

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

PATRICK SHIPSTAD )  
Plaintiff )  
 )  
v. )  
 )  
ONE WAY OR ANOTHER )  
PRODUCTIONS, LLC, and )  
PRINCETON HOLT )  
Defendant(s) )  
 )  
 )  
 )

Civil Action Case 1:16-cv-05145-LAK

**MOTION TO DISMISS**

ECF CASE

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**MEMORANDUM OF LAW IN SUPPORT OF  
DEFENDANT’S MOTION TO DISMISS THE AMENDED COMPLAINT**

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## PRELIMINARY STATEMENT

Defendant One Way or Another Productions, LLC & Defendant Princeton Holt (“Defendant” or “One Way” or “Holt”), by and through its undersigned counsel, respectfully submits this memorandum of law in support of its motion to dismiss the Amended Complaint (“Amended Complaint” or “amended complaint”) of Plaintiff Patrick Shipstad (“Plaintiff” or “Shipstad”), pursuant to 12(b)(6) of the Federal Rules of Civil Procedure (“Rules”).

Plaintiff’s claim is barred for the following reasons:

- a) Plaintiff has failed to state a claim for copyright infringement because **Defendant’s actions fail the substantial similarity test, reasonable observer test, and/or ordinary observer test.**
- b) Plaintiff has failed to state a claim for copyright infringement because **Defendant’s use of copyrighted image is legally transformative as a matter of law.**
- c) Plaintiff has failed to state a claim for copyright infringement because **the alleged copying, even if proven, is de minimus, as a matter of law.**
- d) Plaintiff has failed to state a claim for copyright infringement because **Defendant and/or Negrón had an implied license to use the photograph as a matter of law.**
- e) Plaintiff has sued a party who is protected by law because **Defendant Holt is the managing member of an LLC.**

Accordingly, the Amended Complaint should be dismissed with prejudice.

## **STATEMENT OF FACTS**

Taylor Negron (“Negron”) is a now deceased film and television actor. In 2012, Defendant filmmaker enlisted the acting services of Negron in a low budget film entitled “Alienated” (“the film”). Prior to his death, actor Negron provided a headshot of himself to Defendant for use in the sales, marketing, and distribution of said film. Defendant thereby used the photo in a series of marketing materials for the film.

Plaintiff photographer claims that since the copyright of the original photograph (called the “Subject Image” in the Amended Complaint) lies with him, that Defendant therefore had no authority to use it, and is thus guilty of copyright infringement and other copyright infringement related actions.

Not only does Defendant deny any copyright infringement, but Defendant also denies any lawful basis for Plaintiff’s Amended Complaint. As such, Defendant is filing this Motion to Dismiss Plaintiff’s Amended Complaint.

## **PROCEDURAL HISTORY**

This case was filed by Plaintiff in this court on June 29<sup>th</sup>, 2016 via ECF. An Amended Complaint was filed on August 1, 2016. There is an initial pre-trial conference scheduled for September 15<sup>th</sup>, 2016 before Judge Kaplan at 2:30pm in courtroom 21 B, 500 Pearl Street, New York, NY.

## LEGAL ARGUMENT

All arguments and case law are to be deemed incorporated into all other arguments, if helpful in making a legal determination.

### **1. LEGAL STANDARD APPLICABLE TO A MOTION TO DISMISS UNDER FED. R. CIV. P. 12(b)(6)**

When ruling on a motion to dismiss pursuant to Rule 12(b)(6), courts generally accept well-pled factual allegations as true and view them in the light most favorable to the non-moving party. See *Miree v. Dekalb County*, 433 U.S. 25, 27 n.2 (1977). The purpose of Rule 12(b)(6) is to “streamline litigation by dispensing with needless discovery and fact-finding” and eliminate baseless claims. *Neitzke v. Williams*, 490 U.S. 319, 326-27 (1989).

Thus, where “the allegations in a complaint, however true, could not raise a claim of entitlement to relief, ‘this basic deficiency should ... be exposed at the point of minimum expenditure of time and money by the parties and the court.’” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 556 (2007). That is to say, if it appears from the face of the complaint that the plaintiff cannot prove a set of facts that would entitle him to the relief sought, the court should dismiss plaintiff’s claims. See *id.* at 570. “Dismissal under Fed. R. Civ. P. 12(b)(6) is appropriate when a defendant raises ... an affirmative defense and it is clear . . . that the plaintiff’s claims are barred as a matter of law.” *Conopco, Inc. v. Roll Int’l*, 231 F.3d 82, 86 (2d Cir. 2000).

