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Not Reported in F.Supp.2d, 2005 WL 756558 (N.D.Cal.), 74 U.S.P.Q.2d 1434
(Cite as: 2005 WL 756558 (N.D.Cal.))

Page 1



United States District Court, N.D. California.
OPEN SOURCE YOGA UNITY, Plaintiff,
v.
Bikram CHOUDHURY, Defendant.
No. C 03-3182 PJH.

April 1, 2005.

[James Palmore Harrison](#), Sacramento, CA, [Elizabeth H. Rader](#), Akin Gump Strauss Hauer & Feld LLP, East Palo Alto, CA, [Michael H. Page](#), Kecker & Van Nest, San Francisco, CA, for Plaintiff.
[Laura M. Franco](#), [Susan E. Hollander](#), Manatt, Phelps & Phillips, Palo Alto, CA, for Defendant.

ORDER DENYING PLAINTIFF'S MOTIONS FOR SUMMARY JUDGMENT; GRANTING IN PART AND DENYING IN PART DEFENDANT'S MOTION FOR SUMMARY JUDGMENT

[HAMILTON](#), J.

*1 Plaintiffs' four motions for summary judgment and defendant's omnibus motion for summary judgment came on for hearing on January 26, 2005 and February 16, 2005 before this court. Plaintiff appeared through its counsel, Elizabeth Rader and James Harrison, and defendant Bikram Choudhury ("Choudhury") appeared through his counsel, Susan Hollander. Having read the papers and carefully considered the relevant legal authority, the court DENIES plaintiff's motions in their entirety, and GRANTS IN PART and DENIES IN PART defendant's motion, for the reasons that follow.

BACKGROUND

Plaintiff Open Source Yoga Unity ("OSYU") has filed a declaratory relief action, seeking a declaration that Choudhury does not have valid copyright or trademark rights in a series of yoga exercises he has compiled under the name "Bikram yoga."

Bikram yoga consists of a sequence of 26 yoga positions (known as "asanas") and two breathing exercises, performed at a room temperature of around 100 degrees Fahrenheit. Both parties agree that the asanas

themselves are in the public domain, but that Choudhury was the first to select and arrange this particular sequence of asanas in this particular way. Choudhury first selected and arranged these asanas around 1965 or 1970, and taught the sequence in Southern California throughout the 1970s. Choudhury also presented the yoga sequence at a conference in Japan in 1972.

Choudhury first sought copyright protection for his work in 1979, when he registered his book *Bikram's Beginning Yoga Class*, which was subsequently published (in the ordinary sense) also in 1979. Choudhury has since filed five additional copyright registrations for various books, audiotapes and videotapes, and finally, in 2002, for the yoga sequence itself. The copyright registration for the yoga sequence was filed as a supplemental registration to the copyright Choudhury holds in his book which was created in 1978 and which is alleged to be the first place the yoga sequence appeared in print. Choudhury has also registered the trademarks BIKRAM YOGA, BIKRAM'S BEGINNING YOGA CLASS, BIKRAM'S YOGA COLLEGE OF INDIA, and SPINAL TWIST DESIGN.

Over the last several years, Choudhury has notified yoga instructors that they must obtain a license from him in order to teach Bikram yoga, which he asserts includes not only the exact 26 asanas and two breathing exercises, but all derivative forms of the sequence as well, if the derivative form includes a sequence that is "substantially similar" to the original Bikram yoga sequence. Choudhury also demanded that yoga teachers teaching his sequence of asanas obtain a license to use the term BIKRAM YOGA. At the hearing, Choudhury stated that he was not at this time pursuing individual yoga practitioners who do not teach but simply perform the Bikram yoga sequence, either at home with the books and tapes or in yoga classes.

OSYU and Choudhury have now filed cross-motions for summary judgment. OSYU has filed four separate motions, whereas Choudhury has filed one motion containing all of his arguments. OSYU first moves for summary judgment on copyright invalidity, claiming in one motion that yoga sequences cannot be copy-

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 (Cite as: 2005 WL 756558 (N.D.Cal.))

