

nor of the State of Missouri; and the Missouri Supreme Court.

plaintiff and counter-defendant, Urantia Foundation.

Joseph D. Lewis of Cleary & Komen, Washington, DC, for defendant and counter-claimant, Kristen Maaherra.

URANTIA FOUNDATION, Plaintiff,

v.

Kristen MAAHERRA, Defendant.

Civ. No. 91-0325 PHX WKU.

United States District Court,
D. Arizona.

Jan. 27, 1995.

**MEMORANDUM AND ORDER ON
PLAINTIFF'S MOTION TO
DISMISS**

URBOM, Senior District Judge.

This cause is before the court on the plaintiff's motion to dismiss for lack of standing pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure. The plaintiff, Urantia Foundation, contends that the defendant lacks standing to assert any claims based upon the foundation's alleged violations of its governing declaration of trust.

I. FACTUAL BACKGROUND

The Urantia Foundation was established pursuant to a charitable trust and exists under the laws of the State of Illinois. The plaintiff brought this action in part to enjoin the defendant, Kristen Maaherra, from infringing upon its copyright to *The Urantia Book* and infringing upon its registered trademarks to the name "Urantia" and the three blue concentric circles associated with the foundation. The defendant seeks to justify her actions by claiming that she, and not the Urantia Foundation, is acting in a way required by the foundation's declaration of trust. Furthermore, the defendant initially sought to place the foundation under the supervision of the court and enjoin it from administering the trust in what she believed was an inappropriate manner. The defendant has recently deleted these two prayers for relief from her current answer and counterclaim. See (Revised) Def.'s Substitute 2nd An. Answer and Countercl. at 25.

II. STANDARD OF REVIEW

[1] When confronted with a motion to dismiss for want of standing, the court must accept each material allegation in the complaint as true and construe the complaint in favor of the complainant. *Metropolitan Washington Airports Auth. v. Citizens for the Abatement of Aircraft Noise, Inc.*, 501

L. Dale Owens and Scott A. Wharton, of Booth, Wade & Campbell, Atlanta, GA, for

U.S. 252, 264, 111 S.Ct. 2298, 2306, 115 L.Ed.2d 236 (1991) (quoting *Warth v. Seldin*, 422 U.S. 490, 501, 95 S.Ct. 2197, 2206, 45 L.Ed.2d 343 (1975)); see *McMichael v. County of Napa*, 709 F.2d 1268 (9th Cir.1983) (discussing general principles of standing). "Essentially, the standing question in such cases is whether the constitutional or statutory provision on which the claim rests properly can be understood as granting persons in the plaintiff's position a right to judicial relief." *Warth*, 422 U.S. at 500, 95 S.Ct. at 2206.

III. LEGAL DISCUSSION

[2] Although the defendant has deleted the aforementioned prayers for relief from her most recent counterclaim, Count II of the counterclaim continues to allege violations of the plaintiff's declaration of trust. Furthermore, the defendant appears adamant in her belief that I should endeavor to interpret certain provisions of the trust and determine "to [what] extent . . . the mandates in the Declaration of Trust are consistent with [her] study aid project." (Def.'s Mem. in Opp'n to Pl.'s Mot. to Dismiss for Lack of Standing at 4.) [hereinafter Def.'s Br.] This I cannot do.

The Urantia Foundation is a charitable trust and was created under and is subject to the laws of the State of Illinois. (Bondi Aff. at 2.)

Article V, § 15 of the Illinois Constitution of 1970 provides that "The Attorney General shall be the legal officer of the State, and shall have the duties and powers that may be prescribed by law." Indeed, the right of . . . the Attorney General to interfere in the handling of a public charity to prevent or correct abuses cannot be denied. . . . [B]oth the Illinois Constitution and the supreme court have recognized the common law authority of the Attorney General to protect the rights of the people of Illinois. This responsibility includes the duty to protect, supervise and enforce charitable trusts.

People v. National Anti-Drug Coalition, 124 Ill.App.3d 269, 79 Ill.Dec. 786, 791 & n. 3, 464 N.E.2d 690, 695 & n. 3 (1984) (citations omitted); see also *In re Estate of Stern*, 240

Ill.App.3d 834, 181 Ill.Dec. 461, 608 N.E.2d 534 (1992) (holding Illinois Charitable Trust Act provides Attorney General with authority to supervise and enforce charitable trusts); *Moloney v. Newberry Library*, 150 Ill. 229, 37 N.E. 236 (1894) (explaining Attorney General is proper party to bring action if doubt exists as to the meaning of a trust).

The defendant claims the plaintiff "seeks to have this Court strike all of Defendant Maaherra's references to the Foundation's Declaration of Trust." (Def.'s Br. at 1.) Moreover, she fears that if I grant the plaintiff's motion to dismiss, she may be barred from "utiliz[ing] the Declaration of Trust as evidence relating to the other claims asserted in the pleadings." *Id.* at 2. Neither statement is totally accurate.

In finding that the defendant lacks standing to request this court's assistance in the interpretation, administration, or enforcement of the declaration of trust, I am not prohibiting any reference to the instrument. The Federal Rules of Evidence remain in effect, and therefore relevant evidence will generally be admissible. FED.R.EVID. 402. Evidence concerning the plaintiff's declaration of trust will be considered relevant, if it has "any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence." *Id.* 401.

IT IS THEREFORE ORDERED that the plaintiff's motion to dismiss, filing 188, is granted.

URANTIA FOUNDATION, Plaintiff,

v.

Kristen MAAHERRA, Defendant.

Civ. No. 91-0325 PHX WKU.

United States District Court,
D. Arizona.

Jan. 27, 1995.

L. Dale Owens and Scott A. Wharton, of Booth, Wade & Campbell, Atlanta, GA, for plaintiff.

Joseph D. Lewis, of Cleary & Komen, Washington, DC, for defendant.

MEMORANDUM AND ORDER ON
PLAINTIFF'S MOTION FOR PAR-
TIAL SUMMARY JUDGMENT

URBOM, Senior District Judge.

This cause is before the court on the plaintiff's motion for partial summary judgment pursuant to Rule 56(d) of the Federal Rules of Civil Procedure. The plaintiff, Urantia Foundation, asserts that neither the free speech nor the religion clauses of the First Amendment to the United States Constitution provide the defendant, Kristen Maaherra, a viable defense to the plaintiff's copyright and trademark infringement claims.

I. FACTUAL BACKGROUND

The plaintiff initially brought this action to enjoin the defendant from, among other things, infringing upon its copyright to *The URANTIA Book* and infringing upon its registered trademarks to the name "Urantia" and the three concentric circles associated with the Urantia Foundation. The defendant seeks to avoid the plaintiff's claims in part by relying on the First Amendment as a de-

fense. In particular, the defendant states that "[e]ach of the purported claims infringes the Defendant's rights to religious freedom under the First Amendment to the Constitution of the United States and the prohibition placed upon the Congress of the United States in making laws respecting the establishment of religion or the free exercise thereof." ((Revised) Def.'s Substitute 2nd Am. Answer & Countercl. at 5, ¶ 1.) [hereinafter Def.'s Answer] The defendant also claims that this court is barred from granting any of the plaintiff's requested relief "because the granting of such relief would constitute a violation of the Defendant's right of freedom of speech." *Id.* at ¶ 2.

II. STANDARD OF REVIEW

The standard applied to a motion for partial summary judgment is identical to the standard applied to adjudicate a case fully by summary judgment. The motion shall be granted when, viewing the facts and reasonable inferences in the light most favorable to the nonmoving party, "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." FED.R.Civ.P. 56(c); *Calnetics Corp. v. Volkswagen of Am., Inc.*, 532 F.2d 674, 683 n. 11 (9th Cir.), *cert. denied*, 429 U.S. 940, 97 S.Ct. 355, 50 L.Ed.2d 309 (1976). A genuine issue of material fact exists when there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249, 106 S.Ct. 2505, 2510-11, 91 L.Ed.2d 202 (1986) (citing *First Nat. Bank of Arizona v. Cities Serv. Co.*, 391 U.S. 253, 88 S.Ct. 1575, 20 L.Ed.2d 569 (1968)). If the moving party meets the initial burden of establishing the nonexistence of a genuine issue, then the burden shifts to the opposing party to produce evidence of the existence of a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). "If the evidence is merely colorable or is not significantly probative, summary judgment may be granted." *Anderson*, 477 U.S. at 249-50, 106 S.Ct. at 2510-11 (citations omitted).

III. LEGAL DISCUSSION

[1, 2] Particular facts upon which I have relied heavily must be initially emphasized. First, the plaintiff possesses certificates of copyright and trademark registration for the property at issue. (Pl.'s Compl. at Ex. A-F.) The certificates alone constitute prima facie evidence of the validity of the registration, ownership of the property, and the exclusive right to its use. *Remick Music Corp. v. Interstate Hotel Co. of Neb.*, 58 F.Supp. 523, 531 (D.Neb.1944), *aff'd*, 157 F.2d 744 (8th Cir.1946), *cert. denied*, 329 U.S. 809, 67 S.Ct. 622, 91 L.Ed. 691 (1947); 17 U.S.C. § 410(c) (1988); *Curtis-Stephens-Embry Co. v. Pro-Tek-Toe Skate Stop Co.*, 199 F.2d 407, 413 (8th Cir.1952); 15 U.S.C. §§ 1057, 1115(a) (1988). Therefore, the defendant, claiming that the copyright and trademarks are invalid, has the burden of overcoming this presumption. *Apple Computer, Inc. v. Formula Int'l Inc.*, 725 F.2d 521, 523 (9th Cir.1984); *Sylvania Elec. Prods., Inc. v. Dura Elec. Lamp Co.*, 247 F.2d 730, 732 (3d Cir.1957). Second, although the defendant argues that enforcing the copyright and trademark laws will violate her constitutional rights to free speech and religion, she does not in any way question the laws' constitutionality. Third, the defendant "does not dispute the proposition that religious organizations can hold valid trademarks; she does not dispute that religious organizations can hold valid copyrights, or that works on the subject of religion can be the subject of a valid copyright." (Def.'s Mem. in Opp'n to Pl.'s Mot. for Partial Summ.J. on First Amendment Defense at 1-2.) [hereinafter Def.'s Br.]

