

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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S.A.R.L. DIVERTIS PROPERTIES GROUP,

Plaintiff,

-against-

14-CV-6577 (KMW)

**ORDER**

DENMAY, INC. d/b/a BLUE ORANGE GAMES,

Defendant.

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KIMBA M. WOOD, U.S.D.J.:

After further reflection upon yesterday's conference, the Court **DISMISSES** Plaintiff's motion for a preliminary injunction with leave to refile if justified by additional legal briefing and evidentiary submissions. The parties are no longer required to make supplemental filings by March 24, 2015 at 5:00 p.m. Instead, Plaintiff may refile for a preliminary injunction at any time.

**I. Procedural Background**

Plaintiff has sued Defendant for copyright infringement, trademark infringement, trade dress infringement, and unfair competition, based on Defendant's purportedly unauthorized sales of the card game *Spot It!*. (*See* Compl. [ECF No. 1]). Plaintiff seeks several remedies, including a permanent injunction barring Defendant from producing or selling the *Spot It!* game or otherwise exploiting the *Spot It!* trademark and trade dress. (*See id.* at 27). To prevail on the merits of its claims, Plaintiff must prove (1) that it owns the allegedly infringed French copyright for the game *Dobble*, on which *Spot It!* is based, as well as the allegedly infringed United States trademark and trade dress for *Spot It!*; and (2) that Defendant lacks the legal right to exploit those intellectual properties.

Soon after filing suit, Plaintiff moved for a preliminary injunction identical in substance to its requested permanent injunction. (*See* Pl. Pre. Inj. Mem. [ECF No. 4]). Plaintiff's motion relies heavily on the decision of a French trial court in a related foreign litigation between Plaintiff and Defendant's parent company, Blue Orange Éditions. That foreign decision ("*DPG v. BOE I*") concluded that Plaintiff owns, and Defendant's parent company does not own, the *Dobble* copyright and the *Spot It!* trademark. (*See DPG v. BOE I* [ECF No. 20 Ex. 1]). Plaintiff's preliminary injunction motion seeks to enforce that holding in this Court, and thus establish its exclusive ownership of the intellectual properties at issue, through the doctrines of comity and issue preclusion. (*See* Pl. Pre. Inj. Mem. at 11–14).

In response, Defendant argues that *DPG v. BOE I* should not be enforced in this court, and that absent such enforcement, Plaintiff has failed to meet the standard for a preliminary injunction. (*See* Def. Opp. to Pre. Inj. at 9–19 [ECF No. 17]). According to Defendant, the French trial court's copyright analysis in *DPG v. BOE I* does not merit comity because it conflicts irreconcilably with the analysis contained in another French judgment in a separate proceeding related to *Dobble*. (*Id.* at 12–15). That second judgment ("*DPG v. Blanchot*") held that Plaintiff's corporate predecessor and a French citizen named Henri Blanchot had co-authored *Dobble*, suggesting that — at least initially — the two parties were joint owners of the game's copyright. (*See DPG v. Blanchot* [ECF No. 20 Ex. 3]).

After the parties had fully briefed Plaintiff's preliminary injunction motion, the Court requested an update on related proceedings in France. (*See* Jan. 5, 2015 Order [ECF No. 43]). Plaintiff's submission revealed that *DPG v. BOE I* had been affirmed in part and reversed in part by an appellate judgment ("*DPG v. BOE II*"). (*See* Jan. 16, 2015 Bonnier Decl. [ECF No. 44]; *DPG v. BOE II* [ECF No. 44 Ex. A]). Defendant's submission, in turn, claimed that Defendant

had recently purchased Blanchot's rights in *Dobble*. (See Jan. 23, 2015 Denoual Decl. ¶¶ 6–8 [ECF No. 45]). The Court held a conference on March 19, 2015 to discuss the implications of those recent events for Plaintiff's preliminary injunction motion.

