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[SEAL] **United States Court of Appeals
for the Fifth Circuit**

No. 20-30796

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

Plaintiffs—Appellants,

versus

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.,

Defendants—Appellees.

Appeal from the United States District Court
for the Eastern District of Louisiana
USDC No. 2:20-CV-839

Before JOLLY, ELROD, and OLDHAM, *Circuit Judges.*

JUDGMENT

(Filed Aug. 24, 2022)

This cause was considered on the record on appeal
and was argued by counsel.

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IT IS ORDERED and ADJUDGED that the judgment of the District Court is AFFIRMED.

IT IS FURTHER ORDERED that each party bear its own costs on appeal.

**United States Court of Appeals
for the Fifth Circuit**

No. 20-30796

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INCORPORATED; BRANDMIXER, INCORPORATED;
CURTIS BORDENAVE,

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(Filed Aug. 24, 2022)

Before JOLLY, ELROD, and OLDHAM, *Circuit Judges.*

JENNIFER WALKER ELROD, *Circuit Judge:*

Curtis Bordenave and Paige Lee are in the business of owning trademarks. They petitioned the United States Patent and Trademark Office for federal registration of the mark “THEEILOVE” (and other similar

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marks). That phrase, “Thee I Love,” comes from the alma mater of Jackson State University. They then sued the University’s licensing agent (Collegiate Licensing Company) and a few of the licensees in charge of producing and selling the University’s merchandise (Anthony Lawrence Collection, Defron Fobb, and Thaddeus Reed, together “the Licensees”). But they did *not* sue the University itself. Collegiate and the Licensees moved to dismiss under Federal Rule of Civil Procedure 12(b)(7). The district court granted the motion and dismissed the suit without prejudice. We AFFIRM.

I.

Curtis Bordenave, by his telling, licenses trademarks “from time to time.” He owns Business Moves Consulting, a “branding business[]” which “protect[s] the identity of the products” it sells “by consistent, deliberate federal trademark registration.” In 2017, Business Moves applied for the design mark “THEEILOVE,” which the USPTO granted the next year. Business Moves then licensed use of the mark to Brandmixer (also a branding business) and Paige Lee, all of which claim to sell apparel with the registered design. In 2019, Business Moves and Brandmixer together applied for another “THEE I LOVE” mark, this time for several other uses, such as on license plates. (That application is still pending with the USPTO.)

This posed a problem for Jackson State University. Founded in 1877, the University is one of the largest historically black colleges or universities in the

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country. Its football team, led by Head Coach Deion Sanders (also known as “Prime Time” or “Neon Deion”), runs onto the field each game to the music of the University’s marching band, the Sonic Boom of the South. And when the Tigers secured the Southwestern Athletic Conference championship last season, the Sonic Boom of the South played “Thee I Love,” the University’s alma mater, for the team and all its loyal fans. That phrase plays a significant role in the University’s lore, as it has served as the University’s alma mater for roughly eighty years. Students and alumni wear shirts bearing the phrase, and the State of Mississippi even issues vanity plates with “Thee I Love” and the school’s logo to the University’s most loyal fans. The University does not handle the licensing of its trademarks or make its own merchandise. It instead works with Collegiate Licensing Company to license out the University’s “trademarks and other indicia” to manufacturers to make (and sometimes sell) its merchandise. The University and Collegiate have since authorized several licensees, including Anthony Lawrence Collection, LLC, Defron Fobb, and Thaddeus Reed, to produce and sell the University’s merchandise.

Despite this history, the University never applied to have the phrase registered as a federal mark until after Business Moves had already done so. The University *did* register a mark under Mississippi law in 2015 for use on vanity plates, and in 2019 (after Business Moves had already secured the federal mark) for use on merchandise. It also claims to have common-law

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rights to the mark under the Lanham Act. The University applied in late 2019 for the same federal marks as it secured under state law, but the USPTO preliminarily refused the applications because Business Moves and Brandmixer beat it to the punch.

Business Moves (along with Brandmixer, Bordenave, and Lee) sued Collegiate and the Licensees for various claims centered on their licensing, manufacturing, and selling of “Thee I Love” merchandise. The primary claims were brought under the Lanham Act for trademark infringement and unfair competition. Along with damages, plaintiffs requested the court permanently enjoin the defendants from producing or selling any more “infringing” merchandise, and that the court declare that defendants were infringing on the plaintiffs’ federally registered marks.

Collegiate and the Licensees moved to dismiss under Rule 12(b)(1) and (7). They argued that they were merely the University’s agents, and that these claims are premised on a not-yet-fought battle over who “Thee I Love” rightfully (and lawfully) belongs to. Because defendants said they could not adequately fight that battle for the University, they contended that the University was a required party under Rule 19(a)(1)(A) and (B). But because the University enjoys sovereign immunity (and thus cannot be joined), defendants urged that the court should, “in equity and good conscience,” dismiss the case. Plaintiffs responded that Collegiate and the Licensees were merely joint tortfeasors, and that plaintiffs were not required to include *every* joint tortfeasor. Plaintiffs went on to say that

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even if the University was a required party, the district court could proceed without it because these claims would not affect the University’s claimed right to the phrase “Thee I Love” and would not preclude it from claiming that interest.

The district court granted the motions to dismiss under Rule 12(b)(7). The court first held that, under Rule 19(a)(1)(B)(i), the University claimed an interest in the “Thee I Love” phrase, and without the University present, its interests could be practically impaired—especially because of “the ongoing petition process between [the University] and plaintiffs over the trademark.” Because the court could not join the University, the court then considered under Rule 19(b) whether “‘equity and good conscience’ mandate dismissal.” It ultimately concluded that each of Rule 19(b)’s four factors counseled in favor of dismissal and dismissed the case without reaching the Rule 12(b)(1) issue.¹

¹ Dismissing under Rule 12(b)(7) without resolving the Rule 12(b)(1) issue is appropriate. That is because the dismissal was without prejudice. *See Fed. R. Civ. P. 19(b); id. R. 41(b).* And “in an ordinary civil case, all dismissals [without prejudice] are created equal—they all equally prevent the exercise of jurisdiction where there is none.” *Davis v. Sumlin*, 999 F.3d 278, 280 (5th Cir. 2021); *see Mowrer v. DOT*, 14 F.4th 723, 733–43 (D.C. Cir. 2021) (Katsas, J., concurring) (detailing principles of judicial sequencing).

II.

We review a district court’s assessment of whether a party is “required” under Rule 19 for abuse of discretion. *Moss v. Princip*, 913 F.3d 508, 514–15 (5th Cir. 2019). Rule 12(b)(7) allows for dismissal of a suit when the plaintiff fails to join a required party under Rule 19. Fed. R. Civ. P. 12(b)(7). There are three types of “required” parties: (1) parties needed to give complete relief to the existing parties, *id.* R. 19(a)(1)(A); (2) parties who claim interests which could be practically impaired or impeded if not joined, *id.* R. 19(a)(1)(B)(i); and (3) parties necessary to ensure that existing parties are not exposed to multiple or inconsistent obligations, *id.* R. 19(a)(1)(B)(ii). The burden of proof starts with the movants, but if at first glance it appears a “possibly necessary party is absent,” the burden shifts to the nonmovant to dispute that “initial appraisal” of the facts. *Hood ex rel. Mississippi v. City of Memphis*, 570 F.3d 625, 628 (5th Cir. 2009).

