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8 **United States District Court**
9 **Central District of California**
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11 SYL JOHNSON,

12 Plaintiff,

13 v.

14 UMG RECORDINGS, INC.,

15 Defendant.
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Case No. 2:19-cv-02364-ODW (SSx)

**ORDER GRANTING, IN PART,
DENYING IN PART, DEFENDANT'S
MOTION TO DISMISS [14]**

18 **I. INTRODUCTION**

19 Plaintiff Syl Johnson ("Johnson") brings several claims against Defendant
20 UMG Recordings, Inc. ("UMG") involving copyright infringement. Plaintiff claims
21 Defendant UMG reproduced, distributed, and licensed a sampled portion of Plaintiff's
22 music. (*See* Compl. ¶¶1, ECF No. 1.)

23 Defendant moves to dismiss on the following grounds: (1) Plaintiff's claims are
24 barred by the statute of limitations; and (2) Defendant's alleged copying is not
25 actionable. (*See generally* Mot. to Dismiss Compl. ("Mot."), ECF No. 14.)¹
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28 ¹ Having carefully considered the papers filed in connection to the instant Motion, the Court deemed the matter appropriate for decision without oral argument. Fed. R. Civ. P. 78; C.D. Cal. L.R. 7-15.

1 For the reasons that follow, the Court **GRANTS, IN PART** and **DENIES, IN**
2 **PART**, Defendant’s Motion to Dismiss.

3 II. BACKGROUND

4 Syl Johnson, doing business as Twinight Records, Inc., produces, manufactures,
5 distributes, and sells sound recordings. (Compl. ¶¶ 1, 8.) In 1968, Plaintiff recorded
6 vocals of himself in a track titled “I Feel An Urge” (the “Recording”). (Compl. ¶¶ 1.)
7 In the Recording, a segment contains Plaintiff’s distinctive vocal “Ohh” followed by a
8 fast-paced drum roll, instrumental guitar, high note on a saxophone, and Plaintiff
9 singing “Yeah.”² (Compl. ¶¶ 1, 15.) In 1991, Defendant UMG reproduced,
10 distributed, and licensed a portion of the Recording on various tracks titled “Know the
11 Ledge,” “Juice,” and “Juice (Know the Ledge).” (Compl. ¶¶ 1, 16.) Plaintiff alleges
12 that the Recording “comprises twenty-five percent of these tracks.” (Compl. ¶ 16.)
13 Defendant allegedly used the tracks in theatrical and television movies, greatest hits
14 compilations, music videos, video games, commercials, and third-party licenses all
15 over the world. (Compl. ¶ 1.) Plaintiff discovered that the Recording was sampled
16 when Matthew Clifford, a former disc jockey, informed him that he “recognized
17 Plaintiff’s voice” on Defendant’s recordings. (Compl. ¶ 17.) Plaintiff had not
18 authorized Defendant to reproduce, manufacture, distribute, or license a sample
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20 ² Defendant requests that the Court take judicial notice of the “I Feel An Urge” and “Know the
21 Ledge” sound recordings. (Mot. 8.) As these recordings are not matters of public record, the Court
22 denies Defendant’s request for judicial notice. Nevertheless, “a court may consider documents
23 which are not physically attached to the complaint but ‘whose contents are alleged in [the] complaint
and whose authenticity no party questions.’” *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1128
(C.D. Cal. 2007) (quoting *Branch v. Tunnell*, 14 F.3d 449, 454 (9th Cir. 1994)).

24 In the Complaint, Plaintiff make numerous references to the Recording as well as to Defendant’s
25 allegedly infringing sound recordings. (See Compl. ¶¶ 1, 8, 15, 16.) Furthermore, at the motion to
26 dismiss stage, it is generally appropriate to consider allegedly infringed and allegedly infringing
27 works. See, e.g., *Steward v. West*, No. CV1302449BROJCX, 2014 WL 12591933, at *3 (C.D. Cal.
28 Aug. 14, 2014). Accordingly, the Court may consider the sound recordings cited to in Defendant’s
Motion. (Mot. 1.)

1 portion of the Recording. (Compl. ¶ 2.)

2 Plaintiff has filed several actions based on these facts in several venues. For
3 instance, he filed an action on May 4, 2015 in the Northern District of Illinois and
4 another one on December 12, 2017 in the Middle District of Tennessee.³ (Compl. ¶
5 18.) On March 28, 2019, Plaintiff filed the operative Complaint in the Central District
6 of California alleging three claims for relief under: (1) Cal. Civ. Code § 980 *et seq.*;
7 (2) Cal. Bus. & Prof Code § 17200 *et seq.*; and (3) Cal. Civ. Code § 3344. (*See*
8 *generally* Compl.) On June 3, 2019, Defendant filed a motion to dismiss (“Motion”).
9 (*See* Mot.)