Page 2

righted as a matter of law, and in another motion that the Bikram yoga sequence is in the public domain under the 1909 Copyright Act. OSYU next moves for summary judgment on the question of copyright misuse by Choudhury. In its fourth motion OSYU, moves for summary judgment on the question of trademark invalidity. Choudhury moves for summary judgment in his favor on all of the same issues.

DISCUSSION

A. Legal Standard

*2 Summary judgment is appropriate when the evidence shows there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. [Fed.R.Civ.P. 56\(c\)](#); [Anderson v. Liberty Lobby, Inc.](#), 477 U.S. 242, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986).

B. Copyright Validity and Infringement

OSYU's first motion for summary judgment concerns copyright validity and infringement. In this motion, OSYU claims that individual yoga asanas are in the public domain and constitute functional information rather than expressive creative content, and as a result yoga in general cannot be copyrighted and therefore OSYU's members are not liable for infringement. Choudhury claims in response that his copyright was properly obtained and properly encompasses not only the contents of his books but the yoga sequence itself. Choudhury claims that his yoga sequence constitutes a copyrightable compilation of information in the public domain and that all the accompanying rights of copyrightability thus flow from his registration.

1. Copyright Registration

As an initial matter, OSYU challenges the validity of Choudhury's registration in the Bikram yoga sequence, on the grounds that Choudhury cannot properly register a copyright in the sequence by using the supplemental registration procedure. Choudhury responds that he filed the supplemental registration at the direction of the Copyright Office and that it properly covers the Bikram yoga sequence.

Choudhury is correct that a supplemental registration may properly amplify a previous copyright registra-

tion to claim copyright protection for material encompassed within the previous copyright registration but not previously claimed. *See generally* [37 C.F.R. Ch. II § 201.5](#) (corrections and amplifications of copyright registrations). Thus, assuming that the selection and arrangement of the asanas is entitled to copyright protection, the filing of a supplemental copyright registration was appropriate here.

2. Copyright Validity

The court readily acknowledges that this is a very unusual case. All the parties agree that yoga is an ancient physical practice, and that the individual asanas that comprise the Bikram yoga sequence have been in the public domain for centuries. On first impression, it thus seems inappropriate, and almost unbelievable, that a sequence of yoga positions could be any one person's intellectual property.

However, what is at issue are two competing principles of copyright law. On the one hand, copyright law does not protect factual or functional information, or information that is already in the public domain. On the other hand, copyright law does extend protection to an arrangement of information in the public domain assembled in a sufficiently creative fashion. The question at hand is how to reconcile these two principles.

In 1991, the Supreme Court decided the seminal case of *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, which held that compilations of factual information arranged in an obvious manner, such as alphabetical listings of names, addresses and telephone numbers in a telephone book, could not be copyrighted simply because of the time and effort it took to collect the information. [499 U.S. 340, 111 S.Ct. 1282, 113 L.Ed.2d 358 \(1991\)](#). Some creative contribution must be made to the compilation itself for copyright protection to attach. So, for instance, in [Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.](#), [945 F.2d 509, 516 \(2d Cir.1991\)](#), copyright protection in a telephone book was found for the otherwise-uncopyrightable facts of a business' name and phone number because the author of the telephone book in question had creatively selected and arranged its entries by compiling the names of businesses of interest to the Chinese community.

*3 Applying these principles, the Ninth Circuit found

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 (Cite as: 2005 WL 756558 (N.D.Cal.))

Page 3

that a compilation of an uncopyrightable lifelike model of a jellyfish encased in a standard and uncopyrightable glass container does not qualify for copyright protection because it did not encompass sufficient creativity in the selection and arrangement of the elements. “[A] combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.” [Satava v. Lowry](#), 323 F.3d 805, 811 (9th Cir.2003) (reversing order granting preliminary injunction on the grounds that the idea of encasing a vertically-hanging jellyfish in glass featured “commonplace” elements of glass sculpture and jellyfish physiology that could not be copyrighted). However, by contrast, the Ninth Circuit has also found that while the idea of a lamp standing alone cannot be copyrighted, a lamp featuring “design features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the lamp’s component parts” will qualify for copyright protection. [Lamps Plus, Inc. v. Seattle Lighting Fixture Co.](#), 345 F.3d 1140, 1147 (9th Cir.2003).