This Court has already established the standards for the granting of a motion to dismiss in a copyright matter. *Gordon v. Invisible Children Inc*, 2015 U.S. Dist. LEXIS 129047. While “the court is to accept as true all facts alleged in the complaint,” *Kassner v. 2<sup>nd</sup> Ave Delicatessen*, 496 F.3d at 237 (2<sup>nd</sup> Circuit, 2007), and must “draw all reasonable inferences in favor of the

plaintiff”, “a complaint is inadequately pled ‘if it tenders naked assertions devoid of further factual enhancements and does not provide factual allegations sufficient’ to give the defendant fair notice of what the claim is and the grounds upon which it rests.”

**2. PLAINTIFF HAS FAILED TO STATE A CLAIM FOR COPYRIGHT INFRINGEMENT BECAUSE DEFENDANT’S ACTIONS FAIL THE SUBSTANTIAL SIMILARITY TEST, REASONABLE OBSERVER TEST, AND/OR ORDINARY OBSERVER TEST.**

In accordance with *Gordon*, to establish copyright infringement, two elements must be proven: 1) ownership of a valid copyright, and 2) copying of constituent elements of the work that are original. Further, even if copying is shown, “a plaintiff must still demonstrate ‘substantial similarity’ between the defendant’s work and the protectable elements of plaintiff’s work, because ‘not all copying results in copyright infringement’”. *Gal*, 518 F. Supp 2d at 537 n.4.

In certain cases, determining “substantial similarity” is not the exclusive domain of the jury. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). Here, where “the works in question are attached to a plaintiff’s complaint, it is entirely appropriate for the district court to consider the similarity between those works in connection with a motion to dismiss, because the court has before it all that is necessary in order to make such an evaluation.” *Id.* At 64. “Accordingly, if the district court determines that the works at issue are ‘not substantially similar as a matter of law,’ *Kregos v. Associated Press*, 3 F.3d 656, 664 \*2d Cir. 1993), the district court can properly conclude that the plaintiff’s complaint and the works incorporated therein do not “plausibly give rise to an entitlement of relief.” *Gordon*, 2015 U.S. Dist LEXIS 129047.

The Second Circuit has a standard test for substantial similarity between two items. “In the Second Circuit, the ‘standard test for substantial similarity between two items is whether an ordinary observer, **unless he set out to detect the disparities** [emphasis added by Defendant’s attorney], would be disposed to overlook them.” *DiTocco v. Riordan*, 815 F. Supp.2d 655, 665 (S.D.N.Y., 2011). This “ordinary observer” test asks whether “an average lay person would recognize the alleged copy as having been appropriated from the copyrighted work.”

It is interesting to note that the 2<sup>nd</sup> Circuit sometimes employs a “more discerning” test than the ordinary observer test. This “more discerning” test is only applicable where a copyrighted work “is not ‘wholly original’, but rather incorporates elements from the public domain.” *Boisson v. Banian, Ltd.*, 273 F.3d at 272 “The more discerning test applies only if a plaintiff has imported a substantial portion of its work from the public domain.” *Aaron Basha Corp v. Felix B. Vollman, Inc.* 88 F. Supp. 2d 226, 231 (S.D.N.Y. 2000). Here, the plaintiff has not imported a substantial portion of his work from the public domain, and therefore, the proper test to use here is the “ordinary observer” test.

“Application of the ordinary observer standard requires [a court] to scrutinize the two [images] for substantial similarity” and consider whether “an average lay observer [would] recognize [the allegedly infringing images] as having been appropriated from [plaintiff’s work].” *Gordon*, citing *Hamil Am v GMI*, 193 F.3d at 102. The clear result when applying this test to the works in question is an unequivocal, “No.” By looking at the original work (that contains Negron’s full body) side by side with Defendant’s marketing materials, an average lay person would not without clear prompting from a third party have any reason to believe that Defendant’s marketing images of Negron originate from Plaintiff’s copyrighted work.



