

No. \_\_\_\_\_

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**In The  
Supreme Court of the United States**

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PAIGE LEE, BUSINESS MOVES CONSULTING,  
INCORPORATED, BRANDMIXER, INCORPORATED,  
AND CURTIS BORDENAVE,

*Petitioners,*

v.

ANTHONY LAWRENCE COLLECTION, L.L.C.,  
DEFRON FOBB, THADDEUS REED, ALSO KNOWN  
AS REED ENTERPRISE, COLLEGIATE LICENSING  
COMPANY, L.L.C., INCORRECTLY SUED AS  
LEARFIELD COMMUNICATIONS, L.L.C.,

*Respondents.*

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**On Petition For A Writ Of Certiorari  
To The United States Court Of Appeals  
For The Fifth Circuit**

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**PETITION FOR A WRIT OF CERTIORARI**

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ANDREW T. LILLY  
LILLY PLLC  
4907 Magazine Street  
New Orleans, LA 70115  
(504) 812-6388  
andrew@atlpllc.com

*Attorney for Petitioners*

## QUESTIONS PRESENTED

Under Federal Rules of Civil Procedure 19(a), the joinder of IP owners/licensors as *plaintiffs* alongside licensees is required to prevent double recovery in infringement actions. But infringement *defendants* are joint tortfeasors who, under this Court’s *Temple v. Synthes*<sup>1</sup> rule, are only permissively joined. Their joinder as defendants isn’t required.

The question presented is whether a non-party’s status as trademark licensor, without more, makes his joinder as a defendant alongside his licensee required under Rule 19(a).

Courts interpreting Federal Rules of Civil Procedure 19(a) hold that a party required for joinder must claim a “non-frivolous interest” in the subject of the action. *Republic of Philippines v. Pimentel*.<sup>2</sup> Under federal trademark law, registering a trademark creates strong presumptions about the registration, the mark, and its owner’s exclusive use rights.<sup>3</sup>

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<sup>1</sup> *Temple v. Synthes Corp., Ltd.*, 498 U.S. 5; 111 S.Ct. 315; 112 L.Ed.2d 263 (1990).

<sup>2</sup> 553 U.S. 851; 128 S.Ct. 2180; 171 L.Ed.2d 131 (2008).

<sup>3</sup> “A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.” 15 U.S.C.A. § 1057(b).

**QUESTIONS PRESENTED – Continued**

The question presented is whether a party required for joinder in an infringement action involving a federally-registered trademark mark must claim something more than the usual “non-frivolous interest” in the subject of the action and, if so, the interest the nonparty must claim to be Rule 19(a)-required.

Under Federal Rules of Civil Procedure 19(a), a nonparty required to be joined in an action must face impairment of its interests.

The question presented is whether, under Rule 19(a), a district court trademark infringement claim can impair a nonparty’s ability to establish or maintain its trademark rights before the USPTO or TTAB.

Respondent Collegiate Licensing Company (CLC) is an industry leader in brand protection, representing thousands of intercollegiate and professional athletic departments and teams. It claims it is a trademark licensee under an agreement that requires it to defend the nonparty university (Jackson State University) in court.

The question presented is whether, under the circumstances, nonparty Jackson State University can be Rule 19(b)(1) prejudiced by CLC’s trademark infringement defense in the university’s absence, where a resulting judgment will be against respondents and not the university, and where the licensing agreement

**QUESTIONS PRESENTED** – Continued

CLC claims affords the university full indemnity.

Also presented for review is whether the dismissal of petitioners' infringement claims based on sovereign Jackson State University's nonjoinder leaves petitioners with an adequate remedy against respondents under Federal Rules of Civil Procedure 19(b)(4).

## **PARTIES TO THE PROCEEDING BELOW**

Petitioners are Paige Lee, Business Moves Consulting, Incorporated (“BizMoves”), Brandmixer, Incorporated, and Curtis Bordenave, the plaintiffs-appellants below.

Respondents are Anthony Lawrence Collection, L.L.C., Defron Fobb, Thaddeus Reed, also known as Reed Enterprise, Collegiate Licensing Company, L.L.C. (“CLC”), incorrectly sued as Learfield Communications, L.L.C., the defendants-appellees below.

## **CORPORATE DISCLOSURE STATEMENT**

Only two petitioners are nongovernmental corporations: Business Moves Consulting, Incorporated and Brandmixer, Incorporated. Neither has a parent, and no publicly held company owns ten percent or more of either petitioner corporation’s stock.

## **RELATED PROCEEDINGS**

U.S. District Court for the Eastern District of Louisiana:

*Paige Lee, Business Moves Consulting, Incorporated, Brandmixer, Incorporated, and Curtis Bordenave v. Anthony Lawrence Collection, L.L.C., Defron Fobb, Thaddeus Reed, also known as Reed Enterprise, Collegiate Licensing Company, L.L.C., incorrectly sued as Learfield Communications, L.L.C.*, No. 20-cv-0839 (judgment entered Nov. 17, 2020); and

**RELATED PROCEEDINGS** – Continued

U.S. Court of Appeals for the Fifth Circuit:

*Paige Lee, Business Moves Consulting, Incorporated, Brandmixer, Incorporated, and Curtis Bordenave v. Anthony Lawrence Collection, L.L.C., Defron Fobb, Thaddeus Reed, also known as Reed Enterprise, Collegiate Licensing Company, L.L.C., incorrectly sued as Learfield Communications, L.L.C., No. 20-30796 (judgment entered Aug. 24, 2022).*

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**PETITION FOR A WRIT OF CERTIORARI  
OPINIONS BELOW**

The circuit court’s opinion is reported at 47 F.4th 262 (5th Cir. 2022) and is reprinted in the Appendix (“App.”) beginning at page 3. The circuit court’s judgment is reprinted at App. 1.

