UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

TERRY NEWBORN,	)	
Plaintiff,	)	
v.	)	Case No. 1:04CV00659 (RBW)
YAHOO! INC. and GOOGLE INC.,	)	
Defendants.	)	

MEMORANDUM OPINION

The plaintiff, Terry Newborn, brought this action against Yahoo! Inc. and Google Inc. ("the defendants") for copyright and trademark infringement in violation of the Copyright Act, 17 U.S.C. §§ 101 et seq. (2000), and the Lanham Act, 15 U.S.C. §§ 1117 et seq. (2000).[1] This Court granted the defendants' motion to dismiss the plaintiff's complaint for failure to state a claim and dismissed the case with prejudice. Newborn v. Yahoo!, Inc., 391 F. Supp. 2d 181, 191 & n.10 (D.D.C. 2005). Currently before the Court is the Defendants' Motion for Attorney's Fees, Expenses, and Costs ("Defs.' Mot.") pursuant to the Copyright Act, the Lanham Act, and

[1] As discussed infra, the plaintiff's original complaint in this action solely stated a claim under the Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

28 U.S.C. § 1927 (2000).[2] For the reasons set forth below, the defendants' motion is granted in part and denied in part.

I. Background

The facts and disposition of the merits in this case are discussed in this Court's prior Memorandum Opinion and will only be summarized here. The plaintiff, Terry Newborn, doing business as Government Publications, Inc., Capital Publications, Inc., and Capitol Publications, Inc., owned and operated a number of websites, which, according to Newborn, contained material protected under the Copyright and Lanham Acts. Id. at 184. In April 2004, Newborn sued defendants Yahoo! and Google, which operate Internet search engine websites, initially alleging that the defendants had violated the Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) ("DMCA"), by knowingly allowing third parties to infringe on Newborn's copyrighted material even after Newborn placed the defendants on notice of the allegedly infringing activity.[3] Complaint ("Compl.") ¶¶ 9-23. The defendants moved to dismiss Newborn's original complaint in the Summer of 2004. Defendant Yahoo! Inc.'s Motion to Dismiss the Complaint; Defendant Google Inc.'s Motion to Dismiss the Complaint. Newborn responded to both motions and then, three days after the defendants had filed their joint reply,

---

[2] The following papers have been submitted to the Court in connection with the motion: (1) the Defendants' Memorandum of Points and Authorities in Support of Their Motion for Attorney's Fees, Expenses, and Costs ("Defs.' Mem."); (2) the Declaration of Thomas P. Olson ("Olson Decl."); (3) the Plaintiff's Opposition to Defendants' Motion for Attorney's Fees, Expenses, and Costs ("Pl.'s Opp'n"); and (4) the Defendants' Reply to Plaintiff's Opposition to the Motion for Attorney's Fees, Expenses, and Costs ("Defs.' Reply").

[3] Newborn generically alleged "violations of the Digital Millennium Copyright Act," Compl. ¶ 9, and it is therefore entirely unclear under which provision of the DMCA the original complaint was brought. Nevertheless, because the DMCA amends Title 17 of the United States Code, see Pub. L. No. 105-304, 112 Stat. 2860, and because 17 U.S.C. § 505 gives the Court discretion to award attorney's fees for any actions commenced under Title 17, see 17 U.S.C. § 505 (providing for the award of reasonable attorney's fees "[i]n any civil action under this Title"), the Court will treat the defendants' motion for attorney's fees, expenses, and costs under 17 U.S.C. § 505 as encompassing Newborn's DMCA claim in his original complaint.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

filed an amended complaint which rendered the motions to dismiss the original complaint moot.[4] See Defs.' Mem. at 2. This amended complaint omitted Newborn's DMCA claim and instead alleged violations of the Copyright Act and the Lanham Act.[5] See generally Amended Complaint ("Am. Compl."). All of the claims alleged pursuant to the DCMA in Newborn's original complaint were again asserted pursuant to the Copyright Act and, to a limited extent, the Lanham Act in the amended complaint.[6] Compare Compl. ¶¶ 10-23 with Am. Compl. ¶¶ 11-15, 17, 24-29, 31. The defendants then moved to dismiss the amended complaint, and this Court granted their motion. Newborn, 391 F. Supp. 2d at 184.