Upon reviewing the record before me, I glean two basic assertions by the defendant. One, the copyright to *The URANTIA Book* and each of the trademarks at issue are invalid; and two, if the court rules in favor of enforcing an invalid copyright or trademark, the court, not the plaintiff, will be violating her constitutional rights to freedom of religion and speech. The first contention has yet to be proven, and the second is premature and more properly an issue for any future appeal rather than an affirmative defense in the instant case.

A. *The First Amendment*

[3] The ultimate issue before me is whether the plaintiff's copyright and trademarks are valid. The defendant argues that the court should abstain from deciding the issue because the dispute over this matter is an ecclesiastical one. I am confident, however, that the issue can be decided through the interpretation of statutes, not scriptures.

[T]he First Amendment severely circumscribes the role that civil courts may play in resolving church property disputes. It is obvious, however, that not every civil court decision as to property claimed by a religious organization jeopardizes values protected by the First Amendment. Civil courts do not inhibit free exercise of religion merely by opening their doors to disputes involving church property. And there are neutral principles of law, developed for use in all property disputes, which can be applied without 'establishing' churches to which property is awarded. . . . [T]he Amendment therefore commands civil courts to decide church property disputes without resolving underlying controversies over religious doctrine.

Presbyterian Church in the United States v. Mary Elizabeth Blue Hull Memorial Presbyterian Church, 393 U.S. 440, 449, 89 S.Ct. 601, 606, 21 L.Ed.2d 658 (1969) (citation omitted); see *Serbian E. Orthodox Diocese v. Milivojevic*, 426 U.S. 696, 96 S.Ct. 2372, 49 L.Ed.2d 151 (1976). I am convinced that neutral principles of law are applicable to the instant case and may be relied upon to determine whether the plaintiff's copyright and trademarks are valid.

1. Freedom of Religion

a. The Free Exercise Clause

The defendant's desire is to propagate the message of *The URANTIA Book*, and neither the Urantia Foundation nor this court can constitutionally prohibit that endeavor. The defendant, however, has chosen as one means of accomplishing this task the verbatim copying of the entire text of *The URANTIA Book* coupled with the free distribution of that copied text to all who are interested. In addition, the defendant has used the plaintiff's registered trademarks on various mate-

rials sent along with the distributed text. The defendant attempts to justify her means by pointing to the First Amendment's Free Exercise of Religion Clause.

The Free Exercise Clause absolutely prohibits any governmental attempt to regulate religious beliefs per se. *Cantwell v. Connecticut*, 310 U.S. 296, 303, 60 S.Ct. 900, 903, 84 L.Ed. 1213 (1940).

Government may neither compel affirmation of a repugnant belief; nor penalize or discriminate against individuals or groups because they hold religious views abhorrent to the authorities; nor employ the taxing power to inhibit the dissemination of particular religious views.

Sherbert v. Verner, 374 U.S. 398, 402, 83 S.Ct. 1790, 1793, 10 L.Ed.2d 965 (1963) (citations omitted). The freedom to act, however, even when such action is based upon one's religious convictions, remains tethered to certain legislative restrictions. As the United States Supreme Court declared over fifty years ago:

The religious liberty which the Constitution protects has never excluded legislation of general scope not directed against doctrinal loyalties of particular sects. . . . Conscientious scruples have not, in the course of the long struggle for religious toleration, relieved the individual from obedience to a general law not aimed at the promotion or restriction of religious beliefs. The mere possession of religious convictions which contradict the relevant concerns of a political society does not relieve the citizen from the discharge of political responsibilities.

Minersville Sch. Dist. Bd. of Educ. v. Gobitis, 310 U.S. 586, 594-95, 60 S.Ct. 1010, 1013, 84 L.Ed. 1375 (1940) (footnote omitted).

The copyright and trademark laws are such neutral laws of general applicability to which the defendant must adhere for the betterment of the public good, regardless of her religious convictions to the contrary. Nevertheless, she "admits copying the text of *The Urantia Book* . . . and admits distributing [it] . . . throughout the United States." (Def.'s Answer at 3, ¶ 13.) Furthermore, the defendant "admits to use of the concentric

circles mark and the name Urantia." *Id.* at ¶ 14. Therefore, assuming, as I must, that the plaintiff's copyright and trademarks are valid, I find that the Free Exercise Clause is not a proper defense to the defendant's actions.

b. The Establishment Clause

[4] The First Amendment commands that "Congress shall make no law respecting an establishment of religion." U.S. Const. amend. I. The defendant does not contend that either the copyright or the trademark laws, as written, run afoul of this amendment. Therefore, if the defendant is unable to refute the plaintiff's presumptions of validity concerning the copyright and trademarks at issue, I am satisfied that this court may enforce the aforementioned laws without violating the Constitution. If the plaintiff is found to have a valid copyright or trademark, the enforcement of such cannot be said to be fostering the "establishment" of the Urantia Foundation as a religion. The recognition of copyright or trademark protection for the Urantia Foundation in common with all other entities that comply with statutory formalities "reflects nothing more than the governmental obligation of neutrality in the face of religious differences, and does not represent that involvement of religious with secular institutions which it is the object of the Establishment Clause to forestall." *Sherbert v. Verner*, 374 U.S. 398, 409, 83 S.Ct. 1790, 1797, 10 L.Ed.2d 965 (1963); see *Bridge Pub., Inc. v. Vien*, 827 F.Supp. 629 (S.D.Cal. 1993) (holding the enforcement of valid copyrights violates neither the establishment clause nor the free exercise clause); *United Christian Scientists v. First Church of Christ*, 829 F.2d 1152, 1159 (D.C.Cir.1987) ("Normally, a grant of copyright on a religious work poses no constitutional difficulty."); *Purcell v. Summers*, 145 F.2d 979 (4th Cir.1944) (holding freedom of religion no defense to the misleading and injurious use of trade name).

2. Freedom of Speech

a. The General Rule

[5] The defendant claims that enforcing the plaintiff's copyright and trademarks would violate her right to freedom of speech.

(Def.'s Br. at 2.) The plaintiff, however, is not attempting to prevent the defendant from "spreading the gospel of *The URANTIA Book*." *Id.* at 5. Nor does the plaintiff seek to prohibit the defendant from uttering the word "Urantia," or enjoin the defendant from ever displaying the three blue concentric circles. The plaintiff merely requests that the court protect its property interests in what are presumed to be a valid copyright and trademarks.

The defendant does not dispute that copyrights and trademarks and the right to their exclusive use are property. Therefore, assuming, as I must, the validity of the plaintiff's copyright and trademarks, "[i]t would be an unwarranted infringement of property rights to require them to yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist. Such an accommodation would diminish property rights without significantly enhancing the asserted right of free speech." *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567, 92 S.Ct. 2219, 2228, 33 L.Ed.2d 131 (1972). The alternative avenues of communication available to the defendant are numerous. There are, however, two avenues that must not be ventured down. The defendant may not copy and distribute the text of *The URANTIA Book*, if the copyright is valid, and the defendant may not use the plaintiff's trademarks in a manner that is confusing to the public and injurious to the Urantia Foundation, if the trademarks are valid. "The first amendment is not a license to trammel on legally recognized rights in intellectual property." *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir.1979).

b. The Zapruder Exception

[6] The defendant has gone to great length to convince the court that the instant case calls for the application of a pure First Amendment defense, similar to that which has been hypothesized by Professor Nimmer. See (Def.'s Br. at 11-13.); 1 MELVILLE B. NIMMER & DAVID NIMMER, *Nimmer on Copyright* § 1.10[C][2] (1994) [hereinafter NIMMER]. The defendant offers a list of cases in which other courts although "not faced with

circumstances sufficient to sustain [such] a First Amendment defense have noted the possibility of such a defense." (Def.'s Br. at 12.) I, too, find that such a defense is inapplicable to the facts before me.

Professor Nimmer advocates such a defense in the situation where an entity owns the copyright to a graphic expression of "news," but refuses to disseminate it. NIMMER, *supra*, at 1-89. First, *The URANTIA Book* is not a graphic expression like the film of the Kennedy assassination or the photographs of the My Lai massacre. Second, the contents of *The URANTIA Book* do not fit Professor Nimmer's definition of "news." According to Professor Nimmer, a graphic expression of "news" exists only if the event captured has been the subject of news stories throughout the nation. *Id.* at 1-91. Third, *The URANTIA Book* is not being withheld from the public. The plaintiff suggests there are a quarter million books in print, and assures the court that the book remains "available for sale to the public." (Pl.'s Reply Mem. in Supp. of its Mot. for Partial Summ.J. on First Amendment Defense at 2, 14.) "The fact that the words [with which] the author has chosen to clothe his narrative may of themselves be 'newsworthy' is not an independent justification for unauthorized copying." *Harper & Row, Pub., Inc. v. Nation Enters.*, 471 U.S. 539, 557, 105 S.Ct. 2218, 2229, 85 L.Ed.2d 588 (1985).

B. Reconciliation of an Apparent Conflict

Neither Congress nor the courts have been oblivious to the inevitable conflict between the First Amendment and copyright and trademark law. Under the idea-expression dichotomy "[c]opyright law incorporates First Amendment goals by ensuring that copyright protection extends only to the forms in which ideas and information are expressed and not to the ideas and information themselves." *Los Angeles News Serv. v. Tullio*, 973 F.2d 791, 795 (9th Cir.1992). Furthermore, First Amendment concerns are addressed through the "fair use" doctrine, which recognizes "a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent." *Harper & Row*, 471

U.S. at 549, 105 S.Ct. at 2224 (quoting H. BALL, *Law of Copyright and Literary Property* 260 (1944)).

Trademark law accommodates the First Amendment in a way similar to copyright law. Analogous to the idea-expression dichotomy, a trademark cannot be obtained in generic words or symbols. A word or symbol is generic if it is not an expression that relates exclusively to the potential trademark owner's property. *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 306 (9th Cir.1992); see *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938) (holding the term "shredded wheat" generic and unable to be a trademark). Furthermore, there are numerous statutory defenses in trademark law, including a "fair use" defense. See 15 U.S.C. § 1115(b). The defendant, however, has not chosen to assert any of the recognized defenses, and, instead, relies on a pure First Amendment defense.

I find that the aforementioned principles and defenses adequately serve to accommodate the competing interests of the First Amendment and the laws of copyright and trademark. I do not believe that expansion in this area would be judicially prudent. Consequently, the defendant's proffered First Amendment defense to the plaintiff's claims of copyright and trademark infringement must be rejected.

