

United States District Court,
D. Minnesota, Third Division.

H. Grey GARNER,
Plaintiff.

v.

SAWGRASS MILLS LIMITED PARTNERSHIP,
Defendant.

Civil No. 3-94-307

Dec. 22, 1994.

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MEMORANDUM OPINION AND ORDER

RICHARD H. KYLE, District Judge.

Introduction

This matter is before the Court on Defendant Sawgrass Mills Limited Partnership's ("Sawgrass Mills") Motion to Dismiss or Transfer for Lack of Personal Jurisdiction, Improper Venue or Forum Non Conveniens (Doc. No. 14) and, in the alternative, Motion for Summary Judgment (Doc. No. 16). Sawgrass Mills owns and operates a shopping mall in Sunrise, Florida. Plaintiff H. Grey Garner ("Garner") is a commercial artist Sawgrass Mills commissioned to create various logos for use in promoting its mall. Garner commenced this action alleging Sawgrass Mills infringed upon his copyrighted character design and trademark, and invaded his privacy.

I. Background

A. Parties

Sawgrass Mills is a District of Columbia limited partnership. FN1 Sawgrass Mills owns and operates a super-regional outlet shopping mall located in Sunrise, Florida, known as Sawgrass Mills Mall ("Sawgrass Mall" or "the Mall"). Sawgrass Mall is the world's largest outlet Mall. (Beckett, Aff. para. 3.) Plaintiff Garner is a self-employed commercial artist and resident of Crystal, Minnesota.

FN1. Garner initially brought this action against the Mills Corporation d/b/a Sawgrass Mills. The Mills Corporation is the general partner of a limited partnership entitled "Mills Limited Partnership." Sawgrass

Mills is a limited partner in the Mills Limited Partnership. During argument, Garner made an oral motion to dismiss the Mills Corporation as a defendant and to substitute Sawgrass Mills Limited Partnership as the proper defendant in its place. The Court granted that motion. Garner subsequently filed a Stipulation requesting an Order dismissing The Mills Corporation as a party, naming Sawgrass Mills Limited Partnership as the proper defendant in its place, and permitting Garner to serve an Amended Complaint on Sawgrass Mills. The Court issued an Order granting that request. Unless otherwise noted, the Court will construe references to the Mills Corporation as references to Sawgrass Mills Limited Partnership.

B. Alligator Logo

In 1989, Sawgrass Mall created an alligator head logo ("Sawgrass Alligator Head Logo") to use in promoting the Mall. (Ferguson Aff. para. 2, logo attached at *id.*, Ex. A.) In early 1990, Sawgrass Mall's Tour and Travel Division decided to commission an artist to develop an alligator character based upon the Sawgrass Alligator Head Logo to use in Tour and Travel promotional newsletters. (Beckett Aff. para. 3.) These newsletters were sent to various tour bus companies. (*Id.*) Garner's sister, Carolyn Beckett ("Beckett"), was employed as Director of Sawgrass Mall's Tour and Travel Division during this period. She recommended Sawgrass Mall hire Garner to create the new alligator characterization. (*Id.* para. 4.)

Beckett called Garner to see if he was interested in developing the alligator characterization. (*Id.* para. 5.) Beckett also mailed Garner copies of the Sawgrass Alligator Head Logo and a description of some of the elements Sawgrass Mall wanted incorporated into the alligator characterization. Following their discussions, Beckett hired Garner to develop the alligator characterization.

After exchanging drafts with representatives from the Sawgrass Tour and Travel Division, Garner developed an alligator characterization (hereinafter "Garner Alligator Logo"). The Garner Alligator Logo was created on June 15, 1990. (Amend.Compl.para. 13.) This characterization depicted an alligator character wearing a shirt and carrying a shopping bag. A small, stylized version of the letters "Hg" was included in the character's shirt pattern. (*See* Amend. Compl., Ex. C.) Garner claims that "Hg" is his trademark. (Garner Aff. 59.) Sawgrass Mall used the Garner Alligator Logo in two newsletters it distributed during 1990 and 1991. (Ferguson Aff. para. 4.) Approximately 4,000 copies of each newsletter were distributed, and between thirty and fifty of these were sent to Minnesota. (*Id.* para. 5.) Sawgrass Mall also used the Garner Alligator Logo in several coupon books distributed to bus groups and sold at the Mall. (*Id.*)

