

January 29, 2020

VIA ECF

Honorable Katherine Polk Failla
United States District Court
Southern District of New York
40 Foley Square
New York, NY 10007-1312

Re: *Polaris Images Corp. v. Enttech Media Group, LLC*, 1:19-cv-08208

Dear Judge Failla:

We represent Plaintiff Polaris Images Corp. (“Polaris”) and Nkechi Diallo a/k/a Rachel Dolezal (“Dolezal”) in the above-captioned case and write in response to Defendant Enttech Media Group, LLC (“Defendant”)’s second motion for a pre-motion conference to dismiss the amended complaint under Fed.R.Civ. P. 12(b)(6).

In order to avoid unnecessary motion practice, and given the procedural disposition of the case, we have opted to voluntarily dismiss the action as of right under Rule 41. However, in light of counsel’s previous representations to the Court, we would like to explain our position in response to the issues raised by Defendant’s second letter motion.

Defendant argues that Dolezal does not have standing to sue because Plaintiff’s counsel previously represented that Polaris is the exclusive licensee to the Photograph at issue. We respectfully aver that subsequent to the first pre-motion conference, we re-analyzed Polaris’ exclusive agreement with Dolezal in light of prevailing caselaw and determined in good faith that it was Dolezal, rather than Polaris, who has standing to sue. The issue ultimately comes down to one of contractual interpretation and the timing of when Dolezal transmitted her Photograph to Polaris. It is a complex issue, and presents a question of first impression, so we have attempted to navigate the issue based on our good faith application of the law to the facts.

Under the Copyright Act, “exclusive licenses are recognized as a type of an ownership interest, conveying a particular exclusive right of copyright.” *Davis v. Blige*, 505 F.3d 90, 100 n.10 (2d Cir. 2007); *see also* 17 U.S.C. § 101 (A “[c]opyright owner,” with respect to any one of the exclusive rights comprised in a copyright, refers to the owner of that particular right.”). As the owner of one or all of the exclusive rights under the Copyright Act, “[e]xclusive licensees may sue” for copyright infringement. *Davis*, 505 F.3d at 100 n.10; *see also* 17 U.S.C. § 201(d)(2) (“The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.”). Moreover, “the legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement of that particular right committed while he or she is the owner of it.” 17 U.S.C. § 501(b) (emphasis added)); *see also ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 944 F.2d 971, 980 (2d Cir. 1991) (“The legal or beneficial owner

of an exclusive right under a copyright is entitled to bring actions for infringements of that right occurring during the period of its ownership.”); 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 12.02[C] (“Only the owner of the copyright or the owner of exclusive rights under the copyright, as of the time the acts of infringement occur, has standing to bring an action for infringement of such rights.”) (emphasis added); *Infomercial Ventures P’ship v. CBS Broad., Inc.*, No. 2:09-CV-07370-JHN-CWx, 2010 WL 11519576, at *3 (C.D. Cal. July 23, 2010) (“[T]he Court requires Plaintiff to allege ownership at the time of infringement in this matter.”); *World Thrust Films Inc. v. Int’l Family Entm’t Inc.*, No. 93 0681 CIV, 1996 WL 605957, at *4 (S.D. Fla. Aug. 1, 1996) (“It is also incumbent upon [plaintiff] . . . to establish that the exclusive rights conferred on [the temporary exclusive licensee] were re-vested in [plaintiff] prior to the alleged infringing acts, which began in April of 1990”).

Here, as per Exhibit A attached hereto (the “Agreement”), on December 15, 2017, Dolezal “entered into an exclusive distribution agreement with Polaris to license all photos of RACHEL DOLEZAL sent by DIALLO to Polaris, for distribution worldwide by Polaris.” This Agreement was in effect as of the time of the alleged infringement on June 16, 2019. However, Dolezal did not actually send Polaris the Photograph at issue until after the alleged infringement took place. Accordingly, our good faith interpretation of the Agreement, in light of the above-referenced caselaw authorities, is that Dolezal was the owner of the exclusive rights “at the time of infringement.” *Infomercial Ventures P’ship*, 2010 WL 11519576, at *3. Had Dolezal transmitted the Photograph to Polaris before the alleged infringement took place, then Polaris would have been the proper party to assert the claim.

In sum, based on the existence of the exclusive licensing agreement between Dolezal and Polaris (attached hereto as Exhibit A), we harbored a good faith belief that the Agreement governed the Photograph at issue in this case, both at the time the case was initially filed and at the time of the pre-motion conference. The problem we encountered in re-assessing the claim was with the factual question of timing in light of the express language of the Agreement. Since the infringement took place before Dolezal sent the Photograph to Polaris, we believe that Dolezal is the party with standing pursuant to applicable caselaw. Rather than waste the Court’s and party resources with motion practice, we opted to dismiss Polaris’ case voluntarily under F.R.C.P. 41(a)(1)(A)(i), as is Polaris’ “unfettered right.” See *Polaris Images Corp. v. Cable News Network, Inc.*, 18-cv-3875 (VM), 2019 WL 1245367 (S.D.N.Y. March 6, 2019) (“The Court agrees with Polaris that Rule 41 of the Federal Rules of Civil Procedure gave it an ‘unfettered right’ to dismiss the Complaint because CNN had not yet answered or moved for summary judgment.” (citing *Wolters Kluwer Fin. Servs., Inc. v. Scivantage*, 564 F.3d 110, 114-15 (2d Cir. 2009)).