The district court’s order and reasons, reported at 486 F.Supp.3d 1041 (E.D. La. 2020) and reprinted at App. 22, were incorporated by reference into its judgment, which is reprinted at App. 20.



**JURISDICTION**

The circuit court entered judgment on August 24, 2022. App. 1. This Court has jurisdiction to review this timely-filed petition under 28 U.S.C. § 1254(1).



**STATUTES AND CONSTITUTIONAL  
PROVISIONS INVOLVED**

Federal trademark law provides, in pertinent part, that “[a] certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the

certificate, subject to any conditions or limitations stated in the certificate.” 15 U.S.C.A. § 1057(b).

Rule 19 of the Federal Rules of Civil Procedure provides, in pertinent part:

(a) Persons Required to Be Joined if Feasible.

(1) Required Party. A person who is subject to service of process and whose joinder will not deprive the court of subject-matter jurisdiction must be joined as a party if:

(A) in that person’s absence, the court cannot accord complete relief among existing parties; or

(B) that person claims an interest relating to the subject of the action and is so situated that disposing of the action in the person’s absence may:

(i) as a practical matter impair or impede the person’s ability to protect the interest; or

(ii) leave an existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations because of the interest.

...

(b) When Joinder Is Not Feasible. If a person who is required to be joined if feasible cannot be joined, the court must determine whether, in equity and good conscience, the action should

proceed among the existing parties or should be dismissed. The factors for the court to consider include:

- (1) the extent to which a judgment rendered in the person's absence might prejudice that person or the existing parties;
- (2) the extent to which any prejudice could be lessened or avoided by:
  - (A) protective provisions in the judgment;
  - (B) shaping the relief; or
  - (C) other measures;
- (3) whether a judgment rendered in the person's absence would be adequate; and
- (4) whether the plaintiff would have an adequate remedy if the action were dismissed for nonjoinder.

...



## INTRODUCTION AND STATEMENT OF THE CASE

**1. Introduction.** In a first-of-its-kind ruling, the district court dismissed a trademark infringement case under Rule 12(b)(7) for nonjoinder of a sovereign trademark licensor whom the court held was a required *defendant* alongside its infringing licensees. The circuit court affirmed and reported its opinion.



If left undisturbed, the rulings below arm all manner of IP infringers with a novel and invincible defense in federal court: the sovereign trademark owner/licensor whose joinder *as a defendant* is declared Rule 19(a) “required” alongside the infringement defendant licensee(s).

Historically, Rule 19(a)(1)(B)(ii) has required the joinder of trademark owners/licensors as *plaintiffs* in infringement actions. That goal is legitimate: to avoid potential double recovery against infringers. But there’s no Rule 19(a) justification for the required joinder of those owners/licensors as *defendants* when their licensees are sued for infringement.<sup>4</sup> Courts regularly deny these Rule 12(b)(7) motions by applying this Court’s *Temple v. Synthes* rule, that joint tortfeasors are permissively joined as defendants; they’re not required. Before this case, the rule in the district courts seems to have been: status as a trademark owner/licensor, *without more*, cannot require Rule 19(a) joinder as a *defendant* in an *infringement* action. No real rule has emanated from the circuit courts and there’s no guidance so far from this Court.

Below, the Fifth Circuit seems to have announced a Rule 19(a) “trademark rule” rule, letting courts require joinder of trademark owners/licensors (based on that status alone) as *defendants* alongside their licensees sued for infringement. Nothing distinguishes this

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<sup>4</sup> Unlike *infringement* actions, when trademark *cancellation* is at issue, joinder of the owner/licensor as defendant is proper.

case's nonparty from any other party claiming trademark rights.

The commercial significance of this ruling cannot be overstated. In an era of rapidly expanding commercialization of intercollegiate athletics,<sup>5</sup> so long as a trademark infringer can vaguely point to a college's (even inchoate) trademark rights, it can avoid all manner of federal court infringement accountability. *This point is the most critical part of this petition.* This is an exceedingly important federal law question this Court hasn't decided, but should. Ancillary to that question is the predictable question of what quantum of proof must these Rule 12(b)(7) movants show to determine the nonparty's interest such that it must be joined as an infringement defendant.

Also, the Fifth Circuit broadly determined that petitioners' infringement action against the licensees is enough under Rule 19(a)(1)(B)(i): it impairs the nonparty's ability to establish or maintain its federal trademark rights. No court or commentator has recognized such a trademark truism, and the nonparty university's ability to move forward *ex parte* or *inter partes* before USPTO or TTAB is in reality, unaffected by the prosecution of an infringement action against its purported licensee without the nonparty. The Court should review and clarify this point in Rule 19(a) procedure.

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<sup>5</sup> The circuit court opinion is not shy about this fact and devotes a substantial portion of its introduction to the nonparty, its football team, and its "Prime Time" coach. App. 5.

After determining that the nonparty trademark owner/licensor was a Rule 19(a) required defendant, the Fifth Circuit determined under Rule 19(b) this case should not move forward in the nonparty's absence, distancing itself from the law in the Second and Federal Circuits by (1) giving undue weight to the nonparty's sovereign status as dispositive, rather than applying the four factors in Rule 19(b); (2) divining prejudice to the nonparty despite (i) the reality that an infringement judgment will be against the licensee defendants only; and (ii) the obvious ability of the licensee defendants to protect the nonparty's interest, the former being aligned in interest and an industry leader in protecting and litigating trademark disputes for NBA, NFL, MLB, and NCAA licensors); and (3) the inadequate remedy petitioners face when being told they cannot protect their federally-registered trademark rights because a state university is tangentially involved. Although these issues are more discrete, the circuits are moving in different directions, and, given the overarching Rule 19(a) question presented, the Court's guidance and review make sense.