IT IS THEREFORE ORDERED that the plaintiff's motion for partial summary judgment on the defendant's First Amendment defense, filing 179, is granted.

URANTIA FOUNDATION, Plaintiff,

v.

Kristen MAAHERRA, Defendant.

Civ. No. 91-0325 PHX WKU.

United States District Court,
D. Arizona.

Jan. 27, 1995.

L. Dale Owens and Scott A. Wharton, of Booth, Wade & Campbell, Atlanta, GA, for plaintiff.

Joseph D. Lewis, of Cleary & Komen, Washington, DC, for defendant.

MEMORANDUM AND ORDER ON
PLAINTIFF'S MOTION FOR PARTIAL
SUMMARY JUDGMENT

URBOM, Senior District Judge.

This cause is before the court on the plaintiff's motion for partial summary judgment pursuant to Rule 56(d) of the Federal Rules of Civil Procedure. The plaintiff, Urantia Foundation, asserts that the Religious Freedom Restoration Act of 1993 ("RFRA"), 42 U.S.C. §§ 2000bb-2000bb-4 (Supp. V 1993) is not applicable to the instant case and does not afford the defendant, Kristen Maaherra, a proper basis for an affirmative defense.

I. FACTUAL BACKGROUND

The plaintiff initially brought this action to enjoin the defendant from, among other things, infringing upon its copyright to *The Urantia Book* and infringing upon its registered trademarks to the name "Urantia" and the three concentric circles associated with the Urantia Foundation. The defendant seeks to avoid the plaintiff's claims in part by relying on the RFRA as a defense. In particular, the defendant states that the court's enforcement of either the copyright or trademarks "would substantially burden Defendant's exercise of her religion in violation of the [RFRA]." ((Revised) Def.'s Substitute 2nd Am. Answer & Countercl. at 5, ¶3.)

II. STANDARD OF REVIEW

The standard applied to a motion for partial summary judgment is identical to the standard applied to adjudicate a case fully by summary judgment. The motion shall be granted when, viewing the facts and reasonable inferences in the light most favorable to the nonmoving party, "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." FED.R.CIV.P. 56(c); *Calnetics Corp. v. Volkswagen of Am., Inc.*, 532 F.2d 674, 683 (9th Cir.), cert. denied, 429 U.S.

940, 97 S.Ct. 355, 50 L.Ed.2d 309 (1976). A genuine issue of material fact exists when there is sufficient evidence favoring the non-moving party for a jury to return a verdict for that party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249, 106 S.Ct. 2505, 2510-11, 91 L.Ed.2d 202 (1986) (citing *First Nat. Bank of Arizona v. Cities Serv. Co.*, 391 U.S. 253, 88 S.Ct. 1575, 20 L.Ed.2d 569 (1968)). If the moving party meets the initial burden of establishing the nonexistence of a genuine issue, then the burden shifts to the opposing party to produce evidence of the existence of a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548, 2552, 91 L.Ed.2d 265 (1986). "If the evidence is merely colorable or is not significantly probative, summary judgment may be granted." *Anderson*, 477 U.S. at 249-50, 106 S.Ct. at 2511 (citations omitted).

III. LEGAL DISCUSSION

Congress enacted the RFRA for three very specific purposes: "to restore the compelling interest test . . . to guarantee its application in all cases where free exercise of religion is substantially burdened; and . . . to provide a claim or defense to persons whose religious exercise is substantially burdened by government." 42 U.S.C. § 2000bb(b). Furthermore, it is undeniable that the RFRA "applies to all Federal and State law, and the implementation of that law, whether statutory or otherwise." 42 U.S.C. § 2000bb-3(a). Therefore, I would have no recourse but to adhere to the RFRA and apply the compelling interest test if the defendant requested relief from a federal or state law that substantially burdened her exercise of religion. That, however, is not the situation before me.

[1] The defendant admits that she "does not seek any affirmative relief under this Act." (Def.'s Mem. in Opp'n to Pl.'s Mot. for Partial Summ. J. on RFRA Defense at 18.) Pursuant to the RFRA, the only judicial relief authorized allows "[a] person whose religious exercise has been burdened in violation of this section [to] assert that violation as a claim or defense in a judicial proceeding and obtain appropriate relief against a government." 42 U.S.C. § 2000bb-1(c) (emphasis added). I interpret this language to

mean that if a court finds that a person's free exercise of religion has been substantially burdened by a federal or state law and the government fails to demonstrate that the burden "is in furtherance of a compelling governmental interest; and . . . is the least restrictive means of furthering that compelling governmental interest," 42 U.S.C. § 2000bb-1(b), then the court must either rule that the law is unconstitutional *in toto*, or grant an exemption from the law because the law, as applied to the aforementioned individual, is unconstitutional. See, e.g., *Murdock v. Pennsylvania*, 319 U.S. 105, 63 S.Ct. 870, 87 L.Ed. 1292 (1943) (holding municipal ordinance unconstitutional which, in application, required religious colporteurs to pay a tax in order to pursue their religious convictions); *Sherbert v. Verner*, 374 U.S. 398, 83 S.Ct. 1790, 10 L.Ed.2d 965 (1963) (holding South Carolina may not constitutionally apply the eligibility provisions of its unemployment compensation law so as to coerce a worker to abandon religious convictions); *Wisconsin v. Yoder*, 406 U.S. 205, 92 S.Ct. 1526, 32 L.Ed.2d 15 (1972) (holding Old Order Amish are exempt from Wisconsin's compulsory school-attendance laws because adherence would compel the abandonment of religious beliefs).

[2] The defendant, however, does not contend that the copyright and trademark laws of the United States are unconstitutional, or that the laws are unconstitutional as applied to her. Moreover, she "does not dispute that religious organizations can hold valid copyrights, or that works on the subject of religion can be the subject of a valid copyright." (Def.'s Mem. in Opp'n to Pl.'s Mot. for Partial Summ. J. on RFRA Defense at 1-2.) Furthermore, she correctly states that the RFRA "makes clear that enforcement of a law of general applicability, such as the trademark or copyright laws, must further a compelling governmental interest." *Id.* at 18 (citing 42 U.S.C. § 2000bb-1(b)); see also 42 U.S.C. § 2000bb(a)(2). However, I sincerely doubt that the defendant would disagree with the proposition that courts further a compelling governmental interest by enforcing laws that are constitutional. Yet, even though the defendant does not question

the constitutionality of the copyright and trademark laws, she contends that in the instant case they should not be enforced. She bases her position on the contention that enforcement would not further a *compelling* governmental interest or "[e]ven the *usual* governmental interests." *Id.* (emphasis added).

If there is any doubt as to the constitutionality of the copyright or trademark laws, either as written or as applied, the government should be notified and put to the task of proving that the laws and their enforcement do, in fact, further a compelling governmental interest in the least restrictive manner.¹ The defendant, however, suggests that it is the Urantia Foundation that has the burden of establishing that the protection of *The Urantia Book* and the mark of three concentric circles under the copyright and trademark laws serves a compelling governmental interest. *Id.* at 19. I disagree. It is the government as creator of laws that must act as their defender if their validity is questioned. In the absence of any argument that the copyright and trademark laws are unconstitutional, I find that the RFRA is inapplicable to the instant case.

IT IS THEREFORE ORDERED that the plaintiff's motion for partial summary judgment on the Religious Freedom Restoration Act of 1993 defense, filing 185, is granted.

URANTIA FOUNDATION, Plaintiff,

v.

Kristen MAAHERRA, Defendant.

Civ. No. 91-0325 PHX WKU.

United States District Court,
D. Arizona.

Feb. 3, 1995.

L. Dale Owens and Scott A. Wharton, of Booth, Wade & Campbell, Atlanta, GA, for Urantia Foundation.

Joseph D. Lewis of Cleary & Komen, Washington, DC, for Kristen Maaherra.

MEMORANDUM AND ORDER ON MOTION FOR PARTIAL SUMMARY JUDGMENT ON DEFENDANT'S SECTION 102 COUNTERCLAIM

URBOM, Senior District Judge.

The plaintiff's motion for partial summary judgment on defendant's section 102 counterclaim is aimed at paragraph 96 of the (Revised) Defendant's Substitute Second Amended Answer and Counterclaim. That paragraph states:

"17 U.S.C. 102 lists works of authorship as a) literary works, b) musical works, including accompanying word [sic], c) dramatic works, including any accompanying music, d) pantomimes and choreographic works, e) pictorial, graphic and sculptural works, f) motion pictures and other audiovisual works, and g) sound recordings.

an Act of Congress affecting the public interest is drawn in question." *Id.*

1. 28 U.S.C. § 2403(a) (1988) requires the court to give notice to the Attorney General and allow intervention whenever "the constitutionality of

The *Urantia Book*, published, promoted and disseminated as a divine revelation, does not meet the requirements of any of these categories. Plaintiff attempted to circumvent this requirement when it stated it was the author of *The Urantia Book* in its applications for copyright registration to the Library of Congress."

The plaintiff's position is that the book is within the category "literary works." On the other hand, the defendant argues that:

"To meet the requirements of section 102, a work must be the result of independent creation and must have a modicum of creativity. *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.* [499 U.S. 340, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991)]. The Foundation cannot meet these requirements since it did not create the text of *The Urantia Book*. The text originated with the spiritual entities described in the book such as the Divine Counselor, the Chief of the Corps of Superuniverse Personalities, and the Chief of the Archangels of Nebadon. Thus, the text of *The Urantia Book* was neither original to the Foundation, nor was it the effort of any human creativity."

Defendant's Brief in Opposition to "Plaintiff's Motion for Partial Summary Judgment on Defendant's Section 102 Counterclaim," pp. 2-3.

I find that the uncontroverted evidence is that *The Urantia Book* is a "literary work." The work itself "possesses at least some minimal degree of creativity," as required by *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345, 111 S.Ct. 1282, 1287, 113 L.Ed.2d 358 (1991). There is no hint that the work was not "independently created by the author (as opposed to copied from other works)," within the meaning of *Feist Publications Inc., supra*. It is not necessary that the Foundation have created the text of the book. Title 17, section 409(5) clearly anticipates that a copyright may be held by one who is not the author.

