

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF OKLAHOMA**

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|---|---|------------------------------|
| MICHAEL FOUNDATION, INC., |) | |
| a Not For Profit corporation, |) | |
| |) | |
| Plaintiff and Defendant-in-Counterclaim, |) | |
| |) | |
| v. |) | Case No. CIV-00-885-W |
| |) | |
| URANTIA FOUNDATION, |) | |
| an Illinois Charitable Trust, |) | |
| |) | |
| Defendant and Counterclaimant. |) | |
| |) | |
| - AND - |) | |
| |) | |
| URANTIA FOUNDATION, |) | |
| |) | |
| Counterclaimant and Third |) | |
| Party Plaintiff |) | |
| |) | |
| |) | |
| HARRY McMULLAN III, |) | |
| a citizen of Oklahoma, |) | |
| |) | |
| Third Party Defendant, |) | |
| |) | |
| and MICHAEL FOUNDATION, INC., |) | |
| a Not For Profit corporation |) | |
| |) | |
| Defendant-in-Counterclaim. |) | |

**JOINT BRIEF OF MICHAEL FOUNDATION, INC.
AND HARRY MCMULLAN, III IN OPPOSITION TO MOTION
FOR PARTIAL SUMMARY JUDGMENT OF URANTIA FOUNDATION**

A. INTRODUCTION

Michael Foundation, Inc. (“Michael”) filed this lawsuit against Urantia Foundation (“UF”) seeking a declaratory judgment that Michael’s work, *Jesus – A New Revelation* (“JANR”) does not infringe a work entitled *The Urantia Book* (the “Work”) to which UF asserts a copyright. UF originally registered its claimed copyright to the Work in 1955, purporting to be the actual author of the Work. In 1983, UF attempted to renew the copyright, claiming that the Work was a work for hire. Once again, UF now seeks to revise the basis of its copyright claim by asserting that the Work is a composite work of which it is the proprietor. This action focuses on UF’s flawed renewal of its copyright in 1983.

UF’s attempt to renew its copyright failed because UF never had a valid renewal interest in the Work under any colorable legal theory. Subject only to limited statutory exceptions, renewal rights initially vest in a work’s author and neither UF nor its alleged predecessors in interest¹ were the authors of the Work. Moreover, the individual who was in fact the legal author of the Work did not transfer his renewal interest to UF. Finally, the legal author’s statutory successors, who would have been the parties entitled to renew the copyright upon the author’s death, did not renew the Work themselves, much less assign their interest to UF.

Because these arguments lead to the inevitable conclusion that the Work is in the public domain, UF now makes one final disingenuous effort to abandon its prior two theories of authorship in pursuit of the only remaining statutory exception: proprietorship of a composite work. UF’s improper attempt to both reclassify the Work as a composite work and recast itself as the proprietor thereof must fail. The Work itself is self-evidently a unified literary piece and cannot be reclassified as a composite work to satisfy UF’s

¹ UF claims to have received a transfer of the copyright to the Work from a group referred to as the “contact commission”. The efficacy of such transfer is contested and Michael does not concede that the so-called contact commission had the right to transfer, or transferred, any copyright in the Work to UF.

changing interests. Moreover, UF cannot prove that its alleged predecessors in interest contributed any protectable material or organization to the work as *compilers* (i.e., preparers of a composite work). The evidence simply does not support the conclusion that UF's alleged predecessors, the so-called contact commission, contributed any material whatsoever to the text² of the Work. For that reason, the statutory exception for proprietorship of a composite work does not apply.

Finally, even if UF did hold some limited copyright to material or organization contributed by the contact commission as *compilers*, JANR does not reproduce such matter. JANR is nothing more than a reprint of the underlying, unprotected matter that is independent of any purported additions by the contact commission.

UF also pleads a counterclaim against Michael and a third-party complaint against Harry McMullan, III (“McMullan”), asserting various causes of action sounding in trademark involving the words “Urantia” and “Urantian.” Michael submits that those words are generic when they refer to the name of this planet (referred to thousands of times in the Work as “Urantia”), and an inhabitant of this planet (referred to repeatedly in the Work as a “Urantian”) or as one who follows the teachings in *The Urantia Book*. Furthermore, such words constitute the name of a religion (“Urantia”) and the followers of that religion (“Urantians”).

B. STATEMENT REGARDING UNDISPUTED FACTS

Michael’s Facts.³ Michael submits that the following facts are undisputed and warrant the entry of summary judgment in favor of Michael.

² One member of the contact commission, William S. Sadler, Jr., prepared a table of contents and list of titles of the papers contained in the Work. These efforts obviously added no original material to the text of the Work. In any event, such materials are not at issue in this case, which implicates only the Foreword and Papers 1-196 of the Work.

³ Except where the context requires otherwise, the term “Michael” refers to both Michael and McMullan

1. Dr. William S. Sadler was a psychiatrist in Chicago in the early 1900's. Exh A, UF's Responses to Requests for Admission ("UF Admis."), Request No. 57.

2. Beginning in approximately 1911, an unnamed individual (the "patient") approached Dr. Sadler for medical treatment. UF Admis., Nos. 58, 59, and 60; Exh B, Richard Keeler Depo. ("Keeler"), at 29-30, 86 and 89; Exh C, William S. Sadler, M.D., *The Mind At Mischief*,⁴ at 383-85.

3. During the course of Dr. Sadler's relationship with the patient, Dr. Sadler received handwritten manuscripts (the "papers") from the patient. Those papers were all in the handwriting of the patient. Keeler at 32-33, 71-72, 86, 89; UF Admis., Nos. 1, 2, 11, 12, 13, 33, 58, 59, 194, 195, 196, 197; Exh D, Carolyn Kendall Depo ("C. Kendall") at 26-27, 33-34; Exh E, Carolyn Kendall Depo. In *UF v. Maaherra* ("C. Kendall II") at 19-20, 52-53 and Exh 13; Exh F, Affidavit of Edith Cook; Exh G, UF's Motion for Summary Judgment in *UF v. Burton* at 2.

4. No one was present when the patient wrote out the papers in his own handwriting. Keeler at 33, 64; Exh H, Answers of Urantia Foundation to Interrogatories Submitted in *UF v. Burton* ("UF Answers – Burton"), Nos. 41 and 43.

5. Dr. Sadler's patient was not a "mere conduit" for alleged non-human authors. Exh I, History of the Urantia Movement ("History")⁵ at 1, 14-15; Exh J, Richard Keeler Depo. in *UF v. Maaherra* ("Keeler II") at 56-57; C. Kendall at 17; Exh K, Second Supplemental Answer to Third Interrogatories in *UF v. Maaherra* ("UF Answers –

⁴ Because *The Mind At Mischief* was written by Dr. Sadler, whom UF identifies as leader of the contact commission, and because UF claims its rights through the contact commission, Dr. Sadler's statements in that book constitute admissions admissible pursuant to F.R.E. Rule 801(d)(2).

⁵ A copy of the "History" was attached as an exhibit to UF's Answer, Counterclaims and Third-Party Complaint Against Harry McMullan, III filed in this case.

Maaherra), No. 13; Exh L, Letters from William F. Sadler, M.D., E.L. Christensen, and James C. Mills.⁶

6. The patient was never paid for his role in producing the papers; he was not an employee of the contact commission, nor did the contact commission supervise his work. UF Admis., Nos. 50, 51 & 168-70; C. Kendall at 36.

7. The patient never signed anything assigning his interest in the papers to the contact commission. UF Admis., Nos. 68, 132; Keeler at 120; Keeler II at 55-58.

