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# FOIA MARKER

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**OA/ID Number:** 12690 **CLINTON LIBRARY PHOTOCOPY**  
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**Folder Title:**  
Personal Data Questionnaire [1]

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<b>Stack:</b>	<b>Row:</b>	<b>Section:</b>	<b>Shelf:</b>	<b>Position:</b>
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# Withdrawal/Redaction Sheet

## Clinton Library

DOCUMENT NO. AND TYPE	SUBJECT/TITLE	DATE	RESTRICTION
001. form	RE: Draft Questionnaire (17 pages)	n.d.	P2, P6/b(6)
002. form	RE: Addendum to Draft Questionnaire (24 pages)	n.d.	P2, P6/b(6)

**COLLECTION:**

Clinton Presidential Records  
 Counsel's Office  
 Doug Band  
 OA/Box Number: 12690

**CLINTON LIBRARY PHOTOCOPY**

**FOLDER TITLE:**

Personal Data Questionnaire [1]

2009-1007-F

db1212

**RESTRICTION CODES**

**Presidential Records Act - [44 U.S.C. 2204(a)]**

- P1 National Security Classified Information [(a)(1) of the PRA]
- P2 Relating to the appointment to Federal office [(a)(2) of the PRA]
- P3 Release would violate a Federal statute [(a)(3) of the PRA]
- P4 Release would disclose trade secrets or confidential commercial or financial information [(a)(4) of the PRA]
- P5 Release would disclose confidential advice between the President and his advisors, or between such advisors [(a)(5) of the PRA]
- P6 Release would constitute a clearly unwarranted invasion of personal privacy [(a)(6) of the PRA]

C. Closed in accordance with restrictions contained in donor's deed of gift.

PRM. Personal record misfile defined in accordance with 44 U.S.C. 2201(3).

RR. Document will be reviewed upon request.

**Freedom of Information Act - [5 U.S.C. 552(b)]**

- b(1) National security classified information [(b)(1) of the FOIA]
- b(2) Release would disclose internal personnel rules and practices of an agency [(b)(2) of the FOIA]
- b(3) Release would violate a Federal statute [(b)(3) of the FOIA]
- b(4) Release would disclose trade secrets or confidential or financial information [(b)(4) of the FOIA]
- b(6) Release would constitute a clearly unwarranted invasion of personal privacy [(b)(6) of the FOIA]
- b(7) Release would disclose information compiled for law enforcement purposes [(b)(7) of the FOIA]
- b(8) Release would disclose information concerning the regulation of financial institutions [(b)(8) of the FOIA]
- b(9) Release would disclose geological or geophysical information concerning wells [(b)(9) of the FOIA]

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**SOTOMAYOR RESPONSE TO  
PERSONAL DATA QUESTIONNAIRE  
QUESTION 22**

Attached is a copy of the complaint in the only pending action against my former law firm, Pavia & Harcourt.

SUPREME COURT OF THE STATE OF NEW YORK  
COUNTY OF NEW YORK

STANLEY WEST,

Plaintiff,

-against-

PAVIA & HARCOURT, ESQS.,  
a New York Partnership,

Defendants.

AMENDED VERIFIED COMPLAINT

LEWIS and FIORE  
Attorneys for Plaintiff

225 BROADWAY  
NEW YORK, N. Y. 10007-3001  
(212) 285-2290

To:

Attorney(s) for

Service of a copy of the within

is hereby admitted.

Dated:

Attorney(s) for

PLEASE TAKE NOTICE

Check Appropriate Box

NOTICE OF ENTRY

that the within is a (certified) true copy of a  
entered in the offices of the clerk of the within named Court on

19

NOTICE OF SETTLEMENT

that an Order of which the within is a true copy will be presented for settlement to the Hon.  
one of the judges of the within named Court,

19

at

M.

Dated:

LEWIS and FIORE

Attorneys for

225 BROADWAY  
NEW YORK, N. Y. 10007-3001

To:

CLINTON LIBRARY PHOTOCOPY

Attorney(s) for

msj 10/5/92  
7/83

SUPREME COURT OF THE STATE OF NEW YORK  
COUNTY OF NEW YORK

-----X

STANLEY WEST,

Plaintiff,

AMENDED  
VERIFIED COMPLAINT

-against-

PAVIA & HARCOURT, ESQS.,  
a New York Partnership,

Index #: 30139/91

Defendants.

-----X

Plaintiff, by his attorneys, Lewis & Fiore, complaining  
of the defendant, does hereby allege as follows:

AS AND FOR A FIRST CAUSE OF ACTION

1. Plaintiff, Stanley West (hereinafter West), is a  
resident of the State of New York, City of New York, and a former  
client of the defendant.

2. Defendant is and was for all times mentioned herein,  
upon information and belief, a New York partnership engaged in the  
practice of law with offices at 600 Madison Avenue, and is made up  
of a number of attorneys who are together engaged in the practice  
of law under the firm name of Pavia & Harcourt.

3. Defendant was the attorney for Marcar Restaurant and  
Catering Corp. d/b/a L'Hostaria del Bongustaio (hereinafter  
referred to as Marcar), from January 13, 1983 through and including  
November of 1988.

4. In 1988, defendant was retained by plaintiff and

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Gennaro Picone (hereinafter referred to as Picone), to represent them in the formation of a new business with the intention of forming a new corporation, acquiring a location to conduct a restaurant business and performing all other necessary legal services to protect the rights of Picone and West.

5. Defendant accepted employment on behalf of West and Picone and was paid for its services and performed a number of services for West and Picone.

6. The defendants drafted and filed a Certificate of Incorporation for the formation of a new business corporation known as Malvasia, Inc.

7. The defendants drafted a shareholders' agreement between West and Picone.

8. The defendants drafted and accepted by-laws for Malvasia, Inc.

9. The defendants served as incorporators of Malvasia, Inc.

10. The defendants prepared a Waiver of Notice of the first meeting of the Board of Directors.

11. The defendants prepared the Minutes of the first meeting of the Board of Directors of Malvasia, Inc.

12. The defendants served as an interim secretary of Malvasia, Inc.

13. The defendants prepared written consent of the Board of Directors, accepting the resignation of one of the defendant's members as secretary and appointing West as secretary of Malvasia, Inc.

CLINTON LIBRARY PHOTOCOPY

14. The defendants prepared a corporate resolution providing that Picone be the one and only signatory on the corporate bank account, and be authorized to conduct all banking business on behalf of the corporation.

15. The defendants prepared a written consent of the Board of Directors, authorizing Picone, and Picone alone, to negotiate and bind the corporation in all respects, for the purchase of the business of Marcar.

16. The defendants prepared a document indicating unanimous consent of the Board of Directors, for Picone to be the sole signatory on the Corporate bank account and to conduct all corporate business, including the obtaining of loans on behalf of the Corporation.

17. The interests of Picone and West, by virtue of their proposed roles in the Corporation, were, from the outset, different and adverse.

18. Picone was a professional chef who was intended, by the parties, to be a full time employee of the Corporation.

19. West was a novice to the restaurant business who was intended by the parties, to supply the necessary funds to form and operate the Corporation.

20. Defendant knew, or should have known, of the conflicting and diverse interests of West and Picone.

21. Defendants should not have undertaken the tasks of representing both West and Picone.

22. In any event, defendant should have made full disclosure of the actual and potential conflicts between the

CLINTON LIBRARY PHOTOCOPY

diversity of interest between West and Picone, to West, and should have advised West to retain counsel to represent his interest, as opposed to the interest of Picone.

23. Defendant failed to make disclosures of the actual and potential conflict between the interest of Picone and West, to West, and failed to advise West to seek independent counsel to represent his interest.

24. Defendants were negligent in their representation of West, failed to exercise reasonable care in their representation of West and caused West to suffer damages.

25. Defendants knew, or should have known that their professional judgment in representing both West and Picone would, by the nature of the transaction, be compromised and that they would be incapable of the proper level of independent professional judgment in their representation of West.

26. Defendant represented to West that his rights were protected by virtue of the legal services rendered and the representation rendered by the defendants.

27. West relied upon the representations of the defendant, that his rights were protected by virtue of the legal services provided by the defendants.

28. West reasonably relied upon the representations of the defendant, as described above.

29. In reasonable reliance upon the representations of the defendant, West invested substantial sums of money, by virtue of capital contribution and loans to Malvasia, Inc.

30. Defendant's failure to advise West to retain

CLINTON LIBRARY PHOTOCOPY

independent counsel to represent his interest, was grossly negligent in that West was in the process of investing substantial sums of money in Malvasia, Inc, so that independent counsel could have been retained at a relatively small cost in comparison to the large sums of money being risked by West.

31. Defendant knowingly and intentionally acting on behalf of the interest of others, failed to advise West to retain independent counsel, failed to represent West's interest in the preparation of legal documents while representing to West that his interests were protected.

32. Defendant represented Malvasia, Inc. and Picone against West in a legal action known as Stanley West v. Malvasia, Inc. and Gennaro Picone, in the Supreme Court of New York County.

33. As a result of the foregoing, West has suffered damages in the amount of \$700,000.00.

#### AS AND FOR A SECOND CAUSE OF ACTION

34. Plaintiff repeats each and every one of the above allegations with the same force and effect as if restated in full here.

35. The defendants performed the above described acts intentionally, for the benefit of another and against the interest of West.

36. As a result of the foregoing, Plaintiff has suffered special damages, in that his entire investment of \$700,000.00 in the business venture has been lost to him because the business has closed and is no longer functioning.

CLINTON LIBRARY PHOTOCOPY

AS AND FOR A THIRD CAUSE OF ACTION

37. Plaintiff repeats and realizes each and every allegation contained in the above paragraphs as if restated in full here.

38. As outlined above, defendant made negligent misrepresentations to West.

39. As a result of the foregoing, plaintiff has been damaged in the sum of \$700,000.00.

WHEREFORE, it is respectfully requested that plaintiff be granted judgment for damages in the amount of \$700,000.00 upon the first, second and third causes of action.

DATED: New York, New York  
August 24, 1992

LEWIS & FIORE, ESQS.  
Attorneys for Plaintiff  
Office and P.O. Address:  
225 Broadway, Suite 3300  
New York, New York 10007  
(212) 285-2290

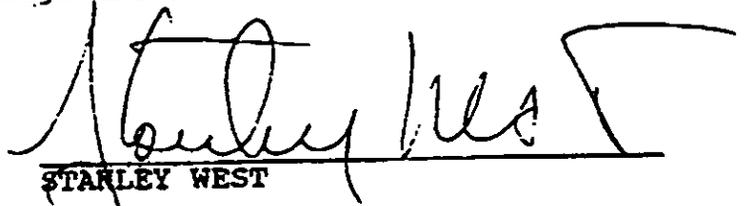
CLINTON LIBRARY PHOTOCOPY

INDIVIDUAL VERIFICATION

STATE OF NEW YORK )  
COUNTY OF ~~KINGS~~ <sup>New York</sup> ) ss.:

STANLEY WEST, being duly sworn, deposes and says:  
deponent is the plaintiff in the within action; deponent has read  
the foregoing Amended Verified Complaint and knows the contents  
thereof; the same is true to deponent's own knowledge, except to  
those matters therein stated to the alleged upon information and  
belief, and as to those matters deponent believes it to be true.

The grounds of deponent's belief as to all matters not  
stated upon deponent's knowledge are as follows:

  
STANLEY WEST

Sworn to before  
me this 18 day  
of Sept, 1992.

  
NOTARY PUBLIC

VIOLET SQUIRES  
COMMISSIONER OF DEEDS  
CITY OF NEW YORK - No. 1662  
CERTIFICATE FILED IN NY COUNTY  
COMMISSION EXPIRES 10/1/92

CLINTON LIBRARY PHOTOCOPY



**SOTOMAYOR RESPONSE TO  
PERSONAL DATA QUESTIONNAIRE  
QUESTION 26**

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

----- x  
**CASTLE ROCK ENTERTAINMENT,**

**Plaintiff,**

**-against-**

**95 Civ. 0775 (SS)**

**CAROL PUBLISHING GROUP, INC., and  
BETH B. GOLUB,**

**Defendants.**  
----- x

**Appearances:**

**DAVIS, SCOTT, WEBER &  
EDWARDS, P.C.  
100 Park Avenue  
New York, New York 10017  
212/685-8000**

**David Dunn, Esq.  
Emily Granrud, Esq.  
Attorneys for Plaintiff**

**BELDOCK, LEVINE &  
HOFFMAN, LLP  
99 Park Avenue  
New York, New York 10016  
212/490-0400**

**Melvin L. Wulf, Esq.  
Daniel M. Krummer, Esq.  
Attorneys for Defendant Carol  
Publishing Group, Inc.**

## OPINION AND ORDER

Plaintiff brings this action alleging copyright infringement and unfair competition flowing from defendants' publication of *The Seinfeld Aptitude Test* ("SAT"), a book of trivia concerning *Seinfeld*, a popular television comedy program "about absolutely nothing." (Golub Dep. Ex. 3, cover). Though this seemingly invites the conclusion that this opinion is not about anything, plaintiff's claims raise a variety of difficult and interesting questions concerning the proper scope of copyright protection as it extends to popular television programming. For the reasons to be discussed, I grant plaintiff's motion for summary judgment on the issue of copyright infringement, finding that defendants have appropriated original material from *Seinfeld* without making "fair use" of the program. I deny plaintiff's motion for summary judgment with respect to its claim of unfair competition, however, because there are material issues in dispute concerning this claim.

### BACKGROUND

Plaintiff, Castle Rock Entertainment ("Castle Rock"), produced and now owns the copyrights to each episode of the highly successful television series *Seinfeld*, a comedy program featuring four characters confronting life's "daily, petty annoyances." (Shostak Dep. Ex. 3).<sup>1</sup> Defendants are the author, Beth Golub, and publisher, Carol

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<sup>1</sup> The parties have provided deposition excerpts as attachments to the affidavits submitted by David Dunn and Melvin Wulf in further support of or opposition to the motion for summary judgment.

Publishing Group, Inc. ("Carol"), of SAT, a book of trivia questions "based on the *Seinfeld* show." (Golub Dep. at 95). According to a view shared by the book's author, Beth Golub, and her editor at Carol Publishing, SAT represents a "natural outgrowth" of *Seinfeld*. (Golub Dep. Ex. 5 at 000606; Shostak Dep. Ex. 3). Indeed, "[SAT], like the *Seinfeld* show, is devoted to the trifling, picayune and petty annoyances encountered by the show's characters on a daily basis." (Golub Dep. Ex. 5 at 00606). In other words, defendants designed SAT to "capture *Seinfeld's* flavor in quiz book fashion." (Golub Dep. Ex. 5 at 000606).

