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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

ELIAS KIFLE,
Plaintiff,
v.
YOUTUBE LLC, et al.,
Defendants.

Case No. 21-cv-01752-CRB

**ORDER GRANTING MOTION TO
DISMISS**

Pro se Plaintiff Elias Kifle is suing Defendants YouTube and Does 1–19 for copyright infringement and trademark infringement. See Fourth Am. Compl. (dkt. 73-1). Kifle’s claims arise from YouTube’s continued service to users who allegedly display Kifle’s videos on YouTube without his permission. Id. at 3–4. The Court previously granted YouTube’s motion to dismiss Kifle’s third amended complaint, with leave to amend his copyright and trademark infringement claims. See MTD Order (dkt. 71). Because Kifle’s current complaint fails to cure the deficiencies in the prior complaint, the Court GRANTS the motion to dismiss. The Court grants leave to amend the trademark infringement claim only.

I. BACKGROUND

Kifle is a resident of the state of Georgia. Fourth Am. Compl. ¶ 4. He owns a satellite television channel and website titled Mereja TV. Id. Mereja TV broadcasts video news segments in the Amharic language for the Ethiopian community by live streams and pre-recorded videos. Id. ¶ 19. Until November 2020, Kifle voluntarily put his content on YouTube’s platform. Id.

YouTube is an online video hosting platform where creators may upload their videos free of charge. Mot. (dkt. 76) at 4. YouTube is based in California and incorporated in the state of Delaware. Fourth Am. Compl. ¶ 5.

1 Mereja programming. Id. ¶ 7. The channel had approximately 2,500 videos. Id. On November 9,
2 2020, YouTube “abruptly terminated” a Mereja livestream airing on Kifle’s YouTube channel
3 without “any specific reason or advance warning.” Id. Two days later, YouTube terminated Kifle’s
4 YouTube channel entirely, removing all the videos posted to the channel. Id.¹

5 Since his channel was suspended, Kifle alleges that “over 300” of his videos have been
6 copied from Mereja TV’s website and uploaded onto YouTube’s platform without his permission.
7 Id. ¶ 14. Kifle also alleges that he has sent “over 40” advance notices of potential copyright
8 infringement, and a trademark cease and desist letter to YouTube. See Id. ¶ 16. On October 6, 2021,
9 the day after this Court granted the last motion to dismiss, Kifle sent YouTube an advance notice that
10 fixed some deficiencies noted in the Court’s order. See Ex. 1 (dkt. 73-1). Kifle also sent an updated
11 “Trademark Cease and Desist Notice” email to YouTube’s legal department. See Ex. 2.

12 On September 16, 2021, after briefing had concluded but before this Court’s order, the U.S.
13 Patent and Trademark Office (“PTO”) issued an Office Action refusing to register “Mereja TV” as a
14 standard character word mark.² See Ex. A (dkt. 76-2). The PTO determined that the marks were
15 “generic in connection with the identified goods and/or service.” Id.

16 **A. Copyright Allegations**

17 Kifle alleges that he owns “the copyright of his works, including his live broadcast titled ‘ገጭ
18 ነጭን ከዘመዶ ጋር,’ and all the content on his copyright-protected website, Mereja.tv.” Fourth Am.
19 Compl. ¶ 9. Kifle alleges that, after terminating his channel, YouTube started allowing the Doe
20 Defendants to copy or intercept hundreds of the videos from his copyrighted website and television
21 channel. Id. ¶ 7, 14. He alleges that “YouTube users (Defendants Does 1–19) have directly
22 infringed at least 300 of Plaintiff’s works that have been copied from his website, Mereja.tv, and
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24 _____
25 ¹ As it would explain in a brief many months later, YouTube terminated Kifle’s YouTube channel
26 because “videos that were streamed in late October 2020 contain programs by a person named
27 Zemedkun Bekele whose YouTube channel was previously terminated.” TRO Order (dkt. 48) at 3.
28 YouTube had suspended Zemedkun Bekele’s account “for posting content that promoted violence,
29 hate speech, and harassment.” Id. Following the suspension, YouTube observed that videos of
30 Bekele were uploaded to Kifle’s channel in violation of YouTube’s anti-circumvention policy. Id.
² This Court takes judicial notice of the PTO Examining Attorney’s non-final office action, dated
September 16, 2021, denying registration of Kifle’s “Mereia TV” mark. See U.S. Trademark Appl.

