



COPYRIGHT CLAIMS BOARD

Docket number: 23-CCB-0211

September 7, 2023

Joseph Rooney

CLAIMANT

v.

Route One Apparel, LLC and Alexandra Von Paris

RESPONDENTS

SECOND ORDER TO AMEND NONCOMPLIANT CLAIM

The Copyright Claims Board finds that your claim, as amended, still does not comply with the requirements of the CASE Act and related regulations. You have not resolved the issues raised in the July 5, 2023 noncompliance order. The claim cannot move forward unless it is properly amended.

If you wish to proceed with this claim, you must file a second amended claim by **October 9, 2023**. If you do not, the Board must dismiss your claim without prejudice, although you may file again in the future before the Board or in federal court. There is no additional filing fee for an amended claim. If you file a second amended claim and it is found compliant, you will be notified and directed to proceed with service. However, if your second amended claim also is found not to comply, the Board will dismiss the proceeding without prejudice. 17 U.S.C. § 1506(f)(1)(B); 37 C.F.R. § 224.1(d).

To make your second amended claim compliant, you must resolve the issues identified below. 37 C.F.R. § 224.1(c)(2). You may also choose to correct or edit any errors or other information in your amended claim before you file it again. You do not need to provide a legal argument in your claim – just a statement of facts and circumstances. Being specific in your description gives the other party and the Board more information about your claim. There is no character limit, so please be as detailed as possible.

Clarity

It is not clear that your allegations state a claim for copyright infringement. You describe your allegedly infringed work as a slogan or product description titled “Old Bay 2 Go Slogan.” Your allegations indicate that the respondents copied the product description on their website, using “almost identical language with minimal changes.” However, as further explained below, certain allegations in the amended claim suggest that you may have created the work as a “joint owner” with respondent Alexandra Von Paris (“Von Paris”), or that you may have entered into an “implied license” for the respondents to use the work, even if there was no written contract. If the product description is jointly owned, then you cannot proceed with an infringement claim against a co-owner, and if there was an implied license you could only proceed if the respondents exceeded the scope of that license, or if the respondents failed to fulfill a “condition precedent,” as further described below.

To address these issues, your second amended claim must describe facts that indicate that the work was not jointly owned and that the respondents did not have, or exceeded, an implied license to use the work.

I. Joint Ownership

Your allegation that “I did share the copyright with [von Paris]” leaves the ownership of the copyright unclear, since sharing “the copyright” could mean sharing copyright ownership. If you mean that you simply gave *the work itself* to von Paris, your second amended claim should state more clearly that you provided the work itself to von Paris, instead of stating that you “shared the copyright” with her.

However, if you mean that you transferred or shared *copyright ownership* of the allegedly infringed work with von Paris, either because you agreed to do so or because you created the work together, then she would own or co-own the copyright, and you cannot raise an infringement claim against her. Information about joint ownership of a copyright is available at pages 9-10 of the [Responding to an Infringement Claim](#) chapter of the CCB Handbook. An owner or co-owner of a copyright in a work cannot be liable for infringement of that copyright. Joint owners generally must share any income they receive from their use and licensing of the work with the other owners, but a claim about failing to make such payments is called an “accounting” claim, which is not a claim that the Board can hear. Any respondent that is an owner or co-owner of the copyright in the allegedly infringed work must be removed from the claim as a respondent.

II. Implied License

As explained in the noncompliance order issued July 5, 2023, the allegations in the claim appeared to “describe a breach of contract dispute, not a copyright infringement.” The amended claim has the same issue. In the original claim, you alleged that “I intended to work with Alexandra and Route One Apparel to bring this product to market on their website. However, she pulled out of our agreement. . .” The noncompliance order requested more information about your agreement with the respondents. Your amended claim removes the allegation about an agreement, and states, “I did share the copyright with Alexandra. However, it is crucial to note that there was no contract in place between Alexandra and me concerning the copyright and I never gave her permission to use the copyright in any manner.” The amendment does not clarify the terms of your working relationship with the respondents enough to show that they did not have an implied license to use the “Old Bay 2 Go Slogan.”

As stated in the July 5, 2023 noncompliance order, “the facts stated in the claim suggest that your work may have been specifically created for the respondents’ use, as per a contract or agreement between you and the respondents.” Even if there was no written contract in place, there may have been an implied license, especially if you provided respondents with your work with the understanding that they could use the work in the way that they did. A license does not need to be in writing. It “may be implied from conduct or granted orally.” *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 514 (4th Cir. 2002).