In a proposal she submitted to Carol Publishing, Golub explained that she gathered the information tested in SAT by "watching and reviewing" *Seinfeld* episodes. (Golub Dep. Ex. 5 at 000606). During her deposition, Golub provided a more detailed account of her methods: she took notes from programs at the time they were aired on television, and she subsequently reviewed videotapes of several of the episodes, some of which she recorded and others that friends provided. (Golub Dep. at 20-21). Plaintiff reasons that Ms. Golub's proposal -- with its "watching and reviewing" language -- left Carol Publishing with constructive knowledge of Golub's practice of videotaping. Carol Publishing's representatives have denied, however, any actual knowledge that Golub reviewed *Seinfeld* episodes on tape. (Schrags Dep. at 91; Shostak Dep. at 62-64).

By defendant's count, SAT includes 643 trivia questions about the events and characters depicted in the *Seinfeld* show. The questions are presented in three forms: 211 are multiple choice; 93 are matching; and the remainder are simple questions. The

book draws from 84 of the 86 *Seinfeld* episodes that had been broadcast as of the time that SAT was published in October 1994. The number of questions devoted to each episode ranges from a low of one to a high of 20. Every answer in the book arises from an episode of the show, though defendant Golub created incorrect answers as choices to the multiple choice questions. (Golub Dep. at 36, 94-95). Actual dialogue from the program is quoted in 41 of the book's questions. Though the parties cannot agree on the percentage of the show's overall dialogue excerpted in SAT, they offer figures -- based upon the script most often referenced in the book, "The Cigar Store Indian" -- ranging from a low of approximately 3.6 % (defendants' calculation) to a high of approximately 5.6 % (plaintiff's calculation).

The name "Seinfeld" appears on the front and back covers of SAT in larger print than any other word, in a typeface which, according to plaintiff, mimics the registered *Seinfeld* logo. (Golub Dep. Ex. 3). During editing, defendants increased the size of the name "Seinfeld" appearing on the back cover. (Shostak Dep. at 107-08). SAT also includes, both on its front cover and in several of its pages, pictures of the principal actors who appear in the *Seinfeld* series. On the back cover, as defendants note, a disclaimer appears indicating that SAT "has not been approved or licensed by any entity involved in creating or producing *Seinfeld*." (Golub Ex. 3, back cover). This language is in smaller print than is any other text in the book, but it is surrounded by a border and printed on a shaded background. Defendants contend that their decision to reduce the print size of this disclaimer, while at the same time surrounding it by a border and placing

it upon a shaded background, represented an effort to highlight the disclaimer. Plaintiff contends that this decision was a blatant effort by defendants to reduce the prominence of the only indication provided that SAT was produced without plaintiff's cooperation or approval.

Because of its concern with preserving the show's reputation for quality, plaintiff has been highly selective in marketing products associated with *Seinfeld*. (Wittenberg Aff. ¶¶s 14, 15). Plaintiff has rejected numerous proposals from publishers seeking approval for a variety of projects related to the show. (Wittenberg Aff. ¶ 23). Plaintiff has licensed the production of a single *Seinfeld* book, *The Entertainment Weekly Seinfeld Companion*, and only after threatening litigation in connection with the book's initial unauthorized release. (Wittenberg Aff. ¶ 25). Also, plaintiff has licensed the production of a CD-ROM product which includes discussions of *Seinfeld* episodes, and which might ultimately include a trivia bank. Plaintiff now alleges that it plans to pursue a more aggressive marketing strategy in the future, a strategy which will include the "publication of books related to *Seinfeld*." (Wittenberg Aff. ¶ 21). The creative team responsible for *Seinfeld* would have to be assured creative control over any such projects, however. (*Id.* at ¶ 23; Wittenberg Dep. at 52). Because that creative team, consisting of Jerry Seinfeld and his partner, Larry David, does not now wish to be distracted from the program, it appears that there has been little, if any, progress in developing such books or products. (*Id.*)

There is no evidence that the publication of SAT has diminished interest in

*Seinfeld*, or that the profitability of the *Seinfeld* logo "has been reduced in any way at all." (Wittenberg Dep. at 110). In fact, the show's audience has grown since SAT was first published. (*Id.* at 109). The television network that broadcasts episodes of *Seinfeld* has distributed copies of SAT in connection with promotions for the program. (Aronson Dep. at 26). Even the executive producer of *Seinfeld*, George Shapiro, benignly characterizes SAT as "a fun little book." (Shapiro Dep. at 33). Nevertheless, it is a book which plaintiff believes "free-rides" on the success of *Seinfeld*, and plaintiff therefore seeks to bar its continued publication.

Plaintiff now moves for summary judgment on its claims of copyright infringement and unfair competition, arguing that SAT is either an unauthorized reproduction, or derivative version, of *Seinfeld*.<sup>2</sup> Defendants cross-move for summary judgment, claiming that SAT is not substantially similar to *Seinfeld*, and that, in any event, the book is protected as "fair use" under the Copyright Act. For the reasons that follow, the Court finds for plaintiff with respect to its claims under the Copyright Act, but is unable to grant either party summary judgment on plaintiff's common law claim of unfair competition.

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<sup>2</sup> Plaintiff is not now seeking judgment on its claim that defendants violated section 43(a) of the Lanham Act, 15 U.S.C. 1125(a) (1988).

## DISCUSSION

Summary judgment is required when "there is no genuine issue as to any material fact and . . . the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). "The moving party has the initial burden of 'informing the district court of the basis for its motion' and identifying the matter 'it believes demonstrate[s] the absence of a genuine issue of material fact.'" Liebovitz v. Paramount Pictures Corp., 1996 WL 733015, \* 3 (S.D.N.Y. Dec. 18, 1996) (quoting Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986)). Once the movant satisfies its initial burden, the nonmoving party must identify "specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e). In assessing the parties' competing claims, the Court must resolve any factual ambiguities in favor of the nonmovant. See McNeil v. Aguilos, 831 F. Supp. 1079, 1082 (S.D.N.Y. 1993). It is within this framework that the Court must finally determine "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 251-52 (1986).

### I. Prima Facie Copyright Liability

The Copyright Act grants a copyright holder a variety of rights, including the exclusive rights to "reproduce the copyrighted work" and "to prepare derivative works based upon the copyrighted work." 17 U.S.C. § 106. To succeed on a claim that these rights have been infringed, a plaintiff must demonstrate two elements: "(1) ownership of a

valid copyright, and (2) copying of constituent elements of the work that are original."

Feist Publications, Inc. v. Rural Telephone Serv., Inc., 499 U.S. 340, 361 (1991)

(citations omitted); see also Arica Institute, Inc. v. Palmer, 970 F.2d 1067, 1072 (2d Cir.

1992). Defendants do not dispute that plaintiff is the owner of a valid copyright in the individual *Seinfeld* episodes and scripts. The question of infringement therefore turns upon whether SAT is an impermissible copy of *Seinfeld*.

#### A. Copying

"[A] plaintiff must first show that his [or her] work was actually copied . . . [and] then must show that the copying amounts to an 'improper' or 'unlawful' appropriation." Laureyssens v. Idea Group, Inc., 964 F.2d 131, 139-40 (2d Cir. 1992) (citations omitted); see also 3 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.01[B], at 13-19 (1996) ("First, there is the factual question whether the defendant, in creating its work, used the plaintiff's material as a model, template, or even inspiration."). Ordinarily, there is no direct evidence of actual copying, and the Court is called upon to "infer [such copying] upon a showing that defendant had access to the copyrighted work, and that the allegedly infringing material bears a substantial similarity to the copyrightable elements of plaintiff's work." Arica, 970 F.2d at 1072; see also Twin Peaks Productions, Inc. v. Publications Int'l, Ltd., 996 F.2d 1366, 1372 (2d Cir. 1993) ("The plaintiff may establish copying either by direct evidence or by showing that the defendant had access to the plaintiff's work and that the two works are substantially

similar." In this case, this inquiry is not necessary in order for the Court to make its initial determination that SAT in fact copied from *Seinfeld*.

Defendants make "no secret" of the fact that SAT is based upon *Seinfeld*. (Golub Dep. at 95). SAT is expressly devoted to testing elements from the program. Every correct answer to each of the 643 questions posed in the book reflects information derived directly from *Seinfeld* episodes. (*Id.* at 36). Moreover, many of the questions posed in SAT, upwards of forty, actually quote dialogue, verbatim, from the show. Such statistics should come as no surprise; a trivia book about *Seinfeld* would make little sense if it tested matters not included in the program, or if it attributed dialogue to characters which they never spoke. Simply put, there can be no real dispute that, as a factual matter, SAT copies information and dialogue from *Seinfeld*.<sup>3</sup>

The determination that SAT serves as is its own direct evidence of copying does not remove substantial similarity from the infringement equation. See Twin Peaks, 996 F.2d 1366. In Twin Peaks, the defendant published a book which was primarily devoted to digesting episodes of another popular television program, *Twin Peaks*. Addressing the concept of "fragmented literal similarity," the Court determined that 89

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<sup>3</sup> Plaintiff argues that defendant Golub's practice of videotaping episodes of *Seinfeld* as an intermediate step in the creation of SAT constitutes prima facie infringement regardless of the content of the show ultimately reflected in the book. (Memorandum of Law in Support of Plaintiff's Motion for Partial Summary Judgment at 5-7). Because the Court finds that SAT copies *Seinfeld*, it is not necessary to reach this question. In any event, while defendant Golub certainly copied *Seinfeld* by taping the program, the record reveals no evidence requiring the conclusion that defendant Carol was involved in, or had constructive knowledge of, Golub's practice.

lines of dialogue copied from the show rendered the book "substantially similar" to the program. Id. at 1372. Because the book digested entire episodes, the Court found that there was "comprehensive nonliteral similarity" between the two works, as well. Id. Of course, the Second Circuit could have found copying, as a factual matter, without searching for substantial similarity; with 89 lines of dialogue quoted in the allegedly infringing book, it was inescapable that some copying had taken place. It is apparent, then, that the Second Circuit applied a substantial similarity test devoted to finding more than mere copying; it applied a test meant to determine whether the copying which had taken place was significant as a matter of law.

"The presence of a 'substantial similarity' requirement in both prongs of the analysis -- actual copying and whether the copying constitutes an improper appropriation -- creates the potential for unnecessary confusion, especially because a plaintiff need not prove substantial similarity in every case in order to prove actual copying." Laureyssens, 964 F.2d at 140; see also 3 Nimmer § 13.01[B], at 13-11 to 13-12 (distinguishing probative similarity from substantial similarity). Where there is no direct evidence of copying, as a factual matter, a substantial similarity between the two works creates an inference of such copying. Where there are sufficient similarities to permit such an inference, or where there is direct evidence of actual copying, the question becomes whether there is substantial similarity as a matter of law. At this stage, substantial similarity becomes a function of whether defendant copied "elements of the work that were original." Feist, 499 U.S. at 361; Laureyssens, 964 F.2d at 140 (upon finding direct

proof of actual copying, Court's "central concern" became whether there was "unlawful appropriation of protected material."). For those reasons already explained, the first of these inquiries is unnecessary in the present case; by its very nature, SAT copies at least some material from *Seinfeld*. The legally significant question therefore becomes whether the copying which took place rendered the two works substantially similar as a matter of law -- i.e., whether SAT copied "elements of [*Seinfeld*] that were original." Id.

B. Original Elements of *Seinfeld*

"The *sine qua non* of copyright is originality." Feist, 499 U.S. at 345. Indeed, it is for this reason that "[n]ot all copying . . . is copyright infringement," but only the copying of the original elements of a protected work. Id. at 361. Addressing this point, defendants invoke a fact/expression distinction that has proven decisive in numerous infringement cases. See, e.g., Feist, 499 U.S. 341 (finding no infringement where defendant produced a multi-county phone directory, in part, by obtaining names and phone numbers from plaintiff's single-county directory); Harper & Row Publishers v. Nation Enterprises, 471 U.S. 539 (1985) (finding infringement where defendant published magazine article which did not merely include facts revealed by President Ford in his as yet unpublished memoirs, but which excerpted the President's expression of those facts); Worth v. Selchow & Richter Co., 827 F.2d 569 (9th Cir. 1987) (finding no infringement where defendant incorporated facts chronicled in plaintiff's reference books into a trivia game), cert. denied, 485 U.S. 977 (1988). Specifically, defendants argue that

SAT does not copy plaintiff's protected expression, but merely quizzes readers as to the show's underlying facts and ideas.

Consideration of the logic underlying the fact/expression distinction reveals a fundamental flaw in defendants' reasoning. The fact/expression dichotomy has been developed in a series of cases concerning the publication of nonfiction works and factual compilations. See, e.g., Feist, 499 U.S. 341 (compilation); Harper & Row, 471 U.S. 539 (nonfiction history). The facts reported in such works "do not owe their origin to an act of authorship." Feist, 499 U.S. at 347. Accordingly, courts have adopted an approach "permitting free communication of [these] facts while still protecting an author's expression." Harper & Row, 471 U.S. at 556 (quoting, with approval, lower court's decision, reported at 723 F.2d 195, 203 (2d Cir. 1983)). Specifically, protection extends only to the original manner in which the copyright holder expresses or compiles the facts that are reported, and not to the facts themselves. See, e.g., Harper & Row, 471 U.S. 539; Feist, 499 U.S. 340. This is an appropriate resolution of the tension between facts and expression because the facts of a nonfiction work simply "do not contain the requisite originality and creativity required as the '*sine qua non* of copyright.'" Arica, 970 F.2d at 1074 (citing Feist, 499 U.S. at 345).

By contending that they are not reproducing original expression from *Seinfeld*, but only "uncopyrightable facts about the *Seinfeld* show," plaintiffs are staking their claim upon a false premise. (Defendant's Memorandum of Law in Opposition to Plaintiff's Motion for Partial Summary Judgment at 7). SAT does not pose "factual"

questions about the *Seinfeld* show; it does not ask who acts in the program, who directs or produces the show, how many seasons it has run, etc. Instead, SAT poses questions about the events depicted during episodes of the *Seinfeld* show. The facts depicted in a *Seinfeld* episode, however, are quite unlike the facts depicted in a biography, historical text, or compilation. *Seinfeld* is fiction; both the "facts" in the various *Seinfeld* episodes, and the expression of those facts, are plaintiff's creation. Thus, while defendants' book does not report plot developments and digest programs, as in Twin Peaks, SAT is devoted to questions concerning creative components of *Seinfeld*. In other words, by copying "facts" that plaintiff invented, SAT "appropriate[s] [plaintiff's] original contributions." Harper & Row, 471 U.S. at 548. Thus, to find in defendant's favor merely by rote application of the rule against affording copyright protection to facts would be to divorce that rule from its underlying rationale. Simply put, and of most direct concern under the Copyright Act, defendants have appropriated original elements of plaintiff's work.

