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**APPENDIX A:  
OPINION OF THE U.S. COURT OF APPEALS  
FOR THE SECOND CIRCUIT**

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18-2955-cv, 18-2959-cv  
*James H. Fischer v. Sandra F. Forrest, et al.*

**IN THE  
UNITED STATES COURT OF APPEALS  
FOR THE SECOND CIRCUIT**

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August Term 2019

Nos. 18-2955-cv, 18-2959-cv

**JAMES H. FISCHER**

*Plaintiff-Appellant,*

v.

**SANDRA F. FORREST, SHANE R. GEBAUER,  
BRUSHY MOUNTAIN BEE FARM, INC.,  
STEPHEN T. FORREST, JR.,**

*Defendants-Appellees.*

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Appeal from the United States District Court  
for the Southern District of New York  
No. 14 Civ. 01304 (PAE-AJP),  
Paul A. Engelmayer, District Judge, Presiding.  
(Argued: December 12, 2019;  
Decided: August 4, 2020)

Before: PARKER AND CHIN, *Circuit Judges*, AND  
COTE, *District Judge*.<sup>1</sup>

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<sup>1</sup> Judge Denise Cote, of the United States District Court for the Southern District of New York, sitting by designation.

Appeal from a judgment of the United States District Court for the Southern District of New York (Engelmayer, *J.*) dismissing claims under the Copyright Act, 17 U.S.C. § 101 *et seq.* and the Digital Millennium Copyright Act, 17 U.S.C. § 1201 *et seq.*  
AFFIRMED.

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GREGORY KEENAN (Andrew Grimm, *on the brief*), Digital Justice Foundation, Floral Park, NY, *for Plaintiff-Appellant.*

DANIEL K. CAHN (Seth L. Hudson, Clements Bernard Walker, Charlotte, NC, *on the brief*), Law Offices of Cahn & Cahn, Melville, NY, *for Defendants-Appellees.*

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BARRINGTON D. PARKER, *Circuit Judge:*

James H. Fischer appeals from a judgment of the United States District Court for the Southern District of New York (Engelmayer, *J.*). The district court granted summary judgment in favor of the Defendants-Appellees, Sandra Forrest, Shane Gebauer, Stephen Forrest, Jr., and Brushy Mountain Bee Farm (“Brushy Mountain”) on Fischer’s claims of copyright infringement and copyright management information (“CMI”) removal. The controversy underlying this litigation arose from the promotion by the Forrests of their own version of a honey harvesting product. The new product replaced one Fischer had

invented and that the Forrests had sold for many years through the website and catalogue of Brushy Mountain, a company the Forrests owned. Judge Engelmayer concluded that Fischer was not entitled to statutory damages or attorneys' fees, the relief he sought on his copyright infringement claim, because the first allegedly infringing act occurred before the work was registered. *See* 17 U.S.C. § 412. The district court also concluded that Fischer failed to establish a CMI removal claim under the Digital Millennium Copyright Act ("DMCA"), 17 U.S.C. § 1201 *et seq.* We agree and accordingly, we affirm the judgment of the district court.

### **BACKGROUND**

Fischer is an apiarist who developed a product known as Fischer's Bee-Quick in 1999. Fischer's Bee-Quick is a "honey harvesting aid" that is used to clear bees from the superstructures placed on beehives where bees store honey. Bee-Quick is sprayed on a fume board, which is placed on the superstructures. The scent causes the bees to exit the structure, at which point the honey can be harvested. Bee-Quick was distinguished from the products of Fischer's competitors because it was non-toxic and did not have the offensive odor associated with other honey harvesting aids.

Brushy Mountain was a mail-order business specializing in bee-keeping supplies. It was owned and operated during the relevant period by Sandra and Stephen Forrest and Shane Gebauer, its President. Brushy Mountain circulated a catalogue of products well-known in bee-keeping circles, featuring pictures and advertisements.

Brushy Mountain began featuring Fischer's Bee-Quick in its catalogue in 2002 and described it as follows:

This 100% Natural, non-toxic blend of oils and herb extracts works just like Bee Go and it smells good! Fischer's Bee Quick is a safe, gentle, and pleasant way to harvest your honey. Are you tired of your spouse making you sleep in the garage after using Bee Go? Are you tired of using a hazardous product on the bees you love? Then this is the product for you! J. App'x at 1JA-267.

Fischer sold Bee-Quick on his own website, Bee-Quick.com, starting around 2000 and he continued to do so during the years it also was available from Brushy Mountain. The description of Bee-Quick in Fischer's brochure, which was featured on the Bee-Quick.com website, included the following phrases:

1. Are you tired of your spouse making you sleep in the garage after using Butyric Anhydride?
2. Are you tired of using hazardous products on the bees you love?
3. Fischer's Bee-Quick is a safe, gentle, and pleasant way to harvest your honey.
4. A Natural, Non-Toxic Blend of Oils and Herbal Extracts. J. App'x at 1JA-169.

Around 2010, Brushy Mountain claimed that Fischer's supply of Bee-Quick was unreliable and decided to stop offering it in its catalogue. In its place, Brushy Mountain started selling its own honey harvesting aid called Natural Honey Harvester. Brushy Mountain's January 2011 catalogue described its new product as follows:

For years we have promoted the use of a natural product to harvest honey but an unreliable supply of such a product has forced us to come out with our own. This 100% Natural, non-toxic blend of oils and herb extracts works just like Bee Go and it smells good! Natural Honey Harvester is a safe, gentle, and pleasant way to harvest your honey.

Are you tired of your spouse making you sleep in the garage after using Bee Go? Are you tired of using hazardous products on the bees you love? Then this is the product for you!  
J. App'x at 1JA-160.

This text remained in the catalogue largely unchanged through 2014 and was featured on the Brushy Mountain website through 2011.

The similarities between the two descriptions are the basis for Fischer's claims. He contends that Brushy Mountain simply replaced "Fischer's Bee-Quick" with "Natural Honey Harvester" in their advertisements, and that this substitution constitutes copyright infringement and the unlawful removal of CMI. *See* 17 U.S.C. §§ 504, 1202.

After Fischer initiated this action, initially as a pro se litigant, the parties engaged in extensive motion practice.<sup>2</sup> The claims that were not dismissed

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<sup>2</sup> The Forrests moved to dismiss Fischer's initial and amended complaints in July 2014, and those motions were denied in January 2015. Fischer then obtained counsel and filed a Third Amended Complaint in December 2015, adding Shane Gebauer and Brushy Mountain as defendants. Pretrial management was referred to Magistrate Judge Andrew J. Peck. Magistrate Judge Peck, in a thorough and thoughtful January 2017 Report & Recommendation, recommended that the district court dismiss Fischer's trademark counterfeiting and New York right of



proceeded through discovery, and eventually the Defendants-Appellees moved for summary judgment on the remaining claims. Magistrate Judge Andrew J. Peck, who was managing the pretrial activity, recommended granting the motion in its entirety in a July 2017 Report & Recommendation. The district court adopted that Report & Recommendation in full in a February 2018 order and opinion. The district court held that § 412 of the Copyright Act barred the recovery of statutory damages for copyright infringement because the alleged infringement predated the copyright registration. *See* 17 U.S.C. § 412. The district court also held that Fischer failed to establish a violation of the DMCA because the changes that Brushy Mountain had made to its catalogue did not constitute removal of CMI. This appeal followed.

### STANDARD OF REVIEW

We review a grant of summary judgment de novo, “resolving all ambiguities and drawing all permissible factual inferences in favor of the party against whom summary judgment is sought.” *FTC v. Moses*, 913 F.3d

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publicity claims, but deny the Forrests’ motion to dismiss all other claims. Judge Engelmayer adopted the Report & Recommendation in a March 21, 2017 order and opinion.

297, 305 (2d Cir. 2019).<sup>3</sup> A “court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); *see also Alabama v. North Carolina*, 560 U.S. 330, 344 (2010) (quoting *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986)).

## DISCUSSION

### I.

The Copyright Office registered Fischer’s copyright for the Bee-Quick.com website, which includes the Bee-Quick brochure, on February 7, 2011.<sup>4</sup> We assume

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<sup>3</sup> Unless otherwise indicated, in quoting cases, all internal quotation marks, alterations, emphases, footnotes, and citations are omitted.

<sup>4</sup> In February 2011, Fischer filed a copyright registration application for the text and image files of the Bee-Quick.com website. Fischer mistakenly included thousands of irrelevant documents in his application, and after the Copyright Office detected this error, he submitted a second and then third set of files on September 23 and September 24, 2011 respectively. The Defendants-Appellees disputed below that Fischer’s Bee-Quick brochure was included in the initial February submission, but Fischer maintains that the second and third submissions were subsets of the files submitted in February. The Copyright Office issued Fischer a copyright registration dated September 24, 2011, the date of his third, corrected submission. The date of the registration was changed to February 7, 2011, the date of his first submission, after he contacted the Copyright Office to clarify that

Fischer's website and the text contained in it are copyrightable creative works and the registration for the website is valid.

As noted, Fischer has elected to pursue statutory damages. A copyright infringer can be held liable for either actual damages and profits obtained or for statutory damages. 17 U.S.C. § 504(a). However, § 412 precludes statutory damages or attorneys' fees for "any infringement of copyright in an unpublished work commenced before the effective date of its registration" or "any infringement of copyright commenced after first publication of the work and before the effective date of its registration." 17 U.S.C. § 412. The Defendants-Appellees argue that § 412 bars statutory damages because the first allegedly infringing act occurred prior to February 7, 2011, the registration date of the copyright.

Fischer, on the other hand, argues that § 412 does not apply because there were no pre-registration infringements by the Defendants-Appellees. There are a host of problems with this contention. First, Fischer's pleadings repeatedly referred to the pre-

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everything that was in the later submissions was in the first submission.

registration use of the advertising text in the Brushy Mountain catalogue as infringements. For example, in the Third Amended Complaint (the operative complaint) Fischer alleged that “permission to use Plaintiff’s intellectual property in any way had been revoked, as no permission was granted to use Plaintiff’s copyrighted works in any way except specifically in the sales of [Bee-Quick].” Third Am. Compl. ¶ 26; 14 Civ. 1307, Dkt. No. 111. Fischer also alleged that the Defendants-Appellees “no longer had any of Plaintiff’s product to sell” as of March 2010 and, consequently, at that point their use of the advertising text constituted infringement. *Id.* Fischer repeated this allegation of infringement with respect to a December 10, 2010 email from Brushy Mountain informing him that it would be discontinuing Bee-Quick. Fischer alleged that “[a]t that point, Defendants immediately lost any right, license, or permission to use any of Plaintiff’s intellectual property.” *Id.* at ¶¶ 46-47. Moreover, the allegedly infringing advertisement for Natural Honey Harvester was in the Brushy Mountain catalogue mailed on January 21, 2011 and the allegedly infringing use of the Bee-Quick advertising text was on the Brushy Mountain website as early as December 26, 2010.

Faced with these obstacles to statutory damages, Fischer’s position shifted. He now argues that the

Defendants-Appellees' actions prior to his registration of the copyright are not infringements because they had a license to use his advertising material. Although Fischer posits the existence of a license, he has failed to adduce admissible evidence of its existence, much less evidence as to its scope, terms, or the dates of its creation or revocation.

In addition to being inconsistent with Fischer's pleadings, this argument was raised for the first time in his objections to the Magistrate Judge's July 2017 Report. Judge Engelmayer correctly declined to allow Fischer to make an about-face in those objections to advance a theory of liability that contradicted his pleadings and had not been raised during summary judgement proceedings before the Magistrate Judge. *See Pan Am. World Airways, Inc. v. Int'l Bhd. of Teamsters*, 894 F.2d 36, 40 n. 3 (2d Cir. 1990). We see no abuse of discretion.

Even were we to consider Fischer's new theory of liability at this late date, it would not save his claim for statutory damages. Fischer first contends that the Defendants-Appellees had a license to use Fischer's material and that the date on which that license was rescinded presents an unresolved factual issue. As noted, he has not adduced evidence sufficient to create a genuine issue of material fact as to the existence of any such license.

Fischer's other contention is that a factual issue exists as to when the first allegedly infringing act occurred. In support of this contention, Fischer claims that the date the first customers received Brushy Mountain's January 2011 catalogue—the first catalogue to offer Natural Honey Harvester with the allegedly infringing text—must be assumed to post-date his February 7, 2011 copyright registration. He fails to offer anything but speculation in support of this argument. For example, he points this Court to an order form that specified a January 21, 2011 shipping date, the authenticity of which Fischer does not contest. That date is consistent with unrefuted testimony below that established the catalogues containing the allegedly infringing material were mailed on January 21, 2011, well before the decisive registration date. Confronted with these facts, Fischer was obligated to come forth with admissible evidence creating a genuine issue of material fact as to the date of mailing. Fischer failed to do so. He points to a reference on the order form that indicated that the catalogues were initially marked for shipment on January 24, 2011 and argues that a fourteen-day shipment window would result in customers' receipt of the catalogue after the February 7 registration. This reference does nothing to help Fischer. The document simply says that the catalogues were planned to be shipped on January 24 but were, in fact, shipped on

January 21.<sup>5</sup> Speculations such as these are not an appropriate substitute for admissible evidence. As we have noted, “mere conclusory allegations, speculation or conjecture will not avail a party resisting summary judgment.” *Cifarelli v. Village of Babylon*, 93 F.3d 47, 51 (2d Cir. 1996). For these reasons, we must conclude that the first allegedly infringing act occurred before the date of the copyright registration and no genuine issue of material fact exists concerning this issue. Consequently, § 412 bars Fischer’s recovery of statutory damages.

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<sup>5</sup> In fact, Fischer cites no authority for the proposition that the relevant date for the first alleged act of infringement is the date of receipt of the catalogue by the customers. The relevant statute states that “[t]he offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display constitutes publication.” 17 U.S.C. § 101. Even on Fischer’s account, the catalogues were printed and shipped prior to his registration of the copyright.