If an absent party is “required” under Rule 19(a), but joinder would destroy the court’s jurisdiction (as is the case here), the court has two options: continue without the absent party or dismiss the litigation. *HS Res., Inc. v. Wingate*, 327 F.3d 432, 439 (5th Cir. 2003). Rule 19(b) tells courts to make this decision “in equity and good conscience,” weighing these factors:

- (1) the extent to which a judgment rendered in the person’s absence might prejudice that person or the existing parties;

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- (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.

Fed. R. Civ. P. 19(b)(1)–(4). With no prescribed formula for balancing these factors, the inquiry is “[g]uided by common sense” and is highly case-specific, requiring a “flexible and pragmatic” evaluation of the facts. *Moss*, 913 F.3d at 515, 517.

A.

The first question is whether the University was a required party under Rule 19(a). The district court held that the University has “an interest relating to the subject of the action” which, if the University is not joined, the suit “may as a practical matter impair or impede [its] ability to protect the interest.” We agree.

First, the inquiry at this stage is more about whether the absent party claims a non-frivolous interest, not the ultimate merit of the claim. *See, e.g., Republic of Philippines v. Pimentel*, 553 U.S. 851, 868–69

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(2008); *White v. Univ. of Cal.*, 765 F.3d 1010, 1026–27 (9th Cir. 2014). The University here claims an interest in the mark that is the basis of each of appellants’ claims. Appellants spend much of their briefing arguing that because the University has no interest in the mark, it cannot be a required party. But that begs the question: the very basis of appellants’ claims require that they prove their ownership of the mark, and the University’s consistent usage (and purported state-and common-law rights) reveal the ownership dispute lurking beneath the surface. The ongoing dispute over the federal mark is already underway. Rule 19 allows courts to consider these facts, and the district court was not required to blind itself to the realities of that litigation in reaching its result.

Second, appellants argue that even if the University has an interest in this suit, the University’s absence would not keep it from protecting that interest later on. They make two points along these lines: (1) the University can sue to challenge appellants’ mark in federal court apart from this litigation; and (2) the University would not be precluded from challenging the federal mark if it is not joined here. But Rule 19 is not concerned with preclusive effect as much as it is “practical[]” impairment.² Fed. R. Civ. P. 19(a)(1)(B)(i). Even if the University remains free to challenge

² Even short of preclusive effect, we have previously explored the circumstances under which the *stare decisis* effect of a decision could justify joinder, highlighting the “practical disadvantage” that a previous non-preclusive decision could pose. *See Atlantis Dev. Corp. v. United States*, 379 F.2d 818, 829 (5th Cir. 1967).

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Business Moves's ownership of "Thee I Love" elsewhere, it 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's trademark in other fora. A loss here, in its absence, could put pressure on the University in the short term to abandon or capitulate to appellants, as it could all but halt their use of the mark in commerce. Because ownership of the mark is what this case is ultimately about, Rule 19's interest in "protect[ing] interested parties and avoid[ing] waste of judicial resources" would counsel in favor of the University's inclusion. *Askew v. Sheriff of Cook Cnty., Ill.*, 568 F.3d 632, 634 (7th Cir. 2009) (quotation omitted).

Thus, the district court did not abuse its discretion in concluding that the University was a required party under Rule 19(a)(1)(B)(i). And because everyone agrees that the University enjoys sovereign immunity, the question becomes whether the district court abused its discretion in dismissing the case rather than proceeding without the University.

B.

When a required party cannot be feasibly joined, the district court "must determine whether, in equity and good conscience, the action should proceed among the existing parties or should be dismissed." Fed. R. Civ. P. 19(b). We again agree with the district court's conclusion.

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1.

Predominating our analysis is the fact that the University is an arm of the State of Mississippi. *See Whiting v. Jackson State Univ.*, 616 F.2d 116, 127 n.8 (5th Cir. 1980). It thus enjoys sovereign immunity. *Daniel v. Univ. of Tex. Sw. Med. Ctr.*, 960 F.3d 253, 257 (5th Cir. 2020). That sovereign immunity “does not exist solely in order to ‘preven[t] federal-court judgments that must be paid out of a State’s treasury’; it also serves to avoid the ‘indignity of subjecting a State to the coercive process of judicial tribunals at the instance of private parties.’” *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44, 58 (1996) (first quoting *Hess v. Port Auth. Trans-Hudson Corp.*, 513 U.S. 30, 48 (1994), then quoting *Puerto Rico Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc.*, 506 U.S. 139, 146 (1993)). Because the University cannot enter the scrum without waiving its immunity, its sovereign interest is necessarily impaired when plaintiffs try to use the state’s sovereign immunity to lure it into a lawsuit against its will. *Cf. Gensetix, Inc. v. Bd. of Regents of Univ. of Tex. Sys.*, 966 F.3d 1316, 1322–23 (Fed. Cir. 2020) (a university cannot be made an involuntary plaintiff under Rule 19(a)(2) because of its sovereign immunity).

The Supreme Court in *Republic of Philippines v. Pimentel* said that “where sovereign immunity is asserted, and the claims of the sovereign are not frivolous, dismissal of the action *must be ordered* where there is a potential for injury to the interests of the absent sovereign.” 553 U.S. at 867 (emphasis added). Even before *Pimentel*, other courts of appeals left “very

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little room for balancing of other factors set out in Rule 19(b) where a necessary party under Rule 19(a) is immune from suit because immunity may be viewed as one of those interests compelling by themselves.” *Kickapoo Tribe of Indians v. Babbitt*, 43 F.3d 1491, 1496 (D.C. Cir. 1995) (quotation omitted). And more recently, in an adjacent context, another court recognized the “wall of circuit authority” favoring dismissal of actions “in which a necessary party cannot be joined due to tribal sovereign immunity.” *Dine Citizens Against Ruining Our Env’t v. Bureau of Indian Affs.*, 932 F.3d 843, 857 (9th Cir. 2019) (citing *White*, 765 F.3d at 1028).

The same can be said for state sovereign immunity. As compelled by *Pimentel*, as discussed above, the University has a non-frivolous claim here. As a practical matter, this suit would impair or impede its ability to protect its interest in the “Thee I Love” mark. That is enough to require dismissal of the action because “there is a potential for injury to” the University’s “interests [as] the absent sovereign.” See *Pimentel*, 553 U.S. at 867; see also *Gensetix*, 966 F.3d at 1331–34 (Taranto, J., dissenting in part).³ Under Rule 19(b), in

³ In a thorough dissenting opinion, Judge Taranto explains how *Pimentel* commands that where, as here, a state “sovereign entity is a required party under Rule 19(a), is protected against joinder by sovereign immunity, and makes a non-frivolous assertion that it will be prejudiced by a suit proceeding in its absence, a district court” must dismiss the suit under Rule 19(b). *Gensetix*, 966 F.3d at 1331–34 (Taranto, J., dissenting in part). The majority opinion, by contrast, concluded that the sovereign’s interests in that case were not substantial enough to justify dismissal “in equity and good conscience.” *Id.* at 1324–27. Specifically, the majority determined that the prejudice to the absent state sovereign

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the interest of “equity and good conscience,” the suit should be dismissed.

