

1 DURIE TANGRI LLP
MARK A. LEMLEY (SBN 155830)
2 mlemley@durietangri.com
JOSEPH C. GRATZ (SBN 240676)
3 jgratz@durietangri.com
GENEVIEVE P. ROSLOFF (SBN 258234)
4 grosloff@durietangri.com
217 Leidesdorff Street
5 San Francisco, CA 94111
Telephone: 415-362-6666
6 Facsimile: 415-236-6300

7 BRACEWELL & GIULIANI LLP
EDWARD A. CAVAZOS
8 ed.cavazos@bgllp.com
CONOR M. CIVINS
9 conor.civins@bgllp.com
111 Congress Avenue, Suite 2300
10 Austin, TX 78701

11 Attorneys for Defendant
LAMEBOOK, LLC
12

13 IN THE UNITED STATES DISTRICT COURT
14 FOR THE NORTHERN DISTRICT OF CALIFORNIA
15 SAN FRANCISCO DIVISION

16 FACEBOOK, INC., a Delaware corporation,

17 Plaintiff,

18 v.

19 LAMEBOOK, LLC, a Texas limited liability
20 company,

21 Defendant.
22
23
24
25
26
27
28

Case No. 3:10-cv-05048-RS

**DEFENDANT LAMEBOOK, LLC'S REPLY
IN SUPPORT OF ITS MOTION TO DISMISS**

Date: March 31, 2011

Time: 1:30 p.m.

Ctrm: Courtroom 3, 17th Floor

Judge: The Honorable Richard Seeborg

1 **I. ARGUMENT**

2 **A. Lamebook agrees that the Texas court should determine venue.**

3 In its Opposition, Facebook “requests that the decision [on this motion] be delayed until such
4 time as the Court in Texas rules on Facebook’s pending motion to dismiss.” Plaintiff Facebook, Inc.’s
5 Opposition to Defendant’s Motion to Dismiss, ECF No. 25 (“Opp.”) at 7. Lamebook agrees. The
6 motion in the Texas action is fully briefed and set for hearing on March 25, 2011. If the Texas court
7 denies Facebook’s motion, this case will proceed in Texas; if the Texas court grants Facebook’s motion,
8 this case will proceed in California. It is appropriate that the court in the first-filed action be the court to
9 determine venue. The “argument should be addressed to the court in the first-filed action” and “the court
10 in the second-filed action is not required to duplicate this inquiry.” *Pacesetter Sys., Inc. v. Medtronic,*
11 *Inc.*, 678 F.2d 93, 96-97 (9th Cir. 1982) (affirming the second-filed court's dismissal under the first-to-
12 file rule).

13 **B. Suit was not imminent when Lamebook filed in Texas.**

14 Facebook argues that suit was imminent on November 3, 2010 because, *the previous July*,
15 Facebook had made a general statement about being “prepared to enforce its rights to the full extent of
16 the law.” Opp. at 3. Facebook also argues that Lamebook believed suit was imminent because Facebook
17 “repeatedly warned Lamebook that it must change its name or face legal action,” Opp. at 6, but the
18 evidence Facebook cites shows only that Facebook suggested in early August of 2010 it was “prepared to
19 litigate, if necessary, to enforce its rights.” Declaration of Kathleen E. Johnston in Support of Defendant
20 Facebook, Inc.’s Motion to Dismiss Complaint for Declaratory Judgment, ECF No. 26-2 (“Johnston
21 Decl.”) at ¶ 4. The communications between Lamebook and Facebook reveal that Facebook took special
22 care *not* to threaten litigation. The only specific threats articulated by Facebook throughout the eight
23 months of discussions between the parties were the removal of Lamebook’s “Facebook page” from the
24 Facebook website and a potential opposition to Lamebook’s trademark application at the United States
25 Patent and Trademark Office. *See* Declaration of Conor M. Civins in Support of Plaintiff Lamebook,
26 LLC’s Response to Defendant Facebook, Inc.’s Motion to Dismiss Complaint for Declaratory Judgment,
27
28

1 ECF No. 19-3 (“Civins Decl.”) at ¶¶ 4-5.¹ Such “veiled threats of legal action” fall well below the
2 relevant standard: that they provide “specific, concrete indications that a suit by defendant was
3 *imminent.*” *Guthy-Renker Fitness, L.L.C. v. Icon Health & Fitness, Inc.*, 179 F.R.D. 264, 271 (C.D. Cal.
4 1998) (emphasis in original) (citation omitted).

5 To say that “legal action” which had been threatened some months before but had not
6 materialized was “imminent” stretches that term beyond its limits. Imminence is a well-developed
7 concept in the law, and excludes uncertain occurrences threatened in the distant past. For example, “[a]n
8 ‘imminent’ harm is one which is immediately likely and threatening.” *United States v. Thompson*, No.
9 90-10118, 1991 WL 67873, at *1 (9th Cir. 1991). “‘Imminent’ dangers are those dangers which are
10 about to occur at any moment or are impending.” *Abdul-Akbar v. McKelvie*, 239 F.3d 307, 315 (3d Cir.),
11 *cert. denied*, 533 U.S. 963 (2001) (citation omitted). Likewise “imminent” suits are those which are
12 about to be filed at any moment.