1 displayed on YouTube.com without his permission.” Id. ¶ 7. The complaint includes images that
2 purport to identify a Doe Defendant’s YouTube page that streamed his “live broadcast” content “as
3 recently as last month.” Id. ¶ 22. (The complaint was filed on November 20).

4 Kifle also alleges that he has sent YouTube “48-hour advance notices” that his live broadcast
5 from his satellite channel would be simultaneously streamed but the Doe Defendants nonetheless
6 “live-streamed [the broadcasts] on YouTube.com without [his] permission.” Id. ¶ 23. The complaint
7 lists the URLs of eight YouTube channels that had allegedly simultaneously streamed Kifle’s
8 broadcasts without his permission. Id. ¶ 24. Kifle alleges that, in refusing to comply with his
9 advance notices, YouTube is “knowingly inflicting economic harm to Plaintiff.” Id. ¶ 26.

10 Kifle also alleges that YouTube has a “repeat-infringer policy that provides for the
11 termination of users who receive 3 copyright strikes.” Id. ¶ 51. But YouTube allegedly “failed to
12 implement its repeat infringer policy” against users posting Kifle’s content. Id. Kifle alleges that
13 “YouTube’s intentional failure to prevent Doe Defendants from live streaming [his] live broadcast
14 makes YouTube liable for contributory infringement.” Id. ¶ 61.

15 **B. Trademark Allegations**

16 Kifle alleges that he “exclusively owns the trademarks ‘Mereja TV’ and ‘ነጭ ነጭን ከዘመዴ
17 ጋር,” which translates to “The Facts with Zemedede.” Id. ¶ 10. These marks “are clearly displayed on
18 all his works and throughout his website, Mereja.tv” and thus “are distinctive marks that identify
19 [his] website, television channel, and videos.” Id. ¶¶ 28–29.

20 Kifle alleges that it “is indisputable that ‘Mereja TV’ has achieved an unequivocal secondary
21 meaning.” Id. ¶¶ 35-37. A “quick search” on various search engines shows that the mark “is
22 uniquely and distinctly associated with Plaintiff’s website and television channel.” Id. ¶ 35. For
23 example, a Google search for “‘Mereja TV’ returns 800,000 results that refer ONLY to Plaintiff’s
24 website or satellite television channel.” Id. Kifle also alleges that “‘Mereja TV’ has acquired
25 distinctiveness by becoming a universally recognized brand among its audience who speak Amharic
26 language.” Id. ¶ 36.

27 Kifle further alleges that “ነጭ ነጭን ከዘመዴ ጋር” has “similarly strong secondary meaning in
28

1 week.” Id. ¶ 37. A “Google search for the keywords ‘ነጭ ነጭን ከዘመዶ ጋር’ returns 32,500 results,
2 100 percent of which are Plaintiff’s works.” Id. ¶ 37.

3 As with the allegedly infringing videos, Kifle alleges that he sent requests asking YouTube to
4 remove all materials on YouTube.com that infringe on his protected marks, but YouTube continues
5 to allow the infringement. Id. ¶ 38. He alleges that “YouTube is liable for contributory and vicarious
6 infringement because it allowed several repeat infringers to steal Plaintiff’s trademark despite
7 receiving valid cease and desist notices.” Id. ¶ 39.

8 **C. Procedural History**

9 In his Third Amended Complaint, Kifle asserted a breach of contract claim, a copyright
10 claim, and a trademark claim. See Third Amended Compl. (dkt 56-1). YouTube moved to dismiss.
11 See MTD (dkt. 62). The Court dismissed Kifle’s contract claim with prejudice because it was barred
12 by Section 230(c)(1) of the Communications Decency Act. MTD Order at 6. The Court dismissed
13 the copyright and trademark claims with leave to amend. Id. Kifle then filed this complaint.

