

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

NEW COLT HOLDING CORP., *et al.*, :
 Plaintiffs, :
 :
 -vs- : Civ. No. 3:02cv173 (PCD)
 :
RJG HOLDINGS OF FLORIDA, INC, *et al.*,:
 Defendants. :

**RULINGS ON MOTION TO STRIKE PLAINTIFFS’ REPLY TO DEFENDANT’S FIRST,
THIRD AND FOURTH COUNTERCLAIMS AND PLAINTIFFS’
MOTION FOR LEAVE TO AMEND THEIR COMPLAINT**

Defendant AWA International Co. moves to strike portions of plaintiffs’ reply to its counterclaim for failure to comply with FED. R. CIV. P. 8. Plaintiff moves to amend its complaint. For the reasons set forth herein, defendant’s motion is denied and plaintiffs’ motion is granted in part.

I. MOTION TO STRIKE

Defendant moves to strike plaintiffs’ reply to three of its counterclaims as legally insufficient, immaterial and impertinent. Plaintiffs responded with a stipulation signed by defendant that it “be granted leave to file” an amended reply. In response to the stipulation, defendant argues that the stipulation does not directly address the motion and may not be construed as memorandum in opposition, thus its motion should be granted absent opposition.

In documents filed the same day, defendant filed documents both stipulating to the filing of an amended reply and seeking an order striking the reply. The stipulation constitutes a resolution of pleading deficiencies raised in the motion.¹ To date, plaintiff has not filed an amended reply.²

Defendant's motion is denied without prejudice to renewal should the amended reply fail to remedy any pleading deficiencies. Plaintiffs shall file their amended reply by September 27, 2002.

II. MOTION TO AMEND

Plaintiff moves to amend its complaint by adding two counts: the first a claim for trademark infringement of Colt's logo, and the second a claim for copyright infringement by the unlawful copying of a manual. Defendant RJG Holdings of Florida, Inc. argues that it would be prejudiced if plaintiff is granted leave to amend and that the copyright claim is futile as plaintiff has not satisfied the copyright registration requirement.

As a general matter, "[l]eave to file an amended complaint 'shall be freely given when justice so requires.'" *Milanese v. Rust-Oleum Corp.*, 244 F.3d 104, 110 (2d Cir. 2001)(quoting FED. R. CIV. P. 15(a)). Leave should not be denied in the absence of undue delay, bad faith, undue prejudice to the non-movant or futility. *Id.* Defendant incorrectly³ states that the discovery deadline is October 1, 2002, not December 16, 2002 as stated by plaintiffs. As such, defendant argues that the untimely filing would cause it undue prejudice in light of the additional discovery required on the added claims. *See Grace v. Rosenstock*, 228 F.3d 40, 53-54 (2d Cir. 2000); *Commander Oil Corp. v. Barlo Equip. Corp.*, 215 F.3d 321, 333 (2d Cir. 2000). As more than two months remain in the discovery period,

¹ As the stipulation resolves the motion, the merits of the motion are not reached.

² It is presumed that plaintiff's failure to file an amended reply manifests a misunderstanding that leave of this Court was required prior to filing. FED. R. CIV. P. 15(a) provides that "a party may amend [its] pleading only by leave of court or by written consent of the adverse party." The stipulation to amend the reply, signed by all relevant parties, satisfies the consent requirement. Plaintiff therefore could have amended its reply at that time without first seeking leave of this Court.

³ On May 7, 2002, in response to the report submitted by the parties pursuant to FED. R. CIV. P. 26(f), the discovery deadline was set to December 16, 2002.

defendant's objection to the amendment is without merit.

Although the claim of prejudice is without merit, the question of the futility of the proposed amendment is another matter. A plaintiff need not be granted leave to add an apparently futile claim. *See Grace v. Rosenstock*, 228 F.3d 40, 53 (2d Cir. 2000). Registration⁴ is a jurisdictional prerequisite to a claim of copyright infringement. *See* 17 U.S.C. § 411 (“no action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made in accordance with this title”). In the present case, the necessary materials have been filed with the Copyright Office but no certificate of registration has issued. Although plaintiff cites to cases purporting to authorize copyright infringement claims prior to the satisfaction of statutory registration requirements, the cases cited do not address the precedent of this Circuit indicating that “proper registration is a prerequisite to an action for infringement.” *Whimsicality, Inc. v. Rubie’s Costume Co., Inc.*, 891 F.2d 452, 453 (2d Cir. 1989); *see Morris v. Business Concepts, Inc.*, 259 F.3d 65, 68 (2d Cir. 2001). Read in conjunction with FED. R. CIV. P. 3, which provides that an “action is commenced by filing a complaint with the court,” this Court would be without jurisdiction to hear a claim of infringement on a copyright not yet registered. The addition of such a claim would therefore be futile.

⁴ In its reply, plaintiff argues that the question of whether the filing of an application along with the required deposit and fee satisfies the jurisdictional prerequisite for a claim of copyright infringement. 17 U.S.C. § 410(a) provides in relevant part that “[w]hen, *after examination*, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, *the Register shall register* the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office.” (Emphasis added). Plaintiff’s argument that a copyright is deemed registered on the filing of the application would render the express language of § 410(a) nugatory.

Plaintiffs are granted leave to amend their complaint to add the trademark infringement claim.

The amended complaint will be filed by October 4, 2002.

III. CONCLUSION

Defendant's motion to strike plaintiffs' reply to defendant's first, third and fourth counterclaims (Doc. No. 28) is **denied**. Plaintiffs' motion for leave to amend their complaint (Doc. No. 37) is **granted in part**.

SO ORDERED.

Dated at New Haven, Connecticut, September ____, 2002.

Peter C. Dorsey
United States District Judge