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15 **UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**  
16 (San Francisco Division)

17 THE MOCKINGBIRD FOUNDATION, INC.,  
18 Plaintiff,  
19 v.  
20 QUANG-TUAN LUONG.,  
21 Defendant.

Case No. 3:19-cv-05671-RS

**PLAINTIFF’S OPPOSITION TO  
MOTION TO DISMISS**

Hearing Date: March 19, 2020  
Hearing Time: 1:30 a.m.  
Courtroom: 3 – 17th Floor  
Judge: Honorable Richard Seeborg

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**INTRODUCTION**

1  
2  
3 Plaintiff The Mockingbird Foundation, Inc. (“Mockingbird”), a non-profit corporation based  
4 in California, filed this action for a declaratory judgment of noninfringement of copyright to protect  
5 its legal interests in response to a series of threatening letters, which became increasingly strident  
6 over the period from early April through the end of July 2019. In those letters, a California  
7 photographer, represented by a law firm that frequently threatens and sometimes brings infringement  
8 lawsuits, told Mockingbird that copyright infringement had occurred on a community forum it  
9 hosted. The letters demanded payment of \$2500 in damages because a member of the forum had  
10 posted a “deeplink” to a copyrighted photo; the letters threatened Mockingbird’s volunteer executive  
11 director, Ellis Godard, with garnishment of his wages, liens on his personal property, and  
12 quadrupling of his monetary exposure unless he gave in promptly. Upping the ante, Defendant’s  
13 counsel sent Godard a series of emails threatening to “escalate” the situation, finally sending him a  
14 draft complaint, prepared for filing against him personally in federal court in California, along with a  
15 warning that Defendant “has instructed us to file” the complaints by a certain date unless  
16 Mockingbird paid. Mockingbird, believing it had done no wrong, filed this action for a declaratory  
17 judgment, seeking to establish through application of longstanding Ninth Circuit precedent that  
18 deeplinking is not infringement and that, in any event, it could not be held liable for any  
19 infringement that might be committed by members of its forum without its “volitional” involvement.

20 But after Mockingbird found counsel and began to pursue this matter in court – just what  
21 Defendant had said that he would do if Mockingbird did not pay his price – Defendant began to  
22 backpedal. He told Mockingbird that he still considered deeplinks on Mockingbird’s forum to  
23 constitute a basis for holding it liable, but that he no longer wanted to litigate the question pertaining  
24 to the photograph that had occasioned his original threats to sue. Defendant offered a narrow license  
25 confined to just the one photograph mentioned in his original threats, but in the very same email as  
26 that offer, he told Mockingbird that he could hold it liable whenever deeplinks to his other  
27 photographs appeared on its forum.

1 Mockingbird was worried such a limited license would not protect it from future lawsuits by  
2 Defendant if other deeplinks were posted to any of his photographs by users of its forum. In fact, this  
3 same photographer, Luong, has threatened to sue other alleged infringers for long-past deeplinking.  
4 Therefore, citing *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013), Mockingbird told Defendant that it  
5 would drop its claim for declaratory relief if Defendant extended his license to past deeplinking to  
6 *any* of his images.

7 The narrow issue presented on Defendant’s pending motion to dismiss (“the Motion”),  
8 therefore, is whether, having created an actual controversy through repeated and concrete threats of  
9 imminent litigation, Defendant has now established that the present controversy cannot recur in light  
10 of the proffered license.<sup>1</sup> The governing precedent on this point is the Supreme Court’s decision in  
11 *Already, LLC v. Nike*—a case not cited in the motion to dismiss—which holds that voluntary  
12 cessation in response to litigation does not moot the litigation, unless the party claiming mootness  
13 satisfies its “formidable burden of showing that it is absolutely clear the allegedly wrongful behavior  
14 could not reasonably be expected to recur.” 568 U.S. at 91 (quoting *Friends of the Earth, Inc. v.*  
15 *Laidlaw Environmental Services, Inc.* 528 U.S. 167, 190 (2000)). As explained below, Defendant  
16 has not met that strict standard in this case.

## 17 **I. Statement of Facts<sup>2</sup>**

### 18 **A. Pre-Complaint Facts**

19 The Mockingbird Foundation, the plaintiff in this case, is a non-profit corporation, staffed

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20 <sup>1</sup> Defendant also styles his motion as one pursuant to Fed.R.Civ.P 12(b)(6), and acknowledges that  
21 all factual allegations in the complaint must be taken as true and all reasonable inferences drawn in  
22 favor of the nonmoving party. Motion at 8. But he does not appear to make any actual arguments  
23 that the complaint does not state a claim on which relief can be granted. Thus, this Opposition  
24 focuses on Defendant’s Rule 12(b)(1) case or controversy arguments.

25 <sup>2</sup> The facts in this section are taken from the First Amended Complaint and its exhibits, and from the  
26 affidavits of Mockingbird’s executive director Ellis Godard and counsel Paul Alan Levy that  
27 accompany this memorandum. Defendant’s Motion recites a number of facts without any citation to  
28 the record; many of those facts are neither alleged in the complaint nor supported by any affidavit or  
any other evidence in the record. Because the Motion is not based on disputing the veracity of the  
allegations in the complaint, but rather on developments after the complaint was filed, Defendant’s  
contentions must be supported by affidavits, which can be considered without transforming the

1 entirely by volunteers and based at the home of its executive director Ellis Godard in Moorpark,  
2 California. It was founded in 1996 by fans of the band Phish to raise funds through various Phish-  
3 related projects to benefit music education programs for children and young adults nationwide. In  
4 addition to its own web site at [www.mbird.org/](http://www.mbird.org/), it operates a web site at [Phish.net](http://Phish.net), which is devoted  
5 to compiling and preserving information about Phish’s music and history; it also includes forum for  
6 Phish fans to discuss music and other topics at [forum.phish.net/](http://forum.phish.net/) (“Phish.net forum”).

