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5 UNITED STATES DISTRICT COURT
6 FOR THE NORTHERN DISTRICT OF CALIFORNIA
7 OAKLAND DIVISION
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9 ADOBE SYSTEMS INCORPORATED, a
10 Delaware Corporation,

11 Plaintiff,

12 vs.

13 A & S ELECTRONICS, INC., a California
14 Corporation d/b/a TRUSTPRICE; ALAN Z.
15 LIN, an Individual; and DOES 1-10,
16 Inclusive,

17 Defendants.

Case No: C 15-2288 SBA

**ORDER GRANTING IN PART
AND DENYING IN PART
DEFENDANTS' MOTION TO
DISMISS ALL CLAIMS; DENYING
ALTERNATIVE MOTION FOR A
MORE DEFINITE STATEMENT**

Dkt. 53

18 Plaintiff Adobe Systems Inc. ("Plaintiff" or "Adobe") brings the instant action
19 against A & S Electronics, Inc. ("A&S"), and its owner, Alan Z. Lin ("Lin"). The First
20 Amended Complaint ("FAC") alleges claims for trademark infringement, false designation
21 of origin and trademark dilution under the Lanham Act; copyright infringement; and breach
22 of contract. The parties are presently before the Court on Defendants' Motion to Dismiss
23 All Claims, and in the Alternative, for A More Definite Statement. Dkt. 53. Having read
24 and considered the papers filed in connection with these matters and being fully informed,
25 the Court hereby GRANTS IN PART and DENIES IN PART the motion to dismiss, and
26 DENIES the alternative motion for a more definite statement. The Court GRANTS Adobe
27 leave to amend to file a Second Amended Complaint. The Court, in its discretion, finds this
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1 matter suitable for resolution without oral argument. See Fed. R. Civ. P. 78(b); N.D. Cal.
2 Civ. L.R. 7-1(b).

3 **I. BACKGROUND**

4 **A. FACTUAL SUMMARY**

5 Adobe is a software company that produces and distributes Adobe Acrobat-branded
6 software. FAC ¶¶ 21-23, Dkt. 41. The ADOBE® and ACROBAT® marks are registered
7 with the Patent and Trademark Office (“PTO”). Id. ¶¶ 21-22, 38. Defendant A&S is a
8 corporation doing business as TRUSTprice, which sells various software products,
9 including Adobe-branded products, through its website, www.TRUSTprice.com. Id. ¶ 30.
10 Defendant Lin owns A&S and is alleged to be its alter ego. Id. ¶¶ 4-5.

11 On or about April 17, 2014, A&S and Adobe entered into an Adobe Partner
12 Connection Program Reseller Agreement (“Reseller Agreement”), pursuant to which A&S
13 became an authorized distributor of Adobe software products. Id. ¶ 32 & Ex. C. Under the
14 agreement, A&S is permitted to sell Original Equipment Manufacturer (“OEM”) versions
15 of Adobe software, provided that it is distributed as a bundle with approved hardware
16 components. Id. ¶ 33. OEM software may not be unbundled and distributed separately
17 from the specific hardware components for which they were intended. Id. OEM software
18 is not the same as full retail versions of the same type of Adobe branded software, as it
19 “usually” has “less functionality and no technical support.” Id. According to Adobe, A&S
20 secured the Reseller Agreement for the purpose of leading consumers to believe that it is a
21 “legitimate” reseller, despite the fact that its conduct violated such agreement. Id. ¶ 41. On
22 information and belief, Adobe claims that A&S purchased copies of Adobe-branded
23 software from “unauthorized sources” to resell the same in the United States. Id. ¶ 42.

24 Adobe regularly conducts investigations to identify sales of unauthorized, pirated
25 and counterfeit versions of its software. Id. ¶ 30. On May 28, 2014, Adobe’s investigator
26 purchased a copy of Adobe Acrobat X Standard v.10 for Windows – 1 User / 2 PCs
27 (License Key Card only – No media) (“Adobe Acrobat X Standard”) from the TRUSTprice
28 website. Id. ¶ 37. The shipment from TRUSTprice included a card displaying a serial

1 number license key (“serial license key”), which is necessary to unlock and operate the
2 software. Id. ¶ 38. The card bore the ADOBE® mark. Id. However, the card “did not
3 originate with [Adobe]” and appears to be “counterfeit.” Id. Adobe claims that the serial
4 license key corresponded to an OEM product which was not authorized for resale separate
5 from physical media. Id.

