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11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF CALIFORNIA

13
14 NINTENDO OF AMERICA INC., a
15 Washington corporation

16 Plaintiff,

17 v.

18 MATTHEW STORMAN, an
19 individual, JOHN DOES 1-10,
individuals and/or corporations,

20 Defendant.

Case No. 2:19-CV-07818-CBM-RAO

**OPPOSITION TO DEFENDANT
MATTHEW STORMAN'S MOTION
TO DISMISS**

Date: January 14, 2020
Time: 10:00 a.m.
Ctrm: 8B

The Honorable Consuelo B. Marshall

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I. INTRODUCTION

1 Defendant Matthew Storman owns and operates a website,
2 “www.romuniverse.com,” built on brazen and mass scale infringement of Nintendo
3 of America Inc.’s (“Nintendo”) intellectual property rights. Compl. (Dkt. No. 1)
4 ¶ 1. Through this website, Mr. Storman reproduces, distributes, monetizes, and
5 offers for download thousands of unauthorized copies of Nintendo’s video games.
6 *Id.* Thus, Nintendo brought this action to stop Mr. Storman’s rampant infringement
7 and protect Nintendo’s intellectual property rights, alleging claims for copyright
8 infringement, trademark infringement, and related causes of action.
9

10 Nintendo more than adequately pled all these claims. Mr. Storman’s
11 arguments to the contrary—even generously interpreting his Motion (Dkt. No. 25-
12 1), as Nintendo does in this opposition—completely miss the mark. Indeed, to the
13 extent the arguments can be understood, the Motion primarily advances three
14 affirmative defenses that are not properly the subject of a motion to dismiss.
15 Mr. Storman’s smattering of passing references to other legal arguments are
16 similarly unavailing.

17 For these reasons and those more fully articulated below, the Court should
18 deny Mr. Storman’s Motion.

II. BACKGROUND

A. Nintendo and Its Business

21 Nintendo develops, markets, and distributes electronic video game hardware,
22 software, and related accessories. *Id.* ¶¶ 11–12. Nintendo’s innovation in these
23 areas has made it a world-famous brand known for its fun video games and beloved
24 video game characters. Nintendo built its business through creative and financial
25 investment in its video games, products, and intellectual property. *Id.* ¶ 14. As part
26 of this investment, Nintendo owns registered United States copyrights for a variety
27 of Nintendo video games, video game characters, and related works. *Id.* ¶ 17; Ex.
28

1 A (Dkt. No. 1-1). Nintendo also owns registered United States trademarks covering
2 these offerings. *Id.*; Ex. B (Dkt. No. 1-2).

3 **B. Mr. Storman’s Infringing Activities**

4 Nintendo’s popularity has made it a frequent target for intellectual property
5 pirates, including Mr. Storman. *Id.* ¶ 18. Video game pirates often make
6 unauthorized copies of video games through copies of “read-only memory files” or
7 “read-only memory images,” commonly referred to as “ROMs.” *Id.* ¶ 19. These
8 ROMs are often generated by copying the software that constitutes a video game
9 from the read-only memory found in a genuine game cartridge or disc. *Id.* These
10 copies can be played on unauthorized devices through the use of an “emulator,” a
11 piece of software designed to mimic the functionality of a physical video game
12 system. *Id.* The ROMs can also be played on Nintendo’s hardware using hacking
13 techniques. *Id.*

14 Mr. Storman, and those who operate the website with him, upload and
15 provide such unauthorized copies to the general public. Mr. Storman’s website
16 offers thousands of illegal copies of Nintendo’s video games for download. *Id.*
17 ¶ 24. In 2009, Mr. Storman emailed members of his website that he would be
18 adding new content including ROMs for various Nintendo game systems. *Id.* ¶ 22.
19 In 2018, when Nintendo was successfully enforcing its intellectual property rights
20 against other pirates, Mr. Storman bragged that he would continue to offer copies of
21 Nintendo’s games. *Id.* ¶ 23. Under Mr. Storman’s control and management, the
22 website has attracted hundreds of thousands of viewers each month, leading to
23 hundreds of thousands of downloads of unauthorized copies of Nintendo’s video
24 games. *Id.* ¶¶ 25, 33. Through the website, users can search across a vast library of
25 pirated games to select the particular ROM copy they wish to download. *Id.* ¶¶ 27–
26 31. In addition to the infringing software code, the website also contains images of
27 the video games’ original “box art,” many of which include Nintendo’s registered
28 copyrights and registered trademarks. *Id.* ¶ 32. When these unauthorized copies

1 are played, they display counterfeit copies of Nintendo’s trademarks at startup and
2 while playing the games. *Id.* ¶¶ 34–35.

