

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

**INTERNATIONAL KITCHEN EXHAUST  
CLEANING ASSOCIATION,**

**Plaintiff,**

v.

**POWER WASHERS OF NORTH  
AMERICA,**

**Defendant.**

**Civil Action 99-00675  
(HHK)**

**MEMORANDUM OPINION AND ORDER**

Plaintiff, International Kitchen Exhaust Cleaning Association (“Kitchen Exhaust”), is a nonprofit corporation that promotes fire safety in restaurants and professionalism in the kitchen-exhaust-cleaning industry. Defendant, Power Washers of North America (“Power Washers”), also a nonprofit corporation, advances the interests of the power-washing industry. Kitchen Exhaust alleges that Power Washers is liable to it for copyright infringement and unfair competition because Power Washers copied and used certain certification-program materials, particularly test questions, that had been created by Kitchen Exhaust’s agent. Kitchen Exhaust seeks multiple remedies, including punitive damages and injunctive relief.

Before the court is Power Washers’ motion to dismiss Kitchen Exhaust’s amended complaint. Power Washers argues that (1) Kitchen Exhaust failed to register its copyright before filing suit as allegedly required by the Copyright Act, (2) the Copyright Act preempts Kitchen Exhaust’s unfair-competition claim, and (3)

Kitchen Exhaust has no “claim” for punitive damages as a matter of law. Having considered Power Washers’ motion, Kitchen Exhaust’s opposition thereto, and the record of this case, the court concludes that Kitchen Exhaust’s attempts at registration before filing suit were adequate under the Copyright Act and that Kitchen Exhaust’s unfair-competition claim is preempted. The court further construes Kitchen Exhaust’s punitive damages “claim” as a remedy and denies Power Washers’s challenge to it at this time.

## II. FACTUAL BACKGROUND

The following facts are gleaned from Kitchen Exhaust’s amended complaint.<sup>1</sup>

Both parties are nonprofit industry associations of sorts. Kitchen Exhaust aspires to promote fire safety in restaurants and professionalism in the kitchen-exhaust-cleaning

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<sup>1</sup> A motion to dismiss is appropriate “only if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations.” See *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957) (holding that a complaint should not be dismissed “unless it appears beyond a doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief”). The court should construe the complaint in a light most favorable to the Kitchen Exhaust and accept as true all reasonable factual inferences drawn from well-pleaded factual allegations. See *Schuler v. United States*, 617 F.2d 605, 608 (D.C. Cir. 1979) (quoting *Jenkins v. McKeithen*, 395 U.S. 411, 421 (1969)) (stating that the court must give the plaintiff “the benefit of all inferences that can be derived from the facts alleged”). In evaluating a Rule 12(b)(6) motion to dismiss, the court should generally consider only those facts alleged in the complaint, any documents either attached to or incorporated in the complaint, and matters of which the court may take judicial notice. *EEOC v. St. Francis Xavier Parochial Sch.*, 117 F.3d 621, 624 (D.C. Cir. 1997).

industry, while Power Washers does its best to advance the interests of the power-washing industry.<sup>2</sup>

Though both parties share an interest in clean kitchen exhausts, Kitchen Exhaust apparently first created a certification program and related testing materials on the subject. In September 1995, Kitchen Exhaust entered an agreement with Ackland Andrews & Associates (“ Ackland”) whereby Ackland was to create 400 test questions for Kitchen Exhaust’s certification program.<sup>3</sup> The agreement specifies that Ackland’s work product is a “work for hire.”<sup>4</sup>

It is unclear when Kitchen Exhaust first employed and sold its certification-program materials and the questions Ackland created. Whatever the date, the materials have carried copyright notices since 1995.<sup>5</sup>

On November 23, 1998, Kitchen Exhaust was informed that Power Washers had published on its web site verbatim excerpts from Kitchen Exhaust’s certification-program materials.<sup>6</sup> Kitchen Exhaust alleges that Power Washers contracted with Ackland to create a certification program and Ackland passed on the questions it had

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<sup>2</sup> Compl. ¶¶ 4,5.

<sup>3</sup> *Id.* ¶ 6.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* ¶ 7.