8. The contact commission caused the papers to be typed. In the course of so doing, no one (i) *added* any words to the patient's handwritten manuscript (ii) *deleted* any words from the patient's handwritten manuscript, or (iii) *changed* any words in the patient's handwritten manuscript (other than typographical corrections related to spelling, capitalization and punctuation). Members of the contact commission did not consider themselves joint authors of the Work. UF Admis., Nos. 14, 15, 16, 17, & 18; Exh M, letters from E.L. Christensen and Thomas A. Kendall;⁷ UF Answers – Burton, No. 31; Keeler at 105.

9. Once the typed copies of the papers were produced, the handwritten originals of the papers were destroyed. UF Admis., Nos. 3, 4 and 13.

10. Part IV of the Work tells the story of the life of Jesus. Like all the other papers, those comprising Part IV were all written in the patient's handwriting. Unlike those other papers, the contact commission obtained the papers that comprised Part IV from the patient all at once. History at 19-20; C. Kendall at 30-31, 40; Keeler at 75, 90-92; C. Kendall II at 40.

⁶ All of the letters were produced from UF business records. Moreover, all were written either by Dr. Sadler himself or by trustees of UF in their capacity as trustees (see Exh JJ, deposition exhibit 3A for a listing of past and present trustees of UF). Accordingly, they are admissible pursuant to F.R.E. Rule 801(d)(1).

⁷ All such letters were produced from UF's business records and were written by trustees of UF. As such, they are admissible. See footnote 6, *supra*.

11. The papers were subsequently published as the Work. The words contained in the Work are the precise words that were contained in the papers as they were written out in the patient's handwriting. The order in which the papers are numbered in the Work is the same order in which the papers were produced by the patient. UF Admis., Nos. 21 and 22; Keeler at 68-69, 105, & 116; Exh N.

12. UF contends that it gathered, organized and posed questions which affected the eventual text by whoever wrote it. According to UF, many of the questions were formulated by a group called the "forum"; however, UF can identify few, if any, of the questions that were posed or who formulated those questions. In fact, UF is aware of the mere identities of fewer than 10% of forum members. Keeler at 67-68, 76 & 79; UF Admis., Nos. 123, 143, 144, 151 & 160; Exh O, Hoyt C. Caston Depo in *UF v. Maaherra* ("Caston"), at 67.

13. Even if the forum's questions exerted some impact on the creation of the Work's text, neither the members of the contact commission nor the members of the forum had any contro5 UF's ht.9()hav(the)beeo in

16. In 1980, UF attorney Lloyd C. Root signed an affidavit stating, “The Urantia Book is not a collective work, since the material contained therein was not in existence before the arrangement of it was placed in tangible form, and it was in existence prior to publication thereof only in manuscript form.” Exh U.⁸

17. The patient died some time prior to 1977. None of the contact commissioners, to the extent they knew patient’s identity, ever disclosed it. UF Answers – Burton, No. 18; UF Admis., Nos. 29, 41, & 74.

18. Every member of the contact commission died prior to the attempted renewal of the copyright to the Work in 1983. UF Admis., Nos. 91, 92.

19. No statutory successors of the patient, nor any individuals who comprised the contact commission, nor anyone other than UF, filed for renewal of copyright to the Work. UF Admis., Nos. 69, 93, 130 & 133.

20. The Work is a religious work. Many individuals found their religion directly on the Work. UF was established to carry out a religious purpose. Exhibit V, Scott Forsythe Depo in *UF v. Maaherra* at 127, 155-56; Keeler at 113; Hales at 16, 25-27 & 31; Keeler II at 63; Exh W, UF’s Declaration of Trust; Exh X, affidavit of Mo Siegel, currently a trustee of UF; Exh Y, affidavits of believers affirming their Urantia religion; Exh Z; McMullan Aff. ¶¶ 52-60.

21. “Urantia” is the name of our planet. It is not a word coined by UF. UF has repeatedly used the word for purposes other than as an identifier of UF or its goods and services. UF Admis., No. 211; Hales at 23-24; Keeler at 58-59, 94, 127-28, 134-35; Caston at 44; Exh AA; Exh BB; Exh CC.

⁸ Mr. Root’s affidavit was authenticated in UF Admis. -- Maaherra, Nos. 43 and 44. Michael has prepared and attaches a transcript of the Root affidavit together with UF’s Responses to Requests for Admissions in *UF v. Maaherra*, Nos. 43 and 44, admitting the authenticity of the document.

22. “Urantian” refers to inhabitants of planet earth. It is not a word coined by UF. UF has repeatedly used the word for purposes other than as an identifier of UF or its goods and services. Keeler at 128-29, 135; UF Admis., Nos. 216-18 & 220; Caston at 136-37; Exh DD. “Urantian” also commonly refers to individuals who follow the teachings of the Work. Hales at 33-34; Caston at 136; Keeler at 129; UF Admis., Nos. 221-222.

23. UF has long recognized the generic and descriptive use of the word “Urantia” to refer to the planet earth and “Urantians” as inhabitants of planet earth. In a widely published formal policy statement sent out in 1998, UF reaffirmed the aforesaid generic and descriptive use of the words “Urantia” and “Urantian”, and moreover, with respect to “Urantian”, admitted that it was a generic and descriptive use of the word, not only to refer to inhabitants of planet earth, but also to refer to readers of the Work. Exh EE; Exh FF; Exh GG; Exh HH; Exh II.

24. McMullan contributed to Kristen Maaherra’s legal fees in a prior case. He contributed \$5200 toward Maaherra’s legal defense expenses while the case was at the trial court level. After the case was on appeal, McMullan contributed additional sums toward Maaherra’s fees. McMullan Aff. ¶¶ 32-34.

Urantia Foundation’s Facts. Michael disputes many of the “undisputed” facts contained in UF’s brief. The following recitation summarizes those disputes.

Most fundamentally, many of UF’s “facts” attempt to establish that the parties agree that the Work was authored by spiritual beings, that the spiritual beings mysteriously transmitted the text of the Work through the instrumentality of the patient in response to questions, and that the contact commission controlled all communications with the spiritual beings. Not a single piece of UF’s *evidence*, however, begins to prove that spiritual beings authored the Work or that the contact commission communicated with spiritual beings. Such statements by UF constitute statements of *faith*, without any *evidentiary* value. See UF’s Statement of Facts (“UF Facts”) ¶¶ 4, 5, 11, 12, 13, 50, 56.

Likewise, not one piece of UF's evidence proves the manner in which the contact commission purportedly communicated with spiritual beings. UF has not, and cannot, demonstrate that questions were communicated to spiritual beings. Such pulpit assertions play no role in a court of law. See UF Facts ¶¶ 4, 5, 11, 12, 13, 50, 56.

Whether or not the contact commission "solicited, gathered, arranged, and submitted" questions to whoever wrote the Work, UF's description of the "question process" does not address how the author chose whether, or how, to *answer* the questions submitted. There is a complete absence of evidence to show how any "questions" impacted the concrete expression of the Work. See Michael Facts ¶¶ 3-5. None of the so-called contact commissioners are alive today, so any statement by them is hearsay even if offered by UF. *Id.* ¶ 18. Similarly, none of the declarations or depositions offered by UF in an attempt to prove what the contact commission did with the questions they allegedly gathered from members of the forum is admissible, inasmuch as the declarants and deponents do not purport to have personally witnessed the events they describe, and therefore lack personal knowledge. See UF Facts ¶¶ 4, 5, 11, 12, 13.

UF claims to be the legal successor in interest to the contact commission. UF Facts ¶ 23. Yet UF's first president, Wm. Hales, testified that UF had no predecessor organization. Hales at 29-30. UF further claims that no forum members objected to UF's assumption of rights to the Work. See UF Facts ¶ 24. The statement is facially ludicrous in view of UF's simultaneous admission that it knows the identity of fewer than 10% of

Given Mr. Kendall's intimate familiarity with the Urantia movement, it is inconceivable that he would not have been aware that UF did not coin the terms "Urantia" and "Urantian." See UF Facts ¶ 47. Indeed, Mr. Kendall himself has admitted that UF had a hard time getting the trademarks. T. Kendall at 35.