Though treating the issue in a very different context, the most recent Second Circuit decision concerning the fact/expression dichotomy provides additional support for this Court's conclusion. See National Basketball Association v. Motorola, Inc., 1997 WL 34001 (2d Cir. Jan. 30, 1997) (hereinafter "NBA"). In NBA, the National Basketball Association claimed that defendant infringed their valid copyright in televised professional basketball games by reporting the scores of those games, during play, to purchasers of their electronic pagers. In finding for defendants, the Court drew a distinction very illuminating for present purposes: the Court noted that, "[u]nlike movies,

plays, television programs, or operas, athletic events have no underlying script." *Id.* at \* 4 (emphasis added). On this basis, the Court concluded that the facts of a game (e.g., the score, the foul situation, the time remaining, etc.) could not be protected by the Copyright Act; only those aspects of a broadcast that are under the NBA's creative control merited such protection (e.g., camera angles, commentary, graphics, etc.). The present case, of course, presents the opposite situation; this case involves facts copied from a "television program" with an "underlying script." Unlike the facts of a professional basketball game (or the facts compiled in a phone directory or biography), the facts revealed during an episode of *Seinfeld* are created by the show's writers. Thus, by reporting "facts" from each episode -- whether by transmitting them on a pager, or by including them as the answers to a set of trivia questions -- defendants have appropriated "original components" of plaintiff's protected work.

C. Willfulness

Though it is not essential to a finding of liability under the Copyright Act, the question of whether a defendant's infringement was willful does have a significant bearing upon the potential damages to be awarded in connection with the violation. *See* 17 U.S.C. § 504(c)(2). "[A] court need not find that an infringer acted maliciously to find willful infringement." *Fitzgerald Pub. Co., Inc. v. Baylor Pub. Co., Inc.*, 807 F.2d 1110, 1115 (2d Cir. 1986). "The standard is simply whether the defendant had knowledge that its conduct represented infringement or perhaps recklessly disregarded the possibility."

Twin Peaks, 996 F.2d at 1382.

The parties have not briefed the question of damages, and the Court is hesitant to make a finding of willfulness outside the context of the damages question which it implicates. Nevertheless, the record provides clear evidence, at a minimum, of defendants' reckless disregard for the possibility that their conduct amounted to copyright infringement. See Twin Peaks, 996 F.2d at 1382. First, defendants were on notice that *Seinfeld* is a protected work: each televised episode commences with a copyright notice. (Wittenburg Aff. ¶ 10). Also, all the defendants are sophisticated with respect to such matters. Defendant Golub is an attorney. Mr. Shragis, Carol's publisher, testified that his company has had experience with the copyright laws, and that he is familiar with the requirements of those laws. (Schragis Dep. at 17, 73-74, 93, 107-09). Finally, Carol continued to publish and distribute SAT after receiving actual notice from plaintiff demanding that Carol cease and desist publication. (Schragis Dep. at 17-19). In other words, defendants continued in their infringement even "after receiving a specific warning." See Twin Peaks, 996 F.2d at 1382.

## II. Fair Use

As the preceding discussion demonstrates, plaintiff has established a prima facie case of infringement by showing that SAT appropriates original elements from *Seinfeld*. Defendants argue, however, that, even if SAT is an unauthorized copy of *Seinfeld* -- as the Court has found it to be -- the book is protected by the "fair use"

doctrine. As set out in the Copyright Act:

the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include —

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107. "[T]he applicability of the fair use defense is ordinarily a factual question for the jury to determine." Roy Export Co. Establishment v. Columbia Broadcasting System, Inc., 503 F. Supp. 1137, 1143 (S.D.N.Y. 1980), aff'd, 672 F.2d 1095 (2d Cir.), cert. denied, 459 U.S. 826 (1982); see also Harper & Row, 471 U.S. at 560 ("Fair use is a mixed question of law and fact."); Maxtone-Graham v. Burtchaell, 803 F.2d 1253, 1258 (2d Cir. 1986) ("Because the fair use question is so highly dependent on the particular facts of each case, courts . . . have usually found it appropriate to allow the issue to proceed to trial."), cert. denied, 481 U.S. 1059 (1987). However, where the district court has "facts sufficient to evaluate each of the statutory factors," it may conclude as a matter of law that the challenged use is not a protected fair use. Harper & Row, 471 U.S. at 560; see also Leibovitz, 1996 WL 733015, \* 4 (citing several cases for the proposition "that a rejection of the fair use defense and a subsequent finding in favor of a copyright plaintiff . . . may be appropriate at summary judgment.").

A. Purpose And Character Of The Use

"The enquiry here may be guided by the examples given in the preamble to § 107, looking to whether the use is for criticism, or comment, or news reporting, and the like." Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, \_\_\_, 114 S.Ct. 1164, 1171 (1994). Though it may be "extravagant" to characterize SAT as a work of criticism or comment, the Court "must be alert to the risk of permitting subjective judgments about quality to tilt the scales on which the fair use balance is made." Twin Peaks, 996 F.2d at 1374. Surely a text testing one's knowledge of Joyce's *Ulysses*, or Shakespeare's *Hamlet*, would qualify as "criticism, comment, scholarship, or research," or such. The same must be said, then, of a text testing one's knowledge of Castlerock's *Seinfeld*. Id. ("A comment is as eligible for fair use protection when it concerns 'Masterpiece Theater' and appears in the New York Review of Books as when it concerns 'As the World Turns' and appears in Soap Opera Digest."). Thus, the Court is satisfied that SAT "serves one or more of the non-exclusive purposes that section 107 identifies as examples of purposes for which a protected fair use may be made." Id.

As the Supreme Court recently explained, the "central purpose" of the Court's inquiry into the character and purpose of an allegedly infringing work must be to determine whether that work is "transformative." Campbell, 114 S.Ct. at 1171; see also Twin Peaks, 996 F.2d at 1375. Put differently, the analysis properly focuses upon whether "the new work merely 'supersedes the objects' of the original creation, or instead adds something new, with a further purpose or different character, altering the first with

new expression, meaning, or message." Campbell, 114 S.Ct. at 1171 (citations omitted). Though plaintiff insists that SAT is not at all creative, the Court concludes otherwise. Given the absence of any case law addressing the copyright status of a work completely devoted to posing trivia questions about the fictional elements of another work, it is clear that SAT is itself an "original creation." By testing *Seinfeld* devotees on their facility at recalling seemingly random plot elements from various of the show's episodes, defendants have "added something new" to *Seinfeld*, and have created a work of a "different character" from the program. It may even be said that defendants have identified a rather creative and original way in which to capitalize upon the development of a "T.V. culture" in our society; a culture in which the distinction between fiction and fact is of declining consequence, and in which people are as concerned with the details of the former as the latter.

The Court's finding that SAT is a transformative work, though important, is not dispositive in defendant's favor. Indeed, it is a basic axiom of copyright law that the unauthorized production of derivative works can give rise to a successful claim of infringement. See 1 Nimmer § 3.06, at 3-34.4; see also Rogers v. Koons, 751 F. Supp. 474 (S.D.N.Y. 1990) (rejecting fair use claim raised by defendant charged with unauthorized creation of a derivative work), aff'd 960 F.2d 301 (2d Cir.), cert. denied, 506 U.S. 934 (1991). And a derivative work, by definition, transforms an original. See 17 U.S.C. § 101 (defining a "derivative work" as one which is "based upon," but which "recast[s], transform[s], or adapt[s]," an original); see also Durham Industries, Inc. v.

Tomy Corp., 630 F.2d 905 (2d Cir. 1980) (explaining that in order to be classified as a derivative, a work must contain some "substantial, not merely trivial, originality"). Thus, to hold that the transformative nature of a work automatically shields it from a successful claim would be to reject an unassailable proposition -- i.e., that the unauthorized production of a derivative can support a claim for infringement. The question of whether a work is transformative must therefore be most decisive when answered in the negative. If a work is not transformative, "fair use should perhaps be rejected without further inquiry into the other factors."<sup>4</sup> Campbell, 114 S.Ct. at 1116. Where, as here, a work is transformative, the crux of the fair use analysis remains: the Court must proceed with a careful consideration of the remaining three factors, while merely granting defendants an advantage at the outset.

Defendants' initial advantage must be tempered, if only slightly, by the fact that their creation and publication of SAT was a commercial endeavor. The Copyright Act "plainly assigns a higher value to a use that serves 'nonprofit educational purposes' than to one of a 'commercial nature.'" Twin Peaks, 996 F.2d at 1374. This factor must not be unduly emphasized, however. As the Supreme Court reasoned in Campbell, "[i]f

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<sup>4</sup> Though a useful generalization, this statement should not be elevated to the status of a rule applicable in all situations. For instance, the Supreme Court has held that the practice of video taping programs for subsequent private viewing represents a fair use, but did not suggest that such video taping is "transformative." See Sony Corp. of America v. Universal City Studios, 464 U.S. 417 (1984). Even without this factor, the Court was satisfied that the creation of a tape designated solely for noncommercial, private enjoyment, represents a fair use under the Copyright Act.

... commerciality carried presumptive force against a finding of fairness, the presumption would swallow nearly all of the illustrative uses listed in the preamble paragraph of § 107 ... since these activities 'are generally conducted for profit in this country.'" Campbell, 114 S.Ct. at 1174 (citations omitted); see also Robinson v. Random House, Inc., 877 F. Supp. 830, 840 (S.D.N.Y. 1995) ("because nearly all authors hope to make a profit with their work, courts should be wary of placing too much emphasis on the commercial nature in a fair use determination."). Thus, the commercial nature of SAT reduces -- but does not nearly eliminate -- the significance properly ascribed to the transformative quality of defendants' work.

#### B. Nature Of The Copyrighted Work

"This factor calls for recognition that some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied." Campbell, 114 S.Ct. at 1175. As already discussed, originality is the core concern of copyright protection. See Feist, 499 U.S. at 345. If the second factor of the fair use test "favors anything," then, "it must favor a creative and fictional work, no matter how successful." Twin Peaks, 996 F.2d at 1376; see also Stewart v. Abend, 495 U.S. 207, 237 (1990) ("In general, fair use is more likely to be found in factual works than in fictional works."). *Seinfeld* is a highly successful fictional and creative work. As defendants concede in their opposition papers, plaintiff thereby has a decisive advantage with respect to the second factor of the fair use analysis. (Defendant's Memorandum of Law in Opposition to Plaintiff's Motion for

Partial Summary Judgment at 14-15).

C. Substantiality Of The Portion Used

In addressing this factor, the parties engage in an almost academic deconstruction of *Seinfeld*, with their analysis ultimately devolving into an exercise in counting the number of words extracted from particular scripts and episodes. Adapting competing methodologies, and failing to agree upon correct word counts, the parties arrive at different measures of the extent of copying that took place. For instance, plaintiff estimates that SAT copies 5.6 % of the *Seinfeld* episode most often referenced in the book; defendants concede only 3.6 %. Accepting defendants' calculations, as is in accord with the appropriate presumptions for summary judgment purposes, the 3.6 % figure does little to advance defendants' cause.

Though the Court recognizes that a quantitative approach to addressing the substantiality question has a place in the analysis, it is clear that even small amounts of material extracted from an original work can suffice to counter a claim of fair use. Twin Peaks, 996 F.2d at 1372 (finding infringement where defendant excerpted a total of 89 lines of dialogue from several episodes of a protected television program); Harper & Row, 471 U.S. at 564-65 (finding infringement where defendant excerpted approximately 400 words of a full length book); Roy, 503 F. Supp. 1137 (upholding jury verdict finding infringement where defendant broadcast a series of film clips from six full-length films by Charlie Chaplin). In other words, the substantiality factor "has both a quantitative and a qualitative element to it." Wright v. Warner Books, 953 F.2d 731, 738

(2d Cir. 1991). If a challenged work appropriates what amounts to "the heart" of an original work, even if only in a few words, then such an appropriation is substantial for purposes of the fair use inquiry. See Harper & Row, 471 U.S. at 565.

The Court's determination that SAT is substantially similar to *Seinfeld* "so as to be prima facie infringing should suffice for a determination that the third fair use factor favors the plaintiff." Twin Peaks, 996 F.2d at 1377. Indeed, whether under the rubric of prima facie copying or the fair use defense, it is inescapable that SAT appropriates essential elements of *Seinfeld*, and that *Seinfeld* is essential to SAT. Beginning with the significance that the appropriated material has in relation to the *Seinfeld* show, a brief review of SAT confirms that the book invokes all of the show's main characters, and many of the show's most humorous plot elements. Perhaps more to the point, SAT seizes upon the notion which lies at the very heart of *Seinfeld* -- that there is humor in the mundane, seemingly trivial, aspects of every day life. Indeed, by inviting its readers to recall literally 643 bits of information from various *Seinfeld* episodes, SAT "follow[s] the basic premise of the *Seinfeld* show by focusing on minutiae in the day-to-day lives of the show's characters." (Shostak Dep. Ex. 2 at 000604). As defendants boasted before the onset of this litigation, SAT succeeds at "capturing [*Seinfeld's*] flavor in quiz book fashion." (Golub Dep. Ex. 5 at 00606).

The "amount and substantiality" fair use factor is addressed primarily to the very matter considered by the Court in the preceding paragraph, *i.e.*, "the volume and substantiality of the work used with reference to the copyrighted work, not to the

allegedly infringing work as a whole." 17 U.S.C. § 107(3). The Second Circuit, however, has deemed it useful also to consider "the amount and substantiality of the protected passages in relation to the work accused of infringement." Wright, 953 F.2d at 739. Not only does SAT draw upon significant elements of the *Seinfeld* program, but SAT introduces relatively little additional material into the mix. Though the book transforms the program by employing a trivia game format, that trivia game relates exclusively to events as they are depicted in the *Seinfeld* program. Simply put, without *Seinfeld*, there can be no SAT. See Salinger v. Random House, 811 F.2d 90, 99 (2d Cir.) (finding that quantitatively modest excerpting from plaintiff's personal letters was substantial where those excerpts, "[t]o a large extent, [made defendant's] book worth reading."), cert. denied, 484 U.S. 890 (1987); see also Addison-Wesley Publishing Co. v. Brown, 223 F. Supp. 219, 223-24 (E.D.N.Y. 1963) (stressing that defendant's book, a manual consisting of the answers to a set of physics problems included in plaintiff's college course book, had "no independent viability."); Midway Mfg. Co. Arctic Int'l, Inc., 1981 WL 1390, \* 9 (N.D. Ill. 1981) ("[If] defendant's device would only have value because of plaintiff's particular copyrighted audio visual image, then plainly defendant's device would only have value because of plaintiff's particular copyrighted audio visual work. Defendant, thus, by selling its device reaps the benefits of plaintiff's artistic endeavor."). In sum, defendants have identified and appropriated the most important elements of *Seinfeld*, and have made them the most important elements of SAT.

