

United States District Court
Northern District of California

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

YZ PRODUCTIONS, INC.,
Plaintiff,
v.
REDBUBBLE, INC.,
Defendant.

Case No. 20-CV-06615-LHK

**ORDER GRANTING MOTION TO
DISMISS WITH LEAVE TO AMEND**

Re: Dkt. No. 29

YZ Productions, Inc. (“Plaintiff”) sues Redbubble, Inc. (“Defendant”) for (1) trademark counterfeiting under 15 U.S.C. § 1114; (2) trademark infringement under 15 U.S.C. § 1114; (3) trademark infringement, trade dress infringement, and false designation of origin under 15 U.S.C. § 1125(a); (4) copyright infringement under 17 U.S.C. §§ 501 *et seq.*; (5) violation of the California Unfair Competition Law (“UCL”), Cal. Bus. & Prof. Code §§ 17200 *et seq.*; and (6) unfair competition under California common law. Before the Court is Defendant’s motion to dismiss Plaintiff’s contributory copyright infringement claim, contributory trademark infringement claim, trade dress infringement claim, and unfair competition claims. ECF No. 29.¹ Having

¹ Defendant’s motion to dismiss contains a notice of motion paginated separately from the memorandum of points and authorities in support of the motion. ECF No. 29 at 1–3. Civil Local

1 considered the parties' submissions, the relevant law, and the record in this case, the Court
2 GRANTS Defendant's motion to dismiss with leave to amend.

3 **I. BACKGROUND**

4 **A. Factual Background**

5 Plaintiff is a California corporation that operates YouTube channels and "engages in the
6 production, design, creation, distribution and sale of multimedia content." ECF No. 28 ("FAC") ¶
7 7. Plaintiff has more than thirteen million subscribers on YouTube and millions of subscribers and
8 followers on its social media channels. *Id.* ¶¶ 8–9.

9 Defendant is a Delaware corporation with its principal place of business in San Francisco,
10 California. *Id.* ¶ 6. Defendant owns and operates an e-commerce system that allows users to create
11 online storefronts on its website, www.redbubble.com. *Id.* ¶¶ 51–53.

12 Plaintiff is allegedly the "owner of all right, title and interest in and to" the REBECCA
13 ZAMOLO Trademark for the REBECCA ZAMOLO Goods. *Id.* ¶ 12. The REBECCA ZAMOLO
14 Trademark was registered with the U.S. Patent and Trademark Office ("USPTO") on June 30,
15 2020. *Id.* Ex. A. According to a printout from the USPTO Trademark Status & Document
16 Retrieval ("TSDR") Database, the REBECCA ZAMOLO goods consist of cosmetics, stickers and
17 transfers, blank journals, clothing, and on-line video journals. *Id.*

18 Plaintiff is allegedly the "owner of all right, title and interest in and to" the
19 GAMEMASTER Design Trademark for the GAMEMASTER Design Trademark Goods. FAC ¶
20 15. The GAMEMASTER Design Trademark was registered with the USPTO on August 4, 2020.
21 *Id.* Ex. A. According to a printout from the USPTO TSDR Database, the GAMEMASTER Design
22 Trademark Goods consist of clothing and advertising services. *Id.*

23 Plaintiff is allegedly the "owner of all right, title and interest in and to" the
24 GAMEMASTER Word Trademark for the GAMEMASTER Word Trademark Goods. FAC ¶ 18.
25 The GAMEMASTER Word Trademark was registered with the USPTO on January 7, 2020. *Id.*

26
27 _____
28 Rule 7-2(b) provides that the notice of motion and points and authorities should be contained in
one document with the same pagination.

1 Ex. A. According to a printout from the USPTO TSDR Database, the GAMEMASTER Word
2 Trademark Goods consist of clothing and advertising services. *Id.*

3 Plaintiff is allegedly the “owner of all right, title and interest in and to” the ZAMFAM
4 Trademark for the ZAMFAM Goods. FAC ¶ 20. The ZAMFAM Trademark application was filed
5 with the USPTO on December 4, 2019. *Id.* Ex. A. According to a printout from the USPTO TSDR
6 Database, the GAMEMASTER Word Trademark Goods consist of stickers and transfers, clothing,
7 and on-line video journals. *Id.* The Court refers collectively to the REBECCA ZAMOLO Goods,
8 the GAMEMASTER Design Trademark Goods, the GAMEMASTER Word Trademark Goods,
9 and the ZAMFAM Goods as the “YZ Goods.”

10 Additionally, Plaintiff is the author of several original works of art. Plaintiff is allegedly
11 the author of the following original works of art and photographs: “RZ Cupcake Pink/Teal,”
12 “Slays Hair,” “#ZAMFAM Sprinkles,” “ZAMFAM CROP Top,” “Slays,” and an original
13 photograph of Rebecca Zamolo. *Id.* ¶¶ 26, 30, 34, 37, 40. Plaintiff is the “owner of all right, title,
14 and interest in and to” the copyright and trade dress for these original works of art and
15 photographs, and Plaintiff has allegedly used these artworks and photographs on the YZ Goods.
16 *Id.* ¶¶ 27–28, 31–32, 35–36, 38–39, 41–42. The artworks “RZ Cupcake Pink/Teal” and “Slays
17 Hair” are both registered with the U.S. Copyright Office. *Id.* ¶¶ 29, 33; ECF No. 28-2 (“Ex. B”).

