

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

THE PAUL RUDOLPH FOUNDATION,

Plaintiff,

-against-

PAUL RUDOLPH HERITAGE FOUNDATION  
and ERNST WAGNER

Defendants.

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No. 20 Civ. 8180 (CM)

**MEMORANDUM AND ORDER GRANTING IN PART AND DENYING IN PART  
DEFENDANTS' MOTION TO DISMISS**

McMahon, J.:

Plaintiff, the Paul Rudolph Foundation (“PRF” or “Plaintiff”), brings this nine-count action against Defendants, the Paul Rudolph Heritage Foundation (“Heritage”) and Ernst Wagner (“Wagner,” together “Defendants”), for trademark infringement, copyright infringement, violation of the Computer Fraud and Abuse Act, and related New York state statutory and common law claims. Plaintiff also seeks a declaratory judgment that the works transferred to the Paul M. Rudolph Archive at the Library of Congress are in the public domain and that Defendants’ copyright registration covering those works is invalid.

Defendants move to dismiss the First Amended Complaint (“FAC,” dkt. 24). That motion is GRANTED in part and DENIED in part. Count III is dismissed with prejudice, Counts VII and IX are dismissed without prejudice, and the motion is otherwise denied.

## BACKGROUND

### I. Factual Background

Although the FAC is replete with allegations regarding Wagner's alleged dishonest and malicious conduct, I here summarize only those facts relevant to the Defendants' motion to dismiss the FAC.

#### A. *The Parties*

Plaintiff is a New York-based non-profit organization. It was founded after the death of renowned modern architect Paul Rudolph, to preserve his legacy as Chair of the Yale Department of Architecture and Brutalist/Modernist architectural designer. (FAC ¶ 1, 8.)

Defendant Wagner was one of the founding members of the plaintiff foundation, as well as its former president. Wagner is domiciled in New York. (FAC ¶ 2.)

On March 2, 2014, Wagner was voted off Plaintiff's Board, after other members grew unhappy with his behavior. (FAC ¶¶ 76-85.)

Heritage is a New York-based non-profit organization formed by Defendant Wagner in 2015 after his ouster from PRF. (FAC ¶ 99.) Heritage operates out of a property at West 58th Street in Manhattan, the former headquarters of PRF. (FAC ¶ 105.)

#### B. *Rudolph's Estate*

##### (1) The 1996 Will

On September 30, 1996, Rudolph executed a will. (the "'96 Will). Under this will, a \$2,000,000 testamentary trust was established for the benefit of Wagner, Rudolph's longtime friend. The trust was to be funded by the sale of certain real property at 23 Beekman Place in Manhattan. (FAC ¶ 13.)

In the '96 Will, Rudolph bequeathed the physical copies of his drawings, plans, renderings, blueprints, models, papers, treatises, and other materials related to his architectural practice (the

“Rudolph Archive”) to the Library of Congress. (FAC ¶ 10.) ”), which named his attorney John Newhouse as his executor. (FAC ¶¶ 11, 12.) There was no mention of any disposition of the intellectual property in those materials in the 1996 Will; but Wagner was named as the residuary beneficiary under the Will (FAC ¶ 23.) Assuming arguendo that the intellectual property was part of the residue – as plaintiff alleges (FAC ¶ 22) – it appears to this court that Wagner would have succeeded to those rights under the 1996 Will, even though, according to Plaintiff, Rudolph wanted scholars and the public to have meaningful access to his work. (FAC ¶ 9)

John Newhouse, Rudolph’s long-time attorney in fact and health care agent, was named as Executor of the 1996 Will.

(2) The 1997 Will

On March 17, 1997, Rudolph suffered a heart attack. Plaintiff alleges that, while Rudolph was in a coma, Wagner and his attorney, Thomas Heckman, devised a plan to draft a new will that would convey a greater share of Rudolph’s assets to Wagner. (FAC ¶¶16-18.)