McMullan testified only that he had not personally reviewed the trademark prosecution file histories. See UF Facts ¶ 45. Such testimony hardly establishes that no one else, such as Michael's attorneys, reviewed the trademark prosecution file histories on Michael's behalf.

McMullan never personally sought permission to publish *21 Steps*. See UF Facts ¶ 52. Rather, Asoka Foundation, of which McMullan was not the alter-ego but simply an officer, sought UF's permission to publish *21 Steps* in 1987. McMullan Aff. ¶ 38.

to the party entitled to judgment as a matter of law, even if that party did not move for summary judgment. *Goldstein v. Fidelity & Guaranty Insurance Underwriters, Inc.*, 86 F.3d 749 (7th Cir. 1996).

D. ARGUMENT

The issue at bar concerns the copyright status of the Work, which was created during the pendency of the 1909 Copyright Act and purportedly renewed during the pendency of the 1976 Act. Accordingly, the first task is to define the category of protection into which the Work fits, under the governing schemes. Part I addresses this task, demonstrating that the Work is the unified literary work of a single author. Part II addresses the current copyright status of the Work, demonstrating that the Work has not been properly renewed. Part III discusses why estoppel bars UF's historically contradictory arguments, while no such bar applies to Michael. Part IV demonstrates why, even if the Work had been properly renewed, Michael's publication of JANR still does not infringe on UF's copyright. Finally, Part V disposes of the trademark issues.

I. The Work Is a Unified Literary Work Authored by the Patient

The discussion below reviews the evidence at bar regarding the Work. That evidence yields only one conclusion: The Work is copyrightable as a literary work produced by a single human author.

a. Cognizable Facts On This Motion

The Work consists of 196 chapters (each labeled a "Paper") detailing a vision of life in this universe. The Work is internally cohesive. McMullan Aff. ¶¶ 2-21.

Adverting to its internal content, the Work purports to be the product of spiritual beings. However, for purposes of the instant motion, it is essential to rely solely on cognizable evidence, rather than on propositions of faith. Insofar as the realm under the jurisdiction of this court is concerned, one human being (the "patient") authored the

Work. The entire manuscript for the book was written solely in the patient’s handwriting. Michael Facts ¶¶ 3, 4, 5, 8.

No portion of the Work was published before 1955. In that year, UF published the Work in its entirety. UF Facts ¶ 28.

The process by which the patient composed the Work is as follows: Dr. William Sadler and several relatives – collectively known as the contact commission – collected installments of the Work from the patient in his own handwriting. According to UF, they, in turn, posed questions to the patient about what he had written. What the questions were, who asked the questions, and any correspondence between those questions and elements of the Work is purely speculative. Michael Facts ¶¶ 4, 12, 13.

b. The Work Qualifies as a Literary Work

The Copyright Act affords protection to “literary works,” 17 U.S.C. § 102(a)(1), which are defined as works “expressed in words, numerals, or other verbal or numerical symbols,” 17 U.S.C. § 101. By the same token, former law conferred protection on “books.” 17 U.S.C. § 5(a) (1909 Act, repealed). At its publication in 1955, the Work qualified as a “book” authored by the patient. As such, it fell within the subject matter of statutory copyright and thereby obtained federal protection. Its initial term lasted for 28 years, which could be renewed if the appropriate party made a timely application. 17 U.S.C. § 24 (1909 Act, repealed). See Part II below.

Neither the fact that the patient may have composed the Work in installments, nor the fact that the contact commission may have formulated questions to him in the midst of those submissions, can detract from the Work’s status as a unified literary work. The history of literature is replete with compositions that were created in installments and shaped by the suggestions, questions, and insights of editors and friends, which nonetheless qualify as some of the most celebrated examples of unified literary works in the Western canon. See Jack Stillinger, *Multiple Authorship and the Myth of Solitary Genius* (1991) (recounting input of others to, *inter alia*, poems of Keats and Wordsworth,

essays of John Stuart Mill, novels of Thomas Wolfe and F. Scott Fitzgerald). The courts have rebuffed all efforts by those other contributors to detract from the unitary quality of the books, poems, plays, and other works at issue. The next section discusses that case law.

c. The Work Is Not a Joint Work

The allegation that the contact commission formulated questions for the patient is insufficient to transform the Work into a joint work. Under uniform case law, joint authorship is lacking under these facts and the Work constitutes a solitary literary work authored by the patient.

In a celebrated Second Circuit case, Alice Childress claimed to be the sole author of “a play about the legendary Black comedienne Jackie ‘Moms’ Mabley.” *Childress v. Taylor*, 945 F.2d 500, 501 (2d Cir. 1991). Clarice Taylor contested that status, claiming to be a joint author with Childress based on the uncontested facts that:

(1) she learned through interviews that “Moms” Mabley called all of her piano player “Luther,” so Taylor suggested that the play include such a character; (2) Taylor and Childress together interviewed Carey Jordan, “Moms” Mabley’s housekeeper, and upon leaving the interview they came to the conclusion that she would be a good character for the play, but Taylor could not recall whether she or Childress suggested it; (3) Taylor informed Childress that “Moms” Mabley made a weekly trip to Harlem to do ethnic food shopping; (4) Taylor suggested a street scene in Harlem with speakers because she recalled having seen or listened to such a scene many times; (5) the idea of using a minstrel scene came out of Taylor’s research; (6) the idea of a card game scene also came out of Taylor’s research, although Taylor could not recall who specifically suggested the scene; (7) some of the jokes used in the play came from Taylor’s research; and (8) the characteristics of “Moms” Mabley’s personality portrayed in the play emerged from Taylor’s research.

Id. at 502. The court rejected those criteria as warranting a conclusion that Taylor shared authorship status in the play. Instead, it issued two rulings that bear on the case at bar:

- To be a joint author, one must contribute independently copyrightable expression to the product, rather than acting in such a way that helps to shape the product. *Id.* at 506-07. *Accord, Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1069-71 (7th Cir. 1994) (“To qualify as an author, one must supply more than mere direction or ideas.”); *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1087 (9th Cir. 1989) (same).
- Even those who contribute independently copyrightable material to the product still do not qualify as joint authors when they do so in subordinate roles, such as Clarice Taylor who made “incidental suggestions, contributing ideas about the presentation of the play’s subject and possibly some minor bits of expression,” 945 F.2d at 509, or “an editor who makes numerous useful revisions to the first draft,” *Id.* at 507. Instead, the test is “whether the putative joint authors *regarded themselves* as joint authors.” *Id.* at 508 (emphasis added); *accord Thomson v. Larson*, 147 F.3d 195, 201-205 (2d Cir. 1998) (upholding the mutual intent requirement and holding that dramaturg who added significant contributions to the play *Rent* still failed to qualify as its co-author).

Gauged by the foregoing standards, the Work doubly fails to qualify as a joint

themselves as joint authors. Michael Facts ¶¶ 8. For both these reasons, the Work is not a joint work.

d. The Work Is Not a Collective Work Or Other Type of Compilation

1. Collective Work

Not only do the contact commissioners fail to qualify as joint authors of the Work, but their involvement also fails to qualify as an assembly of separate ingredients such that the final product is transformed into a collective work. The statute defines a collective work as “a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.” 17 U.S.C. § 101.