18 Plaintiff allegedly “has and continues to widely market and promote the YA Marks, YZ
19 Artworks and YZ Trade Dress” by displaying them on videos watched and clothing sold in the
20 United States. FAC ¶ 46. Plaintiff alleges that “the marks, images and trade dress have acquired
21 great value as specific identifiers of [Plaintiff’s] products and serve to identify and distinguish
22 [Plaintiff’s] products from those of others.” *Id.* ¶ 49. As a result, the marks, artworks, and trade
23 dress are allegedly “intellectual property assets of enormous value as symbols of YZ and its
24 quality products, reputation, and goodwill.” *Id.*

25 Plaintiff alleges that Defendant owns and operates an e-commerce system that allows users
26 to create online storefronts on its website. *Id.* ¶¶ 51–53. Plaintiff alleges that, in Defendant’s
27 ecommerce system, “infringing and counterfeit apparel and other goods displaying the YZ Marks,
28

1 YZ Artworks and Goods . . . are marketed, offered for sale, sold, created, and/or shipped to
2 consumers.” *Id.* ¶ 50. The goods for sale on Defendant’s website are allegedly in the same
3 categories as those present on Plaintiff’s website, such as paper goods, t-shirts, and hoodies. *Id.* ¶
4 57. The First Amended Complaint includes images with side-by-side comparisons of Plaintiff’s
5 goods and the goods for sale on Defendant’s website. *Id.* at 16–18.

6 Plaintiff alleges that “Defendant is directly involved in the sale of goods via its e-
7 commerce system and has direct control over and specific knowledge of the Infringing Goods
8 advertised or sold via that system.” *Id.* ¶ 52. Plaintiff bases this allegation on “Defendant’s
9 intimate involvement in the marketing, offering for sale, selling, producing, and/or shipping of the
10 goods, and other customer support provided . . . relating to the goods.” *Id.* ¶ 58. Moreover,
11 Defendant allegedly has the ability to remove products from its system and “even suspend or
12 terminate users’ storefronts.” *Id.* ¶ 53.

13 On February 5, 2020, Plaintiff allegedly notified Defendant of its infringement and
14 demanded that Defendant stop its unlawful activities. *Id.* ¶ 61. Plaintiff alleges that Defendant
15 continued to market, sell, and distribute the goods. *Id.* Plaintiff further alleges that the Defendant’s
16 acts have been “willful and deliberate” and that Defendant “has intentionally attempted to
17 capitalize on [Plaintiff’s] valuable reputation and customer goodwill . . . by using marks, images,
18 and trade dress that [are] the same as or confusingly similar to YZ Marks on or in connection with
19 Infringing Goods.” *Id.* ¶ 62. According to Plaintiff, Defendant’s acts have caused Plaintiff “to
20 suffer irreparable injury to its business.” *Id.* ¶ 66.

21 **B. Procedural History**

22 On September 21, 2020, Plaintiff filed the instant case against Defendant. ECF No. 1. On
23 January 15, 2021, Plaintiff filed the First Amended Complaint. FAC. Plaintiff brings six claims:
24 (1) trademark counterfeiting under 15 U.S.C. § 1114; (2) trademark infringement under 15 U.S.C.
25 § 1114; (3) trademark infringement, trade dress infringement, and false designation of origin under
26 15 U.S.C. § 1125(a); (4) copyright infringement under 17 U.S.C. §§ 501 *et seq.*; (5) violation of
27 the UCL; and (6) unfair competition under California common law. *Id.* ¶¶ 67–139.

1 On January 29, 2021, Defendant filed a motion to dismiss Plaintiff’s contributory
 2 copyright infringement claim, contributory trademark infringement claim, trade dress claim, and
 3 unfair competition claims. ECF No. 29 (“Mot.”). On February 12, 2021, Plaintiff filed an
 4 opposition. ECF No. 31 (“Opp’n”). On February 19, 2021, Defendant filed a reply. ECF No. 32
 5 (“Reply”). On March 23, 2021, Plaintiff filed a notice of supplemental authority. ECF No. 33. On
 6 May 20, 2021, Defendant filed a statement of recent decision. ECF No. 37.

7 **II. LEGAL STANDARD**

8 **A. Dismissal Pursuant to Federal Rule of Civil Procedure 12(b)(6)**

9 Rule 8(a) of the Federal Rules of Civil Procedure requires a complaint to include “a short
 10 and plain statement of the claim showing that the pleader is entitled to relief.” Fed. R. Civ. P. 8(a).
 11 A complaint that fails to meet this standard may be dismissed pursuant to Federal Rule of Civil
 12 Procedure 12(b)(6). Rule 8(a) requires a plaintiff to plead “enough facts to state a claim to relief
 13 that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). “A claim
 14 has facial plausibility when the plaintiff pleads factual content that allows the court to draw the
 15 reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556
 16 U.S. 662, 678 (2009). “The plausibility standard is not akin to a probability requirement, but it
 17 asks for more than a sheer possibility that a defendant has acted unlawfully.” *Id.* (internal
 18 quotation marks omitted). For purposes of ruling on a Rule 12(b)(6) motion, the Court “accept[s]
 19 factual allegations in the complaint as true and construe[s] the pleadings in the light most
 20 favorable to the nonmoving party.” *Manzarek v. St. Paul Fire & Marine Ins. Co.*, 519 F.3d 1025,
 21 1031 (9th Cir. 2008).

