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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. CV 11-6471-GHK (JCGx)

Date January 18, 2012

Title *Sin Kwang Thé v. Jacob Rydberg aka Jake Mace, et al.*

Presiding: The Honorable

GEORGE H. KING, U. S. DISTRICT JUDGE

Beatrice Herrera

N/A

N/A

Deputy Clerk

Court Reporter / Recorder

Tape No.

Attorneys Present for Plaintiffs:

Attorneys Present for Defendants:

None

None

Proceedings: (In Chambers) Order re: (1) Motion for Preliminary Injunction (Dkt. No. 23); (2) Motion to Strike Side by Side DVD and Supplemental Declaration of Teri Pham (Dkt. No. 43); (3) Motion to Strike Request for Judicial Notice (Dkt. No. 57)

This matter is before the Court on (1) Plaintiff Sin Kwang Thé's ("Plaintiff") Motion for Preliminary Injunction; (2) Defendants Jacob Rydberg aka Jake Mace ("Rydberg") and Chinese Shaolin Center, LLC dba Phoenix Longevity Arts's (collectively, "Defendants") Motion to Strike Side by Side DVD and Supplemental Declaration of Teri Pham ("Defendants' Motion to Strike"); and (3) Plaintiff's "Motion to Strike Improper and Untimely Request for Judicial Notice" ("Plaintiff's Motion to Strike"). We have considered the papers filed in support of and in opposition to the Motions, as well as the Parties' oral arguments at the January 9, 2012 hearing on this matter. Because the Parties are familiar with the facts in this case, we will repeat them only as necessary. Accordingly, we rule as follows.

I. Background

Plaintiff filed this action against Defendants on August 5, 2011. According to the Complaint, Plaintiff is a Grandmaster of Shaolin Do, a form of Shaolin kung fu that he purports to have created. (Compl. ¶¶ 10-11). Plaintiff "registered his system of Shaolin Do with the United States Copyright Office" in 1990. (*Id.* ¶ 12). He "created and owns several service marks and trademarks in connection with his promotion and teachings of his system of Shaolin Do" for which he has filed applications with the U.S. Patent and Trademark Office. (*Id.* ¶¶ 15).

Rydberg is Plaintiff's former student who opened his own martial arts school in Phoenix, Arizona. (Motion for Preliminary Injunction ("PI Mot.") 2, 4). Beginning in 2002, Rydberg licensed the right to use Plaintiff's name, image, trademarks, and copyrighted materials in exchange for conducting annual student testing with Plaintiff, which included a testing fee of \$50-\$100 per student. (*Id.* at 3-4). However, on October 3, 2010, Rydberg allegedly informed Plaintiff that he would no longer comply with Plaintiff's annual testing and fee requirements but would nevertheless continue to teach his martial arts system. (*Id.* at 5; Thé Decl. ¶ 23). On October 29, 2010, Plaintiff's prior counsel

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sent Rydberg a letter withdrawing Plaintiff's consent for the use of his name, image, trademarks, and copyrighted forms, (Thé Decl., Exh. I), which Plaintiff characterizes as a cease and desist letter, (*id.* ¶ 24).

In November 2010, Plaintiff hired a private investigator to conduct video surveillance of Rydberg's school. (Buckholtz Decl. ¶ 2). The investigator conducted a second video surveillance on June 17, 2011. (*Id.* ¶ 5). Several months later, on August 5, 2011, Plaintiff filed this action alleging (1) copyright infringement; (2) trademark infringement; (3) violation of Lanham Act § 43(a); (4) unfair competition (Cal. Bus. & Prof. Code § 17200); (5) right of publicity; (6) violation of privacy (Cal. Civ. Code § 3344); and (7) breach of contract. Several additional months later, on November 7, 2011, Plaintiff filed this Motion for Preliminary Injunction ("Motion").

