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5
6 UNITED STATES DISTRICT COURT
7
8 NORTHERN DISTRICT OF CALIFORNIA
9
10 SAN FRANCISCO DIVISION

10 LIUXIA WONG,) CASE NO. 5:12-CV-00469-YGR
11)
Plaintiff,)
12)
v.) DEFENDANT HARD DRIVE
13) PRODUCTION’S REPLY IN SUPPORT
HARD DRIVE PRODUCTIONS, INC., et al.) OF ITS MOTION TO DISMISS
14)
Defendants.)

15
16 **DEFENDANT HARD DRIVE PRODUCTIONS, INC.’S**
17 **REPLY IN SUPPORT OF ITS MOTION TO DISMISS**

18 **INTRODUCTION**

19 Plaintiff’s opposition (“Opposition” or “Opp.”) to Defendant’s motion to dismiss the
20 Complaint fails to show a valid factual or legal basis justifying this case’s existence. Plaintiff has
21 failed to identify a single valid, or logical, reason why she is pursuing this law suit to seek a
22 declaration that she did not infringe Hard Drive’s copyright, when Hard Drive has already informed
23 her that it believes she did not infringe its copyright and all that she has been asked to do is appear
24 for a deposition regarding who used her Internet Protocol (“IP”) address to download Defendant’s
25 copyrighted work. The Complaint that she chose to file is legally infirm because (i) she has not
26 asserted facts that establish that venue is proper in this court, and in fact she has admitted that venue
27 is proper in the Eastern District of California; (ii) there is no justiciable claim or controversy in this
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1 case, because all named parties agree that she did not infringe; and (iii) there is already another case
2 pending in this District, *Hard Drive Productions, Inc. v. John Doe*, Case No. 11-CV-5630 (“*Hard*
3 *Drive IP*”¹), involving substantially related factual and legal issues; Plaintiff could have sought to
4 intervene in that case to seek the declaration she seeks here, which would have avoided the delays
5 that have thus far prevented Defendant from deposing her.

6 For the reasons set forth below, and in Defendant’s opening brief, this Court should dismiss
7 this action.

8 ARGUMENT

9 **I. PLAINTIFF’S SECOND OPPOSITION IS IMPROPER AND IMPERMISSIBLE ATTEMPT TO MODIFY AND INTRODUCE** 10 **ARGUMENTS THAT ARE ALREADY FULLY BRIEFED.**

11 This is Plaintiff’s Second Opposition to the identical Motion to Dismiss, and the Court
12 should strike it because she seeks to re-tool arguments, and add new arguments, to matters that were
13 already fully briefed.

14 On February 5, 2012, Hard Drive filed its Notice of Motion and Motion to Dismiss Amended
15 Complaint. (Doc. No. 8, hereinafter “Motion to Dismiss”.) At that time, this case was in front of the
16 Honorable Magistrate Judge Howard R. Lloyd. As such, Hard Drive appropriately noticed its
17 Motion to Dismiss in front of Judge Lloyd. (*See id.*) On February 21, 2012, Plaintiff filed her
18 Opposition to Defendant Hard Drive Productions, Inc.’s Motion to Dismiss. (Doc. No. 10,
19 hereinafter “Plaintiff’s First Opposition.”) Hard Drive timely filed its Reply in Support of its Motion
20 to Dismiss on February 27, 2012. (Doc. No. 12.) All the briefing was completed as of February 27,
21 2012.

22 On February 23, 2012, the Court issued a Related Case Order, which, among other things
23 stated that this case was found to be related to a separate case in front of this Court. Accordingly,
24 “all future filings in any reassigned case are to bear the initials of the newly assigned judge
25 immediately after the case number... [and] [u]nless otherwise ordered, any date for hearing noticed
26

27 ¹ Judge Yvonne Gonzalez Rogers entered a Related Case Order in this case on February 23,
28 2012 relating this case and *Hard Drive II*, and reassigning this case to Judge Rogers. *See* Docket

1 motions are vacated and must be re-noticed by the moving party before the newly assigned judge.”
2 (Doc. No. 11, hereinafter “Reassignment Order.”) Pursuant to this Reassignment Order and Local
3 Rule (L.R.) 3-12(g), Hard Drive renoticed the Motion to Dismiss on March 9, 2012 for April 17,
4 2012 at 2:00 pm in front of the Honorable District Court Judge Yvonne Gonzalez Rogers. (Doc. No.
5 14.) In that document, Hard specifically mentioned the reasons for renoticing the Motion to
6 Dismiss, and referred the Court back to Hard Drive’s previously filed Motion to Dismiss Plaintiff,
7 Liuxia Wong’s, Amended Complaint.