**2. Petitioners.** BizMoves and Brandmixer are branding businesses that protect the identity of the products they market for sale by consistent, deliberate federal trademark registration. They license these marks to petitioners Lee and Bordenave occasionally, and they did so with the "Thee I Love" trademark.

**3. Respondents.** Collegiate Licensing Company (CLC) essentially *is* the NCAA, NFL, NBA, and MLB trademark licensing industry. According to its website,

“CLC’s nearly 120 licensing experts provide unmatched ***brand protection***, brand management, and brand development services to connect passionate fans to college brands through licensed merchandise.” CLC spends much of its time litigating, both defending and enforcing its clients’ trademark rights. The other respondents (“retailer respondents”) are lower-level merchandisers who openly infringe on petitioners’ registered marks, even going so far as to fraudulently include the ® designation on their infringing products.

**4. The trademarks.** In 2017-2018, BizMoves applied for and was granted a THEE I LOVE design mark on the U.S. Patent and Trademark Office’s (USPTO) Principal Register. BizMoves and its licensees sell apparel under the registered trademark reproduced below (“BizMoves Mark”):



The following year, BizMoves and Brandmixer applied for the text only “standard character mark” THEE I LOVE (“Biz-Moves/Brandmixer Mark” and, when used with the BizMoves Mark, the “Marks”), and the USPTO “found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.”

**5. The infringement suit.** In March 2020, petitioners sued respondents for infringement of the BizMoves Mark, alleging respondents had not only infringed on it but that they were fraudulently misrepresenting their interest in the Marks by using the ® designation on the infringing goods they sold. But no respondent ever owned or licensed a federally-registered trademark that resembles Thee I Love. And it's not a close call. The only Thee I Love registered mark belongs to BizMoves and was licensed for petitioners' use.<sup>6</sup>

**6. The “nonparty JSU defense.”** CLC moved for Rule 12(b)(7) dismissal, arguing the existence of a required, but sovereign, nonparty. According to CLC, Jackson State University's (JSU) interests are implicated by a twice-amended licensing document that gives respondents the right to use Thee I Love.

**7. The licensing document.** JSU gave CLC the exclusive right to sub-license defined JSU “Indicia” for use on all manner of university-related products and services, from lingerie to fishing gear, to internet service providers. According to the document, “Indicia” are “the designs, trademarks, service marks, logographics and symbols which have come to be associated with [JSU] including those set forth in Appendix A hereto.”

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<sup>6</sup> JSU applied for a Thee I Love standard character mark and Thee I Love! design mark, both of which USPTO *refused* noting: (1) likelihood of confusion with BizMoves Mark; and (2) the earlier-filed BizMoves/Brandmixer Mark application. App. 6.

But the licensing document doesn't mention Thee I Love or anything like it. And JSU's trademark applications show the licensing document (2007) well predated even JSU's first claimed commercial use of the Thee I Love (2010). By the dates JSU provided in its trademark applications, Thee I Love wasn't used until years after the licensing document was confected, it wasn't part of the "Indicia" identified in 2007, and in 2007 it wasn't a "trademark . . . which [had] come to be associated with JSU." Nothing in the twice-amended licensing document conveys later-acquired rights or future rights in trademarks.

But whatever rights it conveyed, the licensing document adequately protects JSU by requiring CLC to prosecute or defend lawsuits unless its interests aren't aligned with JSU's. And it indemnifies JSU from having to pay a judgment arising out of CLC or its' sublicensees' conduct.

**8. District court ruling.** Respondent Reed joined CLC's Rule 12(b)(7) motion, the matter was submitted on the papers, and the district judge issued an order and reasons dismissing CLC and Reed. App. 25. Later-served respondents Fobb and Anthony Lawrence Collection adopted CLC's motion, and they too were dismissed [App. 22], with the final judgment's entry as to all defendants in mid-November 2020. App. 20.

**9. Circuit court ruling.** The Fifth Circuit agreed with the district judge that JSU's joinder was Rule 19(a)(1)(B)(i) required, reasoning that JSU's attempt to register its own trademarks amounts to a

“non-frivolous interest” in petitioners’ suit [App. 9-10], and that JSU’s sovereign interests (and judicial efficiency) were practically impaired “because ownership of the mark is what this case is ultimately about.” App. 10-11.

In deciding the case shouldn’t move forward in sovereign JSU’s absence, “predominating [the circuit court’s] analysis [was] the fact that [JSU] is an arm of the State of Mississippi,” App. 12. The circuit court also reasoned that Rule 19(b) factors required the same outcome. App. 14-19. First, it concluded JSU might be prejudiced if not joined, divining some measure of daylight between the interests of sophisticated litigator/licensor CLC’s and JSU’s, a finding mostly at odds with a detailed Federal Circuit analysis of Rule 19’s operation in intellectual property cases.<sup>7</sup> Its analysis of the third factor (whether a judgment in [JSU’s] absence would be adequate, which the circuit court acknowledged as “more neutral than the others”) was a reiteration of its conclusion that CLC wasn’t adequate to represent JSU’s interests in its absence. On the fourth Rule 19(b) factor (adequacy of plaintiff remedy after dismissal), the circuit court rewrites trademark law by concluding:

the basis of this dispute is which party “Thee I Love” belongs to . . . the proper forum for

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<sup>7</sup> Despite disagreeing with its reasoning [App 13-14, n.3], the circuit court’s intense focus on *Gensetix, Inc. v. Board of Regents of Univ. of Tex. Sys.*, 966 F.3d 1316 (Fed. Cir. 2020), referencing it over a dozen times over the course of its five-page Rule 19(b) analysis, highlights the circuit split.

determining the owner of these trademark rights is the USPTO. Because appellants can presumably bring these claims against Collegiate and the Licensees *after* they have established their superior rights to the mark, this factor too weight in favor of dismissal.<sup>8</sup>



## REASONS FOR GRANTING THE PETITION

### I. **Whether purported trademark owner/licensors are Rule 19(a) required *defendants* in infringement actions brought against their licensees is an important federal law question that has not been, but should be, settled by this Court.**

The circuit court concluded that JSU was Rule 19(a) required to be joined as a trademark infringement defendant. According to the circuit court, JSU has a nonfrivolous interest in petitioners' infringement suit against the licensee retailers such that letting the infringement suit proceed in JSU's absence would practically impair its right to protect that interest.