7 The discussion forum is organized into many separate threads, each of which contains  
8 multiple posts by users of the [Phish.net](http://Phish.net) forum. At the close of August 2019, there were nearly  
9 180,000 separate discussion threads on the forum, comprised of over 4.3 million individual posts,  
10 from over 16,000 users. FAC ¶ 14.

11 In 2017, a forum user started a new thread asking about whether Idaho was a good place to  
12 live. Another user responded by mentioning various parks in or near Idaho, including the Grand  
13 Teton National Park, and by providing deeplinks to photographs of those parks, including a deeplink  
14 to a photograph taken by defendant Luong. A deeplink is a hyperlink to another web site, not  
15 affiliated with the site where the link is posted, where images are stored and displayed. FAC ¶ 16.  
16 The link allows viewers of the forum to see the image within the forum by “pulling” the image  
17 directly from the remote server where it is hosted so that it is displayed to the viewers’ personal  
18 devices. *Id.* No copy of Defendant’s photograph was ever posted or maintained on the server for  
19 [Phish.net](http://Phish.net). FAC ¶ 16. Mockingbird did not post or encourage the posting of any of these links;  
20 indeed, it was unaware of the links on the forum posts until Defendant’s counsel wrote to it earlier  
21 this year. FAC ¶¶ 17-18.

22 Beginning in April and May of 2019, Godard received a series of threatening  
23 communications on behalf of Defendant from attorney Mathew Higbee. *See generally* FAC ¶¶ 22-  
24 29; Godard Aff. ¶ 3(a)-(h). The letters warned Godard that he was liable for copyright infringement  
25 based on the link posted to the Luong photograph and demanded payment of \$2500. FAC ¶¶ 22;

26 \_\_\_\_\_  
27 motion into one of summary judgment. *Safe Air for Everyone v. Meyer*, 373 F.3d 1035, 1039 (9th  
28 Cir. 2004).

1 Godard Aff. ¶ 3(a),(b) and Exs. 1, 3. They warned Godard that if he did not promptly pay as  
2 demanded, Defendant could seek wage garnishments, liens on his property, and the quadrupling of  
3 his monetary exposure. FAC ¶¶ 23, 26; Godard Aff. ¶ 3(a) and Ex. 1.

4 The first letter was mailed to the wrong address and never received. Godard Aff. Exs. 1, 3.  
5 But the Higbee firm followed up with an email on April 8 that stated: “If you are a non-commercial  
6 entity (meaning you do derive income from the website) or if you do not do business in the US,  
7 please let us know as you are probably receiving this letter in error.” Godard Aff. Ex. 2. Godard  
8 responded that same date, explaining promptly that Mockingbird was a nonprofit group, that the  
9 claimed infringement was by a member of the forum on Phish.net for which Mockingbird could not  
10 be held liable, and in any event that Mockingbird had counsel who would weigh in on the issue.  
11 Godard Aff. Ex. 3.

12 A month later, on May 7, despite his statement that he was engaging Mockingbird’s counsel  
13 in the matter, Godard received another letter from Defendant’s counsel, repeating the threats of wage  
14 garnishments, liens on his property, and the quadrupling of his monetary exposure. Godard Aff. Ex.  
15 4. On May 7 and 9, Godard received additional communications from Defendant’s counsel’s firm  
16 stating he had “a limited amount of time to settle... before the litigation team takes over.” Godard  
17 Aff. Ex. 5. An email to Godard accompanying the letter said Mockingbird’s non-profit status did not  
18 matter (even though the previous email, Godard Aff. Ex. 2, had said non-commercial entities were  
19 not intended to be targeted) because the unauthorized use of the image could have caused damages.  
20 Godard Aff. Ex. 5. At this point, Mockingbird responded through counsel, noting by letter dated  
21 May 13 that it was Mockingbird that operates the web site about which Luong was complaining; that  
22 the alleged infringement was only an embedded link back to Luong’s own web site; that in any event  
23 the link was not posted by any officer, director or representative of the Foundation, hence the  
24 Foundation could not be held liable; and that the link was being taken down. Godard Aff. Ex. 6.

25 Defendant, however, continued to insist he had a claim and would take action against Godard  
26 and Mockingbird, sending a series of threatening emails. Despite the fact that Mockingbird’s  
27 counsel Mr. Paolini had now entered the fray by his letter to Mr. Higbee, Godard personally  
28



1 received two more emails, on May 13 and May 15, acknowledging receipt of the letter from counsel,  
2 and also demanding that Mockingbird arrange to have the photo removed from Luong’s own Terra  
3 Galleria web site. Godard Aff. Ex. 7. Defendant’s counsel sent another letter to Godard on July 9  
4 threatening him with “statutory damages of up to \$150,000 for each infringement” as well as costs  
5 and attorney fees. FAC Ex. C; Godard Aff. Ex. 8. This letter included a draft complaint prepared for  
6 filing in California federal court. *Id.* Defendant’s counsel said his client had instructed him to file  
7 this suit unless he received \$2500 within fifteen days. *Id.* Although the demand letters had only cited  
8 one specific photograph, the draft complaint sought relief against alleged infringement of “all  
9 copyrighted works” of Defendant. *Id.*

10 Not only did Mockingbird believe that it had done nothing wrong,<sup>3</sup> but it also understood that  
11 Defendant’s claims could represent only the tip of the iceberg. Godard Aff. ¶¶ 6, 9. With millions of  
12 posts on the forum, Mockingbird had no way to tell whether this was the only Luong photograph  
13 that had been linked or whether there were others. Therefore, Mockingbird filed this action for a  
14 declaratory judgment asking the Court to declare both that deeplinking on its forum does not  
15 constitute infringement, and that postings in which it had no volitional involvement could not be the  
16 basis for claims that it was personally liable for infringement. FAC Prayer for Relief.