8 On March 25, 2012, Plaintiff filed its Second Opposition. (Doc. No. 15.) First, Plaintiff’s
9 Second Opposition raises new arguments. Second, Plaintiff’s Second Opposition objected “to Hard
10 Drive’s renotice of its motion to dismiss for failing to comply with Civil L.R. 7-2(a), (b), (c) & (d) as
11 the only pleading filed and served is its renewed notice of motion.” (*Id.*)

12 Plaintiff’s Second Opposition is uncalled for. First, new arguments are presented in
13 Plaintiff’s Second Opposition that were not presented in Plaintiff’s First Opposition. (*Compare*
14 Plaintiff Liuxia Wong’s Opposition to Defendant Hard Drive Productions, Inc.’s Renewed Motion to
15 Dismiss [Doc. No. 14] and Plaintiff Liuxia Wong’s Opposition to Defendant Hard Drive
16 Productions, Inc.’s Motion to Dismiss [Doc. No. 10].) Nothing in the L.R.s or the Court’s
17 Reassignment Order allowed Plaintiff to reargue its position. All of the papers—i.e., the Motion to
18 Dismiss, Plaintiff’s First Response, and Hard Drive’s Reply—were already in front of the Court.

19 Second, in renoticing the Motion to Dismiss, Hard Drive was simply abiding by the clear
20 language of the Court’s Reassignment Order and the L.R.s. Thus, Plaintiff’s objections to Hard
21 Drive’s renotice should be struck along with Plaintiff’s entire Second Opposition.

22 **II. PLAINTIFF HAS FAILED TO SHOW THAT VENUE IS PROPER IN**
23 **THIS DISTRICT.**

24 Plaintiff admits in its Complaint that venue is proper in the Eastern District of California.
25 (Dkt. #4 at ¶12.) And it has failed to plead facts sufficient to demonstrate that venue is proper in the
26 Northern District of California, as required by governing statutory and case law. Plaintiff
27 nevertheless argues that the Court should ignore its facially defective pleading relating to venue on
28 the ground that, because Hard Drive previously filed two actions relating to infringement from

1 Wong's IP address in this District², it somehow acquiesced to being sued in the future in this
2 District. That argument is utterly baseless, both legally and factually. The Court should therefore
3 dismiss the Complaint.
4

5 **A. Plaintiff Is Required, And Has Failed, To Allege Facts To Establish**
6 **Proper Venue In This Judicial District.**

7 In this case, Plaintiff seeks a declaration that she did not infringe upon Defendant's
8 copyright. Section 1400(a) of the Federal Copyright Act is the sole venue statute for copyright
9 infringement actions. 28 U.S.C. § 1400(a). That section requires that a civil suit under the Copyright
10 Act must be brought in a judicial district "in which the defendant or his agent resides or may be
11 found." 28 U.S.C. § 1400(a). Section 1400(a) therefore requires that every defendant must be
12 "found" here in order for venue to be proper in this Court. Venue will only be appropriate in this
13 District if the Defendant resides in the Northern District of California, or if the Court determines that
14 Defendant can be found in this District. *See Brayton Purcell LLP v. Recordon and Recordon, et al.*
15 606 F.3d 1124 (9th Cir. 2010).

16 **1. Requirements For Establishing Proper Venue.**

17 The Ninth Circuit recognizes a three-pronged test to determine whether a party has sufficient
18 contacts to be found in this district. *Brayton Purcell*, 606 F.3d at 1128: (1) The non-resident
19 defendant must purposefully direct his activities or consummate some transaction with the forum or
20 resident thereof; or perform some act by which he purposefully avails himself of the privilege of
21 conducting activities in the forum, thereby invoking the benefits and protections of its laws; (2) the
22 claim must be one which arises out of or relates to the defendant's forum-related activities; and (3)
23 the exercise of jurisdiction must comport with fair play and substantial justice, *i.e.* it must be
24 reasonable. *Id.*
25

26 _____
27 ² The two cases are *Hard Drive Productions, Inc. v. Does I-48*, Case No. 11:cv-1957 ("*Hard*
28 *Drive I*") and *Hard Drive II*. For ease of reference, this brief will refer to court filings in the case
captioned above or "Dkt.," and court filings in the *Hard Drive I* and *II* cases as "*Hard Drive I*
Dkt. _____" and "*Hard Drive II Dkt. _____*," respectively.