But the qualities the circuit court found in JSU are true of every mark owner. Because there's nothing special about JSU or the property it claims, the ruling below seems to create a new rule: ***trademark owners must be joined as defendants when their licensees are sued for infringement.***

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<sup>8</sup> App. 19.



Below, in **I(a)**, petitioners argue this is a dubious proposition given the existing interplay between Rule 19(a) and trademark law. *Without more*, trademark ownership cannot require the joinder of the owner as an infringement defendant alongside its licensee.<sup>9</sup> In **I(b)**, petitioners suggest the record below was so bare, and the circuit court’s conclusion so indifferent toward the weight the Lanham Act gives a registered mark, that the ruling below can be interpreted only as a new rule announcement for determining “nonfrivolous interest” under Rule 19(a). Stated differently, this is a “*without more*” case. In **I(c)**, petitioners show the rulings below turn squarely upon the courts’ misapprehension of Rule 19(a)(1)(B)(i) “practical impairment” – where an infringement ruling against the retailers can’t affect JSU’s interest in registering Thee I Love, or opposing or canceling petitioners’ attempts to do the same.

**a. Trademark owners/licensors, without more, aren’t Rule 19(a) required defendants in infringement actions brought against their mark licensees.**

A trademark *owner* is probably Rule 19(a) required where his licensee is an *infringement plaintiff*. See *Waterman v. Mackenzie*, 138 U.S. 252; 11 S.Ct. 334, 335; 34 L.Ed. 923 (1891) (owner/licensor should be joined with patent licensee as patent infringement

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<sup>9</sup> The circuit court refused to conduct this analysis or even recognize the starting point as a general rule.

plaintiff). *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348 (9th Cir. 1964) (copyright owner indispensable in infringement suit, citing *Waterman*); *Widenski v. Shapiro, Bernstein & Co.*, 147 F.2d 909 (C.C.A. 1st Cir. 1945) (same). “The same probably is true of trademark litigation, although there is remarkably little authority on this point.” Mary K. Kane, 7 Fed. Prac. & Proc. Civ. § 1614 (3d ed. Apr. 2022 update); *Assn. of Co-Op. Members, Inc. v. Farmland Industries, Inc.*, 684 F.2d 1134, 1143 (5th Cir. 1982) (licensor Rule 19 indispensable because “judgment for the plaintiff-licensee could result in double obligations for the defendant, should the licensor subsequently sue on his own.”). “In some cases, when a licensee sues for infringement of the licensed mark, the trademark owner may be an indispensable party who must be joined in the lawsuit.” J. Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition § 32:12 (5th ed. Sep. 2022 update), citing *Farmland*.

But what if a licensee is sued as a defendant? One court held that a patent owner was Rule 19 indispensable (prior version) where **cancellation** of the patent was at stake. *Am. Optical Co. v. Curtiss*, 59 F.R.D. 644 (S.D.N.Y. 1973) (**emphasis added**). This makes sense – cancellation suits are by their very nature Rule 19(a)(1)(B)(i) interest-impeding. If JSU faced cancellation of its marks or rights, it ought to be joined.

But that didn’t happen. Rather, petitioners sued respondents for infringement, not for cancellation. Before this case, no circuit court had determined a trademark owner Rule 19(a) required *as a defendant* when

his licensee was sued for *infringement*. The briefs are littered with citations to cases that are low-level, old, and factually inapposite. Although Professor Kane wrote “there is very little authority regarding who must be joined in trademark-infringement suits,” she also reasoned:

The question of who must be joined **as defendants** in patent, copyright, and trademark suits for infringement also is fairly easy to answer. A suit for infringement may be analogized to other tort actions. All infringers are jointly and severally liable. Thus, plaintiff may choose whom to sue and is not required to join all infringers in a single action.

Mary Kay Kane, 7 Fed. Prac. & Proc. Civ. § 1614 (3d ed. April 2022 update) (**emphasis added**). Rule 19’s redactors must have agreed:

The subdivision (a) definition of persons to be joined is not couched in terms of the abstract nature of their interests – “joint,” “united,” “separable,” or the like. See N.Y. Temporary Comm. on Courts, First Preliminary Report, *supra*; Developments in the Law, *supra*, at 880. It should be noted particularly, however, that the description is not at variance with the settled authorities holding that **a tortfeasor with the usual “joint-and-several” liability is merely a permissive party to an action against another with like liability**. See 3 Moore’s Federal Practice 2153 (2d ed. 1963); 2 Barron & Holtzoff, Federal Practice & Procedure § 513.8 (Wright ed. 1961). Joinder

of these tortfeasors continues to be regulated by Rule 20; compare Rule 14 on third-party practice.

Fed. R. Civ. P. 19 (Advisory Committee Notes: 1966 Amendment) (**emphasis added**). Professor McCarthy agrees:

Since trademark infringement and unfair competition are torts, the doctrine of joint tortfeasors is applicable . . . a trademark owner can elect to sue less than all of the tortfeasors who are allegedly infringing the mark.

J. Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition § 25:23 (5th ed. Sep. 2022 Update).