17 At no time did the Higbee firm respond that its client had decided to drop his claims. Mr.  
18 Higbee has claimed in an email and in a brief that his client made that decision, but the Motion  
19 provides no evidence to support that contention. When Mockingbird filed its complaint for a  
20 declaratory judgment on September 9, 2019, it had been less than two months since Mr. Paolini’s  
21 last letter to Mr. Higbee and barely two months since its last threat to Godard — a lapse comparable  
22 to the time between the spate of May 2019 threats and the July 7 threat. Mockingbird believed that  
23 it needed the Court’s protection.

24 \_\_\_\_\_  
25 <sup>3</sup> The Ninth Circuit has held that deeplinking to a photograph does not constitute an infringing  
26 “display” of the photograph, *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1161 (9th Cir.  
27 2007), and that the host of a user forum cannot be held liable for infringement by users of his forum  
28 so long as he did not engage in any “volitional act” to cause the infringement to occur. *VHT, Inc. v.*  
*Zillow Group*, 918 F.3d 723, 732, 745-47 (9th Cir. 2019).

**B. Developments After the Complaint Was Filed**

1 Mockingbird filed its initial complaint for a declaratory judgment on September 9, 2019.  
2 Defendant's initial response to the complaint was to propose to simplify the litigation and yet, at the  
3 same time, ensure that the legal issues in the case would be decided in this Court and on appeal.  
4 Levy Aff. ¶ 5. Defendant offered to cooperate with Mockingbird to stipulate the facts, leaving only  
5 legal issues to be decided, but on the condition that Mockingbird would drop its claim for attorney  
6 fees. *Id.* With its volunteer leadership having been subjected to serious threat of personal liability by  
7 Defendant's repeated demands and insistent threats of suit, and forced to file a complaint in this  
8 Court, Mockingbird rejected the condition that it surrender *its* monetary claims against the  
9 photographer whose threats were severely disruptive and disturbing.

10 Defendant's counsel responded by email on November 1: He insisted that the deeplinking on  
11 Mockingbird's forum was infringement, claiming that the Ninth Circuit was wrong and that its  
12 decisions on deeplinking and volition were distinguishable. Levy Aff. Ex. B. But he claimed that his  
13 client had lost interest in pursuing the case because, he said, his firm had decided months earlier that  
14 Mockingbird was currently judgment proof and hence his client lacked the financial incentive to  
15 pursue litigation against Mockingbird in which they could not recover any money.<sup>4</sup> *Id.* Therefore,  
16 counsel stated that his client was issuing a license to allow the use that had been made of the  
17 photograph on the Phish.net forum, and he demanded that the suit be dismissed. *Id.*

18 This offer, however, did not sufficiently protect Mockingbird's legal interests. Mockingbird  
19 hosts a forum with millions of posts, quite possibly including deeplinks to other photographs taken  
20 by Luong. In addition, in a number of past cases, Higbee – on behalf of multiple clients, including  
21 Luong – had warned alleged infringers of his clients' copyrights that they could be sued for alleged  
22 infringement that had occurred several years before. Levy Aff. ¶ 12 and Exs. H, I. In fact, implicit in  
23 Mr. Higbee's November 1 email was a broader threat for posting of any of Luong's other  
24

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25 <sup>4</sup> Mr. Higbee's unsworn contention that his investigation determined that Mockingbird is judgment  
26 proof, and that this is why his clients decided not to proceed, is a dubious one. Because  
27 Mockingbird is a 501(c)(3) nonprofit, it files a Form 990 that is publicly available on the web site  
28 Guidestar.org. Had Mr. Higbee actually performed the investigation he claims to have done, he  
would have learned that Mockingbird Foundation is not judgment proof.

1 photographs. Levy Aff. ¶ 6 and Ex. B. The proffered license from Defendant would allow him to  
2 walk away from this case while preserving his ability to return, perhaps again and again, to threaten  
3 and sue Mockingbird down the road. FAC ¶¶ 14, 32; *see also* Godard Aff. ¶¶ 5-6, 9.

4 Accordingly, Plaintiff’s counsel sent Mr. Higbee a letter dated November 6, citing the  
5 Supreme Court’s ruling in *Already, Inc. v. Nike* and explaining that the offered license did not meet  
6 the standard for mootness based on voluntary cessation of wrongful conduct: The defendant bears  
7 the “formidable burden” of showing that it is “absolutely clear” the controversy between the parties  
8 is over. 568 U.S. at 91; Levy Aff. ¶ 7 and Ex. C. Given that Defendant’s counsel had insisted that  
9 deeplinking on a forum constitutes infringement for which the host is liable notwithstanding lack of  
10 knowledge or volition, Mockingbird could reasonably expect that the threats would recur and Luong  
11 would sue it in the future. Thus, in order to ensure that threats and litigation over deeplinking of  
12 Defendant’s photographs would not recur, Mockingbird needed a license that covered deeplinks to  
13 any of Defendant’s photographs, not just the one that was the basis for the initial threats. Godard  
14 Aff. ¶¶ 5-6, 9. At no time did Mockingbird suggest that it needed a license for photographs from any  
15 photographers other than Defendant.

16 By email dated November 7, Mr. Higbee slightly expanded the license his client was  
17 granting to Mockingbird, allowing the specific photograph to be used on any subdomain associated  
18 with the Phish.net forum, not just the forum pages on which it originally appeared. Levy Aff. ¶ 9 and  
19 Ex. D. By letter dated November 8, Mockingbird declined to dismiss its lawsuit. Instead, it asked  
20 again that Defendant issue a license or a covenant not to sue that extended to any deeplinking of  
21 Defendant’s photographs that had already occurred or may occur in the future on the Phish.net  
22 forum. Plaintiff amended its complaint to specifically delineate the case or controversy that remains  
23 in the case — whether Mockingbird can be liable for copyright infringement for the posting of any  
24 deeplinks to any of Luong’s photographs now or in the future.