Further, in employing this ordinary observer test, “good eyes and common sense may be as useful as deep study of reported and unreported cases, which themselves are tied to highly particularized facts.” *Hamil Am.*, 193 F.3d at 102 (quoting *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.* 490 F.2d 1092, 1093 (2d Cir. 1974)). In *Gordon*, the court decided that “In this case, the dictates of good eyes and common sense lead inexorably to the conclusion that there is no substantial similarity between Plaintiff’s work and the allegedly infringing [images].” Note that this Court used the words “substantial”—it is not enough that the works in question are simply “similar”; by law, the works in question must be “substantially similar”. The works here in question are not “substantially similar”. While one may successfully argue that the *subject matter* in both works is similar (because both include the recognizable image of Negron), Plaintiff has no copyright on said actor’s image and/or rights of publicity. See: *Rogers v. Grimaldi*, 695 F. Supp 112 (1988), *Winter v. DC Comics*, 134 Cal.Rptr.2d 634 (2003), *Comedy III Productions v. Gary Saderup, Inc.*, 106 Cal.Rptr.2d 126 (2001).

While employing the “ordinary observer test” in comparing works for infringement purposes, courts also examine all of the works in question from a perspective of “total concept and feel”. *Hamil Am.*, 193 F.3d at 103. When the “total concept and feel” of the copyrighted work(s) and the allegedly infringing work(s) are different, courts have tended to rule in favor of the defendant.

Therefore, if an ordinary observer simply uses good eyes and common sense, *and* accepting everything that plaintiff claims as true, this ordinary observer will conclude that there is no substantial similarity between Plaintiff Shipstad’s work and the allegedly infringing works of Defendant because:

- a. Even if the marketing materials contain the same image of Negron, no ordinary observer looking at the marketing materials would believe that the image of Negron in the marketing materials is the same as Plaintiff's copyrighted image. The logical and reasonable result using the "substantial similarity" and "ordinary observer" tests outlined above is an adamant, "No, there is not a substantial similarity."
- b. While the image of Taylor Negron is the same in both works, Plaintiff has no rights of publicity for Taylor Negron, and does not own any copyright on Mr. Negron's face. The *only* identifiable similarity is that both works appear to present an image of Negron's face—the images are *not* the same.
- c. Plaintiff himself argues that Defendant allegedly modified many aspects of the copyrighted image, including "the alteration of Negron's eyes, the thinning of his jaw, and the addition of his shadows." The marketing materials themselves will further exhibit that in Defendant's work, Negron's head is at different angles from Plaintiff's copyrighted work, the top of Negron's head is cut off, and the lighting is wholly different. These significant alterations, if made, serve to make the Defendant's use of the image nearly unrecognizable, and therefore, non-actionable.
- d. The "total concept and feel" of the works in question—even when looked at side by side—are completely different as well. *Hamil Am., 193 F.3d at 103*. The original full-body photo's "total concept and feel" is bright, happy, traditionally lit, airy, spacious, and portrait-focused. The "total concept and feel" of Defendant's alleged use of said image is dark, somber, ominously lit, claustrophobic, contained, and emotion-focused.

Therefore, for the foregoing reasons, because the works in question fail the substantial similarity test, the reasonable observer test, and/or the ordinary observer test, this case should be dismissed as a matter of law.

**3. PLAINTIFF HAS FAILED TO STATE A CLAIM FOR COPYRIGHT INFRINGEMENT BECAUSE DEFENDANT’S USE OF COPYRIGHTED IMAGE IS LEGALLY TRANSFORMATIVE AS A MATTER OF LAW**

The work is also transformative as a matter of law, using the “reasonable observer” test (which may or may not be the same as the “ordinary observer” test). *Patrick Cariou v. Richard Prince, United States Court of Appeals, Second Circuit. 714 F.3d 694 (2013)*. In this case, Prince used a number of Cariou’s copyrighted images, and transformed them. It is undeniable that large portions of Cariou’s copyrighted work was copied and used in Prince’s renditions, but the court found that in most of the works, the transformation was undeniable.

Specifically, the court found no copyright infringement in 25 out of 30 works despite the proven fact that the “works involved copying the original photographs and engaging in a variety of transformation.” In fact, “these [transformations] included printing them, increasing them in size, blurring or sharpening, adding content (sometimes in color), and sometimes compositing multiple photographs together or with other works.”