Thus, copyright law provides that while functional and public domain material remains free for all to use, a compilation of that material may nonetheless qualify for copyright protection if the compiler can demonstrate a sufficient level of creativity in the selection and arrangement of the elements in the compilation. It is against this backdrop that Choudhury’s claims must be evaluated.

While OSYU admits that Choudhury has creatively selected and arranged individual unprotected functional asanas into the Bikram yoga sequence, it argues that the Bikram yoga sequence nonetheless cannot be copyrighted because the practice of yoga and the individual asanas cannot be considered creative expression but are instead merely uncopyrightable functional physical movements. OSYU claims that physical movements and exercise regimens cannot be copyrighted, and that the Bikram yoga sequence cannot be considered copyrightable choreography. Choudhury responds that the Bikram yoga sequence warrants copyright protection simply because it is a compilation of asanas that were creatively selected and arranged.

OSYU first argues that physical exercise regimens in

general cannot be copyrighted, citing [National Basketball Ass’n and NBA Prop., Inc. v. Motorola, Inc.](#), 105 F.3d 841, 846 (2d Cir.1997) (NBA does not hold copyright in basketball games). However, as Choudhury correctly notes, the reason why basketball games, or sports activities in general, cannot be copyrighted is because these activities are unscripted and do not involve a fixed routine of motions. Rather they encompass many unanticipated movements resulting from the competitive nature of sports. Because the Bikram yoga sequence is a predetermined sequence of asanas performed the same way every time without a competitive element, NBA does not apply.

*4 Similarly, OSYU cites [Data East USA Inc. v. EPYX, Inc.](#), 862 F.2d 204 (9th Cir.1988) for the proposition that an exercise routine (in that case, a karate routine) cannot be copyrighted either. However, *Data East*, which involved a copyright infringement claim raised by competing karate video games, did not reach the issue of the originality of karate routines in general. Instead, the court compared certain elements of the karate routines portrayed in two video games for similarity in order to determine copyright infringement. *Id.* at 209-10. This analysis has no bearing on the issue of whether a real-life karate routine qualifies for copyright protection.

Thus, OSYU has provided no persuasive authority that a compilation of yoga asanas cannot be protected under the copyright laws in the same manner as other compilations. The court, while recognizing, and even agreeing that application of the law of compilations to yoga asanas appears to violate the spirit of yoga, has been unable to locate any authority that precludes such application. Therefore, if the trier of fact determines that a sufficient number of the individual yoga asanas are arranged in a sufficiently creative manner, copyright protection for the yoga sequence would be available. See [Satava](#), 323 F.3d at 811; see also, e.g., [Matthew Bender & Co., Inc. v. West Publishing Co.](#), 158 F.3d 674, 682 (2d Cir.1998) (explaining when copyright protection inheres in collection of uncopyrightable information in the context of the publication and categorization of judicial opinions by online publishers).

Here, Choudhury claims that he arranged the asanas in a manner that was both aesthetically pleasing and in a way that he believes is best designed to improve the practitioner’s health. At a minimum, this creates a

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 (Cite as: 2005 WL 756558 (N.D.Cal.))

Page 4

dispute of fact on the issue of whether sufficient creativity exists in the Bikram yoga routine so that copyright protection attaches, and thus summary judgment on both copyright validity and copyright invalidity must be denied. *See, e.g., Swirsky v. Carey*, 376 F.3d 841, 851 (9th Cir.2004) (trier of fact determines originality of work).^{FN1}

^{FN1} OSYU also argues that any copyright that Choudhury owns extends only to the written text of his book and thus does not prohibit unlicensed public performances of the Bikram yoga sequence by instructors. However, should Choudhury establish at trial that his copyright in the Bikram yoga sequence itself is valid, under 17 U.S.C. § 106(4) he retains the exclusive right to authorize public performances of the sequence.

