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10 **UNITED STATES DISTRICT COURT**
11 **SOUTHERN DISTRICT OF CALIFORNIA**

12 UNIVERSAL CITY STUDIOS
PRODUCTIONS LLLP, a Delaware
13 limited liability limited partnership,

14 Plaintiff,

15 vs.

16 SHAWN HOGAN, an individual

17 Defendant.

Case No. 06 CV 0545 W WMc

**DEFENDANT’S MOTION TO DISMISS
FOR LACK OF SUBJECT MATTER
JURISDICTION (F.R.C.P. 12(h)(3))**

**NO ORAL ARGUMENT PURSUANT TO
LOCAL RULE**

Judge: Hon. Thomas J. Whelan
Courtroom: 7
Date: November 27, 2006
Time: 10:00 AM

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20 **I. SUMMARY**

21 The Plaintiff’s complaint for copyright infringement must be dismissed for lack of subject
22 matter jurisdiction. Evidence recently obtained from the Plaintiff through discovery has revealed
23 that the Certification of Registration (“Copyright Registration”) upon which the Plaintiff is
24 relying is patently invalid. In addition, this evidence has revealed that the Plaintiff lacks standing
25 to bring and/or maintain this action before this Court. Either of these circumstances—an invalid

1 federal copyright or lack of standing—is sufficient, as a matter of law, to preclude this Court
2 from asserting subject matter jurisdiction. For this reason, Defendant Shawn Hogan does hereby
3 seek an order dismissing the Plaintiff’s complaint.

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5 **II. FACTS**

6 On March 14, 2006, Plaintiff Universal City Studios Productions, LLLP filed suit against
7 San Diego county resident, Defendant Shawn Hogan (hereinafter “Mr. Hogan”). In its
8 Complaint, which is comprised of only one cause of action, the Plaintiff alleges that Mr. Hogan
9 infringed the Plaintiff’s Copyright Registration in the motion picture *Meet the Fockers*
10 (hereinafter “Movie”) by making a copy of it available over the Internet.¹

11 Attached to the Plaintiff’s Complaint is a copy of the Copyright Registration, which makes
12 no reference whatsoever to the Plaintiff.² Rather, the Copyright Registration identifies a third-
13 party (Universal City Studios, LLLP³) as the claimant and the author. The Copyright
14 Registration contains the following statements, all of which were certified under law to be
15 correct:

- 16 1. that third-party Universal City Studios, LLP is a co-author of the Movie;
17 2. that third-party Universal City Studios, LLLP submitted the copyright application;
18 3. that third-party Universal City Studios, LLLP is the copyright claimant; and
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22 ¹ Exhibit 1, *Complaint*, ¶ 10.

23 ² Exhibt 1, *Complaint, Exhibit A*.

24 ³ Third-party Universal City Studios, LLLP is a Delaware limited liability limited partnership. It
25 is neither a parent nor subsidiary of Plaintiff.

1 4. that the individual signing the application (i.e., “Patricia Villalobos”) is the authorized
2 agent of third-party Universal City Studios, LLLP.

3 The application goes on to indicate that it was signed on January 20, 2005, by third-party
4 Universal City Studios, LLLP and received by the United States Copyright Office on January 25,
5 2005.⁴

6 Notably, the Plaintiff never alleges in its Complaint how it came to own the Copyright
7 Registration, so Mr. Hogan was initially unable to contest the issue of subject matter jurisdiction
8 and was thereby forced to file an answer.