In particular, the Court stated:

Prince is a well-known appropriation artist. The Tate Gallery has defined appropriation art as "the more or less direct taking over into a work of art a real object or even an existing work of art." [...] Prince's work, going back to the mid-1970s, has involved taking photographs and other images that others have produced and incorporating them into paintings and collages that he then presents, in a different context, as his own. He is a leading exponent of this genre and his work has been displayed in museums around the world,

including New York's Solomon R. Guggenheim Museum and Whitney Museum, San Francisco's Museum of Modern Art, Rotterdam's Museum Boijmans van Beuningen, and Basel's Museum fur Gegenwartskunst. As Prince has described his work, he "completely tr[ies] to change [another artist's work] into something that's completely different...

Prince first came across a copy of Yes Rasta in a bookstore in St. Barth's in 2005. Between December 2007 and February 2008, Prince had a show at the Eden Rock hotel in St. Barth's that included a collage, titled Canal Zone (2007), comprising 35 photographs torn out of Yes Rasta and pinned to a piece of plywood. Prince altered those photographs significantly, by among other things painting "lozenges" over their subjects' facial features and using only portions of some of the images. In June 2008, Prince purchased three additional copies of Yes Rasta. He went on to create thirty additional artworks in the Canal Copyright Law (Fisher 2014) *Cariou v. Prince* Zone series, twenty-nine of which incorporated partial or whole images from Yes Rasta. The portions of Yes Rasta [...] photographs used, and the amount of each artwork that they constitute, vary significantly from piece to piece. In certain works, such as James Brown Disco Ball, Prince affixed headshots from Yes Rasta onto other appropriated images, all of which Prince placed on a canvas that he had painted. In these, *Cariou's* work is almost entirely obscured. The Prince artworks also incorporate photographs that have been enlarged or tinted, and incorporate photographs appropriated from artists other than *Cariou* as well. Yes Rasta is a book of photographs measuring approximately 9.5" × 12". Prince's artworks, in contrast, comprise inkjet printing and acrylic paint, as well as pasted-on elements, and are several times that size. For instance, *Graduation* measures 72 3/4" × 52 1/2" and *James Brown Disco Ball* 100 1/2" × 104 1/2". The smallest of the Prince artworks measures 40" × 30", or approximately ten times as large as each page of Yes Rasta... *Cariou v. Richard Prince, United States Court of Appeals, Second Circuit. 714 F.3d 694 (2013)*

It is important to note that the US Court of Appeals only deemed 25 of the 30 works transformative as a matter of law. The remaining 5 were sent back to the district court with instructions: that the case would hinge on whether a reasonable observer would find Prince's works to have been transformative, and thus protected under fair use law. The case, though, was settled before a final determination could be made.

However, instructive are the 25 works that *were* deemed fair use. Specifically of note is the work entitled James Brown Disco Ball, in which Prince took copyrighted headshots from Yes Rasta and pasted them onto other appropriated images, all of which Prince then placed on a canvas that he had painted. The court specifically says, “In these, Cariou's work is almost entirely obscured.” This is virtually the very same fact pattern evident in the case before the court: Defendant allegedly took a copyrighted headshot from Plaintiff Shipstad and placed it alongside other headshots, creative materials, and unique original artwork on a digital canvas. The end result: Shipstad’s “work is almost entirely obscured”. Note specifically that the court found James Brown Disco Ball to be a fair-use, and the fact pattern is virtually identical to the case at bar. What we have here is not copyright infringement, but rather, a legally permissible transformative style formally recognized by the Tate Gallery in London as “appropriation”.

Therefore, even if Plaintiff’s images are to some extent recognizable in Defendant’s works, Defendant’s works are nonetheless protected fair use because Shipstad’s “work is almost entirely obscured” in Defendant’s work. *Cariou v. Richard Prince, United States Court of Appeals, Second Circuit. 714 F.3d 694 (2013)*

For the foregoing reasons, because the works in question are legally transformative as a matter of law, this case should be dismissed.

**4. PLAINTIFF HAS FAILED TO STATE A CLAIM FOR COPYRIGHT INFRINGEMENT BECAUSE THE ALLEGED COPYING, EVEN IF PROVEN, IS DE MINIMUS AS A MATTER OF LAW**

This court decided in *Ringgold v. Black Entertainment Television, Inc., 1996 U.S. Dist. LEXIS 13778, 1996 WL 535547 (S.D.N.Y. Sept. 19, 1996)* that where the unauthorized use of a copyrighted work is *de minimis*, no cause of action will lie for copyright infringement. *Ringgold*,

126 F.3d at 76 (where "the allegedly infringing work makes such a quantitatively insubstantial use of the copyrighted work as to fall below the threshold required for actionable copying, it makes more sense to reject the claim on that basis and find no infringement, rather than undertake an elaborate fair use analysis . . .").

