

In March, the U.S. District Court for the Northern District of California granted Facebook’s motion to dismiss a copyright infringement claim brought by Daniel M. Miller, the creator of an online video game called *Boomshine*. Plaintiff alleged that Facebook and Yao Wei Yeo “reproduced and distributed” Yeo’s video game, *ChainRxn*, as an online game in Facebook’s Application Directory, and that *ChainRxn* copied the look and feel of *Boomshine*. Under Fed. R. Civ. P. 12(b)(6), a court may dismiss a case if it fails to state a claim upon which relief can be granted. In applying this rule, the court held that Miller’s claim failed to state claims for either direct or indirect copyright infringement. *Miller v. Facebook, Inc.*, 3:10-cv-00264-WHA (N.D.Cal. March 31, 2010)

The decision is notable for its refusal – in the context of a motion to dismiss – to accept bare bones allegations of copyright infringement that nonetheless arguably asserted the necessary elements of a claim. Yet, faced with somewhat ambiguous assertions regarding Facebook’s role in the alleged infringement, the court granted Facebook’s motion to dismiss, holding that Miller’s allegations were merely disguised legal conclusions.

The complaint alleged the following, which the court accepted as true for purposes of the motion: In early 2007, Miller created the video game *Boomshine* and subsequently published it on his website K2xL.com; thereafter, he registered the copyrights in the game. In 2009, Yeo and his company Zwigglers Apps published *ChainRxn* on Facebook’s website. Facebook included the game in its Application Directory, which according to the complaint “allow[ed] every Facebook user to search and view the application from within the directory.”

Miller filed suit in U.S. District Court for the Northern District of Georgia in October 2009, asserting that *ChainRxn* infringed Miller’s copyrights because “ChainRxn copies the look and feel of Boomshine by incorporating almost every visual element of the game.” The case was later transferred to California.

After the case landed in California, Facebook moved to dismiss for failure to state a claim and District Judge William Alsup granted the motion. The court noted that plaintiff failed to specify whether his single copyright claim alleged direct or indirect copyright infringement, and dismissed as to both possible claims.

In reasoning that a direct infringement claim did not exist, the court stated that Miller’s complaint did not satisfy one of the two requisite parts for such a claim. Although Miller owned the allegedly infringed material, there were insufficient factual allegations illustrating Facebook’s violation of at least one of the exclusive rights under Section 106 of the Copyright Act, including copying, displaying, or distributing copies of *Boomshine*. “As the complaint currently reads, it is unclear whether defendant Facebook published a copy of the game on its application directory, published a link to the game, included a place for Facebook users to blog about the game, or published a combination of these and/or other things,” the court observed in dismissing.

The court next considered the indirect infringement claim. To prove such, a plaintiff must allege that a third party directly infringed plaintiff’s copyright and that the alleged indirect infringer engaged in acts constituting contributory or vicarious infringement. The court found the first requirement met in Miller’s allegations that Yeo published a video game that copied *Boomshine*’s look and feel. However, the same ambiguities that defeated the direct infringement claim against Facebook marked the secondary liability claim as defective. Insofar as the complaint alleged that Facebook induced, caused, or materially contributed to the infringement by refusing to remove *ChainRxn* from its website, this allegation was not enough because the complaint did not allege just what Facebook published on its website, making it impossible to determine what should be removed. Similarly, the court held the vicarious infringement allegations insufficient because the same ambiguous allegations did not show how Facebook had the right and ability to supervise the allegedly infringing conduct.

The court left the possibility open for Miller to amend his claims. This case serves as a reminder to potential plaintiffs that factual allegations must be clearly presented in a complaint in order to have a chance at success in a copyright infringement claim, regardless of whether or not the claim has merit.

Web-Based Specimens of Use for Goods Must Be More Than Mere Advertising

The Trademark Trial and Appeal Board (TTAB) recently issued a precedential ruling involving web-based specimens of use. In *In re Quantum Foods, Inc.*, 94 USPQ2d 1375 (TTAB 2010), the TTAB found the applicant's specimens invalid for failing to display information sufficient to lead a consumer to purchase the goods at issue. While this ruling is not a vast departure from well-accepted trademark principals or practice, it does serve to clarify that web-based specimens used to support registrations for goods, as opposed to those submitted in relation to services, must be more than mere advertising. Specifically, in addition to bearing the mark sufficiently near a picture or description of the goods, the specimens must include information necessary to order the goods.

In *Quantum Foods* the applicant filed an intent-to-use application for the mark Providing Protein and Menu Solutions™ ("Protein" disclaimed), for "processed meats, beef, pork, poultry, and seafood sold in portions; fully cooked entrees consisting primarily of meat, beef, pork, poultry or seafood."

Upon receiving a notice of allowance and having its initial specimen refused by the examiner, the applicant submitted an image of a page from its website as a substitute specimen. The image shows the Quantum Foods logo prominently displayed in the top left corner. The top right corner of the page – just to the right of the Quantum Foods logo – contains four links, labeled, "About Us," "For Restaurants," "For Consumers," and "For Foodservice." Each of these links appears within a small picture of a meat dish. Below, in the main section of the page, the phrase "Providing Protein and Menu Solutions™" appears above three pictures of meat dishes. Immediately below the three pictures appears the following description: "We believe you shouldn't

have to settle for a product or a 'me too' menu. That's why we work with you to create truly custom beef, pork and poultry solutions that perform in your kitchen and on your menu. Because at Quantum Foods, your success is our first priority."

The examiner refused the substitute specimen, on the grounds that it was merely an advertisement. The applicant appealed. In affirming the examiner's refusal, the TTAB held that "if there is no way for a consumer, when visiting a webpage, to order the goods being promoted, then the use of a proposed mark in connection with the goods on the webpage is nothing more than advertising." The TTAB did acknowledge the validity of web-based specimens, likening their use and necessity in e-commerce to that of point-of-sale displays in the brick and mortar space. However, like a brick and mortar point-of-sale display, a web-based specimen "must contain adequate information for placing orders for the goods." Accordingly, the TTAB rejected the applicant's argument that customers can access a "customer service page" deeper within the website, which contains an email address and toll-free number, and at which orders can be placed. In this case, the TTAB stated that based on the specimen at issue, "it is not even clear what goods, if any, can be ordered from applicant."

In order to avoid similar run-ins with the trademark office or the TTAB, trademark owners should ensure that any web-based specimen submitted in support of the registration of goods (1) includes a picture or detailed description of the goods; (2) shows the mark sufficiently near the picture or description; and (3) includes information necessary to order the goods.