9
10 In order to establish whether the Plaintiff actually had any rights in the Copyright
11 Registration, on and/or about August 10, 2006, Defendant propounded and served upon the
12 Plaintiff the Defendant’s Request for Production of Documents and Things (FRCP 34), Set One.⁵
13 At Request No. 3 of the Defendant’s Request for Production of Documents and Things, Mr.
14 Hogan requested that Plaintiff produce the following items:

15 “ANY AND ALL DOCUMENTS that evidence or relate to a transfer of ownership of
16 copyright registration no. PA-1-255-623.”⁶

17 On and/or about September 15, 2006, the Plaintiff responded to Mr. Hogan’s said request as
18 follows:

19 “Universal will produce, or has produced, the following document evidencing the transfer
20 of ownership of copyright registration no. PA-1-255-623: the operative assignment
21 agreement related to the copyright.”⁷

22 ⁴ Exhibit 1, *Complaint, Exhibit A*.

23 ⁵ Exhibit 2.

24 ⁶ Exhibit 2, pp. 5-6.

25 ⁷ Exhibit 3, p. 5.

1 Included with Plaintiff's said response was a copy of the "operative assignment agreement"
2 ("Assignment Agreement"). The Assignment Agreement indicated that third-party Universal
3 City Studios, LLLP had assigned all of its "right, title and interest in and to..." the Movie
4 "...including...the copyright in and to [the Movie]...."⁸ The Assignment Agreement went on to
5 indicate that third-party Universal City Studios, LLLP had divested itself of any and all rights in
6 the Movie by assigning them to the Plaintiff on November 29, 2004.⁹

7 Based upon the evidence recently uncovered, the following facts are now known:

- 8 1. that on November 29, 2004, third-party Universal City Studios, LLLP transferred all of
9 its rights in the Movie to the Plaintiff;
- 10 2. that at the time of the said assignment, there was no Copyright Registration;
- 11 3. that some two months after having assigned all "right, title and interest" in the Movie to
12 the Plaintiff, third-party Universal City Studios, LLLP applied for the Copyright
13 Registration in its own name as an author and claimant;
- 14 4. that at the time of the Copyright Registration, third-party Universal City Studios, LLLP
15 did not own any right, title, and/or interest in the Movie;
- 16 5. that the Plaintiff has not identified any document other than the Assignment Agreement
17 that it purports to evidence or relate to a transfer of ownership in and/or to the Movie
18 and/or to the Copyright Registration; and
- 19 6. that the Plaintiff's complaint for copyright infringement against Mr. Hogan is
20 specifically based upon the Copyright Registration.

21 ⁸ Exhibit 4, *Assignment Agreement*, ¶ (a).

22 ⁹ Exhibit 4, *Assignment Agreement*.

1 In light of these facts, which expose the lack of subject matter jurisdiction by this court, Mr.
2 Hogan has filed this motion.

3 **II. ARGUMENT**

4 **A. THIS COURT MUST DISMISS THE PLAINTIFF’S COMPLAINT FOR LACK OF**
5 **SUBJECT MATTER JURISDICTION BECAUSE THE COPYRIGHT**
6 **REGISTRATION IS INVALID AND UNENFORCEABLE.**

7 Whenever it appears by suggestion of the parties or otherwise that the court lacks
8 jurisdiction of the subject matter, the court shall dismiss the action.¹⁰ An action for infringement
9 may not be brought unless registration of the copyright claim has been made in accordance with
10 the Copyright Act.¹¹ Thus, “[a] copyright registration is a jurisdictional prerequisite to an
11 infringement action.”¹²

12 Only “the owner of copyright or of any exclusive right in the work may obtain registration
13 of the copyright claim....”¹³ Once an author assigns its common-law copyright in a work, it
14 thereby divests itself of all right to claim copyright in such work.¹⁴ For this reason, a copyright

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16 ¹⁰ FRCP 12(h)(3).

17 ¹¹ 17 USCS § 411.

18 ¹² *In re Napster, Inc. Copyright Litig.*, 2004 U.S. Dist. LEXIS 7236 (D. Cal. 2004) (citing 17
19 U.S.C. § 411) (A copy of this case is provided for the court as Exhibit 6). See also Nimmer & D.
20 Nimmer, 2 NIMMER ON COPYRIGHT § 7.16 (2002), citing *Chicago Bd. of Educ. v.*
21 *Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003), cert. denied, 125 S. Ct. 54 (2004).