In order for the court to find for Defendant, Defendant must establish that the infringement of a copyright is *de minimis*, and therefore not actionable. The alleged infringer must demonstrate that 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." *Ringgold*, 126 F.3d at 74 (citing 4 *Melville B. Nimmer & David Nimmer, Nimmer on Copyright* § 13.03[A] at 13-27). In determining whether or not the allegedly infringing work falls below the quantitative threshold of substantial similarity to the copyrighted work, courts often look to the amount of the copyrighted work that was copied, as well as (in cases involving visual works) the observability of the copyrighted work in the allegedly infringing work. *Ringgold*, 126 F.3d at 75.

Observability is determined by the length of time the copyrighted work appears in the allegedly infringing work, and its prominence in that work as revealed by the "lighting and positioning" of the copyrighted work. *Ringgold*, 126 F.3d at 75. Like the analysis of a fair use claim, an inquiry into the substantial similarity between a copyrighted work and the allegedly infringing work must be made on a case-by-case basis, as there are no bright-line rules for what constitutes substantial similarity. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577, 127 L. Ed. 2d 500, 114 S. Ct. 1164 (1994) (analysis of fair use claim must be made on case-by-case basis); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir.

1960)(test for infringement of a copyright is necessarily "vague" and determinations must be made "ad hoc").

This court noted in *Ringgold* that the artwork at issue was "clearly visible" and "recognizable as a painting . . . with sufficient observable detail for the 'average lay observer' . . . to discern African-Americans in Ringgold's colorful, virtually two-dimensional style," *Ringgold* 126 F.3d at 77. However, in the case at bar, Defendant's alleged use of the photograph is insubstantial, not clearly visible, and unrecognizably obscured by a smoky glaze, extensive alterations of lighting, heavy shadows, and even major difference in facial features. *Sandoval v. New Line Cinema Corp*, 147 F.3d 215 (1998).

The facts show that no ordinary observer by simply comparing the works would identify that the Plaintiff's copyrighted image was used in the Defendant's marketing materials. The only portion of the original photograph allegedly used is Negron's face: but not his whole face, not even the same shaped face, and a face framed in wholly different lighting, shadow effects, and orientations—facts all alleged by the Plaintiff himself. In other words, the copyrighted work in question is completely different from the Defendant's works, i.e. Defendant's use of the copyrighted image is *de minimus*.

Again, the only substantial similarity between the works in question is the recognizable likeness of Negron. Plaintiff has no claim whatsoever in this recognizable likeness, but appears to be attempting to convince the court that somehow he does. There is a very good reason why the images have some similarities: it's the same person. This alone, however, does not entitle a plaintiff to claim copyright infringement.

Moreover, Defendant used only a small portion of the original photo, and added it to a significantly larger collage of artwork. In accordance with *Andrea Blanch v. Jeff Koons, The Soloman R. Guggenheim Foundation, and Deutsche*, 467 F.3d 244 (2<sup>nd</sup> Circuit, 2006), this use of the Plaintiff's photo in this larger collage, with all of its additions and changes, leads inexorably to the conclusion that any ordinary observer would find "no substantial similarity between Plaintiff's work and the allegedly infringing images." *Gordon*. In *Blanch*, the 2<sup>nd</sup> Circuit affirmed the district court's summary judgment decision that Defendant's incorporation of Plaintiff's photograph in a collage painting constituted fair use, pursuant to 17 U.S.C. § 107.

For the foregoing reasons, because the Defendant's use of Plaintiff's copyrighted image is *de minimis* as a matter of law, this case should be dismissed.

**5. PLAINTIFF HAS FAILED TO STATE A CLAIM FOR COPYRIGHT INFRINGEMENT BECAUSE DEFENDANT AND/OR NEGRON HAD AN IMPLIED NON-EXCLUSIVE LICENSE TO USE THE PHOTOGRAPH AS A MATTER OF LAW**

The Supreme Court of the United States has clearly decided that "the author of a pre-existing work may assign to another the right to use it in a derivative work." *Stewart et. al. v. Abend* 495 U.S. 207. Further, "license is an affirmative defense to copyright infringement." *Foster v May Lee, Ericka Rodriguez, and Lashpia Corp.* 93 F. Supp. 3d 223.