<sup>6</sup> Fischer argues that, even if this Court finds that statutory damages are precluded pursuant to § 412, this Court should afford him declaratory relief. Fischer bases this claim on the Defendants-Appellees’ stipulation at oral argument on the summary judgment motion that they would (1) remove any links and photos containing Fischer’s name or product on Brushy Mountain’s website, and (2) not use the four advertising phrases again in the future. At the time, Fischer agreed that this mooted his request for injunctive relief. However, on appeal, Fischer claims that the Defendants-Appellees’ stipulation is “functionally a consent decree” and that this Court should grant declaratory judgment on the basis of the stipulation. He offers no support for

**III.**

Fischer next argues that the Defendants-Appellees violated the DMCA when they removed “Fischer’s Bee-Quick” from the advertising copy on the Brushy Mountain website. *See* 17 U.S.C. § 1202. The DMCA was passed in 1998 to implement two international treaties resulting from the 1996 World Intellectual Property Organization (“WIPO”) Convention. S. Rep. 105-190 at 1-2 (1998); *see also* 144 Cong. Rec. S205-02 (1998) (statement of Sen. Leahy). Congress’s intent in enacting the DMCA was to update the copyright laws of the United States for the “digital age.” *Viacom Int’l, Inc. v. YouTube, Inc.*, 676 F.3d 19, 26 (2d Cir. 2012). Generally speaking, the two major aims of the DMCA are (1) anti-circumvention of access controls, codified at 17 U.S.C. § 1201 *et seq.*, and (2) creating a safe harbor for service providers when their users or other third parties engage in infringing activities, codified at 17 U.S.C. § 512. “At its passage, the Digital Millennium Copyright Act contemplated a new world, untested in prior court decisions.” 4 Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* § 12A.06[C] (Matthew Bender, Rev. Ed.) (2020).

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that contention. Moreover, Fischer did not seek declaratory relief below. The stipulation did not concede that the text at issue was Fischer’s copyrighted work nor did it concede that the Defendants-Appellees’ use of the text was an infringement.



This appeal focuses on the anti-circumvention component of the DMCA, and specifically on the definition of CMI in § 1202(c). Section 1202 was “required by both WIPO Treaties to ensure the integrity of the electronic marketplace by preventing fraud and misinformation.” H.R. Rep. 105-551(I) at 10 (1998); *see also* S. Rep. 105-190 (1998). Section 1202 realizes this aim by “prohibit[ing] intentionally providing false copyright management information . . . with the intent to induce, enable, facilitate or conceal infringement. It also prohibits the deliberate deleting or altering [of] copyright management information.” H.R. Rep. 105-551(I) at 10. The section is intended “to protect consumers from misinformation as well as authors and copyright owners from interference with the private licensing process.” *Id.* at 10-11; *see also* Nimmer § 12A.08[A]. While the DMCA establishes certain protections for copyright holders in a digital medium, it also establishes limitations on copyright liability in the interest of promoting growth, development, and innovation in the digital universe. H.R. Rep. 105-551(I) at 11-12.

In broad strokes, § 1202(c) protects the “[i]ntegrity of copyright management information” and prohibits the removal of CMI from copyrighted works. *See* 17 U.S.C. § 1202(a)-(c). The statute describes CMI as information such as the author, title, and other identifying data about the copyright holder of the

work. In relevant part, the term “copyright management information” is defined as:

any of the following information conveyed in connection with copies . . . of a work . . . or displays of a work, including in digital form, except that such term does not include any personally identifying information about a user of a work or of a copy . . . or display of a work:

- (1) The title and other information identifying the work, including the information set forth on a notice of copyright.
- (2) The name of, and other identifying information about, the author of a work.
- (3) The name of, and other identifying information about, the copyright owner of the work, including the information set forth in a notice of copyright.
- . . .
- (6) Terms and conditions for use of the work.
- (7) Identifying numbers or symbols referring to such information or links to such information.

(8) Such other information as the Register of Copyrights may prescribe by regulation, except that the Register of Copyrights may not require the provision of any information concerning the user of a copyrighted work.

17 U.S.C. § 1202(c). To establish a violation of this subsection, a litigant must show (1) the existence of CMI on the allegedly infringed work, (2) the removal or alteration of that information and (3) that the removal was intentional. 17 U.S.C. § 1202(b).

Fischer alleges that his name is CMI and that by deleting the phrase “Fischer’s Bee-Quick” and replacing it with “Natural Honey Harvester,” the Defendants-Appellees violated § 1202(c) by removing his name from copyrighted material. This assertion misunderstands what constitutes CMI.

While an author’s name can constitute CMI, not every mention of the name does. Here, “Fischer’s” is part of a product name; it is not a reference to “James H. Fischer” as the owner of a copyrighted text. Nor is the name “[t]he title and other information identifying the work” or the “[t]he name of, and other identifying information about, the author of the work” as required by the statute. *See* 17 U.S.C. § 1202(c)(1)-(3). We grant that Natural Honey Harvester was designed as a

closely resembling alternative to Fischer's Bee-Quick, and that the advertising copy used on Brushy Mountain's website and catalogue for Natural Honey Harvester mirrors the advertising copy that had been used for Fischer's Bee-Quick. However, what was removed was not Fischer's name as the copyright holder of the advertising text, but "Fischer's" insofar as it was a part of the actual product's name.

Judge Engelmayer provided an example to illustrate the problem with Fischer's approach:

Imagine that the back cover of the Ian Fleming novel *Dr. No*. contained the following encomium: "In Ian Fleming's *Dr. No*, Fleming shows his mastery of Cold War spycraft." Imagine then that a person lifted language from that review to promote a different thriller, writing: "In John Le Carré's *Tinker, Tailor, Soldier, Spy*, Le Carré shows his mastery of Cold War spycraft." Whatever the other legal implications of such conduct might be, it is inconceivable that a DMCA claim would lie from the elimination of Fleming's name. The expression at issue does not connote Fleming's copyright ownership of anything.

*Fischer v. Forrest*, 286 F.Supp.3d 590, 611 (S.D.N.Y. 2018). Similarly, “Fischer’s Bee-Quick” used in material published by a third party like Brushy Mountain, which contains advertisements for dozens of other products from many different suppliers, cannot be reasonably construed as an identifier of the copyright holder of the advertising text. In other words, “Fischer’s” in “Fischer’s Bee-Quick” is not used for ‘managing’ copyright information with respect to the text at issue.

The name of an author can, of course, constitute CMI when conveyed in connection with the relevant copyrighted work. 17 U.S.C. § 1202(c). But “Fischer’s” cannot be construed as CMI with respect to the advertising text at issue because it is simply the name of the product being described. In short: context matters.

## CONCLUSION

We have considered Fischer’s remaining arguments and conclude they are without merit. The judgment of the district court is **AFFIRMED**.

**APPENDIX B:  
ORDER DENYING REHEARING**

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**UNITED STATES COURT OF APPEALS  
FOR THE  
SECOND CIRCUIT**

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At a stated term of the United States Court of Appeals for the Second Circuit, held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the City of New York, on the 15th day of October, two thousand twenty.

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James H. Fischer

Plaintiff – Appellant,

**ORDER**

v.

Docket No. 18-2955

Sandra F. Forrest, Shane R. Gebauer,  
Brushy Mountain Bee Farm, Inc.,  
Stephen T. Forrest, Jr.,

Defendants – Appellees.

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Appellant, James H. Fischer, filed a petition for panel rehearing, or, in the alternative, for rehearing *en banc*. The panel that determined the appeal has considered the request for panel rehearing, and the active members of the Court have considered the request for rehearing *en banc*.

21A

IT IS HEREBY ORDERED that the petition is denied.

FOR THE COURT:  
Catherine O'Hagan Wolfe, Clerk

[SECOND CIRCUIT SEAL]

**APPENDIX C:  
DISTRICT COURT ORDER DENYING REHEARING**

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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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JAMES H FISCHER,

Plaintiff,

-v-

STEPHEN T. FORREST, SANDRA F. FORREST,

Defendants.

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14 Civ. 1304 (PAE)

14 Civ. 1307 (PAE)

**ORDER**

PAUL A. ENGELMAYER, District Judge:

This order resolves the motion of plaintiff James H. Fischer (“Fischer”), proceeding *pro se*, for reconsideration of the Court’s decision granting summary judgment to defendants. As explained below, the Court denies that motion.

**I. Background**

On February 16, 2018, this Court adopted the Report and Recommendation of Magistrate Judge Andrew J. Peck, which recommended granting



defendants Stephen T. Forrest and Sandra F. Forrest's (the "Forrests") motion for summary judgment. *See* Dkt. 197 ("SJ Opinion"); Dkt. 184 ("R&R"). The Court's decision held that Fischer could not recover statutory damages because the Forrests' first infringing act predated Fischer's copyright registration, SJ Opinion at 14-19; the Court rejected Fischer's attempt to recast his complaint to embrace an alternative theory of the case. *See id.* at 15-19. The Court also held that defendants were not secondarily liable for the infringement of other vendors. *Id.* at 20-21. As to Fischer's claims under the Digital Millennium Copyright Act, the Court held that defendants had not removed copyright management information from an original work of Fischer's. *Id.* at 23-29. On Fischer's Lanham Act unfair competition claim, the Court held that Fischer had failed to show a likelihood of consumer confusion. *Id.* at 30-38. The same analysis interred Fischer's claim for unfair competition under New York law. *Id.* at 38. Finally, the Court held that Fischer could not make out a claim for false advertising under the Lanham Act because, as to the defendants' statements at issue, the evidence demonstrated no literal or implied falsity. *Id.* at 39-41.

On March 16, 2018, Fischer, now proceeding *pro se*, moved for reconsideration of the SJ Opinion. Dkt. 202 ("Pl. Br."). In support of that motion, Fischer submitted a document styled as a "56(e)(1) Response." Dkt. 204 ("56.1 Response").

ON March 30, 2018, the Forrests filed a brief in opposition to Fischer’s reconsideration motion, Dkt. 209 (“Def. Br.”) and a motion to strike Fischer’s 56.1 Response, Dkt.s 207, 208.

On April 22, 2018, Fischer filed a reply brief in support of his motion for consideration, Dkt. 216 (“Pl Reply Br.”), as well as a brief in opposition to defendants’ motion to strike, Dkt. 215.

On May 1, 2018, the Forrests filed a reply brief in further support of their motion to strike. Dkt. 217.

## **II. Discussion**

The Court denies Fischer’s motion for reconsideration. Rule 59(e) “allows a district court ‘to alter or amend a judgment.’” *ING Glob. V. United Parcel Serv. Oasis Supply Corp.*, 757 F.3d 92, 96 (2d Cir. 2014) (quoting Fed. R. Civ. P. 59(e)). To prevail on a request for such relief, the moving party must demonstrate “an intervening change of controlling law, the availability of new evidence, or the need to correct a clear error or prevent manifest injustice.” *Virgin Atl. Airways, Ltd. V. Nat’l Mediation Bd.*, 956 F.2d 1245, 1255 (2d Cir. 1992) (quoting 18 C. Wright, A. Miller & E. Cooper, *Federal Practice & Procedure* § 4478 at 790).

In his briefs in support of his reconsideration motion, Fischer advances a host of arguments attacking the Court’s SJ Opinion, Judge Peck’s Report and Recommendation, and the Forrests’ counsel’s defense

of this action. Taken together, those arguments do not suffice to warrant reconsideration of the SJ opinion.

First, Fischer has not pointed to any change in the applicable law. Rather, he argues that the Court misapplied the governing standards. That is not a proper basis for seeking reconsideration. In any event, the Court stands by its rulings. Fischer's recourse is to appeal to the United States Court of Appeals for the Second Circuit. To the extent that Fischer's motion for reconsideration relies on attempts to revise his allegations or his theory of the case to avoid the Court's ruling that he may not recover statutory damages, such a recasting of his allegations is improper on a motion for reconsideration.

Second, Fischer has not identified any new evidence supporting his claim. Rather, in his reply brief in support of his motion, Fischer now imagines that additional information would support his claim but was wrongly withheld by the defense in discovery. *See* Reply Br. at 2. But Fischer's claim is nothing more than rank speculation. *Id.* at 3. The evidence on which he does rely is the same evidence put before the Magistrate Judge and this Court. And in any event, a dispute as to the fulsomeness of defendants' discovery should have been raised—as were several disputes, including as to the Forrests' uses of general objections in their discovery objections, *see* Dkt. 151—during discovery, or, at the very latest, as an objection to the

R&R; Fischer did not raise these concerns at any point.

Finally, Fischer has not demonstrated that the Court's opinion imposes a manifest injustice or relies on a clear error of law. To the extent he believes the Court's decision rests on an error of law—clear or otherwise—that argument must now be addressed to the Court of Appeals.

Because the Court denies Fisher's request for reconsideration, the Court has found it unnecessary to consider the Forrests' motion to strike the 56.1 Responses Fischer filed in support of his reconsideration motion.

## CONCLUSION

For the reasons stated above, Fischer's motion for reconsideration is denied. The Clerk of Court is respectfully directed to close the motions pending in 14 Civ. 1304 at Dkts. 202 and 207, and in 14 Civ. 1307, at Dkts. 199 and 203. These cases remain closed.

SO ORDERED.

[signature]  
Paul A. Engelmayer  
United States District Judge

Dated: August 29, 2018  
New York, New York



**APPENDIX D:  
DISTRICT COURT ORDER GRANTING SUMMARY  
JUDGMENT**

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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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JAMES H FISCHER,

Plaintiff,

-v-

STEPHEN T. FORREST, JR., SANDRA F. FORREST,  
SHANE R. GEBAUER, and BRUSHY MOUNTAIN  
BEE FARM, INC.,

Defendants.

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14 Civ. 1304 (PAE) (AJP)

14 Civ. 1307 (PAE) (AJP)

**OPINION & ORDER**

These consolidated cases arise out of the termination of a longstanding relationship between plaintiff James H. Fischer and defendants Stephen T. Forrest, Jr., Sandra F. Forrest, Shane R. Gebauer, and Brushy Mountain Bee Farm, Inc. (“Brushy” and collectively, “Defendants”). Fischer alleges that the Defendants used his likeness and proprietary text and images to promote their own competing knock-off version of his

product, Bee-Quick, a honesty harvesting aid. He brings claims under the Copyright Act, 17 U.S.C. § 101 *et seq.*, the digital Millennium Copyright Act (“DMCA”), 17 U.S.C. § 1201 *et seq.*, and the Lanham Act, 15 U.S.C. § 1051 *et seq.*, along with a claim under New York law for unfair competition.

Pending now are Brushy’s motion for summary judgment. In a thorough and persuasive Report and Recommendation, the Honorable Andrew J. Peck, United States Magistrate Judge, has recommended granting these motion. For the reasons that follow, the Court agrees, and grants these motions in their entirety.