**ARGUMENT**

1  
2 The principle, reiterated in Defendant’s Motion, that a live case or controversy must exist  
3 throughout a litigation, is uncontested. When, however, a defendant relies on action it took to moot  
4 an ongoing case in which there was a concrete dispute at the outset of the litigation, that defendant  
5 must meet the far more rigorous standard of showing that his voluntary cessation was effective to  
6 moot the case. Under the governing Supreme Court precedent, *Already, LLC v. Nike, Inc.*, 568 U.S.  
7 85 (2013), for voluntary cessation of wrongful conduct to render a case moot, the defendant bears  
8 the “formidable burden” of showing it is “absolutely clear” that the controversy between the parties  
9 cannot be expected to recur. *Id.* at 91. Not only does Defendant’s Motion not meet that standard, but  
10 his brief does not mention *Already v. Nike* or attempt to explain how he can meet the standard.  
11 Defendant should not be permitted to address that case for the first time in his reply brief.  
12

**II. There Was A Case or Controversy Between the Parties When Plaintiff Filed This Lawsuit**

13  
14  
15 Defendant’s repeated threats to sue Mockingbird undoubtedly created a concrete controversy  
16 between the parties. The Declaratory Judgment Act provides that, “[i]n a case of actual controversy  
17 within its jurisdiction... any court of the United States... may declare the rights and other legal  
18 relations of any interested party seeking such declaration, whether or not further relief is or could be  
19 sought.” 28 U.S.C. § 2201(a). The dispute must be “real and substantial” and “definite and concrete,  
20 touching the legal relations of parties having adverse legal interests[.]” *MedImmune, Inc. v.*  
21 *Genentech, Inc.*, 549 U.S. 118, 127 (2007). As this courts in this Circuit have explained, a plaintiff  
22 seeking declaratory judgment must show (1) a “real and reasonable” apprehension that he will be  
23 subject to liability; and (2) that the apprehension was “caused by the defendant’s actions.” *Cabell v.*  
24 *Zorro Prods. Inc.*, No. 5:15-CV-00771-EJD, 2018 WL 2183236, at \*14 (N.D. Cal. May 11, 2018)  
25 (citing *Hal Roach Studios, Inc. v. Richard Feiner & Co.*, 896 F.2d 1542, 1556 (9th Cir. 1989)).  
26 Courts must apply these principles “with a flexibility that is oriented to the reasonable perceptions of  
27  
28

1 the plaintiff.” *Id.* (citing *Chesebrough-Pond’s, Inc. v. Faberge, Inc.*, 666 F.2d 393, 396 (9th Cir.  
2 1982)).

3 The Ninth Circuit has held that a wide variety of conduct by the defendant in a declaratory  
4 judgment action, even if well short of threatening litigation, is sufficient to sustain a legal case or  
5 controversy. Of course, “[i]f a party has threatened another with suit, there is generally a substantial  
6 and immediate controversy.” *Wong v. Hard Drive Prods., Inc.*, No. 12-CV-469-YGR, 2012 WL  
7 1252710, at \*3 (N.D. Cal. Apr. 13, 2012) (citing *Massa v. Jiffy Products Co.*, 240 F.2d 702, 705 (9th  
8 Cir. 1957)). But “even where a party has stated that it has no plans to sue for infringement, if its  
9 course of conduct demonstrates a preparedness and willingness to enforce its rights otherwise, a case  
10 or controversy exists.” *Id.* (citing *SanDisk Corp. v. STMicroelectronics, Inc.*, 480 F.3d 1372, 1382-  
11 83 (Fed. Cir. 2007)); *see also Societe de Conditionnement v. Hunter Engineering Co.*, 655 F.2d 938  
12 (9th Cir. 1981) (holding that the standard for a case or controversy to exist for declaratory relief is  
13 “less strict than an actual threat of litigation”); *Chesebrough–Pond’s*, 666 F.2d at 397 (holding that a  
14 threat of filing an opposition proceeding in the Patent and Trademark Office, although not  
15 threatening litigation, was enough to create a “real and reasonable apprehension” of infringement  
16 litigation). Even something “less than a cease and desist letter threatening a lawsuit can create a  
17 reasonable apprehension of liability.” *Freecycle sunnyvale v. Freecycle Network, Inc.*, No. C 06-  
18 00324CW, 2006 WL 870688, at \*3 (N.D. Cal. Apr. 4, 2006); *see Hal Roach Studios*, 896 F.2d at  
19 1556 (applying “to declaratory relief actions which involve... infringement of a copyright” the  
20 principle that if a declaratory judgment plaintiff is engaged in the questioned conduct, “the showing  
21 of apprehension need not be substantial”) (internal citations omitted).

22 Here, the threat of litigation is express, repeated, clear, and unmistakable. Defendant created  
23 a “real and reasonable apprehension” of liability by sending multiple letters to Mockingbird and its  
24 executive director explicitly threatening suit over a period of months, and further enhancing the  
25 imminence of those threats through draft settlement agreements and draft complaints. Five instances  
26 of Defendant’s conduct make clear that the instant dispute presents a clear-cut case or controversy:

1 First, Defendant stated in his first demand letter to Mockingbird, and reiterated in every  
2 subsequent letter, Defendant's belief that Mockingbird had infringed Defendant's copyright. *See*  
3 FAC Ex. A ("If The Mockingbird Foundation does not have a license, we believe the use of the  
4 work is a violation of the Copyright Act, Title 17 of the United States Code."); FAC Ex. A ("If  
5 PHISH.NET does not have a license, we believe the use of the work is a violation of the Copyright  
6 Act, Title 17 of the United States Code."); FAC Ex. C ("Ellis Goddard d/b/a phish.net engaged in  
7 copyright infringement when it posted our client's copyrighted image on its website without a valid  
8 licensing agreement.").

9 Second, each time Defendant asserted his belief that Mockingbird had infringed Defendant's  
10 copyright, Defendant also made an unequivocal threat to litigate against Mockingbird. *See* FAC Ex.  
11 A ("[W]ithout your cooperation, our only option is to litigate the matter, which we frequently [sic]  
12 do, so please do not make the mistake of ignoring this.").