There also exists established case law on what is known as an implied non-exclusive license. The 2<sup>nd</sup> Circuit has found that "implied non-exclusive licenses should be found only in narrow circumstances where one party created a work at the other's request and handed it over intending that the other copy and distribute it." *Weinstein Co. v. Smokewood Entmn't Grp., LLC*, 664 F. Supp. 2d 332, 244 (S.D.N.Y. 2009). In other words, "an implied [non-exclusive] license



can only exist where an author creates a copyrighted work with knowledge and intent that the work would be used by another for a specific purpose.” The test for an implied license is strict, and such license “will only be found when a copyright owner creates a work at the request of the licensee and with the intention that the licensee exploit it.” *Weinstein Co. v. Smokewood Entmn’t Grp., LLC*, 664 F. Supp. 2d 332, 244 (S.D.N.Y. 2009).

In *Weinstein* (involving the use of one filmmaker’s footage in another’s film), the Court determined that “the plaintiff’s conduct conveyed an implied license for the filmmaker to use the footage of the film.” The 2<sup>nd</sup> Circuit in *Weinstein* has discussed a three-part test that can be used to determine whether an implied non-exclusive license exists:

- a) a person (the licensee ) must request the work,
- b) the creator (the licensor) must make that particular work and deliver it to the licensee who requested it, and
- c) the licensor must intend the licensee-requestor copy and distribute his work.

In the case at bar, Plaintiff admits that Negron was a successful film and television actor.

Plaintiff further admits that he (Plaintiff himself) is a professional photographer.

Plaintiff states that he was not just ‘a’ photographer of Negron, but rather, “served as his photographer from 2009 to 2014”. In other words, based on Plaintiff’s Amended Complaint, Negron had no other photographers.

Plaintiff further admits that Negron was his client from 2009 to his death in 2014.

It is clear from the Amended Complaint that Negron hired Shipstad to take photographs.

Here, in the instant case, the facts alleged make it is clear that Negron hired Plaintiff to take photos of him *expressly for Negron's use in the promotion of his acting career*. Plaintiff states that he is a professional photographer and that one of his clients was professional actor Negron. The word professional, according to Merriam Webster's Dictionary, means: "participating for gain or livelihood in an activity or field of endeavor often engaged in by amateurs." There is nothing in the Amended Complaint to suggest that Plaintiff's services were anything but professional.

As such, the implied license is proven by Plaintiff's very actions: if no license existed, then for what reason would Negron have commissioned Plaintiff Shipstad in the first place? As this Court stated in *Design Options, Inc. v. Belle-Pointe, Inc.*, "if a license was not implied to permit the defendant's use of the copyright owner's work, the work would otherwise have been rendered worthless." *Design Options, Inc. v. Belle-Pointe, Inc.*, 940 F. Supp. 86, 92. (S.D.N.Y., 1996). Indeed, in this type of case, this Court (citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555 (9<sup>th</sup> Cir. 1990), also a case discussing the use of one filmmaker's footage in another filmmaker's film) has in the past "focused on the logic underlying the decision." Specifically, the court focused on "the fact that without a license to use the footage, it would have been of 'minimal value'." *Louis Psihoyos and James P. Reed v. Pearson Education, Inc.*, 855 F. Supp. 2d 103 (S.D.N.Y., 2012). Further, the *Zappa* court has also made clear with respect to implied non-exclusive licenses that it does not necessarily matter whether the works were originally created at the request of actor Negron. *Zappa v. Rykodisc*, 819 F. Supp. 2d 307. What matters is the intent of the parties.

Therefore, in the instant case, it is beyond the stretch of reason that an actor would hire a professional photographer on numerous occasions over the course of five years to create photos of his very own image, and never be able to use those photos to promote his career in whatever ways deemed appropriate. The idea that an actor would repeatedly on numerous occasions commission photo shoots from a professional photographer and never be able to see or use those photos again because the photographer refuses to provide a license for such use is absurd. If this were the case, Negron would have terminated his relationship with Shipstad years earlier. Indeed, if Shipstad took such photos as a professional photographer with the intent of hoarding them and not letting his client use them, such a decision would be completely contrary to the intent of the copyright law. More importantly, if such a situation is deemed copyright infringement, then every actor in the history of the United States who employed a professional photographer at some point to create head and body shots for marketing purposes, would be guilty of copyright infringement. Every headshot on the Internet Movie Database ([www.IMDb.com](http://www.IMDb.com)) is an image obtained from a photographer of some sort, either professional or amateur. It is difficult to believe that each actor who posts his or her headshots on IMDB.com has a written license agreement to post their headshots on a third-party platform that markets ones acting career. These contracts generally do not exist because their necessity is moot: there exists an implied non-exclusive license.