2.

The outcome is the same when considering the Rule 19(b) factors. The aim is to weigh those factors

was “greatly reduced” because the party had an “identical” (rather than “overlapping”) interest in the property at issue. *Id.* at 1325–27.

We disagree with the *Gensetix* majority opinion’s treatment of the state’s sovereign status as insufficient to justify dismissal for several reasons. First, it differs from several of our sister circuits’ cases pre-and post-*Pimentel*. See, e.g., *Fla. Wildlife Fed’n Inc. v. U.S. Army Corps of Eng’rs*, 859 F.3d 1306, 1317–20 (11th Cir. 2017); *Two Shields v. Wilkinson*, 790 F.3d 791, 798 (8th Cir. 2015); *Gensetix*, 966 F.3d at 1331–34 (Taranto, J., dissenting in part) (collecting cases). Second, *Pimentel* involved *foreign* sovereign immunity while this case and *Gensetix* involved *state* sovereign immunity. This matters because “the States’ sovereign immunity is a historically rooted principle embedded in the text and structure of the Constitution,” while a foreign nation’s sovereign immunity is by “consent or compact” (i.e., not grounded in the Constitution). *Franchise Tax Bd. of Cal. v. Hyatt*, 139 S. Ct. 1485, 1497, 1499 (2019). Third, the *Gensetix* majority opinion’s contention that a state interest is “identical” to a non-governmental party is unpersuasive. For one thing, whether there is identity or not, a court’s “consideration of the merits was itself an infringement on [state] sovereign immunity.” *Pimentel*, 553 U.S. at 864. And if anything, for state sovereign immunity, identity is *worse* because we would *allow indirect* adjudication of the state’s interest, even though state sovereign immunity would *forbid direct* adjudication of that interest. For another, the notion that a state entity’s interest in property is “identical” to a non-government party’s is perplexing, to put it mildly. In any event, as discussed in the next section, we conclude that the University’s interests *here* are substantial enough even under each of the Rule 19(b) factors. See *Gensetix*, 966 F.3d at 1324–27 (evaluating factors).

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“seeking to avoid manifest injustice while taking full cognizance of the practicalities involved.” *Pulitzer-Polster v. Pulitzer*, 784 F.2d 1305, 1312 (5th Cir. 1986). The district court concluded that all four of Rule 19(b)’s factors favored dismissal, and we again agree.

Under the first factor, the district court considered “the extent to which a judgment rendered in [the University’s] absence might prejudice [the University] or the existing parties.” Fed. R. Civ. P. 19(b)(1). On this point, the district court said that both the University and Collegiate would be prejudiced without the University’s involvement. The court pointed to appellants’ own complaint to cast doubt on their contention that this case is only about their federal trademark rights; appellants, for instance, complain about “Thee I Love” vanity plates, even though appellants conceded the University has a trademark on those plates under Mississippi law.

Appellants do not highlight that concession, but instead focus on the fact that Collegiate is well-equipped to defend the University’s interest on its own. Collegiate responds that it is “merely a licensing agent with limited rights” which would struggle to establish the University’s “use [of ‘Thee I Love’] in commerce over some eight decades.” *Cf. Two Shields*, 790 F.3d at 799; *Tell v. Trs. of Dartmouth Coll.*, 145 F.3d 417, 419 (1st Cir. 1998) (“[W]ithout a perfect identity of interests, a court must be very cautious in concluding that a litigant will serve as a proxy for an absent party.”).

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This point, on balance, favors the University. To appellants' credit, there does not seem to be a risk that appellees would take a position *inconsistent* with the University. *See Tell*, 145 F.3d at 419. Foundational to appellants' claims is their ownership of the mark, and appellees and the University both want to disprove that ownership. So if the University was joined, it is unlikely that Collegiate or the Licensees would take a different position on who owns the mark. On the other hand, the battle over ownership of the mark is the University's, and as the commercial agents for the University's use of that mark, neither Collegiate nor the Licensees have the same personal stake in that battle as the University.

Many of the arguments center on whether the University and appellees have non-identical interests. Two Federal Circuit cases are instructive. *Gensetix*, 966 F.3d 1316; *A123 Sys., Inc. v. Hydro-Quebec*, 626 F.3d 1213 (Fed. Cir. 2010). The court in *Gensetix* held that a patent licensee could proceed without the patent owner (the University of Texas) because the owner had given the licensee a license "in every field," and thus the interests of the owner and licensee were "identical." 966 F.3d at 1326. The court in *A123*, by contrast, held that a patent owner was a required party when the owner gave only a "field-of-use license" to the licensee, so their interests were "overlapping" but not "identical." 626 F.3d at 1221. Here, the University has an agreement with Collegiate to be its exclusive agent for licensing out the University's "indicia" "in connection with the marketing of various articles of merchandise

and to conduct certain [p]romotions.” Collegiate has no interest in the ownership of the mark, and the University maintains sole discretion to grant licensees access to the mark. It is unclear at this stage whether the University could use this mark for any reason other than merchandise, but it at least maintains sole rights to use of the mark itself. Like the owner/licensee relationship in *A123*, the University and Collegiate have “overlapping” but not “identical” interests in ownership of the mark, which counsels in favor of dismissal. *See id.*

The district court next considered the second factor: “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.” Fed. R. Civ. P. 19(b)(2). The district court noted that the University’s interest in this suit was “implicated not only by potential judgment or the form of relief, but by the necessary inquiry into ownership of the trademark itself.” Appellants provide only a brief retort, that this factor “isn’t useful with a sovereign nonparty” and that the University is “protected from liability” by their agency agreement with Collegiate. The indemnity provision, however, does not have much to do with the University’s continued interest in owning the rights to “Thee I Love,” so this factor also weighs in the University’s favor.

The third factor concerns “whether a judgment rendered in the [University’s] absence would be adequate.” Fed. R. Civ. P. 19(b)(3). Appellants again urge that a judgment would be adequate because appellees

are mere joint tortfeasors with the University, and appellees again respond that it does not fully share the University's interests. As with the other discussions of the differing interests, the district court concluded that the University and appellees did not have the same interests in the phrase "Thee I Love." The defendant in *Gensetix* had a patent "in every field," and thus its interests were "identical" to the absent party. 966 F.3d at 1326. The defendant in *A123*, on the other hand, had only a "field-of-use license," so its interests were "overlapping" but not "identical" to those of the absent party. 626 F.3d at 1221. The district court likened this case to *A123* and distinguished it from *Gensetix*, concluding it could not "presume the licensees fully stand in [the University's] shoes." That comparison is sound: The University still retains interests in "Thee I Love" and retains control over which companies receive its licenses. With that said, appellants' joint-tortfeasor point has purchase here: there is not any evidence that appellees cannot carry out the specific relief requested, or that the University's joinder would somehow enhance their ability to do so. On balance, it was not an abuse of discretion to disregard that fact, but this factor is at least more neutral than the others.

The final factor is about "whether the plaintiff[s] would have an adequate remedy if the action were dismissed for nonjoinder." Fed. R. Civ. P. 19(b)(4). Appellants on this point focus on the futility of requiring it to take this dispute elsewhere. As the district court noted, the basis of this dispute is which party "Thee I Love" belongs to. Though the parties dispute whether

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appellants could bring these claims in state court, the proper forum for determining the proper 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 weighs in favor of dismissal.

