UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

KING-DEVICK TEST INC.,
                              Plaintiff,

                -v-

NYU LANGONE HOSPITALS, et al.,
                              Defendants.

17-CV-9307 (JPO)

OPINION AND ORDER

J. PAUL OETKEN, District Judge:

Plaintiff and Counterclaim-Defendant King-Devick Test Inc. ("King-Devick") has filed

the instant lawsuit against Defendants and Counter Claimants New York University, NYU

Langone Hospitals, Steven L. Galetta, and Laura J. Balcer (collectively, "Defendants"), claiming

among other things that Defendants have infringed its registered copyright in an eye-movement

test that can aid in detecting concussions. (Dkt. No. 41 ("Compl.") ¶¶ 88–97.) Defendants, in

turn, have asserted several counterclaims, one of which seeks a declaration that King-Devick's

copyright is invalid. (Dkt. No. 52 ("CC") ¶¶ 73–85.) King-Devick now moves to dismiss that

counterclaim for failure to state a claim. (Dkt. No. 35.) For the following reasons, the motion is

denied.

I.   Background

        A.   Factual Background

For purposes of resolving King-Devick's partial motion to dismiss, the Court assumes the

truth of the factual allegations in Defendants' counterclaim complaint.[1] *See Walker Process*

Equip., Inc. v. Food Mach. & Chem. Corp., 382 U.S. 172, 174–75 (1965).

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[1] Technically, King-Devick's partial motion to dismiss is directed at the counterclaims
asserted at Docket Number 30 in connection with Defendants' Answer to the First Amended
Complaint. While King-Devick's motion was pending, however, King-Devick filed a Second

In 1976, two students at the Illinois College of Optometry, Alan King and Steve Devick, developed an eye-movement test, known as the King-Devick test (the "K-D Test"), as part of a senior project. (CC ¶¶ 2, 19.) The K-D Test, which asks a participant to read strings of single-digit numbers from left to right off a series of three successively administered test cards as rapidly and accurately as possible, can be used to detect eye-movement impairments linked to dyslexia or abnormal brain function. (CC ¶¶ 2, 18–20; *see also* Compl. ¶¶ 9–10.)

While creating the K-D Test, King and Devick studied the Pierce Saccade Test, an earlier eye-movement test developed in 1972. (CC ¶¶ 19, 25.) Like the K-D Test, the Pierce Saccade Test consists of: (1) a demonstration card containing five rows of single-digit numbers joined by arrows that direct the participant to read from left to right and top to bottom; (2) one test card that contains multiple rows of single-digit numbers, with the digits in each row connected by a horizontal line; (3) a second test card that is similar to the first, but that has no horizontal lines connecting the digits in each row; and (4) a third test card that is similar to the second, but in which the horizontal rows of unconnected digits are vertically spaced closer together. (CC ¶ 21.)

The K-D Test, though, differs in some ways from the Pierce Saccade Test. For example, the K-D Test changes the Pierce Saccade Test by changing the number of horizontal rows contained on each test card and by increasing the number of digits contained within each row. (CC ¶ 22.) A side-by-side visual comparison of the two tests is reproduced below[2]:

Amended Complaint (Dkt. No. 41), and Defendants have responded with a superseding Answer and Amended Counterclaims (Dkt. No. 52). Given that all of the arguments King-Devick has asserted in support of its partial motion to dismiss apply in full to the Amended Counterclaims, the Court treats the currently operative Answer and Amended Counterclaims at Docket Number 52 as the target of King-Devick's motion.
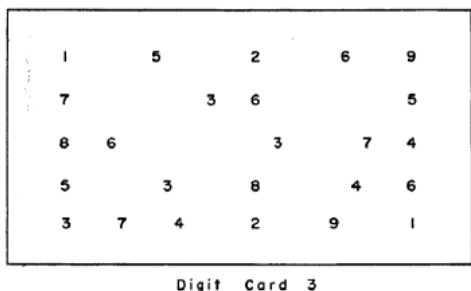
[2] The test-card sequence for the Pierce Saccade Test begins at the top-left corner and runs down the first column before moving to the top of the second column, whereas the test-card sequence for the K-D Test begins at the top-left corner and runs across the first row before moving down to the left side of the second row.