3. Infringement of Bikram Yoga Sequence

If the Bikram yoga sequence can be copyrighted, any copyright that exists is necessarily considered “thin.” In other words, Choudhury's copyright protects only the arrangement of asanas as specifically described in Choudhury's book. *See, e.g., Apple Computer v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir.1994) (“[w]hen the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity.”); *Feist*, 499 U.S. at 349 (another compiler can use the same basic noncopyrightable elements as the first compiler without infringing on the first compiler's copyright in the compilation, “so long as the work does not feature the same selection and arrangement.”). Nonetheless, even under a thin copyright, Choudhury may properly enjoin exact or near-exact duplications of his yoga sequence, if the routines taught by plaintiffs are “substantially similar” to Choudhury's, and thus infringing.

*5 Both parties' positions on this issue are inconsistent and thus somewhat unclear. Choudhury claims in his opposition brief that he does not seek to enjoin yoga teachers from performing and teaching sequences other than the exact sequence of 26 asanas set forth in his 1979 book. However, OSYU has produced cease and desist letters from Choudhury in which he states that he seeks to enjoin not only exact duplications of the Bikram yoga sequence, but also any modifications to the sequence that add or subtract asanas. At the hearing, Choudhury stated that he seeks to enjoin any

yoga sequences he deems “substantially similar” to his own. Thus, the court cannot determine what relief Choudhury is in fact requesting in his motion.

OSYU's position is similarly unclear. On the one hand OSYU claims that its members do not infringe and on the other it asserts that infringement is not an issue in this case. OSYU requests a declaration from the court that none of its members infringe Choudhury's copyright, but has also continuously refused to disclose to Choudhury the elements of the yoga routines taught by its individual members. OSYU takes the position that it need not divulge what its members are teaching because the copyright is invalid and the court need not reach the issue of infringement. However, as discussed above, summary judgment on validity and invalidity is denied for both parties. On this record, it is impossible for the court to evaluate OSYU's claims of non-infringement without additional information about the actual yoga sequences practiced by the individual OSYU instructors.

OSYU does admit that one member teaches the exact Bikram yoga sequence, with no modification, and several others teach yoga sequences that are similar but modify Choudhury's sequence in some unspecified ways. OSYU provides no other information about the sequences taught, such as the order of the asanas, what modifications have been made to the order or to the asanas themselves, or whether the sequences involve specific moves that are common to all yoga practices and thus cannot be copyrighted, among other potentially pertinent information.

Assuming copyright protection is found at trial to attach to the Bikram yoga sequence, the court would find, at a minimum, that exact duplication of the sequence infringes. However, because there are numerous unanswered questions of fact concerning the nature of the yoga routines performed by the other OSYU members, any finding on the issue of copyright infringement as to them is inappropriate at this time. *See, e.g., Smith v. Jackson*, 84 F.3d 1213, 1217 (9th Cir.1996) (summary judgment on copyright infringement not appropriate if questions of fact exist as to the substantial similarity of the works at issue).^{FN2} The trier of fact will thus be required to compare the yoga sequences taught by OSYU members with the Bikram yoga sequence to determine whether copyright infringement exists. If OSYU wishes to pursue its claim for a declaration of non-infringement, it may

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 (Cite as: 2005 WL 756558 (N.D.Cal.))

Page 5

not continue to withhold information regarding the identities and practices of its members.

[FN2](#). OSYU also moves for summary judgment that its members' verbal descriptions of the asanas do not infringe Choudhury's copyright either. Given the relatively limited numbers of ways in which to describe the configurations of the asanas, it is true that the merger doctrine may apply to bar Choudhury from claiming exclusive rights in those descriptions. *See, e.g., Apple, 35 F.3d at 1444* (merger doctrine applies when the idea and the expression of the idea are identical). However, because OSYU has not established what statements of its membership have been challenged, questions of fact exist as to whether the doctrine of merger applies.