Thus, even setting aside the University's sovereign status, the balance of the Rule 19(b) factors weigh in favor of dismissal. As a result, the district court did not abuse its discretion in dismissing the case.

* * *

Because the University is a required party under Rule 19(a) and the suit was properly dismissed under Rule 19(b), we AFFIRM.

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF LOUISIANA**

PAIGE LEE, ET AL. **CIVIL ACTION**
VERSUS **No. 20-839**
LEARFIELD COMMUNICA- **SECTION I**
TIONS, LLC, ET AL.

JUDGMENT

(Filed Nov. 17, 2020)

Considering the record, the Court's Orders of September 15, 2020,¹ September 28, 2020,² and November 16, 2020, and the law, for the reasons assigned,

IT IS ORDERED that the claims of plaintiffs Paige Lee, Business Moves Consulting, Inc., Brandmixer, Inc., and Curtis Bordenave (collectively, "plaintiffs") against defendants Thaddeus Reed, Collegiate Licensing Co.,³ LLC, Defron Fobb, and Anthony Lawrence Collection, LLC (collectively, "defendants") are **DISMISSED WITHOUT PREJUDICE** pursuant to Rule 12(b)(7) of the Federal Rules of Civil Procedure and that final judgment is entered in favor of defendants.

IT IS FURTHER ORDERED that all claims asserted by plaintiffs against defendant MyPlates, Inc.

¹ R. Doc. No. 44.

² R. Doc. No. 46.

³ Collegiate Licensing Co. was incorrectly identified in the complaint as Learfield Communications, LLC. *See* R. Doc. No. 1.

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are **DISMISSED WITHOUT PREJUDICE** pursuant to Rule 4(m) of the Federal Rules of Civil Procedure.

New Orleans, Louisiana, November 17, 2020.

/s/ Lance M. Africk
LANCE M. AFRICK
UNITED STATES
DISTRICT JUDGE

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF LOUISIANA

PAIGE LEE, ET AL. CIVIL ACTION
VERSUS No. 20-839
LEARFIELD COMMUNICA- SECTION I
TIONS, LLC, ET AL.

ORDER & REASONS

(Filed Nov. 17, 2020)

Before the Court is a motion¹ filed by defendants Defron Fobb (“Fobb”) and Anthony Lawrence Collection, LLC (“Collection”) (collectively, “defendants”) for dismissal of the claims filed by plaintiffs Paige Lee, Business Moves Consulting, Inc. (“Business Moves”), Brandmixer, Inc. (“Brandmixer”), and Curtis Bordenave (“Bordenave” and collectively, “plaintiffs”), pursuant to Rules 12(b)(1) and 12(b)(7) of the Federal Rules of Civil Procedure. Plaintiffs oppose² the motion. For the following reasons, the motion is granted pursuant to Rule 12(b)(7) of the Federal Rules of Civil Procedure.

¹ R. Doc. No. 45.

² R. Doc. No. 47.

I.

The Court is familiar with the facts of the case,³ which center on plaintiffs' allegations that defendants are infringing on plaintiffs' rights to the name and registered trademark, "THEEILOVE[.]"⁴ Previously, the Court granted two motions to dismiss, finding that "after reviewing each of the Rule 19(b) factors, in 'equity and good conscience,' the case cannot proceed absent [Jackson State University ("JSU")]. Therefore, the Court finds JSU to be a required party to this lawsuit. Because JSU['s] joinder would divest this Court of subject matter jurisdiction, plaintiffs' claims against defendants must be dismissed pursuant to Rule 12(b)(7)."⁵

In the instant motion to dismiss, defendants reference the Court's reasoning in that previous Order and incorporate the arguments advanced by the defendants who filed the previously successful motions to dismiss.⁶ In opposition to the instant motion to dismiss,

³ See R. Doc. No. 44, at 1-6 (Order and Reasons describing the facts of the case).

⁴ See R. Doc. No. 1.

⁵ R. Doc. No. 44, at 18.

⁶ R. Doc. No. 45-1, at 1 (stating that "Defendants move to dismiss Plaintiffs' claims for the same reasons stated by the Court in its order dated September 25, 2020 (Rec. Doc. 44) and asserted in the motion to dismiss (Rec. Doc. 14) filed by Defendant, Collegiate Licensing Company, L.L.C. ("CLC") (incorrectly identified in the Complaint (Rec. Doc. 1) as Learfield Communications, LLC), pursuant to Federal Rules of Civil Procedure 12 (b)(1) and 12(b)(7)."); *id.* at 2 ("Defron Fobb and Anthony Lawrence Collection, LLC adopt the memorandum and supporting documents

defendants similarly reference the prior motion practice, and they “incorporate by reference” their previously unsuccessful filings.⁷

Having already considered the substance of the motions that have been incorporated by the parties, for the same reasons stated in the previous Order, the Court finds the instant motion to dismiss must also be granted.

II.

Accordingly,

IT IS ORDERED that, pursuant to Rule 12(b)(7) of the Federal Rules of Civil Procedure, Fobb and Collection’s motion to dismiss is **GRANTED** and that the claims against Fobb and Collection in the above-captioned case are **DISMISSED WITHOUT PREJUDICE**.

New Orleans, Louisiana, November 17, 2020.

/s/ Lance M. Africk

LANCE M. AFRICK
UNITED STATES
DISTRICT JUDGE

that CLC filed in support of its Motion to Dismiss, as if copied herein *in extenso*.”).

⁷ R. Doc. No. 47 (stating, in full: “To oppose Defendants’ Motion to Dismiss [R. Doc. 45] and all associated filings, all plaintiffs incorporate by reference Plaintiffs’ *Omnibus Memorandum in Opposition to Motion(s) [sic] to Dismiss* and all associated filings [R. Doc. 31 - R. Doc. 31-4]”).

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF LOUISIANA

PAIGE LEE, ET AL. **CIVIL ACTION**
VERSUS **No. 20-839**
LEARFIELD COMMUNICA- **SECTION I**
TIONS, LLC, ET AL.

ORDER & REASONS

(Filed Sep. 15, 2020)

Before the Court are two motions to dismiss—the first¹ filed by defendant Collegiate Licensing Company, LLC (“Collegiate”), and the second motion² filed by defendant Thaddeus Reed (“Reed”) (collectively, “defendants”). Both motions move for dismissal of plaintiffs’ Paige Lee, Business Moves Consulting, Inc. (“Business Moves”), Brandmixer, Inc. (“Brandmixer”), and Curtis Bordenave (“Bordenave” and collectively, “plaintiffs”) claims, pursuant to Rules 12(b)(1) and 12(b)(7) of the Federal Rules of Civil Procedure. Plaintiffs oppose³ the motion. For the following reasons, the motions are granted.

¹ R. Doc. No. 14. Collegiate was incorrectly identified in the complaint as Learfield Communications, LLC. See R. Doc. No. 1.

² R. Doc. No. 16.

³ R. Doc. No. 31.

I.

