

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF SOUTH CAROLINA  
CHARLESTON DIVISION

The College of Charleston Foundation,	)	Civil Action No.: 2:07-cv-03264-DCN
	)	
Plaintiff,	)	
	)	
vs.	)	<b>MEMORANDUM IN SUPPORT OF</b>
	)	<b>DEFENDANT'S MOTION TO DISMISS</b>
Benjamin Ham,	)	
	)	
Defendant.	)	
	)	

---

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, Defendant Benjamin Ham moves the Court for an Order dismissing Plaintiff’s Complaint for failing to state a claim upon which relief can be granted.

Plaintiff, a 501(c)(3) corporation, filed a complaint in state court seeking to exert ownership rights over the “image” of a tree-lined road which was captured and developed into a photograph by Mr. Ham. Through its various state law claims, Plaintiff seeks both monetary and injunctive relief based upon Mr. Ham’s development, reproduction and distribution of the image in the photograph, which was created through Mr. Ham's sole efforts. Because Plaintiff’s state law claims come within the exclusive purview of federal copyright law, Mr. Ham timely removed the action to this Court pursuant to 28 U.S.C. §§ 1331 and 1338(a).

Mr. Ham now moves to dismiss Plaintiff’s claims for failing to state a claim upon which relief can be granted based on the following grounds:

1. Plaintiff's claims for conversion and trespass are preempted by the Copyright Act pursuant to 17 U.S.C. § 301(a).
2. Plaintiff's attempt to assert copyright ownership under the Copyright Act through its conversion and trespass claims fail as a matter of law.

3. Plaintiff's trespass claim fails because Plaintiff does not claim any *physical* damage to its property associated with the alleged trespass.
4. Plaintiff's claim for invasion of privacy fails because corporations and trees, as non-humans, have no right of privacy.

### **FACTS**

Plaintiff filed its Complaint on August 8, 2007. Plaintiff alleges that Mr. Ham entered and shot photographs of Plaintiff's property located at Dixie Plantation. (Compl. ¶¶ 7, 9-10, 12.) Plaintiff further alleges that Mr. Ham developed, reproduced and sold copies of at least one of these photographs, which he named "Plantation Road." (Compl. ¶¶ 25-26.) Plaintiff seeks both monetary and injunctive relief for the creation, reproduction, and sale of Mr. Ham's photograph under the state law theories of conversion and trespass. (Compl. ¶¶ 13-16, 21-29.) Plaintiff also seeks to recover for the invasion of its right of privacy. (Compl. ¶¶ 17-20.)

### **ARGUMENT**

"A motion to dismiss under Rule 12(b)(6) tests the legal sufficiency of a complaint." Colleton Reg'l Hosp. v. MRS Med. Review Sys., Inc., 866 F. Supp. 896, 898 (D.S.C. 1994). In considering a Rule 12(b)(6) motion, the court must accept all well-pleaded allegations in the plaintiff's complaint as true. Edwards v. City of Goldsboro, 178 F.3d 231, 244 (4th Cir. 1999). However, to avoid dismissal, a plaintiff's "pleading must contain something more . . . than . . . a statement of facts that merely creates a suspicion of a legally cognizable right of action." Bell Atlantic Corp. v. Twombly, 127 S. Ct. 1955, 1966 (2007).<sup>1</sup> Rather, the "[f]actual allegations must be enough to raise a right to relief above the speculative level." Id.

---

<sup>1</sup> Twombly is important because in it the Supreme Court abrogated the "no set of facts" standard that emanated from Conley v. Gibson, 355 U.S. 41 (1957). See Twombly, 127 S. Ct. at slip op. at 16-18 ("The phrase ['no set of facts'] is best forgotten as an incomplete negative gloss on an accepted pleading standard: once a claim has been stated adequately, it may be supported by showing any set of facts consistent with the allegations of the complaint.").

As the Supreme Court explained in Twombly, “[t]he complaint may be dismissed if plaintiff has not stated enough facts to state a claim to relief that is plausible on its face.” 127 S. Ct. at 1968-69.

"The purpose of [Rule 12(b)(6)] is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc., 988 F.2d 1157, 1160 (Fed. Cir. 1993). In resolving a motion to dismiss, a court may look to “matters of public record, items appearing in the record of the case, as well as exhibits attached to the complaint.” Norfolk Fed'n of Bus. Dist. v. H.U.D., 932 F. Supp. 730, 736 (E.D. Va. 1996), aff'd, 103 F.3d 119 (4th Cir. 1996).