3 Mr. Storman directly profits from this infringing activity by allowing users to
4 sign up for “Premium Memberships.” *Id.* ¶¶ 22, 37. While non-members are
5 limited to one free download through the website, premium members pay \$30 per
6 year to Mr. Storman to download an unlimited number of pirated games, and at
7 higher speeds than non-members. *Id.* ¶ 37.

8 III. LEGAL STANDARD

9 A motion to dismiss under Rule 12(b)(6) tests the sufficiency of the
10 complaint to state a claim for relief and may be based either on the lack of a
11 cognizable legal theory or the absence of sufficient facts alleged to support that
12 theory. *Cmtys. Actively Living Indep. & Free v. City of Los Angeles*, No. CV 09-
13 0287 CBM (RZx), 2009 WL 10676002, at *3 (C.D. Cal. June 1, 2009) (Marshall,
14 J.). To survive a motion to dismiss, the factual allegations need only be sufficient
15 to state a claim to relief that is “plausible on its face.” *Id.* (citing *Bell Atl. Corp. v.*
16 *Twombly*, 550 U.S. 544, 570 (2007)). All material factual allegations in the
17 complaint are assumed to be true—as well as any reasonable inferences to be drawn
18 from them—and construed in the light most favorable to the plaintiff. *Id.*; *Safinia*
19 *v. Voltage Pictures, LLC*, No. CV 17-6902-CMB-RAO, 2017 WL 10378500, at *1
20 (C.D. Cal. Dec. 7, 2017) (Marshall, J.); *Delgado v. ILWU-PMA Welfare Plan*, Case
21 No. CV 2:18-cv-5539 CBM, 2019 WL 2864427, at *1 (C.D. Cal. Apr. 26, 2019)
22 (Marshall, J.). In ruling on a motion to dismiss, the court may consider only
23 allegations contained in the pleadings, exhibits attached to the complaint, and
24 matters properly subject to judicial notice. *Cmtys. Actively Living*, 2009 WL
25 10676002, at *3 (citing *Swartz v. KPMG*, 476 F.3d 756, 763 (9th Cir. 2007)).

26 Finally, although courts in the Ninth Circuit are generally more lenient with
27 pro se litigants, courts have no obligation to build substantive arguments for
28 litigants, *see, e.g., Lexington Ins. Co v. Silva Trucking, Inc.*, No. 2:14-CV-0015

1 KJM CKD, 2014 WL 1839076, at *3 (E.D. Cal. May 7, 2014) (refusing to consider
2 undeveloped arguments in a motion to dismiss and collecting similar cases holding
3 that undeveloped arguments are waived).

4 IV. ARGUMENT

5 As best the Motion can be understood, Mr. Storman argues that Nintendo has
6 not stated a claim for copyright infringement, raises two copyright and one
7 trademark affirmative defense, and suggests some jurisdictional concerns. These
8 arguments fail for several reasons.

9 *First*, Nintendo has pled the facts necessary to allege a prima facie copyright
10 infringement claim. At minimum—and Nintendo provides much more—Nintendo
11 properly pleads ownership of valid copyrights and facts supporting Mr. Storman’s
12 infringement of those copyrights. *Second*, Mr. Storman’s assertion of various
13 affirmative defenses (first sale doctrine and DMCA safe harbor) in a motion to
14 dismiss is both procedurally improper and substantively wrong. *See, e.g., Branca v.*
15 *Mann*, Case No. CV 11-00584 DDP (PJWx), 2011 WL 13218028, at *2 (C.D. Cal.
16 Apr. 19, 2011) (procedurally improper). *Finally*, to the extent Mr. Storman makes
17 such arguments, his jurisdictional and related musings are without merit, because he
18 does not deny any of Nintendo’s material subject matter jurisdiction, personal
19 jurisdiction, or venue allegations.

20 A. Nintendo Has Stated a Claim for Copyright Infringement.

21 A plaintiff must plead two elements to state a claim for copyright
22 infringement: (1) ownership of a valid copyright, and (2) that defendant violated at
23 least one exclusive right granted to copyright holders under 17 U.S.C. § 106.
24 *Ticketmaster L.L.C. v. RMG Techs., Inc.*, 507 F. Supp. 2d 1096, 1104 (C.D. Cal.
25 2007); *Safinia*, 2017 WL 10378500, at *1 n.1. A plaintiff properly alleges
26 ownership in the copyrights by providing the title and United States Copyright
27 Office registration numbers. *Malibu Textiles, Inc. v. Label Lane Int’l, Inc.*, 922
28 F.3d 946, 951–52 (9th Cir. 2019) (“And contrary to Defendants’ assertions,

1 [Plaintiff] was not required to include images . . . , a complete deposit . . . , or
2 registration materials . . . to plausibly allege ownership.”).