After using the Garner Alligator Logo in the newsletters and coupon books, Sawgrass Mall hired Garner to make several different versions of the Garner Alligator Logo for other Sawgrass Mall promotions. Garner redesigned the Garner Alligator Logo for the "Mills Miler" program. (Ferguson Aff. para. 6, logo attached at *id.*, Exhs. F, G; Amend. Compl. Exhs. G, H.) The Mills Miler program is a promotion to encourage walking as an aerobic activity in the Mall. Sawgrass Mall used the Garner Alligator Logo on T-shirts and other promotional materials connected with the Mills Miler Program. The logo used in the Mills Miler promotion did not contain the letters "Hg" within the character's shirt. In addition to the Mills Miler promotion, Garner made two modifications to the Garner Alligator Logo for other Sawgrass Mall promotions. Garner made a version of the Garner Alligator Logo for use in an invitation for a private party for Mall employees. (*Id.*, Ex. H.) Sawgrass Mall allegedly distributed this invitation on October 1, 1990. (Amend Compl. para. 18.) Garner created another version of the Garner Alligator Logo for a Sawgrass Mall Christmas season mailer (Ferguson Aff., Ex. I.) This mailer was distributed on November 7, 1991. (*See* Amend. Compl., Ex. E.) Neither of these versions of the Garner Alligator Logo contained Garner's "Hg" trademark.

Finally, Sawgrass Mall adapted a version of the Garner Alligator Logo in a promotional video shown on overhead television screens at the Mall. (*Id.* para. 16.) This video was shown at various intervals during Mall hours to promote the Mall's merchants. The Garner Alligator Logo was modified for the video so that its arms and legs appeared to move. Unlike the other versions of the Garner Alligator Logo, Garner did not participate in the video modification of the Garner Alligator Logo. (*Id.*) This version of the Garner Alligator Logo did not contain the letters "Hg".

On December 17, 1990, Garner applied to and received from the United States Patent Office a certificate of copyright registration (No. VA 444 854). (Amend.Compl., Ex. A.)

C. Payment Disputes

When he was initially hired, Beckett claims that Garner orally agreed he would be paid his "usual rates" to develop a logo for Sawgrass Mall Tour and Travel newsletters. (Beckett Aff. para. 5.) Garner and Beckett also discussed using the Garner Alligator Logo for other purposes. (*Id.* para. 6.) They agreed that a royalty would be negotiated if Sawgrass used the Garner Alligator Logo on merchandise sold to tourists. (*Id.*) Except for these conversations, the parties have not specified the conditions of their agreement. The parties do not allege that they executed a written contract for the Garner Alligator Logo. Instead, Garner sent Sawgrass Mall the following invoices after creating the Garner Alligator Logo and subsequent modifications: \$995.00 for creating the original Garner Alligator Logo, \$175.00 for the Mills Miler modification, \$175.00 for the party invitation modification, and \$200.00 for the Christmas season mailer modification. (Beckett Aff. para. 9, 11, 13, 15, invoices attached at *id.* Exhs. A-D.) Sawgrass Mall paid each of these invoices in full. (*Id.*) Garner contends that these payments were for production costs only, and were not for the purchase of the Garner Alligator Logo. (Garner Aff. para. 5.)

Garner claims that because the payment he received was for production costs only, he did not consent to Sawgrass Mall's publication and distribution of products containing the Garner Alligator Logo or his "Hg" trademark. (Garner Aff. para. 9.) He claims that Sawgrass Mall's various uses of the Garner Alligator Logo infringed upon his copyright and trademark rights. Although he has not identified particular items, Garner claims that in addition to these uses, Sawgrass Mall has intentionally used the Garner Alligator Logo on other publications and items without his consent. (Amend.Compl. para. 28.) Garner has presented no evidence that Sawgrass Mall used his Logo except for the newsletters, coupon books, party invitations, holiday mailings and merchants video. Sawgrass Mall claims that its invoice payment constituted complete payment for Garner's services.

This Court has jurisdiction over this case under 28 U.S.C. s.s. 1331 and 1338.

II. Discussion

In his Amended Complaint, Garner claims that by using the Garner Alligator Logo in its various promotions Sawgrass Mall infringed upon his copyright, infringed upon his trademark and invaded his privacy. In response to his Amended Complaint, Sawgrass Mills alleges that (1) it is not subject to personal jurisdiction in Minnesota (2) the District of Minnesota is not a proper venue in which to adjudicate Garner's claims, and (3) if this matter is properly before the Court, then it is entitled to summary judgment.

