UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF WEST VIRGINIA

DM MOTOR, INC.,
Plaintiff,

v. Civil Action No. 3:24-cv-00192

BLACK BEAR PAC, INC., et al.,
Defendants.

MEMORANDUM IN SUPPORT OF MOTION TO DISMISS FOR FAILURE TO STATE A CAUSE OF ACTION

In support of its Motion to Dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure, Defendant Thomas Broadcasting Co., by its Counsel, William V. DePaulo, Esq., respectfully directs the Court's attention to the following points and authorities.

Rule 12(b), F.R.C. P., requires that a motion asserting the defense of "failure to state a claim upon which relief can be granted" must be made before a pleading if a responsive pleading is allowed.

Plaintiff DM Motor, Inc. alleges in ¶¶ 49-53 of its Complaint that:

> 49. Plaintiff alleges claims of willful copyright infringement, based upon Defendants' unauthorized use of Dutch Miller Kia's intellectual property and their refusal to cease and desist use of Dutch Miller Kia's intellectual property after notice.
>
> 50. Dutch Miller Kia was the creator of all of the subject DM Videos and is the owner of the content.
>
> 51. Each of the Defendants have publicly used Dutch Miller Kia's intellectual property without a license or permission to do so. Thus, Defendants have violated the exclusive rights maintained by Dutch Miller Kia in its

> copyrighted work and committed copyright infringement.
>
> 52. Each of the Defendants is liable for statutory damages for their improper use of Dutch Miller Kia's intellectual property.
>
> 53. The specific acts of copyright infringement alleged in the Complaint, as well as Defendants' entire course of conduct, have caused and are causing Plaintiffs great and incalculable harm and damage. By continuing to broadcast Dutch Miller Kia's intellectual property, Defendants threaten to continue committing copyright infringement. Unless this Court restrains Defendants from committing further acts of copyright infringement, Plaintiffs will suffer irreparable injury for which they have no adequate remedy at law.

Additionally, in its prayer for relief, Plaintiff requests that:

> (I) Defendants, their agents, servants, employees, and all persons acting under their permission and authority, be enjoined and restrained from infringing, in any manner, the intellectual property of Dutch Miller Kia, pursuant to 17 U.S.C. Section 502;
>
> (II) Defendants be ordered to pay statutory damages, pursuant to U.S.C. Section 504(c);
>
> (III) Defendants be ordered to pay costs, including a reasonable attorney's fee, pursuant to 17 U.S.C. Section 505; and
>
> (IV) Plaintiffs have such other and further relief as is just and equitable.

Nowhere in its Complaint does Plaintiff allege that its copyright, if any, has been registered with the Copyright Office of the United States.

Title 17 of the United States Code provides in §501

> The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it.

17 U.S.C. § 501 (emphasis added).

Title 17 of the United States Code provides in §411(a) entitled Registration and *Civil Infringement Actions*, that:

> Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.

17 U.S.C. § 411 (emphasis added).

It is clear that the requirement of registration recited in 17 U.S.C. §411 is not a mere formality; its literal terms been enforced by the U.S. Supreme Court in *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC*, et al., 139 S.Ct. 881, 203 L.ed.2d 147.

Fourth Estate involved an action where the plaintiff, a news gathering organization which had licensed material to the defendant, required that the material be deleted from the defendant's web site if the license agreement were canceled. When the defendant declined to remove the material after the license agreement was cancelled, the plaintiff sued for copyright infringement. The plaintiff in Fourth Estate alleged that it had filed applications to register the articles which had been licensed to the defendant with the Register of Copyrights, but that the Register had not yet acted on the applications.

Rejecting the plaintiff in Fourth Estate that applying for registration was sufficient for §411 purposes, the Supreme Court concluded that:

> Registration ... "has been made" within the meaning of 17 U.S.C. § 411(a) not when an application for registration is filed, but when the Register has registered a copyright after examining a properly filed application.

139 S.Ct. 892.

The *Fourth Estate* court affirmed the decision of the Eleventh Circuit, upholding the District Court's dismissal of the complaint.

In the present action, it appears that no registration has been applied for, let alone granted by the Copyright Office. Nor has Plaintiff alleged that it has registered the materials at issue here. A search of the Public Records System of the Copyright Office under the name DM Motor, Inc. finds no documents of record.[1]

Not surprisingly, lower courts have followed the lead of *Fourth Estate*. See *Munro v United States Copyright Office*, Civil Action 22-2909, March 18, 2024 ([A]lthough an owner's rights exist apart from registration, registration is akin to an administrative exhaustion requirement that the owner must satisfy before suing to enforce ownership rights. Registration is not a condition of copyright protection, but a copyright owner may not pursue an infringement action in court without first applying for registration); *Promedev LLC v Wilson*, C22-1063JLR (W.D. Wash. March 26, 2024))(Before pursuing an infringement claim in court, . . . a copyright claimant generally must comply with §411(a)'s requirement that 'registration of the copyright claim has been made.'" To satisfy the first element, the claimant must have a valid copyright registration); *McKensie v, Big Apple Training, Inc*., 1:22-cv-9554 GHW USDC SDNY, July 31, 2023 (Absent exceptions not relevant here, "[b]efore pursuing an infringement claim in court," a copyright claimant "must comply with [17 U.S.C.] § 411(a)'s requirement that 'registration of the copyright claim has been made). *Act, Inc. v. Worldwide Interactive Network, Inc*. 46 F.4th 489, 513 n. 5 (6th Cir. 2022)([R]egistration is generally required to sue over alleged copyright infringement. *See*

[1] See EXHIBIT "A" results of April 25, 2024 search at https://publicrecords.copyright.gov.

17 U.S.C. § 411(a) ; *Fourth Est. Pub. Benefit Corp. v. Wall-Street.com, LLC* , ––– U.S. ––––, 139 S. Ct. 881, 887, 203 L.Ed.2d 147 (2019)).

WHEREFORE, for the reasons stated, Defendant Thomas Broadcasting Co. respectfully requests that this motion be granted and Plaintiff's Complaint be dismissed.

Respectfully submitted,

THOMAS BROADCASTING COMPANY

By Counsel

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Defendants.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Motion to Dismiss was filed this 25th cay of April, 2024, with the Clerk of the Court via the CM/ECF system and thereby served on Plaintiff. Additionally, a copy of the foregoing Motion to Dismiss was 25th cay of April, 2024 emailed to Counsel for Plaintiff as follows:

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I further certify that a copy of the foregoing Motion to Dismiss was emailed and/or mailed, postage pre-paid, this 25th day of April, 2024 to the following at the addresses indicated below:

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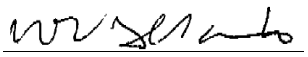

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