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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

REVA E. PAYNE, LUCRETIA E.)
PAYNE,)
)
 Plaintiffs,)
)
 v.)
)
 ANVIL KNITWEAR, INC.,)
)
 Defendant.)
)
 _____)
)
 AND RELATED COUNTERCLAIMS)
)
 _____)
)

CV 06-8100 SW (SSx)
ORDER GRANTING DEFENDANT'S
MOTION FOR SUMMARY JUDGMENT
[12]; ORDER DENYING PLAINTIFFS'
MOTIONS TO DISMISS AND/OR SEVER
[26, 27]

I. INTRODUCTION

On December 18, 2006, Plaintiffs Reva E. Payne and Lucretia E. Payne ("Plaintiffs") lodged their copyright infringement complaint with this Court. The complaint was actually filed two months later on February 21, 2007. Plaintiffs claim that they are the sole owners and proprietors of four copyrights that have been registered with the United States Copyright Office. All of the copyrights include a picture of an anvil. Plaintiffs allege that these copyrighted works have been infringed by Defendant Anvil Knitwear, Inc. ("Anvil"), who

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has created similar anvil designs for its own products. On March 19, 2007, Anvil answered the complaint and filed counterclaims for: (1) federal trademark infringement; (2) federal unfair competition; (3) unfair competition under California Business & Professions Code § 17200; and (4) trademark infringement and unfair competition under common law. Anvil has also joined counter-defendant Success Ware, Inc. in its counterclaims, which was not one of the plaintiffs in the case.

After a status conference was held on April 23, 2007, Anvil filed a motion for summary judgment based on its prior independent creation of its anvil designs. Plaintiffs responded with two motions: (1) to sever or otherwise dismiss counter-defendant Success Ware, Inc.; and (2) to dismiss Anvil's counterclaims under Rule 8(c) under the doctrine of res judicata.

For the reasons discussed below, Anvil's motion for summary judgment is GRANTED. Additionally, Plaintiffs' motions to sever Success Ware, Inc. and dismiss Anvil's counterclaims are DENIED.

II. FACTUAL BACKGROUND

Anvil is a manufacturer of sportswear, including shirts. (Levesque Decl. ¶ 3.) Anvil sells its shirts to screen printers, embroiders, and distributors, who then sell products with the imprinted ANVIL label to retail outlets. (Id. ¶ 4.) Anvil has used a certain design on clothing since 1935, which is referred to as the "1935 Anvil Design." (Id. ¶ 5.) Anvil owns trademark registration No. 783,711 for the 1935 Anvil Design. (Id. ¶ 6 & Ex. A.)

1 In more recent years, Anvil has taken steps to create a more
2 contemporary design for its clothing products. (Id. ¶ 7.) The
3 resulting Anvil designs were created by its "in-house design team,"
4 which is part of its marketing department. (Id. ¶ 8.) In 1984, Anvil
5 created the two designs that Plaintiffs claim have infringed their
6 four registered copyrights. (Id. ¶¶ 9-10.) These "Updated Anvil
7 Designs" have been used by Anvil since at least early 1984, but no
8 later than 1989. (Id. ¶ 11; see also Exs. B-D.) In contrast,
9 Plaintiffs' copyright registrations reveal that their copyrights were
10 not created until sometime between 1996 and 1998. (Weinberger Decl.
11 Exs. A-I.)

12 The only relevant evidence supplied by Plaintiffs for purposes of
13 summary judgment is that Anvil did not submit its Updated Anvil
14 Designs for trademark registration until 1998 or later. (Pls. Opp.
15 Ex. B-3 to B-5.) However, this fact is readily conceded by Anvil.
16 (Leveque Decl. ¶ 15.)

18 **III. ANALYSIS**

19 **A. Legal Standard Governing Summary Judgment**

20 Rule 56(c) requires the Court to grant summary judgment for the
21 moving party when the evidence, viewed in the light most favorable to
22 the nonmoving party, shows that there is no genuine issue as to any
23 material fact, and that the moving party is entitled to judgment as a
24 matter of law. See Fed. R. Civ. P. 56(c); Tarin v. County of Los
25 Angeles, 123 F.3d 1259, 1263 (9th Cir. 1997).

26 The moving party bears the initial burden of establishing the
27 absence of a genuine issue of material fact. See Celotex Corp v.
28

1 Catrett, 477 U.S. 317, 323-24 (1986). That burden may be met by
2 "'showing' - that is, pointing out to the district court - that there
3 is an absence of evidence to support the nonmoving party's case." Id.
4 at 325. Once the moving party has met its initial burden, Rule 56(e)
5 requires the nonmoving party to go beyond the pleadings and identify
6 specific facts that show a genuine issue for trial. See id. at 323-34;
7 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). "A
8 scintilla of evidence or evidence that is merely colorable or not
9 significantly probative does not present a genuine issue of material
10 fact." Addisu v. Fred Meyer, Inc., 198 F.3d 1130, 1134 (9th Cir.
11 2000).