A. Personal Jurisdiction

Sawgrass Mills brings its motion to dismiss pursuant to Rule 12(b)(2) of the Federal Rules of Civil Procedure. Where a defendant challenges a court's personal jurisdiction based on Rule 12(b)(2), the plaintiff has the burden of establishing a prima facie case supporting jurisdiction. *Institutional Food Marketing Assocs., Ltd. v. Golden State Strawberries, Inc.*, 747 F.2d 448 (8th Cir.1984). In reviewing a Rule 12(b)(2) motion, the plaintiff's allegations of jurisdictional facts are presumed true and all factual disputes are resolved in its favor. *Dakota Indus. Inc. v. Dakota Sportswear, Inc.*, 946 F.2d 1384 (8th Cir.1991).

In order to determine whether a party is subject to personal jurisdiction, federal courts consider: (1) whether the state's long-arm statute authorizes personal jurisdiction and (2) whether exercising jurisdiction complies with Fourteenth Amendment due process requirements. *Austad Co. v. Pennie & Edmonds*, 823 F.2d 223, 225 (8th Cir.1987). The Eighth Circuit has specifically recognized that because Minnesota's long-arm statute extends jurisdiction to the fullest extent permitted by the Due Process Clause, a Minnesota federal district court need only determine whether exercising personal jurisdiction over a defendant complies with federal due process requirements. *Soo Line R.R. Co. v. Hawker Siddeley Canada, Inc.*, 950 F.2d 526, 528 (8th Cir.1991) (citations omitted).

The due process requirements for personal jurisdiction are set out in *International Shoe Co. v. Washington*, 326 U.S. 310, 66 S.Ct. 154 (1945). In order for a court to have personal jurisdiction over a non-resident, the non-resident must have "minimum contact with [the forum state] such that the maintenance of the suit does not offend 'traditional notions of fair play and substantial justice.' " *Id.* at 316, 66 S.Ct. 158 (citations omitted). In applying this test, the Supreme Court has explained that there must be "some act by which the defendant purposefully avails itself of the privilege of conducting activities within the forum State, thus invoking the benefits and protections of its laws." *Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 475, 105 S.Ct. 2174, 2183 (1985) (quoting *Hanson v. Denckla*, 357 U.S. 235, 253, 78 S.Ct. 1228, 1239-40 (1958)). Once the plaintiff has met the threshold burden of showing such minimum contacts, the plaintiff must further show that the defendant " 'purposefully directed' its activities at residents of the forum and that the litigation results from alleged activities that 'arise out of or relate to' those activities." *Burger King*, 471 U.S. at 472, 105 S.Ct. at 2182 (citation omitted).

The Eighth Circuit applies a five-factor test to determine whether a defendant's contacts with the forum state are sufficient to satisfy due process. Those factors are: (1) the quantity of the contacts with the forum; (2) the nature and quality of the contacts; (3) the source and connection of the cause of action and the contacts; (4) the state's interest in providing a forum; and (5) the convenience of the parties. *Sybaritic, Inc. v. Interport Int'l. Inc.*, 957 F.2d 522, 524 (8th Cir.1992). The first three factors are considered to be of primary importance. *Id.* These factors are essentially a mechanism for determining whether a defendant's conduct and connections are such that it should "reasonably anticipate being haled into the state's court." *World-Wide Volkswagen Corp. v. Woodson*, 444 U.S. 286, 297, 100 S.Ct. 559, 567 (1980). These factors demonstrate that Sawgrass Mall is subject to personal jurisdiction in Minnesota.

1. Defendant's Minnesota Contacts

Sawgrass Mall has no employees, offices, agents, or assets in Minnesota. Sawgrass Mall has, however, had several important Minnesota contacts in the course of negotiating and modifying the Garner Alligator Logo. Garner is a Minnesota resident. Sawgrass Mall's representatives solicited Garner's services by calling him in Minnesota. (Beckett Aff. para. 5.) During the creation and various modifications of Garner Alligator Logo, Sawgrass Mall employees conducted business with Garner over the telephone and via facsimile. (Garner Aff. para. 4.) Sawgrass Mall placed at least twenty phone calls and sent at least twenty letters by mail or

facsimile to Minnesota in the course of conducting this business. (*Id.*) Garner received payment from Sawgrass Mall in Minnesota. All of the work for the characterization Sawgrass Mall commissioned was performed in Minnesota. Finally, in order to solicit business from Minnesota residents, Sawgrass Mall mailed thirty to fifty newsletters with the Garner Alligator Logo to tour companies in Minnesota. (Ferguson Aff. para. 5.)

