UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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PATRICK SHIPSTAD,

Plaintiff,

–against–

16-cv-5145 (LAK)

ONE WAY OR ANOTHER PRODUCTIONS, LLC, et ano.,

Defendants

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MEMORANDUM AND ORDER

LEWIS A. KAPLAN, *District Judge.*

This action for copyright infringement is before the Court on defendants' motion to dismiss the amended complaint. The Court assumes familiarity with that pleading and therefore does not restate the facts in this memorandum and order.

1. As an initial matter, the Court excludes the declarations submitted by counsel on both sides and declines to convert the motion into one for summary judgment dismissing the amended complaint. *See* Fed. R. Civ. P. 12(d).

2. Defendants argue first that the accused works, as a matter of law, are not substantially similar to the allegedly infringed work and that the case therefore must be dismissed. At least at this stage of the proceeding, the Court is unwilling to go so far. *See Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 461-63 (S.D.N.Y. 2005) (substantial similarity of allegedly infringing photograph to the copyrighted photograph an issue of fact).

3. Defendants next argue that their uses of the copyrighted photograph were

transformative and therefore fair. They rely heavily on *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013), which dealt with the use by a so-called transformative artist of copyrighted works and which held, on an appeal from a summary judgment in favor of the plaintiff, that many but not all of the allegedly infringing uses were fair as a matter of law. Suffice it to say here that the fair use defense often (though as *Cariou* makes clear not always) presents an issue of fact, that there has been no factual development in this case, and that *Cariou* obviously turned on different copyrighted works and their relationship to different accused works. This Court is not persuaded, at least on the present record, that the accused works were fair uses of plaintiff's copyrighted photograph.

4. Defendants argue next that their use of the copyrighted work was "*de minimus* [*sic*]" and that the case should be dismissed on that ground. As their memorandum states, however, they can prevail on this basis only if "the copying of the protected material is so trivial 'as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying.'" Defs.' Mem. 14 (quoting *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997)). Inasmuch as the Court is unpersuaded that the accused and the allegedly infringed works are not substantially similar as a matter of law, the *de minimis* argument fails, at least for the present.

5. Defendants' contention that they had an implied license to use the photograph, whatever its merits on a fuller record, is baseless in the current posture of the case.

6. Finally, defendants contend that the case must be dismissed as against defendant Princeton Holt on the ground that he allegedly is a managing member of defendant One Way or Another Productions, LLC and therefore is protected from personal liability under N.Y. Lim. Liab. Co. L. § 609. On this record, however, it is far from clear exactly who did what and in what

capacity Holt acted. Resolution of defendants' argument with respect to Mr. Holt therefore must await fuller development as well.

Accordingly, defendants' motion to dismiss the amended complaint [DI 14] is denied.

SO ORDERED.

Dated: August 23, 2016

/s/ Lewis A. Kaplan

Lewis A. Kaplan
United States District Judge