A district court 12(b)(7) motion denial features the best analysis to date. *WM International, Inc., et al. v. 99 Ranch Market #601, et al.*, 329 F.R.D. 491 (E.D.N.Y. 1/8/19). The WM International fight involved two different makers of Kong Moon Rice Sticky Noodles. On the plaintiff’s side were manufacturers, distributors, and importers of “Double Swallow Brand.” They sued various wholesale and retail importers and distributors of “Leading Swallow Brand” for infringement and trademark cancellation. But they didn’t sue the owner (Tian Liu) of the “Leading Swallow Brand” trademark. Defendants moved for Rule 12(b)(7) dismissal for failure to join Tian Liu, claiming the “Leading Swallow Brand” trademark owner was a required party under Rule 19(a). The denial turned upon the distinction between infringement and cancellation actions, concluding that Rule 19 doesn’t constrain

*plaintiffs* faced with owner/licensee *infringement* defendants:

Trademark owners are indispensable parties under Rule 19 for purposes of ***canceling a trademark***. This principle protects (i) absent trademark owners from the estoppel effect of a judgment in which the trademark owner did not participate and which determined the trademark to be invalid, (ii) the plaintiff's interest in avoiding multiple lawsuits concerning the same basic facts and (iii) the public's interest in efficiently utilizing judicial resources. *May Apparel Group, Inc. v. Ava Import-Export, Inc.*, 902 F.Supp. 93, 96 (M.D.N.C. 1995) (citing *Earl v. Peverett*, 1991 WL 33281, at \*1 (S.D.N.Y. 1991)). As a result, the owner of a trademark is an indispensable party to an action to cancel the trademark because it would be "pointless to litigate in [the owner's] absence whether plaintiffs or defendants have a superior right to the mark if [the owner's] right is superior to the rights of any parties already joined in th[e] action." *Earl*, 1991 WL 33281, at \*1 (S.D.N.Y. 1991).

However, ***a plaintiff asserting [infringement] claims under the Lanham Act may choose not to name a trademark owner without running afoul of Rule 19 because trademark "[i]nfringers who may be found jointly and severally liable are not necessary parties"*** for purposes of the rule. *Fifth Ave. of Long Island Realty Assocs. v. Caruso Management Co., Ltd.*, 2009 WL 412126, at \*17 (E.D.N.Y. Feb. 17, 2009); *Rostropovich*

*v. Koch Intern. Corp.*, 1995 WL 104123, at \*10-11 (S.D.N.Y. Mar. 7, 1995) (licensor of Plaintiff's music recordings was not a necessary or indispensable defendant in Lanham Act suit brought against licensee and distributor of recordings); see also *Temple v. Synthes Corp. Ltd.*, 498 U.S. 5, 8, 111 S.Ct. 315, 112 L.Ed.2d 263 (1990) (joint tortfeasors are "merely permissive parties" and not indispensable parties under Rule 19). As a result, "in a trademark case any member of the distribution chain can be sued as an alleged tortfeasor," but this does not require joinder of all other potential tortfeasors arising from the same infringing conduct. *Make Up For Ever, SA v. SOHO Forever, LLC*, 198 F.R.D. 56, 60 (S.D.N.Y. 2000); see also *Sygma Photo News. Inc. v. High Society Magazine, Inc.*, 778 F.2d 89, 92 (2d Cir. 1985) ("all persons and corporations who . . . benefit from the infringement are jointly and severally liable as copyright infringers") . . . This is consistent with the "recognized philosophy of Rule 19" to use caution and "avoid dismissal wherever possible." *Stabilisierungsfonds Fur Wein v. Kaiser Stuhl Wine Distributors Pty. Ltd.*, 647 F.2d 200, 208 (D.C. Cir. 1981); see also *Bassett v. Mashantucket Pequot Tribe*, 204 F.3d 343, 360 (2d Cir. 2000).

Defendants point to cases dismissed pursuant to Rule 12(b)(7) because a plaintiff-licensee failed to join a licensor in a copyright or trademark action and argue the same result should apply here. However, in those cases the absent licensor had a legally protected interest in the subject matter of the litigation that it was

entitled to “vigorously assert[]” and there was a significant risk that “judgement for the plaintiff-licensee could result in double obligations for the defendant, should the licensor subsequently sue on his own.” Here, on the other hand, ***Defendants argue for joinder of another defendant, not a licensor-plaintiff***, which eliminates the risk that Defendants will be subject to double, multiple or inconsistent obligations. As a result, this case is better “analogized to other tort actions” where “all infringers are jointly and severally liable.” Bassett, 204 F.3d at 358.

*Id.* at 496-498 (***emphases added***). If this were a trademark *cancellation* case, Rule 19(a) would require JSU’s joinder as a defendant alongside its licensees. But it’s not. Shown above, the best rule seems to be that JSU’s status as a trademark owner, *without more*, isn’t enough to make it Rule 19(a) required as a defendant in an *infringement* action brought against its licensees. This Court hasn’t decided these issues, but it should. Using sovereign parties as “trademark infringement shields” offends the principles underpinning *Temple v. Synthes* and the practice is a contortion of Rule 12, Rule 19, and the Lanham Act.<sup>10</sup> The Court should put an end to it before it becomes commonplace.

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<sup>10</sup> It’s also true that Rule 19(a) contemplates defendant joinder only where a cause of action exists against the supposedly “required” nonparty. See *Vieux Carre Property Owners, Residents & Associates, Inc. v. Brown*, 875 F.2d 453 (5th Cir. 1989).

- b. Without more, respondents’ claim that JSU owns Thee I Love doesn’t require joinder; the record otherwise reveals no JSU “nonfrivolous interest” to satisfy Rule 19(a)(1)(B).**

As shown above (**I(a)**), trademark ownership *by itself* cannot require Rule 19(a) joinder of the owner as an infringement *defendant*. As a California district court recently summarized the law in a trademark infringement case:

It has long been the rule that it is not necessary for all joint tortfeasors to be named as defendants in a single lawsuit. However, this rule does not preclude a joint tortfeasor from being found indispensable **in some instances**. “[T]here may be **circumstances** in which an alleged joint tortfeasor has particular interests that cannot be protected in a legal action unless it is joined under Rule 19(a)(1)(B).” *Ward v. Apple Inc.*, 791 F.3d 1041, 1048 (9th Cir. 2015).