2. Nature and Quality of Defendant's Minnesota Contacts

The nature and quality of Sawgrass Mall's Minnesota contacts also demonstrate a continuing and purposeful business relationship with Minnesota. Sawgrass Mall initiated this relationship by calling Garner and commissioning the Garner Alligator Logo. Sawgrass Mall continued to receive benefits from this relationship by commissioning several different versions of the Garner Alligator Logo over the course of several years. Finally, Sawgrass Mall purposefully directed its activity to encourage Minnesota residents to travel to the Mall to spend their money by mailing the allegedly infringing promotional materials to Minnesota. Sawgrass Mall admits that these mailings were "designed to develop business for its shopping mall." (Def.'s Mem. in Supp. of Mot. to Dismiss at 10).

3. Relation of Plaintiff's cause of Action to Defendant's Minnesota Contacts

Sawgrass Mall's Minnesota contacts are related to Garner's causes of action. Garner claims that Sawgrass Mall wrongfully used the Garner Alligator Logo in its promotional materials. Sawgrass Mall mailed a portion of these allegedly infringing promotional materials to Minnesota to solicit business. This Court has recognized that personal jurisdiction exists in states where an alleged trademark infringement takes place. *See* *Tonka Corp. v. TMS Entertainment, Inc.*, 638 F. Supp 386, 390 (D.Minn.1985) (citing *Land-O-Nod Co. v. Bassett Furniture Indus.*, 708 F.2d 1338, 1343 (8th Cir.1983)); *see also* *Editorial Musical Latino Americana, S.A. v. Mar Int'l Records, Inc.*, 829 F.Supp. 62, 64 (S.D.N.Y.1993) (holding that "[o]ffering one copy of an infringing work for sale in New York, even if there is no actual sale, constitutes commission of a tortious act within the state sufficient to imbue this Court with personal jurisdiction over the infringers"). FN2 More broadly, Garner's claims are related to Sawgrass Mall's Minnesota contacts in so far as they arise out of a Minnesota business relationship Sawgrass Mall purposefully created with a Minnesota resident and relate to a Minnesota domiciliary's property rights. FN3

FN2. Sawgrass Mall claims that there is no nexus between its alleged infringement and its Minnesota contacts. It argues that the alleged infringement did not take place in Minnesota because it did not sell any infringing products in Minnesota. (Def.'s Reply in Supp. of Mot. to Dismiss at 5.) However, Garner's claims are not based upon *selling infringing products*. Garner claims that Sawgrass Mills used the Garner Alligator Logo to *promote the Mall* without his permission. Because Sawgrass Mall mailed its promotional newsletters to Minnesota, infringement is alleged to have occurred in Minnesota.

FN3. Although copyright and trademark rights are intangible property, their situs have been recognized as being that of the proprietor. *See* *Melville B. Nimmer and David Nimmer, Nimmer on Copyright* s. 12.01[c] (1994); *see also* *London Film Prod. Ltd. v. Intercontinental Communications, Inc.*, 580 F.Supp. 47, 48 (S.D.N.Y. 1984) (relying on *Nimmer on Copyright* s. 12, 01[c] to find personal jurisdiction over nonresident accused of copyright infringement).

4. Residual Factors

The interest of the state and the convenience of the parties are considered to be of secondary importance in determining whether a court has personal jurisdiction over a defendant. *Sybaritic, Inc. v. Interport Int'l, Inc.*, 957 F.2d 522, 524 (8th Cir.1992.) Although not sufficiently significant by itself to confer jurisdiction, Minnesota does have an interest in providing a forum for its residents' disputes. *See Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 473-74, 105 S.Ct. 2174, 2182 (1985). Thus Minnesota has some interest in asserting personal jurisdiction over Sawgrass Mills for Garner's claims. The convenience of the parties does not weigh heavily in favor of either party. Although Sawgrass Mills may have to transport documents and witnesses to Minnesota, the parties' relative postures suggest that requiring Sawgrass Mall to litigate in Minnesota is more reasonable than requiring Garner to litigate in Florida. Sawgrass Mall is the world's largest shopping mall; Garner is a self-employed artist from Crystal, Minnesota. Garner asserts that he does not have the resources to maintain this action in another forum. FN4 (Garner Aff. para. 2.)

FN4. Based on the Court's ruling in Part II, C, the convenience of the parties analysis is ultimately academic; there will be no further litigation in Minnesota.

Sawgrass Mall has had numerous minimum contacts with Minnesota. These contacts demonstrate Sawgrass Mall purposefully availed itself of Minnesota privileges. As a result, the Court finds that exercising personal jurisdiction over Sawgrass Mills, the owner and operator of Sawgrass Mall, is consistent with federal due process requirements.