6 **B. PROCEDURAL HISTORY**

7 On April 21, 2015, Adobe filed the instant action against A&S and Lin. The original
8 Complaint alleged seven claims, styled as follows: (1) Federal Trademark Infringement,
9 15 U.S.C. § 1114; (2) False Designation of Origin/False or Misleading Advertising /Unfair
10 Competition, 15 U.S.C. §1125(a); (3) Trademark Dilution, 15 U.S.C. §1125(c); (4) Federal
11 Copyright Infringement, 17 U.S.C. § 501(a); (5) Unlawful/Unfair /Fraudulent Business
12 Practices, Cal. Bus. & Prof. Code § 17200; (6) Breach of Contract; and (7) Digital
13 Millennium Copyright Act (“DMCA”) Violation, 17 U.S.C. § 1201. In response to the
14 Complaint, Defendants filed a motion to dismiss all claims, along with a motion to strike
15 Exhibits A and B to the Complaint. Those exhibits purported to list hundreds of trademark
16 and copyright registrations issued to ADOBE by the Patent and Trademark Office which
17 were potentially violated by Defendants.

18 On August 19, 2015, the Court partially granted Defendants’ motion, dismissing:
19 (1) the claims for trademark infringement, false designation of origin, trademark dilution,
20 and violation of the UCL, with leave to amend; and (2) the DMCA claim without leave to
21 amend. The Court denied the motion to dismiss as to Plaintiff’s claims for copyright
22 infringement and breach of contract. The Court denied Defendants’ motion to strike, but
23 ordered Adobe to file an amended complaint listing the trademarks and copyrights it has a
24 good faith basis for claiming that Defendants infringed.

25 On September 2, 2015, Adobe filed its First Amended Complaint (“FAC”), which
26 alleges the following five claims: (1) Federal Trademark Infringement, 15 U.S.C. § 1114;
27 (2) False Designation of Origin/False or Misleading Advertising /Unfair Competition,
28 15 U.S.C. §1125(a); (3) Trademark Dilution, 15 U.S.C. §1125(c); (4) Federal Copyright

1 Infringement, 17 U.S.C. § 501(a); and (5) Breach of Contract. Dkt. 41. In response to the
2 FAC, Defendants have filed a motion to dismiss all claims for failure to state a claim under
3 Federal Rule of Civil Procedure 12(b)(6), or alternatively, for a more definite statement
4 under Rule 12(e). Dkt. 53. The matter has been fully briefed and is ripe for adjudication.

5 **II. LEGAL STANDARD**

6 Rule 12(b)(6) “tests the legal sufficiency of a claim.” Navarro v. Block, 250 F.3d
7 729, 732 (9th Cir. 2001). “Dismissal under Rule 12(b)(6) is proper when the complaint
8 either (1) lacks a cognizable legal theory or (2) fails to allege sufficient facts to support a
9 cognizable legal theory.” Somers v. Apple, Inc., 729 F.3d 953, 959 (9th Cir. 2013). “Rule
10 12(b)(6) is read in conjunction with Rule 8(a), which requires not only ‘fair notice of the
11 nature of the claim, but also grounds on which the claim rests.’” Zixiang Li v. Kerry, 710
12 F.3d 995, 998-99 (9th Cir. 2013) (quoting in part Bell Atl. Corp. v. Twombly, 550 U.S.
13 544, 556 n.3 (2007)). “To survive a motion to dismiss, a complaint must contain sufficient
14 factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’”
15 Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (quoting Twombly, 550 U.S. at 570).