## **I. Background<sup>1</sup>**

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<sup>1</sup> This summary of the factual and procedural history of this matter draws upon the following submissions (and exhibits thereto): Fischer’s Second Amended Complaints, 14 Civ. 1304, Dkt. 50 (“SAC 04”), and 14 Civ. 1307, Dkt. 70 (“SAC 07”); Fischer’s Third Amended Complaints, 14 Civ. 1304, Dkt. 90 (“TAC 04”), and 14 Civ. 1307, Dkt. 111 (“TAC 07”); Defendants’ motions for summary judgment, 14 Civ. 1304, Dkt. 175 and 14 Civ. 1307, Dkt. 177 (“Def. Br.”); Fischer’s memoranda in opposition to these motions, 14 Civ. 1304, Dkt. 178, and 14 Civ. 1307, Dkt. 179 (Pl. Br.); 14 Civ. 1304, Dkt. 184 and 14 Civ. 1307, Dkt. 185 (“R&R 2” or “the Report”); Fischer’s objections to the Report, 14 Civ. 1304, Dkt. 191, and 14 Civ. 1307, Dkt. 188 (“Obj.”); Brushy’s response to Fischer’s objections, 14 Civ. 1304 Dkt. 193, and 14 Civ. 1307, Dkt. 189 (“Def. Obj. Resp.”); and Fischer’s reply to Defendants’ response to his objections. 14 Civ. 1304, Dkt. 196, and 14 Civ. 1307, Dkt. 192 (“Pl. Obj. Reply”).

## A. Facts

### 1. The Parties

Since 1999, Fischer, an apiarist, has successfully sold the product Bee-Quick. TAC 04 ¶ 26.<sup>2</sup> Fischer promotes “Bee-Quick” as a unique “honey harvesting aid” that it is “food-safe, non-toxic, not foul smelling, and effective.” *Id.*

In 2000, Fischer began using the following four phrases, among others, in conjunction with the sale of Bee-Quick on his website:

1. “Are you tired of your spouse making you
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<sup>2</sup> The two cases addressed herein, 14 Civ. 1304 and 14 Civ. 1307, have been litigated in tandem. On February 27, 2014, Fischer filed similar suits under these docket numbers against Stephen and Sandra Forrest. On June 19, 2014, the Court stated that it was inclined to consolidate the two cases and invited the parties’ views. Dkt. 37. Fischer, then *pro se*, objected to the consolidating, stating that combining the suits would impair his ability to recover separate awards for direct and contributory infringement. *See* Dkt. 41 (citing 17 U.S.C. § 504 and *Arista Records LLC v. Lime Grp. LLC*, No. 06 Civ. 5936 (KMW), 2011 WL 1338194, at \*3 (S.D.N.Y. Apr. 7, 2011)). In an order dated July 2, 2014, this Court declined to consolidate the cases. *See* Dkt. 44. However, the Court determined that the two cases should be dealt with in concert. *Id.* As a result, the parties’ filing in the two cases relevant to the pending motions are substantially identical. Accordingly, for brevity, the Court henceforth will cite to the submission in 14 civ. 1307 unless otherwise indicated.



sleep in the garage after using Butyric Anhydride?”

2. “Are you tired of using hazardous products on the bees you love?”

3. “Fischer’s Bee-Quick is a safe, gentle, and pleasant way to harvest your honey.”

4. “A Natural, Non-Toxic Blend of Oils and Herbal Extracts.”

*See* SAC 04 Ex. 5. Fischer has created non-website advertisement for Bee-Quick using some of the above phrases. *See, e.g., id.*

Stephen and Sandra Forrest (“the Forrests”) are the founders of Brushy Mountain Bee Farm Inc. (“Brushy”). Dkt. 175 (“Stephen Forrest Decl.”) ¶ 2. Brushy is a mail-order business that primarily deals in bee-keeping supplies. *Id.* ¶¶ 2-3. In 2007, the Forrests hired Shane Gebauer, Brushy’s current President. Dkt. 173 (“Gebauer Decl.”) ¶ 1; Dkt. 180, Ex. B (“Gebauer Dep.”) at 6.

According to Gebauer, between 2008 and 2013, he worked collaboratively with the Forrests on the Brushy catalogue and website. Gebauer Dep. At 24, 26-29; Dkt. 180 Ex. D. (“Sandra Forrest Dep. 2”) at 6-7. This collaboration entailed, among other things, selecting photographs and texts for the products Brushy sold online and through its catalogue. Gebauer Dep at 27-32. To that end, Gebauer attests, Brushy “would

draft its own copy [and] describe the products that it had purchased from other vendors that it was reselling.” *Id.* at 29. Today, Gebauer works with others “to review and approve the Brushy Mountain Bee Farm catalogue.” *Id.* at 31.

The Forrests attest that, around 2009, they largely stopped working on the Brushy catalogue. Dkt. 180 Ex. C. (“Stephen Forrest Dep. 2”) at 26-27, Sandra Forrest Dep. 2 at 5; Dkt. 176 Ex. C (“Sandra Forrest Dep 1”) at 17. When they did work on the catalogue, however, they generally did so in the manner described by Gebauer. *See* Sandra Forrest Dep. 2 at 6 (“We would read what the supplier had to say and then we would write it up in a way we thought would be best to describe the product to our customers.”) *id.* Stephen Forrest Dep 2 at 12 (“I believe we wrote [product descriptions] when Sandy and I were doing it.”).

As of 2014, the Forrests “ceased having any equity interest in Brushy Mountain Bee Farm, Inc.” Gebauer Dep. At 9. Brushy Mountain Bee Farm Holdings, Inc. obtained the Forrests’ equity in Brushy. *Id.* at 8.

## **2. The Fischer-Brushy Relationship**

In 2002, Brushy began selling Bee-Quick. Dkt 174 (“Sandra Forrest Decl.”) ¶ 2; Stephen Forrest Decl ¶¶ 4-5. At that point, Fischer alleges, Brushy became an “Authorized Dealer” of the product. TAC 04 ¶ 32.

Stephen Forrest denies this. He attests that Fischer and Brushy never had a written contract. Stephen Forrest Decl ¶ 4; *see also* Dkt. 176 Ex. A (“Fischer Dep.”) at 9; Gebauer Decl. ¶ 3.

From 2002 onwards, Brushy used the following words (or similar ones to it) to promote Bee-Quick in advertisements:

This 100% Natural, non-toxic blend of oils and herb extracts works just like Bee go and it smells good! Fischer’s Bee Quick is a safe, gentle, and pleasant way to harvest your honey. Are you tired of your spouse making you sleep in the garage after using Bee Go? Are you tired of using a hazardous product on the bees you love? Then this is the product for you!

Sandra Forrest Decl. ¶ 3; Gebauer Decl. ¶ 14 & Ex F. Sandra Forrest claims that she wrote the above text, although she and Stephen Forrest recalled with certainty only that they wrote the phrase: “Are you tired of your spouse making you sleep in the garage?” Sandra Forrest Dep. 1 at 8-9; Dkt. 176 Ex. D. (“Stephen Forrest Dep. 1”) at 19. Fischer attests that the Forrests did not author this text. *See* Dkt. 180 Ex. E (“Fischer Aff.”) at 1.

### **3. Termination of the Fischer-Brushy Relationship**

Around 2010, Brushy allegedly began having trouble obtaining Bee-Quick and decided to sell its own version of the product, Natural Honey Harvester, which it obtains from a third-party vendor. Gebauer Dep. at 54-56, 71.; Stephen Forrest Dep. 2 at 36. As a result, on December 10, 2010, a Brushy employee sent Fischer an email stating that Brushy would not be selling Bee-Quick in its 2011 catalogue and asking for an address to which it could ship back its remaining Bee-Quick supply. *See* SAC 04 Ex. 3b (December 10, 2010 Email).

Fischer asserts that, as a result of the December 10, 2010 email, “Defendants immediately lost any right, license, or permission to use any of [his] intellectual property, as all such use was permitted solely in the selling of Plaintiff’s product.” *See* TAC 04 ¶ 35; TAC 07 ¶ 47. Defendants accept this proposition in their motions for summary judgment. On the bases of the parties’ common attestations, the Court for purposes of this lawsuit, assumes that as of December 10, 2010, Brushy no longer had any “right,” “license” or “permission” to use Fischer’s intellectual property.

Fischer did not, however, communicate to Brushy that it no longer had such permission to use his intellectual property until April 2011, when Fischer sent a cease and desist letter, alleging, *inter*

*alia*, that Brushy was engaged in “copyright infringement.” See Gebauer Decl. Ex. D. In a letter dated April 14, 2011, Gebauer replied that “there [did] not seem to be grounds for [Fischer’s] request,” and that Brushy would “review” Fischer’s concerns if he was more “specific.” Gebauer Decl. Ex. E. Fischer does not appear to have responded.

After Brushy’s December 10, 2010 email, Brushy did not immediately remove Bee-Quick from its website. Gebauer Decl. ¶¶ 13-14 & Ex. F. On December 26, 2010, Bee-Quick was still listed for sale there. See *id.* And photos of Bee-Quick remained on Brushy’s website until at least January 28, 2011, at which point they appeared to have been replaced by photos of Natural Honey Harvester. Gebauer Decl. ¶ 15. Further, Fischer has adduced exhibits indicating that an image of Bee-Quick remained on Brushy’s website until at least March 3, 2014. See SAC 04 Exs. 9-12, see also Fischer Arr. at 10 (attesting that links to images of Bee-Quick on Brushy website were still operable as of May 8, 2017).

On January 21, 2011, Brushy shipped its 2011 catalogue advertising Natural Honey Harvester. Def. Br. Ex. 6 at 2-3, Def. Br. Ex. 7 (“Twete Aff.”) ¶¶ 3-4 & Exs. A-B. The text in the 2011 catalogue was as follows:

For years we have promoted the use of  
a natural product to harvest honey but

an unreliable supply of such a product has forced us to come out with our own. This 100% Natural, non-toxic blend of oils and herb extracts works just like Bee Go® and it smells good! Natural Honey Harvester™ is a safe, gentle, and pleasant way to harvest your honey. Are you tired of your spouse making you sleep in the garage after using Bee Go®? Are you tired of using hazardous products on the bees you love? Then this is the product for you!

Def. Br. Ex. 6 at 3. Gebauer attests that Stephen Forrest came up with the name “Natural Honey Harvester” and that he and Stephen Forrest collaborated on the catalogue text. Gebauer Dep. At 55, 23. In contrast, Stephen Forrest attests that Gebauer came up with this wording. Stephen Forrest Dep. 1 at 37. Between 2012 and 2014, the above text remained largely unchanged in Brushy's catalogues, *see* SAC 07 Ex. 20 (excerpts from Brushy's catalogues), and it remained online until at least December 28, 2011, *id.* Ex. 8. Two of Brushy's third-party vendors, The Honey Hole and C&T Bee Supply, used this advertisement in 2012 and 2014. *See* SAC 07 Exs. 21-22.

On February 7, 2011, Fischer filed a copyright registration for the “text and images of [his] Bee-Quick.com website.” TAC 04 ¶ 41; Def. Br. Ex. 4.

According to Fischer, Defendants removed Copyright Management Information ("CMI") from his photographs and other unspecified copyrighted works. Fischer Dep. at 133, 137. As to the photographs, Fischer claims that Defendants removed metadata from a Bee-Quick photo he provided them, Fischer Dep. at 137, and put their own watermark over his photo, TAC ¶ 141. With respect to non-photographic materials, although Fischer's claims as to the precise source of the CMI at issue are elusive,<sup>3</sup> Fischer alleges

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<sup>3</sup> Fischer has not been consistent as to the specific materials, other than his photographs, from which Defendants allegedly removed CMI. In his third amended complaint, Fischer alleged that he had sent Brushy "layout ready text," *see e.g.*, TAC 04 ¶ 92, in a later affidavit, Fischer stated that the "epigrams" were available online, Fischer Aff. at 4, and in his deposition, Fischer appeared to claim that CMI had been removed from his brochure, *see* Fischer Dep. at 137 (Q: "[H]ow many sentences are you alleging [Defendants] removed from your brochure?" A: "Four"). In the same deposition, however, Fischer stated that he was "not alleging [that Brushy] ever made a copy of my brochure without the copyright notice." *Id.* at 133 (emphasis added), and, in a later affidavit in opposition to summary judgment, Fischer stated that there is "clear intentional removal of CMI from the copyrighted Works misused on both the website and in the catalog, specifically, the removal of the word 'Fischer' (the author's name) from the text Works, and its replacement with 'Natural Honey Harvester.'" Fischer Aff. at 6. Judge Peck's Report took the brochure as the "source" material for Fischer's DMCA claim. Although Fischer's varying articulations have made it hard to pin down his theories as to the material(s) from which his CMI was wrongfully removed, the Court, in the interests of completeness and of

that when Defendants began selling Natural Honey Harvester, they altered their online and print advertisements by replacing, inter alia, the term "Fischer's Bee-Quick" with "Natural Honey Harvester" in a sentence describing the product. *See* Fischer Dep. at 131-33, 137, Fischer Arr. at 6, *see also* *Fischer v. Forrest*, 14 Civ. 1304, 2015 WL 195822 at \*8 (S.D.N.Y. Jan. 13, 2015) ("[T]he Bee-Quick brochure attached to the complaints . . . stated that 'Fischer's Bee-Quick is a safe, gentle, and pleasant way to harvest your honey.' . . . Brushy Mountain replaced the textual reference to 'Fischer's Bee-Quick' with the words 'Natural Honey Harvester.'"). Fischer argues that these acts constitute unlawful CMI removal. Defendants deny ever removing any CMI or metadata. Gebauer Decl. 'H 8, Sandra Forrest Decl. ¶ 8, Stephen Forrest Decl. ¶ 9.

## **B. Procedural History**

### **1. Earlier Proceedings**

On July 9, 2014, defendants Stephen and Sandra Forrest moved to dismiss Fischer's pro se complaints. In a decision issued January 13, 2015, the Court denied those motions. 14 Civ. 1304, Dkt. 45, 14 Civ. 1307, Dkt. 65 (collectively, "First MTD").

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fairness to Fischer, addresses each of the theories Fischer has articulated, in the light most favorable to him.



On December 28, 2015, Fischer filed a Third Amended Complaint in each action. *See* TAC 04; TAC 07. After Defendants moved to dismiss various claims, see 14 Civ. 1304, Dkts. 102-110, 14 Civ. 1307, Dkts. 123-129, the Court referred the motions to dismiss to the Honorable Henry Pitman, United States Magistrate Judge, for a Report and Recommendation, having earlier referred the cases to Judge Pitman for general pre-trial supervision. On December 15, 2016, these referrals were reassigned to Judge Peck.

