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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT TACOMA

TOUCHPOINT COMMUNICATIONS,
LLC, an Oregon Limited Liability
Company, d/b/a WEO MEDIA, LLC,

Plaintiff,

v.

DENTALFONE, LLC, a Florida Limited
Liability Company,

Defendant.

CASE NO. 3:15-cv-05240-JRC

ORDER ON PLAINTIFF'S
MOTION FOR PARTIAL
JUDGMENT ON THE
PLEADINGS

This matter is before the Court on plaintiff's motion for partial judgment on the pleadings and has been fully briefed (*see* Dkts. 38, 41, 45, 49, 50, 51).

The Court, and defendant, acknowledge that defendant has withdrawn its compulsory counterclaim for copyright infringement in its Answer to plaintiff's Complaint. However, defendant notes that it has a pending copyright application and therefore, it wishes to retain the ability to assert such counterclaim later and, at oral

1 argument, claimed for the first time that this Court lacks subject matter jurisdiction to
2 decide plaintiff's declaratory action.

3 This Court concludes that since defendant has filed an application for copyright
4 registration at the Copyright Office and, therefore, has the right to bring a copyright
5 infringement action now, plaintiff should also have the right to bring a coercive action for
6 declaratory relief and claim that defendant's claimed copyright was not infringed.
7 Therefore, this Court has subject matter jurisdiction to decide the issue.

8 The Court grants plaintiff's motion for partial judgment on the pleadings with
9 respect to plaintiff's claim for declaratory judgment of non-infringement under the
10 Copyright Act (Count I), but this ruling is without prejudice, pending the outcome of
11 defendant's copyright application.
12

13 BACKGROUND

14 The following background information is taken from the parties' COMBINED
15 JOINT STATUS REPORT AND DISCOVERY PLAN (*see* Dkt. 17, p. 2).

16 Plaintiff, TOUCHPOINT COMMUNICATIONS, LLC *d/b/a* WEO MEDIA, LLC
17 ("WEO"), is an Internet dental marketing company that conducts business in the State of
18 Washington, and is registered as "Touchpoint Communications, LLC" *d/b/a* WEO
19 Media. Touchpoint Communications, LLC is also registered and operates as WEO
20 Media, LLC in the State of Oregon.

21 Defendant, DENTALFONE, LLC, is an internet dental marketing company that
22 conducts business in the State of Washington, and is organized in the State of Florida.
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1 Dentalfone sent WEO a cease and desist letter dated November 25, 2014, alleging,
2 *interalia*, copyright and trade dress infringement of Dentalfone's proprietary mobile
3 application design. Dentalfone never received any response from WEO. Dentalfone sent
4 WEO a follow-up letter dated March 4, 2015, a copy of which was also sent to
5 Washington based "Smiles Dental" as an alleged infringer of Dentalfone's rights. Once
6 more, Dentalfone did not receive any substantive response. Dentalfone states that it filed
7 an application for copyright protection with the Copyright Office, but has not received a
8 response to that application, as yet.
9

10 Plaintiff WEO initiated the subject case by filing a complaint for declaratory
11 judgment alleging that it has not infringed Dentalfone's copyrights and further that
12 defendant Dentalfone has no copyrights in Dentalfone's mobile application design. In
13 addition, WEO alleges that it has not infringed Dentalfone's trade dress related to its
14 mobile application design and further that Dentalfone has no trade dress rights in
15 Dentalfone's mobile application design. Plaintiff also alleges that Dentalfone has
16 engaged in unfair trade practices by attempting to unfairly remove competition from the
17 marketplace through Dentalfone's cease and desist letter to WEO, and follow-up letter to
18 WEO and Smiles Dental. WEO further alleges that when Dentalfone contacted Smiles
19 Dental, it tortuously interfered with the business relationship of WEO and one of WEO's
20 customers.
21

22 PROCEDURAL HISTORY

23 Plaintiff filed its complaint on April 15, 2015 (*see* Dkt. 1) and its Amended
24 Complaint on April 16, 2015 (*see* Dkt. 5). Defendant filed its Answer to Amended

1 | Complaint with Jury Demand, and Counterclaim against plaintiff on July 27, 2015 (*see*
2 | Dkt. 20). On August 14, 2015, plaintiff filed a motion to dismiss in part defendant's
3 | counterclaim for failure to state a claim, regarding Counts II, IV, V and VI (*see* Dkt. 27).
4 | On October 9, 2015, this Court granted plaintiff's motion, however defendant was given
5 | leave to amend the counterclaim within 21 days (Dkt. 35). In part, the Court concluded
6 | that "because defendant claims copyright protection for the same design that entails its
7 | trade dress, and has not demonstrated the absence of an adequate remedy based on
8 | copyright law, this Court 'declines to expand the scope of the Lanham Act to cover
9 | [defendant's trade dress claim herein] [for] which the Federal Copyright Act [may]
10 | provide[] an adequate remedy'" (*see id.* at 8 (citations omitted)). The Court also
11 | concluded "that regarding defendant's state law claims, 'the work at issue comes within
12 | the subject matter of copyright as described in 17 U.S.C. §§ 102 and 103 . . . ;' [that]
13 | the underlying nature of [defendant's] state law claim [] is part and parcel of a copyright
14 | claim' for preemption purposes, and the Court finds that the additional allegations of
15 | 'deception, misrepresentation and public impact' do 'not change the underlying nature of
16 | the action' of the CPA claim" (*id.* at 9, 11 (citations omitted)). Similarly, the Court
17 | concluded that "the gravamen of defendant's claim[s] for unfair competition [and]
18 | [common law misappropriation] [are] that plaintiff copied portions of defendant's
19 | website" (*id.* at 13 (citations omitted)).
20 |
21 |

22 | On October 30, 2015, defendant filed its answer to the amended complaint, with
23 | amended counterclaims against plaintiff (Dkt. 36). This time, defendant did not include a
24 | counterclaim for copyright infringement, "in favor of more ripe counts of trade dress

1 infringement, violations of unfair competition law and state misappropriation, as it has
2 not yet received a copyright registration for its design” (Dkt. 41, p. 5). Nevertheless,
3 defendant concedes that it has filed an application for copyright protection with the
4 Copyright Office and is awaiting a response (Dkt. 49, p. 2).

5 On November 13, 2015, plaintiff filed a motion for partial judgment on the
6 pleadings with respect to its count for copyright non-infringement (Dkt. 38). Defendant
7 filed a response on December 7, 2015 (*see* Dkt. 41), and plaintiff filed its reply on
8 December 11, 2015 (*see* Dkt. 45).

9 At oral argument, defendant raised for the first time the argument that this Court
10 lacked subject matter jurisdiction to decide plaintiff’s declaratory relief action for
11 noninfringement because such a claim was premature since the Copyright Office has not
12 issued a copyright registration. The Court requested additional briefing on this issue
13 (Dkt. 48), which the parties provided (Dkt. 49-51).

14 STANDARD OF REVIEW

15 Plaintiff has filed a motion for judgment on the pleadings pursuant to Federal Rule
16 of Civil Procedure 12(c). A motion for a judgment on the pleadings “is properly granted
17 when, taking all the allegations in the non-moving party's pleadings as true, the moving
18 party is entitled to judgment as a matter of law.” *Fajardo v. County of Los Angeles*, 179
19 F.3d 698, 699 (9th Cir. 1999) (citation omitted). For purposes of ruling on this motion,
20 the complaint is construed in favor of the non-moving party. *Keniston v. Roberts*, 717
21 F.2d 1295, 1300 (9th Cir. 1983) (citations omitted).
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