C. 1909 Copyright Act

*6 When Choudhury originally created the Bikram yoga sequence, in the late 1960s or 1970s, the Copyright Act of 1909 was in effect. Under the 1909 Act, any publication of a copyrightable work made without a copyright notice irrevocably dedicated the work to the public and thus rendered the work uncopyrightable in the future. OSYU argues in its second motion for summary judgment that under the 1909 Copyright Act, the Bikram yoga sequence had already entered the public domain in the 1970s through Choudhury's teaching of the sequence in his yoga classes and his presentation of the sequence at a conference in Japan. Choudhury responds that he did not forfeit copyright protection under the 1909 Act by merely performing the yoga sequence and that OSYU has produced no evidence of any memorialization of the yoga sequence prior to its appearance in his 1979 book.

The current copyright act was enacted in 1976, and only covers works created after January 1, 1978. *See 17 U.S.C. § 302*. Works created before that date remain covered by the provisions of the previous copyright statute, the 1909 Copyright Act. Choudhury claims that he created the Bikram yoga sequence in either 1965 or 1971. Thus, the question of whether the sequence has entered the public domain is governed by the 1909 Copyright Act. *See, e.g., Dolman v. Agee, 157 F.3d 708, 712 n. 1 (9th Cir.1998)*.

Under the 1909 Copyright Act, an unpublished work

was considered protected by state copyright common law from the time it was created until the time it was either "published" or protected under federal copyright law. If the federal statutory requirements for copyright protection were not met at the time of "publication," the work was considered to have entered the public domain. *See, e.g., Twin Books Corp. v. Walt Disney Co., 83 F.3d 1162, 1165 (9th Cir.1996)* (citations omitted). The federal statutory requirement at issue in this motion is the requirement that at the time of publication, a prominent copyright notice be displayed. 17 U.S.C. § 9 (1909 Act, repealed 1976).

The term "publication," however, was not defined in the 1909 Copyright Act. *Abkco Music, Inc. v. Lavere, 217 F.3d 684, 688 (9th Cir.2000)*. The Ninth Circuit has defined "publication" for the purposes of the 1909 Copyright Act as occurring "when by consent of the copyright owner, the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise made available to the general public ..." *American Vitagraph, Inc. v. Levy, 659 F.2d 1023, 1027 (9th Cir.1981)* (adopting Nimmer definition).^{FN3}

[FN3](#). Choudhury also argues that performances cannot be considered "fixed" in a tangible medium and therefore the pre-1976 performances are exempt from copyright law entirely. However, the 1909 Act does not make reference to the term "fixation" and uses only the term "publication" for this concept.

However, a notable exception to this rule is that, "mere performance or exhibition of a work does not constitute a publication of that work." *American Vitagraph, 659 F.2d at 1027* (citations omitted). Thus, screening of a movie does not forfeit federal copyright protection for the movie itself. *Id.* Similarly, Dr. Martin Luther King Jr.'s recitation of his "I Have A Dream" speech did not forfeit federal copyright protection for the text of the speech, *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc., 194 F.3d 1211 (11th Cir.1999)*. This is because of the doctrine of limited publication, which permits the creator of a work to "distribute or show [the work] to a limited class of persons for a limited purpose without losing [the] common law copyright." *Academy of Motion Picture Arts and Sciences v. Creative House Promotions, 944 F.2d 1446, 1451 (9th Cir.1991)* (AMPAS did not lose copyright in the Oscar statuette by dis-

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 (Cite as: 2005 WL 756558 (N.D.Cal.))

Page 6

playing or presenting it at awards ceremonies).

*7 Choudhury concedes that he taught the Bikram yoga sequence in classes during the 1970s. OSYU argues that this teaching constitutes a general publication of the sequence, as opposed to a limited publication, because Choudhury did not impose any limitations on who could attend his classes and did not limit the right of his students to distribute the sequence by teaching it to others. [AMPAS, 944 F.2d at 1452](#) (limited publication occurs when purpose of distribution is limited and when recipients have no right of further distribution of the work). Choudhury responds that he merely performed the sequence in those classes, which does not constitute a general publication, and thus did not forfeit his common law or federal rights under the 1909 Act.

