



March 3, 2005

BY FACSIMILE

The Honorable William H. Pauley III
United States District Court
Southern District of New York
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Chambers 2210
Courtroom 11D
New York, NY 10007

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It is ORDERED that counsel to whom this Order is sent is responsible for faxing a copy to all counsel and retaining verification of such in the case file. Do not fax such verification to chambers.

MEMORANDUM ENDORSED

Vargas et al. v. Pfizer, Inc., et al. 04 CV 9772 (WHP)

Dear Judge Pauley:

We represent Pfizer, Inc. ("Pfizer"), one of the defendants in the above-captioned matter. Although we have not yet been served, we write, pursuant to Section 2A of your Individual Practices, to request a pre-motion conference regarding our intention to move to dismiss the Lanham Act (Count III) and statutory and common law unfair competition (Count IV) claims in the Complaint.

The basis for this motion is as follows:

- Among other cases, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) precludes Lanham Act claims based on alleged failures to attribute copyright ownership.
 - In *Dastar*, the Court held that failing to attribute a work to its author could not constitute a violation of the Lanham Act because the Copyright Act – not the Lanham Act – is the only proper vehicle for protecting authors' rights. The Lanham Act protects only "the producer of . . . tangible goods that are offered for sale, and not . . . the author of any idea, concept, or communication embodied in those goods." *Id.* at 37.
 - Here, the Complaint alleges that Defendants violated the Lanham Act by:

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(i) designating Defendant Transeau, rather than Plaintiffs, as the creator, composer, producer, arranger and owner of the Composition; and

(ii) intentionally failing to identify Plaintiffs as the creators, composers, producers and arrangers of the Composition to various performance collection societies.

Complaint ("Compl.") ¶ 51. Plaintiffs further allege that these acts caused confusion as to the "source or origin . . . of the Composition." *Id.* ¶ 52. These allegations fail to state a Lanham Act claim because, as *Dastar* held, the term "'origin of goods' in the Lanham Act . . . refers to the producer of the tangible goods . . . and not to the author" *Dastar Corp.*, 539 U.S. at 37. Accordingly, Count III of Plaintiffs' Complaint must be dismissed. *See also Carroll v. Kahn*, 03 Civ. 0656 (TJM), 2003 U.S. Dist. LEXIS 17902, at *17 - *18 (S.D.N.Y. Oct. 9, 2003) (holding protection of "creative talent behind communicative products" is found in copyright law); *Smith v. New Line Cinema*, 03 Civ. 5274 (DC), 2004 WL 2049232, at *10-*11 (S.D.N.Y. Sept. 13, 2004) (holding that failure to credit author of screenplay not actionable under the Lanham Act)

- Count IV of Plaintiffs' Complaint must be dismissed as preempted by the Copyright Act.
 - Although Count IV alleges violations of "statutory" law, Plaintiffs fail to identify a single statute upon which they rely. *See* Compl. ¶¶ 58-64. The "statutory" portion of Plaintiffs' Count IV is thus facially deficient.
 - Common law claims for unfair competition and misappropriation are preempted by the Copyright Act. *See* 17 U.S.C. § 301. In New York, courts apply the "extra element" test to decide whether a state claim is preempted by the Copyright Act. *See Archie Comic Publ'ns, Inc. v. DeCarlo*, 141 F. Supp. 2d 428, 432-34 (S.D.N.Y.) (applying extra element test), *aff'd* 11 Fed. Appx. 2d (2d Cir), *cert. denied*, 534 U.S. 1056 (2001). That test asks whether the state law claim has an "extra element" to differentiate it from a claim that would otherwise arise under the Copyright Act. If a state law claim lacks this extra element, it is preempted.

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- o Here, the state law claims arise solely out of the alleged copying of plaintiffs' musical composition. They thus contain no "extra element" to differentiate them from a claim otherwise arising exclusively under the Copyright Act. *See, e.g., Archie Comic Publ'ns*, 141 F. Supp. 2d at 432-34 (Copyright Act preempted claim for misappropriation based on defendant's "*exploiting* and thus infringing rights that are those of a copyright holder") (emphasis supplied); *cf. Compl.* ¶¶ 2-3, 5, 30, 38-39, 42, 53 (accusing defendants of "*exploiting*" or contributing to "exploitation" of plaintiffs' composition) (emphasis supplied).

We respectfully request a pre-trial conference and permission to file this motion to dismiss, which we understand Defendant Publicis, Inc. is likely to join. If granted, the motion would allow all parties to conduct discovery more efficiently and effectively, and streamline the issues for trial. We would be prepared to discuss this and any other potential motions directed to the complaint that might be raised by other parties at the March 18, 2005, conference previously scheduled by the Court, or at any other convenient time.

Respectfully yours,



Bruce P. Keller

cc: Paul A. Chin, Esq.

MEMORANDUM ENDORSED

It is ORDERED that counsel to whom this Order is sent is responsible for faxing a copy to all counsel and retaining verification of such in the case file. Do not fax such verification to chambers.

Application Granted. A pre-motion conference is scheduled for 3/18/2005 at 10:00 a.m.

SO ORDERED:



WILLIAM H. PAULEY III U.S.D.J.

3/4/2005

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Facsimile

4 pages including cover page

Pursuant to the Court's permission, please find the enclosed letter requesting permission to file a pre-trial motion to dismiss.

For assistance or confirmation please call 212 909 6407

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