12 Only genuine disputes - where the evidence is such that a
13 reasonable jury could return a verdict for the nonmoving party - over
14 facts that might affect the outcome of the suit under the governing
15 law will properly preclude the entry of summary judgment. See
16 Anderson, 477 U.S. at 248; see also Aprin v. Santa Clara Valley
17 Transp. Agency, 261 F.3d 912, 919 (9th Cir. 2001) (holding the
18 nonmoving party must provide specific evidence from which a reasonable
19 jury could return a verdict in its favor).

20 B. Copyright Infringement and Prior Independent Creation

21 "A plaintiff must meet two requirements to establish a prima
22 facie case of copyright infringement: (1) ownership of the allegedly
23 infringed material and (2) violation by the alleged infringer of at
24 least one of the exclusive rights granted to copyright holders." LGS
25 Architects, Inc. v. Concordia Homes of Nev., 434 F.3d 1150, 1156 (9th
26 Cir. 2006). "If the plaintiff copyright holder survives the first
27 step, i.e., it establishes that it owns a valid copyright, then the
28 plaintiff must establish infringement by showing both access to its

1 copyrighted material on the part of the alleged infringer and
2 substantial similarity between the copyrighted work and the alleged
3 infringing work." N. Coast Indus. v. Jason Maxwell, Inc., 972 F.2d
4 1031, 1033 (9th Cir. 1992). Anvil contends that the Anvil Updated
5 Designs are prior independent creations that were designed long before
6 Plaintiff's copyrights were completed. While Plaintiffs' copyright
7 registrations establish that their copyrights were created between
8 1996 and 1998, it is undisputed that the Anvil Updated Designs were
9 fixed in a tangible medium of expression between 1984 and 1989 (at the
10 absolute latest). Anvil's declarations unambiguously establish the
11 Anvil Updated Designs were created approximately a decade before
12 Plaintiff's copyrights. It is irrelevant that Anvil submitted
13 trademark registration applications for the Anvil Updated Designs in
14 1998 or later. See In re World Aux. Power Co., 303 F.3d 1120,
15 1125 (9th Cir. 2002) ("Under the Act, 'copyright protection subsists
16 . . . in original works of authorship fixed in any tangible medium of
17 expression' While an owner must register his copyright as a
18 condition of seeking certain infringement remedies, registration is
19 permissive, not mandatory, and is not a condition for copyright
20 protection.") (footnotes & quotation omitted). The fact that Anvil
21 decided to wait until 1998 or later to submit its designs for
22 trademark protection does not create a genuine issue of material fact
23 as to when the Anvil Updated Designs were initially created.

24 Anvil has styled its motion as an affirmative defense of "prior
25 independent creation." In reality, the motion centers on whether
26 there is a material issue of fact regarding Anvil's alleged "access"
27 to Plaintiffs' registered copyrights since Anvil created the Anvil
28 Updated Designs years before Plaintiffs' copyrights were fixed. The

1 Ninth Circuit has held quite clearly that "[b]y simple logic, it is
2 impossible to copy something that does not exist." Christian v.
3 Mattel, Inc., 286 F.3d 1118, 1128 (9th Cir. 2002); see also 4 Melville
4 B. Nimmer & David Nimmer, Nimmer on Copyright § 13.02 ("Of course,
5 when plaintiff's dissemination occurs only after defendant's work has
6 already been created, then access is not established.").

7 As a matter of law, Anvil did not have "access" to Plaintiff's
8 copyrights because the Anvil Updated Designs were undisputedly created
9 before Plaintiff's copyrights were fixed in a tangible medium of
10 expression. As a result, Plaintiffs cannot establish infringement of
11 their copyrights and summary judgment must be granted for Anvil.

12 C. Plaintiffs' Motions

13 Plaintiffs' motions are not persuasive, especially because they
14 do not cite to a single federal case within the Ninth Circuit.
15 Plaintiffs' motion to "sever and/or drop" Success Ware Inc. is based
16 entirely on Judge Collins' discretionary decision not to accept a
17 "notice of related case" pursuant to Local Rule 83-1.3. Judge
18 Collins' case related to an appeal brought by Plaintiffs based on a
19 decision by the Trademark Trial and Appeal Board of the PTO ("TTAB").
20 However, Judge Collins' ruling was not made as a result of the
21 "unrelated" nature of the prior action. She declined to accept
22 Anvil's request because "[n]o action was ever taken by this court in
23 the prior matter, other than dismissal for failure to prosecute."
24 (Weinberger Opp. Decl. Ex. F.) For this reason, Plaintiff's motion to
25 "sever and/or drop" is without merit and is DENIED.¹

26 _____
27 ¹ According to Anvil, Plaintiffs are the principals of Success Ware,
28 Inc. Anvil represents that it has until July 17, 2007, to serve
Success Ware, Inc. The Court declines to act on Anvil's request that
it "enter an order deeming Success Ware to have been served in this

