

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

**American Board of Internal Medicine
(ABIM),**

Plaintiff,

vs.

Jaime A. “Jimmy” Salas Rushford, M.D.,

Defendant

CASE No. 14-cv-06428-KSH-CLW

MOTION DAY: April 18, 2016
(Modified to reflect extension
granted to Plaintiff)

REPLY MEMORANDUM
in support of Rule 12(c)
Motion Requesting Dismissal
for Failure to State a Claim
upon which relief can be granted

Andrew L. Schlafly (Local Counsel)

Attorney at Law
939 Old Chester Road
Far Hills, New Jersey 07931
Tel. 908-719-8608
aschlafly@aol.com

Dora L. Monserrate-Peñagaricano (PHV)
Antonio Valiente (PHV / Lead Counsel)

Maramar Plaza – Suite 1120
101 San Patricio Avenue
Guaynabo, Puerto Rico 00968-2646
Tel. 787-620-5300
dmonserrate@msglawpr.com
avaliente@msglawpr.com / lcdoavaliente@live.com

Guillermo L. Mena-Irizarry (PHV)

Diligent Legal, LLC
PO Box 11383
San Juan, Puerto Rico 00922
Tel. 787-347-9793
guillermo.mena@me.com

Attorneys for Defendant,
Jaime A. Salas Rushford, M.D.

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Defendant Jaime A. “Jimmy” Salas Rushford, M.D., submits this Reply memorandum to the Opposition by Plaintiff and the Third-Party Defendants (collectively “ABIM”) [Dkt. 87] regarding Defendant’s Rule 12(c) motion to dismiss for failure to state a claim upon which relief can be granted. [Dkt. 76, 76-1]

1. Arguments for which Plaintiff offered no substantive reply or basis

- a. Plaintiff did not address our argument that, since the Complaint “joined at least five (5) independent claims in a single action it must plausibly allege each individual claim separately as to timeliness, sufficiency/plausibility and jurisdiction,” and it had not done so. (Memorandum, pp. 4-5, § 2(b)) In fact, it continued to argue as if it was just “a straightforward, single-count Complaint for copyright infringement.” (Opp., p. 1)
- b. Plaintiff did not substantiate its argument that the 12(c) Motion was “improperly asserted,” (Opp., p. 2) other than to say that the “pleadings have long since been closed” and discovery has commenced. (Opp., p. 8-9) Rule 12(c) doesn’t specify a limit of time after the pleadings close to file motion.
- c. In its claim element sufficiency argument, Plaintiff ignores our argument that “[t]he fact that the e-mails [it alleges against Defendant] contain questions, notes, lists and other data related to the subject of internal medicine is not enough to allow the Court to plausibly construe that the content is Plaintiff’s copyrighted exam content related to the same subject.” (Memorandum, p. 18-19).
- d. Neither Plaintiff’s fraudulent concealment argument nor its element sufficiency argument address our argument that “equitable tolling based on fraudulent concealment therefore precludes tolling the statute of limitations for claims based only on strict liability. So, any claims for innocent infringement simply cannot be tolled by fraudulent concealment, any

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and all tolled infringement claims require proof (and therefore plausible allegations) of specific intent.” (Memorandum, p. 11).

2. Plaintiff's timeliness arguments willfully ignored controlling precedent, statutory plain language and our arguments. Plaintiff's case is time-barred.

a. The discovery rule in the Third Circuit is a tolling not an accrual doctrine

Plaintiff's Opposition defines the Discovery Rule by quoting the old case of *William A. Graham Co. v. Haughey*, 568 F.3d 425, 438 (3rd Cir. 2009) (hereinafter *Graham I*). (Opp., p. 14). However, our Memorandum (p. 8) made clear that that definition was explicitly declared dicta two years later in *William A. Graham Co. v. Haughey*, 646 F.3d 138, 148-149 (3rd Cir. 2011) (*Graham II*) (“[N]one of the myriad decisions forming the genealogy of *Graham I*'s statement that the discovery rule pertains to accrual defines precisely what it means for a cause of action to accrue; nor do they explain why accrual rather than tolling is the relevant concept. ... Given the unimportance of the difference between tolling and delayed accrual to the outcomes of the [over 25] decisions cited and the consequent failure of so many courts to recognize the distinction, we do not regard their articulations of the meaning of the discovery rule to be anything more than **nonbinding obiter dicta**”) (emphasis added).