13 Third, Defendant stressed the imminence of his threats by giving Mockingbird a concrete and  
14 extremely short timeframe to comply – 10 days in two letters and 15 days in another, but each  
15 carried the clear implication that Defendant afterward would initiate infringement litigation. FAC  
16 Ex. A ("*If we do not hear from you within 10 days, we will assume that you do not have a license*  
17 *and that you do not want to resolve this matter outside of court*") (emphasis in original); FAC Ex. C  
18 ("This [settlement] offer will be open for fifteen (15) days from the date of this letter, after which  
19 our client has instructed use to file the enclosed Complaint and seek damages to the full extent of the  
20 law.")

21 Fourth, Defendant further confirmed that he would respond with litigation to Mockingbird's  
22 failure to accept his demands by sending to Mockingbird a concrete and specific document – a  
23 settlement and release-from-liability agreement – which would only have been necessary if the  
24 Defendant intended to bring suit to enforce his copyright if Mockingbird did not agree to  
25 Defendant's license terms. *See* FAC Ex. B.

26 Fifth, in the most unmistakable signal that litigation was imminent, Defendant sent a draft  
27 complaint to Mockingbird, after months of back and forth over their initial demand letters, which  
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1 accused Mockingbird of copyright infringement and sought up to \$150,000 in damages as well as  
2 attorney fees. Despite the fact that Mockingbird had already removed from the forum the deeplink to  
3 Defendant’s photograph, the draft complaint sought broad injunctive relief against infringement of  
4 the copyright not just in the specific works named in the threats but in “*all* copyrighted works of the  
5 Plaintiff.” FAC Ex. C, Prayer for Relief; Godard Aff. Ex. 8. Thus, although the demand letters  
6 began by citing only one photograph, the lawsuit that Defendant threatened to file sought protection  
7 against alleged infringement of the entire body of Defendant’s work. Even more unmistakable was  
8 the threat in the cover letter and email sent with the draft complaint: that Defendant had instructed  
9 his counsel to file suit unless Mockingbird paid \$2,500 to Luong within fifteen days. FAC Ex. C.  
10 Godard Aff. ¶ 3(h) and Ex. 8.

11       None of the above threats of litigation had in any way been withdrawn by the time  
12 Mockingbird filed this action. Moreover, Mockingbird and his counsel knew Defendant’s counsel  
13 was well-known for often sending these sorts of demand letters alleging copyright infringement, and  
14 that he does file suit in such cases. “The fact that Defendant contacted plaintiff through counsel with  
15 such a reputation further supports finding that plaintiff acted out of a real and reasonable  
16 apprehension of facing suit by Defendant.” *Expensify, Inc. v. White*, No. 19-cv-018921-PJH, 2019  
17 WL 5295064, at \*4 (N.D. Cal. Oct. 18, 2019) (finding business threatened with an ADA suit had a  
18 reasonable fear of suit because opposing counsel’s firm “is a leading filer of ADA claims”). Because  
19 “defense counsel’s prelitigation communications, *reputation*, and *specialized practice*” all contribute  
20 to the circumstances surrounding prelitigation events that determine whether there is a reasonable  
21 apprehension of suit, *id.* at \*3 (emphasis added), Mockingbird surely had a reasonable expectation  
22 that it would be sued – and thus a sound justification to request a declaratory judgement – when it  
23 received these threats from defense counsel’s law firm.

24       This set of extensive and highly specific threats more than satisfies the requirements of any  
25 of the cases set forth above for finding the existence of a “substantial and immediate controversy.”  
26 One would be hard pressed to imagine a course of conduct that would more clearly and concretely  
27 provide a declaratory judgment plaintiff with a “real and reasonable” apprehension that it will be  
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1 subject to liability. Indeed, in *Chesebrough-Pond's*, 666 F.2d at 396, the Ninth Circuit found a case  
2 or controversy on the basis of a single letter from the defendant to the plaintiff stating a prima facie  
3 case for trademark infringement and threatening an opposition proceeding before the Patent and  
4 Trademark Office. Here, the Defendant sent multiple such letters that threatened actual litigation  
5 instead of an opposition proceeding, plus a draft complaint. Defendant's direct and repeated threats  
6 more closely resemble those of the declaratory judgment defendant in *Shloss v. Sweeney*, whose  
7 "reiterat[ion]" of "clear, if implicit, threats of litigation... easily left Plaintiff with a reasonable  
8 apprehension of copyright liability," 515 F. Supp. 2d 1068, 1077 (N.D. Cal. 2007), though in the  
9 instant case, Defendant' threats were even more explicit.<sup>5</sup>

10 Defendant's conduct easily vaults over the bar for creating a "real and reasonable  
11 apprehension" of liability for the deeplink to that single photograph at the time the initial complaint  
12 was filed and until at least Defendant's November 1 offer of a limited license for the Grand Teton  
13 photograph. The Motion's limited basis for disputing the existence of a case or controversy before  
14 that offer is that two months passed between Defendant's last threat to sue Mockingbird and the  
15 filing of the complaint. Motion at 12-13. But the motion does not dispute that Defendant never  
16 withdrew his multiple threats to sue until after Mockingbird commenced this action for declaratory  
17 relief, and that the series of legal threats had extended over a three and a half month period. See  
18 FAC ¶¶ 22, 29; Ex. A & C. Moreover, in his communications with Mockingbird's counsel after this  
19 litigation began, Defendant's counsel expressly retained the right for Defendant to sue over any of  
20 Defendant's other photographs that may be deeplinked on Mockingbird's forum.<sup>6</sup> Levy Aff. ¶ 7 and  
21 Ex. C; FAC ¶ 31.

22  
23 <sup>5</sup> In *Shloss vs. Sweeney*, the court also held that the defective covenant not to sue contributed to the  
24 creation of a real and reasonable apprehension of copyright liability. 515 F. Supp. 2d at 1078. This  
25 Opposition addresses why Defendant's proposed licenses do not moot the controversy in the next  
section.