II. Motion for Preliminary Injunction

A. Legal Standard

Plaintiff argues that in resolving this Motion, we should employ the Ninth Circuit's "sliding scale" test in which "[a] preliminary injunction may be granted if the moving party shows either (1) a combination of probable success on the merits and the possibility of irreparable harm, or (2) the existence of serious questions going to the merits, the balance of hardships tipping sharply in its favor, and at least a fair chance of success on the merits." (PI Mot. 6 (citing *Senate of Cal. v. Mosbacher*, 968 F.2d 974, 977 (9th Cir. 1992))). Plaintiff appears to assert that we need not examine irreparability of harm provided that he establishes a likelihood of success on the merits. (*Id.* at 6, 14 ("It has long been established that the damages occasioned by trademark infringement, are by their very nature, irreparable and not susceptible to adequate measurement for remedy at law. Once a party has made a showing of likelihood of confusion, irreparable harm will be presumed." (citation omitted))).

Plaintiff is incorrect. Since the Supreme Court's decisions in *Winter v. NRDC*, 555 U.S. 7 (2008),¹ irreparable harm can no longer be presumed in copyright or trademark infringement cases. See *Flexible Lifeline Sys., Inc. v. Precision Lift, Inc.*, 654 F.3d 989, 998 (9th Cir. 2011) ("[O]ur long-standing precedent finding a plaintiff entitled to a presumption of irreparable harm on a showing of likelihood of success on the merits in a copyright infringement case . . . has been effectively overruled. . . . Accordingly, we hold that even in a copyright infringement case, the plaintiff must demonstrate a likelihood of irreparable harm as a prerequisite for injunctive relief, whether preliminary or permanent."); *Kerr Corp. v. N. Am. Dental Wholesalers, Inc.*, No. SACV 11-0313 DOC (CWx), 2011 WL 2269991, at *2 (C.D. Cal. June 9, 2011) (stating that in a trademark case, the plaintiff "cannot evade its burden to demonstrate a likelihood of irreparable injury even if it established a likelihood of success

¹ The Court held: "A plaintiff seeking a preliminary injunction must establish that he is likely to succeed on the merits, that he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his favor, and that an injunction is in the public interest." *Winter*, 555 U.S. at 20.

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on the merits”). However, the Ninth Circuit’s sliding scale test has survived *Winter*, provided irreparable harm is demonstrated. See *Alliance for Wild Rockies v. Cottrell*, 632 F.3d 1127, 1134 (9th Cir. 2011) (“[T]he ‘serious questions’ approach survives *Winter* when applied as part of the four-element *Winter* test. That is, ‘serious questions going to the merits’ and a balance of hardships that tips sharply towards the plaintiff can support issuance of a preliminary injunction, so long as the plaintiff also shows that there is a likelihood of irreparable injury and that the injunction is in the public interest.”).

Accordingly, to obtain preliminary injunctive relief, Plaintiff must establish all four *Winter* requirements: likelihood of success on the merits, irreparable harm, the balance of equities tipping in his favor, and that an injunction is in the public interest. However, these factors can be established on a sliding scale such that “a stronger showing of one element may offset a slightly weaker showing of another.” *Alliance for Wild Rockies*, 632 F.3d at 1131. Moreover, because a preliminary injunction is an “extraordinary remedy,” Plaintiff must make a “clear showing that [he] is entitled to such relief.” *Winter*, 555 U.S. at 22 (2008).