3 The exclusive rights granted to copyright holders include reproduction,
4 preparation of derivative works, and distribution. 17 U.S.C. § 106(1)-(3). Courts
5 routinely deny motions to dismiss where a plaintiff sufficiently alleges that the
6 defendant violated these rights in plaintiff’s copyrighted software. *Mfg.*
7 *Automation & Software Sys., Inc. v. Hughes*, Case No. 2:16-cv-08962-CAS(KSx),
8 2017 WL 1960633, at *11–12 (C.D. Cal. May 8, 2017) (denying motion to dismiss
9 where plaintiff alleged that defendant’s software was virtually identical or
10 substantially similar to plaintiff’s copyrighted works); *DFSB Kollektive Co. Ltd. v.*
11 *CJE & M Am., Inc.*, Case No. 2:15-cv-01650-SVW-FFM, 2015 WL 12781211, at
12 *5 (C.D. Cal. June 4, 2015) (denying motion to dismiss where plaintiff alleged that
13 defendant infringed its rights by distributing plaintiff’s copyrighted music via its
14 website); *Epicor Software Corp. v. Alt. Tech. Sols., Inc.*, No. SACV 13-00448-
15 CJC(RNBx), 2013 WL 2382262, at *3–4 (C.D. Cal. May 9, 2013) (denying motion
16 to dismiss where plaintiff alleged that defendant copied plaintiff’s copyrighted
17 software).

18 Nintendo has alleged sufficient facts to meet both elements of copyright
19 infringement.

20 First, Nintendo alleged that it owns valid, registered United States copyrights
21 for various Nintendo video games, video game characters, and related works that
22 have been copied and are available on Mr. Storman’s website without Nintendo’s
23 authorization. Compl. (Dkt. No. 1) ¶¶ 17, 28, Ex. A. Each work is sufficiently
24 identified in Exhibit A to the Complaint by the title of the work, the copyright
25 registration number, and the registration date. *Id.*, Ex. A (Dkt. No. 1-1).

26 Second, Nintendo alleged that Mr. Storman violated Nintendo’s rights in
27 those copyrighted works. Nintendo alleged that Mr. Storman made unauthorized
28 copies of the Nintendo video games listed in Exhibit A and displays images of the

1 video games' original box art for which Nintendo also owns copyrights. Compl.
2 ¶¶ 28, 32. Mr. Storman also violated Nintendo's rights by creating ROM copies of
3 Nintendo's copyrighted software which can function on other devices with an
4 emulator. *Id.* ¶¶ 19, 22–24. And Mr. Storman distributed, and continues to
5 distribute, hundreds of thousands of these copies and derivative works through his
6 website, including offering over 3,000 Nintendo games for download. *Id.* ¶¶ 24–
7 33, 36–39.

8 There should be no question that Nintendo has pled a prima facie case
9 against Mr. Storman for copyright infringement.

10 **B. Mr. Storman's Affirmative Defenses to Copyright Infringement Fail.**

11 Mr. Storman also appears to assert two affirmative defenses to Nintendo's
12 copyright infringement claims: (1) the first sale doctrine (17 U.S.C. § 109(a)), and
13 (2) the Digital Millennium Copyright Act ("DMCA") safe harbor provisions (17
14 U.S.C. § 512). Mot. at 2–3, 5–7. Neither of these affirmative defenses protect
15 Mr. Storman.

16 As a procedural matter, a motion to dismiss is an improper stage at which to
17 resolve evidentiary-based affirmative defenses, such as the first sale doctrine and
18 DMCA safe harbor defenses. *Adobe Sys. Inc. v. A & S Elecs., Inc.*, Case No. C 15-
19 2288 SBA, 2016 WL 9105173, at *5 (N.D. Cal. Oct. 13, 2016) ("[A]pplication of
20 the [first sale] doctrine generally is not suitable for resolution on a motion to
21 dismiss, where the facts alleged in the pleading are presumed true."); *Branca*, 2011
22 WL 13218028, at *2 (denying motion to dismiss where defendant argued it was
23 protected by the DMCA safe harbor provisions because it was an issue of fact and
24 must be more developed). This alone is reason to deny the motion to dismiss on
25 these grounds.