B. Venue

In addition to its jurisdictional claim, Defendant claims that (a) the District of Minnesota is not a proper venue for this action, and (b) if this case is properly venued here, it should be transferred to the Southern District of Florida pursuant to the doctrine of forum non conveniens.

Venue for Garner's trademark infringement and breach of privacy claims is based upon 28 U.S.C. s. 1391(b), which provides in pertinent part:

A civil action wherein jurisdiction is not founded only on diversity of citizenship may, except as otherwise provided by law, be brought only in (1) a judicial district where any defendant resides, if all the defendants reside in the same State....

Under 28 U.S.C. s. 1391, a corporate defendant "resides" in "any judicial district in which it is subject to personal jurisdiction at the time the action is commenced." 28 U.S.C. s. 1391(c). Although Sawgrass Mills is a limited partnership, courts have recognized that partnerships should be treated as corporations for the purposes of s. 1391(c). *See Injection Research Specialists v. Polaris Indus.*, 759 F.Supp. 1511, 1514 (D.Colo.1991) (citing cases).

Venue for Garner's copyright infringement claim is based upon 28 U.S.C. s. 1400(a), which provides that copyright claims "may be brought in a district in which the defendant or his agents resides or may be found." As with s. 1391(c), for the purposes of s. 1400(a), a defendant is "found" in a judicial district in which the defendant is subject to personal jurisdiction. *Milwaukee Concrete Studios, Ltd. v. Fjeld Mfg. Co.*, 8 F.3d 441, 445 (7th Cir.1993) (citing cases).

Sawgrass Mills is subject to personal jurisdiction in Minnesota. As a result, the District of Minnesota is a

proper venue for this action.

Sawgrass Mills argues that even if venue is proper in the District of Minnesota, Garner's cause of action should be transferred to the Southern District of Florida for any further proceedings. A court may transfer a properly venued action pursuant to 28 U.S.C. s. 1404(a), which provides:

For the convenience of the parties and witnesses, in the interests of justice, a district court may transfer any civil action to any other district or division where it may have been brought.

Because the Court finds that this action is presently postured for resolution on the merits, as discussed in Part II, *C infra*, the Court need not address Sawgrass Mill's forum non conveniens argument.

C. Summary Judgment Motion

Garner alleged three claims in his Amended Complaint: (a) copyright infringement, (b) trademark infringement, and (c) breach of privacy. Sawgrass Mall contends it is entitled to summary judgment on each of these claims.

1. Standard of Decision

Rule 56 of the Federal Rules of Civil Procedure governs motions for summary judgment. Under that Rule:

[summary] judgment shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

Fed.R.Civ.P. 56(c). Summary judgment is to be granted only where the evidence is such that no reasonable jury could return a verdict for the non-moving party. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250, 106 S.Ct. 2505, 2511, 91 L.Ed.2d 202 (1986).

Initially, the movant bears the burden of bringing forward sufficient evidence to establish that there are no genuine issues of material fact and that the movant is entitled to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548, 2552, 91 L.Ed.2d 265 (1986). In evaluating the movant's showing, the evidence offered by the non-moving party is to be believed and all justifiable inferences therefrom are to be drawn in a light most favorable to that party. *Matsushita Elec. Indus. v. Zenith Radio*, 475 U.S. 574, 587, 106 S.Ct. 1348, 1357, 89 L.Ed.2d 538 (1986); *Liberty*, 477 U.S. at 255, 106 S.Ct. at 2513; *Trnka v. Elanco Prod.*, 709 F.2d 1223, 1225 (8th Cir.1983). Where a moving party, with whatever it provides the court, makes and supports a motion for summary judgment in accordance with Rule 56, a party opposing the motion may not rest upon the allegations or denials of its pleadings; rather, the nonmovant must "set forth specific facts showing that there is a genuine issue for trial." *Liberty Lobby*, 407 U.S. at 2516, 106 S.Ct. at 2514; *Fischer v. NWA, Inc.* 883 F.2d 594, 599 (8th Cir.1989), *cert. denied*, 495 U.S. 947, 110 S.Ct. 2205 (1990). However, the nonmovant is not obligated to prove in its favor an issue of material fact. *Unigroup v. O'Rourke Storage & Transfer*, 980 F.2d 1217, 1220 (8th Cir.1992) (citations omitted).