22 The Court, however, need not accept as true allegations contradicted by judicially
 23 noticeable facts, *see Shwarz v. United States*, 234 F.3d 428, 435 (9th Cir. 2000), and it “may look
 24 beyond the plaintiff’s complaint to matters of public record” without converting the Rule 12(b)(6)
 25 motion into a motion for summary judgment, *Shaw v. Hahn*, 56 F.3d 1128, 1129 n.1 (9th Cir.
 26 1995). Nor must the Court “assume the truth of legal conclusions merely because they are cast in
 27 the form of factual allegations.” *Fayer v. Vaughn*, 649 F.3d 1061, 1064 (9th Cir. 2011) (per

1 curiam) (quoting *W. Mining Council v. Watt*, 643 F.2d 618, 624 (9th Cir. 1981)). Mere
 2 “conclusory allegations of law and unwarranted inferences are insufficient to defeat a motion to
 3 dismiss.” *Adams v. Johnson*, 355 F.3d 1179, 1183 (9th Cir. 2004).

4 **B. Leave to Amend**

5 If the Court determines that a complaint should be dismissed, it must then decide whether
 6 to grant leave to amend. Under Rule 15(a) of the Federal Rules of Civil Procedure, leave to amend
 7 “shall be freely given when justice so requires,” bearing in mind “the underlying purpose of Rule
 8 15 to facilitate decisions on the merits, rather than on the pleadings or technicalities.” *Lopez v.*
 9 *Smith*, 203 F.3d 1122, 1127 (9th Cir. 2000) (en banc) (alterations and internal quotation marks
 10 omitted). When dismissing a complaint for failure to state a claim, “a district court should grant
 11 leave to amend even if no request to amend the pleading was made, unless it determines that the
 12 pleading could not possibly be cured by the allegation of other facts.” *Id.* at 1130 (internal
 13 quotation marks omitted). Accordingly, leave to amend generally shall be denied only if allowing
 14 amendment would unduly prejudice the opposing party, cause undue delay, or be futile, or if the
 15 moving party has acted in bad faith. *Leadsinger, Inc. v. BMG Music Publ’g*, 512 F.3d 522, 532
 16 (9th Cir. 2008).

17 **III. DISCUSSION**

18 Plaintiff brings six claims: (1) trademark counterfeiting under 15 U.S.C. § 1114; (2)
 19 trademark infringement under 15 U.S.C. § 1114; (3) trademark infringement, trade dress
 20 infringement, and false designation of origin under 15 U.S.C. § 1125(a); (4) copyright
 21 infringement under 17 U.S.C. §§ 501 *et. seq.*; (5) violation of the UCL; and (6) unfair competition
 22 under California common law. FAC ¶¶ 67–139.

23 Defendant moves to dismiss several causes of action in the First Amended Complaint.
 24 First, Defendant moves to dismiss Plaintiff’s claims for contributory copyright infringement and
 25 contributory trademark infringement. Second, Defendant moves to dismiss Plaintiff’s claim for
 26 trade dress infringement. Third, Defendant moves to dismiss both of Plaintiff’s unfair competition
 27 claims. The Court addresses each of these claims in turn.

1 **A. Contributory Infringement Claims**

2 Below the Court addresses Plaintiff’s contributory copyright infringement claim then
3 Plaintiff’s contributory trademark infringement claim.

4 **i. Contributory Copyright Infringement**

5 Defendant contends that Plaintiff fails to state a contributory copyright infringement claim
6 because Plaintiff fails to adequately allege that Defendant had actual knowledge of specific acts of
7 infringement. Mot. at 5. The Court agrees.

8 To state a claim for contributory copyright infringement, a plaintiff must allege that a
9 defendant “(1) has knowledge of a third party’s infringing activity, and (2) induces, causes or
10 materially contributes to the infringing conduct.” *Perfect 10, Inc. v. Visa Int’l Serv. Ass’n*, 494
11 F.3d 788, 795 (9th Cir. 2007) (internal quotation marks omitted). “To establish liability,” the
12 Ninth Circuit has said, “the first prong requires more than a generalized knowledge by [a
13 defendant] of the possibility of infringement” by a third party. *Luvdarts, LLC v. AT&T Mobility,*
14 *LLC*, 710 F.3d 1068, 1072 (9th Cir. 2013). Rather, “actual knowledge of specific acts of [third
15 party] infringement is required for contributory infringement liability.” *Id.* (internal quotation
16 marks omitted).