Nor is it necessary that the authorship stem from human effort. Whether *The Urantia Book* is a divine revelation dictated by divine beings is a matter of faith, not of proof in a court of law. As a judge, I cannot—I

must not—declare for anyone the truth or nontruth of an article of faith. If I were to declare *The Urantia Book* to be a divine revelation dictated by divine beings, I would be trampling upon someone's religious faith. If I declared the opposite, I would be trampling upon someone else's religious faith. I shall do neither. Whether *The Urantia Book* is a divine revelation dictated by divine beings is irrelevant to the issue of whether the book is a literary work within the meaning of 17 U.S.C. § 102.

The foregoing conclusions essentially end the life of paragraph 96 of Count II of the (Revised) Defendant's Substitute Second Amended Answer and Counterclaim. While Count II is labeled "FRAUDULENT AND DECEPTIVE PRACTICES, VIOLATION OF TRUST, AND COPYRIGHT MISUSE," paragraph 96 is premised upon the idea that because *The Urantia Book* was not a work of authorship, the plaintiff "attempted to circumvent" the requirement that it be a work of authorship "when it stated it was the author of *The Urantia Book* in its applications for copyright registration to the Library of Congress." Inasmuch as the book is a literary work and therefore a work of authorship, any "attempt to circumvent" is without significance.

IT IS ORDERED that the plaintiff's motion for partial summary judgment on defendant's section 102 counterclaim, filing 193, is granted.

URANTIA FOUNDATION, Plaintiff,

v.

Kristen MAAHERRA, Defendant.

Civ. No. 91-0325 PHX WKU.

United States District Court,
D. Arizona.

Feb. 27, 1995.

MEMORANDUM AND ORDER ON
PLAINTIFF'S MOTION FOR PAR-
TIAL SUMMARY JUDGMENT ON
TRADEMARK ISSUES

URBOM, Senior District Judge.

This cause is before me on the plaintiff's motion for partial summary judgment pursuant to Rule 56(d) of the Federal Rules of Civil Procedure. The plaintiff, Urantia Foundation, alleges that the defendant, Kristen Maaherra, has infringed two of its registered trademarks. The defendant denies the allegation of infringement and contends that the plaintiff's marks are generic and were obtained fraudulently. Upon review of the record, I find that the plaintiff's motion shall be granted in part and denied in part.

I. FACTUAL BACKGROUND

The Urantia Foundation was created in 1950 with an objective of educating the peoples of the world in an attempt to increase and enhance their comfort, happiness, and well being. The plaintiff employs various means to accomplish this goal, one of which is the sale of *The URANTIA Book*¹ and related publications. In 1971, the plaintiff registered "URANTIA" and the symbol of three blue concentric circles as trademarks² for books manufactured, printed, or distributed by the Urantia Foundation. (Pl.'s Compl. at Exs. C, D.) In 1979, the plaintiff expanded its trademark protection to include printed publications in general. *Id.* at E, F.

The defendant has been an avid reader of *The URANTIA Book* since 1969, and "[o]ver the years, she has given away many study aids for [the book]." (Def.'s Statement of Facts in Opp'n to Pl.'s Mot. for Partial Summ.J on Trademark Issues ¶ 29.) [hereinafter Def.'s Facts]. In 1990, the defendant prepared a study aid that included the text of *The URANTIA Book*. (Def.'s Facts ¶ 31.) Thereafter, the defendant distributed the

L. Dale Owens and Scott A. Wharton, of Booth, Wade & Campbell, Atlanta, GA, for plaintiff and counter-defendant, Urantia Foundation.

Joseph D. Lewis, of Cleary & Komen, Washington, DC, for defendant and counter-claimant, Kristen Maaherra.

1. In my Memorandum and Order dated February 10, 1995, 895 F.Supp. 1347, I found that the copyright renewal in the book was invalid and the book had therefore entered the public domain.

2. The term "trademark" is defined as "any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods." 15 U.S.C. § 1127 (1988).

aforementioned study aid to various individuals free of charge. *Id.* ¶ 32.

In September, 1990, the Urantia Foundation was notified that an unidentified source was distributing computer disks that contained the entire text of *The URANTIA Book*. (Second Aff. of Wharton Ex. A, ¶ 16.) In November, 1990, the plaintiff discovered a second set of computer disks that not only contained the entire text of *The URANTIA Book* but bore the plaintiff's trademarks: "URANTIA" and the symbol of three blue concentric circles. *Id.* ¶ 22. In January, 1991, the plaintiff surmised that the defendant was the source of the computer disks and, shortly thereafter, filed the instant action against her. The defendant admits she had full knowledge of the plaintiff's use and registration of its trademarks when she distributed the computer disks but denies that her actions constitute infringement. ((Revised) Def.'s Substitute 2nd Am. Answer and Countercl. for Cancellation of Federal Trademark Registrations at 4, ¶¶ 24-25.) [hereinafter Def.'s Answer].

II. STANDARD OF REVIEW

A motion for summary judgment is properly granted if the pleadings and evidence submitted in support of the motion show that "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c); *Calnetics Corp. v. Volkswagen of Am., Inc.*, 532 F.2d 674, 683 n. 11 (9th Cir.), cert. denied, 429 U.S. 940, 97 S.Ct. 355, 50 L.Ed.2d 309 (1976). The moving party has the burden of demonstrating the absence of a genuine issue of material fact. *Blair Foods, Inc. v. Ranchers Cotton Oil*, 610 F.2d 665, 668 (9th Cir.1980). A genuine issue of material fact exists when there is sufficient evidence favoring the party opposing the motion for a jury to return a verdict for that party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986); *First Nat. Bank of Arizona v. Citicorp Serv. Co.*, 391 U.S. 253, 288-89, 88 S.Ct. 1575, 1592-93, 20 L.Ed.2d 569 (1968). If the mov-

ing party meets its initial burden, then the burden shifts to the opposing party to produce evidence of the existence of a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). In deciding a motion for summary judgment, all evidence is considered in a light most favorable to the party opposing the motion. *Blair Foods*, 610 F.2d at 668 (citations omitted). "If the evidence is merely colorable or is not significantly probative, summary judgment may be granted." *Anderson*, 477 U.S. at 249-50, 106 S.Ct. at 2510-11 (citations omitted).

III. LEGAL DISCUSSION

Trademark Claim

The plaintiff brings this action pursuant to the Trademark Act of 1946.³ Section 1114 of the Act requires that the plaintiff in a trademark infringement action show that the defendant (1) without consent, (2) used in commerce, (3) a reproduction, copy or colorable imitation of the plaintiff's registered mark in connection with a sale or distribution of goods or services, and (4) that such a use is likely to cause confusion. See 15 U.S.C. § 1114(1)(a) (1988); *Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 1075 (2d Cir.1993); *Kelley Blue Book v. Carsmarts, Inc.*, 802 F.Supp. 278, 284 (C.D.Cal. 1992). Ms. Maaherra admits that she did not have the plaintiff's consent to reproduce exact copies of the plaintiff's marks on her computer disks before she distributed the disks throughout the United States. (Def.'s Answer at 3-4, ¶¶ 13, 25-27.) Therefore, to prevail on its claim of trademark infringement, the plaintiff must overcome only two obstacles. The plaintiff must prove that it has a valid mark entitled to protection and that the defendant's use of the mark is likely to cause confusion in the minds of the public.

1. Trademark Validity

a. Certificates as Evidence

[1] The defendant admits that the plaintiff has obtained trademark registration certificates for both "URANTIA" and the sym-

& Supp. V 1993).

3. The Trademark (Lanham) Act, ch. 540, 60 Stat. 427, as amended, 15 U.S.C. §§ 1051-1127 (1988

bol of three blue concentric circles. (Def.'s Answer at 3, ¶ 10.) "Federal registration of a trademark endows it with a strong presumption of validity." *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 (9th Cir. 1982) (citing *Miss Universe, Inc. v. Patricelli*, 408 F.2d 506, 509 (2d Cir.1969)); accord *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 196, 105 S.Ct. 658, 662-63, 83 L.Ed.2d 582 (1985) (citation omitted); see 15 U.S.C. § 1057(b) (1988). In addition to being *prima facie* evidence of the registered mark's validity, the certificates of registration are *prima facie* evidence of the registrant's ownership of the mark and the registrant's exclusive right to use the mark. *Pacific Telesis Group v. International Telesis Communications*, 795 F.Supp. 979, 982 (C.D.Cal.1991), *aff'd*, 994 F.2d 1364 (9th Cir. 1993). The defendant attempts to rebut this presumption by claiming that the plaintiff's trademarks are generic and were obtained fraudulently. The plaintiff responds by arguing that its trademarks are incontestable.

b. Presumption of Incontestability

[2] The plaintiff claims that "since the Foundation's marks all have been registered and continuously used for more than five years ... they have become *incontestable*." (Br. in Support of Pl.'s Mot. for Partial Summ. [J.] on Trademark Issues at 4.) [hereinafter Pl.'s Br.]. However, before a registered mark may be deemed incontestable "an affidavit [shall be] filed with the Commissioner within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration." 15 U.S.C. § 1065(3) (1988). No such affidavit is in the record.

Moreover, whether the plaintiff's marks have acquired incontestable status is relatively unimportant. The defendant alleges the defenses of genericness, fraud, and "no likelihood of confusion." Each of these allegations, if proven, overcomes a mark's incontestable status. See 15 U.S.C. § 1065(4) (1988) ("[N]o incontestable right shall be acquired in a mark which is ... generic."); 15

U.S.C. § 1115(b)(1) (1988) (declaring incontestability subject to a defense of fraud); *Gruner*, 991 F.2d at 1078 (explaining Trademark Law Revision Act of 1988 "made clear that incontestability does not relieve the trademark owner from the requirement of proving likelihood of confusion").

c. The Fraud Defense

[3] The defendant claims that the plaintiff engaged in "fraudulent activities in obtaining federal trademark registrations of the concentric circles symbol and the names Urantia and Urantian." (Def.'s Answer at 5, ¶ 4.) The alleged fraudulent activities include the plaintiff's failure to disclose to the United States Patent and Trademark Office the possible religious significance of the plaintiff's marks. *Id.* at 20-21. However, "[n]othing in the Constitution prohibits a religious organization from owning property—and a trademark is a property right." *National Bd. of YWCA v. YWCA of Charleston*, 335 F.Supp. 615, 625 (D.S.C.1971).