Everything about that definition is inapplicable to the work at bar. The Work constitutes a unified whole. It bears no resemblance to a periodical issue, anthology, or encyclopedia. Moreover, its various chapters are not “separate and independent works in themselves.” McMullan Aff. ¶¶ 3-21. Of course, there is some sense in which every book composed of chapters, every poem of stanzas, every symphony of movements, is a “collective work.” But that expansive characterization has never won judicial support – notwithstanding that there exist radio stations that play only one movement from a symphony, student anthologies that only reproduce one chapter out of a book, *etc.*

If the patient had published a Foreword and 196 separate papers in magazines and newspapers around the country which the contact commission subsequently chose to organize into an order of its own choosing, the result might possibly qualify as a collective work – even though all would still emanate from a single human author, whereas the statutory examples (“periodical issue, anthology, or encyclopedia”) uniformly contemplate contributions by multiple authors. Yet the uncontroverted evidence at bar shows that those indicia are wholly lacking in the authorship of the Work:

- The Work constitutes a whole. It was never presented to the world as an anthology. Michael Facts ¶¶ 15, 16.

- Its parts were never offered separately to the public before being assembled into the Work. Michael Facts ¶¶ 15, 16.
- The contact commission did not arrange them into an order of its own choosing; rather, the order in which the patient composed them represents the order in which they appear in the Work. Michael Facts ¶¶ 8, 11.
- Each of the 196 Papers that comprise the Work was assigned a number at the time it was written and the numbers are sequential. Michael Facts ¶¶ 8, 11.
- Many terms are explained in earlier chapters of the Work and used consistently throughout, so that later chapters could not be fully understood without reference to earlier chapters. McMullan Aff. ¶¶ 3-21.

On many occasions, UF has resisted the separate publication of any part of the Work, averring that it is a unified work and its parts must be read together in order for its message to be understood. Michael Facts ¶ 15; McMullan Aff. ¶ 21. A recent case in point was the address of UF trustee Gard Jameson, opposing the publication of JANR (the very matter at bar):

There are those who, in a spirit of impatience, would violate the integrity of the text by splitting it up. We have been given a carefully painted picture of the cosmos, its origin, history and destiny in relation to the life and teachings of Jesus, our Creator Son, as he is carefully portrayed in Parts I, II, III and IV of the Book. This picture was developed over a period of hundreds of years by the revelatory commission. There are those who would cut the revelatory commission's picture up in the name of dissemination. Imagine with me for a moment taking a picture, the Mona Lisa, and cutting it up into four pieces, and displaying a quarter of that beautiful picture in its own frame. I do not think that is what Leonardo Da Vince had in mind, nor do I believe that is what the revelatory commission had in mind. My son, Michael, greatly enjoys picture puzzles. Imagine if I were to give him a box with only one quarter of the pieces. It doesn't seem appropriate, does it? The revelatory commission put a massive puzzle together in an exceedingly artistic and careful way. That picture should be respected by all of us as we go about disseminating the truths of the Book.

Exh R. For all these reasons, the Work is not a collective work.

2. **Compilation**

Collective works form one species of a general category that the statute labels “compilations.” The Work cannot be characterized as a compilation. A compilation is defined as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101. A classic example of a compilation is a directory – its individual listings are not themselves copyrightable (as opposed to the components that comprise a collective work, each of which is copyrightable standing alone), but the *manner* in which they are assembled can itself evince sufficient creativity to warrant copyright protection. *See Southern Bell Tel. & Tel. v. Associated Tel. Directory Publishers*, 756 F.2d 801, 809 (11th Cir. 1985).

Just as a catalog assembles uncopyrightable listings, so a work that concatenated uncopyrightable revelations might qualify as a compilation. However, the linchpin of such a characterization is that each revelation (whatever that is taken to mean), standing by itself, would have to be tantamount to a fact, standing outside copyright protection. It is emphatically not the case that each Paper in the Work is uncopyrightable standing by itself. Instead, each chapter, laboriously composed in the handwriting of the patient, contains innumerable turns of phrase, descriptions, and characterizations to qualify it amply as copyrightable expression – the same way that each chapter of *Moby Dick* (or every other unified literary work of any length), considered in isolation, would itself qualify as copyrightable expression. Accordingly, the definition of compilation simply does not apply here.

e. **The Work Is Not a Work for Hire**

When UF attempted to renew the Work in 1983, it represented that the Work was a work for hire. In its present motion, it asserts that the Work is a composite work.

Nevertheless, in a footnote, UF argues that a fact-finder could find that UF is the proprietor of a work for hire. UF Brief at 14 n.5. The contention is meritless.⁹

An employment (or commissioning) relationship at the time the work is created is a condition for claiming renewal as the proprietor of a ‘work made for hire’. *Urantia Foundation v. Maaherra*, 114 F.3d 955, 961 (9th Cir. 1997). UF has failed to adduce any evidence supporting the existence of the requisite employment relationship. Manifestly, UF was never the patient’s employer and his work was never commissioned, supervised, or controlled. Michael Facts ¶¶ 6, 8, 11. Thus, the Work was not created at the insistence or expense of UF. *See Playboy Enters., Inc. v. Dumas*, 53 F.3d 549, 554-56 (2d Cir. 1995), *cert. denied*, 116 S. Ct. 567 (1995) (test for being a work for hire under the 1909 Act was whether the employer both constituted the motivating factor for the works creation and paid the creator a sum certain rather than royalties). As such, the Work does not qualify as a work for hire.

II. Because Copyright in the Work Was Never Properly Renewed, It Now Reposes in the Public Domain

UF asserts copyright in the Work at present on the basis of a renewal registration filed in its own name in 1983. UF Facts 51. Because subscribed by a party who had no right to file it, that renewal was fatally flawed. Accordingly, any copyright to the Work lapsed at the close of its 28-year original term in 1983. The Work now lies in the public domain.

a. UF Had No Authority To Renew the Literary Work At Issue Here

UF first published the Work in 1955, registered the work in its own name in 1956, and later filed a renewal registration for the work in 1983. This 1983 registration failed to comport with the applicable statutory renewal requirements.

⁹ UF has obliquely admitted this proposition, notwithstanding its contrary claim in the footnote cited above. In particular, it states that the Work “is probably not a work-for-hire”. UF’s Responses to Requests for Admission, Nos. 168-73.

As detailed above, the Work is a literary work authored by the patient. When time came for renewal of the work in 1983, the statute accorded the right to take out that renewal to:

- (i) the author of such work, if the author is still living,
- (ii) the widow, widower, or children of the author, if the author is not living,
- (iii) the author's executors, if such author, widow, widower, or children are not living, or
- (iv) the author's next of kin, in the absence of a will of the author.

17 U.S.C. § 301(a)(1)(C). That scheme is automatic and not subject to alteration, even by unanimous agreement of all concerned. *See Saroyan v. William Saroyan Found.* 675 F. Supp. 843, 845-47 (S.D.N.Y. 1987) (characterizing the renewal provision as “nondiscretionary”), *aff’d mem.*, 862 F.2d 304 (2d Cir. 1988).

By 1983, the patient was no longer alive. Michael Facts ¶ 17. Accordingly, even if the patient had explicitly assigned his renewal copyright along with the initial term to UF (a proposition for which the record is devoid of evidence), that grant would be a nullity and the right to renew the copyright would instead belong to his widow and children still alive in 1983. *See Bartok v. Boosey & Hawkes*, 523 F.2d 941, 947 (2d Cir. 1975) (“An initial assignment of a copyright renewal term by the author can vest [] only if the author remains alive at the time of renewal.”). If none of them were alive, then the renewal would belong, as a matter of law, to his executor or next of kin, according to the mandatory statutory scheme quoted above. *See Nimmer on Copyright* § 9.06[C] (“If the author [] is not living when the renewal rights vest, then those persons who by statute succeed to the renewal rights are not bound by any assignment [] executed by the author [], meaning that the assignee takes nothing.”).