On January 13, 2017, Judge Peck issued a Report and Recommendation, 14 Civ. 1304, Dkt. 132, 14 Civ. 1307, Dkt. 147 ("R&R 1"), as to the pending motions to dismiss. On January 27, 2017, Fischer filed objections to R&R 1, 14 Civ. 1304, Dkt. 137; 14 Civ. 1307, Dkt. 150, and on February 10, 2017, Defendants filed responses to these objections, 14 Civ. 1304, Dkt. 141; 14 Civ. 1307, Dkt. 151. On March 21, 2017, this Court adopted the entirety of R&R 1 in a written opinion. 14 Civ. 1304, Dkt. 153, 14 Civ. 1307, Dkt. 161. The Court thereby dismissed Fischer's trademark infringement claims and his New York right of publicity claim against all defendants. The Court also dismissed Fischer's copyright infringement claims against Gebauer that had accrued before February 3, 2012 and those against Brushy that had accrued before December 28, 2012.

## **2. Defendants' Motions for Summary Judgment**

On April 19, 2017, following discovery, Defendants filed motions for summary judgment, 14 Civ. 1304, Dkt. 170, 14 Civ. 1307, Dkt. 172, as well as memoranda outlaw in support, 14 Civ. 1304, Dkt. 175, 14 Civ. 1307, Dkt. 177 ("Def. Br."). On May 8, 2017, Fischer filed memoranda in opposition. 14 Civ. 1304, Dkt. 178, 14 Civ. 1307, Dkt. 179 ("Pl. Br."). On May 15, 2017, Defendants filed reply memoranda. 14 Civ. 1304, Dkt. 180, 14 Civ. 1307, Dkt. 181 ("Def. Reply Mem.").

On July 14, 2017, Judge Peck issued a thorough (59-page) Report and Recommendation on the motions for summary judgment. 14 Civ. 1304, Dkt. 184; 14 Civ. 1307, Dkt. 185 ("R&R 2" or "the Report"). The Report recommends granting these motions in their entirety. On August 25, 2017, Fischer filed objections. 14 Civ. 1304, Dkt. 191; 14 Civ. 1307, Dkt. 188 ("Obj."). On August 25, 2017, Defendants filed a response. 14 Civ. 1304 Dkt. 193, 14 Civ. 1307, Dkt. 189 ("Def. Obj. Resp."). On September 12, 2017, Fischer filed a reply. 14 Civ. 1304, Dkt. 196, 14 Civ. 1307, Dkt. 192 ("Pl. Obj. Reply"),

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## II. Legal Standards

### A. Reports and Recommendations

After a magistrate judge has issued a Report and Recommendation, a district court may "accept, reject, or modify, in whole or in part, the findings or recommendations made by the magistrate judge." 28 U.S.C. § 636(b)(1). To accept the portions of a report to which no timely objection has been made, "a district court need only satisfy itself that there is no clear error on the face of the record." *Acevedo v. Lempke*, No. 10 Civ. 5285 (PAE) (HBP), 2014 WL 4651904, at \*3 (S.D.N.Y. Sept. 17, 2014) (quoting *King v. Greiner*, No. 02 Civ. 5810 (DLC), 2009 WL 2001439, at \*4 (S.D.N.Y. July 8, 2009)). When a timely and specific objection has been made, the court is obligated to review the contested issues de novo. *See id.*; Fed. R. Civ. P. 72(b)(3), *Hynes v. Squillace*, 143 F.3d 653, 656 (2d Cir. 1998). But when the objections simply reiterate previous arguments or make only conclusory statements, the court should review the Report and Recommendation for clear error. *Dickerson v. Conway*, No. 08 Civ. 8024 (PAE) (FM), 2013 WL 3 199094, at \*1 (S.D.N.Y.

June 25, 2013); *see also Kirk v. Burge*, 646 F. Supp. 534, 538 (S.D.N.Y. 2009) (collecting cases). Further, "[c]ourts generally do not consider new evidence raised in objections to a magistrate judge's report and recommendation." *Tavares v. City of New York*, No. 08 Civ. 3782 (PAE), 2011 WL 5877548, at \*2 (S.D.N.Y. Nov. 23, 2011), *see also Pan Am. World Airways v. Int'l Bhd. of Teamsters*, 894 F.2d 36, 40 n.3 (2d Cir. 1990) ("A district judge is not required to hear or rehear any witness, and Pan Am had no right to present further testimony when it offered no justification for not offering the testimony at the hearing before the magistrate.").

### **B. Motions for Summary Judgment**

To prevail on a motion or summary judgment, the movant must "show . . . that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). The movant bears the burden of demonstrating the absence of a question of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

When the movant has properly supported its motion with evidentiary materials, the opposing party must establish a genuine issue of fact by "citing to particular parts of materials in the record." Fed. R. Civ. P. 56(c)(1), *see also Wright v. Goord*, 554 F.3d 255, 266 (2d Cir. 2009). An issue of fact is "genuine" if the evidence is such that a reasonable jury could return a

verdict or the non-moving party. *SCR Joint Venture L.P. v. Warshawsky*, 559 F.3d 133, 137 (2d Cir. 2009). "[A] party may not rely on mere speculation or conjecture as to the true nature of the facts to overcome a motion for summary judgment." *Hicks v. Baizes*, 593 F.3d 159, 166 (2d Cir. 2010) (internal quotation marks and citation omitted). "Only disputes over facts that might affect the outcome of the suit under the governing law" will preclude a grant of summary judgment. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). In determining whether there are genuine issues of material fact, the Court is "required to resolve all ambiguities and draw all permissible factual inferences in favor of the party against whom summary judgment is sought." *Johnson v. Killian*, 680 F.3d 234, 236 (2d Cir. 2012) (quoting *Terry v. Ashcroft*, 336 F.3d 128, 137 (2d Cir. 2003)).

### **III. Discussions**

Fischer makes several objections to the Report. See Obj. at 1-2.

#### **A. Fischer's Claim for Statutory Damages for Direct Copyright Infringement**

Fischer objects on two grounds to the Report's recommendation that he cannot obtain statutory damages for direct copyright infringement. First, he argues that Judge Peck, in determining the date of Brushy's first infringing act, wrongly relied on an

affidavit that should have been excluded. Obj. at 2-4. Second, he argues that the Report is wrong that he cannot recover statutory damages because Brushy's first infringing act predated Fischer's copyright registration. Id. at 4-6. The Court reviews these arguments in turn, after first reviewing the background legal standards.

### 1. Applicable Legal Standards

"Under the Copyright Act, a copyright infringer can be held accountable for either actual damages and profits of the infringer or statutory damages." *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16 Civ. 724 (LTS), 2016 WL 4126543, at \*2 (S.D.N.Y. Aug. 2, 2016) (citing 17 U.S.C. § 504(a)). Statutory damages under the Act are designed to "discourage wrongful conduct," as well as to provide "reparation for injury." *F. W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228, 233 (1952).

"In order to obtain statutory damages and attorneys' fees, a plaintiff must have registered its copyright prior to the alleged infringement." *Solid Oak Sketches, LLC*, 2016 WL 4126543 at \*2 (citing 17 U.S.C. § 412 and *Knitwaves, Inc. v. Lollyfogs Ltd.*, 71 F.3d 996, 1012 (2d Cir. 1995)). "Courts in this district have held that Section 412 of the Copyright Act imposes a bright-line rule that precludes recovery of statutory damages and attorneys' fees where the first act of infringement in a series of ongoing infringements

occurred prior to the work's copyright registration.”  
*Id.*

As explained below, this rule, given the dates when Brushy used the allegedly infringing advert ser-pents, precludes Fischer from recovering statutory damages as a matter of law.

## **2. Amanda Twete Affidavit**

Fischer objects to the Report's consideration of the affidavit of Amanda Twete, which Defendants of-fered in support of summary judgment. Obj. at 2-4. In fact, the Twete affidavit was properly admitted and considered in the Report.

Twete attests that she works "as the Mailroom Supervisor for Midstates Group," Twete Aff. ¶ 2, , that Midstates shipped Brushy's 2011 catalogue, id 1] 3, that it did so on January 21, 2011, *id.* ¶ 4, and that she "would expect" some, if not all, of Brushy's 2011 cata-logues to have been received "within 7-14 days from the shipment date of January 21, 2011," *id.* ¶ 6. Twete's affidavit attaches two exhibits. Exhibit A is a copy of a Midstates' mailing log, which reflects Janu-ary 21, 2011 as the date on which Midstates shipped Brushy's 2011 catalogues. *Id.* Ex. A. Exhibit B is a copy of a screenshot of the "job ticket" for Brushy's 2011 catalogue. *Id.* Ex. B. It, too, reflects that the ship-ment date for the 2011 catalogue was January 21, 2011. *Id.*

In objecting that Judge Peck should not have treated the Twete affidavit as admissible, Fischer relies on a LinkedIn page that he had not offered on the motions for summary judgment. Obj. Ex. B. Fischer argues that the page is Twete's and that it establishes that Twete lacked "direct knowledge" of the facts to which she attested because it indicates that Twete joined the company in 2014—after the events at issue. He argues that the Twete affidavit should be excluded as not based on personal knowledge. Obj. at 3 (citing Fed. R. Civ. P. 56(e)(1)). Fischer further argues that the Twete affidavit is contradicted by its attached exhibits. *See* Obj. at 3. Fischer explains that he did not object earlier to receipt of Twete affidavit because he "felt all the affidavits [submitted] were . . . clearly excludable under FRE 806," Pl. Obj. Reply at 3 (emphasis added).

These objections fail. Fischer's objection rests almost entirely on the LinkedIn page. Fischer, however, never adduced that page in evidence in connection with briefing on summary judgment, despite being aware that Defendants had offered Twete's affidavit into evidence. (Indeed, Fischer did not take Twete's deposition or object to receipt of her affidavit until after Judge Peck's Report had issued.) It is, however, well settled that "[c]ourts generally do not consider new evidence raised in objections to a magistrate judge's report and recommendation." *Tavares*, 2011 WL 5877548, at \*2. The submission of new evidence



following such a Report is merited only in rare cases, where the party objecting to a Report has offered "a most compelling reason" for the late production of such evidence, *Housing Works, Inc. v. Turner*, 362 F. Supp. 2d 434, 438 (S.D.N.Y. 2005), or a "compelling justification for [its] failure to present such evidence to the magistrate judge," *Thomas v. Comm'r of Soc. Sec.*, , No. 16 CV 9247-LTS-KHP, 2017 WL 3475064, at \*1 (S.D.N.Y. Aug. 11, 2017) (quoting *Berbick v. Precinct 42*, 977 F. Supp. 2d 268, 273 (S.D.N.Y. 2013)). Here, Fischer has not offered any such justification.

Moreover, on its face, Twete's affidavit provides an adequate basis on which she is qualified to testify as to the shipment and expected receipt dates of Brushy's 2011 catalogues. She attests that she serves as mailroom supervisor for Brushy, a position that by its nature would tend to imply experience which such matters. She further attests that the statements to which her affidavit is attesting are known to her to be true. Fischer was at liberty to test in a deposition her competence to so attest, whether based on her personal experience or as a custodian familiar with and qualified to testify about Brushy's mailroom records. He did not do so.<sup>4</sup> And the LinkedIn page that Fischer

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<sup>4</sup> Defendants represent that, had Fischer deposed Twete, he would have learned that "she has worked at Midstates since at least 2006, personally handled the Brushy Mountain accountant,

now presents, based on an Internet download, is plainly inadmissible for any purpose-it has not been authenticated, and the statements in it are inadmissible hearsay. The Court therefore declines to receive Fischer's new evidence or to rule that Twete's unobjected-to affidavit is inadmissible.

In any event, the affidavit is not the only record evidence that Brushy's acts of alleged infringement date to December 2010. Fischer's own SAC attached as Exhibit 7 a screenshot of a webpage that shows alleged infringement of just such a nature on December 26, 2010, and this exhibit was referenced in Fischer's Third Amended Complaint. TAC ¶ 52.<sup>5</sup> Fischer's own evidence thus supports the Report's assessment of the date of Defendants' first infringing act. Excluding Twete's affidavit would, therefore, not disturb the Report's outcome.

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and that Midstates has a postal facility at its location in South Dakota." Defi Obj. Resp. at 3.

<sup>5</sup> Consistent with this evidence, Defendants' Local Rule 56.1 statement, to which Fischer never responded as to this point, states that Fischer's product was on Brushy's website on December 26, 2010 and that Brushy's 2011 catalogue was mailed on January 21, 2011.

### **3. Statutory Damages for Pre-Registration Infringement**

Fischer also objects to the Report's determination that he cannot obtain statutory damages on the ground that Defendants' first infringing act in a series predated Fischer's copyright registration. Obj. at 2-6, see R&R 2 at 23-26. On *de novo* review, the Court finds, with the Report, that Fischer cannot recover statutory damages.

Judge Peck reasoned as follows. He noted that Fischer had repeatedly alleged that Defendants lost all right and license to use his intellectual property on December 10, 2010. R&R 2 at 4 n.4. Judge Peck therefore, without objection, used December 10, 2010 as the date after which any use of Fischer's intellectual property by Brushy would constitute copyright infringement. *Id.* Judge Peck next found that Brushy had kept Bee-Quick on its website until at least December 26, 2010 and had shipped its catalogue containing the allegedly infringing phrases on January 21, 2011. That meant that Brushy had infringed Fischer's copyright in both December 2010 and January 2011. *Id.* at 25-26. Judge Peck further found that Fischer had not registered his copyright until February 7, 2011. *Id.* On these facts, he held, statutory damages are unavailable, based on uniform case law in this District that 17 U.S.C. § 412 imposes a bright-line rule under which such damages (as opposed to actual damages) are

unavailable where a defendant's first infringing act occurs before a plaintiff has registered his copyright. *Id.* at 24-26. Judge Peck also rejected Fischer's theory that each republication of his intellectual property constituted a new infringing act. Rather, he held, Brushy's post-registration uses of Fisher's intellectual property were part of a pattern of similar ongoing infringements dating to Brushy's first pre-registration infringement. As Judge Peck explained, Brushy's post-registration uses of Fischer's phrases were largely identical to its pre-registration uses and no appreciable amount of time had passed between the publications. *Id.* at 25-27.