22 ¹³ 17 USCS § 408.

23 ¹⁴ See Nimmer & D. Nimmer, 2 NIMMER ON COPYRIGHT § 5.01 (2002), citing *Ripley v.*
24 *Findlay Galleries, Inc.*, 155 F.2d 955 (7th Cir.), cert. denied, 329 U.S. 775 (1946). See also
25 *Grandma Moses Properties, Inc. v. This Week Magazine*, 117 F. Supp. 348 (D.N.Y. 1953).

1 registration obtained by a party other than the owner has no legal effect.¹⁵ Thus, a claim based
2 upon such a copyright registration must be dismissed for lack of subject matter jurisdiction.¹⁶

3 It is the plaintiff who bears the burden of demonstrating that the court has subject matter
4 jurisdiction to hear the action.¹⁷ The general rule is that “[i]n any judicial proceedings the
5 certificate of a registration...shall constitute *prima facie* evidence of the validity of the copyright
6 *and of the facts stated in the certificate.*¹⁸ However, the evidence recently disclosed by the
7 Plaintiff to *support* its claim of ownership prove exactly the opposite conclusion—that the
8 Copyright Registration *has no legal effect.*

9 The sequence of events as documented by the Plaintiff’s evidence make it clear that third-
10 party Universal City Studios, LLLP assigned *all* of its rights in the Movie two months *before* it
11 applied for the Copyright Registration. Thus, at that time of registration, third-party Universal
12 City Studios, LLLP was *not* the owner of the copyright, nor was it the owner of any of the
13 exclusive rights in the Movie. In other words, at the time of registration, third-party Universal
14 City Studios, LLLP had as much authority to apply for the Copyright Registration as did
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18 ¹⁵ *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1143 (9th Cir. 2003) (citing 17 U.S.C.
19 §§ 201(b), 501(b)) (holding that a copyright registration is invalid when obtained by the work’s
20 creator pursuant to a work-for-hire relationship), *Morgan, Inc. v. White Rock Distilleries, Inc.*,
21 230 F. Supp. 2d 104, 108 (D. Me. 2002).

22 ¹⁶ *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1143 (9th Cir. 2003).

23 ¹⁷ *Warren v. Fox Family Worldwide, Inc.*, 171 F. Supp. 2d 1057, 1060 (D. Cal. 2001) [citations
24 omitted].

25 ¹⁸ 17 USCS § 410 (emphasis added).

1 Defendant Shawn Hogan—*absolutely none!* For this reason, the Copyright Registration upon
2 which the Plaintiff is relying is simply not enforceable.

3 Federal courts have unwaveringly enforced the statutory ownership requirement by giving
4 no legal effect to copyright registrations obtained by anyone other than the actual owner of the
5 copyright in the underlying work. Where, as here, the Copyright Registration upon which the
6 pending action is based was obtained by somebody other than the actual owner in the copyright,
7 the registration is plainly and fatally defective, invalid, and unenforceable. In fact, the Copyright
8 Office *would not* have registered the subject copyright had it have known that third-party
9 Universal City Studios, LLLP was not the rightful copyright claimant at the time it submitted the
10 application.¹⁹ The Plaintiff’s attempt to nevertheless maintain this action before this Court is
11 plainly improper and must, by order of this court, cease because the Copyright Registration upon
12 which the Plaintiff is relying is fatally defective, invalid, and unenforceable. For these reasons,
13 Defendant Mr. Hogan requests that this court grant this motion and dismiss the Plaintiff’s
14 complaint for lack of subject matter jurisdiction.