The question thus becomes whether, in 1983, the patient’s statutory successors (his widow, children, executor, or next of kin, as the case may be) validly took out renewal for the Work. Records of the Copyright Office indicate that none took such a

step in his/her own name – the only renewal certificate that was filed was done so in the name of UF. Michael Facts ¶ 19. Accordingly, the question devolves into the inquiry whether, as of 1983, UF was acting on the basis of a grant from the patient’s statutory successors when it undertook renewal registration for the Work.

Discovery in this case reveals that no such grant existed. Michael Facts ¶¶ 7, 19. The only purported authority granted to UF emanated from the contact commission – a group which, pointedly, did not include the patient or any of his statutory successors. UF Facts ¶ 6. Accordingly, the record is undisputed that no party entitled to effectuate renewal of the Work in 1983 actually did so. (As will be explained in Part d below, the renewal was ineffective.)

Moreover, even if one posited, contrary to fact, that the Work constituted a joint work authored together by the patient and the contact commission, the same result inures. Each member of the contact commission was dead by the time renewal vested in 1983. Michael Facts ¶ 18. Accordingly, the parties who would be entitled to renew the book, even assuming it were a joint work, would be the surviving statutory heirs of each commissioner as of 1983 (Dr. Sadler’s surviving children as of 1983, Emma Christensen’s living children as of 1983, Wilfred Kellogg’s executor, etc.) According to the undisputed evidence, none of those individuals ever conveyed their renewal rights in the Work to UF. Michael Facts ¶¶ 7, 19. Therefore, the renewal failed to take effect, even under this additional supposition.

b. The Exception for Composite Works is Inapplicable

There are a few exceptions to the general rule noted above that renewal must be effectuated by the living statutory successors of the human author. Insofar as relevant here, UF argues that it falls within the exception applicable to “any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof.” 17 U.S.C. § 304(a)(1)(B)(i).

That provision would apply only if the Work qualified as a “periodical, cyclopedic, or other composite work.” No one contends that it is a periodical, and even the most cursory inspection reveals that the Work bears not the slightest resemblance to an encyclopedia; but UF argues that the Work is a “composite work.”

The statute leaves that term undefined. Nonetheless, the reference to “*other composite work*” invokes the category of *ejusdem generis* – a “composite work” must be interpreted to mean something like a periodical or encyclopedia. See *Norfolk & Western R. Co. v. Train Dispatchers*, 499 U.S. 117, 129 (1991) (“*ejusdem generis*” means that general terms should be understood in context of specific ones). Given how far afield the Work lies from being a periodical or encyclopedia, it is impossible to imagine that it qualifies as the type of “*other composite work*” that Congress intended to embrace within this category.

Case law vindicates this approach. In *Cadence Indus. Corp. v. Ringer*, 450 F. Supp. 59, 63 (S.D.N.Y. 1978), the court approved the definition of “composite works” propounded by the United States Copyright Office: “Generally, a composite work is an original publication relating to a variety of subjects, to which a number of different authors have contributed distinguishable selections.” Judge Learned Hand has offered a similar interpretation: “[C]omposite works,’ by which we understand those to which a number of authors have contributed distinguishable parts, which they have not however ‘separately registered.’” *Shapiro, Bernstein & Co., Inc. v. Bryan*, 123 F.2d 697, 699 (2d Cir. 1941).

That definition both explains how the Ninth Circuit reached its determination in *Urantia Found. v. Maaherra*, 114 F.3d 955 (9th Cir. 1997), and why this Court must determine that the Work, according to the evidence at bar, fails to qualify as a composite work. Starting with the *Maaherra* opinion, all parties to that litigation discounted the patient as an author, considering him a mere conduit for a variety of spiritual agents. 114 F.3d at 957. Given the stipulation in that case that the Work was stitched together from

“a number of different authors [who] have contributed distinguishable selections,” the Ninth Circuit could treat the work there at issue as a composite work. *Id.*

At bar, by contrast, all evidence negates the characterization of the Work as resulting from “a number of different authors [who] have contributed distinguishable selections.” *Michael Facts*, 3, 5. Accordingly, even giving full deference to all legal propositions enunciated by the Ninth Circuit, the Work fails to qualify as a composite work. Instead, it falls outside the exception urged by UF. The inescapable conclusion remains that no party entitled to effectuate renewal of the Work in 1983 actually did so.

It has also been suggested that a “composite” work, as that term was used in the renewal features of the 1909 Act, is equivalent to what is referred to elsewhere in the current Act as a “collective” work. *See Nimmer on Copyright* § 9.03[B]. As discussed in Part I(d)(1) above, the Work cannot qualify as a collective work. It therefore falls outside the exception for composite works, and could not be renewed on that basis.

c. Given Improper Attempts to Renew It in 1983, Doctrine and Sound Policy Relegate the Work to the Public Domain

It is undisputed that UF applied to renew the copyright in the Work in 1983 – and that it did so without authority from any of the statutory heirs of the deceased patient (or, for that matter, of the deceased contact commissioners). *Michael Facts* ¶¶ 7, 18, 19. The law is clear as to the effect of a renewal registration certificate taken out in the name of an entity other than those entitled by statute to renew the copyright (and with no grant from those individuals) – it is a nullity. *See Maaherra*, 114 F.3d at 962; *Von Tilzer v. Jerry Vogel Music Co.*, 53 F. Supp. 191, 196 (S.D.N.Y. 1943) (“A renewal of a copyright by a person not entitled thereto is void and can not be cured by subsequent ratification by the person allegedly entitled to renew.”); *Tobani v. Carl Fischer, Inc.*, 98 F.2d 57, 60 (2d Cir. 1938) (same). Indeed, courts have demanded punctilious attention to the requirement that the appropriate party effectuate renewal registration. *See International Film Exchange Ltd. v. Corinth Films, Inc.*, 621 F. Supp. 631 (S.D.N.Y. 1985) (rejecting

renewal application filed neither in the name of the author nor by the copyright proprietor, but filed instead by a mere licensee); *Nimmer on Copyright* § 9.05[D][1] (“A copyright renewal certificate is valid only if made in the name of persons who are among the statutory class entitled to such renewal copyright.”)

In this manner, copyright serves its constitutional goal – it is conferred for the benefit of society, not to provide perpetual protection to authors. *See Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (purpose of copyright protection for authors is “to allow the public access to the products of their genius after the limited period of exclusive control has expired”); *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The copyright law, like the patent statutes, makes reward to the owner a secondary consideration.”). That policy is particularly pointed at bar – more than sixty-five years after the human author wrote the Work, an entity with no renewal grant from him or his heirs seeks to monopolize his timeless message for its own benefit.

III. While Estoppel Bars UF’s Historically Contradictory Arguments, No Such Bar Applies to Michael

a. UF Is Estopped from Arguing that the Patient Is Not the Author of the Work

The conclusion that the patient is the author of the Work is buttressed by UF’s own statements in *Urantia Found. v. Burton*, 210 U.S.P.Q. 217 (W.D. Mich. 1980). UF there cited *Cummins v. Bond*, L.R. 1 Ch. 167 (1927), involving a claim of copyright in a manuscript written by Ms. Cummins taking dictation from an ancient spirit:

The Plaintiff here has taken the position that the author (being the originator) of *The Urantia Book* is the superhuman being from whom the subject matter was received, but the writer here is in the same position as the writer in the aforesaid *Cummins v. Bond Case*, and, thus the first owner of the copyright must be held to be such writer, be he known or unknown. Since such writer had a common law copyright in what he had written...