In objecting to this aspect of the report, Fischer makes several arguments. See Obj. at 4-5, Pl. Obj. Reply. at 1-2.

Fischer now claims that Brushy's December 10, 2010 email announcing its cessation of sales of Bee-Quick did not, in fact, result in its losing all rights and licenses to use his intellectual property. This argument, he admits, repudiates a core tenet of his Complaint. See Pl. Obj. Reply at 5 ("The Complaint . . . was wrong on contract law, on copyright law, and factually."). Instead, Fischer appears now to characterize Brushy's 2010 email as akin to a notice of intent to breach, Obj. at 4, he claims that Brushy could not have "infringe[d] until 2012," *id.* at 5. This is so, Fischer says, because Brushy "fully performed" in 2011 by

selling Bee-Quick in January 2011. *Id.* Fischer notes that among their defenses to Fischer's copyright infringement claim in their Answer, Defendants stated that they had a "license" to sell. Pl. Obj. Reply at 5, *see* 14 Civ. 1304, Dkt. 53 ("Ans.") at 23. Fischer similarly characterizes his April 2011 cease and desist letter as prospective only. Obj. at 4. In effect, Fischer characterizes this letter to convey that rescission of Brushy's license would first occur in 2012. On this basis, Fischer argues, Brushy's first infringing act could not have occurred until 2012, after Fischer's copyright registration in February 2011. *Id.* at 4-5.

Depending on the circumstances, courts in this district have taken differing approaches where a litigant raises new legal theories in objections to a Report and Recommendation. Many hold that new legal theories are akin to new evidence and therefore not a valid basis to oppose a Report. *See e.g., Parks v. Comm'r of Soc. Sec.*, No. 15 CIV. 6470 (ER), 2017 WL 3016946, at \*3 (S.D.N.Y. July 17, 2017) (collecting cases). Others use a multi-factor test to determine whether there is good reason to consider the new theory. *See e.g., id.*

For two independent reasons, this Court declines to allow Fischer, at this late stage, to fundamentally reconceive his theory of liability.

First, unlike in cases in which a plaintiff has been silent on the relevant legal point, here, Fischer in his Complaint pled directly contrary to the theory

he now pursues, and this litigation has proceeded on Fischer's declared premise that Brushy's right to use his intellectual property terminated in December 2010. It is black letter law that a plaintiff may not alter his pleadings through a brief. *See, e.g., Wright v. Ernst & Young LLP*, 152 F.3d 169, 178 (2d Cir. 1998). Here, Fischer has attempted to do just that, and his repudiation of his pleadings comes late in the litigation, no less. *See* Pl. Obj. Reply at 5 ("The Complaint . . . was wrong on contract law, on copyright law, and factually").<sup>6</sup>

Second, permitting Fischer to reconceive and effectively to restart this case at this late stage—after discovery, full briefing on summary judgment before a magistrate judge, and the rendering of a detailed and thoughtful opinion on the plaintiffs claims as brought

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<sup>6</sup> It is no answer to treat Fischer's objections as, effectively, an untimely motion or leave to file an amended complaint. "[W]here a 'plaintiff blatantly changes his statement of the facts in order to respond to the defendant[s] motion to dismiss . . . [and] directly contradicts the facts set forth in his original complaint,' a court is authorized 'to accept the facts described in the original complaint as true.'" *Collision v. Cfravell11, Swczine & Moore LLP*, No. 08 CIV 0400 (NRB), 2008 WL 4386764, at \*6 (S.D.N.Y. Sept. 24, 2008) (quoting *Wallace v. New York City Dep't of Corr.*, No. 95 Civ. 4404, 1996 WL 586797, at \*2 (E.D.N.Y. Oct. 9, 1996)), *aff'd*, 356 F. App'x 535 (2d Cir. 2009).

would waste substantial judicial resources and undermine the objectives of the Magistrates Act. "A proceeding before a magistrate judge is not a meaningless dress rehearsal." *Dennard v. Kelly*, 90-CV-0203(E)(F), 1997 WL 9785 at \*1 (W.D.N.Y. Jan 2, 1997) (citing *Klawitter v. Chaser*, No. 93-CV-0054E(H), 1996 WL 643367 at \*1 (W.D.N.Y. Oct. 18, 1995)).

The waste of resources would be particularly acute here because permitting Fischer to alter his theory as to when Brushy first infringed his copyright would open the door to a new round of briefing (if not discovery). In particular, were Brushy treated as having a valid license through 2012, the issue would then arise whether Defendants' use of Fischer's copyright prior to the date of Fischer's copyright registration had been within or outside the scope of the license he granted them. "It is black-letter law that a claim or copyright infringement lies when a party's use of copyrighted material exceeds the scope of its license." See *John Wiley & Sons, Inc. v. DRK Photo*, 998 F. Supp. 2d 262, 287 (S.D.N.Y. 2014) (quoting *Harrell v. Vander Plas*, No. 08 Civ. 8252 (GEL), 2009 WL 3756327, at \*2 (S.D.N.Y. Nov. 9, 2009)) (collecting cases). Thus, to defeat the defense to statutory damages that Brushy's infringement predated registration of Fischer's copyright, Fischer would have to show that Brushy's use of Fischer's copyrighted material to promote Natural Honey Harvester—by shipping its catalogue with Natural Honey Harvester and the

infringing phrases on January 21, 2011, and by advertising Natural Honey Harvester on its website by January 28, 2011—was within Brushy's license. Only if those 2011 acts were within Brushy's license would they not give rise to a claim for copyright infringement. To so establish would require Fischer to repudiate his pleadings, in which he consistently contended that these acts by Brushy were unauthorized. *See e.g.*, TAC 07 ¶ 26 ("[N]o permission was granted to use [his] copyrighted works in any way except specifically in the sale of [his] product."), *see also id.* ¶¶ 47, 72. And these pleadings were plausible: As the Court noted in denying the motion to dismiss, "that Fischer[']s license [would] allow[] a competitor to repurpose original works he had created, copyrighted, and continued to use to promote and sell his own produc-is highly improbable." Fischer, 2015 WL 195822, at \*7.<sup>7</sup>

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<sup>7</sup> Fischer attempts to avoid this result by noting, based on *TVT Records v. Island Def./Jam Music Grp.*, 412 F.3d 82 (2d Cir. 2005), and *Graham v. James*, 144 F.3d 229 (2d Cir. 1998), that a breach of a licensing agreement cannot give rise to copyright infringement prior to rescission, and positing that he did not rescind the license until after February 7, 2011. But this theory, too, relies on disputed facts and legal conclusions, including that Defendants' license to sell Fischer's goods persisted after Defendants had announced to Fischer their decision to discontinue selling his goods, and that the license entitled them to use Fischer's intellectual property to sell Defendants' competing products. Fischer has long disputed these points. *See, e.g.*, TAC 04 ¶ 237 ("The fact of this breach of contract is of particular note in this litigation as a firm basis for the loss of any and all



The Court therefore adopts this aspect of the Report, which rightly held that, as a matter of law, Fischer cannot recover the statutory damages he elected to pursue. Given Fischer's claim that Brushy's license to use Fischer's intellectual property ceased on December 10, 2010, Brushy's uses of that property in December 2010 and January 2011 were acts of infringement that predated Fischer's February 2011 copyright registration, precluding recovery of statutory damages under 17 U.S.C. § 412. *See Solid Oak Sketches*, 2016 WL 4126543 at \*2 (collecting cases). And the law does not support Fischer's claim that Brushy's annual republications were separate infringing acts. *See e.g., id.* at \*3 (one-year gap insufficient to give rise to a new infringing act, "when the same defendant infringes on the same protected work in the same manner as it did prior to the work's registration, the post-registration infringement constitutes the continuation of a series of ongoing, infringing acts"), *see*

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license, permission, or grant of rights Defendants had as a result of their status as an Authorized Dealer for Plaintiff. Any/all rights terminated in Dec 2010."), TAC 07 ¶ 72 ("Defendants'[sic] had full knowledge of Plaintiff's rights under copyright, and the highly limited nature of the use they were permitted when selling Plaintiffs product."), *id.* at ¶ 26 ("[N]o permission was granted to use Plaintiffs copyrighted works in any way except specifically in the sale of Plaintiff's product.").

*Irwin v. ZDF Enterprises GmbH*, No. 04-CV-8027-RWS, 2006 WL 374960, at \*6 (S.D.N.Y. Feb. 16, 2006), *cf. Troll Co, v. Unedcz Doll Co.*, 483 F.3d ISO, 158-59 (2d Cir. 2007) (finding "nine or ten years" of cessation a "nontrivial period of time" such that "a post-registration act of infringement [could] be deemed [not] to have commenced before registration").

### **B. Fischer's Claim for Statutory Damages based on Secondary Infringement**

Fischer's Complaints alleged that two third-party vendors, C&T Bee Supply and The Honey Hole, had infringed on his copyrighted works by displaying them online without his permission. *See, e.g.*, TAC 07 ¶ 51. Fischer attached images embodying this alleged infringement. *See, e.g.*, SAC 07 Exs. 21-22. Fischer did not join these vendors, he instead sought to hold Brushy alone liable for their acts. *See* TAC 07 ¶¶ 95, 102, 109, 116. Fischer alleged that Brushy's actions caused the vendors to infringe, for which Brushy is secondarily liable. *See, e.g.*, TAC 07 at ¶¶ 51, 83-89, 95, 102, 109, 116, Pl. Obj. Reply at 7.

The Report recommended granting Brushy's summary judgment motions as to Fischer's secondary infringement claims, substantially because the vendors' infringements were "part of a series of related infringements by defendants and the [third parties] of the same copyrighted work" that predated Fischer's registration of his copyright, *see* R&R 2 at 29, thereby

disentitling Fischer to statutory damages. Fischer objects to that recommendation, arguing that Judge Peck overlooked that these two consolidated cases include "a distinct and separate action (14cv1307) for secondary infringement," Obj. at 5-6, and that Fischer's "sole reason for filing 14cv1307 as a separate action was to seek a separate award of statutory damages for the indirect infringement over and above that for direct infringement," *id.* at 6.

Fischer's basis for objecting to this aspect of the Report is not entirely clear, but he appears to contend that his filing of two separate lawsuits, rather than consolidating his claims against Brushy into a single lawsuit, entitles him to two statutory damage awards, one for Brushy's direct infringement and another for Brushy's having caused its vendors to infringe on its behalf. Fischer appears to rely on 17 U.S.C. § 504, which allows a copyright owner to elect, in lieu of actual damages, an award of statutory damages "*for all infringements involved in the action* with respect to any one work, for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally[.]" 17 U.S.C. § 504(c) (emphasis added).

Fischer's critique is not responsive to the Report's basis for recommending against an award of statutory damages from Brushy based on the vendors' alleged infringement. Judge Peck acknowledged—and

did not overlook—the fact that Fischer had filed two separate suits, including one pursuing a theory of secondary liability. *See* R&R 2 at 27-30, *see also id.* at 1, 28. But he reasoned that Fischer's claim for separate statutory damages failed as a matter of substantive copyright law, irrespective of the number of lawsuits into which Fischer segmented his claims. Judge Peck found that Brushy's vendors' infringement was part of the series of infringing acts performed or assisted by Brushy that had commenced on December 10, 2010 before Fischer registered his copyright, and, relying primarily on *Bouchat v. Bon-Ton Dep't Stores, Inc.*, 506 F.3d 315 (4th Cir. 2007), held that the fact that this series of infringing acts predated Fischer's registration of the copyright, barred an award of statutory damages against Brushy for its contributory infringement. R&R 2 at 30.<sup>8</sup>

Fischer's objection does not engage with this critique. He focuses on the fact that he bifurcated his

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<sup>8</sup> Like this case, *Bouchat* involved multiple lawsuits: one against the Baltimore Ravens and National Football League Properties, and four against "several hundred companies (licensees)." *Bouchat*, 506 F.3d at 324, *Id.* at 330 ("NFLP's battalion of licensees—not NFLP itself—are the defendants in the cases before us today . . . . *Bouchat* argues that the correct approach would have been to treat the date on which each individual licensee first violated *Bouchat*'s copyright as the date that licensee's infringement commenced under § 412(1). We disagree.").

claims into separate lawsuits. He does not, however, respond to the Report's substantive explanation why Brushy does not owe statutory damages. He does not, for example, take issue with the doctrine that disentitles a copyright owner to statutory damages where a series of related infringements began before the owner registered a copyright, or with the Report's conclusion that the vendors' acts of infringement formed part of a series with Brushy's.

Because Fischer has not made a specific objection to the Magistrate Judge's findings, Fischer's objection does not trigger *de novo* review. *Pinknew v. Progressive Home Health Servs.*, No. 06 CIV.5023 (LTS) (JCF), 2008 WL 281 1816, at \*1 (S.D.N.Y. July 21, 2008), *aff'd*, 367 F. App'x 210 (2d Cir. 2010) (citing *United States v. Male Juvenile*, 121 F.3d 34, 38 (2d Cir. I 997)). Applying that standard, the Court has reviewed the Report's findings on secondary liability for clear error and has found none. For avoidance of doubt, however, even had *de novo* review been warranted, the Court would find no error in Judge Peck's articulation of why statutory damages are unavailable based on Brushy's facilitation of its vendors infringement of Fischer's copyrights. The Court therefore adopts Judge Peck's recommendation on this point, too.

### C. Fischer's Claim Under the DMCA

Fischer next objects to the Report's recommendation that this Court grant summary judgment to Defendants on Fischer's claims under the DMCA, 17 U.S.C. § 1202. Obj. at 6-8. Fischer argues that Brushy removed CMI in violation of § 1202 when, in revising its online and print advertisements from promoting Bee-Quick to promoting Natural Honey Harvester, it substituted, in a sentence, the term "Natural Honey Harvester" for the term "Fischer's Bee-Quick." *Id.*, Pl. Br. 17-19. It is undisputed that Defendants made this substitution. However, on *de novo* review, the Court finds, with the Report, that this activity did not constitute CMI removal as a matter of law. The Court therefore adopts the Report's recommendation as to the DMCA claims.

#### 1. Applicable Standards Under the DMCA

Section 1202 prohibits, *inter alia*, "intentionally remov[ing] . . . any copyright management information" with the knowledge (or with reasonable grounds to know) that doing so will "induce, enable, facilitate, or conceal" an infringement of copyright." 17 U.S.C. § 1202(b). To prevail on a claim for CMI removal, a plaintiff must show "(1) the existence of CMI on the [work at issue], (2) removal and/or alteration of that information; and (3) that the removal and/or alteration was

done intentionally." *BanxCorp v. Coslco Wholesale Corp.*, 723 F. Supp. 2d 596, 609 (S.D.N.Y. 2010).