**I. The Court should dismiss Plaintiff's conversion and trespass claims as preempted by the Copyright Act.**

Congress retains the exclusive authority to regulate copyrights. U.S. Const. art. I, § 8, cl. 8. As of January 1, 1978, federal copyright law preempted “all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103.” 17 U.S.C. § 301(a). To determine whether a state-law claim is preempted by the Copyright Act, courts employ a two-pronged inquiry under which Section 301(a) "preempts state-law claims if [1] the work is within the scope of the 'subject matter of copyright' as specified in 17 U.S.C. §§ 102 and 103 and [2] the rights granted under state law are equivalent to any exclusive rights within the scope of federal copyright as set out in 17 U.S.C. § 106." Rosciszewski v. Arete Assocs. Inc., 1 F.3d 225, 229 (4th Cir. 1993). The scope of preemption provided for under Section 301(a) has been described as "broad," "absolute," and "stated in the clearest and most

unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection." United States v. Bd. of Trustees of Univ. of Ala., 104 F.3d 1453, 1464 (4th Cir. 1997).

A. The Court should hold that the photographs and images embodied therein fall within the scope of the subject matter of copyright.

Under the first prong of the preemption inquiry, the photographs taken by Mr. Ham fall within the scope of the subject matter of copyright, which expressly includes "pictorial, graphic, and sculptural works." 17 U.S.C. § 102(a)(5); see also Henry v. Nat'l Geographic Soc'y, 147 F.Supp.2d 16, 20 (D. Mass. 2001) (noting "photographs . . . are subject to copyright protection"). Similarly, although not copyrightable in and of itself, the "unique image" of the real property located at Dixie Plantation, which lies at the heart of Plaintiff's conversion and trespass claims and which is embodied in Mr. Ham's photographs, falls under the scope of the Copyright Act, which is broader than its expressed subject matter.<sup>2</sup> See Bd. of Trustees of Univ. of Ala., 104 F.3d at 1463 (4th Cir. 1997) (finding that ideas and methods embodied in

---

<sup>2</sup> While it is unclear what Plaintiff means in referring to the "image" of Dixie Plantation, the most logical conclusion is that Plaintiff is referring to the underlying subject matter of Mr. Ham's photographs, which, in the case of the "Plantation Road" photograph, consists of a tree-lined road. A tree-lined road or any other element of nature, without more, cannot be copyrighted because it lacks originality, which requires both independent creation and at least a minimal degree of creativity. See Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., 74 F.3d 488, 492 (1996). Similarly, when the subject matter of a photograph is a pre-existing object such as a building or tree, the photographer can claim no rights to those objects due to the lack of independent creation and, as such, cannot prevent others from photographing that same subject matter. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250, 23 S. Ct. 298, 300 (1903); Mannion v. Coors Brewing Co., 377 F.Supp.2d 444, 450 (S.D.N.Y. 2005). However, a photographer can claim copyright protection as to the original aspects of his photograph, such as lighting, angle, positioning and timing. See Mannion, 377 F.Supp.2d at 451. Thus, it is important to note that Plaintiff is incorrect in its belief that it, or anyone else, cannot take a photograph of the same tree-line road from a similar location on its property.

copyrightable works fall within scope of Copyright Act for preemption purposes). As such, the Court should hold that the first prong of the preemption inquiry is satisfied.

B. The Court should hold that the rights sought to be vindicated through Plaintiff's conversion and trespass claims are equivalent to the exclusive rights provided for under the Copyright Act.