13 There was no specific, imminent threat of legal action (let alone litigation), and Facebook’s
14 evidence does not suggest otherwise. Facebook’s communications did nothing more than “suggest[]” to
15 Lamebook the “possibility of legal action,” *Intersearch Worldwide, Ltd. v. Intersearch Group, Inc.*, 544
16 F. Supp. 2d 949, 960 (N.D. Cal. 2008), which was specifically articulated as a potential opposition to
17 Lamebook’s trademark application at the PTO. Talks had been dragging on, and seemed to be going
18 nowhere. Facebook wasn’t returning calls promptly. Civins Decl. at ¶¶ 3-9. Meanwhile, Lamebook
19 faced severe uncertainty about its website and Facebook’s intentions. Under these circumstances,
20 Lamebook’s filing of its declaratory action was not anticipatory, and Lamebook certainly did not mislead
21 Facebook. As this Court has held:

22 A letter which suggests the possibility of legal action, however, in order to
23 encourage or further a dialogue, is not a specific, imminent threat of legal
24 action. Likewise, a reasonable apprehension that a controversy exists
sufficient to satisfy the constitutional requirements for a declaratory
judgment action is not equivalent to an imminent threat of litigation. [This

25 ¹ The content and timing of the discussions between the parties is briefed in detail in Lamebook's
26 Response to Facebook’s Motion to Dismiss (“Lamebook’s Response”) filed in the Western District of
27 Texas. Rather than burden the Court with another recital of the events leading up to litigation, Lamebook
28 respectfully refers the Court to pages 4-8 of Lamebook’s Response filed in the Western District of Texas
and filed in the instant action as Exhibit 2 to Declaration of Joseph C. Gratz in Support of Defendant
Lamebook, LLC’s Motion to Dismiss, ECF No. 19-2.

1 is] because a declaratory action is an appropriate vehicle to alleviate the
2 necessity of waiting indefinitely for a trademark owner to file an
infringement action.

3 *Intersearch Worldwide*, 544 F. Supp. 2d at 960-61 (citations and internal modifications omitted).
4 *See also BuddyUSA, Inc. v. Recording Indus. Ass’n of Am., Inc.*, 21 F. App’x 52, 55 (2d Cir. 2001)
5 (allowing the first-filed action for declaration of noninfringement to proceed because “a declaratory
6 action is not anticipatory where it is filed in response to a letter that is indicative of negotiations”).

7 **C. Lamebook sued in Austin because Lamebook is based in Austin, not because of**
8 **“forum shopping.”**

9 As Facebook points out in its Opposition, “the anticipatory suit doctrine allows the Court to look
10 to factors relating to fairness and judicial efficiency,” including the “whether the plaintiff seeking
11 declaratory relief appears to be engaged in forum shopping.” Opp. at 6 (citing *Kinetic Concepts, Inc. v.*
12 *Connetics Corp.*, No. Civ.A.SA-04-CA0237XR, 2004 WL 2026812, at *3 (W.D. Tex. Sept. 8, 2004)).

13 Facebook doesn’t argue that Lamebook has engaged in forum shopping by choosing to file in
14 Texas—nor could it. Lamebook chose to file in the Western District of Texas for the simple reason that
15 it is a two-person company with all of its operations, documents, and employees located in Austin,
16 Texas. Lamebook gains no unfair procedural or legal advantage by being in the Western District of
17 Texas as opposed to this District. *Cf. Travelers Indem. Co. v. Madonna*, 914 F.2d 1364, 1371 (9th Cir.
18 1990) (typical case of forum shopping involves a plaintiff filing a federal action to “avoid adverse rulings
19 made in the state court or to gain a tactical advantage from the application of federal court rules”);
20 *Cardoza v. T-Mobile USA Inc.*, No. 08-5120 SC, 2009 WL 723843, at *3 (N.D. Cal. March 18, 2009)
21 (“There are no adverse state court rulings at issue here, and Plaintiff has not identified any tactical
22 advantage that T-Mobile would gain from the application of federal court rules if this case were
23 transferred . . .”).

24 ///

25 ///

26 ///

27 ///

1 **II. CONCLUSION**

2 For the foregoing reasons, and the reasons set forth in its Motion, Lamebook respectfully requests
3 that the Court dismiss the instant lawsuit in favor of the earlier-filed lawsuit currently pending in the
4 Western District of Texas.

5 Dated: March 17, 2011

DURIE TANGRI LLP

6
7 By: /s/ Genevieve P. Rosloff

8 MARK A. LEMLEY
9 JOSEPH C. GRATZ
10 GENEVIEVE P. ROSLOFF

11 Attorneys for Defendant LAMEBOOK, LLC
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

1 **CERTIFICATE OF SERVICE**

2 I certify that all counsel of record are being served on March 17, 2011 with a copy of this
3 document via the Court's CM/ECF system.

4 Michael G. Rhodes rhodesmg@cooley.com

5 Gavin L. Charlston gcharlston@cooley.com

6 Anne H. Peck peckah@cooley.com

7 Jeffrey T. Norberg jnorberg@cooley.com

8 */s/ Genevieve P. Rosloff*

9 _____
10 GENEVIEVE P. ROSLOFF