In support of her claim, the defendant offers numerous broad and unsubstantiated allegations but only one piece of evidence, a letter from a Trademark Examiner. See (Def.'s Facts at App. 1A.) The letter addresses the inconsistencies in the plaintiff's application to register a mark identified by Serial No. 398,004. The trademarks at issue are identified by Serial Nos. 157,177; 157,234; 372,049; and 372,050. See (Pl.'s Compl. at Exs. C-F.) Therefore, any statements made by the plaintiff that prompted the letter or were in response to the letter is not shown to have been a deliberate attempt to mislead the Patent and Trademark Office into registering the trademarks at issue. See *Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1444 (9th Cir.1990) (describing elements of successful fraud claim); *Official Airline Guides, Inc. v. Churchfield Publications, Inc.*, 756 F.Supp. 1393, 1399-400 (D.Or.1990) (holding *scienter* required to prevail on fraud claim), *aff'd sub nom.*, *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385 (9th Cir. 1993). Accordingly, I find no merit in the defendant's allegation of fraud.

4. Trademark Law Revision Act of 1988, Pub.L. No. 100-667, 102 Stat. 3946 (codified as amend-

ed in scattered sections of 15 U.S.C.).

d. The Genericness Defense

[4] "The general presumption of validity resulting from federal registration includes the specific presumption that the trademark is not generic." *Coca-Cola*, 692 F.2d at 1254. Furthermore, the plaintiff is entitled to benefit from any relevant presumptions that support its motion for summary judgment. *Id.* (citing *United States v. General Motors Corp.*, 518 F.2d 420, 441-42 (D.C.Cir.1975)). Therefore, the plaintiff, relying on the aforementioned presumptions, has met its burden of demonstrating that the genericness of its trademarks does not raise a genuine issue of material fact.

The defendant attempts to rebut the plaintiff's presumption against genericness by misrepresenting cases and selectively quoting statutes. Section 1064 of the Lanham Act states in pertinent part:

A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become . . . generic.

15 U.S.C. § 1064(3) (1988). The defendant argues that it is impossible to convey the principles espoused in *The URANTIA Book* without using "URANTIA" or the symbol of three blue concentric circles. (Def.'s Answer at 19.) As the first sentence quoted above clearly indicates, a mark does not become generic simply because it identifies a unique product.

The defendant correctly states that the "relevant public" for determining genericness is "the pool of potential purchasers of Urantia books." (Def.'s Br. at 8.) She then inappropriately drains the pool of all but the established "adherents to the Urantia teachings." *Id.* The pool, however, must include all potential purchasers: the avid, the novice, and the not yet acquainted. *See, e.g., Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 718 F.2d 327, 330 (9th Cir.1983) (holding relevant public includes not only business operators and participants but also consumers at large), *rev'd on other grounds*, 469

U.S. 189, 105 S.Ct. 658, 83 L.Ed.2d 582 (1985); *Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1017 (9th Cir.1979) (finding relevant public includes both medical community and potential patients); *Berner Int'l Corp. v. Mars Sales Co.*, 987 F.2d 975, 983 (3d Cir.1993) (holding relevant public for "air curtain" includes manufacturers, architects, construction companies, building managers, and others); *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir.1989) (finding substantial majority of public considers "Murphy bed" to be generic); *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 640 (Fed.Cir. 1991) (defining relevant public as "public which does or may purchase the goods"); *see also* S.Rep. No. 627, 98th Cong., 2d Sess. 2-4 (1984), U.S.Code Cong. & Admin.News 1984, p. 5708 (explaining relevant public includes both actual and potential purchasers of goods).

The defendant makes the bold statement that "[t]he evidence of dictionaries that do not contain the word Urantia is completely irrelevant." (Def.'s Br. at 9.) It strains my imagination to think of a product name "that over time the public adopted, or, rather, appropriated, . . . as a synonym for any [product of that genus]." *Murphy Bed*, 874 F.2d at 101, but which does not appear in any known dictionary. "There is no real issue as to the generic nature of the words Urantia and Urantian." (Def.'s Br. at 9.) "The plain fact is that the public at large has no awareness of either the word[s] or symbol." *Id.* at 9 n. 7.

Although "URANTIA" and the symbol of three blue concentric circles may be considered generic by a segment of the public that has previously purchased *The URANTIA Book*, the segment is but a fraction of the relevant public. Therefore, I find insufficient evidence to support the defendant's defense of genericness. Hence, I find that the plaintiff has overcome the first obstacle to proving infringement by showing its trademarks to be valid.

2. Likelihood of Confusion

a. The Eight Factors

[5-7] Proving one has a valid trademark entitled to protection is rather elementary

when compared to the task of proving that another's use of the trademark is likely to cause confusion to consumers. To conclude that a likelihood of confusion exists, the evidence must show "that numerous ordinary prudent purchasers are likely to be misled or confused as to the source of the product in question because of the entrance in the marketplace of defendant's [use of the] mark." *Gruner*, 991 F.2d at 1077; accord *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 443 (9th Cir.1980). At the time of the alleged infringement, the Urantia Foundation did not have a product that was comparable to the defendant's computer disks. Therefore, the plaintiff's product, *The URANTIA Book*, and the defendant's product, a computerized version thereof with a concordance, are considered to be "related goods"⁵ not "competitive goods."⁶ To determine whether a likelihood of confusion exists between related goods, the following eight factors are evaluated:

- i. strength of the plaintiff's mark;
- ii. proximity of the goods;
- iii. similarity of the marks;
- iv. evidence of actual confusion;
- v. marketing channels employed;
- vi. type of goods and degree of care likely to be exercised by the purchaser;
- vii. defendant's intent in selecting the mark; and
- viii. likelihood of expansion in the product lines.

AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir.1979). The eight factors, however, are not exhaustive, and if the case warrants, other variables may be considered. *Id.* at 348 n. 11 (citations omitted).

i. strength of mark

[8] The strength of a mark and the degree of protection it will be afforded are determined by the mark's distinctiveness. There are four categories of distinctiveness: generic, descriptive, suggestive, and arbitrary or fanciful.

5. Related goods are those goods that would be reasonably perceived by the consuming public to have come from the same source if sold under the same trademark. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 n. 10 (9th Cir.1979).

As discussed, the plaintiff's trademarks are not generic. Therefore, they must fall into one of the three remaining categories. The plaintiff's product is a book; its trademarks are "URANTIA" and the symbol of three blue concentric circles. Neither trademark, in and of itself, describes or suggests a book, nor is there any evidence that "URANTIA" is a word in any known language. Furthermore, the defendant admits that each of the marks is derived solely from *The URANTIA Book*. (Def.'s Answer at 10-11, ¶¶ 38, 42.) "A fanciful mark is a name that is made-up to identify the trademark owner's product like EXXON for oil products and KODAK for photography products." *Gruner*, 991 F.2d at 1076; see also *Pacific Telesis*, 795 F.Supp. at 981-82 (finding "TELESIS does not describe any characteristics, functions, uses or qualities of telecommunications services. As applied to such services, it is arbitrary.").

Whether the plaintiff's marks are considered "arbitrary" or "fanciful" is of little importance, because under either label they are deemed to be a strong mark, and "will be afforded the widest ambit of protection from infringing uses." *AMF*, 599 F.2d at 349.

ii. proximity of the goods

[9] "For related goods, the danger presented is that the public will mistakenly assume there is an association between the producers of the related goods, though no such association exists." *Id.* at 350. In discussing the proximity of the goods, it is not the physical distance between the goods which is evaluated but how closely the goods approximate each other. The use and function of the two products at issue are similar; using either, a consumer would be able to read the entire Urantia book. Apart from the mode of conveyance, the only significant difference in the two products is the inclusion of a concordance with the defendant's product. These differences, however, do not dissuade me from finding that the two products

6. An alleged infringer's goods will be deemed "competitive goods" when they directly compete for sales with the trademark owner's goods. *Id.* at 348.

approximate each other. See *Russell Chem. Co. v. Wyandotte Chems. Corp.*, 337 F.2d 660, 661 (C.C.P.A.1964) (holding when marks are nearly identical, products must be substantially different for confusion to be unlikely).

iii. similarity of marks

The defendant admits she used "URANTIA" and describes her reproductions of the plaintiff's symbol of three blue concentric circles as "exact replications or as near thereto as practicable." (Def.'s Answer at 4, ¶26.) Consequently, I find that the two marks are not only similar but identical.

iv. actual confusion

[10] "Evidence that use of the two marks has already led to confusion is persuasive proof that future confusion is likely." *AMF*, 599 F.2d at 352 (citing *Plough, Inc. v. Kreis Laboratories*, 314 F.2d 635, 639 (9th Cir. 1963)). The plaintiff relies on two letters, written by consumers who had allegedly received the defendant's product, to support its claim of actual confusion. (Third Aff. of Bondi at Ex. C.) The plaintiff, however, does not show that the computer disks to which the aforementioned letters refer originated with the defendant. I find that the existence of only two letters after allegedly five years of infringement is not sufficient proof of actual confusion to weigh this factor in favor of the plaintiff.

v. marketing channels

[11] If convergent marketing channels are employed in the distribution of related products, an increased likelihood of confusion may result. There is scant evidence of such a situation in the instant case. "The Foundation generally offers *The URANTIA Book* to the general public through retail bookstores." (Third Aff. of Bondi at 2, ¶3.) In 1994, ninety-six percent of all the English language books sold by the plaintiff were sold to bookstores for resale to the public. *Id.* ¶4. The plaintiff also uses other marketing channels typically associated with book distribution: advertisements, conventions, and book fairs. *Id.* at 3, ¶5. The defendant, however, is alleged to have distributed free of charge a limited number of computer disks to individuals who had not even solicited the product.

(Second Aff. of Wharton Ex. A at 8-9, ¶22.) I find that the marketing channels do not converge and, therefore, this factor weighs in favor of the defendant.

vi. type of goods and degree of care

If a purchaser has expertise in the field in which the goods fall, or if the goods are expensive or of a highly technical nature, then it is more likely that the purchaser will exercise a higher degree of care in choosing the product. Consequently, the more care one uses in selecting a product, the less likely one is to confuse it with another product. See *AMF*, 599 F.2d at 353. But see *Omega Importing Corp. v. Petri-Kine Camera Co.*, 451 F.2d 1190, 1195 (2d Cir.1971) (warning against undue reliance on "supposed sophistication" of consumers). The plaintiff's book is neither expensive nor highly technical, and its purchasers are not generally bibliophiles. These facts tend to support a finding that confusion is likely.