Under the second prong of the preemption inquiry, "state-law claims that infringe one of the exclusive rights contained in § 106 are preempted by § 301(a) if the right defined by state law may be abridged by an act which, in and of itself, would infringe one of the exclusive rights." Rosciszewski, 1 F.3d at 229. Only if the state law claim requires an extra element in addition to or instead of the acts of reproduction, performance, distribution or display which makes the claim *qualitatively* different from a copyright infringement claim can preemption be avoided. Id. at 229-30. As a practical matter, courts focus on what the plaintiff seeks to protect – if the state law claim seeks to protect a matter within the scope of copyright law, then the claim is preempted.<sup>3</sup> See Henry, 147 F.Supp.2d at 21. Thus, even though the elements of a state law claim appear to be qualitatively different from a copyright infringement claim, "preemption should continue to strike down claims that, though denominated [as state law claims], nonetheless complain directly about the reproduction of expressive materials." Madison River Mgmt. Co. v. Bus. Mgmt. Software Corp., 351 F.Supp.2d 436, 443 (M.D.N.C. 2005). This requires the court to examine the precise bases for the state law claims as alleged in the complaint to determine whether the claims are a veiled attempt to vindicate rights covered by the Copyright Act. Id. at 444 (breach of contract claims preempted when arising from alleged wrongful reproduction and distribution of software); Wharton v. Columbia Pictures Indus., Inc., 907 F. Supp. 144, 145-146 (D.Md. 1995) (misrepresentation, civil conspiracy, unjust enrichment,

---

<sup>3</sup> Failure to register a copyright does not nullify the preemptive effect of § 301. See Trandes Corp. v. Atkinson Co., 996 F.2d 655, 658 (4th Cir. 1993).

fraud, tortious interference with prospective advantage, and breach of contract claims preempted when arising from alleged wrongful preparation of derivative works from a screenplay). In so doing, the court should be vigilant for federal copyright claims masquerading under the pretext of state law causes of action because "if the language of the [A]ct could be so easily circumvented, the preemption provision would be useless, and the policies behind a uniform Copyright statute would be silenced." Bd. of Trustees of Univ. of Ala., 104 F.3d at 1464 (citing Daboub v. Gibbons, 42 F.3d 285 (5th Cir. 1995)).

Under South Carolina law, conversion is "the unauthorized assumption and exercise of the right of ownership over goods or personal chattels belonging to another, to the alteration of the condition or the exclusion of the owner's rights." Hawkins v. City of Greenville, 358 S.C. 280, 297, 594 S.E.2d 557, 566 (Ct. App. 2004). While conversion claims are not per se preempted, where the basis for a conversion claim is merely the unlawful retention of the plaintiff's intellectual property rights, the conversion claim is preempted by the Copyright Act. Bd. of Trustees of Univ. of Ala., 104 F.3d at 1463; Madison River, 351 F.Supp.2d at 444. Here, Plaintiff under the guise of its conversion claim seeks to protect the "image" of Dixie Plantation which Plaintiff alleges Mr. Ham "is not entitled to convert . . . for his personal use and/or commercial gain." (Compl. ¶ 26.) Because this allegation constitutes the mere retention of the images and representations of Dixie Plantation, which fall under the scope of the subject matter of copyright, rather than the retention of any physical object belonging to Plaintiff, the conversion claim is preempted by the Copyright Act. Furthermore, while Plaintiff attempts to make allegations concerning the "conversion" of the photographs which Mr. Ham created, such allegations merely equate to claims concerning the wrongful reproduction and distribution of the image of Dixie Plantation, which are equivalent to the rights granted under Section 106 and, as

such, are also preempted. See Madison River, 351 F.Supp.2d at 444 (conversion claim preempted when allegations of connecting, copying, converting, and distributing software relate to intangible program rather than retention of any physical object).

Similarly, Plaintiff bases its trespass claim on the loss of its alleged exclusive rights in the image of Dixie Plantation. Under South Carolina law, "trespass is any intentional invasion of the plaintiff's interest in the exclusive possession of his property." Hawkins, 358 S.C. at 296, 594 S.E.2d at 565. Here, the "property" which Plaintiff alleges Mr. Ham invaded its interest in is the image of Dixie Plantation, and Plaintiff seeks to recover through its trespass claim the "lost use of its private right to" that image, specifically the "lost use and exclusivity of [the] unique image and representation found on Dixie Plantation." (Compl. ¶ 16.) Furthermore, Plaintiff characterizes the continued reproduction, sale and distribution of the image captured in Mr. Ham's photograph as "a continuous trespass." (Compl. ¶ 27.) Because such allegations are equivalent to the rights to reproduce and distribute under Section 106, Plaintiff's trespass claim is preempted by the Copyright Act.