Previously, the Court emphasized that its finding that SAT is transformative

of *Seinfeld* cannot be dispositive for defendants, because such a holding would discredit the proposition that the unauthorized production of a derivative work can be infringing. On similar logic, the Court's finding that SAT incorporates a substantial amount from *Seinfeld* cannot be dispositive in plaintiff's favor. Because a finding of substantial similarity is a prerequisite to a prima facie claim of infringement, such a finding cannot negate the possibility of fair use. Otherwise, the fair use provision of the Copyright Act would amount to little more than a false promise of a viable defense; there would be no real chance that a prima facie case of infringement could ever be negated by a showing of fair use. The first three factors of the fair use analysis, then, suggest a somewhat unsatisfying result; plaintiff has an advantage, but one that is hardly compelling or dispositive.

#### D. Effect On Potential Market

The effect on the market for the copyrighted work is "undoubtedly the single most important element of fair use."<sup>5</sup> Harper & Row, 471 U.S. at 566; see also

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<sup>5</sup> The Second Circuit has recently suggested that, by "conspicuously omit[ting] this phrasing" in a recent discussion of the fair use standard, the Supreme Court has placed the "effect on potential markets" factor on an equal footing with the remaining three fair use considerations. American Geophysical Union v. Texaco Inc., 60 F.3d 913, 926 (2d Cir. 1994) (citing Campbell, 114 S.Ct. at 1171). Given the vigor with which the Supreme Court has emphasized this factor in the past, this Court hesitates in adapting the Second Circuit's dicta. In any event, because neither party has any considerable advantage through the Court's consideration of the first three fair use factors, the effect on the potential markets -- however important it is relative to the remaining factors -- will be determinative in this case.

Robinson, 877 F. Supp. at 842. For purposes of this inquiry, "harm to both the original and derivative works must be considered." Robinson, 877 F. Supp. at 842. As for the original work, defendants stress that SAT has not and cannot be expected to reduce interest in *Seinfeld*. The Court agrees; SAT compliments *Seinfeld*. The book is only of value to a regular viewer of the program. Moreover, though plaintiff proclaims plans to enter derivative markets with books about *Seinfeld*, there is little suggestion -- and certainly not enough to remove all material doubt -- that such projects are anything more than a remote possibility. See Wright, 953 F.2d at 739 ("Plaintiff offered no evidence that the project will go forward."). Indeed, if past practice provides any indication, plaintiff will be slow to develop any such works for fear of compromising *Seinfeld's* reputation for quality.

This does not end the analysis, however; "the proper inquiry concerns the 'potential market' for the copyrighted work." Salinger, 811 F.2d at 99. More broadly, the inquiry must extend even to the potential market for as yet nonexistent derivative works. Campbell, 510 U.S. at 1178 (accepting defendant's position that rap music parody of the song, *Pretty Woman*, would not detract from sales of the original, but remanding for determination as to whether parody would effect the market for hypothetical non-parody "rap derivatives" of *Pretty Woman*). In other words, the Court must consider not only whether SAT detracts from interest in *Seinfeld*, or even whether SAT occupies markets that plaintiff intends to enter; the analysis is whether SAT occupies derivative markets that plaintiff may potentially enter. Id.; see also Rogers, 751 F. Supp. at 480 ("I do not

think the case turns upon Rogers' past conduct or present intention as much as it does upon the existence of a recognized market for new versions or new uses of the photograph, which unauthorized use clearly undermines."). At first blush, this seems to create an impossible standard for a defendant to satisfy; any time there is a successful infringing work (i.e., one likely to provoke a law suit), it necessarily means that defendants are filling a "potential" market that would otherwise be available for plaintiff's taking. See 3 Nimmer § 13.05[A][4], at 13-187. Properly understood, however, the "potential markets" standard erects no such barrier to a finding of fair use.

The term "potential markets" does not properly encompass all conceivable markets for an original and its derivatives. "The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop." Campbell, 114 S.Ct. at 1178. The examples of parody and criticism should serve to clarify and illustrate this proposition. By the very nature of such endeavors, persons other than the copyright holder are undoubtedly better equipped, and more likely, to fill these particular market and intellectual niches. See Campbell, 114 S.Ct. at 1178 ("there is no protectable derivative market for criticism."); New Era Publications, Int'l v. Carol Publishing Group, 904 F.2d 152, 160 (2d Cir.) ("a critical biography serves a different function than does an authorized, favorable biography, and thus injury to the potential market for the favorable biography by the publication of the unfavorable biography does not affect application of factor four."), cert. denied, 498 U.S. 921 (1990); Leibovitz, 1996 WL 733015, at \* 13 ("although derivative markets are an

appropriate consideration in a fair use analysis, there is no protectable derivative market for criticism." ). Here, the Court sees no reason that the market for derivative game versions of *Seinfeld* is a market that should be reserved for persons other than plaintiff. A *Seinfeld* trivia game is not critical of the program, nor does it parody the program; if anything, SAT pays homage to *Seinfeld*. The market for such works is one that should properly be left to plaintiff's exclusive control.

The Court's resolution of the "potential markets" inquiry is not effected by the prospect that plaintiff will choose to leave this particular derivative market unsatisfied. See Salinger, 811 F.2d at 99 ("the need to assess the effect on the market for Salinger's letters is not lessened by the fact that their author has disavowed any intention to publish them during his lifetime."). The Court is persuaded that there is a meaningful difference, for purposes of the Copyright Act, between a copyright holder's failure to occupy a particular market as a matter of choice, and a failure to occupy such a market as a matter of neglect. Id. In a manner of speaking, plaintiff has exercised its control over derivative markets for *Seinfeld* products, if only by its decision to refrain from inundating those markets. Indeed, artists express themselves not merely by deciding what to create from their original work, but by deciding what not to create as well. Cf. Harper & Row, 471 U.S. at 559 ("freedom of thought and expression 'includes both the right to speak freely and the right to refrain from speaking at all.'") (citations omitted). It would therefor not serve the ends of the Copyright Act -- *i.e.*, to advance the arts -- if artists were denied their monopoly over derivative versions of their creative works merely

because they made the artistic decision not to saturate those markets with variations of their original. Where nothing in the nature of criticism or parody is at issue, this creative choice must be respected.

E. Aggregate Fair Use Assessment

Though there are numerous competing considerations which make this decision a difficult one, the Court is persuaded that, on balance, SAT does not represent a fair use of *Seinfeld*. Only one of the four statutory factors favors defendant, and then, only by a generous understanding of what it means for a work to be "transformative." Plaintiff prevails with respect to each of the remaining three factors: *Seinfeld* is a work of fiction, and such works are accorded special status in copyright law; SAT draws upon "essential" elements of *Seinfeld*, and it draws upon little else; and, most importantly, SAT occupies a market for derivatives which plaintiff -- whatever it decides -- must properly be left to control. In short, SAT does not make fair use of *Seinfeld*, and plaintiff must accordingly be granted summary judgment on its claim of copyright infringement. See Wright, 953 F.2d at 740 ("a party need not 'shut-out' her opponent on the four factor tally to prevail.").

### III. Common Law Unfair Competition

In order to succeed on a claim of common law unfair competition under New York law, plaintiff must establish the bad faith misappropriation of its labor and expenditure resulting in the likelihood of confusion as to the source of the product. See Kraft General Foods v. Allied Old English, Inc., 831 F. Supp. 123, 135 (S.D.N.Y. 1993); Shaw v. Time-Life Records, 38 N.Y.2d 201, 206, 379 N.Y.S.2d 390, 395 (1975). "Thus, some showing of bad faith is crucial to the claim." Brown v. Quiniou, 744 F. Supp. 463, 473 (S.D.N.Y. 1990). The Court must also determine "whether persons exercising 'reasonable intelligence -- and discrimination' would be taken in by the similarity" between the two products. Shaw, 38 N.Y.2d at 206 (citations omitted). In other words, plaintiff must prove a likelihood of confusion among members of the general public as to the source of defendants' work. See Charles Of The Ritz Group, Ltd. v. Quality King Distributors, Inc., 832 F.2d 1317, 1321 (2d Cir. 1987); Weight Watchers International, Inc. v. Stouffer Corp., 744 F. Supp. 1259, 1283 (S.D.N.Y. 1990).

"Likelihood of confusion is usually measured by applying the test formulated by Judge Friendly in Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d at 495." See Weight Watcher, 744 F. Supp. at 1269; see also Twin Peaks, 996 F.2d at 1379 (remanding to the district court for a "full" examination of the Polaroid factors in connection with plaintiff's claim of trademark infringement). Specifically, the Court must balance the following factors:

the strength of [the owner's] mark, the degree of similarity between the two

marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.<sup>6</sup>

Polaroid, 287 F.2d at 495. Despite the stature of the "venerable Polaroid factors," the parties have not addressed, or even identified, most of these considerations in their discussion of consumer confusion. See Twin Peaks, 996 F.2d at 1379.

The matters that the parties have focused upon simply are not so compelling as to merit summary judgment. Plaintiff begins by arguing that defendants have created confusion as to the sponsorship of SAT by including the name "Seinfeld" in the book's title, and by referring to the *Seinfeld* show in promotional materials. (Memorandum of Law in Support of Plaintiff's Motion for Partial Summary Judgment at 23-24). As defendants explain, however, "there's no secret that the book is based on the show." (Golub Dep. at 95). The book is expressly directed to devotees of the television program, and it is dedicated to testing their knowledge of the show. It is all but inevitable that the *Seinfeld* name would be invoked in the book's title and in its advertising. See Twin Peaks, 996 F.2d at 1379 (there can be "little question that the title is of some artistic

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<sup>6</sup> Though this formulation has been developed in the context of federal claims under the Lanham Act for trademark infringement, it has also been applied to common law claims of unfair competition, and it reaches the identical "likelihood of confusion" issue which is of present concern. See, e.g., Weight Watchers, 744 F. Supp. at 1283 ("Common law unfair competition claims closely parallel Lanham Act unfair competition claims; to the extent that they may be different, the state law claim may require an additional element of bad faith or intent."); see also Kraft, 831 F. Supp. 123, 136 ("the Court has already found, in the context of the Lanham Act claims, that plaintiff has demonstrated a likelihood of confusion").

relevance to the Book." ). "The question then is whether the title," and advertising, "is misleading in the sense that it induces members of the public to believe the Book was prepared or otherwise authorized by [defendants]." Twin Peaks, 996 F.2d at 1379.

Plaintiff argues that there are similarities between the word "Seinfeld" as it appears on the cover of SAT and the *Seinfeld* logo which reveal defendants' intention to mislead consumers as to the origin of the book. Specifically, the *Seinfeld* logo and the word "Seinfeld" as it appears on the front cover of SAT share similar type face, and the *Seinfeld* lettering on the back cover appears in the same red coloring as the logo. Moreover, the word *Seinfeld* is prominently featured on the front and back covers of SAT. Though the Court agrees that there are unmistakable similarities between the *Seinfeld* logo and the SAT cover, there are distinct differences, as well. Most notably, the *Seinfeld* logo is written on a slant, with an inverted triangle over the "i." The word "Seinfeld," as it appears on the cover of SAT, is not adorned with any such flourishes.

Even accepting that the word "Seinfeld," as it appears on the cover of SAT, bears an unlikely resemblance to the *Seinfeld* logo, there is another important aspect of the SAT cover -- the disclaimer on the back cover of the book -- which is sufficient to create an issue of fact on the questions of bad faith and consumer confusion.

"Disclaimers are a favored way of alleviating consumer confusion as to source or sponsorship." Consumers Union of United States, Inc. v. General Signal Corp., 724 F.2d 1044, 1052-53 (2d Cir. 1983) ("We are satisfied that the disclaimer is adequate to distance CU and Regina"), cert. denied, 469 U.S. 823 (1984). The parties, predictably

enough, have sharply contrasting views of the disclaimer set out on the back cover of SAT. Plaintiff stresses the small lettering of the disclaimer; lettering that was reduced in size shortly before publication and made smaller than any other text in the book. Defendants draw the Court's attention to the black border surrounding the disclaimer, and to the shaded background allegedly designed to highlight that disclaimer. For purposes of the parties' competing claims for summary judgment, the Court is simply unable to find that any of these considerations is conclusive as a matter of law.

Given that those factors that plaintiff relies upon to establish consumer confusion are inconclusive, it is significant that plaintiff offers little in the way of empirical support for its claim. In fact, "[p]laintiff adduce[s] but one incident of actual confusion, and it is of scant probative value." Brown, 744 F. Supp. at 472. Specifically, plaintiff interprets NBC's decision to distribute copies of SAT in connection with a *Seinfeld* promotion as a clear indication that an average consumer could be misled as to the sponsorship of SAT. As plaintiff sees it, NBC's behavior suggests that the very network which airs *Seinfeld* mistook the book's origin. As defendants point out, however, the network's behavior might also be taken to suggest that NBC was not confused as to the origin of SAT so much as it was simply unconcerned with the origin of SAT.

Any inquiry into a defendant's alleged bad faith and the potential for consumer confusion necessarily entails a "factual inquiry." Brown, 744 F. Supp. at 467, 472. As such, summary judgment cannot be granted on plaintiff's claim of unfair competition unless there is no material dispute as to either of these matters. Id. at 472

("Subjective issues such as good faith and intent are generally inappropriate subjects of summary judgment."); see also Shaw, 38 N.Y.2d 201 (upholding denial of summary judgment where issue of material fact existed as to whether reasonably discriminating members of the public would be confused by publisher's advertising of bandleader's versions of musical compositions). Plaintiff certainly has not succeeded in eliminating any such dispute: "Similarity in overall appearance alone cannot establish source confusion as a matter of law. Nor is the addition of the anecdotal evidence . . . dispositive." Coach, 933 F.2d at 169. Defendants have fared no better; there are significant questions concerning the SAT cover, defendants' alleged bad faith during editing, and the adequacy of the book's disclaimer. In short, a dispute exists between the parties, a dispute which cannot now be resolved. Accordingly, the Court denies plaintiff's motion for summary judgment on its claim of unfair competition, as well as defendants' cross-motion on this same cause of action.