[12] However, at least two facts weigh in the defendant's favor. First, the manner in which the consumers received the defendant's product may have prompted increased suspicion as to its origin and authenticity. Usually, a publisher does not give away its product, especially when the product is a two thousand page book. Second, the plaintiff states that a comparison of the two products revealed only "minor differences." (Second Aff. of Wharton Ex. A at 15, ¶39.) If the differences had been substantial, they may have fostered doubt as to the product's legitimacy, but they were simply "typographical errors, resulting in some missing punctuation and extra space, and the absence of any use of italics." *Id.* at 8, ¶20.

Courts have adopted two separate approaches to evaluate the significance of the quality of a second comer's product. A product of inferior quality is more likely to injure the trademark owner's reputation, if confusion occurs. Conversely, a product of equal quality may be more apt to promote confusion because consumers are more inclined to assume that similar products come from the same source. *Nikon Inc. v. Ikon Corp.*, 987 F.2d 91, 95 (2d Cir.1993) (citation omitted).

I shall adhere to the rationale set forth in *Nikon* and conclude that "unless the junior's product is inferior, the quality factor does not weigh in favor of the senior user." *Id.* Moreover, I find that the "minor differences" in the defendant's product do not render it inferior.

The evidence shows that the recipients of the computer disks were no more likely to exercise a high degree of care in retaining the defendant's product than they were a low degree of care. The factor is therefore neutral.

vii. defendant's intent

[13, 14] The plaintiff claims that "Maaherra's admission that she used exact copies of the Foundation's marks with knowledge of the Foundation's use and registration creates a presumption of intentional infringement." (Pl.'s Br. at 4.) The plaintiff's claim, however, is an overstatement. More accurately stated, a presumption of intentional infringement arises when one party deliberately adopts another's trademark "to obtain advantage from the other's good will." *Academy of Motion Picture Arts & Sci. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir.1991) (citing *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 157-58 (9th Cir.), cert. denied, 374 U.S. 830, 83 S.Ct. 1870, 10 L.Ed.2d 1053 (1963)); accord *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 791 n. 2 (9th Cir.1981) (explaining it would be error to recognize presumption absent a showing of defendant's intent to "profit by confusing consumers"); *Kelley Blue Book*, 802 F.Supp. at 287 (raising presumption upon the showing of defendant's intent to capitalize on plaintiff's reputation); *Pacific Telesis*, 795 F.Supp. at 982 (finding defendant selected "TELESIS with the intent to benefit from the [plaintiff's] goodwill and reputation").

There is no evidence to suggest that the defendant reproduced the plaintiff's marks with an intent to capitalize on the Foundation's reputation. In the absence of showing such an intent, I find this factor to weigh heavily in the defendant's favor.

viii. likelihood of expansion

"[A] 'strong possibility' that either party may expand [its] business to compete with the other will weigh in favor of finding that the present use is infringing." *AMF*, 599 F.2d at 354 (citation omitted). The defendant does not refute the plaintiff's contention that it "has devoted substantial money and effort to the preparation of an electronic text and concordance of *The URANTIA Book*" (Second Aff. of Wharton Ex. A at 2, ¶4.) Moreover, the plaintiff admits she knew of the plaintiff's plans. (*Maaherra Dep.* (3-10-91) at 77-78.) Therefore, I find this factor to weigh in favor of the plaintiff.

b. Balancing the Factors

[15] The first three factors weigh in the plaintiff's favor, as does the last. The defendant, however, has three factors that weigh in her favor. More important, the plaintiff does not prove a likelihood of confusion simply by garnering the benefit of a majority of the factors evaluated.

A trademark is, of course, a form of business property. But the 'property right' or protection accorded a trademark owner can only be understood in the context of trademark law and its purposes. A trademark owner has a property right only insofar as is necessary to prevent consumer confusion as to who produced the goods and to facilitate differentiation of the trademark owner's goods.

International Order of Job's Daughters v. Lindeburg & Co., 633 F.2d 912, 919 (9th Cir.1980), cert. denied, 452 U.S. 941, 101 S.Ct. 3086, 69 L.Ed.2d 956 (1981). Ultimately, I am not convinced that a reasonable jury could not return a verdict in favor of the defendant based upon a finding of "no likelihood of confusion."

IT IS THEREFORE ORDERED that the plaintiff's motion for summary judgment, filing 197, is granted as to Count IV of the defendant's counterclaim and as to the defense of genericness and otherwise is denied.

URANTIA FOUNDATION, Plaintiff,

v.

Kristen MAAHERRA, Defendant.

Civ. No. 91-0325 PHX WKU.

United States District Court,
D. Arizona.

Feb. 10, 1995.

L. Dale Owens and Scott A. Wharton of Booth, Wade & Campbell, Atlanta, GA, for plaintiff and counter-defendant, Urantia Foundation.

Joseph D. Lewis of Cleary & Komen, Washington, DC, for defendant and counter-claimant, Kristen Maaherra.

MEMORANDUM AND ORDER ON DEFENDANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT ON COUNT I FOR COPYRIGHT INFRINGEMENT

URBOM, Senior District Judge.

This cause is before me on the Defendant's motion for partial summary judgment pursu-

ant to Rule 56(d) of the Federal Rules of Civil Procedure. The defendant, Kristen Maaherra, asserts that the plaintiff's copyright in *The URANTIA Book* is invalid and thus her copying of the book's text¹ is not prohibited.

I. FACTUAL BACKGROUND

The plaintiff, Urantia Foundation, brought this action in part to enjoin the defendant from infringing its copyright to *The URANTIA Book*. The defendant essentially admits the actions alleged by the plaintiff, but contends that the plaintiff's copyright renewal in the book is invalid. Consequently, the defendant asserts a counterclaim for declaratory judgment and requests that the plaintiff's copyright renewal in *The URANTIA Book* be declared void. The motion for summary judgment is to be decided under the copyright law as it existed under the Copyright Act of 1909.²

The genesis of the instant case can be traced back nearly a century. Early in the twentieth century a Chicago physician by the name of William S. Sadler, Sr. was confronted by an individual with extraordinary talents. This individual became a patient of Dr. Sadler's and was studied by him for over eighteen years. During this time the patient communicated numerous and sundry messages, initially to Dr. Sadler and, later, to a small group. The court believes Dr. Sadler made reference to these messages in the appendix to a book he wrote in 1929.³

The communications which have been written, or which we have had the opportunity to hear spoken, are made by a vast order of alleged beings who claim to come from

other planets to visit this world, to stop here as student visitors for study and observation when they are en route from one universe to another or from one planet to another. These communications further arise in alleged spiritual beings who purport to have been assigned to this planet for duties of various sorts.

(Def.'s Reply Br. in Supp. of Def.'s Mot. for Partial Summ. J.App. III at 383.) Dr. Sadler concluded the aforementioned appendix by stating, "Our investigations are being continued and . . . I hope some time in the near future to secure permission for the more complete reporting of the phenomena connected with this interesting case." *Id.* at 384.

There is no proof that the patient Dr. Sadler mentioned in his book is the "Contact Personality" to which the parties in the instant case refer; nor is it of particular importance in deciding the motion currently before me. I quote the passage simply because it depicts the generally agreed upon events that help to explain the origin of the "Urantia Papers."

As the "Urantia Papers" came into existence through the Contact Personality, Dr. Sadler and his initial followers⁴ assumed certain responsibilities. They "work[ed] directly with the contact personality in the production of the text of the Urantia Papers . . . providing feedback and receiving instructions regarding the disposition of the Papers." (Pl.'s Resp. to Def.'s Req. for Admis. at 25-26.) [hereinafter Pl.'s Admis.] Subsequently, a larger group of individuals⁵ was invited to participate in this unique experience.

1. The plaintiff does not allege, nor does the defendant admit, a copying of the introductory portions of *The URANTIA Book*. Both parties agree that these portions, entitled "The Titles of the Papers" and "Contents of the Book," were written by William S. Sadler, Jr. (Pl.'s Statement of Facts at 23.) Furthermore, the issues of whether those portions constitute copyrightable subject matter and whether they are protected by the copyright in the book are not under consideration.

2. Act of March 4, 1909, ch. 320, 35 Stat. 1075. Throughout this memorandum, the text refers to this law as the 1909 Act. The citation is 17 U.S.C. § 1 (1976).

3. William S. Sadler, *The Mind at Mischief: Tricks and Deceptions of the Subconscious and How to Cope with Them* (1929).

4. It is generally agreed that these initial five or six followers may be referred to as the "Contact Commission."

5. The parties refer to this larger group of individuals as the "Forum." The Forum, however, never worked directly with or knew the identity of the "Contact Personality."

This larger group's role was "to read and study the early drafts of the text of the Urantia Papers, discuss their content, and submit questions about the subject matter." *Id.* at 88. At the end of this complex and arduous process 196 separate papers were procured and became known as the "Urantia Papers."

Although neither party knows the exact date when the 196 distinct "Urantia Papers" were compiled and became *The URANTIA Book*, it is generally believed to have occurred in the mid-1930's. From that time onward Dr. Sadler and other people who were interested in the messages of *The URANTIA Book* would meet at his home and discuss the book. In 1950 the Urantia Foundation was created by an instrument of trust with an objective of educating the peoples of the world in an attempt to increase and enhance their comfort, happiness, and well being.⁶ The foundation was created by and initially included many of the original followers of Dr. Sadler. In 1955 the Urantia Foundation published *The URANTIA Book* and, shortly thereafter, registered its copyright claim with the Copyright Office, as required by federal law. See 17 U.S.C. §§ 10, 11 and 13 (1976). On the application for registration the Urantia Foundation claimed it was the sole author of the book. (Pl.'s Compl. Ex. A at 2.) In 1983 the Urantia Foundation applied for and obtained a renewal in the copyright to *The URANTIA Book*, claiming to be the "[p]roprietor of copyright in a work made for hire." (Pl.'s Compl. Ex. B.)