As relevant here, CMI includes the name of the author or copyright owner. *See id.*; 17 U.S.C. § 1202(c). CMI can be "contained in the body of a work," *see Bounce Exch., Inc. v. Zeus Enter. Ltd.*, No. 15CV3268 (DLC), 2015 WL 8579023, at \*3 (S.D.N.Y. Dec. 9, 2015), and need not exactly match the name of the copyright owner, *see id.* (a "shorthand form of the official name of the author of the work" can constitute CMI). In light of the above, Fischer is correct that the word "Fischer's"—a part of the term that Defendants substituted out of Fischer's advertisements—is capable of constituting CMI. *See Agence France Presse v. Morel*, 769 F. Supp. 2d 295, 305 (S.D.N.Y. 2011) ("It is implausible that a viewer of Morel's photos would not understand the designations 'Morel' and 'byphotomorel' appearing next to the images to refer to authorship.").

But, to qualify, the word or words said to constitute CMI must also be "conveyed in connection with copies . . . of a work . . . or displays of a work . . . . 51 17 U.S.C. § 1202(c)(2). The CMI must be attached to, depicted in, or broadly "conveyed in connection" with a copyrighted or copyrightable "work." The works on which CMI removal claims are based commonly consist of photographs, *see, e.g., Playboy Enterprises Int'l Inc.*, 2016 WL 1023321, at \*4, but CMI removal actions can lie from the removal of such information

from other works, *see, e.g., BanxCorp*, 723 F. Supp. 2d at 609 (citing cases with CMI claims based on architectural plans, news articles, and drawings). And although a "plaintiff's failure to register its copyrighted work is not a bar to a DMCA action," *Playboy Enterprises Intl Inc.*, 2016 WL 1023321, at \*5 (quoting *I.M.S. Inquiry Mgmt. Sys., Ltd. v. Berkshire Info. Sys., Inc.*, 307 F. Supp. 521, 531 n.9 (S.D.N.Y. 2004)), "[a]n action for removal of copyright management information requires the information to be removed from a plaintiff's product or original work," *Faulkner Press, L.L.C. v. Class Notes, L.L.C.*, 756 F. Supp. 1352, 1359 (ND. Fla. 2010) (citing *Schffér Publ'g, Ltd. v. Chronicle Books, LLC*, Civil Action No. 03-4962, 2004 WL 2583817, at \*14 (E.D. Pa. Nov. 12, 2004) and *Kelly v. Arriba Soft Corp.*, 77 F. Supp. 2d 1116, 1122 (CD. Cal. 1999) *aff'd and rev'd in part on other grounds*, 336 F.3d 8] 1 (9th Cir. 2003)).<sup>9</sup>

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<sup>9</sup> Brushy argues that "§ 1202(b) 'prohibits the removal or alteration of "copyright management information" from a *validly copyrighted work*," rather than a merely copyrightable one, Def. Reply Mem. at 7 (emphasis in original) (citing *Silver v. Lavandeira*, No. 08 Civ. 6522 (JSR), 2009 WL 513031, at \*2 (S.D.N.Y. Feb. 26, 2009)), but courts in this district have persuasively held that CMI is not so limited. *See Playboy Enterprises Int'l Inc.*, 2016 WL 1023321, at \*5.



## 2. Discussion

Although Fischer has oscillated in his theories under the DMCA, *see supra*, note 3, the Court, drawing on Fischer's various filings, has identified four items that could serve as an original "work" of Fischer's from which Brushy allegedly removed CMI: (1) the website and/or brochure Fischer submitted in conjunction with his copyright registration, (2) the "description text" Fischer sent to Brushy, (3) the four copyrighted phrases used in the allegedly offending advertisement, and (4) the phrase to which "Fischer's" is attached in the advertisement altered by Brushy: "Fischer's Bee-Quick is a safe, gentle, and pleasant way to harvest your honey." The Court considers these in turn.

### a. Fischer's Brochure and Website

Fischer testified in his deposition that Brushy removed four sentences from his brochure, Fischer Dep. at 137. Fischer further attested in his affidavit opposing summary judgment that the epigrams relating to his product could also be "found on various web pages." Fischer Arr. at 4. However, even assuming that Fischer's brochure and website are "works" covered by the DMCA, the Report correctly found that Fischer cannot maintain a claim based on removal of CMI from either source. That is because no CMI was

removed from his original brochure, his website, or a copy or display of them.

Aside from the four phrases noted above, Brushy's advertisement bears no resemblance whatsoever to Fischer's brochure or website. In those cases where claims of removal of CMI have been held viable, the underlying work has been substantially or entirely reproduced. *See, e.g., Bounce Exch.*, 2015 WL 8579023, at \*2-4 (CMI removal claim viable where defendants removed "shorthand forms" of plaintiff's name from plaintiff's source code and inserted "portions of [plaintiffs] code, structure, sequence, and organization" into its defendants' own code such that the "[defendant] was selling software source code that was 'substantially similar' to [plaintiff's] proprietary code"), *Associated Press v. All Headline News Corp.*, 608 F. Supp. 2d 454, 458, 461 (S.D.N.Y. 2009) (CMI removal claim viable where defendants "instructed reporters to remove or alter the identification of the [Associated Press] as author or copyright holder of the articles"). This requirement accords with the DMCA text that requires CMI to be "conveyed in connection with copies . . . of a work . . . or displays of a work." 17 U.S.C. § 1202(c). Fischer's brochure and website are not, however, copied here. Aside from four discrete phrases among the many used on Fischer's brochure and website, there is no similarity between Fischer's original works and Brushy's advertisement. Brushy cannot be said to have removed CMI from these of Fischer's "works."

**b. Fischer's "Description Text"**

The "description text" that Fischer sent Brushy could, in theory, constitute a "work" under the DMCA, because, as noted, the material at issue in a DMCA claim need not be a subject of a registered copyright. *Playboy Enterprises Int'l Inc.*, 2016 WL 1023321, at \*5. But Fischer has not shown that Brushy removed CMI from this text, because, at the summary judgment stage, he did not adduce evidence of the content of the "description text" he had sent Brushy.<sup>10</sup> See Pl. Br. at 17-19, Dkt. 180 ("Michelen Aff."). Fischer's complaints alleged that the images and description text he sent to Brushy "consist[ed] of images of brochures, flyers other sales materials," all of which were "derivative works of Plaintiff's original creative unpublished copyrighted Works." TAC 04 ¶ 92. This description, and

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<sup>10</sup> Fischer attaches an exhibit (Exhibit G) to his objections in an attempt to demonstrate that he authored one "work" claimed to underlie Brushy's advertisement. Fischer comes forward with this exhibit too late. See Tavares, 2011 WL 5877548, at \*2. In any event, the exhibit that Fischer produces to illustrate what he claims to have authored for Defendants does not appear to be a document that pre-existed this litigation. Instead, it is disembodied and presented in no recognizable context. It appears to be Fischer's written version of the description text used by Defendants, circumscribed by an added black box. See Obj. Ex G at 1.

descriptions that Fischer furnished later in this litigation, do not suggest that Fischer sent Brushy a singular work, rather, they suggest multiple materials from which Brushy was to construct its own advertisement. *See e.g.*, Fischer Aff. at 1 ("The difference between the print catalog [text] and the website [text] prior to 2008, and the poor artistry in the line art sketch of the Bee-Quick product as compared to those for other products was the primary reason why I kept mailing CDs to the Forrests each fall with camera-ready artwork, photos of the products, *and point-of-sales materials*) (emphasis added), *see also* TAC 07 ¶ 71 ("In all of the above [versions of the online description text], Defendants' had access to and full knowledge of Plaintiffs copyrighted Works, providing them the source material with which to infringe."). Fischer also notes that he and Defendants "would discuss changes to the text . . . of Defendants' product webpage periodically." *Id.* ¶ 70.

These accounts suggest that the work of Brushy at issue here is an advertisement based upon an earlier advertisement which in turn drew upon various materials Fischer sent Brushy. Fischer does not identify any case support that DMCA liability encompasses that sort of composite "work." *See Faulkner Press*, 756 F. Supp. 2d at 1359 ("[N]othing was removed from the copyrighted works. Instead, information from Dr. Moulton's courses was allegedly copied into a different form and then incorporated into the

note packages."), *Frost-Tsuji Architects v. Highway Inn, Inc.*, No. CW. 13-00496 SOM, 2014 WL 5798282, at \*7 (D. Haw. Nov. 7, 2014) ("To the extent Frost-Tsuji is arguing that Kadowaki created 'shop drawings' based on Frost-Tsuji's work and left out Frost-Tsuji's copyright management information in the process, no actionable removal of copyright management information is involved, as basing a drawing on another's work is not the same as removing copyright management information."). Fischer's claim instead sounds, if at all, in copyright infringement, but, for the separate reasons noted in the Report relating to the unavailability of the statutory damages that Fisher elected, he cannot prevail on that claim.

### **c. Fischer's Four Phrases**

The four phrases originally relating to Fischer's product that Brushy used in modified form in its advertisements are of a different character, but they, too, cannot form the basis of a DMCA claim based on the removal of CMI. CMI exists to inform the public that a work is copyrighted and by whom. *See Pers. Keepsakes, Inc. v. Personalizationmall.com, Inc.*, No. 11-CV-5177, 2012 WL 414803, at \*6 (ND. Ill. Feb. 8, 2012) ("[T]he point of CMI is to inform the public that something is copyrighted and to prevent infringement.") The DMCA exists, in part, to protect that notice. *Id.*

The four phrases of Fischer's that Brushy modified and used, however, are not of such character.

Only one even refers to Fischer. No reader would find that the "Fischer's" as used in the phrase "Fischer's Bee-Quick is a safe, gentle, and pleasant way to harvest your honey" speaks to copyright ownership. No reader would find that this product descriptor signals that a "James H. Fischer" or even someone named "Fischer" is the copyright holder of the phrase to which it is attached and those surrounding it. The sentence instead advertises Fischer's *product*, and fairly conveys that Fischer is the owner and/or producer of that product. But that phrase and the other three phrases at issue-do no convey Fischer's authorship or copyright ownership of these expressions. Although Fischer's name is not part of the trademarked name of Fischer's product, his name frequently appears alongside "Bee-Quick" in the product's marketing. *See, e.g.*, SAC 04 Ex. 17.

An analogy illustrates the point. Imagine that the back cover of the Ian Fleming novel *Dr. No*. contained the following encomium: "In Ian Fleming's *Dr. No*, Fleming shows his mastery of Cold War spycraft." Imagine then that a person lifted language from that review to promote a different thriller, writing: "In John Le Carré's *Tinker, Tailor, Soldier, Spy*, Le Carré shows his mastery of Cold War spycraft." Whatever the other legal implications of such conduct might be, it is inconceivable that a DMCA claim would lie from the elimination of Fleming's name. The expression at issue does not connote Fleming's copyright ownership

of anything, much less the language common to the two book-promoting blurbs. Fischer's name-whose deletion Fischer's DMCA claim challenges-similarly has no CMI relevance as used in Defendants' advertisement. It neither informs the reader that Fischer wrote either the phrase to which "Fischer's" is attached or the surrounding text. As the Report recognized, Fischer cannot prevail on a DMCA claim based on the claim that the modified [our phrases are the "work" from which CMI was removed.

**d. “Fischer’s Bee-Quick is a safe gentle and pleasant way to harvest your honey.”**

For the same reasons as above, Defendant's having replaced the word "Fischer's" with "Natural Honey Harvester" is not an act of CMI removal. "Fischer's" has no CMI significance as used in the advertisement.<sup>11</sup>

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<sup>11</sup> Although Fischer objects to the Report's discussion of damages under the DMCA, the Court, having found that no DMCA claim validly lies, has no occasion to address those objections.

### D. Fischer's Lanham Act False Endorsement Claim

Fischer alleges that Defendants violated Section 43(a) of the Lanham Act by including his name in the post-domain path of URLs that linked to Defendants' Natural Honey Harvester. *See* TAC 04 ¶¶ 164-90. Fischer's examples of this include:

- "[http://brushymountainbeefarm.com/Fume-Pad-w\\_-Fischers-Bee-Quick/productinfo/777F](http://brushymountainbeefarm.com/Fume-Pad-w_-Fischers-Bee-Quick/productinfo/777F)," *see* SAC 04 Ex. 12;
- "[http://brushymountainbeefarm.com/8-Frame-Fume-Pad-w\\_Fischers-Bee-Quick/product info/254FPQ/](http://brushymountainbeefarm.com/8-Frame-Fume-Pad-w_Fischers-Bee-Quick/product%20info/254FPQ/)," *see id.* Ex. 13;
- <http://brushymountainbeefarm.com/images/799fischers.jpg>, *see id.* Ex 10;
- <http://brushymountainbeefarm.com/images/799fischerssm.jpg>," *see id.*

The Report recommended that the Court grant summary judgment for Defendants on these claims, because Fischer has not shown a likelihood of confusion from Defendant's ostensible false endorsement. *See* R&R 2 at 45-50. Fischer objects that the Report wrongly decided disputed issues of fact against him on this point. The Court reviews this issue *de novo*.

#### 1. Applicable Legal Standards



To prevail on a false endorsement claim, a plaintiff must prove that "the defendant, (1) made a false or misleading representation of fact; (2) in commerce; (3) in connection with goods or services; (4) that is likely to cause consumer confusion as to the origin, sponsorship, or approval of the goods or services." *Beastie Boys v. Monster Energy Co.*, 66 F. Supp. 3d 424, 448 (S.D.N.Y. 2014) (quoting *Burck v. Mars, Inc.*, 571 F. Supp. 2d 446, 455 (S.D.N.Y. 2008)).

The first three of these factors are not in dispute. Fischer's claim therefore turns on the fourth factor: likelihood of confusion. Although this element ordinarily presents an issue of fact, consumer confusion can become an issue of law where a "[p]laintiff 'cannot possibly show confusion as to source or sponsorship.'" *Roberts v. Bliss*, 229 F. Supp. 3d 240, 251 (S.D.N.Y. 2017) (quoting *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 585 (2d Cir. 1990)).