OSYU has produced no evidence that Choudhury did anything other than simply perform the Bikram yoga sequence, and no evidence that Choudhury ever reduced the elements of the sequence to writing or otherwise tangibly memorialized it prior to his 1979 book. Furthermore, while the 1909 Act is silent on the issue of choreography, the legislative history for the 1976 Act specifies that “choreography that has never been filmed or notated” is to be considered a work “not fixed in tangible form.” Thus, the mere performance of the work cannot be considered a general publication.^{FN4}

^{FN4}. The court questions whether body movements such as the Bikram yoga sequence would have qualified for federal copyright protection when it was created in the 1960s or 70s. See generally [Horgan v. MacMillan, Inc., 789 F.2d 157, 160 \(2d Cir.1986\)](#); *Dance and the Choreographer's Dilemma: A Legal and Cultural Perspective on Copyright Protection for Choreographic Works*, 27 Campbell L.R. 39, 42 (Fall 2004) (copyright protection only granted for choreography to the extent it could be classified as dramatic or musical expression). If the yoga sequence did not qualify for federal copyright protection, it would be deemed unprotectable unless it was protected by common-law state copyright. However, there appears to be no case law on the issue of whether body movements were protected under state law in the 1960s and 70s. If

movements were not protected by state law either, it is possible that the entire yoga sequence has thus been dedicated to the public domain. However, since neither party raised or addressed this issue, the court declines to reach it.

In response to Choudhury's arguments concerning general publication, OSYU argues that Choudhury “must have” memorialized the yoga poses at some point. OSYU hypothesizes that since the same Bikram yoga sequence was presented at a medical conference in Kyoto Japan in 1970, Choudhury “must have” published the Bikram yoga sequence in a tangible form and distributed that publication to the general public. However, OSYU presents no evidence corroborating this speculation. Choudhury, on the other hand, denies that he published the sequence until his 1979 book. The only evidence that he provides in support of his denial, is the copyright registration itself. The registration, while establishing a date of first publication of 1979, does not prove the converse—that no publication occurred prior to 1979. Indeed, it would be nearly impossible for Choudhury to prove the negative, that is that he did *not* publish the sequence during the 1960s and 1970s, with evidence extrinsic to his own declaration.

On OSYU's motion, it is required to make a colorable claim that publication occurred and then the burden shifts to Choudhury to put forth evidence that it did not. Although it seems likely that Choudhury would have memorialized the sequence during the decade or so that he taught it prior to its appearance in his book, OSYU's uncorroborated speculation that he did, simply does not amount to a colorable claim. But even if it did, the court would find Choudhury's statement that he did not publish the sequence prior to 1979, sufficient to raise triable issues of fact and thereby preclude summary judgment in OSYU's favor.

*8 The court is unpersuaded, however, that Choudhury is entitled to summary judgment on this issue either. While the court recognizes the difficulty Choudhury faces in proving a negative, his uncorroborated denial that he memorialized the sequence is about on a par with OSYU's uncorroborated speculation that he did memorialize the sequence. Neither side has produced any evidence on their respective claims. As previously described, OSYU has offered only speculation and supposition. Choudhury has

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 (Cite as: 2005 WL 756558 (N.D.Cal.))

Page 7

offered argument of his counsel and the copyright registration showing a first publication date of January 1, 1979. However, the registration form was not signed by Choudhury and he has filed no declaration on this issue. On this record, the court finds that summary judgment for either party is unwarranted, and that the trier of fact should determine if and when any publication occurred prior to January 1, 1979.

D. Copyright Misuse

OSYU's third motion for summary judgment seeks a finding of copyright unenforceability based on Choudhury's alleged copyright misuse. Choudhury claims in his omnibus motion for summary judgment that he has not misused his copyright. Both parties move for summary judgment on this issue.