26 In addition to this fatal procedural defect, these affirmative defenses would
27 not apply to Mr. Storman as a matter of law.

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1 **1. The First Sale Doctrine Does Not Protect Mr. Storman.**

2 The first sale doctrine does not permit mass distribution of copyrighted
3 works, copying of the copyrighted works or distribution of those copies, or the
4 creation and sale of derivative works based on Nintendo’s copyrighted video
5 games. *See* 17 U.S.C. § 109(a) (“the owner of a **particular copy** [of a copyrighted
6 work]. . . **lawfully made** . . . is entitled, without the authority of the copyright
7 owner, to sell or otherwise dispose of the possession of **that copy.**”) (emphasis
8 added). Indeed, Mr. Storman’s actions fall well outside of the first sale doctrine.
9 The first sale doctrine only allows an owner of a *lawful* copy of the copyrighted
10 work to dispose of *that individual copy*. *Id.* § 106(1)-(2) (“[T]he owner of
11 copyright under this title has the exclusive rights to . . . reproduce the copyrighted
12 work in copies [and] to prepare derivative works based upon the copyrighted
13 work.”). Mr. Storman is doing much more than simply distributing any copy of
14 Nintendo’s copyrighted video games he many have (if indeed he owns a lawful
15 copy). Instead, he is reproducing the video games, creating derivative works, and
16 distributing hundreds of thousands of those derivative works. Compl. ¶¶ 19, 22–24,
17 36–39. The first sale doctrine does not permit such blatant infringement. *Capitol*
18 *Records, LLC v. ReDigi Inc.*, 910 F.3d 649, 656 (2d Cir. 2018) (“On the other hand,
19 § 109(a) says nothing about the rights holder’s control under § 106(1) over
20 *reproduction* of a copy or phonorecord.”).

21 **2. DMCA Safe Harbor Provisions Do Not Apply to Mr. Storman.**

22 Even if the heavily factual issue of DMCA safe harbor provisions were
23 properly before the Court (it is not), the Complaint sufficiently alleges that
24 Mr. Storman is ineligible for DMCA protection.

25 Although Mr. Storman does not specify which of the four DMCA safe
26 harbors he claims shelter under, he appears to be seeking protections under 17
27 U.S.C. § 512(c). *See* Mot. at 2–3, 5, 7, n.9 (discussing “request for removal” and
28 citing 17 U.S.C. § 512(c)(3) notification provisions). Mr. Storman fails to show

1 that he meets any of the numerous requirements under § 512(c), including without
2 limitation that: (1) the infringing material must be stored by Mr. Storman “at the
3 direction of a user,” (2) Mr. Storman must not “receive a financial benefit directly
4 attributable to the infringing activity,” (3) Mr. Storman must have designated a
5 DMCA agent during the infringement, and (4) the required information for DMCA
6 notices must have been included on the www.romuniverse.com website.

7 Moreover, as the Complaint alleges, Mr. Storman and his rampant
8 infringement fall well outside of any DMCA protections.

9 *First*, Mr. Storman controls and operates a website on which he uploads
10 thousands of copies of infringing video game software, and then organizes,
11 catalogues, and offers those games for download to anyone who wants them and is
12 willing to pay his fee. He also reports the number of times each infringing video
13 game is downloaded from his website. *See* Compl. ¶¶ 22-33. This is independently
14 sufficient to remove Mr. Storman from any DMCA protections. *Capitol Records,*
15 *Inc. v. MP3tunes, LLC*, 821 F. Supp. 2d 627, 649 (S.D.N.Y. 2011).

16 *Second*, Mr. Storman receives a financial benefit directly attributable to the
17 infringing material. Compl. ¶¶ 22, 37–39. He charges a premium membership fee
18 to allow users unlimited and faster downloads of the pirated copies of Nintendo’s
19 video games. *Id.* This too is an independently sufficient reason that Mr. Storman is
20 not protected by the DMCA safe harbors. *Greg Young Publ’g, Inc. v. Zazzle, Inc.*,
21 Case No. 2:16-CV-04587-SVW-KS, 2017 WL 2729584, at *8 (C.D. Cal. May 1,
22 2017).

23 In lieu of demonstrating that he affirmatively qualifies for the DMCA safe
24 harbor—an inappropriate effort at this procedural stage—Mr. Storman appears to
25 assert that Nintendo has somehow granted statutory protections to Mr. Storman by
26 sending a takedown notice regarding his infringement. Mot. at 1, 2, 5.