17 As Plaintiff contends, Opp’n at 1, a defendant who has “reason to know” also has the
18 requisite knowledge for contributory copyright infringement. *Ellison v. Robertson*, 357 F.3d 1072,
19 1076 (9th Cir. 2004). However, the defendant must have “reason to know” of *specific* acts of
20 infringement. *See id.* (concluding that a reasonable trier of fact could find that the defendant had
21 the requisite knowledge for contributory copyright infringement because complaints were sent to
22 the defendant about specific acts of infringement and the defendant thus had “reason to know” of
23 specific acts of infringement); *see also Perfect 10, Inc. v. Giganews, Inc.*, No. 11-CV-07098-AB,
24 2015 WL 1746406, at *5 (C.D. Cal. Mar. 6, 2015) (concluding that *Ellison* “is entirely consistent
25 with the litany of Ninth Circuit decisions . . . requi[ring] evidence that [the defendant has] specific
26 knowledge of specific infringing content”). Accordingly, Plaintiff must allege that Defendant
27 knew or had reason to know of specific acts of infringement.

1 Moreover, mere “conclusory allegations that [Defendant] had the required knowledge of
2 infringement are plainly insufficient.” *Luvdarts, LLC*, 710 F.3d at 1071. Plaintiff must allege facts
3 to support the conclusion that Defendant had “knowledge of specific acts of [third party]
4 infringement.” *Luvdarts, LLC*, 710 F.3d at 1071; *accord Epikhin v. Game Insight N. Am.*, No. 14-
5 CV-04383-LHK, 2015 WL 2412357, at *4 (N.D. Cal. May 20, 2015) (granting motion to dismiss
6 contributory copyright infringement claims because “Plaintiffs do not allege any facts in support
7 of the threadbare assertion that [Defendants] ‘had knowledge of the infringing acts’”).

8 In the First Amended Complaint, Plaintiff alleges that Plaintiff “notified Defendant of its
9 infringement.” FAC ¶ 61. Plaintiff also alleges that Defendant had “specific knowledge of the
10 Infringing Goods advertised or sold” through Defendant’s system. FAC ¶ 52. The Court addresses
11 the sufficiency of each allegation in turn.

12 First, Plaintiff alleges that Plaintiff “notified Defendant of its infringement.” FAC ¶ 61.
13 However, Plaintiff never alleges that Plaintiff notified Defendant of specific acts of infringement,
14 namely specific infringing products. *Id.* Because Plaintiff never alleges that Plaintiff notified
15 Defendant of specific infringing products, Plaintiff’s notice may have been simply a “generalized
16 notification that infringement is occurring,” which is insufficient to establish specific knowledge.
17 *See Luvdarts, LLC*, 710 F.3d at 1072–73 (holding that a notice containing a “list of titles” without
18 identifying “which of [the] titles were infringed, who infringed them, or when the infringement
19 occurred” was insufficient).

20 Plaintiff also alleges that Defendant had “specific knowledge of the Infringing Goods
21 advertised or sold” through Defendant’s system. FAC ¶ 52. However, Plaintiff’s allegation is
22 conclusory because Plaintiff does “not allege any facts in support of the threadbare assertion that
23 [Defendants] ‘had knowledge of the infringing acts.’” *Epikhin*, 2015 WL 2412357, at *4; *see also*
24 *Luvdarts, LLC*, 710 F.3d at 1071 (stating that “conclusory allegations that [Defendant] had the
25 required knowledge of infringement are plainly insufficient”).

26 Thus, the Court concludes that Plaintiff fails to adequately allege that Defendant had the
27 requisite specific knowledge of infringement. Accordingly, the Court GRANTS Defendant’s

1 motion to dismiss Plaintiff's cause of action for contributory copyright infringement. The Court
2 does so with leave to amend because amendment would not be futile, unduly prejudice the parties,
3 or cause undue delay, and Plaintiff has not acted in bad faith. *See Leadsinger*, 512 F.3d at 532.

4 **ii. Contributory Trademark Infringement**

5 Defendant further contends that Plaintiff failed to adequately allege the knowledge
6 required for Plaintiff's contributory trademark infringement claim. Mot. at 6. The Court agrees.

7 "The tests for [contributory] trademark infringement are even more difficult to satisfy than
8 those required to find [contributory] copyright infringement." *Perfect 10, Inc.*, 494 F.3d at 806.
9 The Ninth Circuit has recognized two bases for liability. *Id.* at 807. First, a defendant is liable for
10 contributory trademark infringement if the defendant has "'intentionally induced' the primary
11 infringer to infringe." *Id.* at 807 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 855
12 (1982)). In the instant case, the first basis for liability is not at issue because the First Amended
13 Complaint does not allege that Defendant intentionally induced any third party to infringe
14 Plaintiff's marks. Recognizing the insufficiency of the allegations in the First Amended
15 Complaint, Plaintiff's opposition advances an inducement theory for the first time. Opp'n at 3.
16 However, Plaintiff never makes allegations of inducement in the First Amended Complaint. The
17 Court declines to consider an allegation raised for the first time in opposition to the instant motion.
18 *See Schneider v. Cal. Dep't of Corr.*, 151 F.3d 1194, 1197 n.1 (9th Cir. 1998) ("In determining the
19 propriety of a Rule 12(b)(6) dismissal, a court may not look beyond the complaint to a plaintiff's
20 moving papers, such as a memorandum in opposition to a defendant's motion to dismiss."). Thus,
21 the Court does not consider inducement. Because the first basis for liability, inducement, is not at
22 issue here, the Court considers whether Plaintiff has made adequate allegations as to the second
23 basis for liability.