As we further quoted at length in our Memorandum (p.8), *Graham II* declared that the discovery rule is a tolling doctrine, not an accrual doctrine. “[W]e do not think the discovery rule should be read to alter the date on which a cause of action accrues. Since it cannot be an accrual doctrine, the discovery rule must instead be one of those legal precepts that operate to toll the running of the limitations period after a cause of action has accrued...” *Graham II*, at 149-50. To be emphatic, Plaintiff's entire discovery rule argument is based on a case that is no longer good law in this Circuit by explicit decision of the Circuit, and Plaintiff was aware this was the case.

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b. Defendant did argue that Plaintiff's claim is untimely even under the Third Circuit's Discovery Rule

Plaintiff's Opposition makes the categorically untrue argument that "Defendant... does not argue that ABIM's claim was untimely under [the discovery] rule." (Opp., p. 14) However, the entirety of section 3(b) of our Memorandum (pp. 9-10) discusses why Plaintiff's claim is untimely under the discovery tolling rule announced in *Graham II*. Our argument regarding Plaintiff's conclusory allegations of diligence (which Plaintiff did not address at all) is also applicable to our discovery rule argument under Third Circuit law. (Memorandum, pp. 11-12, § 3(d)).

c. Defendant pointed to facts in the Complaint showing why ABIM should have known earlier. It is not Defendant who must properly allege tolling.

Plaintiff's Opposition states that "Defendant does not point to any part of ABIM's complaint that could possibly suggest that ABIM knew or reasonably should have known of its claims against Defendant prior to October 17, 2011." (Opp., p. 13) But our Memorandum underscores in at least two locations, referencing paragraphs 49-50 of the Complaint, that Plaintiff explicitly alleges that it had copies of all the emails it now alleges against Defendant since December 2009. (Memorandum pp. 1-2, 13, §§1, 3(e)). In any case, it is not Defendant who must prove or allege tolling, it is Plaintiff. *Pace v. DiGuglielmo*, 544 U.S. 408, 418 (2005).

Plaintiff inexplicably fails to allege why it chose to forgo the simplest avenue it had available to discover Defendant's identity, asking Dr. Arora to name the user of the *padrinojr@yahoo.com* account as part of the discovery in the case where it obtained the e-mails via seizure in December 2009. Worse yet, ABIM chose to forgo (or at least has not alleged having used) another very easy route that Congress provided to it in cases such as these. Under the Digital Millennium Copyright Act, 112 Stat. 2860, ABIM simply could have requested "the clerk of any United States district court to issue subpoena to a service provider [in this case Yahoo] for

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identification of an alleged infringer..." to 17 U.S.C. § 512(h)(1). Yahoo is a service provider under 17 U.S.C. § 512(k)(1).

Furthermore, Plaintiff, being in possession of the e-mails, could very easily have filed a complaint against the owner of the `padrinojr@yahoo.com` account as an easily identifiable defendant whose only unknown was his name, conducted expedited discovery under F.R.Civ.P. 26(d) and then simply substituted the name as allowed by F.R.Civ.P. 15(c). See for example *AF Holdings LLC v. Doe*, No. 2:12-CV-1661 MCE DAD, 2012 WL 2921356, at *1 (E.D. Cal. July 17, 2012) ("several District Courts in California ... found good cause to allow expedited discovery to ascertain the identity of a Doe defendant in copyright infringement actions."). When a potential plaintiff is well aware that it has been damaged, not knowing the name of the person who caused a damage is not a bar to filing suit when the potential defendant is identifiable by some exclusive characteristic, as here.

In fact, Plaintiff's action against Dr. Arora [Docket #4-2], on which the Complaint is partially based (¶¶ 49-50), included fifty unnamed defendants fitting Dr. Salas Rushford's alleged characteristics. Yet, instead of simply conducting discovery under F.R.Civ.P. 26(d) as to the owner of the `padrinojr@yahoo.com` account and substituting Dr. Salas Rushford under F.R.Civ.P. 15(c), ABIM inexplicably voluntarily dismissed its entire case under F.R.Civ.P. 41(a)(1)(A)(ii) once it settled with Dr. Arora.

In sum, by December 2009 when it seized the e-mails, Plaintiff had all the information it needed to file the action at bar and had the means to easily discover the identity of the defendant. It chose not to. The claim that it was diligent in taking over two years to do what it could have done with a simple question in a deposition or interrogatory in a case where discovery had just started, or even by having a subpoena issued under a special procedure authorized by Congress,

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cannot be taken seriously. Plaintiff has not substantiated its conclusory claims of diligence in any way. Having taken over two years to do what, as we have shown, it could have done in a couple of months, and absent pleaded facts to explain why, its diligence argument fails.

d. Plaintiff's fraudulent concealment argument ignores that it must refer to conduct different from the wrongful activity itself, that it must be directed at plaintiff, and the need to plead its diligence with particular facts that show it