26 <sup>6</sup> The existence of a clear and ongoing case or controversy is further demonstrated by defense  
27 counsel's November 1, 2019, email that first offered limited licenses, which said in part, "[s]eeing as  
[the license offer] removes any controversy, we ask that your clients withdraw their complaints or  
28 provide a legal basis to maintain the action." (emphasis added). Levy Aff. ¶ 6 and Ex. B.



1 The Motion relies on a single case, *Manning v. Dimech*, No. CV 15-05762 RSWL (PJWx),  
2 2015 WL 9581795 at \*5 (C.D. Cal. Dec. 30, 2015), to suggest that there was never a case or  
3 controversy here. Motion at 11-12. But the very different facts in *Manning* only serve to demonstrate  
4 how concrete and immediate the threat to Mockingbird was. The declaratory judgment plaintiff in  
5 *Manning* rested its argument on conclusory and threadbare assertions such as “an actual controversy  
6 exists by way of the Defendants’ credible threat of immediate litigation” that the court found failed  
7 to state a claim because “Plaintiff does not support this contention with any evidence or supporting  
8 factual allegations.” *Id.* at \*5. Unlike that complaint, which had no statement of facts and made only  
9 a few vague factual allegations, Complaint for Declaratory Judgment at 1-2, *Manning*, 2015 WL  
10 9581795, the FAC in this case alleges in extensive detail, with supporting documentation, the  
11 specific and repeated threats by Defendant to sue Mockingbird. The Godard Affidavit, filed with this  
12 Opposition, shows the evidentiary basis for these allegations in the First Amended Complaint.

13 Finally, the Motion claims that because Mockingbird – in a declaratory judgment action –  
14 requests only declaratory relief and not injunctive relief or damages, it has no standing. Motion at  
15 10-11. But as the First Amended Complaint makes clear, Mockingbird seeks resolution of the  
16 controversy created by Defendant’s direct and repeated threats to sue Mockingbird for alleged  
17 copyright infringement occurring on its forum. Relief from such uncertainty and insecurity over the  
18 imminent threat of suit is exactly what declaratory judgment actions are intended to provide. *See,*  
19 *e.g., Noll v. eBay, Inc.*, 282 F.R.D. 462, 469 (N.D. Cal. 2012) (Davila, J.) (quoting *McGraw–Edison*  
20 *Co. v. Performed Line Products Co.*, 362 F.2d 339, 342 (9th Cir.1966) (declining to dismiss a  
21 declaratory judgment action that will “clarify[] and settle[] the legal relations in issue” and  
22 “terminate and afford relief from the uncertainty, insecurity, and controversy giving rise to the  
23 proceeding.”)).

1 **III. Defendant’s Belated Offer of a Limited License After Litigation Had Commenced Does**  
2 **Not Constitute the “Voluntary Cessation” Required to Eliminate This Case or**  
3 **Controversy**

4 Defendant has failed to meet his “formidable burden” of demonstrating that the license he  
5 offered meets the standard required to moot this case by voluntary cessation. *Friends of the Earth*,  
6 528 U.S. at 189. “[A] defendant cannot automatically moot a case simply by ending its unlawful  
7 conduct once sued.” *Already*, 568 U.S. at 91 (citing *City of Mesquite v. Aladdin’s Castle, Inc.*, 455  
8 U.S. 283, 289 (1982)). In fact, “[a] defendant’s voluntary cessation of allegedly wrongful conduct is  
9 *unlikely* to moot a case.” *Johnson v. Tom*, No. 5:18-cv-01297-EJD, 2019 WL 4751930, at \*1 (N.D.  
Cal. Sept. 30, 2019) (emphasis added).

10 The voluntary cessation doctrine is built on “the fact that [courts] do not find cases moot  
11 when the challenged conduct is capable of repetition, yet evading review.” *See Friends of the Earth*,  
12 528 U.S. at 213. If such conduct were allowed, Defendant would be able to engage in illegal  
13 conduct, stop when sued, then resume his unlawful actions as soon as the case was dropped.  
14 *Already*, 568 U.S. at 91. Given this concern, “a defendant claiming that its voluntary compliance  
15 moots a case bears the formidable burden of showing that it is absolutely clear the allegedly  
16 wrongful behavior could not reasonably be expected to recur.” *Id.* at 91 (quoting *Friends of the*  
17 *Earth*, 528 U.S. at 190). Defendant has made no such showing.

18 Plaintiff gave Defendant every opportunity to issue a sufficient license, including sending  
19 two letters outlining why the licenses offered were not broad enough under *Already* – namely, that  
20 they do not cover the photographer’s other photos that may exist in the millions of posts on the  
21 Phish.net forum, leaving Mockingbird at risk of future threats from Defendant. Levy Aff. Exs. C, E.  
22 Defendant never responded to the November 8 letter. *See* Motion at 6 (failing to mention this letter  
23 when describing settlement negotiations). If this case is dismissed, Defendant can immediately  
24 resume threats against Mockingbird for any of his other photos to which forum users may have  
25 posted deeplinks on the forum. Given the Motion’s description of Defendant as a highly  
26 accomplished and well-known photographer who has photographed all the national parks, Motion at  
27 3, it is likely additional photographs by Defendant may well exist on the millions of posts on  
28

1 Mockingbird’s forum.

2 Thus, given the narrowness of the licenses, Defendant’s behavior could reasonably be  
3 expected to recur. *See Already*, 568 U.S. at 94-95, 101. The case is therefore not moot.