24 The second basis for liability varies depending upon whether the defendant supplies an
25 infringing product to an infringer or rather supplies a service to an infringer. *Lockheed Martin*
26 *Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 984 (9th Cir. 1999). In the instant case, Plaintiff
27 alleges that Defendant is the provider of an online marketplace on which third parties allegedly

1 create online storefronts and sell goods that infringe upon Plaintiff’s trademarks. FAC ¶¶ 50, 52.
2 Accordingly, Defendant provides a service, not a product, to the alleged infringers.

3 Where, as here, the defendant provides a service rather than a product to an infringer,
4 courts “consider the extent of control exercised by the defendant over the third party’s means of
5 infringement.” *Lockheed Martin Corp.*, 194 F.3d at 984. The plaintiff must establish that the
6 defendant “knew of acts of direct infringement and exercised the requisite level of control over the
7 means of infringement.” *Theta Chi Fraternity, Inc. v. Leland Stanford Junior Univ.*, 212 F. Supp.
8 3d 816, 825 (N.D. Cal. 2016). Accordingly, the Court considers in turn whether Plaintiff has
9 adequately alleged that Defendant (1) knew of acts of direct infringement, and (2) exercised the
10 requisite level of control over the means of infringement. *Id.*

11 First, as to whether Plaintiff has adequately alleged that Defendant “knew of acts of direct
12 infringement,” in an online marketplace setting, “a service provider must have more than a general
13 knowledge or reason to know that its service is being used to sell counterfeit goods. Some
14 contemporary knowledge of which particular listings are infringing or will infringe . . . is
15 necessary.” *Spy Phone Labs LLC v. Google Inc.*, No. 15-CV-03756-PSG, 2016 WL 1089267, at
16 *3 (N.D. Cal. Mar. 21, 2016); *see also Ripple Labs Inc. v. YouTube LLC*, No. 20-CV-02747-LB,
17 2020 WL 6822891, at *3 (N.D. Cal. Nov. 20, 2020) (holding that defendant must have
18 “contemporaneous knowledge of the infringing conduct and continued to supply its services”);
19 *Coach, Inc. v. Celco Customs Servs. Co.*, No. CV1110787MMMFMOX, 2014 WL 12573411, at
20 *17 (C.D. Cal. June 5, 2014) (holding that defendant must have “particularized knowledge” for a
21 contributory trademark infringement claim). Receiving “[n]otice of certain acts of infringements
22 does not imply generalized knowledge of—and liability for—others.” *Spy Phone Labs LLC.*, 2016
23 WL 1089267, at *3.

24 In the instant case, Plaintiff alleges that Defendant “know[s] or [has] reason to know that
25 [Defendant’s] system is used to market, offer for sale, sell, create, and/or distribute Infringing
26 Goods.” FAC ¶ 88. However, Plaintiff does not allege that Defendant had contemporary
27 knowledge of which particular postings on Defendant’s website infringed upon Plaintiff’s

1 trademarks.

2 Indeed, Plaintiff effectively concedes that its allegations are insufficient because Plaintiff
3 includes new facts in Plaintiff's opposition. Specifically, Plaintiff's opposition contends that "on
4 February 5, 2020, [Plaintiff] notified [Defendant] of the existence of [Plaintiff's] registered
5 trademarks and of specific products on its website that infringed [Plaintiff's] intellectual property,
6 and thus [Defendant] had reason to know that such acts would continue without Redbubble's
7 intervention." Opp'n at 4–5. However, the First Amended Complaint never alleges that Plaintiff
8 notified Defendant of "*specific* products on its website that infringed [Plaintiff's] intellectual
9 property." See FAC ¶ 61 (alleging that Plaintiff "notified Defendant of its infringement" without
10 alleging that Plaintiff notified Defendant of specific products). Accordingly, the Court declines to
11 consider an allegation raised for the first time in opposition to the instant motion. See *Schneider*,
12 151 F.3d at 1197 n.1 ("In determining the propriety of a Rule 12(b)(6) dismissal, a court may not
13 look beyond the complaint to a plaintiff's moving papers, such as a memorandum in opposition to
14 a defendant's motion to dismiss.").

15 In sum, because Plaintiff does not allege that Defendant had knowledge of specific acts of
16 infringement, the Court concludes that Plaintiff has not adequately alleged that Defendant "knew
17 of acts of direct infringement." See *Spy Phone Labs LLC*, 2016 WL 1089267, at *3 (granting
18 motion to dismiss because the plaintiff did not adequately allege that the defendant had
19 "contemporary knowledge of which particular listings are infringing or will infringe"); see also
20 *Coach, Inc.*, 2014 WL 12573411, at *17 (holding that defendant must have "particularized
21 knowledge" for a contributory trademark infringement claim).