15 **B. THIS COURT MUST DISMISS THE PLAINTIFF’S COMPLAINT BECAUSE THE**
16 **PLAINTIF DOES NOT HAVE STANDING TO BRING OR MAINTAIN THIS**
17 **ACTION.**

18 The law is clear. “Standing is a jurisdictional requirement, and the court must dismiss an
19 action for lack of subject matter jurisdiction if it determines that plaintiff lacks standing to assert
20 a claim.”²⁰ With regard to copyright infringement actions, the law is equally clear that only the

21 ¹⁹ See, *Code of Federal Regulations Section 201.7(b)(4)(vi)*, which states that a completed
22 registration will be cancelled where “the ‘claimant’ named in the application does not have the
23 right to claim copyright.”

24 ²⁰ *Warren v. Fox Family Worldwide, Inc.*, 171 F. Supp. 2d at 1063 (D. Cal. 2001) [citations
25 omitted].

1 legal or beneficial owner of an exclusive right under copyright has standing to assert a claim for
2 infringement.

3 “The legal or beneficial owner of an exclusive right under a copyright is entitled, subject
4 *to the requirements of section 411 [17 USCS § 411]*²¹, to institute an action for any
5 infringement of that particular right committed while he or she is the owner of it.²²

6 If a plaintiff is not the author of the copyrighted work then he or she must establish an
7 ownership interest through the chain of title in order to support a valid claim of copyright
8 infringement.²³ If the plaintiff cannot establish this ownership interest, then he/she does not have
9 standing to bring an action for copyright infringement.²⁴

10 Once again, it is the evidence recently disclosed by the Plaintiff in support of its claim of
11 copyright ownership that conclusively establishes that it lacks standing to bring and/or maintain
12 the subject action. This is because this evidence shows that either the underlying Copyright
13 Registration is invalid or that the Plaintiff does not have any right in the Movie that it can allege

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16 ²¹ 17 USCS§ 411 provides that “no action for infringement of the copyright in any work shall be
17 instituted until registration of the copyright claim has been made in accordance with this title [17
18 USCS Sects. 101 et seq.]”

19 ²² 17 U.S.C.S. § 501(b) (emphasis added).

20 ²³ *Religious Tech. Ctr. v. Netcom On-Line Commun. Servs.*, 923 F. Supp. 1231, 1241 (D. Cal.
21 1995) (citing Nimmer & D. Nimmer, 2 NIMMER ON COPYRIGHT § 12.11[C] (2002)) See
22 also *Motta v. Samuel Weiser, Inc.*, 768 F.2d 481, 484 (1st Cir.1985).

23 ²⁴ *Maljack Prods. v. Goodtimes Home Video Corp.*, 1994 U.S. Dist. LEXIS 5838 (D. Cal. 1994)
24 (A copy of this case is provided for the court as Exhibit 7). See also *Motta v. Samuel Weiser,*
25 *Inc.*, 768 F.2d at 484.

1 was infringed by Mr. Hogan. Whatever the case, the evidence is clear that the Plaintiff lacks
2 standing to bring and/or maintain this action.

3 **1. If The Assignment Agreement Is Valid, Then The Plaintiff Lacks Standing To**
4 **Bring This Action Because The Copyright Registration Is Invalid.**

5 The Copyright Act confers standing only upon those Plaintiffs who are asserting their rights
6 under a valid copyright registration. By requiring compliance with 17 USCS § 411, the
7 Copyright Act expressly requires compliance with the entire title, including the requirement in
8 17 USCS § 408 that the party applying for the copyright registration be the owner of the
9 copyright. When the party that applied for the copyright registration was *not* the owner at the
10 time of registration, then registration had not been obtained in compliance with the Copyright
11 Act and the registration is invalid and unenforceable.