10 III. LEGAL STANDARD

11 A court may dismiss a complaint under Rule 12(b)(6) for lack of a cognizable
12 legal theory or insufficient facts pleaded to support an otherwise cognizable legal
13 theory. *Balistreri v. Pacifica Police Dep’t*, 901 F.2d 696, 699 (9th Cir. 1988). To
14 survive a dismissal motion, a complaint need only satisfy the minimal notice pleading
15 requirements of Rule 8(a)(2)—a short and plain statement of the claim. *Porter v.*
16 *Jones*, 319 F.3d 483, 494 (9th Cir. 2003). The factual “allegations must be enough to
17 raise a right to relief above the speculative level.” *Bell Atl. Corp. v. Twombly*, 550
18 U.S. 544, 555 (2007). That is, the complaint must “contain sufficient factual matter,
19 accepted as true, to state a claim to relief that is plausible on its face.” *Ashcroft v.*
20 *Iqbal*, 556 U.S. 662, 678 (2009) (internal quotation marks omitted).

21 The determination of whether a complaint satisfies the plausibility standard is a
22 “context-specific task that requires the reviewing court to draw on its judicial
23 experience and common sense.” *Id.* at 679. A court is generally limited to the
24 pleadings and must construe all “factual allegations set forth in the complaint . . . as
25 true and . . . in the light most favorable” to the plaintiff. *Lee v. City of Los Angeles*,
26 250 F.3d 668, 679 (9th Cir. 2001). But a court need not blindly accept conclusory

27 ³ Defendant requests the Court to take judicial notice of pleadings and orders from the prior actions.
28 (Mot. 8.) Since the Complaint contained all pertinent facts to this motion, the Court denies
Defendant’s request as moot.

1 allegations, unwarranted deductions of fact, and unreasonable inferences. *Sprewell v.*
2 *Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001).

3 IV. DISCUSSION

4 A. Statute of Limitations

5 Defendant moves to dismiss Plaintiff's claims alleging that they are barred by
6 the statute of limitations. Misappropriation claims under Cal. Civ. Code. § 3344 are
7 subject to a two-year limitation. *Yeager v. Bowlin*, 693 F.3d 1076, 1081 (9th Cir.
8 2012) (stating that claims under Cal. Civ. Code § 3344 are subject to a two-year statute
9 of limitations). Claims under UCL are subject to a four-year limitation. Cal. Bus. &
10 Prof. Code § 17208 ("[a]ny action to enforce [the UCL] shall be commenced within
11 four years after the cause of action accrued.") Claims under Cal. Civ. Code §
12 980(a)(2) are subject to a three-year limitations periods. *UMG Recordings, Inc. v.*
13 *Glob. Eagle Entm't, Inc.*, No. CV 14-3466-GW(JPRX), 2016 WL 3457179, at *1
14 (C.D. Cal. Apr. 20, 2016) (citing 17 U.S.C. § 507(b); Cal. Civ. Code § 338(a); *Bridge*
15 *Publications, Inc. v. Vien*, 827 F. Supp. 629, 634 (S.D. Cal. 1993) (applying three-year
16 statute per § 338(a) to "copyright claims based on Cal. Civ. Code § 980(a)(2)")).

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18 Plaintiff asserts that the first instance of infringement occurred in 1991, yet he
19 is entitled to relief for every infringing act since then because Defendant continues to
20 sell recordings with Plaintiff's unlicensed Recording and each sale constitutes a new
21 instance of infringement. (Opp'n to Mot ("Opp'n") 13, ECF No. 16.) However, an
22 individual cannot bring copyright claims beyond the statute of limitations simply
23 because instances of copyright infringement continue to occur within the statutory
24 period. *Roley v. New World Pictures, Ltd.*, 19 F.3d 479, 481 (9th Cir. 1994). Acts
25 that accrued within the three years preceding the filing of suit may be brought. *Id.*
26 (holding that "in a case of continuing copyright infringements, an action may be
27 brought for all acts that accrued within the three years preceding the filing of suit.")
28 Furthermore, under California law, the continuing violation doctrine does not apply to

1 toll the statute of limitations periods for claims of misappropriation, and violation of
2 the UCL unless necessary for series of harms to accumulate before alleged
3 wrongdoing became apparent and actionable. *Wolf v. Travolta*, 167 F. Supp. 3d 1077
4 (C.D. Cal. 2016). Here, Plaintiff has made no such allegation. Thus, Plaintiff is
5 limited to bringing claims that accrued within the statute of limitations preceding the
6 filing of suit.