When determining likelihood of consumer confusion, this Circuit employs an eight-factor test set forth in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961): "The eight factors are: (1) strength of the trademark; (2) similarity of the marks; (3) proximity of the products and their competitiveness with one another; (4) evidence that the senior user may 'bridge the gap' by developing a product for sale in the market of the alleged infringer's product, (5) evidence of actual consumer confusion, (6) evidence that the imitative

mark was adopted in bad faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market." *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d. Cir. 2009). However, "[t]he application of the *Polaroid* test is 'not mechanical, but rather, focuses on the ultimate question of whether, looking at the products in their totality, consumers are likely to be confused.'" *Kelly-Brown v. Winfrey*, 717 F.3d 295, 307 (2d Cir. 2013) (quoting *Star Indus. Inc. v. Bacardi & Co Ltd.*, 412 F.3d 373, 384 (2d Cir. 2005)).

## 2. Discussion

For the reasons that follows, as a matter of law, Fischer cannot establish, under the *Polaroid* factors, a likelihood of consumer confusion.

At the outset, the Court finds, substantially for the reasons given by Judge Peck, that Fischer meets or appears to meet the first three factors. As to the first factor, he has profitably marketed his product for a number of years; as to the second and third, Defendants allegedly used Fischer's last name in URLs on web pages marketing a competing product. The Court further finds—as is common in false endorsement cases—that factors four and seven are irrelevant to the false endorsement claim at issue. *See, e.g., Jackson v. Odernat*, 9 F. Supp. 3d 342, 356 (S.D.N.Y. 2014) ("Courts adjust the factors when dealing with false

endorsement claims. In such cases, the quality of the products and 'bridging the gap' are often not considered.").

The Court's analysis therefore focuses on factors five ("evidence of actual consumer confusion"), six ("evidence that the imitative mark was adopted in bad faith"), and eight ("sophistication of the consumers in the relevant market").

**a. Evidence of Actual Consumer Confusion**

Although "actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove and the Act requires only a likelihood of confusion as to source," *Beastie Boys*, 66 F. Supp. 3d at 456 (quoting *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986)), "it is certainly proper for the trial judge to infer from the absence of actual confusion that there was also no likelihood of confusion," *Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 1188 (2d Cir. 1975).

Here, Fischer has failed to demonstrate any actual consumer confusion. As ostensible proof of such confusion, Fischer relies on the following evidence: a single review that he claims is from Brushy's website; an observation that Google displays Natural Honey Harvester when asked to search for Fischer's Bee-Quick;

and the claim that the use of his name in certain of Brushy's URLs constituted initial interest confusion. The Court considers each item in turn.

As to the review: Fischer attached a single review which he claims he drew from Brushy's website. It states that an earlier shipment of a product was not as good as a later shipment. *See* Fischer Aff. Ex. B ("The first bottle I bought last year worked well but this new stuff was a complete waste of time and money."). Fischer asks the Court to infer that the customer was referring to Fischer's Bee-Quick in the first instance and Natural Honey Harvester in the second. This, however, is speculation: Fischer apparently did not develop and has not provided any evidence to the effect that either product to which the review refers is Bee-Quick.<sup>12</sup>

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<sup>12</sup> Although not necessary to the Court's ruling, Gebauer's supplemental affidavit states that the review was posted on May 7, 2013, long after Brushy discontinued selling Fischer's products.

As to Google: Fischer alleges that search engines like Google would route customers to Natural Honey Harvester because Fischer's name appeared in the post-domain path in certain Brushy URLs. TAC 04 ¶ 175. But Fischer's evidence does not demonstrate that a purchaser is, in fact, led to Brushy's website by virtue of the URL containing Fischer's name. Rather, Fischer's evidence, as he describes it, reflects only that:

"Google results for [Fischer bee] . . . cite Plaintiff's products and services in 9 of first 10 results, 17 of first 20, and 21 of first 30 results. [Beekeeping Fischer] cites Plaintiff and his products in 8 of the 1st 10, 16 of the 1st 20, and 22 of the 1st 30 results. [Jim Fischer bee] cites Plaintiff and his products in 37 of the first 40 results."

Fischer Arr. at 9-10. This evidence does not show actual confusion. Indeed, far from showing that customers were led astray, Fischer's Google evidence appears to indicate the opposite, that is, that his own product overwhelmingly appears when his name is searched. As important, this evidence does not show that Natural Honey Harvester appears instead—it does not indicate that the few search results for sites other than Fischer's product are for Brushy's website. Fischer's evidence further fails to show that, to the limited extent that non-Fischer websites came up as a result of

the Google search, these websites presented as a result of the inclusion of his name in Brushy's post-domain URL.<sup>13</sup>

As to "initial interest" confusion: Although Fischer only obliquely mentioned this item in opposing summary judgment, he alleged in his Complaint that Brushy sought to create "initial interest" confusion by including Fischer's name in the URL for Natural Honey Harvester, and he returns to this point in his objections to the Report. Obj. at 12 ("the initial diversion . . . is the 'actual confusion' here."). Initial interest confusion "arises when a consumer who searches for the plaintiff's website with the aid of a search engine is directed instead to the defendant's site because of a similarity in the parties' website addresses." *Savin*

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<sup>13</sup> In his objections, Fischer states that he "submitted an affidavit detailing how his name in the URL brought the offending page up in Google searches," citing to Fischer Dep. at 212-13. Obj. at 11. The cited deposition, however, does not establish that point, but merely recounts that Fischer has so alleged.

*Corp. v. Savin Grp.*, 391 F.3d 439, 462 n.13 (2d Cir. 2004). "Because consumers diverted on the Internet can more readily get back on track than those in actual space, thus minimizing the harm to the owner of the searched- for site from consumers becoming trapped in a competing site, Internet initial interest confusion requires a showing of intentional deception." *Id.* But, for the reasons recounted above, Fischer's claim of initial interest confusion is factually threadbare. He has not come forward with any evidence that consumers were diverted to Brushy's website when searching for Fischer's product online, let alone that such diversion resulted from the inclusion of Fischer's name in the post- domain path of the URL.

Fischer thus has not demonstrated any actual confusion.

### **b. Evidence That the Imitative Mark Was Adopted in Bad Faith**

Fischer argues that Brushy's use of Fischer's name in the post-domain URL was adopted in bad faith because "continuing use of a mark knowing that it is wrongful" demonstrates bad faith. Obj. at 11 (quoting *First Savings Bank, F.S.B . v. U S Bancorp*, 117 F. Supp. 2d 1078, 1088 (D. Kan. 2000)). But Fischer has not substantiated his claim that the inclusion of his name in the post-domain URL was done knowingly. There is no evidence direct or circumstantial—

whether in the form of testimony, emails and other records, or conduct—so indicating. On the contrary, Gebauer has explained this circumstance as follows:

When Brushy Mountain switched from the Bee-Quick to the Natural Honey Harvester product, the ad created by Brushy Mountain for the Bee-Quick product was changed, but the URL was mistakenly not changed. Once I learned the URLs contained the words 'Fischers' and 'Fischer's Bee-Quick' I had the URLs changed.

Gebauer Decl. ¶ 9. In his deposition, Fischer gave testimony consistent with this benign explanation. See Fischer Dep. at 153 ("Q: [D]id Brushy Mountain, on their website, use the same URL that they sold Bee-Quick as they did when they switched over and started selling Natural Honey Harvester? A: Yes. They continued to use the same URL.").

With the evidence indicating that Brushy's initial maintenance of the earlier URL was an inadvertent error, Fischer is forced to argue that Brushy's failure to remove his name from the URL's was an act of bad faith. But the evidence Fischer adduces does not bear this out.

First, Fischer claims that, based on his "read[ing] the manuals, stud[y]ing the training videos, and sp[eaking] with tech staff at Dyacomp," the software



used by Gebauer does not now operate as Gebauer claims it does. Fischer Arr. at 8. Fischer's lay conclusion to this effect does not suffice to substantiate this claim as to the operation of his competitor's software. He has not, for example, deposed a Dyacom employee or, for that matter, come forward with documentary or testimonial evidence that the website functions other than as Gebauer has stated.

Second, Fischer notes that Brushy's website retains two links, archived in its web server, that contain Fischer's name. Pl. Obj. Reply at 7. At argument before Judge Peck, however, Brushy's lawyer emphasized that the links do not appear on any page advertising Defendants' products, and explained that the two links were not removed from the website archives out of a concern that such removal "could be perceived as spoliation of evidence." R&R 2 at 46 n.30. Fischer has not come forward with contrary evidence as to the operation of, or the reason for the retention of, these two links.

These slender threads are insufficient to establish this important *Polaroid* factor. "[T]o show bad faith, a plaintiff must show that the defendant intended to create confusion between the products or marks at issue." *Crye Precision LLC v. Duro Textiles, LLC*, 689 F. App'x 104, 108 (2d Cir. 2017). Fischer, however, has not shown any action by Defendants undertaken with intent to confuse.

### **c. Sophistication of the Consumers**

Fischer argues that "the sophistication of the consumer here actually makes it more likely that they were confused as they would know that Fischer's name was synonymous with quality bee-keeping products." Pl. Br. at 21. However, Judge Peck persuasively refuted that argument, emphasizing the context in which Fischer's name appears on Defendants' website: "Whether defined as the typical consumer of beekeeping products, or Internet users writ large, no ordinary consumer is likely to see Fischer's name in the post-domain path of the URL and wonder if that signified his endorsement of a completely different product in the accompanying web page." R&R 2 at 49 n.34. This factor, too, as Judge Peck found, does not assist Fischer.

### **d. Other Considerations and Overall Assessment**

The Court considers two other aspects of Judge Peck's analysis with which Fischer takes issue.

First, Fischer objects that the Report, in analyzing the likelihood of consumer confusion, cited a case that dealt with "domain squatting," a situation not present here. Obj. at 10 (citing R&R 2 at 46). But Judge Peck's Report cited *Interactive Products Corp. v. a2z Mobile Office Sols., Inc.*, 326 F.3d 687, 692 (6th Cir. 2004), not

as controlling precedent but because that case "provide[s] a helpful discussion of the mechanics of website URLs," R&R 2 at 48 n.32; that decision, however, as Judge Peck emphasized, "d[id] not guide the [Report's] consumer confusion analysis," *id.* And, on its review, the Court agrees that Interactive Products Corp. is useful as a guide to the concept of post-domain paths. The Sixth Circuit helpfully explained that while trademark names used in domain names often give rise to trademark infringement claims because domain names "usually signify source," post-domain paths usually do not do so. 326 F.3 at 696-97. As the Sixth Circuit explained: "Typically, webpages containing post-domain paths are not reached by entering the full URL into a browser; instead, these secondary pages are usually reached via a link from the website's homepage, which does not contain a post-domain path." *Id.* at 697. "A post-domain path . . . merely shows how a website's data is organized within the host computer's files." *Id.* at 691. The Sixth Circuit's discussion reasonably informed Judge Peck's assessment that, in considering the likelihood of consumer confusion, it is important to distinguish between a domain name and a post-domain path.

To be sure, that a competitor's trademark was situated in a post-domain path does not preclude a finding of likely confusion. See, e.g., *H-D U.S.A., LLC v. Sur Frog, LLC*, No. 17-CV-711-JPS, 2017 WL 3261709, at \*4-5 (E.D. Wis. July 31, 2017) (issuing preliminary

injunction based in part on evidence that placement of a trademark in a post-domain path was done with intent to confuse and that the post-domain path led to a website selling counterfeit products). But Judge Peck did not hold otherwise, and, for the reasons noted above, the factors yielding the finding of likely confusion in *H-D U.S.A.*, are not present here.

Second, Fischer objects that, in the likelihood of confusion inquiry, the continued use of a mark after the termination of a licensing agreement should be a factor in his favor. Obj. at 11. Courts in this district have indeed held that "[w]hen an ex-licensee continues to use a mark after its license expires, likelihood of confusion is established as a matter of law." *Microbe Prod Co. v. API Indus., Inc.*, No. 14 CIV. 41 KPF, 2014 WL 1856471, at \*6 (S.D.N.Y. May 8, 2014) (quoting *L & L Wings, Inc. v. Marco-Destin, Inc.*, 676 F. Supp. 2d 179, 188 (S.D.N.Y. 2009)). Here, however, as Judge Peck recognized, Brushy has not used Fischer's name as a mark. Fischer does not, for example, allege—let alone establish—that, after termination of its license, Brushy continued to sell its products with Fischer's logo attached to them or to use Fischer's name in the domain name of its website. Fischer's claim instead is that consumers are likely to be confused as to whether he sponsors or endorses Natural Honey Harvester merely because his name appears in the post-domain path of some of Brushy's URLs. The cases on which Fischer relies, applying a *per se* rule to

use of a mark by former licensees, are not applicable to this circumstance, in which the fact-intensive *Polaroid* test properly applies. See *Kelly-Brown*, 717 F.3d at 307.

In the end, the decisive question is whether, "looking at the [marks] in their totality, consumers are likely to be confused." *Starbucks Corp.*, 588 F.3d at 115 (internal quotation omitted). "Likelihood of confusion means a probability of confusion, it is not sufficient if confusion is merely possible." *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510 (2d Cir. 1997) (quotations omitted). Here, although there are factors that favor Fischer, those the Court finds most decisive disfavor Fischer's claim. He has not shown actual confusion or bad faith. And the sole use of his name is not as a mark. Fischer's name is instead tucked away in the post-domain path of Brushy's URL. The Court concludes, with Judge Peck, that, as a matter of law, Fischer "cannot possibly show confusion as to source or sponsorship." *Roberts*, 229 F. Supp. 3d at 251 (quoting *Pirone*, 894 F.2d at 585). On the evidence adduced, consumers are not at all likely to be confused as to whether Fischer endorses or sponsors Natural Honey Harvester based on the fact that his name appears in the post-domain path of Brushy's URLs. The Court therefore agrees that Brushy's motions for summary judgment on Fischer's false endorsement claims are property granted.

### **E. Fischer's Unfair Competition Claim Under New York Law**

Fischer next objects to the Report's recommendation that the Court grant summary judgment in favor of Brushy on Fischer's common law unfair competition claim, brought under New York law. Obj. at 10-12. Fischer argues that, in so recommending, Judge Peck improperly resolved an issue of fact as to whether there was actual confusion. Id.