12 The Plaintiff appears to claim that it has acquired rights in the Movie via the Assignment
13 Agreement. However, the Assignment Agreement was executed two months *before* the
14 Copyright Registration was applied for. If, therefore, the Assignment Agreement is effective to
15 establish chain of title, then the document is also effective to prove that third-party Universal
16 City Studios, LLLP had divested itself of all rights, title, and interest in the Movie and, therefore,
17 did not have any right to apply for and obtain the Copyright Registration. The Plaintiff can not
18 have it both ways. Either third-party Universal City Studios, LLLP assigned all “right, title and
19 interest” in the Movie and then mistakenly or fraudulently obtained the Copyright Registration in
20 its own name, or the Assignment Agreement is somehow invalid and third-party Universal City
21 Studios, LLLP properly applied for the Copyright Registration.

22 In bringing this action, the Plaintiff is relying upon an invalid Copyright Registration if it
23 alleges that the Assignment Agreement is valid. Therefore, because the Plaintiff has failed to
24 identify another valid copyright registration for the Movie, it lacks standing to bring and/or
25

1 maintain this action for copyright infringement against Mr. Hogan. For this reason, this Court
2 must dismiss this action for lack of subject matter jurisdiction.

3 **2. If Plaintiff Alleges That The Copyright Registration is Valid, Then The Plaintiff**
4 **Lacks Standing To Bring This Action Because It Has Failed To Establish Chain of**
5 **Title In The Movie.**

6 The law requires that a plaintiff asserting an ownership interest in a copyrighted work
7 document the chain of title by which it obtained its rights. The burden is on the Plaintiff to prove
8 its ownership rights.

9 If the Plaintiff alleges that the Copyright Registration is valid, than the Assignment
10 Agreement is invalid because, according to the terms of the Copyright Registration, third-party
11 Universal City Studios, LLLP is the owner of the copyright in the Movie. If, therefore, the
12 Assignment Agreement is invalid, then the Plaintiff has failed to set forth any evidence to
13 document the chain of title through which it allegedly acquired rights in the Movie. Without any
14 showing of how the Plaintiff acquired rights in the Movie, the Plaintiff lacks standing to bring
15 this suit because it has failed to establish the ownership of any right which it can claim was
16 infringed by Mr. Hogan. For this reason, this Court must dismiss the Plaintiff's complaint for
17 lack of subject matter jurisdiction.

18 **III. CONCLUSION**

19 For the reasons set forth above, Defendant Shawn Hogan moves this Court for an order
20 dismissing the Plaintiff's Complaint, without leave to amend, for lack of subject matter
21 jurisdiction.

22 Dated: October 19, 2006

s/Seyamack Kouretchian

Seyamack@CoastLawGroup.com

Coast Law Group, LLP

Seyamack Kouretchian

Attorney for Defendant, Shawn Hogan

PROOF OF SERVICE

I, the undersigned, declare that I am employed in the County of San Diego, California, and that I am over eighteen years of age and not a party to the within action and that on the date set forth below, I served the within document(s), described as: DEFENDANT'S MOTION TO DISMISS FOR LACK OF SUBJECT MATTER JURISDICTION on the following parties and non-parties in this action, addressed as follows:

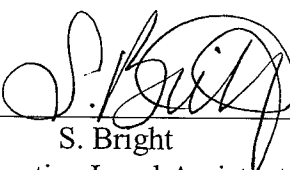
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- BY MAIL** by placing a true copy of each document listed above in a sealed envelope addressed to the parties listed on the attachment hereto and placing it for collection in a place in our office for regular pick up and/or delivery to a United States Post Office mailbox at Encinitas, California.
- BY HAND** I caused each such envelope to be delivered by hand to the addressee(s) listed above via hand delivery; express messenger.
- BY FEDERAL EXPRESS** I caused each such envelope to be delivered by placing a true copy of each document listed above in a sealed envelope for delivery via Federal Express to the addressee(s) listed above.
- BY FACSIMILE**, by causing a true and correct copy hereof to be transmitted to the parties listed above via facsimile.
- BY ECF**, by causing a true and correct copy hereof to be transmitted to the parties listed above via the CASD ECF system as registered recipients.

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

Executed on October 19, 2006, at San Diego County, California.



S. Bright
Executive Legal Assistant