7 Plaintiff asserts several grounds to extend the statute of limitations: (1) delayed
8 discovery rule⁴ and (2) doctrine of fraudulent concealment. (Opp’n 14–19.)

9 **1. Delayed Discovery Rule**

10 In the Ninth Circuit, the discovery rule applies and “permits damages occurring
11 outside of the three-year window, so long as the copyright owner did not discover—
12 and reasonably could not have discovered—the infringement before the
13 commencement of the three-year limitation period.” *Polar Bear Prods., Inc. v. Timex*
14 *Corp.*, 384 F.3d 700, 706 (9th Cir. 2004). The discovery rule does not require
15 “absolute certainty” for a cause of action to accrue. *Wolf v. Travolta*, 167 F. Supp. 3d
16 1077, 1102 (C.D. Cal. 2016) (citing *Fox v. Ethicon Endo-Surgery, Inc.*, 35 Cal.4th
17 797, 807, 27 Cal.Rptr.3d 661, 110 P.3d 914 (2005)). Rather, “suspicion of one or
18 more of the elements of a cause of action, coupled with knowledge of any remaining
19 elements, will generally trigger the statute of limitations period.” *Id.*

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21 Though Plaintiff concedes the first instance of infringement occurred in 1991,
22 Plaintiff asserts that he was unaware of the infringement because he does not listen to
23 the genre of “rap” or “gangster rap” due to religious reasons. (Opp’n 13, 15.)
24 Plaintiff further concedes that he became aware of the infringement when a disc
25 jockey friend brought it to his attention in December 2013. (Opp’n 15.) Yet, Plaintiff

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27 ⁴ In support of the application of the delayed discovery rule, Plaintiff cites *Evans v. Eckelman*, 216
28 Cal.App.3d 1609, 1618–1620 (Ct. App. 1990), which discusses delayed discovery as it pertains to
third party claims in sexual abuse cases and was superseded by statute as stated in *Quarry v. Doe I*,
53 Cal. 4th 945 (Cal. 2012). Plaintiff’s case law is misplaced.

1 filed his complaint on March 28, 2019. As five years have elapsed since the time
2 Plaintiff allegedly became aware of his claim, even if applicable, the discovery delay
3 would not save his claims outside of those accrued within the relevant statute of
4 limitations. Thus, Plaintiff may bring an action for copyright infringement under the
5 California statute for all acts that accrued between March 27, 2016 and March 28,
6 2019. Furthermore, he may bring a UCL claim and a misappropriation claim for all
7 acts that accrued up to four and two years, respectively, before March 28, 2019.

8 **2. Doctrine of Fraudulent Concealment**

9 The doctrine of fraudulent concealment involves “[a] defendant's fraud in
10 concealing a cause of action.” *In re Packaged Seafood Prod. Antitrust Litig.*, 242 F.
11 Supp. 3d 1033, 1112 (S.D. Cal. 2017) (citing *Grisham v. Philip Morris U.S.A., Inc.*,
12 40 Cal.4th 623 (Cal. 2007) (applying the doctrine to the UCL)). Where the doctrine
13 applies, the statute of limitations is tolled until a plaintiff's reliance on the
14 misrepresentations is reasonable. *Id.* Here, Plaintiff asserts that by omitting any
15 credit to Plaintiff or the Recording on any label copy, Defendant fraudulently
16 prevented Plaintiff from discovering the infringing use. As Plaintiff concedes that
17 he became aware of the alleged infringements in December 2013, he could have
18 only relied on Defendant's misrepresentations until then. Even if applicable, the
19 doctrine would only toll the statute of limitations until December 2013.
20 Consequently, as above, the doctrine would not save his claims outside of those
21 accrued within the relevant statute of limitations as five years have elapsed since
22 December 2013. Thus, Plaintiff is barred from bringing claims accrued beyond the
23 statute of limitations.

24 **3. Equitable Tolling**

25 Plaintiff argues that the doctrine of equitable tolling should apply. Plaintiff
26 must satisfy three essential elements: (1) timely notice to the defendant in filing the
27 first claim; (2) lack of prejudice to defendant in gathering evidence to defend against
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1 the second claim; and, (3) good faith and reasonable conduct by the plaintiff in filing
2 the second claim. *Aguilera v. Heiman*, 174 Cal.App.4th 590, 598 (Ct. App. 2009)
3 (citing *Collier v. City of Pasadena*, 142 Cal.App.3d 918, 924 (Ct. App. 1983)).