<sup>6</sup> *Id.* ¶ 8.

created for Kitchen Exhaust.<sup>7</sup> That same day, Kitchen Exhaust sent separate letters to Power Washers and Ackland concerning this alleged infringement.<sup>8</sup>

Kitchen Exhaust filed a copyright-registration form on November 25, 1998, with the U.S. Copyright Office.<sup>9</sup>

On December 2, 1998, Power Washers responded to Kitchen Exhaust's letter and agreed to eliminate references to Kitchen Exhaust's materials.<sup>10</sup> Notwithstanding this representation, Kitchen Exhaust claims that Power Washers subsequently administered certification exams by employing materials identical to Kitchen Exhaust's proprietary materials.<sup>11</sup> Kitchen Exhaust filed this suit on March 19, 1999.

### III. ANALYSIS

#### A. Copyright Registration

Power Washers argues that Kitchen Exhaust's failure to obtain certification from the Copyright Office before filing suit precludes this action and strips the court of jurisdiction. Kitchen Exhaust rejoins that it is sufficient to demonstrate receipt of the registration application by the Copyright Office (along with proof of payment and

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<sup>7</sup> *Id.* ¶ 9.

<sup>8</sup> *Id.* ¶¶ 10, 11.

<sup>9</sup> *Id.* ¶ 12.

<sup>10</sup> *Id.* ¶ 13; *see also* Att. E to Compl.

<sup>11</sup> *Id.* ¶¶ 16-17.

deposit of the work) and that, regardless, registration need only be completed prior to the time the court considers the matter.

The Copyright Act states that “no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title.”<sup>12</sup> The Act sets the effective date of copyright registration as “the day on which an application, deposit, and fee . . . have all been received in the Copyright Office.”<sup>13</sup> However, the Act does not explicitly establish whether this “effective date” is indeed effective upon filing or only once the filer has the copyright certification (or denial) in hand.

This is a question of first impression in this circuit.<sup>14</sup> Courts in other circuits have come out differently on this issue. Some have held that the plaintiff must have a registration certificate in hand before filing suit,<sup>15</sup> while others have held that a plaintiff

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<sup>12</sup> 17 U.S.C. § 411(a) (West 1996).

<sup>13</sup> 17 U.S.C. § 410(d) (West 1996).

<sup>14</sup> Other cases from this circuit have stated that registration is a “prerequisite” to suit, but these courts did not have occasion to actually discuss and rule upon the issue squarely before the court here. *See Berman v. DePetrillo*, 1997 WL 148638, \*3 n.3 (D.D.C. 1997); *Shamsedin v. Franklin-Trout*, 1988 WL 135104, \*1 (D.D.C. 1988).

<sup>15</sup> *See, e.g., M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488-89 (11<sup>th</sup> Cir. 1990); *Demetriades v. Kaufmann*, 680 F.Supp. 658, 660 (S.D.N.Y. 1988); *Noble v. Town Sports Int’l Inc.*, 46 U.S.P.Q.2d 1382, 1383-84 (S.D.N.Y. 1998).

may sue once the Copyright Office receives the plaintiff's application, work, and filing fee.<sup>16</sup> The latter view is endorsed by the late Melville Nimmer.<sup>17</sup>

To best effectuate the interests of justice and promote judicial economy, the court endorses the position that a plaintiff may sue once the Copyright Office receives the plaintiff's application, work, and filing fee. Thus, if Kitchen Exhaust indeed filed its copyright application, deposited its work, and paid the appropriate fee before filing suit, the court shall hear its claims on the merits rather than dismiss them and require the refiling of the complaint.

However, Kitchen Exhaust has alleged in its amended complaint that it "filed a copyright registration form" before commencing the instant action.<sup>18</sup> This does not, of course, state whether Kitchen Exhaust deposited its certification-program materials and paid the appropriate filing fee.<sup>19</sup> At least one other court has permitted the plaintiff to amend its complaint to demonstrate proper registration.<sup>20</sup> The court shall do the same here. Assuming that Kitchen Exhaust is able to timely amend its

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<sup>16</sup> See, e.g., *Apple Barrel Productions, Inc. v. Beard*, 730 F.2d 384, 386-87 (5<sup>th</sup> Cir. 1984); *Sebastian Int'l, Inc. v. Consumer Contact Ltd.*, 664 F.Supp. 909, 912 (D.N.J. 1987), *vacated on other grounds*, 847 F.2d 1093 (3<sup>rd</sup> Cir. 1988).