Fraudulent concealment must be pleaded with particularity. *Byrnes v. DeBolt Transfer, Inc.*, 741 F. 2d 620, 626 (3rd Cir. 1984); Fed.R.Civ.P. 9(b). As the Fourth Circuit has stated, that means specifically pleading and proving "conduct... affirmatively directed at deflecting litigation." *Pocahontas Supreme Coal Co. v. Bethlehem Steel Corp.*, 828 F.2d 211, 218-19 (4th Cir. 1987). Or as has also been held, "plaintiff [must] establish that the defendant took affirmative steps **beyond the allegedly wrongful activity itself** to conceal her activity from the plaintiff." *Urbont*, 863 F.Supp.2d, at 286, n.7 (citing *SEC v. Gabelli*, 653 F.3d 49, 59-60 (2d Cir. 2011)) (emphasis added).

Plaintiff simply ignores our argument that since the e-mails alleged in this case were sent by Defendant to Dr. Arora,¹ who was the actual and intended recipient of the e-mails and who, plaintiff's allegations admit, readily corresponded with the owner of the padrinojr@yahoo.com account, then it follows that nobody was hiding. If everyone in the conversation knew who he was, why should Defendant go to greater lengths to identify himself? Who was he concealing from? The answer, of course, is nobody. Nothing Defendant did was directed at Plaintiff. There is absolutely no duty to announce oneself in detail to the whole world all the time. If I leave a note to my niece with only my nickname and some archaeologist finds it in the future, it cannot be said

¹ Except for the one that Dr. Arora sent Defendant and for which a finding of fraudulent concealment would simply be mindboggling.

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that I was hiding from the archaeologist. It is enough, and normal, to identify oneself solely to the extent necessary that the ones one communicates with know who they are speaking with.

Plaintiff further ignores our argument that when a tolling argument is based on fraudulent concealment, plaintiffs "must plead with particularity the circumstances surrounding the concealment and state **facts showing ... due diligence** in trying to uncover the facts." *Gonzalez Bernal v. U.S.*, 907 F.2d 246, 250 (1st Cir. 1990). (Memorandum, p. 11-12, § 3(d)). No such facts are stated. Plaintiff goes so far as to admit in its Opposition (pp. 15-16, note 7) that the cases we cited to this point apply to all equitable tolling doctrines. And then, despite it being blackletter law that fraudulent concealment is an equitable tolling doctrine, Plaintiff doesn't use the word diligence even once in its fraudulent concealment argument. (Opp., p.16-17) And of course, as we showed above, Plaintiff chose to forgo its diligent alternatives.

In short, Plaintiff's fraudulent concealment allegations do not allege fraud or concealment and fail to correctly plead Plaintiff's diligence with specific facts. Any of those is enough to make its tolling argument fail. This action is time-barred.

3. The Complaint fails to plausibly plead copyright infringement

Plaintiff's copyrighted works are a series of secret secure tests. 37 C.F.R. § 202.20(c)(2)(vi). "A *secure test* is a non-marketed test administered under supervision at specified centers on specific dates, all copies of which are accounted for and either destroyed or returned to restricted locked storage following each administration." 37 C.F.R. § 202.20(b)(4). "The regulation suspends the requirement to deposit copies of the work, and requires instead that registrants of secure tests need only deposit a sufficient portion or a description of the test sufficient

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to identify it.”² *Educational Testing Services v. Katzman*, 793 F.2d 533, 538 (3rd Cir. 1986) (citing 37 C.F.R. § 202.20(c)(2)(vi)).³

Tests and their questions, even when they are not the secure kind, are problematic and very limited bearers of copyright because copyrights are matters of “artistic creativity.” *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). Tests, on the other hand, are inherently systems or processes designed, through a procedure usually partly spelled out in the test itself (the instructions), to distinguish among test takers (usually separating by score those who know from those who don’t know about the subject matter of the test but other times distinguishing between personalities or other criteria). And, as is plain from copyright law itself, systems, processes and procedures cannot get copyright protection. 17 U.S.C. § 102(b). This is why the Third Circuit has held that test owners do not have copyright protection over the structure of the questions, only their wording. *Katzman*, 793 F.2d, at 542. So, the value of the efforts to include ideas in questions, statistically validate the questions and keep the test system current, must lie outside of copyrights, despite Plaintiff’s allegations to the contrary. (Opposition, pp. 3-4; Complaint, ¶¶ 23-27).