**Pierce Saccade Test**   **King-Devick Test**
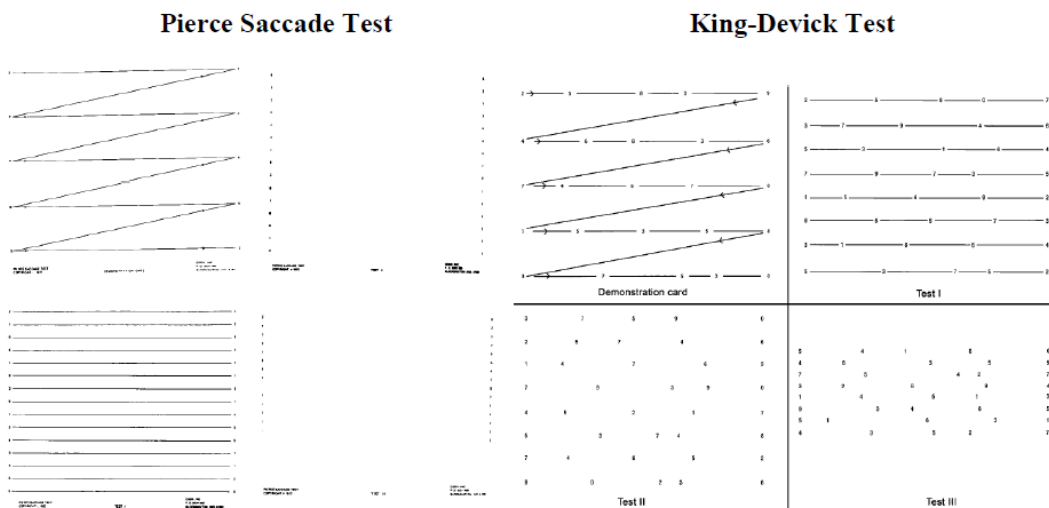
(CC ¶ 21.)

According to Defendants, King and Devick also drew inspiration from a reading-speed test, known as the Gilbert Test, which was developed in 1953. (CC ¶ 23.) The spatial arrangement of single-digit numerals on one of the Gilbert Test's test cards resembles the arrangement of the numbers in the K-D Test's second and third test cards. (*Id.*) A comparison of the relevant Gilbert Test card and the K-D Test's third test card is reproduced below:

Gilbert Test, Digit Card 3   **King-Devick Test, Test III Card**
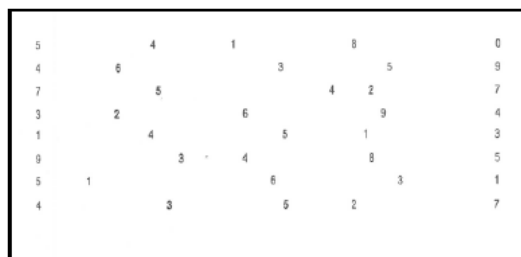
(*Id.*)

After King and Devick completed their senior project in March 1976, they allowed the Illinois College of Optometry Press to publish their final paper—with the K-D Test attached as

an appendix—and to place at least four copies in the school library. (CC ¶¶ 26–29.) Over the

next few years, the K-D Test drew attention from New York–based researchers as a possible tool

for detecting visual impairments in schoolchildren (CC ¶¶ 31–34), and on or around August 23,

1983, King and Devick successfully registered the K-D Test with the United States Copyright

Office. (CC ¶¶ 37–40; Dkt. No. 41-1 at 2.) In doing so, Defendants contend, King and Devick

intentionally failed to disclose their reliance on the Pierce Saccade and Gilbert Tests, as well as

their prior publication of the K-D Test without a notice of copyright in 1976. (CC ¶ 38.)

Thereafter, Devick pursued no further research associated with the K-D Test until 2009,

when he read an article about a New Zealand study that connected head concussions to certain

eye-movement impairments. (CC ¶¶ 43–44.) After discussing the article with Len Messner,

Director of the Illinois Eye Institute, Devick grew interested in the K-D Test's potential as a

screening tool for detecting concussions in injured athletes. (CC ¶¶ 44-45.) Messner identified

Defendants Dr. Steven Galetta and Dr. Laura Balcer (together, the "Doctors")—both at that time

neurology professors at the University of Pennsylvania—as two of the nation's leading neuro-

ophthalmologists, and in 2010 Messner approached the Doctors about the possibility of their

studying the K-D Test. (CC ¶¶ 46, 48.)

After meeting Devick, the Doctors agreed to conduct two studies to assess the K-D Test's

ability to screen for head trauma. (CC ¶ 48–49.) To facilitate these studies, Devick provided the

Doctors with free copies of the K-D Test and related materials, along with raw data that he and

his colleagues had previously collected. (CC ¶¶ 50–51, 53.) The Doctors' initial studies showed

the K-D Test to be potentially useful in concussion detection, and over the next few years the

Doctors began to study the K-D Test's possible applications to other neurological disorders. (CC

¶¶ 51, 58.) During the course of these studies, the Doctors continued to use and distribute the materials Devick had provided. (CC ¶ 60.)

As their studies proceeded, the Doctors started to develop their own eye-movement test, known as the Mobile Universal Lexicon Evaluation System ("MULES"). (CC ¶¶ 63–64.) Rather than asking a participant to read numbers off a series of test cards, as the K-D Test does, MULES asks the participant to name a series of colored images. (CC ¶¶ 64–65.) The Doctors began to test MULES in 2016, and toward the end of that year they published an article assessing the test as an alternative to the K-D Test for use in concussion screening. (CC ¶¶ 66–67.)

B.   Procedural History

On November 28, 2017, King-Devick, a Delaware company that now holds the copyright in the K-D Test, initiated this lawsuit against the Doctors and their present employers, New York University and NYU Langone Hospitals.[3] (Dkt. No. 1; *see also* Compl. ¶¶ 1, 4–5, 11.) After Defendants moved to dismiss certain of King-Devick's claims (Dkt. No. 24), King-Devick mooted the motion by filing a First Amended Complaint (Dkt. No. 27; Apr. 2, 2018 Minute Entry). The case proceeded to discovery, and King-Devick amended the complaint once more to ensure that it named the proper institutional defendants. (Dkt. Nos. 40–41.) The resultant, presently operative Second Amended Complaint raises a number of claims against Defendants, including a claim that Defendants have infringed King-Devick's copyright in the K-D Test by using and distributing the test in the course of developing MULES. (Compl. ¶¶ 88–97.)

On May 31, 2018, Defendants answered the Second Amended Complaint and asserted three counterclaims, one of which seeks a declaratory judgment that King-Devick's registered

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[3] New York University was not initially named as a defendant (Dkt. No. 1), but it was added by consent in a subsequent amendment to the complaint (Dkt. Nos. 40–41).

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