B. Discussion

1. Likelihood of Success on the Merits

(a) Copyright Infringement

To prevail on a copyright infringement claim, Plaintiff must show that he owns a copyright and that Defendants copied protected elements of the copyrighted work. *Narell v. Freeman*, 872 F.2d 907, 910 (9th Cir. 1989). Plaintiff’s moving papers are unclear about the copyright he purports to own. His Motion repeatedly refers to his “copyrighted system of Shaolin Do.” (See, e.g., PI Mot. 1, 5; see also *id.* at 3 (“Thé recorded his system of Shaolin Do with the United States Copyright Office”); *id.* at 8 (“Thé obtained copyright registration for his Shaolin Do system in 1990.”)). Plaintiff, of course, cannot copyright a “system” of martial arts. See 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”). Recognizing this rule, Plaintiff’s counsel clarified during oral argument that Plaintiff’s claimed copyright is not of his entire system but rather of particular sequences of martial arts techniques in which his claimed originality is the selection and ordering of those techniques. We find some support for this assertion in Plaintiff’s moving papers, (PI Mot. 3 (referring to “a series of specific martial arts movements and exercises that are performed in a specific manner and order”); Reply 3-4 (referring to “the same sequence and series of movements performed the same way each time”); *id.* at 6 (“Defendants are free to teach [self defense] ‘techniques’ without copying the same sequences and ordering copyrighted by the Grandmaster”). Thus, notwithstanding statements to the contrary in his Complaint and Motion, Plaintiff does not intend or purport to claim ownership over the martial arts system of Shaolin Do.

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Because Plaintiff registered his purported copyright with the Copyright Office in 1990 and deposited a videotape of the sequences he purports to have created, he argues that his copyright is presumptively valid under the 1976 Copyright Act.² (PI Mot. 7-8). First, Defendants challenge the applicability of this presumption. They argue that these sequences were “published” in the early 1980s via a public education series by Kentucky Entertainment Television (“KET”) on “karate,” (Opp’n ¶¶ 5, 8), and thus do not enjoy a presumption of validity. See 17 U.S.C. § 410(c) (“In any judicial proceedings the certificate of a registration *made before or within five years after first publication of the work* shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” (emphasis added)).³ Second, Defendants argue that regardless of the presumption, Plaintiff transferred his copyright to KET, which claimed a copyright in the karate series that it had broadcast.⁴

The Parties have neither sufficiently briefed these arguments, nor presented facts and evidence for us to assess their merits. For example, the Parties have presented no evidence showing who taped the karate series (Plaintiff or KET). Nor is there any evidence of the content of any agreement between KET and Plaintiff. Accordingly, we cannot at this time adequately assess whether any prior

² During oral argument, Defendants’ counsel argued for the first time that the Copyright Act of 1909 governs this dispute and that choreography is not protectable under that Act. As the argument was not briefed by the Parties, and ultimately does not affect our disposition of this Motion, we decline to consider it at this time.

³ If KET taped Plaintiff’s performance and broadcast it in the karate series, we are skeptical of Defendants’ claim that this broadcast constitutes “prior publication” of the work. See 1-4 NIMMER ON COPYRIGHT § 4.11 (“Under the current Act, the distribution of copies of a motion picture to television stations for broadcast purposes constitutes an act of publication, while broadcasting per se is merely a performance and hence, not an act of publication.”); H.R. Rep. No. 94-1476 (1976) (“The [1976 Act’s] definition [of publication] clears up the question of whether the sale of phonorecords constitutes publication, and it also makes plain that any form or dissemination in which a material object does not change hands – performances or displays on television, for example – is not a publication no matter how many people are exposed to the work.”).

During oral argument, Defendants’ counsel also made a vague reference to another video that may have been produced by Plaintiff and distributed for Hollywood screen testing purposes. However, this allegation was not included in Defendants’ Opposition, and Defendants have provided absolutely no evidence as to the purported video. We decline to consider it at this time.

⁴ Defendants’ counsel states that he has “a good faith belief that if allowed discovery from KET [he] could prove Plaintiff signed an agreement with KET giving up all intellectual property rights in the contents of the broadcast.” (Olson Decl. ¶ 8). Such a statement, unsupported by evidence, is insufficient to cast serious doubt on this issue. Moreover, we note that unless any purported agreement between Plaintiff and KET explicitly transferred ownership of Plaintiff’s purported work (that is, the Shaolin Do sequences performed) to KET, KET’s copyright over the video series itself would not seem to encompass Plaintiff’s purported copyright to the specific movements performed therein.