Plaintiffs allege that defendants are infringing on plaintiffs' rights to the name and registered trademark, "THEEILOVE,"⁴ which was approved by the USPTO on June 19, 2018.⁵ Plaintiffs state that, in violation of this trademark, defendants "advertised, marketed, sold and/or distributed merchandise, and/or participated in the advertising, marketing, sale and/or distribution of merchandise," that, according to plaintiffs, not only "improperly" bore the name and mark, "THEEILOVE," but also "improperly and deceptively" bore the ® designation.⁶ Consequently, plaintiffs asserted seven claims against defendants: (1) federal trademark infringement pursuant to 15 U.S.C. § 1114(1);⁷ (2) federal unfair competition pursuant to 15 U.S.C. § 1125(a);⁸ (3) unfair competition pursuant to unspecified state laws of Louisiana, Texas, Mississippi,

⁴ R. Doc. No. 1. Plaintiffs state that on November 2, 2017, Business Moves filed an application bearing serial number 876702210 for the word mark "THEEILOVE" with the United States Patent and Trademark Office ("USPTO"), bearing registration number 5496751. Plaintiffs claim that as a result, they possess a complete, perfected and approved federal registration in the word mark. R. Doc. No. 1, at 6 ¶ 23. Plaintiffs also state that on November 26, 2019, Business Moves and Brandmixer filed an application, which is currently pending and has a serial number of 88707020, for the "THEEILOVE" word mark for various other goods and services. R. Doc. No. 1, at 7.

⁵ R. Doc. No. 1, at 1 ¶ 2; *see also* R. Doc. No. 5.

⁶ R. Doc. No. 1, at 7 ¶ 4, ¶ 25.

⁷ *Id.* at 9 ¶¶ 33–38.

⁸ *Id.* at 10 ¶¶ 39–46.

Tennessee, and Georgia;⁹ (4) violation of unspecified deceptive and unfair trade practices acts and false advertising laws of those same states;¹⁰ (5) commercial defamation;¹¹ (6) conspiracy, pursuant to unspecified state and federal laws;¹² and (7) a claim for judgment of non-infringement.¹³

Defendants cast this lawsuit as being “about who owns the trademark rights to ‘Thee I Love.’”¹⁴ Defendants assert that the phrase has been the alma mater for Jackson State University (“JSU”), which is not a party to the case.¹⁵ Defendants state that through JSU’s use of “THEE I LOVE” since the 1940s,¹⁶ the university has obtained common law trademark rights, pursuant to the Lanham Act, 15 U.S.C. § 1125, and Mississippi law,¹⁷ as well as registered trademark

⁹ *Id.* at 12 ¶¶ 47–52.

¹⁰ *Id.* at 12 ¶¶ 53–59.

¹¹ *Id.* at 13 ¶¶ 60–64.

¹² *Id.* at ¶¶ 65–66.

¹³ *Id.* at 14 ¶¶ 66–68.

¹⁴ R. Doc. No. 14-1, at 7. Reed’s motion adopts Collegiate’s memorandum and supporting documents. *See* R. Doc. No. 16-1, at 2.

¹⁵ *See* R. Doc. No. 1 (naming defendants and not naming JSU).

¹⁶ R. Doc. No. 14-1, at 7. The phrase, according to defendants, is also incorporated into JSU’s fight song. *Id.* *See also* R. Doc. No. 14-3, at 2–3 ¶¶ 7–12 (declaration of Kamesha Hill).

¹⁷ *See id.* at 8 n.5 (citing Miss. Code Ann. § 75-25-31, which states: “Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.”).

rights, pursuant to Mississippi state law.¹⁸ In connection with the federal trademark that plaintiffs seek to defend through this lawsuit, defendants state that “JSU is in the process of petitioning to cancel plaintiffs’ U.S. Registration for THEEILOVE! (& design)” and that “[i]n due course, JSU plans to oppose the registration of the pending application for THEE I LOVE, U.S. Ser. No. 88/707,020 if and when a notice of allowance is issued and defend its various pending applications for THEE I LOVE[.]”¹⁹

Plaintiffs acknowledge that “JSU does own two Mississippi trademarks[]”—one for use “on license plates and in its alma mater[,]” and the other for use on t-shirts.²⁰ However, plaintiffs maintain that, in the instant matter, “there’s no assault on any marks JSU claims to own.”²¹

Defendants further assert that their connection to the phrase “THEE I LOVE” is through JSU.²² Specifically, Collegiate states that it has a contract with JSU to act as an agent for the university in granting

¹⁸ *Id.* at 8. *See also* R. Doc. No. 37, at 3 n.3 (“[JSU] has filed a number of trademark applications for one or more formative versions of THEE I LOVE, including THEE I LOVE, Mississippi Trademark Registration No. 15767, registered 9/22/2015; Thee I Love, Mississippi Registration No. 15580, registered 11/14/2019; HAIL HAIL TO THEE, U.S. Reg. No. 6,050,006; THEE I LOVE! (and design), U.S. Ser. No. 88/730,067 (application pending), and THEE I LOVE, U.S. Ser. No. 88/728,596 (application pending).”).

¹⁹ R. Doc. No. 14-1, at 15.

²⁰ R. Doc. No. 31, at 8 (citations omitted).

²¹ *Id.* at 2.

²² R. Doc. No. 14-1, at 2.

licenses for various designs, trademarks, and service marks, including the trademark “Thee I Love.”²³ Collegiate argues that, because it “does not even select JSU’s licensees and does not itself own the mark,” it “has less than all substantial rights” in the relevant designs, trademarks, and service marks.²⁴ Reed, similarly is, according to the complaint, a “licensed vendor of Jackson State University,”²⁵ and it assumes Collegiate’s arguments on this point.

Accordingly, defendants argue that JSU’s absence from this lawsuit and inability to be joined requires that the case be dismissed.²⁶ Specifically, defendants argue that plaintiffs failed to name JSU as a defendant; that “as owner of the trademark [plaintiffs] claim to own, [JSU] is an indispensable party to the litigation[;]²⁷ and that, because JSU—“an arm of the State

²³ R. Doc. No. 37, at 4. Specifically, Collegiate avers that it “is neither a licensor with complete rights (akin to an assignment of the owner’s rights) to the mark nor is it a licensee (with rights of use) of the mark. JSU granted [Collegiate] the exclusive right to act as an **agent** for JSU in the **granting of licenses** to licensees to use JSU’s Indicia on merchandise. In other words, [Collegiate] merely assists JSU in its decision of who may license the trademark. [Collegiate] does not even select JSU’s licensees and does not itself own the mark – *i.e.*, it has **less than all substantial rights** in the Indicia.” *Id.* (emphasis in original).

²⁴ *Id.*

²⁵ R. Doc. No. 1, at 4 ¶ 14.

²⁶ R. Doc. No. 14, at 1–2.