14 **II. LEGAL STANDARD**

15 Under Rule 12(b)(6) of the Federal Rules of Civil Procedure, a complaint may be dismissed
16 for failure to state a claim upon which relief may be granted. Fed. R. Civ. P. 12(b)(6). Rule 12(b)(6)
17 applies when a complaint lacks either “a cognizable legal theory” or “sufficient facts alleged” under
18 such a theory. Godecke v. Kinetic Concepts, Inc., 937 F.3d 1201, 1208 (9th Cir. 2019). Whether a
19 complaint contains sufficient factual allegations depends on whether it pleads enough facts to “state a
20 claim to relief that is plausible on its face.” Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (citing Bell
21 Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007)). A claim is plausible “when the plaintiff
22 pleads factual content that allows the court to draw the reasonable inference that the defendant is
23 liable for the misconduct alleged.” Id. at 678. This is not a “probability requirement,” but it requires
24 more than a “sheer possibility” that the defendant is liable: “Where a complaint pleads facts that are
25 merely consistent with a defendant’s liability, it stops short of the line between possibility and
26 plausibility of entitlement to relief.” Id. (quoting Twombly, 550 U.S. at 557).

27 Courts should allow a plaintiff leave to amend unless amendment would be futile. Cook,

28 Redline & Liska, Inc. v. N. Cal. Collection Serv. Inc., 911 F.2d 242, 246-47 (9th Cir. 1990). Twombly

1 determine whether amendment would be futile, courts examine whether the complaint can be
2 amended to cure the defect requiring dismissal “without contradicting any of the allegations of [the]
3 original complaint.” Reddy v. Litton Indus., Inc., 912 F.2d 291, 296 (9th Cir. 1990).

4 **III. DISCUSSION**

5 **A. Copyright Claim**

6 Kifle argues that YouTube knowingly and intentionally failed to prevent other users from
7 infringing his live broadcasts and prerecorded videos. See Fourth Am. Compl. ¶ 46. The Court
8 denies the copyright claim with prejudice because Kifle (again) fails to plausibly allege that he
9 complied with 17 U.S.C. § 411, and further opportunities to amend this claim would be futile.

10 **1. Applicable Law**

11 A plaintiff seeking to bring a copyright suit must comply with certain procedural
12 requirements. Subject to certain limited exceptions, a copyright holder must register the relevant
13 work before filing an infringement suit. See 17 U.S.C. § 411(a). Copyright registration “occurs, and
14 a copyright claimant may commence an infringement suit, when the Copyright Office registers a
15 copyright.” Fourth Estate Pub. Benefit Corp. v. WallStreet.com, LLC, 139 S. Ct. 881, 887 (2019).
16 Consistent with other district courts in the Ninth Circuit, this Court holds that a plaintiff must have
17 registered the relevant work before filing suit. See TRO Order (dkt. 48) at 9–10.

18 The one relevant exception to § 411(a) is the § 411(c) exception for simultaneous
19 transmissions. Subject to certain requirements, a copyright owner may bring an infringement suit for
20 works “the first fixation of which is made simultaneously with its transmission.” See 17 U.S.C.
21 § 411(c). To qualify for this exception, the copyright owner must (1) serve “notice upon the
22 infringer, not less than 48 hours before such fixation, identifying the work and the specific time and
23 source of its first transmission, and declaring an intention to secure copyright in the work,” and (2)
24 make “registration for the work,” if otherwise required under § 411(a), “within three months after its
25 first transmission.” 17 U.S.C. §§ 411(c)(1)–(2).

26 The copyright owner must take these steps “in accordance with requirements that the Register
27 of Copyright shall prescribe by regulation.” 17 U.S.C. § 411(c). The regulations require that service

28 of the “Advance Notice” be made “on the person responsible for the potential infringement” within

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