Ordinarily, the court's task on a motion for summary judgment is not to weigh facts or evaluate the credibility of affidavits and other evidence. Rather, the Court need only determine whether the record, as identified by the parties, shows the existence of a real controversy over a material issue, such that the controversy must be resolved by the finder of fact at trial. *Agristor Leasing v. Farrow*, 826 F.2d 732, 733

(8th Cir.1987). However, the nonmovant cannot avoid summary judgment in favor of the movant merely by pointing to some alleged factual dispute between the parties. Instead, any fact alleged to be in dispute must be "outcome determinative under prevailing law," that is, it must be material to an essential element of the specific theory of recovery at issue. *Get Away Club, Inc. v. Coleman*, 969 F.2d 664, 666 (8th Cir.1992) (quoting *Holloway v. Pigman*, 884 F.2d 365, 366 (8th Cir.1989)).

2. Copyright Infringement

In Count I of his Amended Complaint, Garner charges Sawgrass Mills with copyright infringement of the Garner Alligator Logo. In order to maintain a copyright infringement action, Garner must demonstrate (1) a valid copyright and (2) copying by an alleged infringer. *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F.Supp. 175, 185 (D.Minn.1985), *aff'd*, 794 F.2d 678 (8th Cir.1986). In its Motion for Summary Judgment, Sawgrass Mills alleges that Garner does not have a valid copyright to the Garner Alligator Logo because he did not disclose the Sawgrass Alligator Head Logo to the Copyright Office when he applied for the Garner Alligator Logo copyright. The Copyright certificate of registration form contains a section entitled "Derivative Work or Compilation" which requires applicants to "[i]dentify any preexisting work or works this work is based on or incorporates" and to "[g]ive a brief, general statement of the material that has been added to this work and in which a copyright is claimed." (*See* copy of Garner's copyright application attached to Stabbe Aff.) Garner did not disclose the Sawgrass Mall Alligator Head logo and instead left this section in his application blank. (*Id.*) The Copyright Office subsequently approved this registration.

Garner's copyright certificate of registration, (Amend.Compl.Ex.A), constitutes prima facie evidence of the validity of his copyright. 17 U.S.C. s. 410(c). This presumption may be overcome by proof of deliberate misrepresentation. *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2nd Cir.1989) (citations omitted). Although an innocent misstatement or technical omission will not invalidate a copyright, "knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application constitutes a reason for holding the registration invalid and thus incapable of supporting an infringement action ... or denying enforcement on the ground of unclean hands." *Russ Berrie & Co., Inc. v. Jerry Elsner Co.*, 482 F.Supp 980, 988 (S.D.N.Y.1980), *accord* *GB Marketing USA, Inc. v. Gerolsteiner Brunnen GmbH & Co.*, 782 F.Supp. 763, 774 (W.D.N.Y.1991); *Whimsicality*, 891 F.2d at 456; *see also* *Melville B. Nimmer and David Nimmer, Nimmer on Copyright* s. 7.20 at 7-202 (1994) (citing cases). Courts have recognized that the existence of prior work is a fact which "might have occasioned the rejection" of a copyright application. *See* *GB Marketing*, 782 F.Supp. at 774-75 (citing cases). FN5

FN5. The rationale behind this rule is clear: when a copyright claimant fails to advise the Copyright Office of a prior work, the office is not afforded a fair opportunity to pass upon the question of originality in relation to the prior work; thus while courts ordinarily defer to the judgment of the Copyright Office, that is impossible when an applicant does not disclose the prior work. *See* *GB Marketing USA, Inc. v. Gerolsteiner Brunnen GmbH & Co.*, 782 F.Supp. 763, 774-75 (W.D.N.Y.1991); *Past Pluto Productions Corp. v. Dana*, 627 F.Supp. 1435, 1440 n. 5 (S.D.N.Y.1986). Thus the question before the Court is not simply whether an applicant's product is sufficiently unique to be copyrighted, but whether an applicant knowingly failed to disclose the relevant information.

Garner left the "Derivative Work or Compilation" section of his application blank. The Copyright Act defines "derivative work" as "a work based upon one or more pre-existing works, such as a translation, musical arrangement, dramatizations, fictionalization, motion picture version, sound recording, art

reproduction abridgment, condensation, *or any other form in which a work may be recast, transformed, or adapted,*" and specifically provides that "[a] work consisting of ... modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'" 17 U.S.C. s. 101 (emphasis added). Thus the Court will not enforce Garner's copyright if the Garner Alligator Logo is a "derivative work" which Garner knowingly failed to disclose.

The material submitted by the parties demonstrates that Garner should not be allowed to proceed with his infringement action. The Court recognizes that issues concerning a party's knowledge are not typically resolved on summary judgment. Nevertheless, the Court finds summary judgment on Garner's copyright infringement claim appropriate in this case. *See* GB Marketing, 782 F. Supp at 775-76 (granting defendant's summary judgment motion on plaintiff's copyright infringement claim because plaintiff failed to disclose derivative nature of work on Copyright registration form and uncontested evidence showed plaintiff knew of prior art).