The doctrine of copyright misuse permits a party accused of copyright infringement to challenge the enforceability of the copyright based on the plaintiff's improper attempt to "secur[e] an exclusive right or limited monopoly not granted by the Copyright Office." See, e.g., [A & M Records, Inc. v. Napster](#), 239 F.3d 1004, 1026 (9th Cir.2001) ("The misuse defense prevents copyright holders from leveraging their limited monopoly to allow them control of areas outside the monopoly") (citations omitted).

Copyright misuse exists solely as a defense to copyright infringement, [Practice Management Info. v. American Medical Ass'n](#), 121 F.3d 516, 520 (9th Cir.1997), and thus arguably cannot exist as an affirmative claim, see, e.g., [Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.](#), 269 F.Supp.2d 1213, 1225 (C.D.Cal.2003), *aff'd*, 380 F.3d 1154, cert.granted, 543 U.S. 1032, 125 S.Ct. 686, 160 L.Ed.2d 518 (2004). However, here, OSYU has filed a declaratory relief action seeking a judgment that it does not infringe Choudhury's copyrights. Because there has been a sufficiently immediate and concrete threat that its members will be sued for copyright infringement, subject matter jurisdiction exists over the dispute. In a declaratory relief setting, the declaratory relief plaintiff is thus permitted to "assert" a claim for copyright misuse because the declaratory relief plaintiff is in fact likely to be accused of copyright infringement. See [Practice Management](#), 121 F.3d at 520 (declaratory relief plaintiff permitted to assert copyright misuse defense). Therefore, the court determines that as a preliminary matter, OSYU is

permitted to assert copyright misuse in this action.^{FN5}

^{FN5} Choudhury argues that copyright misuse may only be asserted in a declaratory relief action when infringement claims have been asserted by the declaratory relief defendant. This seems an unduly narrow reading of the copyright misuse doctrine. Because OSYU, through its members, has a reasonable and concrete fear of being sued for copyright infringement which is sufficient to confer subject matter jurisdiction over the dispute, it is entitled to assert any defenses it would reasonably have to such a claim. Furthermore, OSYU does not assert the claim as a separate cause of action or seek damages or a separate injunction based on the claim, but rather, it asserts the claim simply as an affirmative defense should it be found liable for infringement. If OSYU does not obtain a declaration of noninfringement, the copyright misuse claim will be moot. See [Grokster](#), 269 F.Supp.2d at 1225-26 (distinguishing between copyright misuse as a defense and as an affirmative claim).

However, even if OSYU is permitted to assert the defense, it cannot prevail. Even presuming the truth of all the allegations presented by OSYU in its motion papers, OSYU has merely alleged that Choudhury obtained a copyright on the Bikram yoga sequence and is enforcing his copyright by informing people he believes to be infringing his copyright that his copyright permits him to enjoin their performance of the Bikram yoga sequence, or any modifications of the sequence that can be considered substantially similar to it. This is well within Choudhury's rights as the copyright owner, and is thus insufficient to prove copyright misuse.

*9 While Choudhury is admittedly policing his rights aggressively, the court is required to construe the facts in his favor as the non-moving party and thus must assume that the persons to whom Choudhury sends cease and desist letters are in fact performing or teaching works that are identical or substantially similar to Choudhury's protected yoga sequence. Thus, the court cannot find that Choudhury has attempted to monopolize areas outside of the scope of his copyright, such as attempting to claim a copyright on the public domain asanas themselves or restricting yoga

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 (Cite as: 2005 WL 756558 (N.D.Cal.))

Page 8

instructors' ability to create yoga sequences that are not substantially similar to his own. Compare *Napster*, 239 F.3d at 1026-27 (plaintiffs merely attempting to police copyrights in MP3 music files) with *Practice Management*, 121 F.3d 520-21 (plaintiffs' copyright in compilation of public domain materials improperly extended by requiring licensing parties to use their compilation exclusively, whether or not other compilations were substantially similar).

Summary judgment for OSYU on copyright misuse is DENIED, and summary judgment for Choudhury on copyright misuse is GRANTED.