The Court's discussion above controls as to this point. The elements of an unfair competition claim under New York law are identical to the elements of an unfair competition claim under the Lanham Act, save that the plaintiff must also show "bad faith by the infringing party." *Int'l Diamond Importers, Inc. v. Oriental Gemco (N.Y.), Inc.*, 64 F. Supp. 3d 494, 514 (S.D.N.Y. 2014) (quoting *Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.*, 887 F. Supp. 2d 519, 541 (S.D.N.Y. 2012)). Here, for the reasons above, Fischer has not made out a viable Lanham Act claim, and has not adduced evidence sufficient to support a finding of bad faith on Brushy's part. Brushy's summary judgment motion on this claim is, therefore, granted.

### G. Fischer's False Advertising Claims

"To prevail on a Lanham Act false advertising claim, a plaintiff must establish that the challenged message is (1) either literally or impliedly false, (2) material, (3) placed in interstate commerce, and (4) the cause of actual or likely injury to the plaintiff." *Church & Dwight Co. v. SPD Swiss Precision Diagnostics, GmbH*, 843 F.3d 48, 65 (2d Cir. 2016).

Here, Fischer brings two false advertising claims under the Lanham Act. The first alleges that Brushy's description of Natural Honey Harvester as "100% Natural" is false. TAC 04 ¶¶ 210(a), 211, see Pl. Br. at 26. The second alleges that Brushy's statement that it "c[a]me out with [its] own" product (i.e., Natural Honey Harvester) is false because Brushy purchases Natural Honey Harvester from a third party. TAC ¶¶ 210(d), 211; see Pl. Br. at 26. The Court addresses these in turn.

#### 1. "100% Natural"

Brushy describes Natural Honey Harvester as "100% Natural" in its online and print advertisements. Fischer alleged that this claim is false insofar as Natural Honey Harvest is not, in fact, "100%

Natural." Fischer does not, however, object to the Report's recommendation that this Court grant summary judgment for Defendants on this claim. The Court, finding no clear error, adopts the Report's recommendation.

## **2. "Come out with our own"**

In its advertisement for Natural Honey Harvester, Brushy states: "For years we have promoted the use of a natural product to harvest honey but an unreliable supply of such a product has forced us to come out with our own." See SAC 04 Ex. 8.<sup>14</sup> Fischer argues that "our own" is false because Brushy purchases the product it sells from a third-party. Pl. Br. at 22. The Report recommended that the Court grant summary judgment for Defendants because the operative term, "our own," is neither literally nor impliedly false. R&R 2 at 54-58.

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<sup>14</sup> In his objections, Fischer alternatively styles Brushy's offending phrase as "We made our own" and "We came out with our own." Obj. at 2, 12. In fact, both as alleged by Fischer and as reflected in Brushy's advertisement, the phrase used is "forced us to come out with our own." See TAC 04 WI210(d); SAC 04 Ex. 8.



Fischer objects that this was an issue of fact not appropriately resolved by a court. *Obi.* at 12. The Court reviews this issue de novo. For the reasons that follow, the Court agrees with Judge Peck that summary judgment is properly granted for Defendants because the evidence does not show literal or implied falsity.

#### **a. Literal Falsity**

"To establish literal falsity, a plaintiff must show that the advertisement either makes an express statement that is false or a statement that is 'false by necessary implication,' meaning that the advertisement's 'words or images, considered in context, necessarily and unambiguously imply a false message.'" *Church & Dwight Co.*, 843 F.3d at 65 (quoting *Time Warner Cable, Inc. v. DIRECTV, Inc.*, 497 F.3d 144, 158 (2d Cir. 2007)). A message can only be literally false if it is unambiguous. *Id.*

Here, the Court finds that the statement "come out with our own" is not literally false because it is not unambiguous. *See Apotex Inc. v. Acorda Therapeutics, Inc.*, 823 F.3d 51, 63 (2d Cir. 2016)("[O]nly an unambiguous message can be literally false." (quoting *Time Warner Cable*, 843 F.3d at 153) (emphasis in original)). The phrase does not unavoidably signify that the product offered by Brushy was created in the first instance by Brushy. Indeed, Fischer's allegations in his complaint, which assign alternative interpretations to

this phrase, underscore its uncertain meaning. See TAC 04 ¶ 210(d) ("The claim '*has forced us to come out with our own*' implies that they are somehow making the same product, or have taken over the manufacturing of Plaintiff's product, and/or that their product is related to, approved by, endorsed by, licensed, or authorized by Plaintiff."); see also *Classic Liquor Importers, Led. v. Spirits Int'l B. V.*, 201 F. Supp. 3d 428, 453 (S.D.N.Y. 2016) (plaintiff's own admission that the term "Since 1867" could have different meanings demonstrated term's ambiguity); *Time Warner Cable, Inc.*, 497 F.3d at 158 ("[I]f the language or graphic is susceptible to more than one reasonable interpretation, the advertisement cannot be literally false.").<sup>15</sup>

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<sup>15</sup> The formulation used by the Second Circuit in *Time Warner Cable* can be read to suggest that a statement cannot be literally false if its meaning is ambiguous, even if each alternative meaning of the statement is itself false. See *Classic Liquor Importers*, 201 F. Supp. 3d at 453 n.27 ("One could argue that, despite the Second Circuit's seemingly clear mandate that a message be 'unambiguous' to be deemed literally false, it would be illogical to require extrinsic evidence of consumer deception if it were the case that each possible message conveyed by an ambiguous statement was indisputably false."). This Court has no occasion to consider that circumstance here, because the expression at issue—"came out with our own"—issues susceptible to at least one truthful construction: that Natural Honey Harvester replaced Bee-Quick. Fischer's Complaint recognizes as much. See TAC 04 11211(e). To be sure, Fischer disputes that Brushy's Natural

**b. Implied Falsity**

Where a message is not literally false, a plaintiff may nonetheless demonstrate that it is impliedly false where the message leaves "an impression on the listener or viewer that conflicts with reality. *Church & Dwight Co.*, 843 F.3d at 65 (quoting *Time Warner Cable*, 497 F.3d at 153). However, "courts have, at times, required a claim of implied falsity to be supported by extrinsic evidence of consumer confusion." *Id.* "Alternatively, courts have allowed implied falsity to be supported by evidence that the defendant intended to deceive the public through 'deliberate conduct' of an 'egregious nature,' in which case a rebuttable presumption of consumer confusion arises." *Id.* (quoting *Merck Eprova AG v. Gnosis S.p.A.* 760 F.3d 247, 255-56 (2d Cir. 2104)).

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Honey Harvester is equivalent to his Bee-Quick. But, whether or not Brushy's is an inferior product, it is undisputed that Natural Honey Harvester replaced Bee-Quick as the product marketed by Brushy.

Here, as reviewed above, Fischer has not come forward with any credible evidence of consumer confusion. He therefore cannot establish implied falsity by that route. Nor has he adduced any evidence that Brushy's behavior in advertising its product with the term "come out with our own" was in any sense deliberately deceptive and "egregious." Fischer has therefore failed to adduce evidence establishing, on the first element of actual or implied falsity, a genuine issue for trial. See *Aslanidis v. US. Lines, Inc.*, 7 F.3d 1067, 1072 (2d Cir. 1993). The Court therefore grants Brushy's motions for summary judgment on this point.

#### **H. Remainder of the Report**

The Court has reviewed the remaining portions of the Report, as to which Fischer did not file any objections. The Court finds no clear error and adopts Judge Peck's recommendations in full.

#### **CONCLUSION**

For the foregoing reasons, the Court grants Brushy's motions for summary judgment. The Clerk of Court is respectfully directed to close the motions pending at 14 Civ. 1304, Dkt. 170, and 14 Civ. 1307, Dkt. 172, and to close this case.

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SO ORDERED.

[signature]  
Paul A. Engelmayer  
United States District Judge

Dated: February 16, 2018  
New York, New York

**APPENDIX E:**  
**RELEVANT STATUTORY PROVISIONS**

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**17 U.S.C. § 401. Notice of copyright: Visually perceptible copies**

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**(a) General provisions.** Whenever a work protected under this title is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section may be placed on publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device.

**(b) Form of notice.** If a notice appears on the copies, it shall consist of the following three elements:

(1) the symbol © (the letter C in a circle), or the word “Copyright”, or the abbreviation “Copr.”; and

(2) the year of first publication of the work; in the case of compilations or derivative works incorporating previously published material, the year date of first publication of the compilation or derivative work is sufficient. The year date may be omitted where a pictorial, graphic, or sculptural work, with accompanying text matter, if any, is reproduced in or on greeting cards, postcards,

stationery, jewelry, dolls, toys, or any useful articles; and

**(3)** the name of the owner of copyright in the work, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner.

**(c) Position of notice.** The notice shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright. The Register of Copyrights shall prescribe by regulation, as examples, specific methods of affixation and positions of the notice on various types of works that will satisfy this requirement, but these specifications shall not be considered exhaustive.

**(d) Evidentiary weight of notice.** If a notice of copyright in the form and position specified by this section appears on the published copy or copies to which a defendant in a copyright infringement suit had access, then no weight shall be given to such a defendant's interposition of a defense based on innocent infringement in mitigation of actual or statutory damages, except as provided in the last sentence of section 504(c)(2).

**17 U.S.C. § 402. Notice of copyright:  
Phonorecords of sound recordings**

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**(a) General provisions.** Whenever a sound recording protected under this title is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section may be placed on publicly distributed phonorecords of the sound recording.

**(b) Form of notice.** If a notice appears on the phonorecords, it shall consist of the following three elements:

(1) the symbol (P) (the letter P in a circle); and

(2) the year of first publication of the sound recording; and

(3) the name of the owner of copyright in the sound recording, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner; if the producer of the sound recording is named on the phonorecord labels or containers, and if no other name appears in conjunction with the notice, the producer's name shall be considered a part of the notice.

**(c) Position of notice.** The notice shall be placed on the surface of the phonorecord, or on the phonorecord



label or container, in such manner and location as to give reasonable notice of the claim of copyright.

**(d) Evidentiary weight of notice.** If a notice of copyright in the form and position specified by this section appears on the published phonorecord or phonorecords to which a defendant in a copyright infringement suit had access, then no weight shall be given to such a defendant's interposition of a defense based on innocent infringement in mitigation of actual or statutory damages, except as provided in the last sentence of section 504(c)(2).

**17 U.S.C. § 1202. Integrity of copyright  
management information**

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**(a) False copyright management information.** No person shall knowingly and with the intent to induce, enable, facilitate, or conceal infringement—

(1) provide copyright management information that is false, or

(2) distribute or import for distribution copyright management information that is false.

**(b) Removal or alteration of copyright management information.** No person shall, without the authority of the copyright owner or the law—

(1) intentionally remove or alter any copyright management information,

(2) distribute or import for distribution copyright management information knowing that the copyright management information has been removed or altered without authority of the copyright owner or the law, or

(3) distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information

has been removed or altered without authority of the copyright owner or the law,

knowing, or, with respect to civil remedies under section 1203, having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any right under this title.

**(c) Definition.** As used in this section, the term “copyright management information” means any of the following information conveyed in connection with copies or phonorecords of a work or performances or displays of a work, including in digital form, except that such term does not include any personally identifying information about a user of a work or of a copy, phonorecord, performance, or display of a work:

**(1)** The title and other information identifying the work, including the information set forth on a notice of copyright.

**(2)** The name of, and other identifying information about, the author of a work.

**(3)** The name of, and other identifying information about, the copyright owner of the work, including the information set forth in a notice of copyright.

**(4)** With the exception of public performances of works by radio and television broadcast stations, the name of, and other identifying information

about, a performer whose performance is fixed in a work other than an audiovisual work.

(5) With the exception of public performances of works by radio and television broadcast stations, in the case of an audiovisual work, the name of, and other identifying information about, a writer, performer, or director who is credited in the audiovisual work.

(6) Terms and conditions for use of the work.

(7) Identifying numbers or symbols referring to such information or links to such information.

(8) Such other information as the Register of Copyrights may prescribe by regulation, except that the Register of Copyrights may not require the provision of any information concerning the user of a copyrighted work.

**(d) Law enforcement, intelligence, and other government activities.** This section does not prohibit any lawfully authorized investigative, protective, information security, or intelligence activity of an officer, agent, or employee of the United States, a State, or a political subdivision of a State, or a person acting pursuant to a contract with the United States, a State, or a political subdivision of a State. For purposes of this subsection, the term “information security” means activities carried out in order to

identify and address the vulnerabilities of a government computer, computer system, or computer network.

**(e) Limitations on liability.**

**(1) Analog transmissions.** In the case of an analog transmission, a person who is making transmissions in its capacity as a broadcast station, or as a cable system, or someone who provides programming to such station or system, shall not be liable for a violation of subsection (b) if—

**(A)** avoiding the activity that constitutes such violation is not technically feasible or would create an undue financial hardship on such person; and

**(B)** such person did not intend, by engaging in such activity, to induce, enable, facilitate, or conceal infringement of a right under this title.

**(2) Digital transmissions.**

**(A)** If a digital transmission standard for the placement of copyright management information for a category of works is set in a voluntary, consensus standard-setting process involving a representative cross-section of broadcast stations or cable systems and

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copyright owners of a category of works that are intended for public performance by such stations or systems, a person identified in paragraph (1) shall not be liable for a violation of subsection (b) with respect to the particular copyright management information addressed by such standard if—

(i) the placement of such information by someone other than such person is not in accordance with such standard; and

(ii) the activity that constitutes such violation is not intended to induce, enable, facilitate, or conceal infringement of a right under this title.

**(B)** Until a digital transmission standard has been set pursuant to subparagraph (A) with respect to the placement of copyright management information for a category of works, a person identified in paragraph (1) shall not be liable for a violation of subsection (b) with respect to such copyright management information, if the activity that constitutes such violation is not intended to induce, enable, facilitate, or conceal infringement of a right under this title, and if—

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(i) the transmission of such information by such person would result in a perceptible visual or aural degradation of the digital signal; or

(ii) the transmission of such information by such person would conflict with—

(I) an applicable government regulation relating to transmission of information in a digital signal;

(II) an applicable industry-wide standard relating to the transmission of information in a digital signal that was adopted by a voluntary consensus standards body prior to the effective date of this chapter; or

(III) an applicable industry-wide standard relating to the transmission of information in a digital signal that was adopted in a voluntary, consensus standards-setting process open to participation by a representative cross-section of broadcast stations or cable systems and copyright owners of a category of works that are intended for public performance by such stations or systems.

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**(3)** Definitions. As used in this subsection—

**(A)** the term “broadcast station” has the meaning given that term in section 3 of the Communications Act of 1934; and

**(B)** the term “cable system” has the meaning given that term in section 602 of the Communications Act of 1934.