²⁷ *Id.* at 1. The Court notes that Rule 19 “no longer uses the terms ‘indispensable’ or ‘necessary party[;’] the ‘more modern term is ‘required party.’” *Gensetix, Inc. v. Bd. of Regents of Univ. of Texas Sys.*, 966 F.3d 1316, 1320 (Fed. Cir. 2020) (observing that “[t]hese changes were intended to be stylistic only”); *see also* Fed.

of Mississippi”—“enjoys sovereign immunity under the Eleventh Amendment” and so cannot be joined without stripping the Court of subject matter jurisdiction, the claims against Collegiate and Reed “fail as a matter of law” and must be dismissed.²⁸

Additionally, defendants claim that plaintiffs Bordenave and Business Moves are “trademark pirates,”²⁹ stating that this “assault upon JSU’s trademark is but the latest example of a long-running pattern of abusive conduct, whereby Mr. Bordenave seeks to register trademarks to which he has no prior connection in the hope of converting or holding for ransom goodwill created through the efforts, traditions, and creativity of others.”³⁰

R. Civ. P. 19 advisory committee’s note to 2007 amendment; *Republic of the Phil. v. Pimentel*, 553 U.S. 851, 855–56, 863 (2008) (“though the text has changed, the new Rule 19 has the same design”). The Court will use this “modern” terminology.

²⁸ *Id.* at 1–2; R. Doc. No. 16-1, at 1–2.

²⁹ See R. Doc. No. 14-1, at 15–18. Specifically, defendants allege that these plaintiffs “have long standing reputations of being trademark pirates whose main business is appropriating and exploiting well-known brands and applying for trademark registrations that they have no connection to whatsoever, as is the case with “THEEILOVE.” *Id.* at 15. Defendants cite as an example *Jazzland, Inc. v. Bordenave*, No. 98-1356 1999 WL 243820 (E.D. La. Apr. 22, 1999) (Africk, Magistrate J.). R. Doc. No. 14-1, at 9–10. Plaintiffs counter that Collegiate possesses a reputation as a “bully.” R. Doc. No. 31, at 10. The Court notes, but will not consider, these allegations in resolving the instant motions; “reputations” do not necessarily reflect truth, nor do these other matters have direct bearing on the instant motions before the Court.

³⁰ R. Doc. No. 14-1, at 9.

The Court will first address whether JSU must be joined to this litigation pursuant to Rule 12(b)(7). If JSU must be joined, pursuant to Rule 19(a), the Court will then determine whether sovereign immunity interferes with joinder. If sovereign immunity does interfere with joinder, the Court will decide whether the case can nevertheless proceed absent JSU, pursuant to Rule 19(b), or whether, because that required party must be joined, pursuant to Rule 12(b)(7), the Court lacks subject matter jurisdiction, pursuant to Rule 12(b)(1).

II.

A. Rule 12(b)(1)

Federal Rule of Civil Procedure 12(b)(1) requires dismissal of an action if a court lacks jurisdiction over the subject matter of the plaintiff's claim. F. R. Civ. P. 12(b)(1). A case is properly dismissed pursuant to Rule 12(b)(1) "for lack of subject-matter jurisdiction when the court lacks the statutory or constitutional power to adjudicate the case." *Krim v. pcOrder.com, Inc.*, 402 F.3d 489, 494 (5th Cir. 2005) (citing *Home Builders Ass'n of Miss., Inc. v. City of Madison*, 143 F.3d 1006, 1010 (5th Cir. 1998)).

Rule 12(b)(1) allows a party to challenge a court's subject matter jurisdiction based upon the allegations on the face of the complaint. *See Barrera-Montenegro v. United States*, 74 F.3d 657, 659 (5th Cir. 1996); *see also Lopez v. City of Dallas*, No. 03-2223, 2006 WL 1450520, at *2 (N.D. Tex. May 24, 2006). "The burden

of proof for a Rule 12(b)(1) motion to dismiss is on the party asserting jurisdiction.” *Ramming v. United States*, 281 F.3d 158, 161 (5th Cir. 2001).

When applying Rule 12(b)(1), a court may dismiss an action for lack of subject matter jurisdiction “on any one of three separate bases: (1) the complaint alone; (2) the complaint supplemented by undisputed facts evidenced in the record; or (3) the complaint supplemented by undisputed facts plus the court’s resolution of disputed facts.” *Spotts v. United States*, 613 F.3d 559, 565–66 (5th Cir. 2010); *see also Den Norske Stats Oljeselskap As v. HeereMac Vof*, 241 F.3d 420, 424 (5th Cir. 2001); *Barrera-Montenegro*, 74 F.3d at 659. When examining a factual challenge to subject matter jurisdiction that does not implicate the merits of plaintiff’s cause of action, a district court has substantial authority “to weigh the evidence and satisfy itself as to the existence of its power to hear the case.” *Arena v. Graybar Elec. Co.*, 669 F.3d 214, 223 (5th Cir. 2012); *see also Berry v. NLRB*, No. 15-6490, 2016 WL 1571994, at *2 (E.D. La. Apr. 19, 2016) (Morgan, J.) (“The standard of Rule 12(b)(1), ‘while similar to the standard of Rule 12(b)(6), permits the court to consider a broader range of materials in resolving the motion.’”) (citation omitted).

The party asserting jurisdiction carries the burden of proof when facing a Rule 12(b)(1) motion to dismiss. *Randall D. Wolcott, M.D., P.A. v. Sebelius*, 635 F.3d 757, 762 (5th Cir. 2011) (citing *Ramming*, 281 F.3d at 161); *see also Hozenthal v. Balboa Ins. Co.*, No. 07-4644, 2008 WL 11357735, at *2 (E.D. La. July 15, 2008)

(Africk, J.) (quoting *Paterson v. Weinberger*, 644 F.2d 521, 523 (5th Cir. 1981)).

Matter outside the complaint forms the basis of the instant motions to dismiss for lack of subject matter jurisdiction. Accordingly, the Court will look outside the four-corners of the complaint to assure itself of its power to hear the case.

B. Rule 12(b)(7)

Rule 12(b)(7) of the Federal Rules of Civil Procedure provides for the dismissal of claims when a plaintiff fails to join a required party to the lawsuit pursuant to Rule 19 of the Federal Rules of Civil Procedure. To determine whether to dismiss an action for failure to join a required party, a court must first determine, pursuant to Rule 19(a), whether a party must be joined. Rule 19(a) provides that a party must be joined where:

- (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.

F. R. Civ. P. 19(a).

The initial burden of proof for the party advocating joinder only requires a showing of “the possibility that an unjoined party is arguably indispensable,” *Boles v. Greeneville Hous. Auth.*, 468 F.2d 476, 478 (6th Cir. 1972), and when “an initial appraisal of the facts indicates that a possibly necessary party is absent, the burden of disputing this initial appraisal falls on the party who opposes joinder.” *See Pulitzer-Polster v. Pulitzer*, 784 F.2d 1305, 1309 (5th Cir. 1986) (citing *Boles*, 468 F.2d at 478).

If Rule 19(a) calls for joinder, then a court must next determine whether “in equity and good conscience,” F. R. Civ. P. 19(b), the lawsuit can proceed without the party, or whether the party is required. *See Pulitzer*, 784 F.2d at 1309 (“if joinder is called for, then Rule 19(b) guides the court in deciding whether the suit should be dismissed if that person cannot be joined.”). Rule 19(b) directs that a court should “consider” in its analysis:

- (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.