## **II. Legal Standard**

To obtain a preliminary injunction, Plaintiff must establish (1) a likelihood of success on the merits or sufficiently serious questions going to the merits, (2) a likelihood of irreparable injury, (3) a balance of hardships that tips in Plaintiff's favor, and (4) the absence of any harm to the public interest. See *Appalseed Prods., Inc. v. MediaNet Digital, Inc.*, No. 11 CIV. 5922, 2012 WL 2700383, at \*7–8 (S.D.N.Y. July 6, 2012) (Gardephe, J.).

## **III. Discussion**

On the present record, and in light of recent developments in France, Plaintiff has failed to meet the standard for a preliminary injunction on any of its claims. As an initial matter, the Court declines to enforce the French appellate decision in *DPG v. BOE II* through the doctrines of comity and issue preclusion. That decision's analysis of the *Dobble* copyright conflicts irreconcilably with the analysis in *DPG v. Blanchot*, and the Court considers comity inappropriate until that conflict is definitively resolved.

Absent enforcement of *DPG v. BOE II*, the record to date is simply too sparse to establish that Plaintiff has a sufficient likelihood of success on the merits, largely because the parties have not fully addressed the potentially significant recent developments in France. Accordingly, the Court dismisses Plaintiff's motion for summary judgment with leave to refile on the basis of new briefing and evidentiary submissions.

### A. Denial of Comity

As discussed at length during the March 19, 2015 conference, *DPG v. BOE II* concluded that *Dobble* is a “collective” work with one author, and that Plaintiff is the sole owner of the *Dobble* copyright. (See *DPG v. BOE II* at 6–8). The judgment in *DPG v. Blanchot*, in contrast, implicitly concluded that *Dobble* is a “collaborative” work with two joint authors, Plaintiff’s corporate predecessor and Blanchot, who under French law would initially have been joint copyright owners. (See *DPG v. Blanchot* at 12). Defendant’s parent company now claims to have purchased Blanchot’s rights to *Dobble*, a claim that has not been fully briefed or examined. (See Jan 23, 2015 Denoual Decl. ¶¶ 6–8). On the present record, therefore, it is possible — under the holding in *DPG v. Blanchot* — that Defendant is a joint owner of the *Dobble* copyright. Because the copyright analyses in *DPG v. BOE II* and *DPG v. Blanchot* are irreconcilable on this potentially critical point, and both foreign litigations remain active and apparently independent, the Court concludes, in its discretion, that it would be premature to afford comity to either holding.<sup>1</sup> Cf. N.Y. C.P.L.R. § 5304 (listing “conflict[] with another final and conclusive judgment” as a ground for non-recognition of a foreign judgment).

As for the *Spot It!* trade dress and trademark, *DPG v. BOE II* makes no mention of the former and expressly declines to rule on the ownership of the latter (overruling *DPG v. BOE I* in the process). (See *DPG v. BOE II* at 13). Because the foreign judgment contains no relevant holding, the doctrine of comity is inapplicable as to the *Spot It!* trade dress and trademark.

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<sup>1</sup> Although irreconcilable, the latest decisions from the two French cases share common ground regarding *Dobble*’s copyright: both suggest that Plaintiff is at least a joint owner. Plaintiff urges the Court, in effect, to grant comity to that common ground and enforce as preclusive the portion of copyright analysis on which both French decisions agree. (See, e.g., Pl. Prel. Inj. Reply at 2–3 [ECF No. 24]). Although that argument holds a certain logical appeal, it finds no support in case law, and the Court considers it ultimately unpersuasive. The Court has discretion to enforce as preclusive holdings from a single decision, but not shared partial holdings from multiple conflicting decisions.

B. Insufficiency of Remaining Record

Absent enforcement of *DPG v. BOE II*, the briefing and evidence submitted so far do not demonstrate that Plaintiff is likely to establish that Defendant lacks the legal right to exploit the *Dobble* copyright or the *Spot It!* trademark and trade dress. Plaintiff has thus failed to satisfy the standard for a preliminary injunction.