4 Here, Plaintiff fails to meet the standard for equitable tolling as he lacks the
5 third element. Under the third element, courts have found that plaintiffs lacked good
6 faith when parties delayed filing their second claim. *Mitchell v. Frank R. Howard*
7 *Mem'l Hosp.*, 6 Cal. App. 4th 1396, 1407 (Ct. App. 1992) (finding plaintiff lacked
8 good faith when nine months had lapsed since he dismissed his federal action); *Ervin*
9 *v. Los Angeles Cty.*, 848 F.2d 1018, 1020 (9th Cir. 1988) (finding plaintiff lacked
10 good faith for delaying the second claim when plaintiff had possession of facts for
11 over a year and a half prior to her filing the action). Here, Plaintiff waited a year and
12 a half after he became aware of the infringement in December 2013 to file his first
13 case, and Plaintiff waited another eleven months after the resolution of his first action
14 to file his second one. (Reply to Opp'n 6, ECF No. 17.)

15 Furthermore, after District Court Judge Amy St. Eve in the Northern District of
16 Illinois indicated to Plaintiff on January 4, 2017 that this case would be proper in the
17 Central District of California, Plaintiff filed its second case in the Middle District of
18 Tennessee. *Johnson v. Barrier*, No. 15-cv-03928, 2017 WL 36442 (N.D. Ill. Jan. 04,
19 2017). Plaintiff's disregard of Judge St. Eve's order demonstrates that Plaintiff
20 intended to forum shop and circumvent the proper venue. Thus, the Court finds that
21 Plaintiff lacks good faith and therefore, the doctrine of equitable tolling does not
22 apply.

23 Accordingly, the Court **GRANTS** Defendant's Motion as to all claims accrued
24 outside the relevant statute of limitations.

25 **B. Failure to State a Claim**

26 The Ninth Circuit has long held that courts can determine whether a party
27 infringed a protected work on a motion to dismiss. *Steward v. West*, No.
28 CV1302449BROJCX, 2014 WL 12591933, at *7 (C.D. Cal. Aug. 14, 2014) (citing

1 *Christianson v. W. Pub. Co.*, 149 F.2d 202, 203 (9th Cir. 1945)). “[W]hen the
2 copyrighted work and the alleged infringement are both before the court, capable of
3 examination and comparison, non-infringement can be determined on a motion to
4 dismiss.” *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1130 (C.D. Cal. 2007)
5 (citing *Christianson v. West Pub. Co.*, 149 F.2d 202, 203 (9th Cir. 1945)). To
6 establish copyright infringement, Plaintiff must prove: (1) ownership of a valid
7 copyright; and (2) copying of constituent elements that are original. *See Feist Publ'ns,*
8 *Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). Copying may be established
9 by showing that the works in question are “substantially similar in their protected
10 elements” and that the infringing party had access to the copyrighted work. *Metcalf v.*
11 *Bochco*, 294 F.3d 1069, 1072 (9th Cir. 2002).

12 Defendant does not dispute that Plaintiff is the owner of a valid copyright or
13 that Defendant sampled the Recording. Instead, Defendant asserts that Plaintiff’s
14 copyright claim should be dismissed because (1) no reasonable jury could find that the
15 works are substantially similar and any use by the Defendant was de minimis, and (2)
16 the fair use doctrine bars Plaintiff’s claim.

17 **1. De Minimis Use**

18 Plaintiff contends that California’s statute does not provide for de minimis use.
19 (Opp’n 12.) However, the test to determine whether there has been unlawful copying
20 of protectible material is whether the two works, when compared, show such
21 pronounced similarities of substantial portions of details, sequence of events, and
22 manner of expression and treatment, as to warrant inference of copying. *Barsha v.*
23 *Metro-Goldwyn-Mayer*, 32 Cal.App.2d 556, 561 (Ct. App. 1939) (discussing
24 copyright common law). The Court infers that where the use of a party’s copyright
25 protected art is de minimis, the use does not have “pronounced similarities of
26 substantial portions.”

27 Courts have found de minimis use of music excerpts where several seconds
28 were used from a piece that lasted several minutes long. *See e.g. Steward v. West*, No.

1 CV1302449BROJCX, 2014 WL 12591933, at *9 (C.D. Cal. Aug. 14, 2014) (finding
2 fair use where the sampled portions lasted only about a half-second in time and the
3 recording of plaintiffs’ song is over seven minutes in length); *VMG Salsoul, LLC v.*
4 *Ciccone*, No. CV 12–05967 BRO (Cwx), 2013 WL 8600435, at *11 (C.D. Cal. Nov.
5 18, 2013) (finding a quarter-second sample not quantitatively significant to a seven-
6 minute recording); *TufAmerica, Inc. v. Diamond*, 968 F. Supp. 2d 588, 605 (S.D.N.Y.
7 2013) (finding a three-second drum sequence not quantitatively significant to a six-
8 minute song).