F. R. Civ. P. 19(b). No single factor is dispositive. *See Gensetix*, 966 F.3d at 1326 (finding that “the district court abused its discretion in giving overwhelming weight to UT’s sovereign status to the exclusion of all other facts”). Resolving whether a party is required is a practical inquiry, with an emphasis on pragmatism, whereby the various harms that the parties and the absentees might suffer are considered. *Id.*; *see also Shell W. E & P Inc. v. Dupont*, 152 F.R.D. 82, 85 (M.D. La. 1993) (citing *Bethell v. Peace*, 441 F.2d 495, 496 (5th Cir. 1971)).

Where Rule 19(b) requires dismissal, a court must dismiss the case pursuant to Rule 12(b)(7).

III.

Defendants state that “JSU, as an owner of the trademark which [plaintiffs] claim to own, is an indispensable party to this litigation.”³¹ Defendants argue that JSU is an “indispensable party” to the case because it holds common law and Mississippi state trademarks for the phrase at issue,³² and because “[i]t is fairly obvious that where the owner is left without the

³¹ R. Doc. No. 16-1, at 1–2.

³² R. Doc. No. 14-1, at 8.

opportunity to defend its ownership, it could experience a loss of rights[.]”³³ See *St. James v. New Prague Area Cnty. Ctr.*, No. 06-1472, 2006 WL 2069197, at *2 (D. Minn. July 26, 2006) (noting that it is “well established, in suits for . . . trademark infringement, that the owner of the . . . trademark is subject to compulsory joinder”) (citations omitted).

Plaintiffs counter that JSU need not be a party because “potential defendant-licensors aren’t Rule 19(a) ‘required parties’ and . . . trademark infringement plaintiffs can sue or not sue infringers (joint tortfeasors, legally) as they see fit.”³⁴ Plaintiffs conclude that “forcing infringement plaintiffs to sue every possible infringer cannot be the purpose of Rule 19(a).”³⁵ For support, plaintiffs cite a legal treatise stating that “there is very little authority regarding who must be joined in trademark-infringement suits.”³⁶

In response, defendants note that the “tort law maxim” that defendants who are jointly and severally liable may be joined “at plaintiff’s discretion” would indicate that plaintiffs need not join “all infringers” to a tort lawsuit. However, according to defendants, that general rule fails to consider “particular distinctions

³³ R. Doc. No. 37, at 7.

³⁴ R. Doc. No. 31, at 23.

³⁵ *Id.* at 13–14.

³⁶ *Id.* at 9 (quoting Mary Kay Kane, 7 Fed. Prac. & Pro. Civ. § 1614 (3d ed. April 2020 update)). Plaintiffs also assert that the cases defendants cite for the proposition that JSU must be joined are “inapposite” because they concern trademarks lawsuits in different postures. R. Doc. No. 31, at 1.

among ‘infringers,’ such as a trademark *owner* and trademark *licensee*,” a relevant distinction between defendants and JSU.³⁷ It would be inappropriate to treat all alleged “infringers” alike, according to defendants, when not all alleged infringers have the same interests. “[T]he owner, if not joined, is likely to experience significant impairment to its interests.”³⁸ Defendants argue that, while plaintiffs may select their choice of parties, Rule 19 “requires a balancing of the plaintiffs’ prerogative in choosing who to sue and the necessity of joining a party the plaintiff *failed* to sue in a particular case.”³⁹

The Court agrees with defendants that, pursuant to Rule 19(a), JSU must be joined. Defendants are correct that JSU’s possession of “an interest relating to the subject of the action may as a practical matter impair or impede the person’s ability to protect the interest.” F. R. Civ. P. 19(a)(1)(B)(i). JSU claims a trademark owner’s interest in the phrase “Thee I Love,” and engaging the merits of plaintiffs’ complaint absent JSU’s participation in the case would, as a practical matter, hinder JSU’s ability to protect its interest. This is

³⁷ R. Doc. No. 37, at 4–6 (emphasis in original).

³⁸ *Id.* at 5. *See also id.* (noting that defendants’ “position would not ultimately force Plaintiffs to sue every *infringer*, but only to include a single party – the trademark *owner* – and for good reason.”).

³⁹ *Id.* (citing *Lisseveld v. Marcus*, No. 96-336, 1997 WL 366053, 693 (M.D. Fla. 1997), *aff’d sub nom. Enviro Response v. Marcus*, 268 F.3d 1066 (11th Cir. 2001)).

particularly true in light of the ongoing petition process between JSU and plaintiffs over the trademark.⁴⁰

Therefore, the Court will evaluate whether sovereign immunity bars joinder, and, if so, whether the case can proceed in JSU's absence pursuant to Rule 19(b) or, whether instead, the case must be dismissed, pursuant to Rule 12(b)(7) and/or Rule 12(b)(1).

III.

"The Eleventh Amendment bars citizens of a state from suing their own state or another state in federal court unless the state has waived its sovereign immunity or Congress has expressly abrogated it." *Raj v. Louisiana State Univ.*, 714 F.3d 322, 328 (5th Cir. 2013) (internal citations omitted). "[E]leventh amendment immunity is a jurisdictional issue that cannot be ignored, for a meritorious claim to that immunity deprives the court of subject matter jurisdiction of the action." *Jefferson v. Louisiana State Supreme Court*, 46 F.App'x 732, 732 (5th Cir. 2002).⁴¹ See also *Arce v. Louisiana*, No. 16-14003, 2017 WL 5619376, at *4 (E.D. La. Nov. 21, 2017) (Africk, J.) ("Sovereign immunity operates as 'a constitutional limitation on the federal

⁴⁰ R. Doc. No. 14-1, at 14-15.

⁴¹ The exceptions to sovereign immunity are inapposite, as immunity has not been waived, nor has the immunity been undermined by abrogation or consent. See *Hughes v. Johnson*, No. 15-7165, 2016 WL 6124211, at *4 (E.D. La. Oct. 20, 2016) (Vance, J.).

judicial power.’”) (quoting *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 98 (1984)).

Rule 19(a) demands that JSU be joined; but sovereign immunity precludes joinder.⁴² JSU, as an arm of the State of Mississippi, enjoys the benefits of Mississippi’s Eleventh Amendment protection. *See Whiting v. Jackson State University*, 616 F.2d 116, 127 n.8 (5th Cir. 1980) (finding that “JSU is an agency of the state because it is a state-created political body, Miss. Code Ann. § 37-125-1 (Cum. Supp. 1979), and receives state funding.”). JSU cannot be joined without depriving of the Court of subject matter jurisdiction. Therefore, the Court must determine whether this lawsuit may nevertheless proceed, absent JSU.

IV.

The question becomes whether, pursuant to Rule 19(b), the Court may proceed without joining JSU or whether “equity and good conscience” mandate dismissal. F. R. Civ. P. 19(b).