Further, the subject matter of a particular test is necessarily a matter of ideas (in the test at bar medical, biological or pharmacological ones), and when the questions are multiple choice questions, the different choices are usually also ideas or facts of a related nature. Those cannot receive copyright protection independently either. 17 U.S.C. § 102(b). Additionally, in the vast majority of occasions, tests are designed to be easily understood, they avoid poetic or creative writing, and in that sense, they commonly merge the ideas with the writing in a way that is also not protectible by copyright. *Katzman*, 793 F.2d. at 539-40. Test questions many times include

² The particular portion of each test that Plaintiff deposited is unknown at this time.

³ See section G below for a discussion of the legality and constitutionality of this scheme.

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characters—like the Complaint’s overhyped “lady from Mississippi” (¶ 39; Opposition, p. 6)—but copyright does not extend to them. See *Compendium of U.S. Copyright Office Practices*, § 202.02(1) (2 Ed. 1984). Tests also commonly must include *scènes à faire* in their questions and options because they must narrate the situations where the ideas to be tested typically arise—like, presumably, whatever may have been happening to that “lady from Mississippi” or the mention of an injured pedestrian in a car accident on a torts test—and those also cannot provide grounds for copyright infringement claims.⁴ *Oracle America, Inc. v. Google Inc.*, 750 F. 3d 1339, 1358 (Fed. Cir. 2014); see also *Mitel, Inc. v. Iqtel, Inc.*, 124 F. 3d, 1366, 1374 (10th Cir. 1997) (“expressive elements of a work of authorship are not entitled to protection against infringement if they are standard, stock, or common to a topic, or if they necessarily follow from a common theme or setting”); and for examples see, *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50-52 (2nd Cir. 1986); and *Ets-Hokin v. Skyy Spirits Inc.*, 323 F.3d 763 (9th Cir. 2003).⁵ Other tests, usually about literary works or motion pictures, will sometimes refer, in lieu of *scènes à faire*, to the actual situations faced by the characters in the original works, and that and any other preexisting material (such as reproductions of x-rays), is also excluded from the test copyright. 17 U.S.C. § 103(b).

So, once one removes the structural, procedural or systemic, the ideas or merged ideas, the *scènes à faire* and the preexisting material, the original creative part of a test that may remain (if any), the one that may be copyrightable or can give rise to a copyright infringement claim, is limited to the gaps between all those other elements, and then only when those gaps are not merely short phrases which also lack copyright protection. 37 C.F.R. § 202.1(a). It is the “unauthorized

⁴ If test authors chose arcane or wildly speculative situations the test simply wouldn’t work because test takers would be guessing at the answer.

⁵ My torts professor loved using the names of other professors of the Law School in the *scènes à faire* of his test questions, but even if I listed their names along with a short summary of the situations they were put in, I wouldn’t be violating his copyright to the test.

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copying” of those very limited “original elements” (if any), that may give rise to an infringement claim. *Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 206 (3rd Cir. 2002). This is the sort of copyright that has been called “a ‘thin’ copyright which protects against only virtually identical copying.” *Ets-Hokin*, 323 F.3d, at 766 (citing *Apple Computer Corp. v. Microsoft Corp.*, 35 F.3d 1435, 1439, 1442 (9th Cir. 1994)). Those original elements certainly do not extend to a test taker’s particular (right or wrong) answer (Opposition, p. 10; Complaint, ¶ 39) because it is the test taker who showed the creativity in giving it and even in relating it to others despite what Plaintiff thinly alleges. (Opposition, p. 7; Complaint ¶ 42). The protected elements also do not extend to “descriptions of pictures shown on the exam,” (Opposition, p. 10; Complaint, ¶ 39) because that description is in fact the original creation of the describer and, in any case, the copyright for the picture belongs to whoever took it. In fact, Plaintiff’s allegations, comprehensively summarized in its Opposition, do not refer to even one identifiable original and copyrightable element of its registered works (if indeed there are any). They may be long, but as it relates to copyrightability and copying, they are conclusory.⁶

4. The unconstitutionality claims are sufficiently alleged

a. All procedural defects of the unconstitutionality claims have been cured.

In its Opposition, Plaintiff correctly argued that we had not complied with the requirements of Federal Rule of Civil Procedure 5.1(a) by the time Plaintiff filed its Opposition Brief. We have now fully complied with that Rule and with Local Civil Rule 24.1 which covers similar ground, and have requested the Court’s forgiveness and leniency in that regard. [Docket 88] Since

⁶ Plaintiff states in its Opposition (p. 11) that it has produced to us “all the copyrighted exam content it alleges defendant infringed.” Discovered evidence was not a proper matter to raise at this stage in an Opposition so we will not respond substantively to that assertion here, but if we must get to the Summary Judgement stage we will gladly guide the Court through Plaintiff’s so-called full production.