16 In assessing the sufficiency of the pleadings, “courts must consider the complaint in
17 its entirety, as well as other sources courts ordinarily examine when ruling on Rule 12(b)(6)
18 motions to dismiss, in particular, documents incorporated into the complaint by reference,
19 and matters of which a court may take judicial notice.” Tellabs, Inc. v. Makor Issues &
20 Rights, Ltd., 551 U.S. 308, 322 (2007). The court is to “accept all factual allegations in the
21 complaint as true and construe the pleadings in the light most favorable to the nonmoving
22 party.” Outdoor Media Group, Inc. v. City of Beaumont, 506 F.3d 895, 899-900 (9th Cir.
23 2007). Where a complaint or claim is dismissed, leave to amend generally is granted,
24 unless further amendment would be futile. Cervantes v. Countrywide Home Loans, Inc.,
25 656 F.3d 1034, 1041 (9th Cir. 2011).

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1 **III. DISCUSSION**

2 **A. LANHAM ACT CLAIMS**

3 Defendants contend that Adobe’s Lanham Act claims should be dismissed for the
4 following reasons: (1) Adobe has not sufficiently alleged consumer confusion; (2) their use
5 of Adobe’s marks is permissible as nominative fair use; and (3) the claims conflict with the
6 claim for copyright infringement. The Court discusses each contention, in turn.

7 **1. Likelihood of Consumer Confusion**

8 “To prevail on its Lanham Act trademark claim, a plaintiff must prove: (1) that it has
9 a protectible ownership interest in the mark; and (2) that the defendant’s use of the mark is
10 likely to cause consumer confusion.” Rearden LLC v. Rearden Commerce, Inc., 683 F.3d
11 1190, 1202-203 (9th Cir. 2012) (internal quotation marks and citations omitted). A false
12 designation of origin claim likewise requires a showing of a likelihood of consumer
13 confusion. New W. Corp. v. NYM Co. of Cal., Inc., 595 F.2d 1194, 1201 (9th Cir. 1979)
14 (“Whether we call the violation infringement, unfair competition or false designation of
15 origin, the test is identical[:] is there a ‘likelihood of confusion?’”).

16 Defendants argue that Adobe’s allegations of customer confusion are deficient
17 because they do not expressly recite that their distribution of the serial license key “actually
18 prevented the purchaser from receiving the expected level of service or support for use [sic]
19 Adobe Acrobat X Standard software.” Dkt. 53 at 12. Although Adobe’s opposition does
20 not address this contention specifically, the Court finds the argument unpersuasive. The
21 likelihood of confusion analysis focuses on “whether a ‘reasonably prudent consumer’ in
22 the marketplace is likely to be confused as to the origin of the good or service bearing one
23 of the marks.” Rearden, 683 F.3d at 1244.¹ Thus, whether or not the purchaser in this
24 particular instance had access to the requisite level of service and support for a domestic

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26 ¹ In assessing consumer confusion, courts in this Circuit typically apply the eight
27 factors set out in: (1) the strength of the mark; (2) the proximity of the goods; (3) the
28 similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used;
defendant’s intent in selecting its mark; and (8) likelihood of expansion into other markets.
AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979).

1 version of Adobe Acrobat X Standard software is not germane to whether a reasonably
2 prudent customer would be confused regarding the origin of the software.

3 The Court likewise rejects Defendants’ ancillary assertion that “[t]he FAC alleges no
4 basis for believing that consumers visiting ‘TRUSTprice.com’ would reasonable believe
5 that Adobe is sponsoring or endorsing TRUSTprice’s sales.” Dkt. 53 at 13. However, the
6 FAC expressly alleges that Defendants website advertised and sold Adobe products bearing
7 Adobe’s protected marks which they had no right to distribute. FAC ¶ 30. Further, Adobe
8 avers that Defendants entered into the Reseller Agreement with Adobe “for the purpose of
9 appearing legitimate to consumers despite said ongoing and willful infringing activities,
10 and without any intention of abiding by the [R]eseller [A]greement.” Id. ¶ 41. Those
11 allegations, taken as true, support Adobe’s claim of consumer confusion.

