

Court of Claims of Ohio

The Ohio Judicial Center
65 South Front Street, Third Floor
Columbus, OH 43215
614.387.9800 or 1.800.824.8263
www.cco.state.oh.us

DOUGLAS CLAY OSBORNE

Plaintiff

v.

OHIO DEPARTMENT OF REHABILITATION AND CORRECTION

Defendant

Case No. 2007-07388

Judge Joseph T. Clark

Magistrate Steven A. Larson

DECISION

{¶ 1} On November 17, 2008, defendant filed a motion for summary judgment pursuant to Civ.R. 56(B). The motion is now before the court on a non-oral hearing pursuant to L.C.C.R. 4(D).

{¶ 2} Civ.R. 56(C) states, in part, as follows:

{¶ 3} “Summary judgment shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, written admissions, affidavits, transcripts of evidence, and written stipulations of fact, if any, timely filed in the action, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. No evidence or stipulation may be considered except as stated in this rule. A summary judgment shall not be rendered unless it appears from the evidence or stipulation, and only from the evidence or stipulation, that reasonable minds can come to but one conclusion and that conclusion is adverse to the party against whom the motion for summary judgment is made, that party being entitled to

have the evidence or stipulation construed most strongly in the party's favor." See also *Gilbert v. Summit County*, 104 Ohio St.3d 660, 2004-Ohio-7108, citing *Temple v. Wean United, Inc.* (1977), 50 Ohio St.2d 317.

{¶ 4} At all times relevant to this action, plaintiff was an inmate in the custody and control of defendant at the Mansfield Correctional Institution pursuant to R.C. 5120.16. Plaintiff alleges that defendant has both infringed upon and contributed to the infringement of a copyright interest and trademark or trade name interest that he possesses in his name written with all capital letters; to wit, DOUGLAS CLAY OSBORNE. Defendant argues that no such copyright or trademark/trade name interests exist.

{¶ 5} With respect to plaintiff's copyright claims, 17 U.S.C. 301(a) provides:

{¶ 6} "On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. *Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.*" (Emphasis added.)

{¶ 7} Furthermore, 28 U.S.C. 1338(a) provides:

{¶ 8} "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. *Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.*" (Emphasis added.)

{¶ 9} Civ.R. 12(H)(3) provides that "[w]hen it appears by suggestion of the parties or otherwise that the court lacks jurisdiction of the subject matter, the court shall dismiss the action."

{¶ 10} Based upon the foregoing, the court finds that this court lacks subject matter jurisdiction to adjudicate any of plaintiff's claims based upon his alleged copyright interest in DOUGLAS CLAY OSBORNE. Accordingly, plaintiff's copyright infringement and contributory infringement claims are DISMISSED pursuant to Civ.R. 12(H)(3).

{¶ 11} In support of its motion for summary judgment, defendant filed a transcript of plaintiff's deposition testimony. Plaintiff testified that defendant withdrew money from his institutional account for child support pursuant to an order from the Crawford County Court of Common Pleas. Plaintiff claims that in doing so, defendant violated the trademark/trade name DOUGLAS CLAY OSBORNE. Plaintiff alleges that he has registered DOUGLAS CLAY OSBORNE as a trademark/trade name only in the state of Indiana. (Plaintiff's Deposition, Page 10, Lines 3-8.)

{¶ 12} Trademarks and trade names are governed by R.C. Section 1329.

{¶ 13} R.C. 1329.01 provides, in relevant part:

{¶ 14} "(A) As used in sections 1329.01 to 1329.10 of the Revised Code:

{¶ 15} "(1) 'Trade name' means a name used in business or trade to designate the business of the user and to which the user asserts a right to exclusive use.

{¶ 16} "(2) 'Fictitious name' means a name used in business or trade that is fictitious and that the user has not registered or is not entitled to register as a trade name. * * *

{¶ 17} "(B) Subject to sections 1329.01 to 1329.10 of the Revised Code, any person may register with the secretary of state, on a form prescribed by the secretary of state, any trade name under which the person is operating * * *."

{¶ 18} R.C. 1329.54(A) provides:

{¶ 19} "'Trademark' means any word, name, symbol, device, or combination of any word, name, symbol, or device, that is adopted and used by a person to identify and distinguish the goods of that person, including a unique product, from the goods of other persons, and to indicate the source of the goods, even if that source is unknown."

{¶ 20} Plaintiff does not allege that he uses the name DOUGLAS CLAY OSBORNE to designate any business; rather, he uses it to designate himself. Plaintiff also does not allege that he uses DOUGLAS CLAY OSBORNE to "identify and distinguish" any goods. However, even if plaintiff could arguably claim a valid trade name or trademark in the name DOUGLAS CLAY OSBORNE, the statutory schemes require that such a trade name or trademark be registered with the Ohio Secretary of State before commencing any civil action with regard to the same.

{¶ 21} R.C. 1329.10(B) provides that:

{¶ 22} “No person doing business under a trade name or fictitious name shall commence or maintain an action in the trade name or fictitious name in any court in this state or on account of any contracts made or transactions had in the trade name or fictitious name until it has first complied with section 1329.01 of the Revised Code * * *.”

{¶ 23} Likewise, with respect to a trademark, R.C. 1329.66. provides, in part:

{¶ 24} “Any owner of a trademark or service mark *registered under the sections 1329.54 to 1329.67 of the Revised Code*, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations of the mark, and any court of competent jurisdiction may grant injunctions to restrain such manufacture, use, display, or sale as may be by the court considered just and reasonable, and may require the defendants to pay to the owner all profits derived from and all damages suffered by reason of the wrongful manufacture, use, display, or sale; the court may also order that any such counterfeits or imitations in the possession or under the control of any defendant in such case, to be delivered to an officer of the court, or to the complainant, to be destroyed.” (Emphasis added.)

{¶ 25} Based upon the foregoing and plaintiff’s admission that he has not registered his trademark or trade name with the Ohio Secretary of State, the court finds that plaintiff has not met the statutory requirements for bringing an action based upon alleged violations of his trade name and trademark. Therefore, the court finds that defendant is entitled to judgment as a matter of law with regard to those claims and defendant’s motion for summary judgment shall be granted.

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JUDGMENT ENTRY

A non-oral hearing was conducted in this case upon defendant's motion for summary judgment. For the reasons set forth in the decision filed concurrently herewith, plaintiff's copyright and contributory infringement claims are DISMISSED pursuant to Civ.R. 12(H)(3). Furthermore, defendant's motion for summary judgment is GRANTED and judgment is rendered in favor of defendant. Court costs are assessed against plaintiff. The clerk shall serve upon all parties notice of this judgment and its date of entry upon the journal.

JOSEPH T. CLARK
Judge

cc:

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MR/cmd
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