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F.R.Civ.P. 5.1(d) states that failure to comply with F.R.Civ.P. 5.1(a) does not forfeit the constitutional claim, we ask the Court to hold that the procedural defects have been cured and to rule on the constitutionality argument, after waiting the required 60 days for the Attorney General's optional intervention, if it cannot dispose of the case in Defendant's favor in any other manner at this stage.

b. Plaintiff misconstrued the sufficiency of our unconstitutionality argument

This Court is not bound by the Seventh Circuit's isolated and limited constitutionality and statutory soundness holdings in *National Conference of Bar Examiners*, 692 F.2d, at 482-87, regarding the secure test regulatory scheme contained in 37 C.F.R. §§ 202.20(b)(4) and (c)(2)(vi) because the Third Circuit expressly did not analyze or adopt them (and neither has any other Circuit that we are aware of), see *Katzman*, 793 F.2d. at 538, and because the holdings and the discussion in *Bar Examiners* did not cover, even tangentially, most of the constitutional issues we have raised.

In *Bar Examiners* the Seventh Circuit held that the regulatory scheme's waiver of the normal full deposit requirement for secure tests was within the scope authorized by Congress in the Copyright Act, and further held that the Copyright Clause of the Constitution (Art. I, § 8, Cl. 8) does not require complete deposit with the Register because the deposit is not meant as a way to avoid unconscious infringement. *National Conference of Bar Examiners*, 692 F.2d, at 482-87. The Seventh Circuit did not rule on whether the Due Process Clause of the Fifth Amendment and/or the Free Speech Clause of the First Amendment require full deposit or some other minimal guarantee of fair warning (like, for example, the copyright notice described by the Copyright Act, 17 U.S.C. § 405, even if in some cases even that might be insufficient), particularly to a person copying the work of third parties (sometimes even named as authors in those works) that did not contain any real notice of not being their work (as Plaintiff claims Defendant did in ¶¶ 41-42, 44 and 46 of the Complaint regarding Ex. D and F, among others).

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As we stated in our original Memorandum of Law, the Due Process Clause requires either full deposit or some other guarantee of fair warning, because the lack of fair-warning, the confusion that it fosters, and the total inability to ascertain *a priori* who the copyright owner actually is (if anyone), unduly expose a reasonable law-abiding person to financially ruinous legal costs (even if one is innocent) and judgments (even if a person was an unknowing infringer) and thus to deprivation of property. And, the Free Speech Clause requires it as well because the rational fear of those litigious consequences, particularly when brought in a fashion similar to Plaintiff's claims about Exhibits D and F in the Complaint which undisputedly Defendant did not author or compile (Opposition, pp. 6-7), and emphatically when it might turn out that a putative defendant unknowingly copied material copyrighted by the putative plaintiff and might be held liable even through no intention or even negligence on her part, create a chilling effect on protected speech by deterring the sharing of knowledge and information that happens to be within the subject matter of any secure test even when that information is or might be in the public domain. Courts have long held that sort of incentivized overpolicing by third parties who did not produce the content (or censorship by proxy) to be a violation of the First Amendment. See *Smith v. California*, 361 U.S. 147, 153 (1959) (holding unconstitutional a California statute that made it a crime for bookstore owners to stock books later judicially determined to be obscene, even when the owner did not know of the books' contents); see also *Denver Area Educational Telecommunications Consortium, Inc. v. FCC*, 518 U.S. 727, 753-54 (1996) (holding an FCC regulation that required cable networks to place 'patently-offensive' programs on a separate channel and blocking it at customer request because, among other reasons, networks might simply ban any potentially problematic show rather than shouldering the "costs and burdens" of setting up separate channels and responding to requests); further see *United States v. Playboy Entertainment Group, Inc.*, 529

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U.S. 803, 811 (2000) (same regarding blocking children's access to sexually oriented programming); and see *Center for Democracy and Technology v. Pappert*, 337 F.Supp. 2d 606, 650-51, 656 (E.D. Pa. 2004) (same regarding legislation requiring internet service providers to filter out child pornography). Courts in fact do not limit this overpolicing concern to third parties and in fact include anyone who is expressing, publishing or distributing potentially protected content or speech. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 340-48 (1974) (“a rule of strict liability that compels a publisher or broadcaster to guarantee the accuracy of his factual assertions may lead to intolerable self-censorship.”); and see *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988) (same). And therefore, the secure test regulatory scheme contained in 37 C.F.R. §§ 202.20(b)(4) and (c)(2)(vi) violates either or both the Due Process Clause of the Fifth Amendment and the Free Speech Clause of the First Amendment.