22 Second, as to whether Plaintiff has adequately alleged that Defendant exercised the
23 requisite level of control over the means of infringement, Plaintiff contends that Defendant "has
24 direct control over its e-commerce system" and "has supervisory power over users of its e-
25 commerce system." Opp'n at 5; FAC ¶ 89. However, even assuming that Plaintiff's allegations as
26 to control are sufficient, Defendant must know "of acts of direct infringement *and* exercise[] the
27 requisite level of control over the means of infringement." *Spy Phone Labs LLC*, 2016 WL

1 1089267, at *3. In the instant case, Plaintiff has not plausibly alleged facts that establish that
 2 Defendant knew of specific acts of infringement. Accordingly, Plaintiff has not adequately alleged
 3 a contributory trademark infringement claim. Thus, the Court GRANTS Defendant's motion to
 4 dismiss Plaintiff's cause of action for contributory trademark infringement. The Court does so
 5 with leave to amend because amendment would not be futile, unduly prejudice the parties, or
 6 cause undue delay, and Plaintiff has not acted in bad faith. *See Leadsinger*, 512 F.3d at 532.

7 **B. Trade Dress Infringement Claim**

8 Defendant next argues that Plaintiff's trade dress infringement claim should be dismissed
 9 for two reasons. Mot. at 8. First, Defendant contends that Plaintiff fails to identify "the purported
 10 elements of its trade dresses in a manner that would allow the Court to evaluate whether they are
 11 functional." *Id.* at 9. Second, Defendant contends that Plaintiff's trade dress infringement claim
 12 impermissibly overlaps with Plaintiff's copyright theory. *Id.* The Court agrees with Defendant that
 13 Plaintiff fails to list the elements that constitute the alleged trade dress. Accordingly, the Court
 14 need not consider Defendant's second argument for dismissal.

15 A product's trade dress consists of "its total image and overall appearance; it includes
 16 'features such as size, shape, color, color combinations, texture, or graphics.'" *Kendall-Jackson*
 17 *Winery, Ltd. v. E. & J. Gallo Winery*, 150 F. 3d 1042, 1044 n.2 (9th Cir. 1998) (quoting *Vision*
 18 *Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 613 (9th Cir. 1989)). To state a claim for trade dress
 19 infringement, a plaintiff must allege that "(1) the trade dress is nonfunctional, (2) the trade dress
 20 has acquired secondary meaning, and (3) there is substantial likelihood of confusion between the
 21 plaintiff's and defendant's products." *Art Attacks Ink, LLC v. MGA Ent. Inc.*, 581 F.3d 1138, 1145
 22 (9th Cir. 2009) (citing *Disc Golf Ass'n v. Champion Discs*, 158 F.3d 1002, 1005 (9th Cir. 1998)).

23 Because trade dress claims involve intensely factual issues, "courts in this circuit have
 24 required trade dress plaintiffs, at the very least, to provide adequate notice by including in their
 25 complaint 'a complete recitation of the concrete elements of [their] alleged trade dress.'" *Arcsoft,*
 26 *Inc. v. Cyberlink Corp.*, 153 F. Supp. 3d 1057, 1070 (N.D. Cal. 2015) (quoting *Lepton Labs, LLC*
 27 *v. Walker*, 55 F. Supp. 3d 1230, 1240 (C.D. Cal. 2014)); *see also Bryant v. Matviessen*, 904 F.

1 Supp. 2d 1034, 1046 (E.D. Cal. 2012) (“In order to state a trade dress claim . . . , [Plaintiff] needs
2 to clearly define the specific elements that constitute the trade dress; a general description of the
3 site is insufficient”); *Salt Optics, Inc. v. Jand, Inc.*, No. 10-cv-00828, 2010 WL 4961702, at *4
4 (C.D. Cal. Nov. 19, 2010) (“A plaintiff must clearly articulate its claimed trade dress to give a
5 defendant sufficient notice”); *Sleep Sci. Partners v. Lieberman*, No. 08-cv-04200-CW, 2010 WL
6 1881770, at *3 (N.D. Cal. May 10, 2010) (“Without an adequate definition of the elements
7 compromising the website’s ‘look and feel,’ [Defendant] is not given adequate notice”); *Autodesk,*
8 *Inc. v. Dassault Systemes SolidWorks Corp.*, No. 08-cv-04397-WHA, 2008 WL 6742224, at *5
9 (N.D. Cal. Dec. 18, 2008) (“[Plaintiff] must provide more detail and clarify the total appearance of
10 the product that [Plaintiff] claims is the trade dress at issue”).

11 Moreover, courts in this circuit have held that “images and descriptions . . . of some . . .
12 products are alone insufficient to put [the defendant] on notice of the asserted trade dress”; rather,
13 a complete recitation of the concrete elements of the trade dress is required. *See, e.g., Crafty*
14 *Prods., Inc. v. Michaels Cos., Inc.*, 424 F. Supp. 3d 983, 991–92 (S.D. Cal. 2019), *aff’d sub nom.*
15 *Crafty Prods., Inc. v. Fuqing Sanxing Crafts Co.*, 839 F. App’x 95 (9th Cir. 2020) (dismissing
16 trade dress infringement claim because plaintiffs did “not clearly articulate[] their trade dress”
17 and, instead, “merely attach[ed] hundreds of images” to their complaint); *Mosaic Brands, Inc. v.*
18 *The Ridge Wallet LLC*, No. 220CV04556ABJCX, 2020 WL 5640233, at *5 (C.D. Cal. Sept. 3,
19 2020) (citations omitted) (dismissing trade dress infringement claim because images failed to
20 adequately identify plaintiff’s trade dress).