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publications affect the presumption of validity and/or whether there was any effective transfer of Plaintiff's purported copyright to KET. On this record, we do not purport to conclusively determine whether (1) the copyright is valid, (2) it is owned by Plaintiff, and/or (3) Plaintiff enjoys a presumption of validity.

Moreover, even assuming that Plaintiff validly registered his purported copyright within five years of its first publication, the presumption of validity of the copyright is just that: a presumption that can be rebutted by, for example, a lack of originality or creativity in the purportedly protected work. *See Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 489 (9th Cir. 2000); *e.g., Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003) (holding that an artist's glass-in-glass jellyfish sculptures were unprotectable notwithstanding the plaintiff's registration of those works with the Copyright Office, because the works did not contain sufficient originality).

We have serious doubts about the validity and/or scope of Plaintiff's copyright. As Plaintiff acknowledges, individual martial arts movements are not copyrightable, (Reply at 3); each sequence must have at least minimal originality to be protectable. However, we are unable to determine precisely what sequences are claimed to be copyrighted. Plaintiff lodged a copy of the DVD that was deposited with the Copyright Office. Plaintiff's counsel clarified at oral argument that Plaintiff purports to have copyrighted individual sequences contained within the DVD, as opposed to the entire contents of the DVD as one long, single sequence. However, even after viewing the DVD multiple times, we cannot determine precisely where one sequence ends and another begins, and Plaintiff provided no clarification on this issue at oral argument. Because we cannot tell precisely where each sequence begins and ends, we are also unable to judge the originality of the selection and ordering of those movements, which is the only element of Plaintiff's work that is arguably protectable. Moreover, because Plaintiff's work consists of a combination of unprotectable elements, thus reflecting minimal originality, any protection that Plaintiff enjoys is "thin" and "protects against only virtually identical copying." *See Satava*, 323 F.3d at 811. For that reason, the importance of identifying precisely the sequences that were purportedly copyrighted cannot be overstated.

Because we are unable to determine precisely which sequences are purportedly copyrighted, we are also unable to determine whether these sequences were copied by Defendants. The side-by-side DVD lodged by Plaintiff is largely useless in determining whether the precise sequences were copied, as the timing, camera angle, and exercises performed in the compared videos do not appear in sync. Meanwhile, Rydberg states under penalty of perjury that he "do[es] not teach the punches, kicks, movements and techniques in the same order as in the DVD [lodged with the Court]." (Rydberg Decl. ¶ 4).

In light of the foregoing, Plaintiff has not established a likelihood of success on the merits or even serious questions going to the merits. Plaintiff has failed to submit evidence that allows us to even determine precisely what sequences Plaintiff purports to have copyrighted, and whether those sequences contain sufficient originality to be protectable under copyright law. Plaintiff has also failed to establish whether Rydberg teaches the same or "virtually identical" sequences as Plaintiff purports to have

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copyrighted. Moreover, Rydberg has provided a declaration signed under penalty of perjury that he does not teach those same sequences. Given that Plaintiff's protection, if any, is very thin, his inadequate showing does not even demonstrate that he has at least a fair chance of success on the merits.

(b) Trademark Infringement

To establish trademark infringement, Plaintiff must show that (1) he is the owner of a valid, protectable trademark, (2) that Defendants used that mark without Plaintiff's consent, and (3) that Defendants' use of the mark is likely to cause confusion as to the source or affiliation of the mark. *See* 15 U.S.C. § 1125(1); *Credit One Corp. v. Credit One Fin., Inc.*, 661 F. Supp. 2d 1134, 1137 (C.D. Cal. 2009). Plaintiff states that he designed several marks that are associated with his teaching and with his Shaolin Do system. (Thé Decl. ¶ 8). Defendants do not dispute that Plaintiff is the owner of valid, protectable marks. Instead, the Parties dispute whether Defendants have used those marks without Plaintiff's consent in a way that is likely to cause confusion.