On February 27, 1991, the Urantia Foundation filed a complaint against the defendant, alleging that she had "copied the text of *The URANTIA Book* ... and ... distributed [it] ... throughout the United States." (Pl.'s Compl. at ¶ 13.) Thereafter, the defendant filed her answer in which she "admits copying the text of *The Urantia Book* ... and admits distributing [it] ... throughout the United States." ((Revised) Def.'s Substitute 2nd Am. Answer and Countercl. at ¶ 13.) The defendant contends, however, that "[t]he

renewal copyright for *The Urantia Book* was not properly obtained." *Id.* at ¶ 92.

II. STANDARD OF REVIEW

The standard applied to a motion for partial summary judgment is identical to the standard applied to adjudicate a case fully by summary judgment. The motion shall be granted when, viewing the facts and reasonable inferences in the light most favorable to the nonmoving party, "there is no genuine issue as to any material fact and ... the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c); *Cabnetics Corp. v. Volkswagen of Am., Inc.*, 532 F.2d 674, 683 n. 11 (9th Cir.), cert. denied, 429 U.S. 940, 97 S.Ct. 355, 50 L.Ed.2d 309 (1976). A genuine issue of material fact exists when there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249, 106 S.Ct. 2505, 2510-11, 91 L.Ed.2d 202 (1986) (citing *First Nat. Bank of Arizona v. Cities Serv. Co.*, 391 U.S. 253, 88 S.Ct. 1575, 20 L.Ed.2d 569 (1968)). If the moving party meets the initial burden of establishing the nonexistence of a genuine issue, then the burden shifts to the opposing party to produce evidence of the existence of a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). "If the evidence is merely colorable or is not significantly probative, summary judgment may be granted." *Anderson*, 477 U.S. at 249-50, 106 S.Ct. at 2510-11 (citations omitted).

III. LEGAL DISCUSSION

A. Preliminary Matters

1. Burden of Proof

[1] To prevail on the claim of copyright infringement the Urantia Foundation must prove both ownership of a valid copyright and "copying" by the defendant of the protected components of the copyrighted material. *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 206 (9th Cir.1988) (citing *Sid & Marty Krofft Television Productions, Inc. v.*

6. I acknowledge that in pursuing brevity I have been forced to truncate the Principal Object of the Urantia Foundation as announced in its

Declaration of Trust. I believe I have, however, preserved its essence.

McDonald's Corp., 562 F.2d 1157, 1162 (9th Cir.1977)). The defendant's admission as to copying the text of *The URANTIA Book* allows me to focus solely on the validity of the plaintiff's copyright.

2. Mere Possession of Manuscript

[2] The plaintiff claims that "[t]he Contact Commission and Foundation's *exclusive* possession of the unpublished manuscripts and the Foundation's subsequent publication creates a *presumption* that the copyright was *transferred* with the manuscript." (Pl.'s Mem. of Law in Opp'n to Def.'s Mot. for Partial Summ.J. as to Pl.'s Claim for Copyright Infringement at 4 n. 3.) [hereinafter Pl.'s Br.] (emphasis added). I find at least three weaknesses in the plaintiff's argument. First, I disagree with the plaintiff's assertion that the Contact Commission and the Urania Foundation had *exclusive* possession of the unpublished manuscripts. "The URANTIA Foundation admits and states that ... the text of at least some of the Papers contained in *The URANTIA Book* was first set forth in ... handwritten form by a human patient of Dr. William Sadler." (Pl.'s Admis. at 15.) Although the means by which Dr. Sadler obtained those papers is far from clear, it cannot be denied that it was the patient who initially had exclusive possession of at least some of the papers.⁷

Second, the plaintiff's use of the word "presumption" is inaccurate. "A presumption is a rule of law, statutory or judicial, by which finding of a basic fact gives rise to existence of presumed fact, until presumption is rebutted." *Black's Law Dictionary* 1067 (5th ed. 1979) (citation omitted). I do not read the cases cited by the plaintiff to require a presumption of copyright transfer upon the showing of mere possession of a manuscript. See, e.g., *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir.1927) ("Plaintiff must next *prove* that he is the 'proprietor' of the painting.") (emphasis added); *Houghton Mifflin Co. v. Stackpole Sons, Inc.*, 104 F.2d 306, 311 (2d

Cir.) ("[P]ossession of the manuscript ... is *evidence* of ownership.") (emphasis added), *cert. denied*, 308 U.S. 597, 60 S.Ct. 131, 84 L.Ed. 499 (1939); *Freudenthal v. Hebrew Pub. Co.*, 44 F.Supp. 754, 755 (S.D.N.Y.1942) (same); see also 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 10.09[B], at 10-78 (1994) (explaining author's "absolute and unconditional *sale* of the material object carried with it an implied assignment of the common law copyright therein") (emphasis added) [hereinafter *Nimmer*].

Third, each of the cases cited by the plaintiff is easily distinguished from the instant case. In the cases relied upon by the plaintiff there was ample evidence other than the mere possession of the work to support the conclusion that the publisher acquired the work through a proper transfer from the author. Usually, the evidence included a certificate of registration for the original copyright which, by law, was considered *prima facie* evidence of the facts stated therein. However, there was often other evidence. See, e.g., *Houghton Mifflin Co. v. Stackpole Sons, Inc.*, 113 F.2d 627, 628 (2d Cir.1940) (holding copyright to *Mein Kampf* properly transferred to publisher "considering the author's power and position in Germany ... it would be unreasonable to suppose that anyone would have been allowed to [make unauthorized use of it]"); *Ripley v. Findlay Galleries, Inc.*, 155 F.2d 955, 958 (7th Cir.) ("It, therefore, seems inescapable that the proper construction to be placed upon these two letters is that Findlay was authorized by plaintiff to sell any of the paintings ... and to pass complete title thereto without reservation."), *cert. denied*, 329 U.S. 775, 67 S.Ct. 194, 91 L.Ed. 666 (1946).

3. Certificate of Renewal as Evidence

[3] The plaintiff encourages the court to give the renewal registration certificate "*prima facie* evidentiary value and find that the certificates constitute *prima facie* evidence of the validity of the Foundation's copyright,

7. The plaintiff's admissions further state that "information available ... indicates that some of the Papers were made known through a group of individuals called the Contact Commission ... [The Foundation] is unable to obtain information

from these individuals ... as to whether such Papers initially were in handwriting by a human patient of Dr. William Sadler, or in other form." (Pl.'s Admis. at 15.)

and all facts stated in the certificates." (Pl.'s Br. at 3 n. 1.) The plaintiff claims such action would be proper because "17 U.S.C. § 410(c) . . . provides that the weight given to any certificate issued more than 5 years after publication of the work is left to the Court's discretion." (Pl.'s Br. at 2 n. 1.) I decline the plaintiff's invitation. See *Picture Music, Inc. v. Bourne, Inc.*, 457 F.2d 1213, 1214-15 n. 3 (2d Cir.) (explaining Register of Copyrights typically allows conflicting claimants to register for renewal without determining validity of claim), *cert. denied*, 409 U.S. 997, 93 S.Ct. 320, 34 L.Ed.2d 262 (1972); *Epoch Producing Corp. v. Killiam Shows, Inc.*, 522 F.2d 737, 746 (2d Cir.1975) (holding no presumption of validity attaches to certificate of renewal), *cert. denied*, 424 U.S. 955, 96 S.Ct. 1429, 47 L.Ed.2d 360 (1976); *Nimmer* § 9.05[D][2], at 9-88 ("explaining span of time between initial publication and copyright renewal should generally preclude renewal certificate from constituting *prima facie* evidence").

Therefore, I decline both of the plaintiff's entreaties. I will not adhere to the old adage that "possession is nine-tenths of the law," nor will I submit to the minority view that a certificate of copyright renewal is *prima facie* evidence of the facts stated therein. Instead, I will evaluate each piece of evidence according to its independent worth.

B. The Copyright Act of 1909

The plaintiff renewed its copyright in *The URANTIA Book* in 1983, by which time the Copyright Act of 1976 had become effective. However, the renewal section under which the book falls, Section 304, is identical to that of Section 24 of the Copyright Act of 1909. Furthermore, as the plaintiff correctly states, "[t]he passage of the [1976 Act] did not alter the definition of a 'work for hire' for the purpose of renewing a copyright originally registered under the [1909 Act]. . . . Thus, whether *The URANTIA Book* is a 'commis-

sioned work' must be decided under the Copyright Act of 1909." (Pl.'s Br. at 5 n. 4.) See *Stewart v. Abend*, 495 U.S. 207, 217, 110 S.Ct. 1750, 1758, 109 L.Ed.2d 184 (1990) (holding renewal rights in pre-1978 works require Court to "look to the language of and case law interpreting § 24"); *Forward v. Thorogood*, 985 F.2d 604, 606 n. 2 (1st Cir. 1993) (explaining 1976 Act's provisions on works for hire operate prospectively).

The 1909 Act provides statutory copyright protection to "all the writings of an author." 17 U.S.C. § 4 (1976). The Act also extends copyright protection to the "proprietor of any work made the subject of copyright by this title." *Id.* § 9. Although the Act never defines the term "proprietor," it does define the word "author" to "include an employer in the case of works made for hire." *Id.* § 26. "The statute represents a codification of the so-called 'works for hire' doctrine recognized by the Supreme Court in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S.Ct. 298, 47 L.Ed. 460 (1903)." *Murray v. Gelderman*, 566 F.2d 1307, 1309 (5th Cir. 1978). Therefore, one claiming the initial term of copyright must either be "the author of the copyrightable work (i.e., either the individual creator or the employer in the case of works made for hire . . . or he must have succeeded to the rights of the author through an assignment or other device.)"⁸ *Epoch*, 522 F.2d at 743 (citation omitted) (emphasis added).

The right to renew a copyright under the 1909 Act is determined exclusively by Section 24. Although the renewal has been described as not simply an extension of the initial term of copyright, *id.*, but rather the creation of "a new estate,"⁹ separate and distinct from the original copyright,¹⁰ the section does utilize the same aforementioned terms and principles. Section 24 states in pertinent part:

Fisher Music Co. v. M. Witmark & Sons, 318 U.S. 643, 63 S.Ct. 773, 87 L.Ed. 1055 (1943).

8. I might simply add the term "legally valid" before the word assignment to ensure absolute accuracy of the phrase.

9. See *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469, 471 (2d Cir.), *cert. denied*, 342 U.S. 849, 72 S.Ct. 77, 96 L.Ed. 641 (1951); *Fred*

10. See *Edward B. Marks Music Corp. v. Charles K. Harris Music Publishing Co.*, 255 F.2d 518, 521 (2d Cir.), *cert. denied*, 358 U.S. 831, 79 S.Ct. 51, 3 L.Ed.2d 69 (1958).