On April 16, 1997, shortly after Rudolph awoke from the coma, Rudolph executed a new will (“’97 Will”). In that will, Rudolph bequeathed to Wagner \$1,000,000 outright, as opposed to \$2,000,000 in trust. The ’97 Will also provided for the outright transfer to Wagner of a piece of property on West 58th Street that Rudolph owned. (FAC ¶ 20.) And the will made other, unspecified changes that were deemed

In the ’97 Will, as in its predecessor, Rudolph bequeathed his Archive to the Library of Congress. (*Id.*) Again the Will said nothing about the intellectual property rights appurtenant to the physical items in the Archive (FAC ¶ 22). However, the residuary beneficiary under the 1997 Will was not Wagner, but the Library of Congress Trust Fund Board (LOCTFB). (FAC ¶ 24.)

(3) The Guardianship Proceeding, Rudolph’s Death, the Will Contest and Reformed Will

In July of 1997, Rudolph's sister and his office manager instituted an Article 81 guardianship proceeding, alleging that Wagner had induced Rudolph to amend his will to Wagner's benefit. (FAC ¶ 25.) Rudolph died before the hearing took place, and the '97 Will was submitted for probate. (FAC ¶¶ 26, 28.) Plaintiff alleges that Newhouse (Rudolph's attorney) sought leave to file objections to the '97 Will. (FAC ¶ 29.) It also alleges that a Court-appointed Evaluator questioned whether Rudolph had the capacity to execute documents during the period when the '97 Will was signed. (FAC ¶ 26)

On June 6, 2001, Wagner, Wagner's attorney Heckman, Newhouse, and the LOCTFB resolved the probate challenges by entering into a stipulation of settlement ("Stipulation of Settlement"), and by modifying the terms of the '97 Will. (FAC ¶ 31.) This "Reformed Will" is the will that was eventually probated.

Article THIRD provides for a bequest of certain tangible property to Wagner. Excluded from that property in the Reformed Will is the following:

Currency and any and all drawings, plans, renderings, blueprints, models, papers, treatises, and other materials that I prepared or had prepared in connection with my professional practice of architecture which is hereinafter specifically disposed of in Article FOURTH hereof.

Article FOURTH of the Reformed Will bequeathes all such materials to the LOCTFB.

With respect to that bequest, the Stipulation of Settlement provides as follows:

In furtherance of fulfilling the wishes of Paul M. Rudolph as set forth in Article FOURTH of the Reformed 1997 Will, the LOC Trust Fund Board shall transfer to the Library of Congress those items among the Architectural Archives and among the items set forth in Paragraph 5 below that the Library of Congress determines are suitable for its collections. The intellectual property rights of all such items transferred to the Library of Congress shall be dedicated to the public.

(FAC ¶ 32.) Plaintiff alleges that approximately 20,000 works physical works from the Rudolph Archive (some of which are the subject of this dispute) were ultimately donated

to the Library of Congress and became part of the public domain. Plaintiff further alleges that the phrase “The Intellectual property rights of all such items transferred to the Library of Congress shall be dedicated to the public,” means that the Estate voluntarily and irrevocably abandoned Rudolph’s intellectual property rights in those 20,000 works. (FAC ¶ 40).

Per the complaint, Wagner inherited the West 58<sup>th</sup> Street Property. (FAC 60).

*C. Paul Rudolph Foundation*

Plaintiff is a charitable organization that began operating under the name Paul Rudolph Foundation in 2002. (FAC ¶ 48.) Plaintiff alleges that it has used the name exclusively and continuously in connection with promoting public awareness of architectural preservation and restoration, including on the internet and its social media accounts. (FAC ¶¶ 49, 51.) Plaintiff’s name, Paul Rudolph Foundation, is a registered trademark, and has allegedly acquired strong secondary meaning. (FAC ¶ 55.)

From 2002 until 2014 Wagner served on Plaintiff’s Board, including as its President. During that period, the Plaintiff Foundation operated out of the West 58<sup>th</sup> Street property. During portions of that period, both Plaintiff and a business operated by Wagner out of the same premises, Modulightor, even shared a computer server.

However, the FAC alleges a variety of ways in which Wagner – even during his term as President of Plaintiff’s Board – sought to undermine Plaintiff’s operations and aggrandize his own role as the conservator of Rudolph’s memory. As a result, Wagner was voted off the Board in 2014, whereupon he evicted Plaintiff from that property. Plaintiff migrated its files to a cloud based server after it parted ways with Wagner, ultimately deleting them. (FAC ¶ 61)

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