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1 This is not the case.¹ Whether Nintendo sent a DMCA notice is irrelevant to
2 the question of whether Mr. Storman is eligible for statutory safe harbor
3 protections. A service provider must itself comply with the various safe harbor
4 requirements. *Capitol Records*, 821 F. Supp. 2d at 649 (holding that an individual
5 who uploaded infringing material to his website was not eligible for DMCA safe
6 harbor, even though plaintiffs sent a DMCA takedown notification); *Columbia*
7 *Pictures Indus., Inc. v. Fung*, 710 F.3d 1020, 1045 (9th Cir. 2013) (affirming that
8 defendant was not eligible for DMCA safe harbor because it received a direct
9 financial benefit from infringing material, even though plaintiff sent a notice).
10 Nintendo's good faith attempt to enforce its intellectual property rights does not
11 ameliorate Mr. Storman's infringement or cure his deficiencies in qualifying for
12 DMCA safe harbor.

13 Therefore, although the Complaint need not allege facts to defeat this as-yet-
14 unpled affirmative defense, *see Branca*, 2011 WL 13218028, at *2, Nintendo has
15 nevertheless pled sufficient facts to deny Mr. Storman's motion to dismiss on these
16 grounds.

17 **C. Mr. Storman's Affirmative Defense to Trademark Infringement Fails.**

18 Mr. Storman also seems to attempt to assert a first sale doctrine affirmative
19 defense to Nintendo's trademark infringement claims. Mot. at 3. Just as in the
20 copyright context, this affirmative defense is procedurally improper. *See, e.g., HM*
21 *Elects., Inc. v. R.F. Techs., Inc.*, NO. 12-CV-2884-MMA(WMC), 2013 WL
22 12073837, at *3 (S.D. Cal. Mar. 18, 2013). It is also substantively defective. In
23 trademark law, as in copyright, the first sale doctrine protects resale of only the
24 "original article." *Sebastian Int'l, Inc. v. Longs Drug Stores Corp.*, 53 F.3d 1073,
25 1074 (9th Cir. 1995). Mr. Storman's first sale defense substantively fails at least
26

27 ¹ It is also improper to consider the email excerpt offered by Mr. Storman at
28 the motion to dismiss stage. *Cmtys. Actively Living*, 2009 WL 10676002, at *3
(citing *Swartz v. KPMG*, 476 F.3d 756, 763 (9th Cir. 2007)).

1 because Nintendo's Complaint alleges that he distributed copies and derivative
2 works based on the infringing video games, not the "original articles." Compl.
3 ¶¶ 19, 22–33, 36–39, 41–45. Thus, Mr. Storman is not entitled to dismissal of the
4 trademark-related claims.

5 **D. Mr. Storman's Remaining Grounds for Dismissal Are Meritless.**

6 Although Mr. Storman's Motion (at 4–5) lists the various grounds for
7 dismissal under Rule 12(b), he does not provide material allegations or arguments
8 in support. As to subject matter jurisdiction, for example, Mr. Storman does not
9 deny, and cannot deny, that Nintendo has alleged claims under the Lanham Act (15
10 U.S.C. §§ 1114, 1125(a)) and the Copyright Act (15 U.S.C. § 501 et seq.), and that
11 subject matter jurisdiction is therefore proper (a) as federal question jurisdiction
12 under 28 U.S.C. § 1331, (b) this Court's original jurisdiction over trademark and
13 copyright claims under 28 U.S.C. § 1338, or (c) that supplemental jurisdiction over
14 the remaining state law claims is proper under 28 U.S.C. § 1367. As to personal
15 jurisdiction and venue, Mr. Storman does not deny that he resides in this District
16 nor that a substantial part of the activities giving rise to Nintendo's claims occurred
17 here; to the contrary, on his Motion he claims an address in Covina, California,
18 which is in this District. Mot. at 1. Moreover, Mr. Storman does not suggest that
19 some other jurisdiction or venue is appropriate or more convenient. On this record,
20 the Court need not entertain Mr. Storman's jurisdictional musings.

21 **V. CONCLUSION**

22 For the foregoing reasons, Nintendo respectfully requests that the Court deny
23 Mr. Storman's motion to dismiss.²

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² Nintendo has attempted to generously construe Mr. Storman's arguments
27 and respond to those it understands. To the extent the Court determines that Mr.
28 Storman has raised other cognizable arguments that Nintendo has not addressed,
Nintendo respectfully requests it be given the opportunity to provide supplemental
briefing to respond to those additional arguments.

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DATED: December 20, 2019

PERKINS COIE LLP

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