As we further explained in our original Memorandum, the denial of almost all fair use for secure tests, premised on the notion that any revelation of the content destroys its value to the owner, turns the entire constitutional principle of copyrights on its head. Since Plaintiff states that we did not provide a basis for our challenges (Opposition, p. 17), even though we cited the Supreme Court's general explanation of copyright principles in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, at § II (1994), (Memorandum, p. 25) we are forced to explain those constitutional principles and how they clash with the regulatory scheme.

The problem is that the secure test regulation puts copyrights on a collision course with free speech which was never intended by the framers. This is because secrecy is inimical to the constitutional concept of copyrights, particularly when, as surely happens with most secure tests, their content never sees the light of day or enriches public knowledge generally, even after their copyright protection has expired because, as the regulation itself requires, “all copies... are

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accounted for and either destroyed or returned to restricted locked storage following each administration," 37 C.F.R. § 202.20(b)(4), and the test owner has no credible incentive to reveal their content after the protection expires. The secure test regulation is therefore contrary to two of the three constitutional policies of copyright: promoting learning and protecting the public domain; and, even worse, the regulation is openly hostile to the other constitutional principle of copyright: providing public access. *See* L. Ray Patterson and Craig Joyce, *Copyright in 1791: An Essay*, 52 *Emory L. J.* 909, 936-52 (2003).⁷ As Profs. Patterson and Joyce explain:

The one absolute condition necessary for learning is access to the material to be learned: no access, no learning. This explains the requirement of *publication* of a new work as a condition for copyright protection. Once a work was printed and in the bookseller's shop, it was no longer subject to the copyright holder's control of access. The Founders were wise enough to recognize that the control of access was the *sine qua non* of censorship—and that control of access to learning materials for proprietary reasons is as harmful as suppression for political reasons, if not more so.

Copyright for political censorship targets a class of materials (*e.g.*, seditious, heretical, and blasphemous material) for governmental reasons, such as, in England, protecting a state religion and the Sovereign as the head of the church. Material that is not in the forbidden class passes muster and avoids suppression. Copyright as a tool of private censorship for proprietary reasons, however, is not so limited because its purpose is private profit. Thus, it applies to all uses of all copyrighted works whenever a profit is to be made by licensing their use or providing access for a fee. The objection to the latter form of censorship is that its goal is either ignorance or, preferably, knowledge for a price—an objective whose impact is unlimited because learning is a cultural, as well as a political, concern. To Washington, the First Congress and the Founders generally, an educated populace, with broad access to "knowledge" of every description, was essential to a free society.

Thus, copyright protection in the new nation was, from the first, conditioned upon publication—a reaction to the unsavory role

⁷ We encourage everyone to read the superlative exposition about the founder's understanding of the nature and limits of constitutional copyrights in this instantly classic work by Profs. Patterson and Joyce which we make part of this argument in whole.

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of English copyright in the scheme of press control, and the one act that ensured access. Without the policy of public access, copyright would have been reduced to the status of a private law to benefit a limited class of people, namely, publishers—an outcome inimical not only to the Copyright Clause written into the Constitution in 1787 but also to the First Amendment added to it in 1791. To the Founders, a copyright law that did not ensure public access—access through publication, dissemination, and, in short order, passage into the public domain—would have been a law regulating the availability of knowledge in violation of both the constitutional provision regarding copyright and the complementary principle of "the freedom... of the press."

Id., at 948-49; and see *Campbell*, 510 U.S., at 575-76. A copyright regulation that does not require publication and conversely openly requires the destruction or locked concealment of works would have been simply shocking and unthinkable to the framers, reminiscent of the English Licensing Act of 1662 and obviously unconstitutional. So, by extending copyrights to secure tests in the manner it did, the Register of Copyrights exceeded its delegation of power over copyrights in violation of the Copyright Act, 17 U.S.C. § 702 and/or acted in violation of the Copyright Clause of the Constitution (and, by extension, in violation of the First Amendment).

One does not have to be an originalist to appreciate Profs. Patterson and Joyce's beautiful explanation of the Framers' genius in crafting constitutional copyright as a tool of liberty, learning and free expression and a bulwark against censorship. One also does not have to be an originalist to use their explanation to invalidate the secure tests regulation. But, the same conclusion can also be reached using other approaches that account for the owner rights expansion that has occurred in copyright law and regulation since the 1970's and the concomitant strengthening of the First Amendment which has reached its apex in the Roberts Court. Viewed in this historical context, the unconstitutionality of the secure tests regulatory scheme is also inescapable.

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As we explained in Section 3 above (and re-allege fully here), tests and their questions, even non-secure tests, are generally problematic and very limited bearers of copyright. As we will see, the situation is exacerbated when the test is a secure test.