9 However, even where the sheer quantity of time used was minimal, courts have
10 considered the characteristics of the voice and sounds in determining if the use was de
11 minimis. *See e.g. Pryor v. Warner/Chappell Music, Inc.*, No. CV 13-04344 RSWL,
12 2014 WL 2812309, at *7 (C.D. Cal. June 20, 2014) (finding that even though the
13 sampled piece was half of a second in a six-and-a-half-minute recording, the signature
14 voice dissuaded the Court from finding de minimis use on a motion to dismiss).

15 The Court finds that, at this stage, Plaintiff has sufficiently alleged that the
16 copying can be substantial enough to constitute infringement. Although Defendant
17 only allegedly sampled “3.094 second fragment” of the bridge of the Recording,
18 which is about two-and-a-half minutes long, Plaintiff alleged that Defendant sampled
19 a segment containing Plaintiff’s distinctive vocal “Ohh” followed by a fast-paced
20 drum roll, instrumental guitar, high note on a saxophone, and Plaintiff singing “Yeah.”
21 (Mot. 5; Compl. ¶ 15.) Based on Plaintiff’s allegations of Plaintiff’s signature voice
22 and unique composition, the Court concludes that a jury could find the two pieces
23 substantially similar. Thus, the Court **DENIES** Defendant’s Motion on this ground.

24 **2. Fair Use**

25 Plaintiff contends that California’s statute does not provide for fair use. (Opp’n
26 9, 12.) In distinguishing between common law and California copyright law, the
27 California Court of Appeal stated:
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1 The common law prohibits any kind of unauthorized interference with, or
2 use of, an unpublished work on the ground of an exclusive property right,
3 and the common-law right is perpetual, existing until lost or terminated
4 by the voluntary act of the owner, . . . while a statutory copyright permits
5 a “fair use” of the copyright publication, without deeming it an
6 infringement. . . .

7 *Zachary v. W. Publ'g Co.*, 75 Cal. App. 3d 911, 919 (Ct. App. 1977). From this
8 reasoning, the Court infers that under Cal. Civil Code §980 *et seq.* fair use of
9 copyright protected music is permitted. *See also Richlin v. Metro-Goldwyn-Mayer*
10 *Pictures, Inc.*, 531 F.3d 962, 971 (9th Cir. 2008) (“In California, the basic principles
11 governing common law copyright have been codified in Civil Code section 980 *et*
12 *seq.*” (internal quotation marks omitted)). In *Zachary*, the court found a party misused
13 drawings in a public patent filing by reprinting them in its commercial publications.
14 *Zachary*, 75 Cal. App. 3d at 912. Further, the court held the party was entitled to copy
15 the drawings and descriptions of the kite, but was not to use or misappropriate them
16 for its own benefit. *Id.* at 926.

17 Here, Plaintiff alleges that Defendant has “reproduced, manufactured,
18 distributed, licensed, and/or sold master recordings embodying [the Recording] . . . in
19 motion pictures, television programs, commercials, music videos and video games.”
20 (Compl. ¶ 20.) At this juncture, the Court does not find that Defendant’s use of
21 Plaintiff’s clip for its commercial benefit was fair.⁵ Thus, the Court **DENIES**
22 Defendant’s motion
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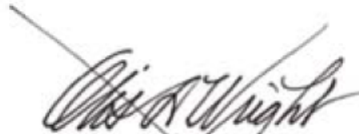
26 ⁵ Defendant cites to *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985),
27 which lists the four factors to consider in determining fair use as enumerated in the Federal
28 Copyright Act, 17 U.S.C.A. § 107. (Mot. 18.) Since Plaintiff does not bring a claim under the
federal statute, the Court does not apply the four-factor test, but considers the arguments under the
California framework.

1 **IV. CONCLUSION**

2 For the foregoing reasons, the Court **GRANTS, IN PART** and **DENIES, IN**
3 **PART**, Defendant's Motion. Specifically, the Court **GRANTS** Defendant's Motion as
4 to Plaintiff's claims barred by the Statute of Limitations and **DENIES** Defendant's
5 Motion as to all other claims. Accordingly, all other claims will proceed.

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7 **IT IS SO ORDERED.**

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9 October 23, 2019

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12 **OTIS D. WRIGHT, II**
13 **UNITED STATES DISTRICT JUDGE**
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