Noting that the plaintiff's complaint was "riddled with vague, confusing, and contradictory statements making deciphering the basis for the plaintiff's Copyright Act claim a hopeless endeavor," the Court concluded that Newborn failed to state a claim under the Copyright Act. Id. at 187. Among other reasons, this Court cited the impossibility of determining what materials had allegedly been infringed, id., and Newborn's failure to allege any

---

[4] In their original motion to dismiss, the defendants argued, inter alia, that Newborn had not stated a claim upon which relief could be granted because the DCMA "in relevant part, creates a limitation on liability, not a cause of action," and therefore could not be violated by the defendants as Newborn had alleged. See Defendant Yahoo! Inc.'s Motion to Dismiss the Complaint at 1; Memorandum of Points and Authorities in Support of Defendant Yahoo! Inc.'s Motion to Dismiss the Complaint ("Yahoo! Mem.") at 7-8. The defendants identify 17 U.S.C. § 512, which limits the liability of online service providers, as "the portion of the DMCA to which [Newborn] apparently refers." See Yahoo! Mem. at 7. As the Court notes supra, however, the original complaint does not indicate which section of the DMCA purportedly covered the violations alleged by Newborn.

[5] In addition to restating Newborn's claims of copyright infringement, the amended complaint alleged that the defendants permitted third parties to use his "domain names" as webpage keywords, description meta tags, and web addresses in violation of the Lanham Act. See Newborn, 391 F. Supp. 2d at 184.

[6] The Court surmises that the wholesale substitution of the Copyright Act and Lanham Act for the DMCA in the amended complaint was, as Newborn contends, an "attempt[] to cure or correct any possible flaws in the Complaint." Pl.'s Opp'n at 3.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

facts to support a conclusion that the defendants substantially participated in any acts of infringement, id. at 189.

This Court similarly noted Newborn's failure to allege that his "domain names" were, in fact, trademarks that were protected under the Lanham Act. Id. at 190. This ruling was based on the finding that "besides the conclusory allegation that the defendants allowed unauthorized third party use of the plaintiff's alleged trademark, there are simply no facts in the complaint to support such an allegation." Id. at 191. This Court therefore dismissed Newborn's entire case with prejudice. Id. at 191 n.10.

The defendants now request that this Court award them attorney's fees, expenses, and costs resulting from this litigation. Defs.' Mot. at 1. The defendants seek a total award against the plaintiff of $92,671.96, which includes $89,803.00 in attorney's fees and $2,868.96 in expenses and costs.[7] Defs.' Mem. at 8. Specifically, the defendants seek $42,851.27 in fees, expenses, and costs associated with their first motion to dismiss, and $49,820.69 in fees, expenses, and costs associated with their second motion to dismiss. Defs.' Reply at 6. The defendants further request that plaintiff's counsel, pursuant to 28 U.S.C. § 1927, be held jointly liable for the fees, expenses, and costs associated with the second motion to dismiss—that is, $49,820.69 of the total award.[8] Defs.' Mem. at 8. As evidence that the amounts are reasonable,

---

[7] The defendants have waived their prior, unspecified request for additional fees and costs incurred in bringing the motion currently before the Court. Defs.' Reply at 6.

[8] In their reply brief, the defendants have presented an alternative, conditional request to the Court. Defs.' Reply at 5-6. Under this alternative, the defendants claim that they would accept an award against the plaintiff that was limited to fees and costs associated with the first motion to dismiss, as long as the Court held plaintiff's counsel personally liable under Section 1927 for fees, expenses, and costs associated with the second motion to dismiss. Id. According to the defendants, this alternative would comprise a $42,851.27 award against the plaintiff and a $49,820.69 award against plaintiff's counsel. Id. Because the court declines to award fees under Section 1927, the

(continued...)

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

the defendants have submitted the Declaration of Thomas P. Olson, one of their attorneys. Olson Declaration ("Olson Decl."). The declaration details the hourly rates, time expended, and specific work accomplished in the course of litigating the two motions to dismiss and their associated costs.[9] Olson Decl. ¶¶ 5-9, Ex. A-C.

II. Legal Analysis

As noted above, the defendants seek attorney's fees, expenses and costs under the Copyright Act, the Lanham Act, and 28 U.S.C. § 1927. Each statute's applicability will be addressed in turn.

(A) The Copyright Act

The relevant portion of the Copyright Act provides the following:

> In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs.

17 U.S.C. § 505. The Supreme Court has held that Section 505 does not provide for automatic recovery of attorney's fees by the prevailing party. Fogerty v. Fantasy, Inc., 510 U.S. 517, 534 (1994). Rather, attorney's fees are to be awarded "only as a matter of the court's discretion." Id. In deciding whether to award attorney's fees, courts may consider factors such as "frivolousness, motivation, objective unreasonableness (both in the factual and legal components of the case)

[8](...continued)
Court will not consider this alternative request.

[9] In his declaration, Olson further represents that the $89,803.00 total is, "out of an abundance of caution . . . , $10,000 less than the actual fees incurred by the defendants." Olson Decl. ¶ 7 (emphasis in original); see also Defs.' Mem. at 7.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase®
Smarter legal research.