaps to strengthen its claim, Plaintiff appears to pursue a work-for-hire theory as well. To be a work-for-hire under 17 U.S.C. 101, the work must be either: (1) a work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, . . . if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

Plaintiff makes no serious attempt to prove that Defendant(s) were employed by it under (1) other than to recite that “Plaintiff paid Defendants a salary for their work on the film.” (Complaint Paragraph 15). However, despite Plaintiff's attempted characterization of payments to an independent contractor—Defendant Sevenfold Films LLC--as a “salary,” the Defendant LLC was not an employee.

Plaintiff also cites to the contract's statement that the results and proceeds of Defendant Sevenfold's efforts as an independent contractor shall be a “work made for hire.” (Complaint Paragraphs 13 and 14). In combination with the subject matter of the contract, this might be seen as satisfying two of the prerequisites for a work-for-hire in

the category of a “motion picture or other audiovisual work.” However, a vital ingredient is missing. This was not a “specialty ordered or commissioned” work in that category. Defendant(s) had already been working on the project prior to a meeting of some of the principals (inaccurately portrayed in Complaint Paragraph 8).

Further, Defendant(s) did not receive a special order or commission at that time (nor is this key required fact alleged in the complaint). There is nothing of this type alleged and nothing of this type occurred. The closest thing to such a thing is a form recitation in the mutual contract agreement executed and made effective years later after much of the work had already been accomplished by Defendant(s) and was pre-existing (both in terms of the date of execution and the effective date of the contract). Not surprisingly given the need for the work to be produced pursuant to an advanced order/commission with a written agreement, retroactive written agreements of the type seen in the instant contract are not allowed. *Schiller v. Nordisco Corp.*, 969 F.2d 410 (7th Cir. 1992), where the court held that a “work made for hire” agreement must precede the creation of the work, because the writing requirement under the “work made for hire” doctrine is not merely a statute of frauds provision “designed to protect people against false claims of oral agreements.” Likewise, the Ninth Circuit in *Gladwell Govt. Services Inc. v. County of Marin*, 265 Fed. Appx. 624 2008 WL 268268 (9th Cir. 2008), suggested that the plain language of Section 101(2) of the U.S. Copyright Act requires that an agreement be reduced to a writing prior to the creation of the work, stating that the language of Section 101(2) “indicates that a work for hire agreement cannot apply to

works that are already in existence. Works “specially ordered or commissioned can only be made after the execution of an express agreement between the parties.” (Emphasis added; *Id.* at 626).

In view of the foregoing, Defendants believe that Plaintiff’s pleading in regard to Counts II and III, if intended to support a claim to the copyright as a work-for-hire is fatally deficient. Without copyright ownership, Count II cannot support an infringement action. Likewise, without a work-for-hire claim, Count III is merely a breach of contract claim and should be dismissed as it is no longer distinguishable from the contractual relief sought and/or available under the breach of contract claim set forth under Count IV. If Defendants’ motions to dismiss Counts II and III are not sustained, Defendants hereby move the court to order a more definite statement of Plaintiff’s claims in regard to the requisites for their respective cause of action, particularly for the apparent work-for-hire set forth therein.

IV. Count IV (Breach of Production Agreement) and Count V (Conversion) Should be Dismissed for Lack of Subject Matter Jurisdiction

Count IV (Breach of Production Agreement), and Count V (Conversion) of the complaint should be dismissed under Rule 12(b) for lack of subject matter jurisdiction if Counts I - III are dismissed, as they set forth Common Law causes of action normally subject to state jurisdiction and could only be within the court’s supplemental jurisdiction due to the presence of federal jurisdiction over at least one of Counts I - III under the extant pleadings. The “Common Law” subject matter of Counts IV and V are

specifically stated in the heading for each. Count III (though it cites to 17 USC 101 *et seq.*) is actually—as its title states—a cause of action related to copyright ownership based solely on contractual grounds, which are the only grounds alleged therein. (*See*, Count III, paragraphs 91-106). Thus, Count III is also, like Counts IV and V, a “Common Law” cause of action though not titled as such in the Complaint.

V. Certification Under Local Rule 7.1

No conference was required in this matter as all of the motions seek to determine the outcome of a case or claim and are therefore exceptions to the conference requirement under Local Rule 7.1(D). Nonetheless, a negotiated solution was sought unsuccessfully in regard to the venue issue.

WHEREFORE, the Defendants respectfully request that the Complaint herein be dismissed in its entirety.

Respectfully submitted,

/Steven R. Scott/

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