4  
5 **A. The Licenses Offered by Defendant Are Much Narrower Than the Covenant  
6 Not to Sue in *Already v. Nike***

7 The licenses offered by Defendant are too narrow to moot this case. To determine whether  
8 voluntary cessation renders a case moot, the district courts in this Circuit consider whether the  
9 covenant not to sue or license in question is as broad as that in *Already*. *See, e.g., Expensify*, 2019  
10 WL 5295064, at \*6 (mooting case because “there is no cognizable distinction between the covenants  
11 provided by Defendant to plaintiff and those considered in *Already*”); *Humu, Inc. v. Hulu, LLC*, No.  
12 19-CV-00327-HSG, 2019 WL 3220271, \*2 (N.D. Cal. Jul. 17 2019) (refusing to moot case because  
13 “the disputed covenant not to sue differs in material ways from the covenant at issue in *Nike*”);  
14 *Kindred Studio Illustration & Design, LLC v. Elec. Commun. Tech., LLC*, No. CV 18-7661-  
15 GW(GJSx), 2018 WL 6985317, at \*5 (C.D. Cal. Dec. 3, 2018) (mooting case because the covenant  
16 not to sue “appears to have substantially the same components as the covenant[] not to sue in  
17 *Already*”); *Spicy Beer Mix, Inc. v. New Castle Beverage*, No. CV 14-00720 SJO (JEMx), 2014 WL  
18 7672167, at \*5 (C.D. Cal. 2014) (mooting case because “[t]he Covenant not to sue is essentially the  
19 same as the one at issue in *Already*”). In cases claiming mootness by voluntary cessation, the  
20 “parties dispute turns on whether Defendant’s covenant not to sue [in the case at issue] sufficiently  
21 tracks the covenant not to sue provided in *Nike*.” *Humu*, 2019 WL 3220271 at \*1.

22 The covenant not to sue in *Already* met the formidable burden necessary to moot the case  
23 because it was exceptionally broad. Nike claimed *Already*, a shoe company, was infringing on its  
24 trademark. But after *Already* counterclaimed that Nike’s trademark was invalid, Nike issued a  
25 covenant not to sue *Already* for *any* shoe designs:

26 [Nike] unconditionally and irrevocably covenants to refrain from making any claim(s) or  
27 demand(s) against *Already* or any of its related business entities...[including] distributors...  
28 and employees of such entities and all customers... on account of any possible cause of  
action based on or involving trademark infringement, unfair competition, or dilution, under

1 state or federal law... relating to the NIKE Mark based on the appearance of any of Already's  
2 current and/or previous footwear product designs, and any colorable imitations thereof,  
3 regardless of whether that footwear is produced... or otherwise used in commerce before or  
4 after the Effective Date of this Covenant.”

5 *Already*, 568 U.S. at 93. The Court found that the “breadth of this covenant suffices to meet  
6 the burden imposed by the voluntary cessation test,” thus mooting *Already*’s action to have the  
7 trademark declared invalid. *Id.* This covenant covered past and future sales of existing products, as  
8 well as *future products not yet designed or imagined by Already*. *Id.* 89-90, 93. The case was moot  
9 because the “scope of the covenant,” *id.* at 101, made it “hard to imagine a scenario that would  
10 potentially infringe Nike’s trademark and yet not fall under the Covenant.” *Id.* at 94 (internal  
11 punctuation omitted). Thus, it was highly unlikely that Nike could resume enforcing its allegedly  
12 invalid trademarks against *Already*.

13 A license or covenant not to sue must be broad to meet the “formidable burden” standard.  
14 Covenants not to sue do not meet this standard when they are “too narrow ‘to extinguish any current  
15 or future case or controversy between the parties’” even if “the covenants do not contain any  
16 exceptions or caveats.” *Intellisoft, Ltd. V. Acer. Am. Corp.*, No. 17-cv-06272-PJH , 2018 WL  
17 2412179 at \*5 (N.D. Cal. May 29, 2018) (quoting *Dow Jones & Co. v. Abblaise Ltd.*, 606 F.3d 1338,  
18 1348 (Fed. Cir. 2010)). In *Humu v. Hulu*, for example, the court refused to find the case moot  
19 despite Hulu’s offer of a covenant not to sue. The facts of that case are similar to those here: *Humu*  
20 sought declaratory judgment after Hulu accused it of trademark infringement. *Humu*, 2019 WL  
21 3220271 at \*1. Hulu subsequently provided *Humu* a covenant not to sue, then filed a motion to  
22 dismiss. *Id.* The court found the covenant not to sue at issue too narrow to moot the case because the  
23 covenant contained a “critical proviso” that limited the terms of the covenant, namely that the  
24 covenant only applied to *Humu*’s communications with its customers, rather than offering a blanket  
25 agreement not to sue over the underlying trademark infringement issue. *Id.* at \*1-2. The covenant at  
26 issue in *Hulu* read:

27 Hulu ... hereby unconditionally and irrevocably covenants to refrain from making any  
28 claim(s) or demand(s)... on account of any possible cause of action based on or involving  
trademark infringement, unfair competition, or dilution, under state or federal law in the  
United States relating to the Hulu Marks based on *Humu*’s use of the HUMU mark in the

1 manner described in the Complaint in connection with the Humu Services offered to the  
2 Humu Customers, or in connection with any other goods or services similar to the Humu  
3 Services marketed directly to the Humu Customers.

4 *Id.* at \*2. Because the “disputed covenant not to sue differs in material ways from the  
5 covenant at issue in Nike,” the case was not moot. *Id.* at \*3.

6 The license offered in this case falls far short of the broad, multi-product, future-looking  
7 covenant not to sue, which included future products not yet designed, that was found sufficient to  
8 moot the controversy in *Already*. Defendant’s narrow license applied only to the specific image in  
9 question:

10 Quan-Tuan Luong grants the owners and operators of Phish.net an irrevocable retroactive  
11 and future license to display the image grte25409.jpeg via an inline on Phish.net, including  
12 any of its subdomains.