Sawgrass Mall alleges that Garner knowingly failed to disclose a preexisting work to the copyright office. Faced with these allegations, Garner has the burden of going beyond the pleadings and, based upon affidavits, depositions, or interrogatory answers, designating specific facts which show there is a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324, 106 S.Ct. 2548, 2553 (1986). Garner has not met that burden. The undisputed evidence shows that Sawgrass Mall mailed him copies of its Sawgrass Mall Alligator Head Logo (Beckett Aff. para. 4; Garner Aff. para. 8); Garner used these copies in drawing his Logo (Garner Aff. para. 8); Sawgrass Mall specifically told Garner to create an alligator character "based on" the Sawgrass Mall Logo (Beckett Aff. para. 4); and, based upon a review of the two logos, it is clear that Garner unquestionably incorporated the Sawgrass Mall Logo into his. (*see* logo copies attached as Ferguson Aff., Exhs. A, G). FN6 Garner has not presented an explanation for his nondisclosure sufficient to create a material question of fact. FN7

FN6. Garner admits that "[i]n creating the [Garner Alligator Logo], I used ideas from [Sawgrass Mills'] alligator head drawing." (Garner Aff. para. 8.) However, a review of the two logos shows that Garner did not simply use "ideas" from Sawgrass Mills' Logo, he incorporated Sawgrass Mills' Logo in nearly every detail into his Logo.

FN7. Garner claims that he thought his Logo was a completely new work of art because he added a shirt, arms, legs, tail, and shadow. He also states that he was not advised Sawgrass Mills had a copyright registration for its Logo. (*Id.*) Garner's work may have been a new work of art. Nevertheless, it unquestionably was based on and substantially incorporated Sawgrass Mills' Logo. In its definition of "derivative work," the Copyright Act specifically provides that "[a] work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'" 17 U.S.C. s. 101 (emphasis added). Accordingly, a work may be both "original" and "based upon" a preexisting work. Thus the fact that a work may qualify as "original" does not obviate the requirement that an applicant disclose the derivative nature of the work. *See e.g.* *Weissmann v. Freeman*, 868 F.2d 1313 (2nd Cir.1989) ("[t]he principle of derivative work protection is subject to two important limitations.... To support a copyright, a derivative work must be more than trivial, *and* the protection afforded a derivative work must reflect the degree to which the derivative work relies on preexisting material, without diminishing the scope of the latter's copyright protection") (emphasis added). By failing to indicate on the certificate of registration the degree to which the Garner Alligator Logo relies upon and incorporates the Sawgrass Alligator Head, both the Copyright Office and potential licensees of or

infringers upon the Garner Alligator Logo are denied the ability to know the scope of the protection to be afforded under the copyright. Additionally, Garner's knowledge of a prior *copyright* is irrelevant; the copyright application requires applicants to disclose all "preexisting material," not just material which is copyrighted.

The Garner Alligator Logo is clearly a derivative work. He knew of the prior work, he based his logo on that work, and he failed to disclose that to the Copyright Office. As a result, Garner is barred from his copyright infringement action. FN8

FN8. The Court also notes that Garner did not receive his copyright certificate of registration until December 17, 1990. In his Amended Complaint, several of the uses Garner claims infringe on his copyright occurred prior to December 17, 1990. Because he did not have a copyright certificate prior to December 17, 1990, these claims fail as a matter of law.

3. Trademark Infringement

In Count II of his Amended Complaint, Garner alleges that Sawgrass Mall infringed on his trademark when it used the first version of his Garner Alligator Logo in its mailings and initial promotion. In this version of the Garner Alligator Logo, Garner drew the alligator character wearing a shirt with a design of crooked lines and dots. (*See* Amend. Compl., Ex. C.) In the midst of that design, Garner drew small, stylized letters "Hg." Garner claims that "Hg" is his trademark, and that Sawgrass Mall's unauthorized use of the initial logo constitutes trademark infringement.