21 In the instant case, Plaintiff fails to list the concrete elements that constitute the alleged
22 trade dress. Plaintiff alleges that it “is the owner of all right, title and interest in and to” the “RZ
23 Cupcake Trade Dress,” the “Slays Hair Trade Dress,” the “ZAMFAM Trade Dress,” the “Slays
24 Trade Dress,” and the “RZ Photograph Trade Dress.” FAC ¶¶ 28, 32, 36, 39, 42. However,
25 Plaintiff does not include a “recitation of the concrete elements of [its] alleged trade dress[es].”
26 *Lepton Labs, LLC*, 55 F. Supp. 3d at 1240. Instead, Plaintiff merely attaches a list of images of the
27 alleged infringing goods offered for sale and sold on Defendant’s website. FAC ¶ 56. However,

1 images alone are insufficient to provide adequate notice. *See, e.g., Crafty Prods., Inc.*, 424 F.
 2 Supp. 3d at 991–92 (dismissing trade dress infringement claim because plaintiffs did “not clearly
 3 articulate[] their trade dress” and, instead, “merely attach[ed] hundreds of images” to their
 4 complaint); *Mosaic Brands, Inc.*, 2020 WL 5640233 at *5 (dismissing trade dress infringement
 5 claim because images failed to adequately identify plaintiff’s trade dress).

6 Rather, a complete recitation of the concrete elements of the trade dress is required to
 7 provide adequate notice to the defendant. *Arcsoft, Inc.*, 153 F. Supp. 3d at 1070 (granting motion
 8 to dismiss trade dress claim because “courts in this circuit have required trade dress plaintiffs, at
 9 the very least, to provide adequate notice by including in their complaint ‘a complete recitation of
 10 the concrete elements of [their] alleged trade dress’”); *Lepton Labs, LLC*, 55 F. Supp. 3d 1230,
 11 1240 (C.D. Cal. 2014) (granting motion to dismiss trade dress claim where plaintiff failed to
 12 provide “a complete recitation of the concrete elements of their alleged trade dress”).

13 Because Plaintiff fails to provide a recitation of the concrete elements of its trade dress, the
 14 Court GRANTS Defendant’s motion to dismiss Plaintiff’s trade dress claims. The Court does so
 15 with leave to amend because amendment would not be futile, unduly prejudice the parties, or
 16 cause undue delay, and Plaintiff has not acted in bad faith. *See Leadsinger*, 512 F.3d at 532.

17 **C. Unfair Competition Claims**

18 Defendant next moves to dismiss Plaintiff’s unfair competition claims. Mot. at 9.
 19 Defendant argues that these claims are barred by the Communications Decency Act (“CDA”), 47
 20 U.S.C. § 230. *Id.* The Court agrees.

21 The CDA aims to “preserve the vibrant and competitive free market that presently exists
 22 for the Internet and other interactive computer services, unfettered by Federal or State regulation.”
 23 47 U.S.C. § 230(b)(2). In pursuit of that goal, § 230 “immunizes providers of interactive computer
 24 services against liability arising from content created by third parties.” *Fair Hous. Council of San*
 25 *Fernando Valley v. Roommates.Com, LLC*, 521 F.3d 1157, 1162 (9th Cir. 2008) (en banc). The
 26 text of § 230(c)(1) specifically provides that “[n]o provider or user of an interactive computer
 27 service shall be treated as the publisher or speaker of any information provided by another

1 information content provider.” 47 U.S.C. § 230(c)(1). Pursuant to this statutory text, the Ninth
 2 Circuit has set forth a three element test for a defendant to receive § 230(c)(1) immunity. Section
 3 230(c)(1) “only protects from liability (1) a provider or user of an interactive computer service (2)
 4 whom a plaintiff seeks to treat . . . as a publisher or speaker (3) of information provided by another
 5 information content provider.” *Barnes v. Yahoo!, Inc.*, 570 F.3d 1096, 1100–01 (9th Cir. 2009), *as*
 6 *amended* (Sept. 28, 2009). However, the CDA’s grant of immunity does not apply where the
 7 interactive computer service provider is “also an ‘information content provider,’ which is defined
 8 as someone who is ‘responsible, in whole or in part, for the creation or development of’ the
 9 offending content.” *Roommates.Com, LLC*, 521 F.3d at 1162 (quoting 47 U.S.C. § 230(f)(3)).

10 In the instant case, Defendant contends that all three elements of the Ninth Circuit test are
 11 met. Mot. at 9. Plaintiff contends that the CDA’s grant of immunity does not apply here because
 12 Defendant is also an information content provider. The Court first addresses the three elements of
 13 the Ninth Circuit test then discusses Plaintiff’s contention that Defendant is an information content
 14 provider.