12 Finally, Defendants claim that any consumer confusion is attributable to Adobe’s
13 business practice of distributing different versions of its software in different markets at
14 different prices. Dkt. 53 at 12. That argument misses the point. The Lanham Act protects
15 against the unauthorized use of a trademark in a manner likely to cause consumer
16 confusion. See 15 U.S.C. §§ 1114(1), 1125(a)(1)(A). Whether or not Defendants engage
17 in price discrimination does not obviate the possibility that a reasonably prudent customer
18 would be confused regarding the sources of software as a result of their allegedly
19 unauthorized use of Adobe’s marks.

20 2. Nominative Fair Use

21 Defendants next contend that Adobe’s Lanham Act claims fail under the doctrine of
22 nominative fair use. Nominative fair use is a defense to trademark infringement in cases
23 where the alleged infringer uses a trademark “to refer to a particular product for purposes of
24 comparison, criticism, point of reference or any other such purpose.” New Kids on the
25 Block v. News Am. Publ’g, Inc., 971 F.2d 302, 306 (9th Cir. 1992); e.g., Toyota Motor
26 Sales, U.S.A., Inc. v. Tabari, 610 F.3d 1171, 1175-76 (9th Cir. 2010) (holding that a car
27 broker’s domain names—“buy-a-lexus.com” and “buyorleaselexus.com” may be protected
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1 as nominative fair use because they describe the manufacturer of the cars being sold). For
2 the defense to apply, three criteria must be satisfied:

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4 First, the product or service in question must be one not readily
5 identifiable without use of the trademark; second, only so much
6 of the mark or marks may be used as is reasonably necessary to
7 identify the product or service; and third, the user must do
8 nothing that would, in conjunction with the mark, suggest
9 sponsorship or endorsement by the trademark holder.

10 Playboy Enters., Inc. v. Welles, 279 F.3d 796, 801 (9th Cir. 2002) (quoting New Kids on
11 the Block, 971 F.2d at 308).²

12 Here, the pleadings allege that Defendants distributed a fabricated serial license key
13 card displaying Adobe's marks in the course of distributing software neither intended for
14 sale in the United States nor authorized to be sold separately from an OEM product. FAC
15 ¶¶ 38, 56. According to Adobe, Defendants' use of Adobe's marks was not intended to
16 describe Adobe's product, but rather to make it appear that the software was sanctioned by
17 Adobe for sale and distribution. Id. In view of these allegations, the Court cannot conclude
18 at this stage of the litigation that Defendants' use of Adobe's marks can be classified as
19 nominative fair use. See E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095,
20 1099 (9th Cir. 2008) (finding that the nominative fair use defense did not apply because the
21 defendant's use of the plaintiff's trademarked logo was not for descriptive purposes).

22 3. Conflict with Copyright Law

23 Defendants contend that Adobe's Lanham Act claims are precluded under Dastar
24 Corp v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003), which held that the
25 Lanham Act should not be construed in a manner that would cause a "conflict with the law
26 of copyright[.]" Id. at 33; see Sybersound Records, Inc. v. UAV Corp., 517 F.3d 1137,
27 1144 (9th Cir. 2008) (noting that Dastar instructs courts "to avoid overlap between the

28 ² In cases in which the defendant raises a nominative use defense, the above three-
factor test should be applied instead of the test for likelihood of confusion set forth in
Sleekcraft. Playboy Enters., 279 F.3d at 801.

1 Lanham and Copyright Acts”). But aside from citing Dastar, Defendants fail to present any
2 argument demonstrating that any conflict between Adobe’s copyright and Lanham Act
3 claims exists in this case. See Indep. Towers of Wash. v. Wash., 350 F.3d 925, 930 (9th
4 Cir. 2003) (“It is [the movant’s] burden . . . to present the court with legal arguments to
5 support its claims.”). The mere fact that trademark and copyright claims are alleged in the
6 FAC, standing alone, does not implicate the concerns expressed in Dastar. See Luxul Tech.
7 Inc. v. Nectarlux, LLC, 78 F.Supp.3d 1156, 1172 (N.D. Cal. 2015) (“[A]t the pleading
8 stage, the Court is not persuaded that Plaintiff’s Lanham Act claims are precluded merely
9 because Plaintiff also alleges copyright infringement.”).

