THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF PUERTO RICO

HECTOR L. ALVARADO-ORTIZ, aka "TOWY",

Plaintiff,

v.

OMAR GONZALEZ-SANTIAGO, aka "SUPER YEI", and/or "SUPERIORITY", d/b/a/ "SUPERIORITY", et al.,

Defendants.

Civ. No. 21-1197 (ADC)

MEMORANDUM OPINION & ORDER

Before the Court are two post-judgment motions filed by the prevailing defendants, Omar González-Santiago ("González-Santiago"), Osquel Santiago-García, Gerardo Martínez-Salella, Samuel J. Figueroa-Cruz, Heriberto Santiago-García, and Jonathan González-Collazo (collectively, and with González-Santiago, "defendants"). In their first motion, defendants request that the Court amend *nunc pro tunc* the judgment entered on September 30, 2022 (**ECF No. 43**) to reflect that the copyright infringement claims filed by plaintiff Héctor L. Alvarado-Ortiz ("plaintiff") against González-Santiago have been dismissed with prejudice. *See* **ECF No. 47**. Seeing that this motion is unopposed and that the Court's Order of September 26, 2022 (**ECF No. 41**) reflects a dismissal with prejudice as to the claims against González-Santiago, the Court hereby **GRANTS** defendants' request to amend the judgment *nunc pro tunc*.

Defendants' second motion requests an award for reasonable attorney's fees incurred in defending the copyright infringement claims levelled against González-Santiago under the

Copyright Act and for vexatious litigation, 28 U.S.C. § 1927. **ECF No. 46**. Defendants request an award for $19,350. *See id.*, at 4.

From the outset, the Court advances that it will deny an award under 28 U.S.C. § 1927, as it is not evident that plaintiff's counsel "so multiplie[d] the proceedings in [this] case unreasonably and vexatiously" to warrant relief of this kind. The situation is different for defendant's request under the Copyright Act, which provides for the "recovery of full costs by or against any party" and an "award [for] reasonable attorney's fee to the prevailing party as part of the costs," subject to the Court's discretion. 17 U.S.C. § 505. In order for such allowance and award, the Court must evaluate the criteria set out in *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994) and *Kirstaeng v. John Wiley & Sons, Inc.*, 579 U.S. 197 (2016). In doing so, it is guided by the First Circuit's application of these criteria in subsequent cases. *See, e.g.*, *Markham Concepts, Inc. v. Hasbro, Inc.*, 71 F.4th 80 (1st Cir. 2023); *Small Justice LLC v. Xcentric Ventures LLC*, 873 F.3d 313 (1st Cir. 2017).

As a threshold matter, the Court sees no problem in finding that González-Santiago is a "prevailing party" for purposes of 17 U.S.C. § 505. González-Santiago obtained judgment in his favor over plaintiff's claims based on a motion to dismiss for failure to state a claim. After presenting proof that he held a license from the other undisputed joint authors (i.e., co-defendants Heriberto Santiago-García, Osquel Santiago-García, and Jonathan González-Collazo) to use the copyrighted material at issue. *See* **ECF No. 35-2** (granting "Superiority,"

González-Santiago's alias and trade name, license to exploit the master recording of the copyrighted material at issue). Thus, his dismissal operates as a decision on the merits that has created "a material alteration of the legal relationship between the parties." *Buckhannon Bd. & Care Home, Inc. v. W. Virginia Dep't of Health & Hum. Res.*, 532 U.S. 598, 603–04 (2001).

But even if one were to see the dismissal as something less than a full victory on the merits, that would matter little. A defendant can be a prevailing party even if his or her victory is one on standing grounds or comes as a result of a plaintiff's discovery violations. *See Small Justice LLC v. Xcentric Ventures LLC*, 873 F.3d at 328 (citing *InvesSys, inc. v. McGraw-Hill Cos.*, 369 F.3d 16, 20 (1st Cir. 2004)). Thus, González-Santiago is a prevailing party under 17 U.S.C. § 505.

Turning to the *Fogerty* test, the Supreme Court in that case adopted "several nonexclusive factors that courts should consider in making awards of attorney's fees to any prevailing party." *Fogerty*, 510 U.S. at 534 n. 19. "These factors include frivolousness, motivation, objective unreasonableness (both in the factual and in the legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence." *Id.*, (citation and quotation marks omitted). In *Kirstaeng*, the Supreme Court clarified that the "objective reasonableness" factor was "an important factor in assessing fee applications [but] not a controlling one." *Kirstaeng*, 579 U.S. at 208. "Although objective reasonableness carries significant weight, courts must view all the circumstances of a case on their own terms, in light of the Copyright Act's essential goals." *Id.* The statute's "essentials goals" are "enriching the

general public through access to creative works… by striking a balance between two subsidiary aims: encouraging and rewarding authors' creations while also enabling others to build on that work." *Kirstaeng*, 579 U.S. at 204 (citing U.S. Const., Art. I, § 8, cl. 8 and *Fogerty*, 510 U.S. at 526-27).

After fresh review of the amended complaint and the ensuing motions, the Court finds that the record does not show that plaintiff's claims against González-Santiago were either frivolous, motivated in bad faith, or objectively unreasonable either at law or in fact. Admittedly, the record is slim, limited to pleadings, two motions to dismiss under Fed. R. Civ. P. 12(b)(6), and the documents submitted by defendants in compliance with the Court's order at **ECF No. 32** to "file into the record evidence as to the copyrights and licenses held by each party…."

From the outset, the Court notes that defendants arguments are two-fold: (1) that the Copyright Act's essential goals were frustrated by plaintiff's lawsuit given that defendants' "creative work has been inaccessible to the public for 18 months;" and that (2) plaintiff's lack of interest in the prosecution of his case, evidenced by inexplicable procedural delays and failures to comply with filing and court-imposed deadlines, was objectively unreasonable. No argument is made as to whether the complaint was frivolous or motivated by bad faith.

First, the Court's own review of the record finds that there is little to no indication of a bad faith motivation behind the complaint. Second, neither can the Court classify the claims against González-Santiago as frivolous, and in that same vein, the Court finds that the claims

against González-Santiago were not objectively unreasonable in fact or law. As opposed to co-defendants Heriberto Santiago-García, Osquel Santiago-García, and Jonathan González-Collazo, plaintiff did not recognize González-Santiago as a co-author of the copyrighted material in his complaint. *See* **ECF No. 19-1** at ¶¶ 23, 34, 68(g). The proof that ultimately carried the day for González-Santiago was a "split sheet" royalty agreement in which these co-defendants, as joint authors of the copyrighted material, granted him a license to exploit it. *See* **ECF No. 35-2**. Although plaintiff's name and contribution were included in the agreement, his signature is absent from the document and there is nothing in the record that would suggest that he was aware of this license. Accordingly, it was neither frivolous nor objectively unreasonable, from the limited facts available on the record, for plaintiff to claim that Gonzalez-Santiago was infringing on his copyright.

Third, defendants do have a point in that plaintiff's lawsuit resulted in the public being deprived of the enjoyment of the copyrighted work at issue here, as well as defendants' enjoyment of its fruits for that period. This deprivation was ultimately unjustified given the lack of merit of plaintiff's copyright infringement claims—evidenced by its complete dismissal with prejudice as to González-Santiago and without prejudice on sufficiency and time-limitations grounds as to all other defendants. The above supports the imposition of attorney's fees as a deterrent against similar future actions.

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