Respectfully Submitted,

s/richardliebowitz/
Richard Liebowitz

Counsel for Plaintiff

EXCLUSIVE LICENSE AGREEMENT

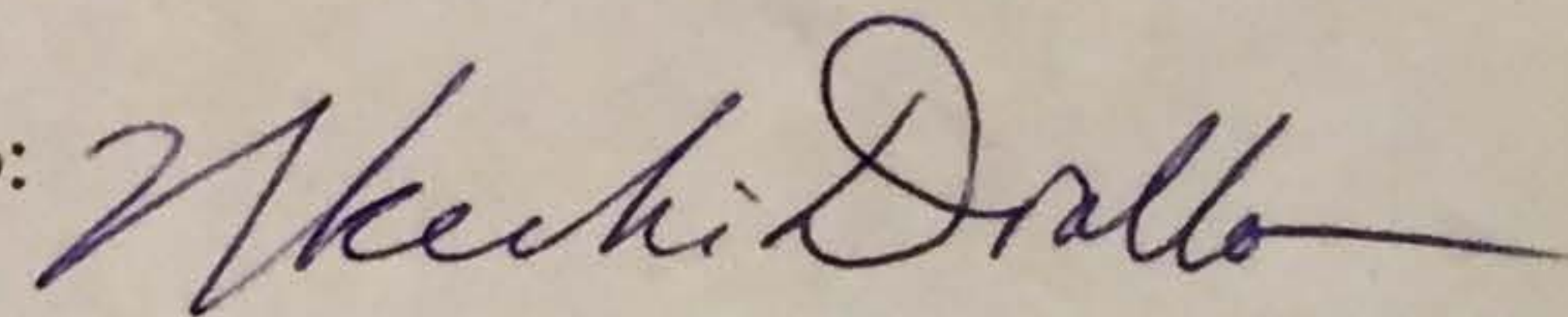
PHOTOGRAPHER Nkechi Diallo AKA Rachel Dolezal, residing at 618 E 36th Avenue, Spokane, WA 99203 and Polaris Images ("Polaris"), located at 259 West 30th Street, New York, NY 10001 confirm that DIALLO has entered into an exclusive distribution agreement with Polaris to license all photos of RACHEL DOLEZAL sent by DIALLO to Polaris, for distribution worldwide by Polaris. DIALLO is the copyright owner of the photographs and has granted an Exclusive Distribution and Reproduction License to Polaris on or about November 2017.

The license DIALLO granted to Polaris is an exclusive license to distribute copies of her copyrighted work to the public by sale or by rental, lease, or lending, to reproduce his / her copyrighted works in copies and to prepare derivative works based on his/her copyrighted works and to grant licenses to others to do the same. Further, DIALLO grants to Polaris the right to enforce their exclusive license and rights in their own name or in conjunction with any claims she may have in the enforcement of her copyrights.

DIALLO authorizes Polaris attorneys to exclusively pursue cases of copyright infringement of her photographs on her behalf. DIALLO will receive 50 % of all net sums recovered by Polaris after each successful copyright litigation. DIALLO understands that Polaris attorney will be registering the copyrights to the photograph on behalf of DIALLO and that Polaris is the exclusive representative of her photographs. Polaris' attorneys will pursue the infringement cases as instructed by Polaris.

For Polaris:

Nkechi Diallo:



Date:

Date:

12-15-2017

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6.15.19 -Rachel Dolezal_Polaris.

Type of Work: Visual Material

Registration Number / Date: VA0002163244 / 2019-07-20

Application Title: 6.15.19 -Rachel Dolezal_Polaris.

Title: 6.15.19 -Rachel Dolezal_Polaris.

Description: Electronic file (eService)

Copyright Claimant: Nkechi Diallo AKA Rachel Dolezal. Address: 618 E 36th Ave., Spokane, WA, 99203, United States.

Date of Creation: 2019

Date of Publication: 2019-06-15

Nation of First Publication: United States

Authorship on Application: Nkechi Diallo AKA Rachel Dolezal; Domicile: United States. Authorship: Photograph.

Copyright Note: Regarding basis for registration: A work may be registered with the Single Application only if the following requirements have been met: 1) The registration covers one work; 2) The work must be created by one individual; 3) All of the material contained within the work must be created by the same individual; 4) The author and the owner of the work must be the same person, and that person must own all of the rights in the work; 5) The work cannot be a work made for hire.

Names: [Diallo AKA Rachel Dolezal, Nkechi](#)



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