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**UNITED STATES DISTRICT COURT**  
**DISTRICT OF NEVADA**

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SANDY HACKETT,

Plaintiff,

vs.

RICHARD FEENEY, an individual; ARTHUR  
PETRIE, an individual; TRP  
ENTERTAINMENT, LLC, a Nevada limited  
liability company, PLAYLV GAMING  
OPERATIONS, LLC d/b/a PLAZA HOTEL  
AND CASINO, a Nevada limited liability  
corporation, BROADWAY BOOKING OFFICE  
NYC, LTD, a New York corporation,

Defendants.

TRP ENTERTAINMENT, LLC, a Nevada  
limited liability company,

Counterclaimant,

vs.

SANDY HACKETT, an individual,

Counterdefendant.

TRP ENTERTAINMENT, LLC, a Nevada  
limited liability company,

Third Party Plaintiff,

vs.

THE HACKETT MILLER COMPANY, INC., a  
Nevada Corporation,

Third Party Defendant.

Case No.: 2:09-cv-02075-RLH-LRL

**ORDER**

(Motion for Leave to File  
Amended Counterclaim-#128;  
Motion for Partial Summary  
Judgment-#135; Motion for Partial  
Summary Judgment-#145; Motion for  
Partial Summary Judgment-#147)

1 Before the Court are Third-party Defendants/Third-party Counterclaimant The  
2 Hackett Miller Company's ("Hackett/Miller") **Motion for Leave to File Amended**  
3 **Counterclaims** (filed Apr. 6, 2011), Defendant/Counterclaimant/Third-party Plaintiff TRP  
4 Entertainment, LLC's **Motion for Partial Summary Judgment** (#135, filed June 2, 2011) on its  
5 false advertising and unfair competition claims, all the Defendants' **Motion for Partial Summary**  
6 **Judgment** (#145, filed June 2, 2011) on Plaintiff Sandy Hackett's copyright infringement claim,  
7 as well as Hackett and Hackett/Miller's **Motion for Partial Summary Judgment** (filed June 23,  
8 2011) on the issue of puffery. The Court has also considered the relevant Oppositions and Replies  
9 filed by the parties.

#### 10 BACKGROUND

11 Because the facts of this case are complicated the Court will only summarize the  
12 background necessary to generally explain this dispute, resolve these motions, and generally  
13 outline the procedural posture of this case.

14 Plaintiff Sandy Hackett and Defendants Richard Feeney and Arthur Petrie formed  
15 TRP Entertainment in 2002 to produce a live tribute show to the Rat Pack (as composed of Frank  
16 Sinatra, Dean Martin, Sammy Davis, Jr., and Joey Bishop). TRP Entertainment began production  
17 of the show (eventually titled "The Rat Pack is Back," though they have given it various names  
18 over the years), performing it here in Las Vegas and internationally. Hackett wrote the script for  
19 the show and acted in it as well.

20 In 2005, Hackett filed a copyright registration with the United States Copyright  
21 Office for the script he had originally created much earlier. The application matured into United  
22 States Copyright Registration No. PA 1-284-402, which is the copyright originally in dispute in  
23 this case. Hackett has since filed more copyright registrations for revisions to his script and filed  
24 to modify his original registration to correct certain errors.

25 In 2006, Feeney and Petrie contend that they bought out Hackett's interest in TRP  
26 Entertainment for \$40,000, which Hackett disputes. Regardless of any possible buyout, Hackett

1 continued his involvement in the production until 2009. At that point tension amongst Hackett,  
2 Feeney, and Petrie arose and Hackett was terminated from any further involvement with the show.  
3 The next day, Hackett informed Feeney, Petrie, and TRP Entertainment that he terminated “any  
4 license or consent he may have granted” in his copyrighted materials. (Dkt. #1, Compl. ¶ 21.)  
5 Defendants apparently did not cease production of their show and allegedly continued to use  
6 Hackett’s copyrighted material in the show.

7           After being separated from TRP Entertainment in 2009, Hackett formed  
8 Hackett/Miller with his wife (the “Miller” in Hackett/Miller) to produce a “new” tribute show to  
9 the Rat Pack based on Hackett’s same script. (The degree to which Hackett/Miller’s show is truly  
10 new is disputed in this litigation.) Hackett/Miller created a website using the TRP Entertainment’s  
11 original website designer and based off the same html and graphical code base to promote their  
12 show, Sandy Hackett’s Rat Pack Show. The website (and posters, billboards, etc.) included claims  
13 which TRP Entertainment contends are false advertising as they were either actually given to TRP  
14 Entertainment’s show or simply false entirely.