1 The first prong is satisfied if the plaintiff establishes either purposeful availment or
2 purposeful direction. *Id.* “A purposeful availment analysis is most often used in suits sounding in
3 contract. A purposeful direction analysis, on the other hand, is most often used in suits sounding in
4 tort.” *Id.* Where, as here, the underlying action is for copyright infringement, it is an action
5 sounding in tort. *Id.* The Court must therefore apply the three-part “*Calder-effects*” test, under
6 which “the defendant allegedly must have (1) committed an intentional act, (2) expressly aimed at
7 the forum state, (3) causing harm that the defendant knows is likely to be suffered in the forum
8 state.” *Id.*, citing *Yahoo! Inc. v. La Ligue Contre Le Racisme Et L’Antisemitisme*, 433 F.3d 1199,
9 1206 (9th Cir. 2006) (en banc) (internal quotation marks omitted).

10 While Defendant arguably performed an “intentional act” by operating a website that can be
11 accessed here (*see, e.g., Rio Props., Inc. v. Rio Int’l Interlink*, 284 F.3d 1007, 1020 (9th Cir.2002)
12 (operating a passive website was an intentional act)); Plaintiff has not, and cannot, allege facts
13 satisfying the second and third parts of the *Calder-effects* test. The second part requires that the
14 defendant’s conduct be expressly aimed at the forum. *See Brayton Purcell*, 606 F.3d at 1129, citing
15 *Pebble Beach v. Caddy*, 453 F.3d 1151, 1156. “It is beyond dispute in this circuit that maintenance
16 of a passive website alone cannot satisfy the express aiming prong.” *Id.*; citing *Holland Am. Line*
17 *Inc. v. Wartsila N. Am., Inc.*, 485 F.3d 450, 460 (9th Cir. 2007) (“We consistently have held that a
18 mere web presence is insufficient to establish personal jurisdiction.”); and *Pebble Beach*, 453 F.3d at
19 1158 (“[W]e reject . . . any contention that a passive website constitutes express[] aiming.”).

20 **2. Plaintiff Has Failed To Allege Proper Venue.**

21 Plaintiff has not alleged anything suggesting that venue is proper in the Northern District of
22 California. The sole allegation in the Amended Complaint relevant to venue is that “Plaintiff is
23 informed and believes, and thereon alleges that Hard Drive is an Arizona Corporation whose
24 principal place of residence is in Maricopa County, [Arizona], and which does business worldwide
25 including in the State of California, Counties of San Francisco and Solano.” Dkt. #4 at ¶3. Plaintiff
26 thus admits that Hard Drive may not be found in this Court. And she includes no allegations to
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1 suggest that Hard Drive committed an intentional act expressly aimed at California causing harm
2 that it knows is likely to be suffered in this district.

3 Instead of alleging a valid basis for asserting that venue in this Court is proper, Plaintiff
4 offers the defective argument that Hard Drive “**waiv[ed] venue by bring suit in a district,**
5 even though venue is not proper there under the statute.” (Opp. at p. 5, emphasis in original.) In
6 attempting that argument, Plaintiff betrays a profound misunderstanding of the difference between a
7 “plaintiff” and a “defendant.” It cites merely to a 1953 U.S. Supreme Court case (*Olberding v.*
8 *Illinois Cent R.R. Co.*, 346 U.S. 338 (1953)) as its sole support that venue is proper, in which,
9 Plaintiff unhelpfully points out, an “Illinois corporation, by bringing suit against Indiana resident in
10 Kentucky ..., waived its right to object to venue...” Opp. at p. 5. However, Hard Drive is the
11 *defendant* here. Wong is the *plaintiff*. Hard Drive did not waive anything when Wong chose to sue
12 in an improper forum. And Wong, apparently unwittingly, fully admits the validity of Hard Drive’s
13 venue objection when she states that, under *Olberding*, “defendant, unless he had also consented to
14 be sued in such district, was still entitled to object to improper venue.” Opp. at p. 5. Hard Drive is
15 the Defendant, it has not consented to Wong suing it in this district, and it is objecting to improper
16 venue.