Finally, Plaintiff's conversion and trespass claims are preempted to the extent such claims attempt to grant all rights to the images and photographs to Plaintiff. Application of either the doctrine of conversion or trespass as alleged by Plaintiff would effectively grant to Plaintiff the exclusive right to reproduce, distribute and display the images and photographs of Dixie Plantation which were created by Mr. Ham. As a result, "the rights that would be acquired by [conversion or trespass] would be equivalent to the rights set out in § 106 of the Copyright Act" and are preempted by Section 301(a). Advance Magazine Publishers Inc. v. Leach, 466 F.Supp.2d 628, 635 (D.Md. 2006) (claim of acquisition of rights in magazines under doctrine of adverse possession preempted under Copyright Act).

Plaintiff seeks to vindicate its alleged right to control the reproduction, distribution and display of the images and photographs of Dixie Plantation through its conversion and trespass claims. Because the Copyright Act exclusively governs such rights, the Court should hold that the conversion and trespass claims are preempted.

**II. The Court should hold that Plaintiff's assertions of copyright ownership through its conversion and trespass claims constitute an improper transfer of copyright under the Copyright Act.**

Plaintiff's conversion and trespass claims are equally dismissible to the extent that Plaintiff attempts to state a claim under the Copyright Act for transfer of copyright ownership. The Copyright Act expressly provides that copyright subsists in a copyrightable work at the moment of the work's creation and automatically vests in the original author of the work. 17 U.S.C. §§ 102(a), 201(a). The Copyright Act goes to great lengths to protect the author's rights in his or her work, expressly setting forth the requirements for voluntary transfers and prohibiting involuntary transfers except in bankruptcy proceedings. 17 U.S.C. §§ 201(d), 204, 201(e). No precedent for the transfer of ownership of a copyright in a photograph due to any allegedly wrongful act committed by the photographer has been found but, in any event, such precedent would run afoul of the express provision of the Copyright Act concerning involuntary transfers. See Leach, 466 F.Supp.2d at 636 ("claim to have effected the transfer by operation of law through adverse possession amounts to a claim for an involuntary transfer of rights, which is barred by 17. U.S.C. § 201(e)").

Here, Plaintiff admits that Mr. Ham is the author of the photographs which he shot while allegedly on Plaintiff's property. (See, e.g., Compl. ¶¶ 10, 11, 23-25.) As such, the copyrights in the photographs are owned exclusively by Mr. Ham. 17 U.S.C. § 201. Any transfer of Mr. Ham's copyrights must be completed in accordance with the provisions of the

Copyright Act, and Plaintiff's claims to the contrary fail as a matter of law. See Leach, 466 F.Supp.2d at 636-37 (dismissing claim of ownership of copyright through state law doctrine of adverse possession); Food Lion, Inc. v. Capital Cities/ABC, Inc., 946 F. Supp. 420, 422 (M.D.N.C. 1996) (dismissing claim of ownership of copyright through state law doctrine of constructive trust), aff'd, 116 F.3d 472 (4th Cir. 1997) (table). Furthermore, Plaintiff's alleged ownership of the real property depicted in the photographs created by Mr. Ham does not confer any rights in the photographs themselves, and vice versa. See note 2, supra. Given the clear language of Section 201(a) of the Copyright Act concerning an author's automatic ownership of the copyrights in his or her works and the distinction between copyright ownership and ownership of physical property in Section 202, such arguments are similarly unavailing. As such, to the extent Plaintiff seeks to assert ownership of the copyrights in Mr. Ham's photographs under the Copyright Act, Plaintiff's claims fail as a matter of law and should be dismissed.

**III. The Court should dismiss the trespass claim because Plaintiff fails to allege any physical damage was proximately caused by the alleged trespass.**

In May 2007, the United States Supreme Court clarified the standard to survive a motion to dismiss for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6). See Bell Atlantic Corp. v. Twombly, 127 S. Ct. 1955 (2007). Traditionally, courts have looked to whether "it appear[ed] beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief." See Conley v. Gibson, 355 U.S. 41, 45-46 (1957). The Court rejected the Conley language as the standard for motions to dismiss, noting it "has earned its retirement." Twombly, 127 S. Ct. at 1969. Rather, the Twombly court emphasized that plaintiff must plead "enough facts to state a claim to relief that is plausible on its face." Id. at 1974. Rule 8(a)(2) requires more than just a "formulaic recitation of the elements of a cause of action," and plaintiffs must include sufficient facts to demonstrate that recovery is a possibility

– not just a plausibility. See id. at 1966-67. If plaintiffs fail to plead facts which "nudge[] their claims across the line from conceivable to plausible" then the complaint must be dismissed. Id. at 1974.