Beginning with the *Dobble* copyright, it appears possible — based on *DPG v. Blanchot* and the alleged purchase of Blanchot's rights — that Defendant, through its parent company, is a joint owner. Plaintiff's counsel disputed that notion during the recent conference, arguing that Defendant had not validly acquired Blanchot's rights in *Dobble* under French law. (*See* Mar. 19, 2015 Conf. Tr. at 7:13–25). At this point, however, there is insufficient evidence to back that assertion; the underlying facts remain relatively undeveloped, and Plaintiff has not submitted an affidavit from an expert in French law concerning the legitimacy of Defendant's acquisition of Blanchot's rights in *Dobble*.

It further appears possible that as a joint owner of *Dobble*'s copyright, Defendant has the legal right to exploit the work, including by selling the derivative game *Spot It!*. Again, Plaintiff's counsel disputed that notion during the recent conference, for two reasons. First, counsel argued that Defendant would not be able to exploit rights acquired from Blanchot because they are licensed exclusively to Plaintiff under an agreement between Plaintiff and Blanchot. (*See id.* at 9:12–23). At present, there is insufficient evidence to back that assertion, as the agreement at issue is not part of the record. (*See id.* at 41:5–9).

Second, Plaintiff's counsel argued that Defendant would not be able to exploit rights to *Dobble* acquired from Blanchot because under French law, a joint copyright owner may not exploit the work without permission from the other joint owners, which Defendant has not

received. (*See id.* at 11:9–22). At this point, that statement of French law is unsubstantiated by any supporting affidavit. Moreover, its relevance to this litigation remains unsettled. Under United States copyright law — which dictates whether Defendant’s use of the *Dobble* copyright constitutes infringement in this action, *see Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 90–91 (2d Cir. 1998) — a joint owner may generally exploit a copyright without permission from the other joint owners. *See, e.g., Oddo v. Ries*, 743 F.2d 630, 632–33 (9th Cir. 1984) (“A co-owner of a copyright cannot be liable to another co-owner for infringement of the copyright.”); *Corbello v. DeVito*, 832 F. Supp. 2d 1231, 1243 (D. Nev. 2011) (same). It is not presently clear, and the parties have not briefed, whether that means that Defendant, as the joint owner of *Dobble*’s copyright under French law, would be incapable of copyright infringement in this case.

Turning to the *Spot It!* trademark and trade dress, Plaintiff has offered no evidence that it owns those intellectual properties other than the licensing agreement by which Plaintiff’s corporate predecessor permitted Defendant’s parent company to develop *Spot It!* based on the copyrighted elements of *Dobble* (the “Licensing Agreement”). (*See* [ECF No. 20 Ex. 5]). As the French appellate court recently concluded in *DPG v. BOE II*, however, the Licensing Agreement provides for Plaintiff and Defendant’s parent company to jointly own the *Spot It!* trademark, with no indication that such joint ownership would terminate along with the Licensing Agreement. (*See DPG v. BOE II* at 12). As for the *Spot It!* trade dress, the Licensing Agreement contains no express provision; arguably, however, it could be read to provide for the same type of continuing joint ownership. (*See* Mar. 19, 2015 Conf. Tr. at 23:6–20). The current record, therefore, suggests that Defendant may jointly own the *Spot It!* trademark and trade dress, and

thus may possess the legal right to exploit both intellectual properties. Plaintiff has so far failed to demonstrate an adequate likelihood of proving otherwise.

**IV. Conclusion**

Many of the current gaps in the record are simply the product of timing — the parties have not yet had the opportunity to fully address the novel factual and legal issues raised by recent developments in France. Rather than permit the parties to continue supplementing their original, outdated briefing to address those recent developments, the Court dismisses Plaintiff's preliminary injunction motion and invites a new filing tailored to the dispute as it currently stands. In preparing a new preliminary injunction motion, Plaintiff should consider how best to answer the questions raised in this Order.

SO ORDERED.

Dated: New York, New York  
March 20, 2015

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/s/  
Kimba M. Wood  
United States District Judge