An implied license is created when “(1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes the particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee-requestor copy and distribute his work.” *Id.* (quoting *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th

Cir. 1996)). To clarify whether your actions created an implied license, your second amended claim must state facts that indicate whether or not:

- the respondents requested the creation of the “Old Bay 2 Go Slogan”;
- you created the “Old Bay 2 Go Slogan” and delivered it to the respondents; and
- you intended that the respondents would copy and distribute it as they did.

In particular, you allege, “I created a slogan and product description for a specific product intended to be listed on an e-commerce website and used on the product’s blister packaging.” If you file a second amended claim, clarify whether you intended that the respondents would copy and use the “Old Bay 2 Go Slogan” in connection with a product listing on a particular website, and if so, which website.

If the facts alleged indicate that the respondents had an implied license to use the work, the Board may only hear the infringement claim if it also states facts indicating that the respondents failed to satisfy a “*condition precedent*” of the implied license, or that their use of the work went beyond the *scope* of the uses permitted under the license, both of which are explained below.

A. Condition Precedent to an Implied License

Your claim can proceed if you state facts in a second amended claim that indicate that a “condition precedent” had to occur before the implied license could take effect, and that it did not occur. A “condition precedent” is an act or event that must occur to trigger certain contract obligations. For example, if an author agrees that a licensee may publish her book “if, and only as long as” the licensee makes monthly payments to the author, then the payments may be a “condition precedent” to the licensee’s right to publish. Or, if a photographer allows a website to use his photograph “if” the website credits the photographer by name, that credit could be a condition precedent. If a copyright license depends on the licensee **first** satisfying a condition precedent, and the licensee does not satisfy it when using the work under copyright, then the license is not effective and the licensor may raise a copyright infringement claim.

Maryland law, which applies to any implied license related to this claim, disfavors interpreting a license provision as a condition precedent unless there was plain, unambiguous language or the condition is necessarily clear. *J.E. Dunn Construction Co. v. S.R.P. Development L.P.*, 115 F. Supp. 3d 593, 607 (D. Md. 2015).

You have not alleged that, in any communications with the respondents before they used the work, you set a condition for them to satisfy first. If such communications existed, your second amended claim should provide the terms you imposed, including any specific conditional wording. In order to show that any term of use was a “condition precedent” to an implied license, your second amended claim must include enough details about the term stated to show that it had to be satisfied before the implied license would take effect.

B. Scope of an Implied License

Your claim could also proceed if you present facts in a second amended claim that indicate that, even if an implied license existed, the respondents exceeded its scope by using your work in a way that the license would not

allow. To support a contention that the respondents' use of your "Old Bay 2 Go Slogan" exceeded the scope of an implied license, you must provide more details in a second amended claim to indicate how the use went beyond the scope of the implied license formed when you created and delivered the allegedly infringed works on request of the respondents.

Final Amendment

This is your third and final opportunity to submit a compliant claim in this proceeding. **If your claim remains noncompliant, the entire proceeding will be dismissed.** 17 U.S.C. § 1506(f)(1)(B).

To submit a second amended claim, log into your eCCB account and take the following steps:

1. From your dashboard, click the "**Amend claim**" button and select your docket number from the dropdown list.
2. Your claim will unlock for editing. The information you originally entered will appear in the same order as in your original claim.
3. Make the necessary edits. If you have filed supplemental documents, you must re-upload any documents you wish to include in the amended claim on the "**Documentation**" page. Please include only documents directly related to your claim, and label them clearly.
4. Once you have completed your edits, continue to click through the fillable claim form until you reach the "**Review**" page. The Review page includes all the information that you have provided in the claim up to this point. Carefully double-check the information on this page. If you have any corrections, you can select "**Edit**" to revise any entries necessary. Each section of information has an "**Edit**" button, which will take you back to that section so you can make changes. After you make changes, you can click "**Save & review**" to return to the Review page. Please review your claim carefully. Once you submit your amended claim, you will be unable to edit the claim while it is in compliance review.
5. Once you have completed your review and any revisions, you must confirm that the information in your claim is accurate and truthful to the best of your knowledge. To complete the declaration, type your full name into the "**Digital signature**" box near the bottom of the "**Review filing**" page and click "**Agree & submit.**"

If you have questions, please contact asktheboard@ccb.gov. Include your docket number in the subject line. The Board is unable to provide legal advice. We can only provide legal information and assistance concerning Board procedures and requirements. If you would like to seek further guidance from a lawyer or a law student at reduced or no cost, please visit the [Pro Bono Assistance](#) page on ccb.gov. You may also refer to the [Compliance Review](#) chapter of the CCB Handbook for more assistance.