Plaintiffs claim that JSU need not be a party to this lawsuit because its absence based on sovereign immunity “won’t prevent [Collegiate] from representing

⁴² Plaintiffs argue that the motions to dismiss “can’t be analyzed under Rule 12(b)(1) because federal subject matter jurisdiction isn’t affected by the Eleventh Amendment,” R. Doc. No. 31, at 7, claiming that “the discretion courts exercise when the Eleventh Amendment intersects with Rule 19 means the Constitutional limitations at play are prudential; they’re not jurisdictional.” *Id.* at 8. Plaintiff’s contention is incorrect. *See Jefferson*, 46 F.App’x. at 732.

its interests[.]”⁴³ In support of this argument, plaintiffs rely on *Gensetix*, which plaintiffs state counsels that the named defendants in this case could “adequately represent” JSU’s interest.⁴⁴ Plaintiffs also argue that “sovereign immunity alone isn’t a compelling enough Rule 19(b) reason to dismiss a case where a licensee can adequately defend the licensor’s interests.”⁴⁵ Moreover, plaintiffs argue that “a judgment rendered in [JSU’s] absence would be adequate” because “JSU faces no invalidation of the questionable “trademarks” it “licensed” to [Collegiate]”; the claim is based on “plaintiffs registered and pending federal marks,” not any that may belong to JSU; and “there’s no evidence that JSU can or would defend where [Collegiate] cannot.”⁴⁶ Plaintiffs explain that Collegiate “is being sued because it infringed on the plaintiffs’ marks – whether JSU continues to use its marks is not the point of the suit.”⁴⁷

Defendants counter that *Gensetix* is distinguishable and that defendants cannot adequately represent JSU’s interest because “the interests are not coextensive.” As such, defendants argue that JSU’s interests would not be adequately represented by defendants.⁴⁸ Defendants reason that Collegiate “does *not* have

⁴³ R. Doc. No. 31, at 2.

⁴⁴ *Id.* at 1–2.

⁴⁵ *Id.* at 23.

⁴⁶ *Id.* at 22 (emphasis in original).

⁴⁷ *Id.* at 12.

⁴⁸ *Id.*

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‘substantially all interests’ of the owner” and, therefore, “the licensee does not adequately represent the absent owner’s interests.”⁴⁹ Additionally, defendants argue that, for practical reasons, “[t]he absence of JSU . . . impairs” the defendants’ ability to defend themselves, as such a defense would require “proof of use in commerce among other particular facts and information belonging to JSU,” and that defendants have “no way of even trying to present on behalf of JSU without JSU’s presence to defend itself.”⁵⁰

In the Fifth Circuit, “[d]etermining whether [a lawsuit should be dismissed in the absence of a required party] is a highly-practical, fact-based endeavor.” *Gensetix*, 966 F.3d at 1324 (citing *Hood v. City of Memphis*, 570 F.3d 625, 628 (5th Cir. 2009)). In *Gensetix*, the Federal Circuit permitted a patent challenge to proceed under Rule 19(b) without sovereign patent owner University of Texas, reasoning that the patent licensees’ interests were sufficiently aligned with the patent owners’ to be able to adequately represent its interest. *Id.*

The Court concludes that all four Rule 19(b) factors favor finding JSU to be a required party. As to the first factor, “the extent to which a judgment rendered in the person’s absence might prejudice that person or the existing parties,” F. R. Civ. P. 19(b)(1), the Court finds that both JSU and Collegiate would be prejudiced by JSU’s absence. Though plaintiffs insist that the case

⁴⁹ R. Doc. No. 37, at 6.

⁵⁰ *Id.*

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is about their federal trademark, not about JSU’s state or alleged common law trademark to Thee I Love, those marks are not so clearly distinguished. For example, in their complaint, plaintiffs explicitly complain about the “sale, distribution and dissemination of license plates, attached to vehicles which move throughout the country, including Louisiana . . .” that bear the phrase “Thee I Love.”⁵¹ But JSU owns a Mississippi trademark for use of the phrase “Thee I Love” on license plates, as plaintiffs ultimately conceded in their opposition to the motions to dismiss.⁵² As evidenced by this assertion in the complaint itself, JSU’s interests as owner are implicated by this lawsuit, and JSU would be prejudiced if absent from it.

The second factor, “the extent to which any prejudice could be lessened or avoided by” either “protective provisions in the judgment; shaping the relief; or other measures,” also tilts toward finding JSU to be a required party. JSU’s interest in the lawsuit is implicated not only by potential judgment or the form of relief, but by the necessary inquiry into ownership of the trademark itself.

The third factor, “whether a judgment rendered in the person’s absence would be adequate,” favors including JSU. The Court is persuaded by the distinctions that defendants identify between *Gensetix* and the instant case. Unlike in *Gensetix*, the interests between JSU and its licensees are not “identical[,]” *see*

⁵¹ R. Doc. No. 1, at 5.

⁵² R. Doc. No. 31, at 8 (citing R. Doc. 14-3, at 59–60).

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966 F.3d at 1326; the Court cannot presume the licensees fully stand in JSU’s shoes.⁵³ *See A123 Sys., Inc. v. Hydro-Quebec*, 626 F.3d 1213, 1216 (Fed. Cir. 2010) (affirming the district court’s finding that, in a patent infringement case, where the patent owner had “grant[ed] only a field-of-use license,” the patent owner “had transferred less than all substantial rights in the patents in suit to [licensee], thereby making [the patent owner] a necessary party” to the lawsuit).

Finally, the fourth factor, “whether the plaintiff would have an adequate remedy if the action were dismissed for nonjoinder,” also favors including JSU. Unlike in *Gensetix*, where plaintiff was “without recourse to assert its patent rights because UT cannot be feasibly joined[,]” 966 F.3d at 1326, plaintiffs in the instant case would not be fully without recourse if the instant case were dismissed. Rather, as defendants suggest, plaintiffs could challenge “JSU’s applications for THEE I LOVE at the United States Patent and Trademark Office.”⁵⁴

The Court concludes that after reviewing each of the Rule 19(b) factors, in “equity and good conscience,” the case cannot proceed absent JSU. Therefore, the Court finds JSU to be a required party to this lawsuit.

Because JSU is a required party who must be joined, but whose joinder would divest this Court of subject matter jurisdiction, plaintiffs’ claims against

⁵³ *See* R. Doc. No 37, at 6.

⁵⁴ R. Doc. No. 14-1, at 27.

defendants must be dismissed pursuant to Rule 12(b)(7).

The Court declines to reach the Rule 12(b)(1) analysis, as the inquiry pursuant to Rule 12(b)(7) fully resolves the motions before the Court. *See Sinochem Int'l Co. v. Malaysia Int'l Shipping Corp.*, 549 U.S. 422, 431 (2007) (noting “that a federal court has leeway to choose among threshold grounds for denying audience to a case on the merits” and holding that a district court may dispose of a case on any proper nonmerits ground—including nonjurisdictional grounds—before establishing its subject matter jurisdiction) (citations omitted); *cf. Fla. Wildlife Fed'n Inc. v. United States Army Corps of Engineers*, 859 F.3d 1306, 1321 (11th Cir. 2017) (Tjoflat, J., concurring) (asserting that the district court exceeded its discretion by “declining to rule on a nonjurisdictional ground (the [] Rule 19(b) failure-to-join ground) in favor of a jurisdictional basis (the [] Rule 12(b)(1) sovereign-immunity ground)”).

V.

Accordingly,

IT IS ORDERED that, pursuant to Rule 12(b)(7) of the Federal Rules of Civil Procedure, Collegiate’s and Reed’s motions to dismiss are **GRANTED** and that the claims against Collegiate and Reed in the above-captioned case are **DISMISSED WITHOUT PREJUDICE**.

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New Orleans, Louisiana, September 15, 2020.

/s/ Lance M. Africk
LANCE M. AFRICK
UNITED STATES
DISTRICT JUDGE