In the instant matter, Plaintiff fails to state any facts that make recovery under its trespass claim more than a mere plausibility. In order to state a claim for trespass under South Carolina law, Plaintiff must prove that "the harm caused by the invasion of the land [is] the direct result of that invasion." Hawkins v. City of Greenville, 358 S.C. 280, 297, 594 S.E.2d 557, 566 (Ct. App. 2004). It is a fundamental tenant of the law of trespass that the only damages recoverable under this cause of action are *physical* damages proximately caused by the intentional invasion. See Restatement (Second) of Torts § 162 (1965). Here, Plaintiff fails to allege any physical damage from the alleged trespass. Rather, Plaintiff only claims that it was damaged by the loss of "use of its private right to the property" and the loss of "use and exclusivity of a unique image and representation found on Dixie Plantation." (Compl. ¶ 16.) Plaintiff fails to state how Mr. Ham is preventing Plaintiff's use of its real property – certainly, Plaintiff cannot state under Federal Rule of Civil Procedure 11 that Mr. Ham is physically blocking Plaintiff from using its property, and to the extent that Plaintiff alleges Mr. Ham is blocking its use of the "image" of its property, such claims are preempted. See sec. I, supra. Furthermore, no where in its Complaint does Plaintiff allege that Mr. Ham broke any lock on any gate on the property, or that he trampled on any flowerbed, or that he cut down any branches on the trees which he was photographing. While such physical damages are theoretically possible, Twombly's heightened pleading requirements preclude allegations based on mere theoretical possibilities; as such, the Court should dismiss Plaintiff's trespass claim.

**IV. The Court should dismiss Plaintiff's invasion of privacy claim because corporations and trees, as non-humans, have no right of privacy.**

Plaintiff alleges that Mr. Ham's "trespass onto Plaintiff's property represents a wrongful intrusion on Plaintiff's privacy rights." (Compl. ¶ 18.) However, while South Carolina recognizes the right of privacy, "[t]his interest in 'privacy' is a distinct aspect of *human* dignity and moral autonomy." Snakenberg v. Hartford Cas. Insurance Co., 299 S.C. 164, 169, 383 S.E.2d 2, 5 (Ct. App. 1989) (emphasis added). As such, a right of privacy can only be asserted by human beings. Plaintiff is a corporation, a non-human entity that has no right of privacy. See 62A Am. Jur. 2D *Privacy* § 21 (2005) ("A corporation, partnership, or unincorporated association has no personal right of privacy...."). Similarly, the trees and other plant material that are the subject of Mr. Ham's photograph are also non-human entities which have no right of privacy. See Lawrence v. Ylla, 184 Misc. 807, 809, 55 N.Y.S.2d 343, 345 (Sup. Ct. 1945) (dog has no right of privacy). No allegation in the Complaint states that any part of a human being was photographed by Mr. Ham or that Mr. Ham even identified Plaintiff's property as the subject of the photograph. Rather, Plaintiff alleges only that the photograph is known as "Plantation Road," a generic description which could be applied to any of the tree-lined roads located on the many plantations in the South. Given that Plaintiff cannot claim a right of privacy, the Court should dismiss the invasion of privacy claim.

### **CONCLUSION**

For the reasons stated above, Mr. Ham's motion to dismiss Plaintiff's claims for failure to state a claim should be granted.

[SIGNATURES ON FOLLOWING PAGE]

Respectfully submitted,

NELSON MULLINS RILEY & SCARBOROUGH, L.L.P.

By: s/ John C. McElwaine

John C. McElwaine

Federal Bar No. 6710

Email address: john.mcelwaine@nelsonmullins.com

Eli A. Poliakoff

Federal Bar No. 9747

Email address: eli.poliakoff@nelsonmullins.com

Janene B. Smith

Federal Bar No. 9960

Email address: janene.smith@nelsonmullins.com

Liberty Building, Suite 500

151 Meeting Street

Post Office Box 1806 (29402)

Charleston, SC 29401

(843) 853-5200

George J. Kefalos

Federal Bar No. 2290

Email address: george@kefaloslaw.com

3 State Street

Charleston, SC 29401

(843) 722-6612

Attorneys for Benjamin Ham

Charleston, South Carolina

October 4, 2007