Plaintiff’s Brief in Reply to the Defendant’s Main Brief at 8. The court accepted that argument:

Since the plaintiff is not the author of The Urantia Book, it must demonstrate its claim of copyright as an assignee of the rights of the author. The plaintiff claims that the right to claim statutory copyright was transferred orally from the author to Dr. Sadler, and that Dr. Sadler then transferred that right to the plaintiff through the document of trust by which it was created. The very facts which the defendant has used to show that the plaintiff was not the author have also *established that Dr. Sadler was the assignee of the rights of the author of The Urantia Book.*

210 U.S.P.Q. at 221 (emphasis added, citations omitted).

The position taken by UF in *Burton* and the evidence presented in support of its position demonstrate that the patient must be considered the author of the Work for copyright purposes. At least one member of the contact commission, Emma Christensen, was still alive and active in UF's affairs when UF asserted in *Burton* that the patient was the author of the book. She died prior to UF's renewal of the copyright in 1983. All other contact commission members predeceased her, leaving no one involved with UF from the time of her death forward with personal knowledge of the facts regarding the authorship of the Work. Michael Facts 18. Under these circumstances, it is highly prejudicial to allow UF's *volte-face* regarding the Work.

The case at bar presents ideal circumstances for the application of judicial estoppel: UF asserted in *Burton* that the patient was the author of the Work and the court relied on that assertion, ruling that UF was the assignee of the patient's common law copyright. Now, because the alleged assignment of the patient's common law copyright is no longer efficacious, UF argues contrariwise that the patient was a mere conduit and not the author of the book. Michael acknowledges that this Court is limited by the extreme minority position taken by the Tenth Circuit refusing to recognize the doctrine of judicial estoppel. *See e.g., United States v. MegaMania Gambling Devices*, 231 F.3d 713, 726 (10th Cir. 2000). Nonetheless, Michael submits that the Tenth Circuit, if given the opportunity, will reconsider its decisions in light of the circumstances of this case.

b. UF Is Estopped from Arguing that the Work Is a Work for Hire

Distinct from judicial estoppel is the doctrine of collateral estoppel, which the Tenth Circuit does recognize. *Murdock v. Ute Indian Tribe of Uintah & Ouray Reservation*, 975 F.2d 683 (10th Cir. 1992). In a recent case, the district court ruled UF's work for hire argument groundless and granted summary judgment against UF on that claim. *Urantia Foundation v. Maaherra*, 895 F.Supp. 1347, 1352-54 (D.Ariz. 1995). While the Ninth Circuit reversed on other grounds, it noted that "[a]s to whether the Book was a 'work made for hire,' Maaherra is probably correct that it was not." 114 F.3d 955, 961 (9th Cir. 1997). Having litigated this issue and lost, UF is estopped from raising it again.

c. Michael Is Not Bound by Any Prior Determinations

UF has brought many lawsuits in the past, resulting in a cacophony of judicial opinions regarding its purported rights in the Work. *See Urantia Found. v. King*, 194 U.S.P.Q. 171 (C.D. Cal. 1977); *Urantia Found. v. Burton*, *supra*; *Urantia Found. v. Maaherra*, 895 F. Supp. 1328 (D. Ariz. 1995), 895 F. Supp. 1329 (D. Ariz. 1995), 895 F. Supp. 1335 (D. Ariz. 1995), 895 F. Supp. 1337 (D. Ariz. 1995), 895 F. Supp. 1338 (D. Ariz. 1995), 895 F. Supp. 1347 (D. Ariz. 1995), *rev'd*, 114 F.3d 955 (9th Cir. 1997). Because UF has taken mutually exclusive positions throughout the decades, the holdings that emerge from those cases are contradictory.

Regardless of that previous history, UF does not claim that any of the cited opinions bind Michael or McMullan. Given that neither Michael nor McMullan were party to the previous cases, the doctrines of collateral estoppel and res judicata are facially inapplicable at bar. *See, e.g., Benson and Ford, Inc. v. Wanda Petroleum Co.*, 833 F.2d 1172, 1174 (5th Cir. 1987) (holding that nonparty who merely helps to finance litigation or participates as *amicus curiae* is not subsequently barred by conclusive effect of final judgment). Accordingly, the instant summary judgment motion must be determined only by the facts as they appear in the record before this Court.

Because so much of UF's brief is premised on the Ninth Circuit's holding in *Urantia Found. v. Maaherra*, 114 F.3d 955 (9th Cir. 1997), it is worth analyzing that opinion's significance to the case at bar, insofar as it bears on characterization of the Work. Given its failure to qualify for collateral estoppel, *Maaherra* plainly cannot control the ultimate issue regarding the status of the Work. Instead, the Ninth Circuit's opinion, to the extent it sets forth accurate statements of law, may at most provide guidance on parallel issues confronting this Court.

Turning to *Maaherra*, the court recounts at the outset the posture in which the case was framed:

Central to an understanding of the case is the history, as perceived by both parties, of the creation of the Book. Both parties believe that the words in the Book were "authored" by non-human spiritual beings described in terms such as the Divine Counselor, the Chief of the Corps of Superuniverse Personalities, and the Chief of the Archangels of Nebadon. These spiritual entities are thought to have delivered the teachings, that were eventually assembled in the Book, "through" a patient of a Chicago psychiatrist, Dr. Sadler.

The crabbed way that the parties presented the issues for resolution in *Maaherra* goes a long way in explaining the strange twists and turns that the Ninth Circuit took. The court started with the theological conundrum of whether a work not authored by human beings can obtain copyright protection. *Id.* at 958. Happily, that issue does not bedevil the current case. The evidence at bar shows that a human being, the patient, composed the entirety of the Work. For that reason, it qualifies as a unified literary work – a characterization evidently foreclosed to the Ninth Circuit by the stipulations of the parties in that case.

Faced with those stipulations as to spiritual authorship, the Ninth Circuit was relegated to attempting to identify the “first human beings who compiled, selected, coordinated, and arranged the Urantia teachings.” 114 F.3d at 958. For that role, the court alighted on the contact commission. *Id.* at 959. From that contorted posture, the Ninth Circuit reasoned:

In this case, the Contact Commission may have received some guidance from celestial beings when the Commission posed the questions, but the members of the Contact Commission chose and formulated the specific questions asked. These questions materially contributed to the structure of the Papers, to the arrangement of the revelations in each Paper, and to the organization and order in which the Papers followed one another. We hold that the human selection and arrangement of the revelations in this case could not have been so “mechanical or routine as to require no creativity whatsoever.”

Id.

The evidence in the case at bar shows that the patient composed the Work, which accordingly obtained copyright protection in 1955. By contrast, the Ninth Circuit proceeded on a record so far removed from those facts that the patient did not even impinge on its consciousness. *See* 114 F.3d at 961 (“The Foundation was never the employer of any of the spiritual beings, of Dr. Sadler, of the Contact Commission, or of any other entity that played a role in the creation of the Papers that were eventually transferred to the Foundation.”).

Regardless of whether the Ninth Circuit reached a proper resolution for a case involving revelations by spiritual beings, its ruling does not apply to the case at bar – which concerns the copyright status of a human-authored literary work.

d. **Michael Is Not Estopped To Challenge the Validity of Urantia Foundation’s Copyright.**

UF argues that Michael is estopped from challenging the validity of UF’s copyright because its president, McMullan, licensed the copyright at issue and executed an agreement assigning to UF McMullan’s rights to a work entitled *Key Word Index*. In support of its position, UF cites *Creative Gifts, Inc. v. UFO*, 235 F.3d 540, 544 (10th Cir. 2000), for the proposition that “[i]n the Tenth Circuit, licensees and former licensees are estopped from challenging the validity of the underlying copyright or trademark.” UF Brief at 21.