Liability for trademark infringement is predicated on the use of a registered trademark which "is likely to cause confusion." 15 U.S.C. s. 1441(1)(a). This Circuit has recognized that "the essential question in any case of alleged trademark infringement is whether purchasers are likely to be misled or confused as to the source of the different products or services." *WSM, Inc. v. Hilton et. al.*, 724 F.2d 1320, 1329 (8th Cir.1984) (citing *Vitek Sys., Inc. v. Abbott Lab.*, 675 F.2d 190, 192 (8th Cir.1982)). The *WSM* court also explained that "a mere possibility [of confusion] is not enough. There must be a substantial likelihood that the public will be confused." *Id.* In assessing the likelihood of consumer confusion, courts consider the following factors: (1) the strength of the trademark; (2) the similarity between the plaintiff's and defendant's marks; (3) the competitive proximity of the parties' products; (4) the alleged infringer's intent to confuse the public; (5) evidence of any actual confusion; and (6) the degree of care reasonably expected of the plaintiff's potential customers. *Anheuser-Bush, Inc. v. Balducci Publications*, 28 F.3d 769, 774 (8th Cir.1994).

After considering these factors, the Court finds that Sawgrass Mall is entitled to summary judgment on Garner's trademark infringement claim. Granting Garner the gratuitous assumption that a consumer could decipher the letters "Hg" used in his logo, no reasonable trier of fact could conclude that there was a "substantial likelihood" these letters would confuse consumers into thinking that Sawgrass Mall, the world's largest outlet mall and Florida's second largest tourist attraction, is somehow affiliated with or sponsored by H. Grey Garner, a self-employed artist from Crystal, Minnesota.

4 Invasion of privacy

Minnesota does not recognize a cause of action for invasion of privacy. *Stubbs v. North Memorial Medical Center*, 448 N.W.2d 78, 80 (Minn.Ct.App.1989). Garner admits that his invasion of privacy claim is not

cognizable under Minnesota law, but claims that "summary judgment [on this claim] is not appropriate at this time because choice-of-law issues have not been briefed by the parties and therefore remain to be decided by the Court." (Pl.'s Rely to Def.'s Mot for Summ. J. at 15.)

The Court need not resolve the choice-of-law issue. FN9 Although Florida recognizes a common law cause of action for invasion of privacy, *Tucker v. Resha*, 634 So.2d 756 (Fla. Dist. Ct. App. 1994), Garner has not provided evidence from which a jury could find the common law elements of invasion of privacy satisfied. Garner claims Sawgrass Mall invaded his privacy by incorporating the initials "Hg" into its newsletters. The common law recognized a cause of action for invasion of privacy when a plaintiff's name or likeness is appropriated for another's pecuniary gain. *W. Page Keeton et. al., Prosser and Keeton on the Law of Torts* Ch. 20, s. 117 at 851 (1984). Under the common law, "[i]t is the plaintiff's name as a symbol of his identity that is important, not the mere name ... it is only when [a defendant] makes use of the name to pirate the plaintiff's identity for some advantage of his own ... that [a defendant] becomes liable." *Id.* at 852.

FN9. Minnesota applies a five-factor choice-of-law analysis to determine which law applies. These factors are (1) predictability of results, (2) maintenance of interstate and international order, (3) simplification of the judicial task, (4) advancement of the forum's governmental interests, and (5) application of the better rule of law. *Milkovich v. Saari*, 295 Minn. 155, 203 N.W.2d 408 (Minn. 1973). Although the Court finds analyzing these factors in great detail unnecessary, it does appear likely that Minnesota law will govern and therefore bar Garner's invasion of privacy claim.

After reviewing the material Garner claims invaded his privacy, (Amend. Compl. Exhs. C, E), the Court finds that no reasonable jury could conclude that Sawgrass Mall used Garner's "identity" to market its products when it mailed newsletters with the tiny letters "Hg" scrawled into the shirt pattern of the Garner Alligator Logo. In fact, in considering an action for invasion of privacy based on the use of another's name or likeness without consent, this Court has previously explained that in an appropriation action, "a name is commercially valuable as an endorsement of a product or for use for financial gain only because the public recognizes it and attributes good will and feats of skill or accomplishments of one sort or another to that personality." *Uhlaender v. Hendricksen*, 316 F.Supp. 1277, 1283 (D. Minn. 1970). Sawgrass Mall's alleged use of the letters "Hg" in its mailers clearly does not meet this standard.

Conclusion

Accordingly, based on the foregoing, and upon all the files, records and proceedings herein, **IT IS ORDERED** (1) Defendant's Motion to Dismiss or Transfer for Lack of Personal Jurisdiction, Improper Venue or Forum Non Conveniens (Doc. No. 14) is **DENIED**; (2) Defendant's Motion for Summary Judgment (Doc. No. 16) is **GRANTED**, and Plaintiff's Complaint is **DISMISSED WITH PREJUDICE** .

LET JUDGMENT BE ENTERED ACCORDINGLY.

D. Minn., 1994.

Garner v. Sawgrass Mills Ltd. Partnership

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