15           On October 28, 2009, Hackett filed suit alleging multiple claims, however, only the  
16 copyright infringement claim is discussed in this order. TRP Entertainment then filed various  
17 counterclaims against Hackett and a third-party complaint against Hackett’s new company,  
18 Hackett/Miller, but only the false advertising and unfair competition claims are discussed in this  
19 order. Finally, Hackett/Miller also filed counterclaims against TRP Entertainment, which it seeks  
20 to amend here. For the reasons discussed below, the Court denies TRP Entertainment’s motion on  
21 false advertising and unfair competition, denies Defendants motion on copyright infringement,  
22 grants Hackett and Hackett/Miller’s motion on puffery, and denies Hackett/Miller’s motion for  
23 leave to amend.

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## DISCUSSION

### I. Motion for Leave to Amend to Add Counterclaims

#### A. Legal Standard

Under Rule 15 of the Federal Rules of Civil Procedure, a party may amend its complaint only by leave of the court after 21 days have passed since responsive pleadings have been filed and in the absence of the adverse party's written consent. *Thornton v. McClatchy Newspapers, Inc.*, 261 F.3d 789, 799 (9th Cir. 2001). The court has discretion to grant leave and should freely do so "when justice so requires." *Allen v. City of Beverly Hills*, 911 F.2d 367, 373 (9th Cir. 1990) (quoting Fed. R. Civ. P. 15(a)). Nonetheless, courts may deny leave to amend if it will cause: (1) undue delay; (2) undue prejudice to the opposing party; (3) the request is made in bad faith; (4) the party has repeatedly failed to cure deficiencies; or (5) the amendment would be futile. *Leadsinger, Inc. v. BMG Music Publ'g*, 512 F.3d 522, 532 (9th Cir. 2008).

However, "a request for leave to amend made after the entry of a Rule 16 Scheduling Order is governed primarily by Rule 16(b)," rather than Rule 15. *C.F. v. Capistrano Unified School Dist.*, 656 F. Supp. 2d 1190, 1192 (C.D. Cal. 2009) (citing *Johnson v. Mammoth Recreations, Inc.*, 975 F.2d 604, 608–09 (9th Cir. 1992)). Rule 16(b) and Local Rule 26-4 require a showing of "good cause" before modifying a scheduling order. *See Mammoth Recreations*, 975 F.2d at 608–09. Only if the moving party shows good cause under Rule 16 does the Court then consider whether amendment is proper under Rule 15. *Id.* In other words, the Court first determines whether amendment of the scheduling order to extend the time for amending the pleadings is proper and then determines whether the actual amendment is proper under Rule 15.

#### B. Analysis

Hackett/Miller seeks to amend its answer to include three additional causes of action: (1) a declaratory judgment claim that "The Rat Pack" is generic in reference to live shows covering the Rat Pack; (2) cancellation or modification of the "The Rat Pack Is Back" mark because of genericness; and (3) cancellation of the "The Rat Pack Is Back" mark because of naked

1 licensing. However, Hackett/Miller has failed to show good cause for amending the scheduling  
2 order to allow for amending its answer to include these additional counterclaims. As  
3 Hackett/Miller has not met the Rule 16 standard, the Court does not address the more liberal Rule  
4 15 standard for amending the pleadings.

5           It is too late in this litigation to add claims that are only somewhat relevant or that  
6 would require the Court to reopen discovery. At the time this motion was filed, discovery was still  
7 open. However, discovery closed in this case in July, it is now September and trial is scheduled  
8 for October. While discovery may not be necessary for Hackett/Miller's first two proposed  
9 additional counterclaims, a substantial amount of discovery would be necessary for the naked  
10 licensing claim. *See generally*, Anne Gilson LaLonde, *Gilson on Trademarks* § 6.04. Further,  
11 Hackett/Miller's proposed reasons for needing to add the naked licensing claim at this time are  
12 insufficient to delay trial and reopen discovery. Thus, the Court denies amendment as to the third  
13 proposed additional counterclaim.

14           As to the first two proposed additional counterclaims, Hackett/Miller argues that  
15 these claims are necessary only because *TRP Entm't, LLC v. BC Entm't, Inc.*, 2:08-cv-579-LDG-  
16 RJJ, 2009 WL 5102960 (D. Nev.) was recently dismissed for failure to prosecute despite the  
17 Honorable Lloyd D. George granting summary judgment in favor of BC Entertainment on these  
18 same claims. However, on the same day this motion was filed, a motion to reconsider the  
19 dismissal was filed in *BC Entm't*. Judge George has since granted that motion, vacated the  
20 dismissal, and entered a partial judgment granting much of the relief Hackett/Miller wishes to seek  
21 with these amended counterclaims (specifically a ruling that "The Rat Pack" is generic in reference  
22 to the Rat Pack and an order that the U.S. Patent and Trademark Office add a disclaimer to TRP  
23 Entertainment's trademark for "The Rat Pack Is Back" mark), thus negating much of  
24 Hackett/Miller's argument and reasons for needing to add these counterclaims. For all of the  
25 above reasons, the Court denies the motion to amend.

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