10 For the reasons set forth above, Defendants’ motion to dismiss Adobe’s Lanham Act
11 claims is DENIED.

12 **B. COPYRIGHT INFRINGEMENT**

13 Defendants contend that Adobe’s claim for copyright infringement must be
14 dismissed on the ground that they have not violated any exclusive right conferred to Adobe
15 under the Copyright Act. “Copyright is a federal law protection provided to the authors of
16 ‘original works of authorship,’ including software programs.” Vernor v. Autodesk, Inc.,
17 621 F.3d 1102, 1106-107 (9th Cir. 2010) (citing 17 U.S.C. §§ 101-103). In this case, the
18 FAC alleges that Defendants distributed its copyrighted software in violation of the
19 Reseller Agreement, thereby willfully infringing Adobe’s copyright registrations. FAC
20 ¶¶ 36, 87-92. “To recover for copyright infringement based on breach of a license
21 agreement, (1) the copying must exceed the scope of the defendant’s license and (2) the
22 copyright owner’s complaint must be grounded in an exclusive right of copyright (e.g.,
23 unlawful reproduction or distribution).” MDY Indus., LLC v. Blizzard Entmn’t, Inc., 629
24 F.3d 928, 940 (9th Cir. 2010). The latter element requires that “there must be a nexus
25 between the condition and the licensor’s exclusive rights of copyright.” Id. at 941.

26 None of the discursive arguments posited by Defendants for the dismissal of
27 Adobe’s copyright infringement claim are persuasive. First, they argue that Adobe has not
28 met the second element of the MDY test; to wit, that there is a nexus between Defendants’

1 violation of the Reseller Agreement and the infringement of at least one of Adobe’s
2 exclusive rights under the Copyright Act. In particular, Defendants contend that the only
3 conduct attributed to them is the sale of a “piece of paper imprinted with a 25-digit key
4 number,” which is “not copyrightable.” Dkt. 53 at 8. The Court previously considered and
5 rejected this argument in connection with Defendants’ prior motion to dismiss. As the
6 Court explained: “Adobe’s copyright infringement claim is not premised on whether the
7 serial license key is itself copyright-protected, but rather, the assertion that Defendants
8 distributed Adobe software in violation of the Reseller Agreement.” Dkt. 40 at 6.³ In other
9 words, even if the serial license key is not separately subject to copyright protection,
10 Defendants’ alleged distribution of the code to facilitate the sale and use of software it had
11 no right to distribute is sufficient to state a claim for copyright infringement. S.O.S., Inc. v.
12 Payday, Inc., 886 F.2d 1081, 1087 (9th Cir. 1989) (“A licensee infringes the owner’s
13 copyright if its use exceeds the scope of its license.”).

14 Next, Defendants argue that no violation of the Copyright Act occurred because as
15 the putative owner of the software, they have the right to make copies of the same. Dkt. 53
16 at 8-9. “The Copyright Act confers several exclusive rights on copyright owners, including
17 the exclusive rights to reproduce their works and to distribute their works by sale or rental.”
18 Vernor v. Autodesk, Inc., 621 F.3d 1102, 1106-107 (9th Cir. 2010) (citing 17 U.S.C.
19 §§ 101-103). That right is not unlimited. Id. Under the affirmative defense known as the
20 first sale doctrine, an owner of a copyrighted work may resell those copies. 17 U.S.C.
21 § 109(a). However, this affirmative defense is unavailable to “those who are only licensed
22 to use their copies of copyrighted works.” Id. To determine whether a software user is a
23 licensee or an owner, courts consider whether the “copyright owner (1) specifies that the

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26 ³ Defendants’ present motion to dismiss includes a number of arguments which the
27 Court previously considered and rejected. A motion for reconsideration is subject to the
28 requirements of Civil Local Rule 7-9, which Defendants have not followed. Defendants are
warned that repeating previously-rejected arguments may subject them to sanctions under
28 U.S.C. § 1927.

1 user is granted a license; (2) significantly restricts the user’s ability to transfer the software;
2 and (3) imposes notable use restrictions.” Id. at 1111.