*Coachella Music Festival, LLC v. Live Nation Entm’t, Inc.*, 2021 WL 6882303, at \*3 (C.D. Cal. Dec. 20, 2021) (**emphasis added**).

As a procedural matter, the circuit court noted that the burden of proof starts with the movants. App. 8. And in the Fifth Circuit, that burden shifts once a *prima facie* case of required party has been made. *Id.*, citing *Hood ex rel. Mississippi v. City of Memphis*, 570 F.3d 625, 628 (5th Cir. 2009). “Rule 12(b)(7) motions cannot be granted on the mere suggestion of vague



possibility that nonparties may have an interest in the action.” *In re JCC Envtl., Inc.*, 575 B.R. 692, 703 (E.D. La. 2017), citing Arthur R. Miller, 5C Fed. Prac. & Proc. Civ. § 1359 (3d ed.).

With this in mind, and by accepting the general rule (e.g. a claim of trademark ownership alone cannot require joinder as infringement defendant), there is no burden shift “*without more*.” And here, there’s nothing more.

An appreciation of this case’s atmospheric trimmings is critical. It is undisputed that petitioners own federal trademark registration. App. 4-6. It’s a Lanham Act truism that trademark registration with USPTO is powerful *prima facie* evidence of the mark’s validity, registration, ownership, and use by exclusive right. 15 U.S.C.A. § 1057(b).

Here, petitioners sued respondents for infringing petitioners’ federally-registered trademark rights. App. 6. There was no attempt to attack any rights JSU may have had, or to cancel any trademarks as being junior to petitioners’ registered marks. *Id.* The allegations were simply that respondents were conducting business in a manner that offended petitioners’ federally-registered rights. *Id.*

JSU’s only link to these defendants, or this dispute, is through the argument of counsel and the production of a twice-amended licensing agreement. Even if JSU’s link as owner-licensor could ever be enough (*without more*, it cannot, as shown in **I(a)**, above), the problems with the license document are so substantial

the district judge should have cut off his analysis and sent respondents to the end of the line to try again. See Statement of the Case, ¶ 7.

To show that Rule 19(a)(1)(B) “claimed interest,” the circuit court relied upon JSU’s status as a trademark owner, which is not enough, *without more*. And where the circuit court found it meaningful that JSU’s interest might be in shoring up unregistered or poorly-protected rights it might have,<sup>11</sup> those inchoate or speculative rights have never supported a Rule 19(a)(1)(B) required status. Underpinning every successful “trademark owner-must be joined” Rule 12(b)(7) motion is an inescapable precondition – that the owner has the rights that could be damaged if he wasn’t joined:

The “interest” contemplated in Rule 19(a) must be “more than a financial stake, and more than speculation about a future event.” *Automation Support, Inc. v. Wallace*, No. 3:14-CV-04455, 2015 WL 13106329, at \*5 (N.D. Tex. July 23, 2015) (citing *Conceal City, L.L.C. v. Looper Law Enf’t, LLC*, 917 F.Supp.2d 611, 623 (N.D. Tex. 2013)). The nonparty’s “interest” must also be legally protectable. *United Keetoowah Band of Cherokee Indians of Okla. v. United States*, 480 F.3d 1318, 1324 (Fed. Cir. 2007) (citing cases).

*Pearson’s Inc. v. Ackerman*, 2018 WL 5886608, \*3 (N.D. Tex. Nov. 9, 2018) (denying Rule 12(b)(7) motion in trademark infringement case). From a mechanics

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<sup>11</sup> “[T]he ownership dispute lurking beneath the surface.” App. 10.

standpoint, the circuit court took accepted respondents’ “JSU rights” argument whole cloth, but that’s not how Rule 12(b)(7) motions work. “A court deciding a Rule 12(b)(7) motion ‘must accept all factual allegations in the complaint as true and draw inferences in favor of the non-moving party.’” *Dine Citizens Against Ruining Our Env’t v. Bureau of Indian Affairs*, 932 F.3d 843 (9th Cir. 2019), *cert. denied*, 141 S.Ct. 161; 207 L.Ed.2d 1098 (2020); *Nanko Shipping, USA v. Alcoa, Inc.*, 850 F.3d 461, 465 (D.C. Cir. 2017).

The circuit court found Rule 19(a)(1)(B) “required” JSU’s joinder as a trademark infringement *defendant*, with nothing *more* than a showing that JSU either *was* or *might be* the trademark owner. Even if such a showing were Rule 19-sufficient, the record doesn’t permit it because of (1) the petitioners’ federal registration of the mark at issue; and (2) a litany of problems with the purported license link between JSU and respondents.

This is a “without more” case, and had the circuit court conducted the proper analysis, it would have found the Rule 12(b)(7) initial burden never shifted. Such a “without more” finding amounts to the circuit court’s recognition of the very rule, which, under the analysis in I(a), cannot be.

But the circuit court had no guidance, and to answer this important question of federal law, the Court should grant this petition and conduct a certiorari review with the record, briefing, and argument.

**c. A district court infringement case doesn't Rule 19(a)(1)(B)(i) impair JSU's trademark rights.**

JSU's ownership of (or efforts toward owning) Thee I Love, without more, aren't Rule 19(a)(1)(B) interests requiring JSU to be joined as an infringement *defendant* alongside its mark licensees. Without a "required party" finding, the calculus ends.

But even if JSU's interests are enough for Rule 19(a) "required party" status, maintenance of the petitioners' suit in JSU's absence won't impair its interests.

According to the circuit court, "ownership of the mark is what this case is ultimately about," App. 11, and "the proper forum for determining the proper owner of these trademark rights is the USPTO." App. 19.