## CONCLUSION

For the reasons set forth above, the Court grants plaintiff's motion For summary judgment, on the issue of liability, on its claim of copyright infringement. As for plaintiff's common law claim of unfair competition, the Court finds that there remains a dispute as to material facts between the parties. Therefore, the Court denies plaintiff's request for summary judgment on this issue, as well as defendants' cross-motion for judgment in its favor.

A conference is scheduled for March 20, 1997, at 4:30 p.m., by which time the parties are directed to present the Court with a case management plan addressing how the measure of relief for the copyright infringement claim will be determined, and proposing a schedule for proceeding to trial on the claim of unfair competition.

### SO ORDERED

Dated: New York, New York  
February 27, 1997

  
Sonia Sotomayor  
U.S.D.J.

Barbara HAYBECK, Plaintiff,  
v.  
PRODIGY SERVICES COMPANY, a  
Partnership of Joint Venture with IBM  
Corporation  
and Sears Roebuck and Co., and Jacob Jacks,  
Defendants.

95 Civ. 9612(SS).

United States District Court,  
S.D. New York.

Nov. 12, 1996.

Customer who bought time on company's computer service and who had unprotected sex with company's employee who was positive for Human Immunodeficiency Virus (HIV) and who met customer in on-line company sex chat room brought action against company, alleging that, under theories of respondeat superior or negligent hiring and retention, company was responsible for employee's transmission of the HIV virus to her. Company moved to dismiss. The District Court, Sotomayor, J., held that: (1) employee was not acting within the scope of his employment with company when, outside the place of employment, he decided to conceal his HIV status from, and have unprotected sex with customer and thus, company could not be held liable, under the doctrine of respondeat superior, for employee's conduct, and (2) customer did not establish that company's hiring or retention of employee was negligent under New York law because customer did not allege that company knew that employee was concealing his HIV status from sex partners or was having unprotected sex with them.

Motion granted.

[1] MASTER AND SERVANT ⇔ 329  
255k329

Because determination of whether a particular act was within the scope of servant's employment for purposes of respondeat superior liability is so heavily dependent on factual considerations, the question is ordinarily one for the jury under New York law; however, where court takes as true all the facts alleged by plaintiff and concludes that the conduct complained of cannot be considered as a

matter of law within the scope of the employment, then court must dismiss complaint for failure to state claim.

[1] MASTER AND SERVANT ⇔ 332(2)  
255k332(2)

Because determination of whether a particular act was within the scope of servant's employment for purposes of respondeat superior liability is so heavily dependent on factual considerations, the question is ordinarily one for the jury under New York law; however, where court takes as true all the facts alleged by plaintiff and concludes that the conduct complained of cannot be considered as a matter of law within the scope of the employment, then court must dismiss complaint for failure to state claim.

[2] MASTER AND SERVANT ⇔ 302(2)  
255k302(2)

Under New York law, courts look to the following factors in considering whether a particular act falls within employee's scope of employment for purposes of respondeat superior liability: connection between the time, place, and occasion for the act; history of relationship between employer and employee as spelled out in actual practice; whether act is one commonly done by such employee; extent of departure from normal methods of performance; and whether the specific act was one that employer could have reasonably anticipated.

[3] MASTER AND SERVANT ⇔ 302(2)  
255k302(2)

Under New York law, employee was not acting within the scope of his employment with company which sold time on its computer service when, outside the place of employment, he decided to conceal his positive Human Immunodeficiency Virus (HIV) status from, and have unprotected sex with, company's customer whom he met in an on-line company sex chat room and thus, company could not be held liable, under the doctrine of respondeat superior, for the nondisclosure off duty conduct of employee, even if it acquiesced in the conduct by accepting the benefit of increased customer use of its services from employee's sexual activity.

[4] MASTER AND SERVANT ⇔ 302(1)  
255k302(1)

Under New York law, even where employee does not act within the scope of his employment, employer may be required to answer in damages for the tort of an employee against a third party when employer has either hired or retained the employee with knowledge of employee's propensity for the sort of behavior which caused the injured party's harm.

**[5] MASTER AND SERVANT ⇔ 303  
255k303**

Customer who purchased time from company on its computer service and who engaged in unprotected sex with company's employee who was Human Immunodeficiency Virus (HIV) positive and who met customer in on-line company sex chat room did not establish that company's hiring or retention of employee was negligent under New York law; customer did not, and presumably could not, allege that company knew that employee was concealing his HIV status from his sex partners or was having unprotected sex with them and the conduct complained of, whether it was the act of sex or employee's failure to disclose his HIV status, took place outside of employer's premises and without employer's chattels.

**[6] MASTER AND SERVANT ⇔ 302(1)  
255k302(1)**

Under New York law, when employee's conduct is beyond the scope of employment, employer's duty to third parties to prevent misconduct is limited to torts committed by employees on employer's premises or with employer's chattels.

\*327 Parker & Waichman, Jerrold S. Parker, Great Neck, NY, for Plaintiff.

Phillips Nizer Benjamin Krim & Ballon, L.L.P., New York City (Perry S. Galler, Thomas G. Jackson, Liza M. Cohn, Michael Fischman, of Counsel), for Defendants Prodigy Services Company, International Business Machines Corporation and Sears Roebuck and Co., Inc.

**OPINION AND ORDER**

SOTOMAYOR, District Judge.

In this diversity action, plaintiff alleges that she contracted the HIV virus from Jacob Jacks (hereinafter "Jacks"), [FN1] an employee of

defendant Prodigy Services Company (hereinafter "Prodigy"), whom plaintiff first met in an on-line Prodigy sex chat room. Plaintiff contends that under theories of respondeat superior or negligent hiring and retention, Prodigy is responsible for Jacks' transmission of the HIV virus to her because Prodigy knew that Jacks had the AIDS virus and knew that Jacks was having sex with customers he met on-line. Prodigy moves pursuant to Fed.R.Civ.P. 12(b)(6) to dismiss the complaint on the ground of failure to state a claim upon which relief can be granted. For the reasons to be discussed, defendant's motion to dismiss is granted.

FN1. Jacob Jacks is believed to be deceased at this time. Although named in the complaint, neither Jacks nor his estate have been served in this action. (Defs' Mem. at 3).

**\*328 BACKGROUND**

Plaintiff's complaint alleges that Prodigy injured plaintiff by its negligent conduct in allowing their employee, Jacob Jacks, to have sexual intercourse with customers with the knowledge that Jacks had AIDS. Although the complaint asserts that Prodigy's conduct injured plaintiff, it does not explain how. [FN2] Plaintiff's Affidavit and Memorandum of Law in Opposition to the instant motion, however, explain that after Jacks denied being HIV positive, plaintiff had sexual intercourse with him and contracted the AIDS virus. (Haybeck Aff.; Pl.Mem. at 4-5).

FN2. The Complaint merely asserts: "[t]hat by reason of the foregoing, plaintiff Barbara Haybeck sustained severe and permanent personal injuries, became sick, sore, lame and disabled, suffered mental anguish, was confined to hospital, bed and home and may, in the future, be so confined; was incapacitated and [sic] from attending to her usual duties and may in the future, be so incapacitated, plaintiff was and is substantially psychologically damaged, and plaintiff was otherwise damaged." (Compl. ¶ 152.)

The facts, assumed to be true for purposes of this motion, are that:

At some time prior to November 11, 1994 the plaintiff Barbara Haybeck became a customer of the defendant Prodigy. Prodigy sold time on their computer service and Barbara bought same. Jacob

Jacks was an employee of Prodigy. Mr. Jacks was a sexual predator who had full blown AIDS, a fact known and admitted by Prodigy....

By using his position as an employee of Prodigy, Jacks was able to spend countless hours on-line with plaintiff while he was at work at Prodigy's offices. In addition, Jacks gave plaintiff months of "free time" on the Prodigy network, as well as unlimited use of his own Prodigy account. The motive for this conduct was solely to entice Barbara Haybeck, by any means necessary, into an illicit and aberrant relationship that resulted in her having a consensual sexual relationship with Jacks. Both before and during this relationship, Jacks repeatedly denied having AIDS. Thereafter, and as a direct result of this sexual relationship, Barbara Haybeck contracted AIDS--from which she will die.

(Pl.'s Mem. at 4--5.)

Plaintiff contends that Prodigy "should have taken special precautions to prevent" Jacks' conduct. (Compl. ¶ 150) Plaintiff also insists that her injuries were "due solely to the negligence, carelessness, recklessness and gross negligence of the defendants in their ownership, operation, management, repair and control of their agents, servants, employees and their on-line network and through no fault of lack of care on the part of the plaintiff." (Compl. ¶ 151.)

Defendant argues, however, that Prodigy is not responsible for plaintiff's contraction of the AIDS virus from Jacob Jacks because Jacks' sexual intercourse with plaintiff fell outside the scope of his employment. Further, it maintains that Prodigy owed no duty to plaintiff to "[i]nvolve itself in her personal or sexual conduct," (Def.Mem. at 17), because Prodigy was forbidden by law and public policy either to inquire into Jacks' HIV status or to control his relations with persons outside the work environment. (Def.Mem. at 18--21.) Defendant also contends that plaintiff's consent to the sexual union was an "unforeseeable superseding act" which "absolve[s]" Prodigy of "any possible liability." (Def.Mem. at 22). Finally, defendant urges that plaintiff cannot satisfy the jurisdictional threshold of \$50,000 required for diversity jurisdiction because she accepted a contractual limitation of liability with Prodigy that limits her recovery to an amount below the threshold. (Def.Mem. at 24--25.)

#### DISCUSSION

A district court's function on a motion to dismiss under Fed.R.Civ.P. 12(b)(6) is to assess the legal feasibility of the complaint. *Kopec v. Coughlin*, 922 F.2d 152, 155 (2d Cir.1991). The issue "is not whether a plaintiff will ultimately prevail, but whether the claimant is entitled to offer evidence to support the claims." *Scheuer v. Rhodes*, 416 U.S. 232, 236, 94 S.Ct. 1683, 1686, 40 L.Ed.2d 90 (1974). Allegations contained in the complaint must be construed favorably to the plaintiff. *Walker v. New York*, 974 F.2d 293, 298 (2d Cir.1992), cert. denied, 507 U.S. 961, 113 S.Ct. 1387, 122 L.Ed.2d 762 (1993). Dismissal \*329 is warranted only where "it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief." *Ricciuti v. N.Y.C. Transit Authority*, 941 F.2d 119, 123 (2d Cir.1991) (quoting *Conley v. Gibson*, 355 U.S. 41, 45-46, 78 S.Ct. 99, 101-02, 2 L.Ed.2d 80 (1957) (footnote omitted)).

In considering a Rule 12(b)(6) motion, a court must look to: (1) the facts stated on the face of the complaint; (2) documents appended to the complaint; (3) documents incorporated in the complaint by reference; and (4) matters of which judicial notice may be taken. *Hertz Corp. v. City of New York*, 1 F.3d 121, 125 (2d Cir.1993) (citing *Allen v. WestPoint-Pepperell, Inc.*, 945 F.2d 40, 44 (2d Cir.1991)). See also *Samuels v. Air Transport Local 504*, 992 F.2d 12, 15 (2d Cir.1993) (same). In this case, I take judicial notice of the facts alleged in plaintiff's affidavit submitted in opposition to the instant motion because the facts explain the predicate for plaintiff's cause of action.

#### I. Scope of Employment

[1] The central issue in this case is whether Jacob Jacks' failure to disclose his HIV status before having sexual intercourse with the plaintiff was conduct which can be deemed to fall, as a matter of law, within the scope of his employment with Prodigy. I understand that "because the determination of whether a particular act was within the scope of the servant's employment is so heavily dependent on factual considerations, the question is ordinarily one for the jury." *Riviello v. Waldron*, 47 N.Y.2d 297, 302, 418 N.Y.S.2d 300, 391 N.E.2d 1278 (Ct.App.1979). However, where a court takes as true all the facts alleged by plaintiff and concludes that the conduct complained of cannot

be considered as a matter of law within the scope of employment, then the court must dismiss the complaint for failure to state a claim. See, e.g., *Rappaport v. International Playtex Corp.*, 43 A.D.2d 393, 352 N.Y.S.2d 241 (3d Dep't.1974) (reversing lower court for failing to dismiss where conduct fell outside of the scope of employment as a matter of law); cf. *Petrousky v. United States*, 728 F.Supp. 890 (N.D.N.Y.1990) (holding as a matter of law that plaintiff's supervisor was acting within the scope of his employment when he libeled plaintiff in disciplinary memoranda).

[2] In considering whether a particular act falls within an employee's scope of employment, New York courts look to five factors:

[1] the connection between the time, place and occasion for the act, [2] the history of the relationship between employer and employee as spelled out in actual practice, [3] whether the act is one commonly done by such an employee, [4] the extent of departure from normal methods of performance; [5] and whether the specific act was one that the employer could reasonably have anticipated.

*Riviello v. Waldron*, 47 N.Y.2d 297, 302, 418 N.Y.S.2d 300, 391 N.E.2d 1278 (Ct.App.1979). Here, defining carefully the precise act which is the subject of the complaint is crucial. To that end, it must be noted that plaintiff does not complain of Jacks' sexual relationship with her, but rather she complains of his failure to tell her that he was HIV positive and to engage in protected sex. In fact, plaintiff admits that she fully consented to the sexual union. Plaintiff insists, however, that had she known Jacks was HIV positive, she would never have consented to having sex with him. Hence, the core of plaintiff's complaint is that Jacks' failure to give her this information caused her injury, and it, therefore, is the proper focus of the scope of employment inquiry.

[3] Can it be said, then, that Jacks was acting within the scope of his employment with Prodigy when--outside the place of employment--he decided to conceal his HIV status from, and have unprotected sex with, a sexual partner? I conclude the answer is no. Courts have repeatedly held that acts taken and decisions made on an employee's personal time outside of work cannot be imputed to an employer. "New York courts have stated that 'where an employee's conduct is brought on by a

matter wholly personal in nature, the nature of which is not job-related, his actions cannot be said to fall within the scope of his employment.' " *Longin v. Kelly*, 875 F.Supp. 196, 201-203 (S.D.N.Y.1995) (quoting *Stavitz v. City of New York*, 98 A.D.2d 529, 531, \*330 471 N.Y.S.2d 272, 274 (1st Dep't 1984)); see also *Joseph v. City of Buffalo*, 83 N.Y.2d 141, 146, 608 N.Y.S.2d 396, 629 N.E.2d 1354 (Ct.App.1994) (police officer not acting within the scope of his employment when he left a service revolver where a child found it, even where a municipal law required the officer to have the gun nearby for emergencies); *Kelly v. City of New York*, 692 F.Supp. 303, 308 (S.D.N.Y.1988) (city not liable for assault by city corrections officer where "[i]t is undisputed that the incident ... arose from a prior personal dispute"); *Forester v. State*, 645 N.Y.S.2d 971 (Ct.Claims 1996) (state not responsible where SUNY instructor assaulted student, even where the "acts occurred on school property and during school hours").