3 The Court found in its prior order that the first sale doctrine did not foreclose Adobe
4 from pursuing a copyright infringement claim. Dkt. 40 at 5-6. In support of that
5 conclusion, the Court noted that the Reseller Agreement explicitly provides that a reseller is
6 granted a license to resell licenses for Adobe software to end users, and obligates the
7 reseller to advise the end user that such software has been “licensed, not sold.” Id. at 6
8 (citing Reseller Agt. § 2.2.1, 2.2.2).⁴ Defendants respond that this requirement merely
9 pertains to what a reseller must inform its customers, and does not establish that Adobe’s
10 software was merely licensed to them for distribution. However, the Reseller Agreement
11 makes clear that Adobe is only granting resellers a license—and not any ownership
12 interest—to resell a license to use its software. Reseller Agt. ¶ 2.2.1 (“Adobe hereby grants
13 Reseller, and Reseller hereby accepts, a non-exclusive and *non-transferable license* to order
14 Software Products under the Authorized Programs from Authorized Adobe Distributors, for
15 the purpose of reselling to End Users in the Territory during the Term of this Agreement.”)
16 (emphasis added). In view of these allegations, the Court finds that Defendants have failed
17 to establish the validity of the first sale affirmative defense at this stage of the litigation.
18 See Sams v. Yahoo! Inc., 713 F.3d 1175, 1179 (9th Cir. 2013) (“[T]he assertion of an
19 affirmative defense may be considered properly on a motion to dismiss where the
20 ‘allegations in the complaint suffice to establish’ the defense.”).

21 Defendants also posit that their conduct is permissible under the essential step
22 defense, which is set forth at 17 U.S.C. § 117(a)(1). “Congress enacted the essential step
23 defense to codify that a software user who is the ‘owner of a copy’ of a copyrighted
24 software program does not infringe by making a copy of the computer program, if the new
25 copy is ‘created as an essential step in the utilization of the computer program in

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27 ⁴ The Reseller Agreement is attached to the Complaint, making it part of the
28 pleadings. Nat’l Ass’n for the Advancement of Psychoanalysis v. Cal. Bd. of Psychology,
228 F.3d 1043, 1049 (9th Cir. 2000) (when determining if the complaint states a claim for
relief “we may consider facts contained in documents attached to the complaint”).

1 conjunction with a machine and . . . is used in no other manner.” Vernor, 621 F.3d at 1109
2 (17 U.S.C. § 117(a)(1)). Like the related first sale doctrine, the essential step defense is
3 applicable only if the alleged infringer is an owner, as opposed to licensee, of the copy of
4 the software in dispute. Id. at 1108-109. As discussed, the pleadings sufficiently allege
5 that Defendants are licensees, not owners. Therefore, the essential step defense does not
6 require the dismissal of Adobe’s copyright claim. Defendants’ motion to dismiss this claim
7 is therefore DENIED.

8 **C. BREACH OF CONTRACT**

9 **1. Sufficiency of the Allegations**

10 Adobe alleges that Defendants breached the terms of the Reseller Agreement “by
11 ordering ADOBE® ACROBAT® software products from unauthorized distributors,
12 offering for sale, selling, and distributing licenses for counterfeit and/or unauthorized OEM
13 software products, by unbundling Adobe branded software, and by distributing
14 unauthorized software serial number license keys not meant for sale in the United States
15 and/or not meant for sale separately from physical media.” FAC ¶ 96. “[T]he elements of
16 a cause of action for breach of contract are (1) the existence of the contract, (2) plaintiff’s
17 performance or excuse for nonperformance, (3) defendant’s breach, and (4) the resulting
18 damages to the plaintiff.” Oasis West Realty, LLC v. Goldman, 51 Cal.4th 811, 821
19 (2011). Defendants challenge the second, third and fourth elements of this test.

20 With regard to the second element of a breach of contract claim, Defendant correctly
21 points out that the FAC does not allege that Adobe performed its obligations (or is excused
22 therefrom) under the Reseller Agreement. A breach of contract claim must allege
23 performance, though this obligation “can be satisfied by allegations in general terms.”
24 Careau & Co. v. Security Pacific Business Credit, Inc., 222 Cal.App.3d 1371, 1389 (1990).
25 Here, Adobe concedes that it has not expressly alleged its own performance, but argues that
26 such performance is “implied” based on allegations that it entered into a Reseller
27 Agreement with Defendants and that Defendants breached the terms of that agreement.
28 Dkt. 54 at 18. The case cited by Defendants, however, does not support that proposition.