Here, in the case at bar, Defendant relied on the industry expectation and common practice that an actor may use a headshot he commissioned for any marketing purposes whatsoever in the furtherance of his or her acting career. Defendant filmmaker relied on and used actor Negron's implied license when using Plaintiff photographer's photo in marketing materials for the film "Alienated"—a film in which Negron himself plays a supporting role.

Note that it is irrelevant that the Amended Complaint does not make clear whether Negron authorized such use:

- a) Such authorization is implied by actor Negron's participation as an actor in Defendant's film;
- b) Defendant need only establish that Shipstad gave an implied non-exclusive license to Negron.

Once an implied non-exclusive license is established, whether Negron gave Defendant such authority (and this is clearly implied given the facts and logical reasoning) is a matter not for Plaintiff to argue, but rather a matter for Negron's estate to take up, should they have an issue with the use of the photo. The Court's finding of an implied non-exclusive license provided by Shipstad to Negron will show that Negron had the authority to grant an authorization to Defendant to use the photo. Such a finding will establish that Shipstad was not the sole custodian of authorization for use of the photo. Plaintiff has not, and cannot, prove that Negron did not give such an authorization.

Therefore, in the instant case, even if the court construes all facts in the favor of the Plaintiff, Negron still clearly had an implied license to use the photo as he saw fit in the promotion of his acting career, and this alone justifies Defendant's motion to dismiss. Further, Defendant also had an implied non-exclusive right to use Negron's photo in the promotion of a film in which Negron played a supporting role.

For the foregoing reasons, because Negron and/or his estate had an implied non-exclusive license to authorize use of the photo and/or because the allegedly infringing works in question were authorized for use under an implied non-exclusive license, this case should be dismissed.

**6. PLAINTIFF HAS SUED A PARTY WHO IS PROTECTED BY LAW.**

Should the court find all of the above arguments non-persuasive, Defendant respectfully asks the Court to grant our motion to dismiss all charges against Defendant Princeton Holt, since Princeton Holt is the managing member of the LLC, One Way or Another Productions, LLC. In New York State, members of a limited liability company generally may not be held personally liable for causes of actions against the LLC. *N.Y. Ltd. Liab. Co. Law § 609(a)*. Since all the facts alleged in the Amended Complaint must be inferred to be true, then the LLC is a legal entity separate and distinct from its managing member, Princeton Holt. All claims against Princeton Holt, and any future claims against others members of the LLC related to this matter, therefore, are barred as a matter of law.

**CONCLUSION**

Defendant One Way or Another, LLC & Princeton Holt respectfully request that its motion to dismiss the Amended Complaint be granted in its entirety with prejudice, and that the Court grant such other and further relief as it deems appropriate, including attorney fees and expenses, should the Court so determine.

While Defendant may have had access to Plaintiff's work and Plaintiff may even have used Plaintiff's work, Plaintiff's claim must fail as a matter of law. Aside from similarity of subject matter, "the allegedly infringing [images] do not share any meaningful similarities." *Gordon, 2015 U.S. Dist. LEXIS 129047*. By using the "reasonable observer" test, as well as the

“ordinary observer” test, and the “substantial similarity” test (if they are in fact different), in conjunction with the *Cariou* decision (and by looking at the related *Cariou* exhibits which show Prince’s before and after photographs:

[http://cyber.law.harvard.edu/people/tfisher/cx/2013\\_Cariou.pdf](http://cyber.law.harvard.edu/people/tfisher/cx/2013_Cariou.pdf)), and/or based on Defendant’s and/or Negron’s implied non-exclusive licenses to use the photograph, it is clear that judgment here should be decided in favor of the Defendant. Further, charges against Defendant Princeton Holt should be dropped as a matter of law in accordance with NY’s Limited Liability Company Law. Finally, any future charges related to the facts of this Amended Complaint against any other members of the LLC should be barred in accordance with NY’s Limited Liability Company Law.

I declare under penalty of perjury that the foregoing is true and correct.

Signed this 1<sup>st</sup> day of August, 2016.

Respectfully,

LAW OFFICES OF MONROE MANN  
s/Monroe Mann (MM 0662)

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