

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

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EASTER UNLIMITED, INC. d/b/a FUN
WORLD,

Plaintiff,

MEMORANDUM & ORDER
18-CV-06637 (KAM)

-against-

TERRY ROZIER,

Defendant.

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KIYO A. MATSUMOTO, United States District Judge:

Plaintiff Easter Unlimited, Inc. d/b/a Fun World ("Plaintiff" or "Easter") commenced this action alleging that Defendant Terry Rozier ("Defendant" or "Mr. Rozier") unlawfully produced merchandise bearing a design in violation of Plaintiff's copyright and trademark rights. Plaintiff asserts six claims pursuant to the Copyright Act, 17 U.S.C. § 501 et seq., and the Lanham Act, 15 U.S.C. § 1114, including the following: direct copyright infringement (Count I), contributory copyright infringement (Count II), vicarious copyright infringement (Count III), trademark infringement (Count IV), federal trademark counterfeiting (Count V), and dilution by blurring (Count VI). (*See generally* ECF No. 13, Amended Complaint ("Am. Compl.").) Plaintiff seeks statutory damages under the Copyright Act, actual damages under the Lanham Act,

permanent injunctive relief, and attorneys' fees and costs.
(*Id.* at 11-12.)

Pending before this Court are a motion for partial summary judgment filed by Plaintiff and a cross-motion for summary judgment filed by Defendant. Plaintiff moves for partial summary judgment on its claims against Defendant as to Counts II-IV for contributory copyright infringement, vicarious copyright infringement, and trademark infringement. (See ECF No. 49-5, Memorandum of Law in Support of Plaintiff's Motion for Partial Summary Judgment ("Pl. Summ. J. Mem.")) Defendant moves for summary judgment on all six/ of Plaintiff's claims. (See ECF No. 52-22, Memorandum of Law in Support of Defendant's Motion for Summary Judgment ("Def. Summ. J. Mem.")) For the reasons set forth below, Plaintiff's motion for partial summary judgment is DENIED in its entirety. Defendant's cross-motion for summary judgment is GRANTED.

BACKGROUND

I. Factual Background¹

A. The Parties

Plaintiff Easter Unlimited, Inc., is a business that designs, manufactures, and supplies costumes, masks, holiday

¹ The following facts are taken primarily from the parties' respective Statements of Material Facts pursuant to Local Civil Rule 56.1 ("56.1 statement"), and have not been specifically or directly disputed with admissible evidence unless otherwise noted.

items, and novelty gifts. (Pl. 56.1 Statement ("56.1") ¶ 2.) Among these products is a ghost face mask with shroud ("Ghost Face Mask") for which Easter Unlimited holds a copyright registration, effective as of February 23, 1993. (*Id.* at ¶ 19; ECF No. 14-1, Am. Compl. Ex. 2, Certificate of Registration VA 552 798.) The Certificate of Registration states the "nature of this work" as "sculpture," and the title as "ghost mask with shroud" and "Glow in Dark & Fluorescent - Item #9206/9207." (ECF No. 14-1, Am. Compl. Ex. 2, Certificate of Registration VA 552 798, p. 2.) The certificate of registration for the supplementary registration is dated June 21, 1999, and states the title of the work is "'Ghost Face' Mask with Shroud." (*Id.* at p. 4.) The parties dispute the identity of the original author the Ghost Face Mask; Plaintiff presents a declaration stating that Hong Kong-based sculptor Fok Lee created the mask for Easter Unlimited as part of a work-for-hire relationship, while Defendant presents a declaration stating that Alterian Studios originally created the mask called the "Wailer" in early 1991. (See ECF No. 49-2, Declaration of Alan Geller ("Geller Decl.") ¶¶ 14-18; see also ECF No. 52-2, Gardner Decl. ¶¶ 17-22.)

Easter Unlimited also holds a trademark registration under registration number 4,256.208, most recently updated and registered as of December 11, 2012. (See Pl. 56.1 at ¶¶ 30-31;

see also ECF No. 14-2, Am. Compl., Ex. 3; Geller Decl. ¶¶ 9-10.)

The United States Patent and Trademark Office ("USPTO")

describes the trademark as follows:

The mark consists of a stylized representation of a ghost outlined in red with a white face, black eyes, nose and mouth, a black cloak and holding a black and gray knife in its left hand. The stylized wording "Ghost Face" appears in shades of gray to white below the ghost design with a red drop hanging off the letter "F" in "Face". The Black rectangle represents background only and is not part of the mark.

(ECF No. 14-2, Am. Compl. Ex. 3, USPTO Reg. No. 4,256,208, at p.

1.) The mark in the USPTO registration is depicted below:



(*Id.*)

Defendant Terry Rozier is a professional basketball player in the National Basketball Association ("NBA") who currently plays for the Charlotte Hornets. (Def. 56.1 ¶ 1.) Mr. Rozier began his NBA career when he was drafted in the first round of the 2015 NBA draft by the Boston Celtics. (*Id.* at ¶ 2.) In 2018, Mr. Rozier, a backup guard, filled in when Celtics' star point guard Kyrie Irving ("Mr. Irving") was

injured; this was Mr. Rozier's first start after appearing in more than 160 regular season games. (Def. 56.1 ¶ 3; Pl. 56.1 ¶ 33.) Mr. Rozier became the first NBA player since the 1970-71 season to earn a triple-double in his first career start. (Pl. 56.1 at ¶ 34.)

B. Events Giving Rise to the Complaint

Plaintiff alleges that the Ghost Face Mask for which it holds a copyright registration, appears as follows:



(ECF No. 1-1, Compl., Ex. 1.)² In or about 1996, Easter Unlimited granted Dimension Films a license to use the Ghost Face Mask in the 1996 film *Scream*. (Pl. 56.1 at ¶¶ 23-24.) *Scream* was "a wildly successful box office sensation," and the

² Plaintiff submitted Exhibit 1 as part of its original Complaint. (ECF No. 1, Compl.) Plaintiff subsequently filed an Amended Complaint, and though it continued to reference this same Exhibit 1, Plaintiff failed to attach Exhibit 1 to its Amended Complaint. (See ECF No. 13, Am. Compl., at ¶ 18 ("Plaintiff is the original designer of the Ghost Face Mask, as set forth in *Exhibit '1'* which is annexed hereto and incorporated in its entirety herein."))

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