As a Rule 19(a)(1)(B)(i) "impairment" matter, the district court infringement proceeding won't affect JSU's ability to establish or protect mark ownership. That's a legal truism as much as it's a practical consideration. The circuit court emphasized the latter, focusing *only* on theoretical possibilities like "[JSU] could still face challenges protecting its interest if it is not joined here. For instance, if the University was part of the lawsuit, there would be no need to challenge Business Moves' trademark in other fora." App. 11.

But the circuit court's appreciation of the Article III courts' interplay with USPTO/TTAB is incomplete.

Petitioners' case is an infringement case; it doesn't seek to invalidate any JSU rights. Even if JSU were joined, and asked for a declaration of cancellation of the BizMoves Mark, that would be improper. "The declaratory judgment procedure cannot be used to short-circuit established administrative procedures, such as TTAB proceedings (which are already underway here). J. Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition § 32:53 (5th ed.), citing *Pub. Serv. Comm'n of Utah v. Wycoff Co., Inc.*, 344 U.S. 237, 73 S.Ct. 236, 97 L.Ed. 291 (1952).

Aside from the fact that petitioners' infringement action seeks only to punish misuse, rather than attack nonparty JSU's broadly-described trademark rights, in every other way legally imaginable, petitioners' infringement claims (or even a judgment) against respondents won't block JSU from going to USPTO or TTAB and asking for what it wants. It's true of JSU's purported common law rights.<sup>12</sup> It's true of JSU's ability to engage in USPTO/TTAB *inter partes* opposition or cancellation proceedings against petitioners' mark(s).<sup>13</sup> And in practical terms the circuit court

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<sup>12</sup> 6 McCarthy on Trademarks and Unfair Competition § 32:94 (5th ed.), citing *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 U.S.P.Q. 412 (C.C.P.A. 1961), *cert. denied*, 369 U.S. 864, 8 L. Ed. 2d 84, 82 S. Ct. 1030, 133 U.S.P.Q. 702 (1962); *DeCosta v. Columbia Broadcasting System, Inc.*, 498 F.2d 1383, 182 U.S.P.Q. 169 (C.C.P.A. 1974) (decision of court that a party has prior rights in a character idea is not binding on PTO as to registrability of character as a service mark).

<sup>13</sup> "A 'claim' for trademark infringement in a prior infringement case in court is not usually the same as a 'claim' in a TTAB

preferred over legal terms; we know this because JSU has proceeded (and continues today) before USPTO and TTAB despite the ongoing nature of this litigation, with the only impediment existing in USPTO's records. App. 6.

The circuit court expressed concern that an infringement loss by respondents, without JSU, "could put pressure on the University in the short term to abandon or capitulate to [petitioners], as it could all but halt their use of the mark in commerce" App. 11. To the extent petitioners' federally-registered marks might conflict with JSU's unregistered, common law, or state registrations, the proper course of conduct is for JSU to apply with USPTO or instigate *inter partes* proceedings with TTAB, both of which it has done without impediment during this case's pendency. The circuit court puts the horse before the cart when it mistakenly suggests that petitioners' infringement claims should be dismissed "[b]ecause [petitioners] can presumably

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opposition or cancellation against another's registration of a mark." J. Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition § 32:82 (5th ed.) § 32:82, citing *Treadwell's Drifters Inc. v. Marshak*, 18 U.S.P.Q.2d 1318 (TTAB 1990). This means that JSU wouldn't be precluded by the rule of claim preclusion if it later petitioned or opposed appellants' marks before TTAB, even if its licensees lost a previous infringement claim in court. *Id.* The Federal Circuit has written on the topic extensively, concluding that the significant difference between a federal court infringement claim and a TTAB *inter partes* cancellation claim means that in most cases, the "claim" is not the same. *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1364, 55 U.S.P.Q.2d 1854 (Fed. Cir. 2000) ("[T]he overall transactional facts are simply too distinct to allow claim preclusion from an infringement claim action to bear on a subsequent cancellation claim").

bring these claims against [CLC] and the [other respondents] after they have established their superior rights to the mark.” App. 19. JSU’s interest isn’t insignificant, but even assuming the record below showed a JSU link to this case (which the license document didn’t), those interests aren’t adequate to compel joinder of JSU as an additional infringement *defendant*, and both the law and the practicalities show JSU hasn’t been impeded in establishing and protecting whatever rights it might have.

**II. In several respects, the Fifth Circuit’s Rule 19(b) analysis conflicts with Second and Federal Circuit rulings and reveals the need for this Court’s guidance.**

The majority of the circuit court’s Rule 19(b) analysis turned on either JSU’s sovereign status, or its status as a purported trademark owner. The former is an impermissible collapse of the proper 4-factor analysis. The latter shows even less fidelity to Rule 19(b)(1)-(4), preferring a quality that, by itself, isn’t even sufficient to make the nonparty Rule 19(a) “required”:

**A. The inappropriate weight the circuit court gave JSU’s sovereign status conflicts with the general Rule 19(b) principle recognized in the Federal Circuit.**

Although it conducted a secondary Rule 19(b) analysis using each of the four factors in the rule, the circuit court essentially concluded JSU’s sovereign

status, alone, was enough to require dismissal. App. 12-14. That approach was held improper in a patent infringement case decided by the Federal Circuit. *Gensetix, Inc. v. Bd. of Regents of Univ. of Texas Sys.*, 966 F.3d 1316, 1326 (Fed. Cir. 2020) (district court’s dismissal was an abuse of discretion by “giving overwhelming weight to [university’s] sovereign status to the exclusion of all other facts.”). Courts’ real temptation to fold the sovereign status into every Rule 19(a) or (b) consideration calls for this Court’s review and clarifying analysis.