Plaintiff alleges that Defendants have infringed on his marks by using them on their website and in promotional materials. (PI Mot. 6). More specifically, Plaintiff claims that Defendants posted on their website and Facebook page photographs of Rydberg and others wearing these marks (contained on patches and belts on their martial arts uniforms). By doing so, Defendants have used the marks in a way that is likely to cause confusion about whether Defendants are associated with Plaintiff.⁵

The primary dispute between the Parties centers on the timing of the alleged infringement. It is undisputed that prior to late 2010, Plaintiff had given permission to Rydberg to use his trademarks as part of Plaintiff's licensing agreement. (Thé Decl. ¶¶ 14, 16 (noting that Rydberg was authorized to teach Shaolin Do and that instructors who are so authorized are permitted to use Plaintiff's name, image, and marks in their promotional materials)). On October 29, 2010, Plaintiff's prior attorney sent a letter to Rydberg withdrawing Plaintiff's consent to the use of his name, image, trademarks, and copyrighted forms. (Thé Decl., Exh. I). Accordingly, if Plaintiff cannot provide any evidence that Defendants used these marks after receiving the October 29, 2010 cease and desist letter, then Plaintiff cannot establish a likelihood of success on his trademark infringement claim.⁶

⁵ We note that Plaintiff does not allege that Defendants have produced or sold these patches, or that Defendants have produced counterfeit versions of Plaintiff's patches. Rather, it appears that the patches worn by individuals in the photographs at issue were earned by these individuals when they trained with Plaintiff.

⁶ If Plaintiff has a valid claim for trademark infringement (that is, if Defendants used Plaintiff's marks in a way likely to cause confusion after Plaintiff withdrew his consent for the use of those marks), but Defendants have since ceased using the marks, then the need for a preliminary injunction is not obviated by Defendants' voluntary cessation if there is a possibility of recurrence of the infringement. *See FTC v. Affordable Media*, 179 F.3d 1228, 1237-38 (9th Cir. 1999). However, if due to Defendants'

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Whether Defendants removed photographs containing Plaintiff's marks from their website and promotional materials is a factual dispute between the Parties. Defendants state that photos of Plaintiff, Rydberg, and others were removed from their websites after Rydberg received the cease and desist letter. (Opp'n 13-16; Rydberg Decl. ¶ 2; Reply 1). Plaintiff states that this is not true, and that "[u]ntil this action and motion were filed, defendants repeatedly refused to stop marketing their unauthorized school with plaintiff's trademarks, name and images . . ." (Reply 1).

Although Plaintiff bears the burden of making a "clear showing that [he] is entitled to such relief," *Winter*, 555 U.S. at 22 (2008), he has provided no evidence of Defendants' use of these marks after October 29, 2010. Upon filing this Motion, Plaintiff's counsel provided a declaration attaching "true and correct copies of pages of images of the Grandmaster and his trademarks my office printed from the website of Phoenix Longevity Arts at www.phoenixlongevityarts.com." (Pham Decl. ¶ 4). However, this declaration provides no information on when these images were printed. During oral argument, counsel pointed out that one print-out attached to the declaration contains a date in the lower right-hand corner, which she characterized as the date on which the page was printed. Upon examination of this page, however, we are not able to determine whether any allegedly infringing mark is present on the uniform of the individuals pictured in the small, blurry photograph contained on that page. Most of the other images attached to her declaration are similarly small and blurry, making it difficult or impossible to determine whether the patches worn by the participants depicted in the picture are the same as Plaintiff's marks, and no other page includes any indication of the date on which it was printed. Further, Plaintiff provides no specifics regarding which individuals in which images are wearing the purportedly protected marks that would guide us in our infringement analysis. Moreover, this declaration also does not provide a proper evidentiary foundation for these photographs, as it only states that counsel's "office" printed these images. Counsel failed to identify (much less include a declaration signed by) the individual who printed the images or to state the specific dates on which they were printed.