17 The fact that Hard Drive previously brought lawsuits in this venue, in which Wong was never
18 a party, is not a valid ground to allege proper venue under either 28 U.S.C. § 1400(a), or *Brayton*
19 *Purcell*. And it is not logical. Hard Drive alleged that venue was proper in this Court in *Hard Drive*
20 *I Productions, Inc. v. Does 1-48* (11:cv-1957, “*Hard Drive I*”) #1 because “under 28 U.S.C. §§
21 1391(b) and 1400(a)..., on information and belief, Doe Defendants reside in this District, may be
22 found in this District, and/or committed acts in this District giving rise to Plaintiffs claims.” *Hard*
23 *Drive I* Dkt. #1 at ¶4. It alleged in *Hard Drive II* that “Venue is properly founded in this judicial
24 district pursuant to 28 U.S.C. §§ 1391(b) and 1400(a) because Defendants reside in this District, may
25 be found in this District, or a substantial part of the events giving rise to the claims in this action
26 occurred within this District.” *Hard Drive II* Dkt.#1 at ¶8.

1 Plaintiff's argument is defective because, as set forth above, Plaintiff has the burden of
 2 pleading facts sufficient to show that the location and conduct of Defendant establishes venue in this
 3 District. The fact that Hard Drive filed prior lawsuits in which venue was proper in this District has
 4 no bearing on whether venue is proper in this case, where Hard Drive is a Defendant.

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 6 **B. There Is No Ground To Apply "Judicial Estoppel."**

7 Plaintiff also argues that, by alleging that this Court was the proper venue for it to sue in
 8 *Hard Drive I* and *II*, Hard Drive should be "judicially estopped" from asserting that that Plaintiff has
 9 failed to allege that venue is proper in this court in this case. Plaintiff argues that "Hard Drive
 10 judicially admitted the fact that all Doe defendants resided in this district, may be found in this district,
 11 and/or committed acts in this district giving rise to its claims ... Hard Drive judicially admitted facts
 12 giving rise to support its claims to join all 48 Doe defendants in this district ... Hard Drive further
 13 notified the court that at issue in the case was whether it was the exclusive licensee of the adult
 14 pornographic work at issue ... Likewise in its present action, Hard Drive again judicially admitted the
 15 fact that Mrs. Wong resided in this district."³ Opp. at pp. 5-6. That argument is factually and legally
 16 baseless.

17 **1. No Basis To Assert Judicial Estoppel.**

18 Judicial estoppel is generally a discretionary equitable doctrine that precludes a party from
 19 gaining an advantage by asserting one position in a court proceeding and later seeking an advantage
 20 by taking a completely different position later. A court's determination whether to invoke judicial
 21 estoppel is informed by several factors:

- 22 (1) Whether a party adopts a position clearly inconsistent with its earlier position; (2)
 23 whether the court accepted the parties' earlier position; and (3) whether the party
 24 would gain an unfair advantage or impose an unfair detriment if the ... party is not
 25 estopped."

26 *Williams v Boeing Co.*, 517 F.3d 1120, 1134 (9th Cir. 2008) (citing *New Hampshire v. Maine*,
 532 U.S. 742, 750-51 (2001)).

27
 28 ³ The meaning of this last sentence is unclear, as Plaintiff cites Paragraph 66 of its own
 Complaint and does not include any statement on the part of Hard Drive.

1 Plaintiff offers no factual basis to assert that Hard Drive “judicially admitted” anything
2 relevant with respect to venue in this case. First, Hard Drive has taken no position as to the
3 residence of Wong in connection with this case, because it is not relevant for purposes of venue.
4 “[A]n inconsistent factual or legal position is a threshold requirement to the doctrine” of judicial
5 estoppel. *Klamath Siskiyou Wilderness Ctr. V. Boody*, 468 F.3d 549, 554 (9th Cir. 2006) (citation
6 omitted). As set forth above, it is the residence and conduct of *Hard Drive* that is relevant for
7 purposes of determining proper venue. The residence of Plaintiff is irrelevant for that purpose, and
8 Hard Drive has taken no position as to her residence, much less a position contrary to what it alleged
9 in other litigation. Plaintiff has thus failed to meet the threshold requirement for alleging judicial
10 estoppel.

