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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ROBERT JACOBSEN, Plaintiff, v. MATTHEW KATZER, et al., Defendants.	No. C-06-1905-JSW **[PROPOSED] ORDER DENYING DEFENDANTS MATTHEW KATZER AND KAMIND ASSOCIATES, INC.'S MOTIONS TO DISMISS FOR FAILURE TO STATE A CLAIM ON WHICH RELIEF CAN BE GRANTED, AND MOTION TO DISMISS FOR FAILURE TO JOIN A PARTY UNDER RULE 19 AND MOTION TO STRIKE AND MOTION FOR MORE DEFINITE STATEMENT** Courtroom: 2, 17th Floor Judge: Hon. Jeffrey S. White

Defendants Matthew Katzer and KAMIND Associates, Inc. seek to dismiss Counts 5, 8 and 10 for failure to state a claim on which relief can be granted. They seek to dismiss Counts 5 and 10 as preempted by federal copyright law. They also seek to dismiss Count 6 for failure to join a necessary party. They seek a more definite statement as to Count 9. They also seek to strike portions of the Amended Complaint, and to deny Plaintiff an opportunity to amend his Complaint again. Plaintiff opposes these motions. For the following reasons, the Court DENIES Defendants'

motion.

Counts 5, 8, and 10 state claims on which relief can be granted. For purposes of the 12(b)(6) motion, "[a]ll factual allegations set forth in the complaint are taken as true and construed in the light most favorable to [p]laintiff[]." Lee v. City of Los Angeles, 250 F.3d 668 (9th Cir. 2001) (citation, quotation omitted). The Court may not refer to documents outside the complaint unless the documents are attached to the complaint, the complaint necessarily relies upon them, or the Court takes judicial notice of matters of public record. Id. at 688-89. A claim should not be dismissed unless it appears that plaintiff can prove no set of facts which would entitle him to relief. Conley v. Gibson, 355 U.S. 41, 45-46 (1957). The Rule 12(b)(6) motion with respect to Count 5 is DENIED as an improper successive motion to dismiss, per Rule 12(g). Count 8 asserts copyright infringement either in the absence of a license or contract, outside the scope of a license, or after rescission of a contract. There has been no waiver as a matter of law. Count 10 seeks recovery through a constructive trust theory of any profits or benefits, outside those Plaintiff could obtain in copyright law, which Defendants received. Thus, the motion to dismiss Counts 5, 8, and 10 for failure to state a claim is DENIED

Counts 5 and 10 are not preempted by federal copyright law. For a state law claim to be preempted, (1) the subject matter of Jacobsen's claim must come within the subject matter of copyright, and (2) the rights Jacobsen asserts under California law must be equivalent to those created under the Copyright Act. Laws v. Sony Music Entm't, Inc., 448 F.3d 1134, 1139 (9th Cir. 2006). "If the state law claim includes an 'extra element' that makes the right asserted qualitatively different from those protected under the Copyright Act, the state law claim is not preempted by the Copyright Act." Altera Corp. v. Clear Logic, Inc., 424 F.3d 1079, 1089 (9th Cir. 2005). In Count 5 (§ 17200), several claims are asserted which are unlawful, unfair or fraudulent business practices, which caused Jacobsen to lose money or property. Thus, an extra element exists that makes the claim not equivalent to a right created under the Copyright Act. In Count 10, Jacobsen seeks recovery of any profits or benefits that Defendants have received – outside of those that could be obtained in copyright – as a result of unlawful use of Jacobsen's copyright. Thus, the

recovery is not equivalent to any right created under the Copyright Act, and Count 10 is not preempted. The motion to dismiss claims 5 and 10 as preempted is DENIED.

The motion to dismiss for failure to join a necessary party is DENIED as an improper successive motion to dismiss, per Rule 12(g).

The motion for a more definite statement is DENIED. Defendants can determine which JMRI trademarks are being used in a manner that violates federal trademark dilution laws.

The motion to strike is DENIED, in part because it is an improper successive motion to dismiss, and in part because the remedy to strike is drastic – and unneeded. With only one exception, Defendants have not identified with particularity why the complained-of sections need to be stricken as required by Rule 7(b). Thus, the motion is DENIED.

The motion to prohibit further amendments by Plaintiff is DENIED. Rule 15(a) states that leave to amend should be freely given, and Defendants admit that they believe Plaintiff has a breach of contract claim. This Court sees no reason to deny the amendment should Plaintiff seek it.

Dated:_____

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Hon. Jeffrey S. White
District Court Judge