13 Levy Aff. Ex. D. This limited license contrasts starkly with the comprehensive covenant not  
14 to sue in *Already*.<sup>7</sup> Unlike that covenant – or even the covenant in *Humu*, which was found  
15 insufficient to moot the case – this license does not stop Defendant “from making any claim(s) or  
16 demand(s) against [Plaintiff]... on account of any possible cause of action based on or involving”  
17 the underlying issue that caused the controversy in the first place. *Already*, 568 U.S.at 93; *Humu*,  
18 2019 WL 3220271 at \*2. Critically, the proffered license does not stop Defendant from simply  
19 finding another image deeplinked on the Phish.net forum and sending Mockingbird the exact same  
20 threat letter the day after this case is dismissed. For the license to moot this case, it must prevent  
21 Defendant from bringing claims against Mockingbird containing identical factual and legal issues as  
22 those in this case. The license does not approach the scope of “any possible cause of action” and “in  
23 connection with any other goods or services” that was still found to be insufficient in *Humu* to  
24 constitute voluntary cessation.

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25 <sup>7</sup> To assess whether a covenant or license meets the formidable burden of mooting a case, “courts  
26 consider, ‘in addition to other factors: (1) the language of the covenant, (2) whether the covenant  
27 covers future, as well as past, activity and products, and (3) evidence of intention or lack of  
28 intention, on the part of the party asserting jurisdiction, to engage in new activity or to develop new  
potentially infringing products that arguably are not covered by the covenant.’” *Humu*, 2019 WL  
3220271 at \*1 (citing *Chromadex, Inc. v. Elysium Health, Inc.*, No. SACV 16-02277-CJC(DFMx),  
2017 WL 7080237 (C.D. Cal. Nov. 28, 2017); see also *Already*, 568 U.S. at 90 (noting that the  
Second Circuit assessed these factors).

**B. Defendant Has Not Met His “Formidable Burden” to Show That It Is “Absolutely Clear” His Wrongful Conduct Cannot Be Expected to Recur**

A case is not moot when “the disputed covenant not to sue [or license] differs in material ways from the covenant at issue in *Nike*... [because] the Court thus cannot conclude that it is ‘absolutely clear’ that Defendant’s covenant eliminated all potential... disputes.” *Humu*, 2019 WL 3220271 at \*2. Here, the components of the case include any of Defendant’s photographs which appear on Mockingbird’s forum, not just the particular image in question. Significantly, Defendant himself put the broader set of all their photographs into the scope of this controversy. The draft complaint that Defendant threatened to file against Mockingbird’s executive director demanded injunctive relief protecting not just the specifically identified work but “*all copyrighted works*” of Defendant. FAC Ex. C, Prayer for Relief; Godard Aff. Ex. 8 (emphasis added). And throughout his threats to Mockingbird and his discussions with Mockingbird’s counsel, Defendant has explicitly maintained his rights to sue over any other of his photographs that have been posted in identical ways as the one identified photograph (deeplinks posted by forum users) and that raise identical legal issues of deeplinking and volitional conduct.

The limited nature of the license – and Defendant’s refusal to grant the appropriate license – make it clear the proffered license does nothing to stop Defendant from bringing claims regarding the same issue in the future. The problem with the narrowness of the license, and the nature of the license that would have eliminated the case or controversy, was identified to Defendant’s counsel, Levy Aff. Ex. E, who chose to file a motion to dismiss instead of responding to the problem. If this case is dismissed, Mockingbird will run the risk of an ongoing game of legal whack-a-mole: Defendant can locate one of his images shared via deeplink among the 4 million posts on the forum and commence a new round of costly and disruptive legal threats and possible lawsuits, even though Mockingbird believes its actions have been fully legal. And then repeat the process. Without a declaratory judgment, Mockingbird will continue to have a reasonable expectation that Defendant’s abusive conduct will recur. FAC ¶¶ 14, 32; *see also* Godard Aff. ¶¶ 5-6, 9.

If Defendant truly has no intention of suing Mockingbird, it is hard to fathom why he will not grant the broader license required by *Already* and *Humu*. Most importantly, however, nothing in

1 Defendant's Motion even attempts to satisfy his "formidable burden" of demonstrating that it is  
2 "absolutely clear" his unfounded threats will not recur. *Already*, 568 U.S. at 91.

#### 3 **IV. THE QUESTION OF ATTORNEY'S FEES IS PREMATURE**

4 Defendant argues that, assuming that the Court grants his motion to dismiss, it should at the  
5 same time hold Plaintiff liable for attorney fees for failing to dismiss voluntarily in response to the  
6 issuance of a license. That request is both wrong and premature.

7 Under 17 U.S.C. § 412, the court can consider Defendant's claims for attorney fees only if  
8 Defendant shows that he registered their copyright before the photographs were deeplinked from  
9 Plaintiff's forum or, at least, within three months of first publication, and under section 505 only if  
10 Defendant can show that they prevailed. Defendant has not alleged that the copyright was registered  
11 timely. *Adlife Mktg. & Comm. Co. v. Best Yet Mkt.*, 2017 WL 4564763, at \*5 (E.D.N.Y. Oct. 11,  
12 2017). Moreover, if Defendant was to secure dismissal of this action for lack of subject matter  
13 jurisdiction, that dismissal would be without prejudice. *Kelly v. Fleetwood Enterprises*, 377 F.3d  
14 1034, 1036 (9th Cir. 2004). A dismissal without prejudice would not entitle Defendant to attorney  
15 fees, *Branson v. Nott*, 62 F.3d 287, 293 (9th Cir. 1995), particularly when the dismissal was based  
16 on Defendant's cessation of conduct after suit was filed. *See also Avery v. First ADR Mgt. Corp.*,  
17 568 F.3d 1018, 1024 (9th Cir. 2009); *Oscar v. Alaska Dept. of Educ. and Early Dev.*, 541 F.3d 978,  
18 981 (9th Cir. 2008).

19 Attorney fees under the Copyright Act may be awarded after considering all of  
20 the *Kirtsaeng* factors. *Kirtsaeng v. John Wiley & Sons*, 136 S. Ct. 1979, 1982 (2016). Defendant's  
21 discussion of those factors is superficial at best. The time to address the issue of attorney fees is once  
22 either side in this case has prevailed on the merits.

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**CONCLUSION**

The motion to dismiss for lack of subject matter jurisdiction should be denied.

Dated: December 13, 2019

By:  /s/ Paul Alan Levy

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