15 First, Plaintiff alleges that Defendant provides an interactive computer service. An
 16 “interactive computer service” is defined as “any information service, system, or access software
 17 provider that provides or enables computer access by multiple users to a computer server.” 47
 18 U.S.C. § 230(f)(2). Plaintiff alleges that Defendant operates an “ecommerce system” that allows
 19 users “to create online storefronts through which Infringing Goods are then marketed, offered for
 20 sale, and sold.” FAC ¶¶ 51–52. This allegation is enough to suggest that Defendant provides an
 21 “interactive computer service.” *See, e.g., Joseph v. Amazon.com, Inc.*, 46 F. Supp. 3d 1095, 1106
 22 (W.D. Wash. 2014) (finding Amazon.com to offer an “interactive computer service” because
 23 plaintiff “allege[d] that Amazon operates a website that allows consumers to purchase items
 24 online, i.e., to access [its] servers by placing orders”).

25 Second, Plaintiff alleges that Defendant is a publisher or speaker of information. In *La*
 26 *Park La Brea A LLC v. Airbnb, Inc.*, the court held that the plaintiff treated the defendant, Airbnb,
 27 as a publisher by alleging that Airbnb “facilitate[d] the posting of rental opportunities at the host’s

1 property, by providing the means for guests to locate and book host properties, and by processing
 2 payments from guests to hosts.” *La Park La Brea A LLC*, 285 F. Supp. 3d at 1106. Similarly, in
 3 the instant case, Plaintiff alleges that Defendant facilitates various online transactions between
 4 third parties by listing third party goods on Defendant’s platform. FAC ¶¶ 51–52. Accordingly,
 5 Plaintiff’s claims require the Court to treat Defendant as a publisher of information.

6 Third, Plaintiff alleges that the communications were provided by another content
 7 provider. The First Amended Complaint alleges that third party “users” “create online storefronts”
 8 through Defendant’s e-commerce system. FAC ¶ 52. Thus, the First Amended Complaint alleges
 9 that third party users use Defendant’s platform to market, offer for sale, and sell their products.
 10 Accordingly, the First Amended Complaint alleges that third party users are the ones providing the
 11 information at issue in the instant case.

12 Plaintiff alleges that Defendant is an information content provider because Defendant
 13 “providies [*sic*] the platform for the Infringing Goods, processes orders for the Infringing Goods
 14 placed by consumers, arranges for the manufacture of the Infringing Goods, arranges for shipping
 15 of the Infringing Goods, controls all customer service and return activities with the consumer, and
 16 pockets a significant portion of profits.” FAC ¶ 134. However, multiple courts in the Ninth Circuit
 17 have rejected the proposition that similar acts make a defendant an information content provider.
 18 *See, e.g., Free Kick Master LLC*, 140 F. Supp. 3d at 982 (rejecting argument that Amazon was a
 19 content provider because it profited from the alleged infringement, helped users set up profiles,
 20 and promoted and approved apps on the Amazon AppStore); *La Park La Brea A LLC*, 285 F.
 21 Supp. at 1104 (rejecting argument that Airbnb, an online hospitality marketplace, was a content
 22 provider because it provided user information verification, messaging systems, and a refund
 23 policy). Similarly, the Court concludes in the instant case that Plaintiff’s allegations do not suggest
 24 that Defendant is a content provider or an author of the challenged content.

25 In sum, the Court concludes that § 230 immunity applies because all three elements of the
 26 Ninth Circuit’s test are satisfied in the instant case. *See Barnes*, 570 F.3d at 1100–01 (9th Cir.
 27 2009) (stating that § 230 immunity protects “(1) a provider or user of an interactive computer

United States District Court
Northern District of California

1 service (2) whom a plaintiff seeks to treat . . . as a publisher or speaker (3) of information provided
2 by another information content provider”). Furthermore, the exception to § 230 immunity does
3 not apply because Plaintiff has not adequately alleged that Defendant is an information content
4 provider in the instant case. 47 U.S.C. § 230(f)(3). Because § 230 immunity bars Plaintiff’s unfair
5 competition claims, the Court GRANTS Defendant’s motion to dismiss Plaintiff’s unfair
6 competition claims. The Court grants leave to amend because amendment would not necessarily
7 be futile, unduly prejudice the parties, or cause undue delay, and Plaintiff has not acted in bad
8 faith. *See Leadsinger*, 512 F.3d at 532.


9 **IV. CONCLUSION**

10 For the foregoing reasons, the Court GRANTS Defendant’s motion to dismiss Plaintiff’s
11 contributory copyright infringement claim, contributory trademark infringement claim, trade dress
12 claim, and unfair competition claims with leave to amend. Plaintiff shall file any amended
13 complaint within 30 days of this Order. Failure to do so, or failure to cure deficiencies identified
14 herein or identified in the instant motion to dismiss, will result in dismissal of the deficient claims
15 with prejudice. Plaintiff may not add new causes of action or add new parties without stipulation
16 or leave of the Court. Plaintiff is directed to file a redlined complaint comparing the complaint to
17 any amended complaint as an attachment to Plaintiff’s amended complaint.

18 **IT IS SO ORDERED.**

19
20
21
22
23
24
25
26
27
28

Dated: June 24, 2021



LUCY H. KOH
United States District Judge