With Plaintiff's Reply, counsel provided a supplemental declaration that is also insufficient to provide any evidentiary showing on infringement. The supplemental declaration merely states: "Between July and October 2011, my office downloaded photographs and images of Grandmaster Thé and his trademarks from the defendants' website and from their Facebook page." (Pham Supp. Decl. ¶ 3). Counsel attached no photographs and images to the supplemental declaration and made no reference to photographs or images already filed with the Court, making it impossible to determine whether the photographs and images mentioned in her supplemental declaration are the ones attached to her original declaration. Moreover, even if she had said so, counsel still failed to lay a proper foundation for her assertion that the photographs and images were downloaded in 2011. Counsel does not state that *she* downloaded the images on a specific date or dates, or that she directed a particular staff member to do so. Rather, the declaration says amorously that her "office" downloaded the images on various

timely voluntary cessation, they never infringed on Plaintiff's trademark (that is, if Defendants voluntarily ceased using the marks after receiving notice that Plaintiff revoked his consent for the use of his marks), then Plaintiff cannot establish a likelihood of success on the merits.

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occasions over a period of three months. Accordingly, these declarations are insufficient to lay a proper foundation to establish the dates on which the images were purportedly downloaded or printed.

At oral argument, the Parties for the first time made reference to a second cease and desist letter that was purportedly sent to Defendants in 2011. Defendants' counsel expressed some ambiguity as to whether all of the allegedly infringing images were taken down after the first letter revoking consent (in which case no infringement occurred) or after the purported second letter was sent. However, this issue was not briefed by the Parties, and the purported second letter has not been provided to the Court. The record lacks sufficient clarity for us to make any determination of whether Defendants infringed Plaintiff's trademark.⁷ The fact remains that Plaintiff has provided no admissible evidence showing that Defendants used Plaintiff's marks after consent was revoked on October 29, 2010, while Defendants allege that the images were removed upon receipt of Plaintiff's cease and desist letter from Plaintiff's prior attorney. (Opp'n 13 (stating that Rydberg "has stopped wearing the patches since receiving a cease and desist order"); Rydberg Decl. ¶ 2 (stating that the marks were removed from his website "after receiving a cease and desist letter from Plaintiff's prior attorney")). With a lack of any evidence on infringement, Plaintiff has not established a likelihood of success on the merits, or even serious questions going to the merits with at least a fair chance of success on the merits.

(c) *State law claims*

Plaintiff claims that due to Defendants' use of Plaintiff's photograph on their website and promotional materials, Defendants are liable under a common law "right of publicity" claim and California Civil Code § 3344. Section 3344 imposes liability on "[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent." The common law claim "may be pleaded by alleging (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury." *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992) (quoting *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 417 (1983), *superseded by statute on other grounds as stated in KNB Enters. v. Matthews*, 78 Cal. App. 4th 362 (2000)).

⁷ Moreover, to the extent Defendant's counsel expressed any uncertainty regarding whether images remained after receipt of the first cease and desist letter, his only uncertainty appeared to be whether other individuals (not Rydberg) had posted images on Facebook, which were then linked to Phoenix Longevity Arts's Facebook page and therefore viewable in Phoenix Longevity Arts's Facebook photo gallery, some of which may have remained after the first cease and desist letter was received. This was not discussed in either of the Parties' papers, nor have the Parties briefed whether such posting by non-defendants constitutes Defendants' "use" of Plaintiff's trademarks in a manner likely to cause confusion. Accordingly, Defendants' counsel's equivocation on this issue does not show a likelihood of infringement.

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These state law claims involve virtually the same allegations as Plaintiff's trademark claim: that Defendants posted photographs on their website and promotional materials that contained content that could not be posted without Plaintiff's consent. Accordingly, Plaintiff's insufficient evidentiary showing likewise dooms his state law claims. Plaintiff has provided no admissible evidence showing that Defendants used photographs of Plaintiff after receipt of the October 29, 2010 letter.⁸ Thus, Plaintiff fails to establish a likelihood of success on the merits, or even serious questions going to the merits with at least a fair chance of success on the merits.