11 Plaintiff also fails to address, much less satisfy, the other two parts of the test for seeking
12 judicial estoppel. The Court did not “accept” the position of Hard Drive in either *Hard Drive I* or
13 *Hard Drive II*. Instead, the Court held that there was “[g]ood cause” to grant Hard Drive’s
14 applications to take discovery (*Hard Drive I* Dkt. # 11) and that “[u]nder the circumstances here, the
15 request to depose [Wong] appears reasonably calculated to lead to the discovery of admissible
16 evidence, and leave to issue a subpoena will be granted, without prejudice to [Wong’s] rights under
17 the Federal Rules to move to quash or limit the subpoena” (*Hard Drive II* Dkt. #10).

18 The Court did not make factual or legal ruling of a contested issue in either case. In order for
19 judicial estoppel to apply, a court has to rely upon inconsistent statements. *Masayeva v. Hale*, 118
20 F.3d 1331, 1382 (9th Cir. 1997). The Courts in both *Hard Drive I* and *Hard Drive II* did not make
21 factual rulings based on Hard Drive’s statements as to venue, it simply allowed Hard Drive to serve
22 subpoenas to learn the identities of the Doe defendants. As such, Plaintiff has failed to show that a
23 court “relied upon” or “accepted” statements by Hard Drive. And it cannot allege that Hard Drive
24 will gain an unfair advantage, or impose an unfair detriment, if the Court does not estop it from
25 challenging venue.

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1 **2. Plaintiff Lacks Standing To Request This Court To Grant A**
2 **Motion To Intervene In Another Case.**

3 Wong argues that this Court should grant her leave to intervene in *Hard Drive II* if it grants
4 Hard Drive’s motion to dismiss in this case. Opp. at p. 8.

5 While Wong cites an excerpt from Fed. R. Civ. P. 24(b)(1) regarding intervention in cases
6 involving common questions of law or fact, he overlooks the fact that *Hard Drive II* is an entirely
7 different case from this one. Wong does not have standing to ask the Judge presiding over this case,
8 to enter an order on for the Judge presiding over *Hard Drive II*, to allow Wong to intervene in *Hard*
9 *Drive II*. The Court in *Hard Drive II* is, of course, fully capable of determining who may or may not
10 intervene in that case. And while Wong may have the right, in the abstract, to intervene in *Hard*
11 *Drive II*, Rule 24 requires him to do “[o]n timely motion.” Fed. R. Civ. P. 24(a). Burying a request
12 to intervene deeply within a verbose opposition to a motion to dismiss, filed in an entirely separately
13 case, cannot under any circumstances be considered to be a proper motion to intervene presented in a
14 U.S. District Court. The Court should disregard and deny Wong’s peculiar request to intervene in
15 *Hard Drive II*.

16 **3. Wong Cannot “Waive” Objections Over Venue.**

17 Plaintiff also maintains that “Hard Drive’s argument that Mrs. Wong claims that venue is
18 likewise proper in the Eastern District is irrelevant for her action. This is because a copyright
19 infringement defendant or a party who is moving for a declaratory order of non-infringement, like
20 Mrs. Wong, can always waive the affirmative defense of venue ... She has done so here by filing
21 her declaratory relief action in this district.” Opp. at p. 6.

22 The precise meaning of this argument is unclear. But Plaintiff has firmly admitted in her
23 Complaint that “Venue is proper in the *Eastern District* of California pursuant to 28 U.S.C. section
24 1400(a) as Hard Drive has claimed that plaintiff infringed its purported copyrighted work by
25 downloading such works where she resides.” Dkt. #4, ¶12 (emphasis added). She does not have
26 grounds to assert or waive an “affirmative defense of venue” because she is not defendant in any
27 litigation referenced in Plaintiff’s Opposition. And the suggestion that Plaintiff can purport to
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1 “waive” Defendant’s objections to venue by simply filing a complaint in her chosen venue is, of
2 course, nonsense.

3 **III. THERE IS NO CASE OR CONTROVERSY.**

4 Plaintiff has also failed to rebut the plain fact that there is no case or controversy at issue in
5 this litigation. Plaintiff asserts that she did not infringe upon Hard Drive’s copyright. Defendant has
6 informed Plaintiff that it believes that she did not infringe on its copyright, and that it will not sue
7 her for infringement. The Court therefore has no jurisdiction to hear this case.