In cases specifically involving sexual misconduct by employees, New York courts have carefully avoided extending liability to employers. See, e.g., *Joshua S. v. Casey*, 206 A.D.2d 839, 615 N.Y.S.2d 200 (4th Dep't 1994) (holding that a priest's sexual abuse of a child was, as a matter of law, not within the scope of employment); *Kirkman v. Astoria General Hospital*, 204 A.D.2d 401, 611 N.Y.S.2d 615 (2d Dep't 1994) (hospital security guard who raped a minor child was not acting within the scope of his employment); *Koren v. Weihs*, 190 A.D.2d 560, 593 N.Y.S.2d 222 (1st Dep't 1993) (psychotherapist who had sex with patient under the guise of treatment was not acting within the scope of his employment); *Noto v. St. Vincent's Hospital*, 160 A.D.2d 656, 559 N.Y.S.2d 510 (1st Dep't) (plaintiff "failed to allege facts on which the existence of a viable claim ... could be predicated" where she complained that her psychiatrist "engaged in sexual relations with her after she had been discharged, and after he had ceased treating plaintiff as his patient"), appeal denied, 76 N.Y.2d 714, 564 N.Y.S.2d 718, 565 N.E.2d 1269 (Ct.App.1990); *Heindel v. Bowery Savings Bank*, 138 A.D.2d 787, 525 N.Y.S.2d 428 (3d Dep't 1988) (mall security guard's rape of fifteen year old girl "was in no way incidental to the furtherance of [the employer's] interest" and was "committed for personal motives" and was "a complete departure from the normal duties of security guard."); *Cornell v. State*, 60

A.D.2d 714, 401 N.Y.S.2d 107 (3d Dep't 1977) ("homosexual attack" committed by attendant at mental institution upon a patient was "obviously neither within the scope of the attendant's employment nor done in furtherance of his duties to his employer").

In *Tomka v. Seiler Corp.*, 66 F.3d 1295, 1317 (2d Cir.1995), the Court of Appeals held that "an employer is not liable for torts committed by the employee for personal motives unrelated to the furtherance of the employer's business." In that case, plaintiff had been to a business dinner with several supervisors and co-employees when the group became highly intoxicated and a supervisor later sexually assaulted her. The Court viewed the assault as "a complete departure from the normal duties of a Seiler employee." *Tomka*, at 1318. In the instant case, the imposition of respondeat superior liability would be even more troubling because even if the sexual activity at issue furthered Prodigy's business by increasing a customer's use of its services, as alleged by plaintiff, the true conduct of which she complained is Jacks' failure to reveal a private medical condition while engaging in an off-duty, intimately personal act.

The purely personal decision by Jacks whether to disclose a medical fact about himself cannot be said to have furthered his employer's business. Rather, his decision to conceal his HIV status arose from a purely personal motivation. Therefore, just as New York courts have held that assaultive behavior arising from personal motivations do not further an employer's business, even where it is committed within the employment context, see e.g., *Heindel v. Bowery Savings Bank*, 138 A.D.2d 787, 525 N.Y.S.2d 428 (3d Dep't 1988) (mall security guard's rape of fifteen year old girl "was in no way incidental to the furtherance of [the employer's] interest" and was "committed for personal motives" and was "a complete departure from the normal duties of security guard."), so here must I conclude as a matter of law that Jacks' concealment of his HIV status arose from personal motivation and cannot be considered as within the scope of his employment.

One New York court has found that where "the business purpose alone would not have" prompted the conduct complained of, there \*331 can be no finding of employer liability. See *Rappaport v.*

*International Playtex Corp.*, 43 A.D.2d 393, 397, 352 N.Y.S.2d 241, 246 (3rd Dep't 1974) (in automobile accident involving salaried company sales agent traveling to home of a girlfriend where he intended to do employment-related paperwork, court finds that sales agent was not acting within the scope of employment and respondeat superior did not apply). Here, even if Jacks' conduct arose in part out of his intent to further the business of Prodigy in that his sexual relationship with plaintiff began on line and arguably encouraged plaintiff to use more Prodigy services, there is no "business purpose" which "alone" would have compelled Jacks either to have sex with plaintiff or to hide from her the fact that he had AIDS.

Therefore, considering the factors outlined in *Riviello*, I find, as a matter of law, that Jacks' failure to reveal his HIV status before having sex with plaintiff cannot be deemed to be within the scope of his employment. There is no "connection" in either "time, place, [or] occasion" between his status as a Prodigy employee and his failure to reveal his medical condition to his sex partner. Any "history of the relationship between [Jacks] and [Prodigy] as spelled out in actual practice" only reveals at best, accepting plaintiff's allegations as true, that Prodigy knew that Jacks had AIDS and that he was having sex with customers. It does not reveal that Prodigy knew that Jacks was failing to inform his sex partners that he carried the AIDS virus or that Prodigy did more than remain silent in the face of Jacks' conduct. Clearly Jacks' act, whether it was his sexual conduct or his failure to reveal his medical condition, cannot be considered "one commonly done by such an employee"--there is no allegation that technical advisors in positions such as Jacks' commonly have sex with customers or failed to reveal the fact that they carried communicable diseases. Finally, Jacks' conduct was obviously a "departure from normal methods of performance," and even if Prodigy knew that Jacks was having sex with customers, it could not "reasonably have anticipated" that Jacks was doing so without revealing his medical condition. See *Riviello v. Waldron*, 47 N.Y.2d 297, 302, 418 N.Y.S.2d 300, 391 N.E.2d 1278 (Ct.App.1979).

As an additional consideration, I note that by imposing respondeat superior liability on an employer in a case such as this, I would be setting a precedent under which employers would be forced

to monitor, and in some cases control, not only the health of their employees, but also the most intimate aspects of their off-duty lives. Such monitoring would contravene clear law and public policy that prohibits employers from inquiring into the HIV status of employees and attempting to control their off-duty behavior with others. See Americans with Disabilities Act, 42 U.S.C. § 12101 et seq. (prohibiting discrimination in the workplace based upon an employee's health condition); N.Y.Exec Law § 296 (prohibiting discrimination against persons because of their disability); Whalen v. Roe, 429 U.S. 589, 599, 97 S.Ct. 869, 876, 51 L.Ed.2d 64 (1977) (explaining that within the constitutional right to privacy there is an "individual interest in avoiding disclosure of personal matters"); Griswold v. Connecticut, 381 U.S. 479, 85 S.Ct. 1678, 14 L.Ed.2d 510 (1965) (recognizing a right of privacy, particularly in matters of sexuality); Doe v. City of New York, 15 F.3d 264, 267 (2d Cir.1994) ("Clearly, an individual's choice to inform others that she has contracted what is at this point invariably and sadly a fatal, incurable disease is one that she should normally be allowed to make for herself. This would be true for any serious medical condition, but is especially true with regard to those infected with HIV or living with AIDS, considering the unfortunately unfeeling attitude among many in this society toward those coping with the disease."); Doe v. Kohn Nast & Graf, P.C. 866 F.Supp. 190 (E.D.Pa.1994) (law firm prohibited from searching plaintiff's office upon suspicion that he had AIDS). Given the legal and policy limitations on an employer's ability either to control the off-duty conduct of its employees or to disclose the medical conditions of its employees, I find as a matter of law that Prodigy cannot be held liable for the non-disclosure off-duty conduct of its employee, even if it acquiesces in the conduct by accepting the benefit of increased customer use of its services from that employee's sexual activity.

**\*332 II. Prodigy's Negligent Hiring and Retention of Jacks**

[4] Even where an employee does not act within the scope of his employment, "an employer may be required to answer in damages for the tort of an employee against a third party when the employer has either hired or retained the employee with knowledge of the employee's propensity for the sort of behavior which caused the injured party's harm."

Kirkman v. Astoria General Hospital, 204 A.D.2d 401, 611 N.Y.S.2d 615 (2d Dep't 1994) (citing Detone v. Bullit Courier Service, Inc., 140 A.D.2d 278, 279, 528 N.Y.S.2d 575 (1st Dep't.1988)). Here, plaintiff contends that even if Prodigy is not vicariously liable for Jacks' conduct, it is nevertheless liable for its negligent hiring and retention of him as an employee whom they knew to be infected with AIDS and having sex with Prodigy customers. (Compl. at ¶¶ 155-169).

[5] What plaintiff fails to allege, however, is that Prodigy knew that Jacks was having unprotected sex with customers without informing them that he carried the AIDS virus. This is a critical distinction because it was not Jacks' having AIDS nor Jacks' having sex with customers which was tortious under the law. Rather, it was Jacks' having unprotected sex with others without informing them that he was HIV positive that plaintiff argues is tortious. Compare Maharam v. Maharam, 123 A.D.2d 165, 510 N.Y.S.2d 104 (1st Dep't 1986) (holding that "wife stated legally cognizable causes of action [against husband] for wrongful transmission of genital herpes on theories of either fraud or negligence") and Doe v. Roe, 157 Misc.2d 690, 598 N.Y.S.2d 678 (Justice Ct.1993) (explaining that "New York recognizes a cause of action for intentional or negligent communication of a venereal disease") with id. 598 N.Y.S.2d at 693 (dismissing action, inter alia, because "persons who engage in unprotected sex, at a time of the prevalence of sexually transmitted diseases, including some that are fatal, assume the risk of contracting such diseases. Both parties in an intimate relationship have a duty adequately to protect themselves. When on ventures out in the rain without an umbrella, should they complain when they get wet?"). Because plaintiff here has not, and presumably cannot, allege that Prodigy knew that Jacks was concealing his HIV status from his sex partners or was having unprotected sex with them, plaintiff cannot argue that Prodigy's hiring or retention of Jacks was negligent. See Kirkman v. Astoria General Hospital, 204 A.D.2d 401, 403, 611 N.Y.S.2d 615, 616 (2d Dep't), leave to appeal denied, 84 N.Y.2d 811, 622 N.Y.S.2d 913, 647 N.E.2d 119 (Ct.App.1994) (employer not liable for negligent hiring or retention of mall security guard who raped a customer where there was no showing that the employer had any knowledge of employee's propensity or history of such misconduct); Cornell

v. State, 60 A.D.2d 714, 401 N.Y.S.2d 107 (3d Dep't 1977) (holding that where "nothing in the record indicates that the [employer] either knew or should have known of [the employee's] alleged dangerous homosexual tendencies," no liability for negligent hiring or retention of the employee could be found), aff'd, 46 N.Y.2d 1032, 416 N.Y.S.2d 542, 389 N.E.2d 1064 (Ct.App.1979).

[6] Further, under New York law, when an employee's conduct is beyond the scope of employment, an employer's duty to third parties to prevent misconduct "is limited to torts committed by employees on the employer's premises or with the employer's chattels...." *D'Amico v. Christie*, 71 N.Y.2d 76, 87, 524 N.Y.S.2d 1, 6, 518 N.E.2d 896 (Ct.App.1987). Here, the conduct complained of, whether it is the act of sex or Jacks' failure to disclose his HIV status, unquestionably took place outside the employer's premises and without the employer's chattels.

#### CONCLUSION

For the reasons discussed above, defendant's motion to dismiss for failure to state a claim is GRANTED, and the Clerk of the Court is directed to enter judgment in Defendant Prodigy's favor, dismissing the complaint with prejudice. [FN3] The Clerk of the \*333 Court is also directed to dismiss the action against Jacob Jacks without prejudice pursuant to Fed.R.Civ.P. 4(m) in that plaintiff has not served Jacks within the 120 days specified by the rule and has failed to demonstrate cause for such failure.

FN3. In light of my finding that the action is dismissed for failure to state a claim, I do not reach Prodigy's argument that plaintiff cannot meet the threshold jurisdictional amount for diversity jurisdiction.

SO ORDERED.

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**FISHER SCIENTIFIC COMPANY, Plaintiff,**  
v.  
**CITY OF NEW YORK; New York City Council;**  
**Andrew Stein, as President Thereof;**  
**Charles Millard, C. Virginia Fields, Lawrence A.**  
**Warden, Jose Rivera, Rafael**  
**Castaneira-Colon, Walter L. McCaffrey, Karen**  
**Koslowitz, Annette Robinson, Susan**  
**Alter, as Council Members Constituting the**  
**Committee on Civil Service and Labor**  
**of the New York City Council, Defendants.**

No. 92 Civ. 8774 (SS).

United States District Court,  
S.D. New York.

Jan. 29, 1993.

Employer sought to enjoin city and city council from proposing, holding hearing on, or ratifying resolution expressing negative opinion about employer's labor negotiations. Employer requested preliminary and permanent injunctive relief. After trial, the District Court, Sotomayor, J., held that employer, which hired replacement workers during labor dispute, failed to show that it would suffer irreparable harm if city and city council were not enjoined from ratifying resolution expressing negative opinion about employer's labor negotiations and thus, employer was not entitled to permanent injunction.

Injunctive relief denied and complaint dismissed.

**[1] CONSTITUTIONAL LAW ⇔ 70.1(1)**  
92k70.1(1)

Courts' foray into ongoing legislative activity should be restrained by healthy respect for separation of powers; implicit in that doctrine, and intertwined with requirement of ripeness, is notion that court should give legislative body the opportunity to avoid running afoul of the Constitution.

**[2] CONSTITUTIONAL LAW ⇔ 70.1(1)**  
92k70.1(1)

Court may order legislative body to adopt particular act if legislators have signed consent decree stating that they would do so.

**[3] LABOR RELATIONS ⇔ 994**  
232Ak994

Employer, which hired replacement workers during labor dispute, failed to show that it would suffer irreparable harm if city and city council were not enjoined from holding hearing on or ratifying resolution stating that employer's use of replacement workers called into question the quality of its medical and laboratory supplies and recommending that city agencies buy supplies from companies other than employer, and thus, employer was not entitled to permanent injunction; employer was unable to identify even one customer that expressed concern over proposed resolution and resolution might undergo substantial modification before passage or might not be passed at all.

\*23 Pitney, Hardin, Kipp & Szuch, Morristown, NJ, for plaintiff; by Sean T. Quinn.

City of New York, Law Dept., New York City, for defendants; by Lawrence S. Kahn.

Shea & Gould, New York City, for Intervenor Intern. Broth. of Teamsters, Steel, Metal, Alloys and Hardware Fabricators and Warehousemen, Local 810, AFL-CIO; by Eve I. Klein, Joshua A. Adler, Mark S. Weprin.