In *Golan v. Holder*, 132 S.Ct. 873 (2012), the Supreme Court made clear that heightened First Amendment scrutiny of the Copyright Act and its regulations is unwarranted as long as the “built-in First Amendment accommodations” of the constitutional grant of copyright power remain “undisturbed.” *Id.*, at 890-91; see also *Eldred v. Ashcroft*, 537 U.S. 186, 219-21 (2003) (same). This line of reasoning in *Golan* and *Eldred* resonates *sub silentio* in a long line of free speech cases that usually involve laws, like Copyright, that provide a private cause of action that makes the defendant’s speech the grounds for potential liability. In these sorts of cases “courts considering First Amendment defenses to those private causes of action ask whether certain types of speech that would otherwise give rise to civil liability must, rather, enjoy a privilege under the First Amendment [disregarding the typical content-based/content-neutral analysis. In doing so] courts have imposed significant restrictions on private causes of action to ensure that First Amendment-protected speech will not be chilled.” Neil Weinstock Netanel, *First Amendment Constraints After Golan v. Holder*, 60 UCLA L. Rev. 1082, 1090 (2013). Cases in this jurisprudential line follow on *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964), and apply to both state and federal statutes. *Id.*, at 1090-91. They include, *Snyder v. Phelps*, 131 S.Ct. 1207 (2011) (about intentional infliction of emotional distress); *Hustler Magazine*, 485 U.S., *supra* (same); *Bartnicki v. Hopper*, 532 U.S. 514 (2001) (about private damages under wiretapping laws); *Gertz*, 418 U.S., *supra* (about defamation of private persons); *Time, Inc. v. Hill*, 385 U.S. 374 (1967) (about right of privacy); *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-1101 (9th Cir. 2008) (about trademarks); and *Cliff Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*,

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886 F.2d 490, 494-95 (2nd Cir. 1989) (about free speech defenses in Lanham Act cases).⁸ Copyright Law has not been absent from this “definitional balancing” analytical trend since the Supreme Court expressly adopted it in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985). But the *Eldred* and *Golan* cases expressly expanded the First Amendment protections recognized as implied in the Copyright Clause to include not only the idea/expression dichotomy but also to the fair-use privilege, which now that its constitutional force is recognized, should be better described as the fair-use right. *Eldred*, 537 U.S. at 190; *Golan*, 132 S.Ct., at 890. In essence, the principles explained in *Campbell* were recognized constitutional authority.

The free speech constitutionality of copyright law in the *Eldred* and *Golan* cases is premised partly on the notion that “every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication.” *Eldred*, 537 U.S., at 219; and see *Golan*, 132 S.Ct., at 889 (expressly following *Eldred*). But this is precisely what never happens with a secure test. Plaintiff’s allegations are telling, for example, when they state, as part of its copyright infringement claim (its only type of claim in this case), that “advance knowledge by a candidate” about the “subject matter” or “fact patterns” of a test question “provides the candidate an unearned advantage that subverts the integrity of the examination and may permit an unqualified” candidate to pass the test. (Opposition, p. 87; Complaint ¶ 17). But the subject matter and facts of a work, or even of discrete parts of a work, are precisely the sort of ideas and facts that the Supreme Court says should be available for public exploitation immediately for the balance between copyright protection and free expression to exist. See *Golan*, 132 S.Ct., at 890-91. And the advance knowledge so derided by Plaintiff simply implies knowledge prior to having access to the work (such as one gets from the previews and reviews of a movie), while proof of

⁸ See other cases listed in Netanel, *First Amendment Constraints*, at 1090-92, n. 32, 38-40.

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access is traditionally essential to a copyright infringement claim. In fact, it is also almost impossible to conceive of any potential fair use under this view of the regulatory scheme because the mere act of revelation would seem to destroy the value of a question. So if this is the correct view of the intent behind the regulatory scheme it must be unconstitutional under the rule announced in *Golan*, 132 S.Ct., at 889-91. Why else would Plaintiff keep underscoring the existence of the "Pledge of Honesty" (Opposition, p. 5; Complaint, ¶¶ 19-21) if the rights it may create are simply duplicative of Plaintiff's clear rights under constitutional and statutory copyright? The true reason is that Plaintiff, and any other test giver, may achieve by private contractual non-disclosure agreements, what the government, constrained by the First Amendment, cannot give it through copyright regulation. And that, in many cases, may make the source of a putative plaintiff's rights irrelevant to its ability to get compensation. But contractual penalty cannot reach third-parties and in this case Plaintiff admits that Defendant did not violate the Pledge of Honesty, in fact had not even seen it when all the alleged events occurred. So, Plaintiff's only recourse is to copyright law and regulation, not to contractual law, and the Constitution must make its claim fail there because Plaintiff's (and the regulatory scheme's) view of copyright regulation as akin to a source of censorship power runs counter to the constitutional principle of copyright as an engine of expression. A college student who forwards an email that states the subject matter of each and every question in a class test may, in certain circumstances, perhaps be subject to grievous academic consequences stemming from violations of the Student Handbook, but, constitutionally speaking, a strict liability copyright infringement lawsuit should not be one of them. Kids who want to email their parents about the questions that stumped them on a test should not be held back out of fear of federal copyright lawsuits.