<sup>17</sup> 2 Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* § 7.16[B][1][a] (1999).

<sup>18</sup> See Compl. ¶ 12.

<sup>19</sup> Kitchen Exhaust has attached documents to its opposition memorandum that purport to prove this. As explained *supra*, the court has not considered materials outside the complaint.

<sup>20</sup> See, e.g., *ISC-Bunker Ramo Corp. v. Altech, Inc.*, 765 F.Supp. 1308, 1309 (N.D. Ill. 1990).

complaint, the court denies Power Washers' motion to dismiss for untimely copyright registration.

## **B. Copyright Preemption**

Power Washers argues that Kitchen Exhaust's unfair-competition claim is preempted by the Copyright Act, because Kitchen Exhaust seeks identical relief from its copyright and unfair-competition claims. Kitchen Exhaust does not substantively respond but cryptically claims that Power Washers has not proven preemption.<sup>21</sup>

The Copyright Act preempts a state-law claim if two conditions are met: (1) the subject matter protected by the state-law claim "come[s] within the subject matter of copyright as specified by section 102 and 103" of the Act; (2) the state-law claim governs a "legal or equitable right[] that [is] equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106."<sup>22</sup>

The parties do not dispute that the first condition is met here. Any contrary argument would be in vain, as there is no doubt that Kitchen Exhaust's certification-program materials fall within the ambit of the Copyright Act.

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<sup>21</sup> The court notes that Kitchen Exhaust has not identified the specific unfair-competition law under which it seeks relief. The court assumes that Kitchen Exhaust seeks relief under District of Columbia law. D.C. Code § 28-3904(a) prohibits any person from "represent[ing] that goods or services have a source, sponsorship, approval, certification, accessories, characteristics, ingredients, uses, benefits, or quantities that they do not have." Kitchen Exhaust's claim that Power Washers plagiarized Kitchen Exhaust's certification-program materials without acknowledging Kitchen Exhaust's ownership fits here.

<sup>22</sup> 17 U.S.C. § 301(a) (West 1996).

The second preemption condition is also met. Section 106 of the Copyright Act protects (and preempts) the rights to: (1) reproduce the work; (2) prepare derivative works; (3) distribute copies to the public via sale or other ownership transfer or by rental, lease, or lending; and (4) publicly display the work.<sup>23</sup> Kitchen Exhaust has identified two distinct types of harm in its unfair-competition claim. First, it claims that Power Washers “has been publishing, distributing, selling and otherwise marketing” infringing products.<sup>24</sup> Second, Kitchen Exhaust argues that Power Washers has “passed off its infringing program and materials as being its own without giving credit to [p]laintiff.”<sup>25</sup>

To gauge Kitchen Exhaust’s unfair-competition claim, the court applies the “extra element” test. This circuit has not considered the applicability of this test, but this district has recently applied it.<sup>26</sup> In addition, a number of other circuits employ the test.<sup>27</sup> To survive preemption, Kitchen Exhaust’s unfair-competition claim must qualitatively require at least one element in addition to those needed to make out a

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<sup>23</sup> See 17 U.S.C. § 106 (West 1996).

<sup>24</sup> Compl. ¶ 32.

<sup>25</sup> *Id.*

<sup>26</sup> See *Whitehead v. Paramount Pictures Corp.*, 53 F.Supp.2d 38, 53 (D.D.C. 1999).

<sup>27</sup> See, e.g., *Alcatel USA, Inc. v. DGI Technologies, Inc.*, 166 F.3d 772, 787 (5<sup>th</sup> Cir. 1999); *National Basketball Ass’n v. Motorola, Inc.*, 105 F.3d 841, 850 (2d Cir. 1997); *Data General v. Grumman Systems Support*, 36 F.3d 1147, 1164 (1<sup>st</sup> Cir. 1994); *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 659 (4<sup>th</sup> Cir. 1993). See also 1 Nimmer, *supra*, § 1.01[B][1] at 1-13.

Copyright Act claim. If Kitchen Exhaust's claim cannot meet this scrutiny (i.e., it requires merely the same showing as a Copyright Act claim), it is preempted.