8 Article III of the United States Constitution limits the jurisdiction of federal courts to the
9 adjudicating of “cases” and “controversies. U.S. Const. art. III, § 2, cl. 1. The Declaratory
10 Judgment Act provides that “[i]n a case of actual controversy within its jurisdiction ... any court of
11 the [United States], upon the filing of an appropriate pleading, may declare the rights and other legal
12 relations of any related party seeking such declaration, whether or not further relief is or could be
13 sought....” 28 U.S.C. § 2201(a). Article III requires that a dispute must be “definite and concrete,
14 touching the legal relations of parties having adverse legal interests; and that it be real and
15 substantial and admi[t] of specific relief through a decree of a conclusive character, as distinguished
16 from an opinion advising what the law would be upon a hypothetical state of facts.” *MedImmune,*
17 *Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007) (citation omitted).

18 Plaintiff argues that there is a case or controversy here because counsel for Hard Drive
19 initiated settlement discussions in July 2011 relating to *Hard Drive I*; asked her to preserve
20 evidence; and extended a settlement offer to forego deposing her in *Hard Drive II*, through a
21 settlement offer in which she could avoid being deposed and settle possible claims against members
22 of her household who may be the actual infringers. Opp. at p. 10. None of that gives rise to a
23 justiciable controversy.

24 Plaintiff’s argument fails at the outset for what it tries to minimize: *neither party claims that*
25 *Wong is the infringer.* Plaintiff alleged in her Complaint that she is not the infringer. Counsel for
26 Defendant informed counsel for Plaintiff that Defendant believes another person is the infringer and
27 that Defendant will not seek to name Wong as a defendant in this action.

1 The most Plaintiff can claim is that in July 2011, Defendant indicated that it may name her as
2 a defendant in *Hard Drive I*, and pursued settlement with her. While Plaintiff claims that “Hard
3 Drive ... threatened a lawsuit against Mrs. Wong for copyright infringement,” Defendant never did.
4 Hard Drive did not, and has not, named Wong as a defendant in any action, and it dismissed *Hard*
5 *Drive I* in September 2011. Plaintiff’s suggestion that Defendant’s request that she preserve all
6 evidence relevant to the use of her IP address creates to a case or controversy is baseless. Indeed, it
7 is commonplace for litigants to request preservation of evidence at the outset of litigation. And
8 Defendant’s offer of January 2012 to settle *Hard Drive II* with Wong, so that she could avoid being
9 deposed and members of her household could avoid potential liability for infringement, also falls far
10 short of establishing a judicable claim or controversy. Indeed, the wording of that offer confirms
11 the fact that Defendant does not view Wong as the infringer and that it instead believes another
12 member of Wong’s household may be.

13 Defendant’s reasonable attempts to resolve its infringement claims fall far short of a “threat”
14 to sue her for infringement. Faced with that obstacle, Defendant has misapplied and misstated the
15 Federal Circuit Court of Appeals’ decision in *SanDisk Corp. v. STMicroelectronics, Inc.*, 480 F.3d
16 1372 (Fed. Cir. 2007) as holding that “a patent owner’s statement that it had absolutely no plans to
17 sue the declaratory relief plaintiff did not eliminate nor moot the justiciable controversy between the
18 parties.” Opp. at pp. 11-12.

19 *SanDisk* is inapplicable and distinguishable, and cannot salvage Plaintiff’s claim for
20 declaratory judgment. Initially, the court in *SanDisk* expressly limited its ruling to claims relating to
21 patent infringement. *SanDisk*, 480 F.3d at 1381 (“**We hold only** that where a **patentee** asserts
22 rights under a **patent** based on certain identified ongoing or planned activity of another party, and
23 where that party contends that it has the right to engage in the accused activity without license, an
24 Article III case or controversy will arise and the party need not risk a suit for infringement by
25 engaging in the identified activity before seeking a declaration of its legal rights”) (emphasis added).
26 There are no patent issues in this case.

1 Furthermore, *SanDisk* does not suggest that there is a case or controversy here, because (i)
2 Defendant has indicated that it will assert claims against an unidentified “John Doe,” not Wong; and
3 (ii) Wong does not “contend that [she] has the right to engage in” infringement of Defendant’s
4 copyright without license. *SanDisk* therefore offers no basis for Plaintiff to assert that there is a
5 judicable case or controversy in spite of Defendant’s statements that it will not add Wong as a party.