**MEMORANDUM OPINION AND ORDER**

SOTOMAYOR, District Judge.

Plaintiff Fisher Scientific Company ("Fisher") seeks to enjoin defendants, the City of New York, the New York City Council ("City Council"), the City Council's Committee on Civil Service and Labor (the "Committee") and the members of the City Council (collectively, the "City Defendants"), from holding a hearing on or proposing, endorsing, or ratifying Resolution 910. Resolution 910 expresses a negative opinion about Fisher's labor negotiations with the International Brotherhood of Teamsters, Steel, Metal, Alloys and Hardware Fabricators and Warehousemen, Local 810, AFL-CIO (the "Union"), notes that Fisher's use of replacement workers calls into question the quality of its products, and recommends that City agencies buy medical and laboratory supplies from companies other than Fisher until Fisher rehires its Union workers. The parties agreed to combine the trial on

the merits on Fisher's application for a permanent injunction with the preliminary injunction hearing. For the reasons stated below, Fisher's application for injunctive relief is DENIED and the Complaint is dismissed. In addition, Fisher's request for an injunction pending appeal is DENIED.

#### I. Background

##### A. The Events Giving Rise to This Action

Fisher manufactures and distributes medical, laboratory, and scientific equipment. Fisher's Eastern Distribution Center ("EDC"), in Springfield, New Jersey, serves as a regional warehouse and distribution point for medical and laboratory equipment, such as microscopes and test tubes.

Since 1967, Fisher and the Union have been parties to successive collective bargaining agreements covering EDC employees. The most recent collective bargaining agreement expired by its own terms on October 21, 1991 and certain Union employees at the EDC then began to strike. Fisher operated the EDC with a reduced crew of supervisors and temporary replacements until February 1992, when it permanently replaced the economic strikers at the EDC. Since the strike began, negotiations between the parties have been unsuccessful.

By letter dated November 12, 1992, Yvonne Gonzalez, Assistant Counsel to the Speaker of the City Council, notified Fisher that the City Council's Committee would be holding a hearing on Resolution 910. Resolution 910 observes that Fisher "offered their warehouse employees [at the EDC] the ultimatum of accepting a 450% increase in the employee contribution to the health insurance premium, or going out on strike," and that Fisher rejected a cost-saving proposal by the Union and instead \*24 "permanently replaced those 77 long-service, experienced workers." Resolution 910 goes on to note that "[t]he quality of the products now offered by Fisher to medical institutions of the City of New York is compromised by the company's use of inexperienced replacement workers." For those reasons, the City Council would resolve to recommend "that every city agency that buys medical and laboratory supplies from Fisher Scientific seek alternative sources for products," and

that the City Council notify Fisher that its action "violates acceptable labor relation standards, and that the City of New York will seek to give preference to alternative suppliers until the [EDC] warehouse employees are rehired and reinsured."

A Committee hearing was originally scheduled for December 9, 1992. Fisher advised Ms. Gonzales that it believed that the proposed hearing on Resolution 910 constituted an unlawful interference with the collective bargaining process. Two days later, Fisher brought this action pursuant to 42 U.S.C. § 1983, alleging that the Committee's and Council's actions on Resolution 910 would violate its federal right to collective bargaining. Fisher sought a Temporary Restraining Order ("TRO"), and preliminary and permanent relief from any actions by the City Defendants on the proposed resolution.

At this Court's hearing on the application for a TRO, City Defendants announced that the Committee hearing on Resolution 910 was postponed until January, 1993. In addition, the Union entered an appearance, seeking to intervene in this action, as of right or by permission, or, alternatively, to participate in the proceedings as amicus curiae. [FN1] The Court did not grant the temporary injunctive relief that Fisher sought, finding that the adjournment of the hearing removed the immediate threat of irreparable injury, and that a balance of the equities favored affording the City Defendants the opportunity to respond fully to Fisher's application. The City Defendants, however, were ordered to notify the Court at least seven days prior to "any hearing on Resolution 910 or any other resolution or action similar thereto which relates to the labor dispute or the collective bargaining negotiations between [Fisher] and [the Union]."

FN1. The Union has satisfied the requirements of Fed.R.Civ.P. 24(a)(2) and its unopposed motion to intervene as of right is granted. See, e.g., *Farmland Dairies v. Comm. of New York State Dept. of Agriculture*, 847 F.2d 1038, 1043 (2d Cir.1988). The Court need not consider the Union's alternative motions to intervene permissively, pursuant to Fed.R.Civ.P. 24(b)(2), or to appear as amicus curiae.

A hearing was held in January on Fisher's

application for a preliminary injunction. The Court has granted the parties' request that, pursuant to Fed.R.Civ.P. 65(a), the preliminary injunction hearing be combined with the trial on the merits on Fisher's request for permanent injunctive relief. Timely notice has now been given that a Committee hearing on Resolution 910 is scheduled for February 1, 1993.

#### B. The City Council and Its Resolutions

A short review of the powers and procedures of the City Council, as well as the path by which a resolution is enacted, and its subsequent effect, illuminates the issues that this case presents.

The City Council and its committees possess and exercise all of the legislative power of the City of New York. The City Council's powers include the exclusive authority to adopt local laws and to adopt and modify the budget for New York City. In addition, the City Council has the authority to provide an opportunity for discussion of matters of public concern and to provide a forum for public comment on such issues through a public hearing process. Finally, the City Council, or any of its standing or special committees, may investigate any matters within its jurisdiction relating to the "property, affairs or government of the City." Charter of New York City § 29. The City Council is also charged with the regular review of the activities of New York City agencies. *Id.*

To implement these responsibilities and mandates, the City Council has previously \*25 held two different types of hearings. On the one hand, following the notorious fire at a Bronx social club that resulted in the death of over eighty people, a City Council committee conducted a vigorous full-scale investigation and public inquiry, that resulted in strong criticism of New York City's regulation of clubs. In contrast, other hearings have been convened to provide fora for discussion and public comment upon issues of public concern. According to the City Defendants, the hearing on Resolution 910 falls into this latter category of less formal inquiries.

Pursuant to City Council rules, a public hearing must be held before a committee may vote on a resolution. [FN2] If a Committee then chooses to vote on the resolution, and a majority of the

committee's members approves the resolution, it is then presented to the full City Council for consideration, where it may or may not be approved. A proposed resolution may be amended at numerous stages in the process. In contrast to a bill for a local law, no mayoral approval is required for a resolution: once the City Council passes the resolution, no further activity is required. In addition, unlike a local law, which has binding force and effect, a resolution such as that concerning Fisher is merely hortatory, with no binding effect.

FN2. There is a narrow exception for those resolutions that are introduced at a meeting of the full Council for immediate consideration. Resolution 910 does not fall within this exception.

#### II. Discussion

The purpose of a preliminary injunction is "to protect plaintiff from irreparable injury and to preserve the court's power to render a meaningful decision after a trial on the merits." Wright & Miller, 11 Federal Practice and Procedure § 2947; *Abdul Wali v. Coughlin*, 754 F.2d 1015, 1025 (2d Cir.1985). At the hearing on Fisher's application for a preliminary injunction, the parties agreed that no further evidence would be presented at any ultimate trial on the merits. The Court granted their request that the trial on the merits be consolidated with the preliminary injunction hearing, as prescribed by Fed.R.Civ.P. 65(a)(2). See, e.g., *McNeil-P.C.C., Inc. v. Bristol-Myers Squibb Co.*, 938 F.2d 1544, 1545 (2d Cir.1991). Thus, the trial on the merits has already been held, and Fisher's application for a preliminary injunction is now treated as a request for the permanent injunctive relief that Fisher sought in its Complaint.

Fisher asks this Court to enjoin City Defendants under 42 U.S.C. § 1983 from proposing, sponsoring, holding a hearing on, or ratifying Resolution 910. Fisher contends that such actions on City Defendants' part would deprive Fisher of its federal right to engage in collective bargaining free from state or municipal intrusion, as the Supreme Court has explained that right in *Lodge 76, Int'l Association of Machinists and Aerospace Workers v. Wisconsin Employment Relations Commission*, 427 U.S. 132, 140, 96 S.Ct. 2548, 2553, 49 L.Ed.2d 396 (1976) ("Machinists"), and its progeny, including *Golden State Transit Corp. v.*

City of Los Angeles, 475 U.S. 608, 614, 106 S.Ct. 1395, 1398, 89 L.Ed.2d 616 (1986) ("Golden State I").

[1][2] The City Defendants and the Union have offered a wide range of reasons why the Court should not issue the requested equitable relief, including legislative immunity, First Amendment rights, and lack of ripeness. Moreover, they have drawn compelling distinctions between this case and those labor law preemption cases on which Fisher relies, most notably *New York News, Inc. v. State of New York*, 745 F.Supp. 165 (S.D.N.Y.1990). However, the Court need not address any of these issues at this time for the simple reason that Fisher has failed to show that it would suffer irreparable injury if the Court denied its application for injunctive relief. [FN3]

FN3. This action raises serious questions about the power of a district court to enjoin legislative activity. If the courts could, and did, routinely entertain suits concerning pending legislation, they would be swamped with actions by citizens fearful that the destruction of their rights was imminent. Many of these putative suits regarding inchoate legislation are kept at bay by the requirement of ripeness, which also ensures that the court hearing such suits has the benefit of a precise factual framework. In addition, the courts' foray into ongoing legislative activity should also be restrained by a healthy respect for separation of powers. Implicit in that doctrine, and intertwined with the requirement of ripeness, is the notion that a court should give a legislative body the opportunity to avoid running afoul of the Constitution. See *Prentis v. Atlantic Coast Line Co.*, 211 U.S. 210, 227-30, 29 S.Ct. 67, 70-71, 53 L.Ed. 150 (1908). As the City Defendants have frequently reminded the Court, neither the Committee nor the City Council has yet passed Resolution 910, and they may yet conclude on their own that the Resolution in its current form is unlawful, or unwise. There are exceptions to this general hands-off rule. For example, although it is not the case here, a court may order a legislative body to adopt a particular act if the legislators had signed a consent decree saying that they would do so. See, e.g., *Spallone v. United States*, 487 U.S. 1251, 109 S.Ct. 14, 101 L.Ed.2d 964 (1988). However, none of the cases that Fisher cites in support of its request that this Court stop the legislative process in its tracks

involved injunctive relief directed at a legislature's mere consideration of a bill or resolution. See, e.g., *Golden State I* (city unlawfully conditioned a franchise renewal on the settlement of a labor dispute); *Machinists* (overturning state commission's order that Union cease and desist from certain activities); *New York News* (State Department of Labor enjoined from convening board of inquiry). However deeply troubled this Court may be about the reach of a district court's power into the legislative process itself, there is no need to address that question today because of Fisher's failure in this case to demonstrate that it will suffer irreparable harm absent injunctive relief.

\*26 [3] It is well established that a party seeking a permanent injunction must demonstrate "the absence of an adequate remedy at law and irreparable harm if the relief is not granted." *N.Y. State National Organization for Women v. Terry*, 886 F.2d 1339, 1362 (2d Cir.1989), cert. denied, 495 U.S. 947, 110 S.Ct. 2206, 109 L.Ed.2d 532 (1990). Fisher has not carried its burden of showing that it will suffer irreparable harm if the Defendants are not permanently enjoined from proposing, sponsoring, holding a hearing on, or ratifying Resolution 910. Consequently, its application for permanent injunctive relief must be denied.

Fisher contends that the consideration of Resolution 910 by the City Defendants constitutes impermissible intrusion by a municipal government into the collective bargaining process. At oral argument, Fisher conceded that a statement by the City Council members that they opposed Fisher's negotiation tactics and stance would not be unlawful. It also agreed that the City Defendants could conduct an investigation into a complaint about the safety of its products. Fisher's position, however, is that any type of hearing by the City Defendants to express an opinion on the collective bargaining process would be impermissibly coercive, and irreparably harmful, by raising the possibility of economic sanctions.

Nevertheless, Fisher has failed to introduce competent evidence sufficient to convince the Court that its faces irreparable harm. It has not shown that the City Defendants are forcing it to lose business or to capitulate to the Union, or that they will force it to do so. For example, Fisher was unable to identify even one customer that had expressed concern over

the proposed resolution.

Fisher also argues that the legislative process must be stopped now because the very passage of Resolution 910 would perfect a solicitation of an illegal boycott that would irreparably harm Fisher. However, the legislative proceedings that pertain to Resolution 910 are still at an embryonic stage. Resolution 910 may undergo substantial modification before passage or it may not be passed at all [FN4]. Even if did pass, Resolution 910 would merely render advice to agencies--advice which, the City Defendants tell us, the agencies would be free to ignore. Fisher has failed to introduce evidence as to how irreparable injury would follow the passage of a hortatory resolution. For example, Fisher has offered no evidence that any city agencies would follow such advice, and could not identify any city agencies that had stopped doing business with it as a result of the proposal of Resolution 910. For that matter, Fisher introduced no evidence on the \*27 portion of business that it does with city agencies. Fisher's counsel simply noted that after the Boston City Council passed a resolution nearly identical to Resolution 910, a Boston newspaper article reported that a hospital administrator there agreed with the boycott.

FN4. An action for damages or for an injunction against implementation of Resolution 910 would therefore be patently unripe at this juncture. See, e.g., *New Orleans Public Service, Inc., v. Council of City of New Orleans*, 491 U.S. 350, 371-73, 109 S.Ct. 2506, 2520, 105 L.Ed.2d 298 (1989) (ripeness holding in *Prentis* directed against "interference with an ongoing legislative process").

There is also no support for Fisher's contention that a legislative hearing would be coercive because it would present Fisher with the Hobson's choice of not defending itself, or of being forced to protect its interests at a hearing by disclosing its collective bargaining stance. Fisher, however, has failed to demonstrate that its absence from the hearing would necessarily result in the passage of Resolution 910, or that even if Resolution 910 did pass, irreparable harm would follow. Further, there is no merit to Fisher's suggestion that if it attended a hearing, it would be forced to reveal confidential bargaining goals and strategies that would compromise its collective bargaining position in abrogation of its federal rights. Even if the hearing did turn to the

question of Fisher's negotiation strategy, which may or may not happen, Fisher would not be forced to reveal anything. The City Defendants have expressly disclaimed their subpoena powers for the hearing. Unlike the enjoined proceedings in *New York News*, in which the parties would have been "[c]ompelled to produce documents and testify under oath setting forth their bargaining positions," 745 F.Supp. at 169, the contemplated hearing in this case would not be coercive. It will neither "disrupt the negotiations" nor "impact upon the positions of the parties." 745 F.Supp. at 170. Thus, Fisher has made no showing that its non-coerced attendance at a hearing held in conjunction with a legislature's consideration of a non-binding resolution would constitute such impermissible governmental intrusion as to result in irreparable harm.