2. Remaining *Winter* Factors: Irreparable Harm, Balance of Hardships, Public Interest

Based on the foregoing findings and conclusions, Plaintiff is not entitled to injunctive relief. But even assuming he had established a likelihood of success or serious questions going to the merits of his claims, he is also not entitled to injunctive relief because of his failure to establish the remaining factors of the *Winters* test.

First, Plaintiff fails to establish irreparable harm, a prerequisite to injunction relief. Plaintiff provides no showing on this factor, instead stating in conclusory terms:

[T]he defendants' wholesale use of the Grandmaster's copyrighted materials, trademarks, name and image not only causes irreparable injury to the Grandmaster in the form of lost revenue and lost students, but also to his reputation and goodwill, and deceives the public and harms consumers. Monetary damages alone will not be able to compensate the Grandmaster for the damage to his reputation and goodwill by being involuntarily associated with defendants' school, which is not subject to the Grandmaster's conditions or guidelines.

(PI Mot. 14). The risk of lost revenue is of course not irreparable, and the risk of "lost students" is exceedingly speculative. Plaintiff is located in Los Angeles, (Compl. ¶ 4), while Rydberg's school is located in Phoenix, (PI Mot. 4). It is difficult to see how students would choose Rydberg as an instructor over Plaintiff, given that the two are not in the same geographic market. Plaintiff has made no showing that he has any schools in the Phoenix area, or that he receives fees from any schools in the Phoenix

⁸ Defendants argue that because the photographs at issue were taken by Rydberg or at Rydberg's instructions, Rydberg's copyright in the photograph preempts Plaintiff's state law claims. We are skeptical of the merits of such an argument, given the Ninth Circuit's decision in *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001). In *Downing*, the court held that where the alleged violation is not the publication of the photograph but rather the use of the likenesses and names of the individuals pictured in the published photograph, state law privacy claims are not preempted by the Copyright Act. *Id.* at 1004 ("A person's name or likeness is not a work of authorship within the meaning of 17 U.S.C. § 102. This is true notwithstanding the fact that Appellants' names and likenesses are embodied in a copyrightable photograph."). However, because it is not necessary to our disposition of this Motion, we do not purport to decide this issue at this time.

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area, such that Defendants could conceivably “lure” students away from “authorized instructors.” Plaintiff’s claims of loss of goodwill and reputation are also speculative and conclusory, unsupported by any evidence or even argument.

Moreover, even Plaintiff’s conclusory claim of irreparable harm is undercut by his delay in bringing this action and Motion. A delay in bringing an action of even a few months weighs against injunction relief, as does a further delay in bringing a motion for preliminary injunction. *See, e.g., Kerr Corp. v. N. Am. Dental Wholesalers, Inc.*, No. SACV 11-0313 DOC (CWx), 2011 WL 2269991, at *3 (C.D. Cal. June 9, 2011) (“Kerr cannot plausibly assert that it faces irreparable injury because of NAD when it demonstrated little urgency in its seeking a preliminary injunction. It has been roughly eight months since Kerr learned of NAD’s alleged infringement”); *Studio Red, Inc. v. Rockwell Architecture Planning & Design, P.C.*, No. C 07-396 CW, 2007 WL 1462458 (N.D. Cal. May 18, 2007) (preliminary injunction denied because, *inter alia*, plaintiff asked defendant to stop using its trade name in August 2006, did not file an infringement lawsuit in federal court until January 2007, and did not seek preliminary injunctive relief until April 2007); *GTE Corp. v. Williams*, 731 F.2d 676, 678 (10th Cir. 1984) (“Although plaintiff contends that it will be irreparably harmed should defendants; activities not be enjoined, it has waited nearly a year before seeking any relief. Delay of this nature undercuts the sense of urgency that ordinarily accompanies a motion for preliminary relief and suggests that there is, in fact, no irreparable injury.”), *cited in SRI Intern. v. Acoustic Imaging Technologies Corp.*, No. C-92-5015-VRW, 1993 WL 356896, at *4 (N.D. Cal. Sept. 3, 1993).