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Further, as we also stated in the Memorandum (p. 25), even if the regulation is consistent with the Act, then it is unconstitutional because, by creating a scheme which for all practical purposes disallows fair use (with the consequences explained above), secure tests are being regulated as if they were trade secrets, which as a matter of law fall under the Commerce Clause (Art. I, § 8, Cl. 3), not the Copyright Clause. We do not think the Copyright Act, 17 U.S.C. § 702, intended to provide the Register with commercial regulatory authority beyond copyrights. But, even if it did, since the source of power would be the Commerce Clause and not the Copyright Clause, the Register could not extend protection to all secure tests but only to those affecting interstate or foreign commerce; and then, only to the extent that trade secrets are within federal and not state purview. See *Restatement (Third) of Unfair Competition*, §§ 39-45 (1995). Of course, for trade secrets the punishable act is the intentional conversion, not merely using, developing, discovering, reverse-engineering, or selling a trade secret. 18 U.S.C. § 1832(a). And the owner's rights are traditionally completely different from the copyright exclusive rights. See, Paul J. Heald, *Federal Intellectual Property Law and the Economics of Preemption*, 76 Iowa L. Rev. 959, 976-80 (1991). And, that requirement of intentionality along with the non-monopolistic nature of trade secrets law is what would allow it to be a proper use of the Commerce power without clashing with the Copyright Clause. See in general, Paul J. Heald and Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. Ill. L. Rev. 1119, 1194-95 (2000). But that is certainly not the sort of regulation that the Register enacted. It attempted to shoehorn trade secrets-like protection into exclusive copyrights.

All of the above arguments, properly understood, are in fact variations on the same overarching argument that presupposes that the Copyright Clause happily coexists with the Commerce Clause and with the First and Fifth Amendments because the founders were masterful

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drafters that would not have blundered so badly as to make these fundamental principles clash instead of complement, and that therefore a statutory or regulatory violation of the Copyright Clause probably entails a violation of one or all the others. This is why our opening brief could be so short on the subject and still be complete despite Plaintiff's argument to the contrary. The secure test regulations create a cascade effect of unconstitutionality by impliedly conceiving the Copyright Clause as a grant of power primarily over private property or commercial regulation and not as a grant of power primarily over speech and information regulation meant to ultimately service learning, public access, and the public domain. The scheme is unconstitutional because it overvalues the self-interest of the copyright owner and undervalues the public-interest that the founders enshrined in the Constitution, and in doing so breaks the carefully crafted balance between incentivizing creativity and promoting public learning while protecting free speech and a free press, it chills speech and knowledge instead of protecting and promoting them, running afoul of its own constitutional grant of power and of the First and Fifth Amendments.

5. The Complaint should be dismissed

Based on the above, Defendant, Dr. Salas Rushford, respectfully requests that the Court allow this Motion; that Plaintiff's Complaint be dismissed in its entirety with prejudice as time-barred by the three (3) year statute of limitations of the Copyright Act, 17 U.S.C. § 507(b); and/or that the Court hold that Plaintiff failed to sufficiently and plausibly allege all or some of its claims. Defendant also respectfully requests any other remedy in his favor that may be derived from the facts and the law herein set forth.

Dated: April 11, 2016.

/s/ Guillermo L. Mena-Irizarry
Guillermo L. Mena-Irizarry (Pro Hac Vice)
Diligent Legal, LLC
PO Box 11383
San Juan, Puerto Rico 00922

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787-347-9793
guillermo.mena@me.com

/s/ Andrew L. Schlafly (AS4533)
Andrew L. Schlafly (Local Counsel)
939 Old Chester Road
Far Hills, New Jersey 07931
908-719-8608
aschlafly@aol.com / aschlafly@yahoo.com

Dora L. Monserrate-Peñagaricano (Pro Hac Vice)
Antonio Valiente (Pro Hac Vice / Lead Counsel)
Maramar Plaza – Suite 1120
101 San Patricio Avenue
Guaynabo, Puerto Rico 00968-2646
787-620-5300
dmonserrate@msglawpr.com
avaliente@msglawpr.com / lcdoavaliente@live.com

Attorneys for Defendant,
Jaime A. Salas Rushford, M.D.