### **B. The circuit court’s Rule 19(b)(1) analysis**

As to “the extent to which a judgment rendered in [trademark owner/licensor’s] absence might prejudice [it] or [defendant trademark licensees],” under these circumstances, it doesn’t. That’s what the Southern District of New York held in denying a licensee-defendant’s Rule 12(b)(7) motion, and reasoning:

In contrast to the licensor-plaintiff cases Defendants cite, in *Rostropovich* the Court declined to find a would-be *licensor-defendant* “indispensable” in a Lanham Act lawsuit. 1995 WL 104123, at \*11. There, the plaintiff sought to “enjoin defendants from misappropriating his property rights” but defendants “assert[ed] that a foreign non-party from whom they allegedly acquired their right must be joined.” *Id.* The Court concluded that the case could go forward without the absent



licensor because the dispute could be resolved without affecting the licensor's rights in the future and "any relief that may be granted will be limited to defendants, leaving any possible interests of [the absent licensor] unaffected." *Id.* Here, as in *Rostropovich*, Tian Liu is a foreign party named, but not yet joined, as a defendant and joint tortfeasor. Any relief granted will be limited to defendants already served, leaving Tian Liu's rights and interests untouched.

*WM International, Inc., et al. v. 99 Ranch Market #601, et al.*, 329 F.R.D. 491, 496-498 (E.D.N.Y. 1/8/19) (*emphasis added*), citing *Rostropovich v. Koch Intern. Corp.*, 1995 WL 104123, at \*10-11 (S.D.N.Y. Mar. 7, 1995) (licensor of plaintiff's music recordings was not a necessary or indispensable defendant in Lanham Act suit brought against licensee and distributor of recordings). The same holds true in this case, and the Court should examine this issue to determine whether the foundation it created in *Temple v. Synthes* is susceptible of erosion at the hands of trademark infringers who point to sovereign joint tortfeasors to avoid accountability.

Also, the circuit court divines some daylight between JSU and CLC's interests in determining that the latter, which is a sophisticated licensing and litigation agent responsible for the majority of intercollegiate and professional athletics trademark litigation, can't adequately represent JSU's interests in its absence. This collides with the Federal Circuit's *Gensetix* rule and imposes an inapplicable "overlapping but not

identical” distinction between JSU and CLC’s interests. Trademark law isn’t as complicated as patent law with assignments and licensing. This is despite the licensing agreement’s mandate that professional and college sports litigation juggernaut CLC control litigation unless its interests depart from JSU’s, in which case the latter controls litigation. These false distinctions contradict the approach endorsed by the Federal Circuit and call for certiorari review.

**C. The circuit court’s 19(b)(4) analysis conflicts with the Second and Federal Circuits’ approach toward the maintenance of suits absent sovereign non-party joint tortfeasors.**

The circuit court mostly sidestepped whether petitioners would have had a Rule 19(b)(4) adequate remedy if their action was dismissed for nonjoinder. “[T]he proper forum for determining the proper owner of these trademark rights is the USPTO.” App. 19. JSU’s abilities to create and protect its property rights haven’t been affected by petitioners’ infringement action in the district court. Petitioners aren’t as fortunate; Second<sup>14</sup> and Federal<sup>15</sup> Circuit precedent would have compelled a different result:

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<sup>14</sup> *Bassett v. Mashantucket Pequot Tribe*, 204 F.3d 343 (2d Cir. 2000)

<sup>15</sup> *Gensetix, Inc. v. Bd. of Regents of Univ. of Texas Sys.*, 966 F.3d 1316 (Fed. Cir. 2020)

[T]he equities do not sway in favor of [dismissal]. In *Bassett* the Second Circuit found that “assuming [Plaintiff’s] copyright is infringed . . . dismissal [under Rule 12(b)(7)] would completely deprive [Plaintiff] of the opportunity to prevent further infringement” since the alleged indispensable party was an Indian tribe immune from suit. *Bassett*, 204 F.3d at 358. Here, like *Bassett*, if Plaintiffs are not permitted to litigate claims without Tian Liu and Tian Liu cannot be served, despite Plaintiffs’ extensive efforts, Plaintiffs will be deprived of the opportunity to prevent future infringement. The law permits joint and several liability and allows plaintiffs to recover from some, but not all tortfeasors, particularly where the need to join all potentially liable tortfeasors might prevent the Plaintiff from recovering at all.

*WM Int’l, Inc. v. 99 Ranch Mkt.* #601, 329 F.R.D. 491, 498 (E.D.N.Y. 2019), citing *Bassett v. Mashantucket Pequot Tribe*, 204 F.3d 343, 358 (2d Cir. 2000). The same Rule 19(b)(4) considerations were at play in *Gensetix*, a Federal Circuit patent case out of Texas:

Rather than cede control, once again, to UT’s claim of sovereign immunity, the district court should have given weight to the fact that *Gensetix* is without recourse to assert its patent rights because UT cannot be feasibly joined.

*Gensetix, Inc. v. Bd. of Regents of Univ. of Texas Sys.*, 966 F.3d 1316, 1326 (Fed. Cir. 2020).

The circuit court's analysis doesn't touch on whether petitioners have any measure for forcing the infringing retailers to stop using their federally-registered mark. The better approach is found in the Federal and Second Circuits' acknowledgment that infringement plaintiffs are "complete[ly] depriv[ed]" and "without recourse" when sovereign licensors are considered required defendants alongside its licensees. Because this will *always* be the result, the Court should review and determine whether Rule 19(b)(4) can operate any differently than it does in *Bassett* and *Gensetix*.

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## CONCLUSION

The Court should grant this petition and a writ of certiorari should issue for review of the Circuit Court's decision.

Respectfully submitted,

ANDREW T. LILLY  
LILLY PLLC  
4907 Magazine Street  
New Orleans, LA 70115  
(504) 812-6388  
andrew@atlpllc.com

*Attorney for Petitioners*