Creative Gifts is a *trademark* case. It does not support the conclusion that the same rule can be applied in *copyright* cases. UF has not cited any case that suggests a similar rule would be applied by the Tenth Circuit in a copyright case. In *Lear v. Adkins*, 395 U.S. 653, 89 S.Ct. 1902, 23 L.Ed.2d 610 (1969), the Supreme Court repudiated in the context of a patent the very “licensee estoppel” doctrine that UF urges her patroTI the

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who is not the holder of a copyright for copyrighted material is prevented from using that material to enrich the lives of humanity through expansion or publication of that material. Similar considerations do not apply to trademarks, which do not embody ideas but merely symbolize the goods or services of their holders. Consequently, UF's reliance on a trademark case to support its claim of licensee estoppel is unavailing.¹⁰

IV. Even If the Work Had Been Properly Renewed, JANR Does Not Infringe It

Assuming contrary to fact that UF is entitled to claim a copyright in the Work as a whole, Michael did not infringe that copyright by reprinting the portion contained in JANR. Ample evidence supports the conclusion that Part IV of the Work – the part printed in JANR – had a different origin from the rest of the book.

In *Maaherra*, the Ninth Circuit noted:

It must be remembered that the claim of copyright infringement in this case concerns the verbatim copying of the entire Urantia Book, including the selection and arrangement of the Revelations into the Papers that comprise the Book. This case does not concern the use of a single 'revelation' outside the context of the Book, which for purposes of this case would be analogous to a 'fact,' and which of course would not be copyrightable.

114 F.3d at 959. That holding effectuates the provision of the Copyright Act mandating that the "copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work." 17 U.S.C. § 103(b) *Maaherra* did not decide what "preexisting material" the contact commission allegedly compiled. If UF is ruled to have a valid copyright in the Work, the issue of whether the material contained in JANR was preexisting remains a factual one that must be resolved in this case.

¹⁰ Even if the holding in *Creative Gifts* applied to copyrights, UF has offered nothing to show that Michael Foundation, who has never been a licensee of UF, waived its right to challenge UF's copyright.

In deciding *Maaherra*, the Ninth Circuit relied upon the document entitled “History of the Urantia Movement.” Exh JJ, Mindy Williams depo at 46-48. A copy of that document is attached to UF’s counterclaim in this case. The document describes the question process upon which UF relies. Then, it continues:

What has just been recorded refers more particularly to Parts I, II and III of The Urantia Book. Part IV - The Jesus Papers – had a little different origin. They were produced by a midwayer commission and were completed one year later than the other Papers.

Id. at 19. Additional evidence suggests that the papers that comprised Part IV were received as a single unit after the alleged question process was completed. A major time discrepancy is involved in UF’s reasoning. Since Part IV arrived a year later than Part III, and since Part III was written in 1935, Exh. AA at 1319. Part IV must have been written in 1936. However, Carolyn Kendall testified that the forum “question process” ended in 1935. Therefore, the time discrepancy forecloses even the opportunity for questions to have impacted the text which comprises JANR. (Michael Facts 10) At a minimum, this evidence creates a factual issue whether the alleged contributions of the contact commission contributed anything to Part IV, which is the sole material from the Work reproduced in JANR.

V. The “Urantia” and “Urantian” Trademarks Are Invalid and Unenforceable.

a. Incontestability Clarified.

Registrations become incontestable by the registrant’s filing of an affidavit under section 33(b) of the Lanham Act, 15 U.S.C. §1115(b). “The label ‘incontestable’ is misdescriptive and misleading. In fact, there may be as many as twenty-one possible exceptions to the status of an incontestable registration of a mark.” *5 McCarthy On Trademarks and Unfair Competition*, §32:147 at 32-229.¹¹ Genericness and fraud are just two of the many such grounds.

¹¹ This contradicts UF’s representation that there are “very few” defenses to incontestable marks.

b. “Urantia” and “Urantian” Are Generic.

1. Generic Words Are Not Protectable

The generic name of a product or service can never function as a trademark to indicate origin of that service or product whether federally registered or not. Several courts have addressed the issue of “genericness” in the name of a religion and have consistently held that the name of a religion or a religious sect is a generic name that is part of the public domain and not entitled to trademark protection. *Christian Science Board of Directors of the First Church of Christ, Scientist v. First Church of Christ, Scientist, Plainfield, New Jersey*, 520 A.2d 1347, 1351 (N.J. 1987) (“Plaintiffs simply cannot appropriate from the public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it.”) *See also, McDaniel v. Mirza Ahmad Sohrab*, 27 N.Y.S.3d 525, 527 (N.Y. 1941) (holding that plaintiffs have no right to a monopoly of the name of a religion [Baha’i] and that “the defendants, who purport to be members of the same religion, have an equal right to use the name of the religion in connection with their own meetings, lectures, classes and other activities . . . and have the absolute right to practice Baha’ism, to conduct meetings, collect funds and sell literature in connection therewith”) (emphasis added); *New Thought Church v. Chapin*, 159 A.D. 723 (N.Y.S. 1913) (refusing to enjoin the defendant from conducting services under the name “New Thought Services,” and denying plaintiff, the founder of the new system of religion that was based on a new creed, the exclusive right to use the name of the religion, “New Thought”); *Board of Provincial Elders of the Moravian Church v. Jones*, 159 S.E.2d 545 (N.C. 1968) (reversing injunction granted in favor of plaintiff, the governing body of the Moravian Church against The Bible Moravian Church for the use of its name); *Rosicrucian Fellowship v. Rosicrucian Fellowship Non-Sectarian Church*, 245 P.2d 481 (Cal. 1952) (denying injunction against

use of the name “Rosicrucian Fellowship” when a dispute arose between two groups who followed the religious philosophy of “Rosicrucian”).¹²

2. Urantia and Urantian Are the Name of a Religion and Its Followers

The terms “Urantia” and “Urantian” are introduced in *The Urantia Book*¹³ and were in use prior to the formation of Urantia Foundation. (Michael Facts 21, 22) The term “Urantia” – which literally means earth – is used generically to refer to a religion or ideology which adheres to the doctrine contained in *The Urantia Book*. (Michael Facts 23) Similarly, the term “Urantian” – which literally means earthling or human – is used generically to refer to the religion and its followers and believers of the ideology espoused in *The Urantia Book*. Thus, just as believers of *The Book of Mormon* are referred to as Mormons, followers of *The Urantia Book* are referred to as Urantians.¹⁴

There is abundant additional evidence that these terms are generic, including potent evidence that UF and its leadership use these terms generically to refer to a religion and its followers. Michael Facts 20. Harry McMullan considers himself an

¹² Courts have even applied this line of reasoning outside of the religion and ideology settings. *See Primal Feeling Center, Inc. v. Janov*, 201 U.S.P.Q. 44 (T.T.A.B. 1978) (canceling the registered mark “Primal Therapy” even though the holder had developed the method of therapy, coined the expression “primal therapy” and had used that name exclusively).

¹³ The United States Patent and Trademark Office adheres to the view that the title of a book is generic and not entitled to trademark protection or registration. *In re Cooper*, 254 F.2d 611, 613 (C.C.P.A. 1958) (“The name which is the only name by which an article of merchandise may be identified—whether a book or any other—is not a trademark and is therefore not registrable.”). *See also In re Hal Leonard Publishing Corp.*, 15 U.S.P.Q.2d 1574 (T.T.A.B. 1983); *In re Posthuma*, 45 U.S.P.Q.2d 2011 (T.T.A.B. 1998); *In re Caserta*, 46 U.S.P.Q.2d 1088 (T.T.A.B. 1998).