6 The declaratory judgment defendant in *SanDisk* informed the plaintiff verbally that it had
7 “absolutely no plan to sue” the plaintiff. But it nevertheless believed that the plaintiff was infringing
8 on its patent. *See Id.* at 1381. Aside from the defendant’s verbal representation as to its then-
9 current plan, there was no written suggestion that it would not elect to sue the plaintiff in the future.
10 The court ruled that “We decline to hold that [defendant’s] statement that [defendant] would not sue
11 [plaintiff] eliminated the justiciable controversy caused by [defendant’s] actions, because
12 [defendant] has engaged in a course of conduct that shows a preparedness and willingness to enforce
13 its patent rights. *Id.* The case is clearly distinguishable where, as here, the declaratory judgment
14 defendant has agreed in writing not to sue the plaintiff. *See Crossbow Technology, Inc. v. YH*
15 *Technology*, 531 F.Supp.2d 1117, 1123 (N.D. Cal. 2007) (distinguishing *SanDisk*; holding that “a
16 statement of intent not to sue during negotiations is not the same as a covenant not to sue in the
17 future for infringement”).

18 Application of *SanDisk* does not suggest that there is a case or controversy in this action.
19

20 **IV. THE COURT SHOULD DISMISS THIS CASE BECAUSE IT**
21 **INVOLVES THE SAME FACTUAL AND LEGAL ISSUES AS *HARD***
22 ***DRIVE II.***

23 Plaintiff argues that the “first to file doctrine” does not require dismissal of this action, based
24 primarily on factual distinctions that it seeks to draw from cases cited in Defendant’s Motion.
25 Plaintiff also argues that Defendant should be “judicially estopped” from seeking application of the
26 doctrine. Neither argument is valid.

27 Plaintiff’s circular estoppel argument is that Defendants informed the court in *Hard Drive I*
28 that this case should not be deemed to be related to *Hard Drive I*, because *Hard Drive I* involved

1 different legal and factual issues than this one. Opp. p. 10. While Plaintiff accuses Defendant of
2 playing “fast and loose with the courts” by seeking application of the “first-filed doctrine,” in reality,
3 it is Plaintiff that is playing fast and loose by misstating Defendant’s argument. The “first-filed”
4 case Defendant referred to in opposing a motion to deem cases related was *Hard Drive II*, not *Hard*
5 *Drive I* as Plaintiff suggests. In *Hard Drive II*, Defendant identified Wong as the IP owner, and
6 sought and obtained permission from the Court to take her deposition. *Hard Drive II* Dkt. #10. That
7 order apparently led Plaintiff to file this suit, which for all practical purposes appears to be simply a
8 way of avoiding having her deposition taken. Irrespective of the motive, it is clear that *Hard Drive*
9 *II* and this case involve the same factual and legal issues: In its case, Hard Drive seeks to depose
10 Wong for purposes of determining who used her IP address to download its copyrighted materials.
11 In this case, Wong seeks a declaration that it did not infringe upon the Hard Drive copyright at issue
12 in *Hard Drive II*. The cases clearly involve identical legal and factual issues.

13 Plaintiff’s attempts to distinguish the cases Defendant cited in its Motion, based on
14 procedural and factual differences, also fails, because the “first to file” doctrine has been recognized
15 in this District as a doctrine of comity in which a district court may decline jurisdiction where a case
16 presents the same parties and issues already pending elsewhere. See, e.g., *Mediostream, Inc. v.*
17 *Priddis Music, Inc.*, No. 07-2127, 2007 U.S. Dist. LEXIS 73707, at *6 (N.D. Cal. Sept. 24, 2007)
18 (citing *Pacesetter Systems, Inc. v. Medtronic, Inc.*, 679 F.2d 93, 94-5 (9th Cir. 1982)). Courts may
19 invoke that doctrine to transfer or stay an action when a similar complaint is already on file.
20 *Alltrade, Inc. v. Uniweld Products, Inc.*, 946 F.2d 622, 623 (9th Cir. 1991). The purposes of this
21 doctrine include promoting judicial efficiency and the avoiding the risk of inconsistent outcomes.
22 *Church of Scientology of California v. United States Dep’t of Army*, 611 F.2d 738, 750 (9th Cir.
23 1979). Courts generally consider three factors in applying the doctrine: (1) the chronology in which
24 the two actions were filed; (2) the similarity of the parties; and (3) the factual similarities. *Greenline*
25 *Industries v. Agri-ProcessInnovations, LLC*, No. 08-2438, 2008 U.S. Dist. LEXIS 60504, at *8
26 (N.D. Cal. July 28, 2008).

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 1, 2012, all individuals of record who are deemed to have consented to electronic service are being served a true and correct copy of the foregoing document using the Court's ECF system, in compliance with Local Rule 5-6 and General Order 45.

/s/ Brett L. Gibbs