Plaintiff states that on October 3, 2010, Rydberg informed him in no uncertain terms that he would continue to teach without paying Plaintiff’s required license fee. (Thé Decl. ¶ 23). On October 29, 2010, Plaintiff revoked his consent for Defendants to use his copyrighted sequences, trademarks, and name and likeness. (*Id.* ¶ 24). On November 18, 2010, Plaintiff sent a private investigator to secretly videotape Plaintiff’s classes. (Buckholtz Decl. ¶ 3). Accordingly, if Defendants were infringing on Plaintiff’s trademarks, copyright, or appropriating Plaintiff’s name or likeness for economic advantage, Plaintiff possessed all of this information by November 2010. However, Plaintiff did not file this lawsuit until August 5, 2011. Worse yet, Plaintiff did not seek injunctive relief until November 7, 2011 – more than three months after this action was filed. Plaintiff’s failure to show irreparable harm, and his delay in bringing this action and Motion, suggest that the “extraordinary remedy” of a preliminary injunction is not warranted in this case.

Plaintiff also fails to establish that the balance of hardships weighs “sharply” in his favor, as would be required if he had at least established serious questions going to the merits of his claim. He states, again in a conclusory fashion, that “there would be no harm to defendants should an injunction issue, as defendants are free to teach other forms of martial arts, and can utilize other images and marks to promote their school.” (PI Mot. 5). To the extent Defendants currently use Plaintiff’s photographs and trademarked symbols, it may not be too burdensome to order Defendants to cease the use of these items. However, an injunction over the use of Plaintiff’s purported copyrighted sequences would be quite burdensome, particularly given the lack of clarity about which specific sequences are purportedly copyrighted. Given this vagueness, Defendants would understandably fear being at risk of contempt by

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Title *Sin Kwang Thé v. Jacob Rydberg aka Jake Mace, et al.*

teaching any of the underlying techniques. This hardship to Defendants is substantial inasmuch as Rydberg would be effectively deterred from practicing his profession.

Moreover, our refusal to grant a preliminary injunction would result in minimal, if any, harm to Plaintiff when compared with the harm to Defendants. Defendants consist of one martial arts school and its instructor. An injunction that could conceivably prevent Defendants from teaching a form of martial arts could do irreparable damage, as it could be nearly impossible to win back the students that might leave while the injunction is in place. However, by his own admission Plaintiff receives fees from more than 100 schools around the world; failing to enjoin the instruction of one school in a city where Plaintiff has not alleged that he has authorized any other individuals to teach would not appear to significantly impact Plaintiff. *See Applied Materials, Inc. v. LTD Ceramics, Inc.*, No. C-01-20478-JF(PVT), 2002 WL 971721, at *2 (N.D. Cal. Mar. 22, 2002) (“[G]iven the disparity in size and income between Applied on the one hand and LTD and SET on the other, the Court is persuaded that the balance of hardships tips sharply in Defendants’ favor”). Finally, given that this action involves a narrow dispute between private parties, the “public interest” factor does not weigh strongly for or against injunctive relief.

C. Conclusion

Plaintiff has not established a likelihood of success on the merits, or even serious questions going to the merits with at least a fair chance of success on the merits of his copyright, trademark, or state law claims. He has also failed to show irreparable harm, and even his conclusory allegations of irreparable harm are undercut by his significant delay in bringing this action and this Motion. Finally, in light of the lack of clarity regarding the purportedly copyrighted forms and the disparity in size and income between the Parties, Plaintiff has failed to establish that the balance of harms tips in his favor, much less tips *sharply* in his favor. In light of the foregoing, we hereby **DENY** Plaintiff’s Motion for Preliminary Injunction.

III. Motions to Strike

We hereby **DENY** Defendants’ and Plaintiff’s respective Motions to Strike.

IT IS SO ORDERED.

Initials of Deputy Clerk

Bea