¹⁴ UF cannot dispute this analogy. In a 1972 letter urging a fund-raising strategy to the then-President of UF, current trustee Richard Keeler wrote, “Urantians are as zealous as Mormons” and “Give me the names of the 1,000 hard-core Urantians, and I shall ask each of them face to face to tithe.” (Exh PP)

Urantian and a follower of the Urantia religion. (McMullan aff. ¶¶ 52-60) Mr. McMullan is not alone; thousands of other individuals do as well. (Michael Facts 20)

3. These Terms are Generic to the Relevant Public

UF argues that the relevant public for genericism determinations is “[a]ll book consumers” or “the entire market of consumers” or “the public at large”. UF Facts 44. UF must assert these unrealistic markets of potential purchasers who have never heard of *The Urantia Book* or the religion because the overwhelming evidence set forth above establishes that Urantia and Urantian are generic to readers of *The Urantia Book* and followers of the Urantia religion. People exposed to the Urantia religion for the first time and new readers of *The Urantia Book* immediately understand that these terms mean the religion and its followers. (Michael Facts 20) The entire premise of UF’s argument is that a purported mark used in a small market is somehow less generic because the purported mark is generally not recognized (and thus has no source identifying capability) outside of that small market. Thus, UF relies on the lack of source identifying capability of the trademarks to *potential* consumers to bolster its claim that the mark is not generic to *actual* consumers. Since the purpose of the genericism analysis is to determine whether the mark has any capacity to distinguish source, UF’s argument is entirely fallacious.

The relevant public is the market of “actual or potential purchasers.” *E.g.*, *Creative Gifts v. UFO*, 235 F.3d 540, 544 (10th Cir. 2000). As applied in the religion context, and particularly in the context of non-mainstream religions, the relevant public of purchasers is rather narrow. *Self-Realization Fellowship v. Anonda Church*, 59 F.3d 902 (9th Cir. 1995) (“the way to determine whether a term is generic is to determine whether consumers of Hindu-Yoga products & services think it is generic.”); *Maktab Tarighe Oveyssi Shah Maghsoudi v. International Assoc. of Sufism*, 1999 WL 381022 at *5 (TTAB 1999) (“In this case, the majority of persons coming into contact with respondent’s publication will be adherents of Sufism. Thus, the relevant public here

consists of adherents of Sufism.”);¹⁵ *Stocker v. General Conference Corp. of Seventh-day Adventists*, 39 U.S.P.Q.2d 1385, 1394 (TTAB 1996) (relevant public for mark “Seventh-day Adventist” are Adventist Christians).

Applying this analysis, the relevant public of purchasers should be followers of *The Urantia Book*. Within this relevant public, the marks are clearly generic for the Urantia religion, the followers of the religion, and the various goods and services commonly associated with a religion such as teaching, conducting meetings and providing literature relating to the religion. *McDaniel*, 262 A.D. 838. At a minimum, the genericness analysis is a question of fact.¹⁶

c. The Federal Registrations for “Urantia” and “Urantian” Were Fraudulently Obtained.

The elements necessary for fraud in obtaining trademark registration include: (1) a false representation regarding a material fact; (2) knowledge or belief that the representation is false; (3) an intention to induce the listener to act or refrain from acting in reliance on the misrepresentation; (4) reasonable reliance on the misrepresentation; and (5) damage proximately resulting from such reliance. *San Juan Products, Inc. v. San Juan Pools, Inc.*, 849 F.2d 468, 473 (10th Cir. 1988). Applying these elements in view of the above prosecution history establishes fraud.

First, statements by UF’s attorney, Mr. Emrich, to the trademark examining attorney in response to direct inquiries about the meaning of Urantia and Urantian were false. As established above, Urantia and Urantian are the name of a religion. (Michael

¹⁵ The opinion in the *Sufism* case was designated as “non-precedential”. *But see Anastasoff v. United States*, 223 F.3d 898 (8th Cir. 2000) (holding that unpublished opinions have precedential effect), *vacated as moot*, 235 F.3d 1054 (8th Cir. 2000). Regardless, the *Sufism* case is persuasive and relevant.

¹⁶ See *Dan Robbins & Assoc., Inc. v. Questor Corp.*, 599 F.2d 1009 (CCPA 1979); *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556 (Fed. Cir. 1985); *Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc.*, 76 F.3d 743 (6th Cir. 1996); *Door Systems, Inc. v. Pro-Line Door Systems, Inc.*, 83 F.3d 169 (7th Cir. 1996); *Committee for Idaho’s High Desert v. Yost*, 92 F.3d 814 (9th Cir. 1996).

Facts 20) Much of the evidence establishing this fact comes directly from the Foundation and its leadership based on documents and statements prior to September 29, 1970, the filing date of the earliest of these applications. For example, UF's Declaration of Trust used to establish its tax-exempt status and recorded in 1950 states that one of its "Principal Objects" is "the fostering of a religion." (Michael Facts 20) This particular fact is noteworthy because (1) all of the above registrations list the applicant as "URANTIA Foundation, *an educational foundation* created by declaration of trust dated January 11, 1950" (emphasis added) (Exh. W),¹⁷ and (2) a copy of the Declaration of Trust was included as a specimen in the application that matured into registration no. 1,112,713 for Urantia, which application was also prosecuted by the same Mr. Emrich. Thus, Mr. Emrich was very aware at the time of his misrepresentations that Urantia and Urantian are the names of a religion and that UF's purpose was to promote that religion. Moreover, Mr. Emrich's statement that Urantian is a "coined word—formed by, and from the name of, Applicant Foundation" is clearly a misrepresentation since this term is introduced in *The Urantia Book* and was used prior to the formation of Urantia Foundation. (Michael Facts 21, 22) Mr. Emrich's statement was knowingly false because the trademark application file histories, all of which he was involved in prosecuting, are replete with the references to *The Urantia Book*.¹ Exhs. KK-OO.

These misrepresentations were made in response to office actions rejecting the applications. The applications would not have issued as registrations unless the rejections were overcome. Thus, the misrepresentations were made to induce the examining attorney to withdraw the rejections and pass the applications to the publication phase so that registrations could be obtained. It worked. The examining attorney relied on the misrepresentations as evidenced by publication of the applications and then

¹⁷ Moreover, UF's own Declaration of Trust contradicts UF's representation to this Court that neither Urantia nor Urantian was the name of a religion at the time these trademark applications were filed. (UF Fact 39).

ultimately registration. As a result of the registrations, damage necessarily ensues as UF is attempting to exclusively appropriate these terms and prevent others from using generic names.¹⁸

While the above-referenced fraud occurred “only” in two of the five listed registrations, all five are invalid. *See e.g., Robi v. Five Platters, Inc.*, 918 F.2d 1439 (9th Cir. 1990) (upholding order to cancel three registrations, even though a false incontestability statement was filed only in one application); *see also Keystone Driller v. General Excavator*, 290 U.S. 240 (1933) (inequitable conduct may extend beyond the particular patent to related patents); *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1182 (Fed. Cir. 1995) (fraud on the Patent Office or inequitable conduct in the prosecution of the application rendered a related patent unenforceability). All of the trademark applications are for goods and services related to the Urantia religion. Mr. Emrich, who was involved in the fraud, was responsible for the prosecution of all the applications. Because the issue of the meaning of Urantia and Urantian was raised in two of the applications, Mr. Emrich should have addressed it in all. If he had been truthful, none of the applications would have matured as registrations. Thus, UF’s registrations were obtained by fraud and should be cancelled.

¹⁸ Moreover, UF has used these registrations to obtain overly broad permanent injunctions prohibiting individuals from using “Urantia” or “Urantian” for any purpose. See file history of Registration No. 948,104 for Urantia, Exhs KK-OO.

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CERTIFICATE OF MAILING

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