E. Trademark Invalidity

Finally, in its fourth motion for summary judgment, OSYU argues that Choudhury's trademark in the term BIKRAM YOGA is invalid due to genericness, and therefore OSYU members are not liable for trademark infringement. OSYU claims that the relevant consumer market perceives the term BIKRAM YOGA as a generic term that describes any standardized yoga exercise routine performed in a hot room. Choudhury responds that consumers continue to perceive the term BIKRAM YOGA as a source-identifying term that identifies the specific 26-asana Bikram yoga sequence that he developed and teaches.

A "generic" or "common descriptive" term is a term that does not refer to a specific type of product or service, but refers instead to the product or service itself. *Filipino Yellow Pages v. Asian Journal Pub.*, 198 F.3d 1143, 1147 (9th Cir.1999). In determining whether a term is generic, the Ninth Circuit often relies on the "who are you/what are you" test-if the name of the mark answers the question "who are you," the mark is considered valid, because it refers to a particular source of goods and services, but if the name of the mark answers the question "what are you," the mark would be considered generic because in that circumstance, it refers not only to one particular source of goods or services but all goods and services of that kind regardless of their origin. *Id.* at 1147.

Determining genericness is a question of fact. *Committee for Idaho's High Desert, Inc. v. Yost*, 92 F.3d 814, 821 (9th Cir.1996). The main factor to be considered is how "the relevant public," or the consumers interested in purchasing the goods and services at issue, perceive the mark at issue.*Id.*; *Self-Realization*

Fellowship Church v. Ananda Church of Self-Realization, 59 F.3d 902, 909 (9th Cir.1995); see also, e.g., 15 U.S.C. § 1064(3) (statutory test for genericness). Factors to be considered in making this determination include the plaintiff's own use of the mark, competitors' usage, dictionary definitions, media usage, testimony from others in the same field, and consumer surveys, among others. See, e.g., *Self-Realization*, 59 F.3d at 909; *Filipino Yellow Pages*, 198 F.3d at 1148, 1150-51; see also *2 McCarthy on Trademarks § 12:13-14*.

*10 While OSYU notes significant generic usage of the term in the media, at certain times by Choudhury himself, by other yoga practitioners and by consumers of yoga services, Choudhury presents contrary evidence showing source-identifying usage of the mark, proper usage of the mark by Choudhury and in other media outlets, and the lack of any dictionary definition for the term "BIKRAM YOGA ." Thus, it is simply not clear from the evidence presented, which includes Choudhury's use of the mark, competitors' use of the mark, media usage, and declarations from other yoga practitioners, whether the term "BIKRAM YOGA" signifies only the "species" of Choudhury's practice, or if it is instead used by the relevant public to connote the entire "genus" of standardized yoga sequences performed in a hot room. Thus, there are numerous questions of fact at issue which prevent the court from determining on summary judgment whether the BIKRAM YOGA mark is generic or not.

This issue thus is not appropriate for decision on summary judgment for either party and must be decided by the trier of fact. Cf. *Self-Realization*, 59 F.3d at 907 (summary judgment on genericness granted because owner of trademark produced no evidence showing non-generic use of mark).

F. Conclusion

OSYU's motions for summary judgment are DENIED. Choudhury's motion for summary judgment on the issue of copyright misuse is GRANTED. Choudhury's motion for summary judgment on the remaining issues is DENIED. This order fully adjudicates the matters listed at nos. 65, 67, 75, 94, 97, 110, 114, and 117 on the clerk's docket for this case.

IT IS SO ORDERED.

Not Reported in F.Supp.2d
Not Reported in F.Supp.2d, 2005 WL 756558 (N.D.Cal.), 74 U.S.P.Q.2d 1434
(Cite as: **2005 WL 756558 (N.D.Cal.)**)

Page 9

N.D.Cal.,2005.
Open Source Yoga Unity v. Choudhury
Not Reported in F.Supp.2d, 2005 WL 756558
(N.D.Cal.), 74 U.S.P.Q.2d 1434

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