In sum, Fisher has not convinced the Court that the consideration of Resolution 910 by the City Defendants is coercive in any way. Fisher has simply failed to demonstrate that it will suffer irreparable harm, and absent such proof, injunctive relief cannot issue. *N.Y. State National Organization for Women v. Terry*, 886 F.2d at 1362. This is not to say that Fisher may never have a meritorious claim against the City Defendants. Indeed, some of Fisher's suggestions regarding Resolution 910 are quite troubling. For example, Resolution 910 states at the outset that "[t]he quality of the products now offered by Fisher to medical institutions of the City of New York is compromised by the company's use of inexperienced replacement workers." Yet, counsel for the City Defendants admitted during oral argument that the Committee had received no complaints from Fisher's customers questioning the quality of its products. Fisher's observation that Resolution 910 may erroneously and unjustifiably raise the specter of a health and safety threat in order to act as an economic bludgeon is indeed alarming. The Court, however, cannot address this concern in view of the scanty record assembled so far and in light of the inchoate character of the resolution.

### III. Conclusion

For the reasons stated above, the Union's motion to intervene as of right is GRANTED. Fisher's motion for a preliminary injunction, as well as its current request for permanent injunctive relief, is DENIED and the Complaint is dismissed. Finally,

because the Court concludes that there is little likelihood of irreparable harm to Fisher if the City Defendants continue to consider Resolution 910 in accordance with the normal legislative procedures, Fisher's request for a Fed.R.Civ.P. 62(c) injunction pending appeal is DENIED.

SO ORDERED.

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1 UNITED STATES DISTRICT COURT  
2 SOUTHERN DISTRICT OF NEW YORK  
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3 UNITED STATES OF AMERICA,

4 v.

96 Civ. 5305 SS

5 LOUIS MENCHACA, AMY  
6 BOISSONNEAULT, KATHRYN  
7 TRUDELL and SHERYL FITZPATRICK,

8 Defendants.

-----x

9 August 26, 1996  
4:45 p.m.

10 Before:

11 HON. SONIA SOTOMAYOR,

12 District Judge

13 APPEARANCES

14 MARY JO WHITE  
15 United States Attorney for the  
Southern District of New York  
16 MARTIN J. SIEGEL  
Assistant United States Attorney

17 JOHN BRODERICK  
18 Attorney for Defendants

19  
20 D E C I S I O N

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23  
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1 THE COURT: Well, counsel, I have read the papers  
2 and I'm ready to rule. If you have anything to add to the  
3 papers before I do so, let me know now.

4 MR. SIEGEL: No, ma'am.

5 MR. BRODERICK: I don't, your Honor.

6 THE COURT: All right. I'll read my decision  
7 into the record. I'm not usually ready to rule, but it  
8 seemed as if the positions were straightforwardly set forth  
9 in the papers and there wasn't much to add.

10 This action arises under the Freedom of Access to  
11 Clinic Entrances Law of 1994 ("FACE") 18 U.S.C. Section 248,  
12 which provides for injunctive relief and statutory monetary  
13 relief against any person who

14 by force or threat of force or by physical  
15 obstruction, intentionally injures, intimidates or  
16 interferes with or attempts to injure, intimidate or  
17 interfere with any person because that person is or has  
18 been, or in order to intimidate each person or any other  
19 person or any class of persons from, obtaining or providing  
20 reproductive health services.

21 In its initial application filed on July 18,  
22 1996, the government sought a preliminary injunction  
23 enjoining the defendants from violating FACE and coming  
24 within 15 feet of the Women's Medical Pavilion ("WMP") at  
25 Dobbs Ferry. At a conference held in this matter on August  
1, 1996, I consolidated the government's application for a  
preliminary injunction with a trial on the merits under  
Federal Rule of Civil Procedure 65(a)(2).

1           The government alleges and has provided evidence  
2 that the four defendants in this action have over the course  
3 of six years, repeatedly hindered medical care at the WMP by  
4 physically blocking patient and staff attempts to enter the  
5 building. Each defendant has been arrested by Dobbs Ferry  
6 police on numerous occasions, convicted, served jail  
7 services, and been barred by state court orders of  
8 protection from coming near the WMP. Defendant Menchaca was  
9 convicted of trespass three times; defendant Boissonneault  
10 has been convicted three times of disorderly conduct and  
11 once of violating a permanent order of protection; defendant  
12 Trudell has been convicted twice of trespass and once of  
13 disorderly conduct; and defendant Fitzpatrick has been  
14 convicted twice of disorderly conduct, twice for violation  
15 of a permanent order of protection and once for trespass.  
16 All defendants had prior arrests for trespass that resulted  
17 in the charges being dismissed because the time served  
18 exceeded the maximum penalty.

19           The last incident of obstruction occurred on  
20 April 3, 1996, when each defendant blocked the only entry to  
21 the clinic by sitting at its doorway, which is at the rear  
22 of the building and which can only be reached by traversing  
23 an 18-inch wide, walkway from the building's parking lot.  
24 Police officers issued trespass warnings to the defendants  
25 who refused to leave and then the defendants were arrested

1 and removed. By blocking the only entrance to the clinic,  
2 patients and employees were prevented from gaining access to  
3 the building and from receiving or giving reproductive care.  
4 Of the twelve women scheduled for treatment, only six  
5 ultimately appeared for treatment. Without protests of the  
6 type conducted by defendants, the normal "no-show" rate for  
7 treatment is only 10 percent and not 50 percent as occurred  
8 on this date. Moreover, employees scheduled to engage in  
9 counseling of patients were prevented from rendering those  
10 services.

11 Now, defendants Menchaca, Boissonneault and  
12 Fitzpatrick have not filed papers in opposition to the  
13 government's request for a permanent injunction. Because  
14 the government has amply proven that these defendants have  
15 violated FACE by their obstruction of the WMP's only  
16 entrance on April 3, 1996, and because there is more than  
17 reasonable cause, given their past history, to believe that  
18 these defendants will continue their unlawful conduct, I  
19 find that issuing the injunction sought by the government  
20 against these defendants is warranted. The standards for  
21 injunctive relief are more than met in this case given the  
22 irreparable injury presumed because of the statutory harm  
23 caused by the defendants to the public's interest, and the  
24 government's proof of the FACE violations by these  
25 defendants.

1           The same finding for the same reasons can be  
2 applied to defendant Trudell but she has filed papers  
3 opposing the preliminary injunction and moving to dismiss  
4 the complaint in this action on the ground that FACE is  
5 unconstitutional. For the reasons to be discussed, I reject  
6 defendant Trudell's constitutional challenges to FACE.

7           The Government's Memorandum of Law in opposition  
8 to defendant's Trudell's Motion to Dismiss the Complaint and  
9 in Further Support of Plaintiff United States' Application  
10 for a Preliminary Injunction at pages 5, 10, 11-12 and 18,  
11 lists the circuit and district courts throughout the country  
12 that have addressed almost all of defendants' constitutional  
13 challenges to FACE. I have nothing new to add to the  
14 reasoning or analysis of those courts and merely incorporate  
15 those cases and their analysis by reference. Herein I am  
16 merely summarizing the essence of why I do not accept  
17 defendants' constitutional challenges.

18           I am aware of the deeply personal feelings that  
19 have motivated defendant's actions in this matter. I am  
20 also fully aware of the highly charged societal debate  
21 concerning reproductive rights in our nation. I further  
22 recognize the fine line between defendant's rights to  
23 passive, nonviolent protest, and the conduct prohibited by  
24 FACE. Nevertheless, I am compelled by Supreme Court  
25 precedence, including but not limited to *Cameron vs.*

1 Johnson, 390 U.S. 611, 617 (1968) and *Cox vs. Louisiana*, 379  
2 U.S. 559 (1965) to conclude that FACE in the context of this  
3 case does not penalize ideas or religious beliefs, but only  
4 that conduct, intentional obstruction of another's property,  
5 that infringes on the rights of WMP and its patients.

6 For similar reasons, I reject defendant's  
7 challenge to FACE as vague. I agree with the government  
8 that FACE is substantially similar to the statute upheld in  
9 *Cameron vs. Johnson* 390 U.S. 611, 617 (1968), and  
10 accordingly, I am bound by the *Cameron* reasoning to conclude  
11 that FACE is not unduly vague.

12 With respect to the defendant's challenge to FACE  
13 under the commerce clause and *United States vs. Lopez*, 115  
14 S. Ct. 1624 (1995), I, like Judge Sprizzo in *United States*  
15 *vs. Lynch*, 95 Civ 9223 (JES), his decision of February 23,  
16 1996, have examined the extensive legislative history of  
17 FACE and conclude that Congress had an ample and adequate  
18 basis to conclude that the blockade of clinics and other  
19 conduct examined by Congress has a likelihood of and does  
20 affect interstate commerce. I make this conclusion under  
21 the traditional analysis of commerce clauses set forth by  
22 the Supreme Court, see *Preseault vs. Interstate Commerce*  
23 *Clause*, 494 U.S. 1, 17, (1990) (courts "must defer to a  
24 congressional finding that a regulated activity affects  
25 interstate commerce if there is any rational basis for such

1 a finding") I too find that FACE survives a commerce clause  
2 challenge to its constitutionality based on this stricture  
3 by the Supreme Court.

4 Defendant's equal protection argument fails for  
5 the reasons her First Amendment challenge does not survive.  
6 FACE, as it relates to defendant's conduct, only regulates  
7 her unlawful conduct, not expression, and FACE in any event  
8 is narrowly tailored to protect the government's interest as  
9 expressed by Congress.

10 Finally, defendant Trudell's Eighth Amendment  
11 challenge to FACE's criminal penalties is not ripe for  
12 resolution because this action is a civil, not criminal,  
13 action.

14 In summary, I find that FACE withstands Trudell's  
15 constitutional challenges and deny Trudell's motion to  
16 dismiss the complaint in this action for the reasons I just  
17 stated.

18 Trudell, however, maintains that FACE requires an  
19 individual to have "discriminatory animus" towards the  
20 employee or patients at reproductive service facilities  
21 before an injunction can issue. Defendant contends and  
22 requests that a hearing on this issue be held. I agree with  
23 the government that nowhere in Section 248 of FACE is  
24 discriminatory animus set forth as a requirement and that  
25 FACE only requires proof that a person has intentionally

1 interfered with others for obtaining or providing  
2 reproductive care. On this issue, there is no dispute.  
3 Defendant in her opposition papers concedes that on April 3,  
4 1996, at WMP, she and others took their

5 accustomed places in a sitting position blocking  
6 the entrance. With reverence for life they sat down ... and  
7 devoutly awaited their arrest ... [T]hey were arrested. The  
8 clinic then opened. One-half of the women scheduled on that  
9 "abortion day" changed their minds and the clinic claims  
10 damages in this action for loss of that revenue.

11 This is taken from Trudell's opposition to the  
12 preliminary injunction at page 12.

13 This concession leaves no dispute at issue that  
14 plaintiff intentionally, albeit for deeply held personal  
15 views, obstructed the clinic's entranceway with the express  
16 purpose of interfering with the rights of the clinic's  
17 patients to obtain reproductive services and of the clinic's  
18 employees to give such services. No hearing, given  
19 defendant's concessions, on the issue of intent, the only  
20 requirement by FACE, is therefore necessary. Plaintiff has  
21 been fully heard and the injunction in Trudell's case will  
22 be issued for the same reasons it is issued against the  
23 three other defendants.

24 Finally, I, like Judge Sprizzo, in the exercise  
25 of my discretion, do not believe it warranted to impose  
26 statutory damages at this time. Defendants are advised,  
27 however, that any further conduct at WMP violating FACE will

1 both counsel the imposition of statutory damages at that  
2 time and constitute a contempt of this Court's order  
3 warranting other sanctions.

4 I note that I have carefully examined the  
5 description of the physical layout of this clinic and  
6 conclude that given the location of its driveway and only  
7 entrance, that a 15 feet injunction is the minimum amount of  
8 space necessary to safeguard the First Amendment rights of  
9 defendants while safeguarding the rights of persons using  
10 the clinic. The government should submit an order  
11 consistent with this opinion incorporating the Court's  
12 rulings on the motion to dismiss and the government's  
13 request for injunctive relief and statutory relief.

14 The government is warned that an injunction that  
15 says "don't violate the law" is meaningless. Read the case  
16 law on this issue. The injunction must specify the specific  
17 conduct which the defendant is prohibited from undertaking,  
18 not merely "don't violate the law." Everyone is under an  
19 obligation not to violate the law with or without an  
20 injunction, so set forth the specific conduct that the  
21 defendants are enjoined from engaging in.

22 I am going to request that the government give a  
23 copy of that order to Mr. Broderick. Mr. Broderick, you're  
24 representing all the defendants?

25 MR. BRODERICK: Yes, I am, your Honor.

1 THE COURT: Including Ms. Trudell?

2 MR. BRODERICK: Yes, your Honor.

3 THE COURT: Give a copy of the order to  
4 Mr. Broderick for his review. If you have objections to the  
5 order, make up a letter explaining what the objections are  
6 and then submit the entire package to me. Let's get this  
7 done by the end of the week.

8 MR. BRODERICK: Yes, ma'am.

9 THE COURT: Okay. Mr. Broderick, take a day to  
10 review the order. No longer than a day because I don't want  
11 a delay in entering this.

12 MR. BRODERICK: Sure.

13 MR. SIEGEL: The government also requested civil  
14 penalties.

15 THE COURT: I thought that's what I was ruling on  
16 when I said no statutory damages.

17 MR. SIEGEL: Well, the law provides both for  
18 civil penalties and statutory damages.

19 THE COURT: My intent was to say no to both for  
20 the reasons I indicated. I think if there's further action  
21 by these defendants, then it's appropriate in the exercise  
22 of my discretion. I will await their future decision on how  
23 they want to proceed. They've been given due warning --

24 MR. SIEGEL: Thank your Honor.

25 THE COURT: -- both by Congress and by me. All

1 right. That will dismiss this case hereafter, correct, once  
2 the injunction is issued and my decision?

3 MR. SIEGEL: It will, your Honor.

4 THE COURT: Thank you, counsel. Good papers on  
5 both sides by the way and not unimportant issues. But I'm  
6 not the one to decide them, Mr. Broderick.

7 MR. BRODERICK: I see, your Honor.

8 THE COURT: I'm bound by the Supreme Court.  
9 Thank you, counsel.

10 MR. BRODERICK: Thank you, your Honor.

11 MR. SIEGEL: Thank you.

12 (Record closed)

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