Kitchen Exhaust's first claimed wrong—that Power Washers unlawfully published, distributed, sold, and marketed Kitchen Exhaust's protected materials—is, of course, explicitly within the coverage of section 106 of the Copyright Act and is preempted. Kitchen Exhaust's second claimed wrong—also preempted—merits further discussion.

Kitchen Exhaust's claim that Power Washers is "passing off" Kitchen Exhaust's copyrighted material as Power Washers's own is termed "reverse passing-off."<sup>28</sup> Kitchen Exhaust's claim is distinct from "passing off," as occurs when an infringer sells its own product and claims it is another's (typically the plaintiff's).<sup>29</sup> Nimmer explains these two distinct claims—and their interplay with the Copyright Act— well:

If A claims that B is selling B's products and representing to the public that they are A's, that is passing off. If, by contrast, B is selling B's products and representing to the public that they are B's, that is not passing off. A claim that the latter activity is actionable because B's product replicates A's, even if denominated "passing off," is in fact a disguised copyright infringement claim, and hence pre-empted.<sup>30</sup>

Kitchen Exhaust basically seeks protection for Power Washers's failure to attribute Kitchen Exhaust's ownership of the certification-program materials Power Washers allegedly copied. This district has held before that such a "failure to

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<sup>28</sup> See *Web Printing Controls Co. v. Oxy-Dry Corp.*, 906 F.2d 1202, 1203 n.1 (7<sup>th</sup> Cir. 1990) (citation omitted).

<sup>29</sup> See *id.*

<sup>30</sup> 1 Nimmer, *supra*, § 1.01[B][1][e] at 1-26.1.

attribute” is alone insufficient for a state-law claim to avoid Copyright Act preemption.<sup>31</sup> Taken together with Nimmer’s suggestion above, the court finds that Kitchen Exhaust’s “reverse passing off” claim is also preempted. Hence Kitchen Exhaust’s unfair-competition claim is preempted in its entirety by the Copyright Act.

### **C. Punitive Damages**

Power Washers moves to dismiss Kitchen Exhaust’s third claim, styled “punitive damages.” Power Washers argues that Kitchen Exhaust mispleaded a remedy as a free-standing cause of action and further, under the Copyright Act, punitive damages are unavailable. Kitchen Exhaust rejoins that, if this is not a free-standing cause of action, it should not be dismissed because it is a technical and not substantive error.

Power Washers is correct: this claim is a remedy and not a free-standing cause of action and should be dismissed. The court, however, declines to rule on whether Kitchen Exhaust may recover punitive damages as a remedy at this stage of this litigation. This issue is properly considered at a later time in the proceedings.

## **IV. CONCLUSION**

Assuming that Kitchen Exhaust is able to timely amend its complaint to assert that it deposited its work with the Copyright Office and paid the appropriate fee before filing this suit, the court denies Power Washers’s motion to dismiss Kitchen Exhaust’s copyright-infringement claim. Because Kitchen Exhaust’s unfair-competition

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<sup>31</sup> See *Peckarsky v. American Broadcasting Co., Inc.*, 603 F.Supp. 688, 695-96 (D.D.C. 1984) (citing *Suid v. Newsweek Magazine*, 503 F.Supp. 146, 149 (D.D.C. 1980)).

claim seeks damages for “reverse passing off,” the court finds it preempted by the Copyright Act. Finally, the court shall dismiss Kitchen Exhaust’s punitive damages “claim” as improperly pleaded, but reserves judgment on the availability of punitive damages as a remedy to Kitchen Exhaust’s copyright claim.

Accordingly, it is, this 10<sup>th</sup> day of January 2000, hereby

**ORDERED** that Power Washers’s motion to dismiss Kitchen Exhaust’s unfair-competition claim is **GRANTED**; and it is further

**ORDERED** that Power Washers’s motion to dismiss Kitchen Exhaust’s punitive damages “claim” is **GRANTED**; and it is further

**ORDERED** that Power Washers’s motion to dismiss Kitchen Exhaust’s copyright-infringement claim is **DENIED**; and it is further

**ORDERED** that Kitchen Exhaust is granted until January 25, 2000, to amend its amended complaint.

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Henry H. Kennedy, Jr.  
United States District Judge