1 To the contrary, the complaint in that case expressly alleged that the plaintiffs “performed
2 all conditions, covenants, and promises.” Reinhardt v. Gemini Motor Transport, 879
3 F.Supp.2d 1138, 1143 (E.D. Cal. 2012).

4 Defendants next argue that its alleged one-time distribution of a serial license key
5 does not establish a breach of the Reseller Agreement. The conduct underlying Plaintiff’s
6 breach of contract claim is much broader that Defendants purport it to be. The pleadings
7 clearly allege, inter alia, that Defendants purchased copies of Adobe-branded software
8 intended for international distribution, imported them into the United States, and resold
9 them domestically—all in violation of the Reseller Agreement. FAC ¶¶ 44-46, 96.

10 Defendants’ ancillary contention that Adobe must identify the specific provisions of the
11 Reseller Agreement allegedly breached by them is unsupported and otherwise at odds with
12 Supreme Court authority requiring only that the pleadings provide “fair notice” of the claim
13 being asserted and the grounds upon which it rests. Twombly, 550 U.S. at 555. Although
14 the FAC does not identify the specific sections of the Reseller Agreement that Defendants
15 allegedly violated, it does allege the substance of those provisions, see FAC ¶¶ 33-36,
16 which is sufficient to survive a motion to dismiss, see Frances T. v. Village Green Owners
17 Ass’n, 42 Cal.3d 490, 511 (1986) (holding that a breach of contract claim failed where no
18 provision of the alleged contract imposed an obligation on the defendant).

19 Finally, Defendants assert that Adobe has not sufficiently alleged damages resulting
20 from their alleged breach of the Reseller Agreement. Dkt. 54 at 17. The pleadings allege
21 only that “Defendants [sic] willful breach of the [Reseller Agreement] has damaged
22 Plaintiff entitling it to damages and reasonable fees and costs.” FAC ¶ 97. It is unclear
23 from these conclusory allegations what particular damages Adobe seeks as a remedy for
24 Defendants’ alleged breach of the Reseller Agreement. Dismissal of Adobe’s breach of
25 contract claim is therefore warranted. E.g., Stein v. Bank of Am., N.A., No. 2:10-cv-
26 02827-GEB-EFB, 2011 WL 4594916, at *2-*3 (E.D. Cal. Feb. 23, 2011) (complaint failed
27 to adequately allege damages for breach of contract where complaint only alleged that
28 plaintiff “suffered damages”); In re Zynga Priv. Litig., No. C 10-04680 JWW, 2011 WL

1 7479170, at *2 (N.D. Cal. June 15, 2011) (allegation that plaintiffs have “suffered and will
2 continue to suffer damages and losses” was insufficient to plead damages resulting from a
3 contractual breach).⁵

4 In sum, the Court finds that Adobe has failed to sufficiently allege its performance
5 under the Reseller Agreement or the nature of damages it suffered as a result of
6 Defendants’ alleged breach of that agreement.⁶ Defendants’ motion to dismiss the breach
7 of contract claim is therefore GRANTED.

8 **D. MOTION FOR A MORE DEFINITE STATEMENT**

9 As an alternative to dismissal, Defendants move for a more definite statement,
10 pursuant to Rule 12(e), which provides: “If a pleading is so vague or ambiguous that a
11 party cannot reasonably be required to frame a responsive pleading, the party may move for
12 a more definite statement before interposing a responsive pleading.” Motions for a more
13 definite statement are “proper only where the complaint is so indefinite that the defendant
14 cannot ascertain the nature of the claim being asserted.” Sagan v. Apple Computer, Inc.,
15 874 F.Supp. 1072, 1077 (C.D. Cal. 1994). A plaintiff need only “set forth enough details
16 so as to provide the defendant and the court with a fair idea of the basis of the complaint
17 and the legal grounds claimed for recovery.” Self Directed Placement Corp. v. Control
18 Data Corp., 908 F.2d 462, 466 (9th Cir. 1990). Rule 12(e) motions are viewed with
19 disfavor and are rarely granted. Id.