That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or . . . by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years.

17 U.S.C. § 24 (1976). The plaintiff claims its renewal copyright in *The URANTIA Book* is valid "because it is the proprietor, and the work is both a 'work for hire' and a 'composite work' within the meaning of the applicable copyright law." (Pl.'s Br. at 3.) I do not find sufficient evidence to support either claim.

C. Claiming as Proprietor of Copyright

1. Works for Hire Doctrine

[4] I accept the plaintiff's contention that "an anonymous individual known simply as the 'contact personality' . . . had some involvement with the physical process by which the 'Urantia Papers' were written down[, but] . . . did not contribute any copyrightable expression to the papers . . . [and therefore] is not an author of any part of *The URANTIA Book*." (Pl.'s Br. at 4 n. 2.) I interpret the Contact Personality's role to be that of a mere scribe, unable to be the author of that which it mechanically transcribes. Furthermore, I agree with the plaintiff's contention that under the 1909 Act the "works for hire" doctrine was broad enough to include both traditional employees and individuals commissioned for a particular project.

[W]hen one person engages another, whether as employee or as an independent contractor, to produce a work of an artistic nature, that in the absence of an express contractual reservation of the copyright in the artist, the presumption arises that the mutual intent of the parties is that the title to the copyright shall be in the person at

whose instance and expense the work is done.

Lin-Brook Builders Hardware v. Gertler, 352 F.2d 298, 300 (9th Cir.1965) (citations omitted).

However, the "works for hire" doctrine is premised on the plaintiff's ability to prove an employment relationship. Without credible evidence of an actual employment relationship, the "works for hire" doctrine has no application. *Murray*, 566 F.2d at 1310. Consequently, in the absence of such a relationship, a court will not deny an author its constitutional right to a copyright in its work. Therefore, the crucial question is whether there is sufficient evidence to support the conclusion that there was an employment relationship between Dr. Sadler's patient and either Dr. Sadler or the Contact Commission.¹¹ I find that there is not.

Courts have relied upon numerous factors to determine whether an alleged employment relationship exists.

The crucial element in this determination appears to be whether the work was created at the employer's insistence and expense, or, in other words, whether the motivating factor in producing the work was the employer who induced its creation. Another factor is whether the employer had the right to direct and supervise the manner in which the work was being performed. Actual exercise of that right is not controlling, and copyright is vested in the employer who has no intention of overseeing the detailed activity of any employee hired for the very purpose of producing the material. In addition, the nature and amount of compensation or the absence of any payment for the work may be considered but are of minor importance.

Murray, 566 F.2d at 1310 (citations omitted). Each of the aforementioned factors, considered in light of the facts of the instant case,

11. The plaintiff suggests that the individual members of the Contact Commission and the Forum may also have been employees for hire within the meaning of the 1909 Act. (Pl.'s Admis. at 115.) However, it is the patient from whom, ultimately, the "Urantia Papers" came. The plaintiff does not suggest that Dr. Sadler could have acquired

the "Urantia Papers" by working strictly with the Contact Commission or Forum and without the patient or the "personalities." Therefore, the only employment relationship that could conceivably manifest copyright rights in the plaintiff would be one in which the patient was the employee.

suggests the absence of an employment relationship.

Originally, it was the patient who sought Dr. Sadler, and not as an employer but as a therapist. The first "Urantia Papers" were not created at the insistence of Dr. Sadler, nor was the thought of their creation conceived by Dr. Sadler or the Contact Commission. Furthermore, there is no evidence that indicates the patient ever intended to deviate from the established doctor-patient relationship.

More important, there is no evidence that either Dr. Sadler or the Contact Commission had any power to induce, direct, supervise, oversee, or control the actual production of a single "Urantia Paper." It appears as though Dr. Sadler and the Contact Commission were simply reacting to the independent activity of the patient. The plaintiff admits that it was the Contact Commission that was given instructions, responsibilities, and authority by the "personalities" emanating from the patient. (Pl.'s Admis. at 12.) Typically, however, it is the employer who gives instructions and delegates responsibilities, not the employee. The plaintiff essentially concedes that the Contact Commission lacked any power to control the production of the "Urantia Papers" when it states that although the Contact Commission would submit questions,¹² it was the "personalities" that determined which questions would be considered and what would be included in the text. *Id.* at 13. The plaintiff states that "without the questions, there would be no papers." (Pl.'s Br. at 7.) The facts show, however, that the papers came before the questions, and that the questions were in response to the papers. Showing that the author chose to expand a particular paper in the wake of questions falls far short of meeting the plaintiff's burden of showing that the author was *required* to do so as a subservient employee. Absent some credible evidence of an employment relationship, the existence of evidence that may be as consistent with such a relationship as it is with various other hypotheses cannot be bootstrapped to reme-

dy the basic deficiency, which is the absence of any proof that the patient was in fact hired by Dr. Sadler or the Contact Commission to write the "Urantia Papers." See *Epoch*, 522 F.2d at 744-45.

Each of the cases relied upon by the plaintiff is good law on the topic of the "works for hire" doctrine as construed under the 1909 Act, but each is distinguishable from the instant case. For example, the plaintiff directs the court's attention to *Dielman v. White*, 102 F. 892 (C.C.D.Mass.1900). In that case, however, there were numerous items of correspondence that proved that the plaintiff was offered a commission to design a particular work, accepted it, and then entered into a formal work order. Similarly, there were express employment contracts in many of the other cases cited by the plaintiff. *E.g.*, *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28, 29 (2d Cir.1939) (finding artist executed his painting pursuant to a written contract), *cert. denied*, 309 U.S. 686, 60 S.Ct. 891, 84 L.Ed. 1029 (1940); *Siegel v. National Periodical Pub., Inc.*, 508 F.2d 909, 911 (2d Cir.1974) (finding plaintiff entered into initial and supplemental employment agreements); *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 698 (2d Cir.1941) (finding plaintiff employed each artist under a written employment contract).

Moreover, even in the cases where there was not an express employment contract, there was an abundance of evidence to support the conclusion that an employer-employee relationship existed. *E.g.*, *Lin-Brook Builders Hardware*, 352 F.2d at 300 n. 3 (finding artist admitted being employed by plaintiff and disavowed any interest in work performed); *Picture Music*, 457 F.2d at 1217 (finding artist was sought out, given a pre-existing work, instructed to modify it, and paid for her efforts); *Murray*, 566 F.2d at 1310 (finding plaintiff basically admitted being employee in a letter written to defendant).

In the instant case, even affording the plaintiff the benefit of every doubt, I fail to discern the existence of an employment rela-

swer.

12. I assume that these were questions to which the Contact Commission earnestly desired an an-

tionship. To find that the plaintiff is the author of *The URANTIA Book* pursuant to the "works for hire" doctrine on the basis of the evidence relied upon by the Urantia Foundation "would be to substitute mere speculation for reason and experience." *Epoch*, 522 F.2d at 744.

2. Composite Works

[5] The plaintiff earnestly argues that *The URANTIA Book* is a composite work. This is the plaintiff's attempt to validate its copyright renewal, not by claiming that it is the author of the book based upon the "works for hire" doctrine but by claiming it is the proprietor of a composite work who originally secured the copyright in the work. As previously mentioned, Section 24 of the 1909 Act entitles such a proprietor "to a renewal and extension of the copyright in such work." 17 U.S.C. § 24 (1976).

I agree that *The URANTIA Book* may be considered a composite work, if the term is simply defined as a work "to which a number of authors have contributed distinguishable parts, which they have not however 'separately registered.'" *Shapiro*, 123 F.2d at 699. The book, itself, suggests that it was written by "a number of authors." The "Urantia Papers" are obviously "distinguishable parts" and the Copyright Office verifies that no other author of the book has "separately registered." Such concessions, however, do not benefit the plaintiff.

The legislative history shows that the determinative factors in a 'composite work' were:

- 1) A number of authors contributing copyrightable matter to a single work; and
- 2) An *employment or contractual arrangement* entitling the proprietor to secure copyright in the various contributions.

Cadence Industries Corp. v. Ringer, 450 F.Supp. 59, 64 (S.D.N.Y.1978) (quoting *Ringer*, *Renewal of Copyright* (1960)).

As already discussed in depth, the evidence is insufficient to substantiate the claim that the plaintiff became the author of *The URANTIA Book* through an employment arrangement. The plaintiff is therefore relegated to arguing that it is the proprietor. However, "[p]roprietor" is the equivalent of

'assign'; a 'proprietor' must trace title from the author." *Quinn-Brown Publishing Corp. v. Chilton Co.*, 15 F.Supp. 213, 214 (S.D.N.Y.1936) (citing *Mifflin v. R.H. White Co.*, 190 U.S. 260, 23 S.Ct. 769, 47 L.Ed. 1040 (1903); *Public Ledger v. New York Times*, 275 F. 562 (S.D.N.Y.1921), *aff'd*, 279 F. 747 (2d Cir.), *cert. denied*, 258 U.S. 627, 42 S.Ct. 383, 66 L.Ed. 798 (1922)). "And, in pleading a case of infringement, the plaintiff must show title, not merely by broad allegation of proprietorship, but by setting forth facts which indicate how he became proprietor." *Quinn-Brown*, 15 F.Supp. at 214 (citations omitted). The plaintiff channels its efforts toward proving that the structure of *The URANTIA Book* satisfies the definition of a composite work, but is unable to offer evidence that the individual "Urantia Papers" were transferred pursuant to a contractual arrangement, entitling the plaintiff to become their proprietor. Ultimately, I find insufficient evidence to suggest that the plaintiff acquired the "Urantia Papers" in any way other than serendipitously.

IT IS THEREFORE ORDERED that the defendant's motion for partial summary judgment, filing 199, is granted as to (1) Count I of plaintiff's complaint for copyright infringement; and (2) Count I of defendant's counterclaim declaring the copyright renewal in *The URANTIA Book* to be invalid.

UNITED STATES of America, Plaintiff,

v.

David CRUMBY, Defendant.

No. CR 94-122-PHX-RGS.

United States District Court,
D. Arizona.

July 7, 1995.