20 Like the original Complaint, the FAC includes two attachments, identified as
21 Exhibits A and B, each of which lists hundreds of trademark and copyright registrations
22 held by Adobe. In their prior motion, Defendants sought to strike these exhibits on the
23 ground that the pleadings failed to specify which of the litany of registrations allegedly
24

25 ⁵ Adobe’s reliance on California cases for the pleading requirements for contract
26 damages is inapposite, since federal, not state law, controls pleading standard in cases
venued in federal court.

27 ⁶ Alternatively, Defendants contend that the Reseller Agreement is unenforceable on
28 the ground that it impermissibly nullifies their rights under the first sale doctrine, 17 U.S.C.
§ 109(a). As discussed above, this contention lacks merit.

1 were violated by their conduct. The Court denied the motion to strike, but, pursuant to
2 Rule 12(e), ordered Adobe to “expressly allege each trademark or copyright that they
3 believe Defendants have infringed.” Dkt. 40 at 18. In response to the Court’s instructions,
4 Adobe amended its pleadings to specifically identify the trademark and copyright
5 registrations allegedly infringed by Defendants. FAC ¶¶ 39, 90.

6 In their present motion, Defendants contend that a more definite statement is
7 necessary on the ground that Adobe has not specifically identified which of the copyright
8 and trademark registrations listed in Exhibits A and B are at issue. This contention is
9 meritless. Unlike the original Complaint, and in accordance with the Court’s prior
10 instructions, the FAC now specifically identifies the registrations allegedly violated by
11 Defendants:

39. [The] trademarks infringed by Defendants, are
12 registered with the USPTO under Reg. Nos.: 4,488,273;
2,091,792; 4,091,791; 4,087,358; 4,083,556; 3,940,171;
13 3,029,061; 1,988,712; 1,956,216; 1,486,895; 1,475,793;
3,652,384; 3,652,383; 3,652,382; 2,068,523; 1,833,219;
14 4,488,280; 4,488,279; 4,186,925; 4,183,465; 4,087,369;
15 4,083,558; 3,032,288; 2,081,343; 1,988,710; and 1,901,149.

16 * * * *

90. Without permission, Defendants . . . [distributed] . . .
17 counterfeit ADOBE® ACROBAT® software which are at a
18 minimum substantially similar to Plaintiff’s copyright protected
19 works . . . , namely, Plaintiff’s “Adobe Acrobat X” entitled
work of authorship protected by United States Copyright Office
20 Reg. No.: TX0007357858.

21 FAC ¶¶ 39, 90. In view of these allegations, the continued inclusion of Exhibits A and B as
22 attachments to the FAC is somewhat superfluous. Nonetheless, Adobe’s specification of
23 the trademark and copyright registrations allegedly violated by Defendants provides “a fair
24 idea of the basis of the complaint and the legal grounds claimed for recovery.” Self
25 Directed Placement Corp., 908 F.2d at 466. Defendants’ motion for a more definite
26 statement is therefore DENIED.

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1 **IV. CONCLUSION**

2 For the reasons set forth above,


3 **IT IS HEREBY ORDERED THAT:**

4 1. Defendants' motion to dismiss is GRANTED with respect to Adobe's claim
5 for breach of contract, which is DISMISSED with leave to amend. The remainder of the
6 motion to dismiss and the alternative motion for a more definite statement are DENIED.

7 2. Adobe shall have fourteen (14) days from the date this Order to file a Second
8 Amended Complaint, consistent with the Court's rulings, as set forth above. Plaintiff is
9 advised that any additional factual allegations set forth in its amended complaint must be
10 made in good faith and consistent with Rule 11. The failure to timely file an amended
11 pleading will result in the dismissal of the aforementioned claim, with prejudice.

12 **IT IS SO ORDERED.**

13 Dated: 12/29/15


14 SAUNDRA BROWN ARMSTRONG
15 United States District Judge
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