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12 **UNITED STATES DISTRICT COURT**
13 **FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

14 BREAKING CODE SILENCE, a
15 California Public Benefit Corporation,

16 Plaintiff,

17 vs.

18 CHELSEA PAPCIAK aka FILER, an
19 individual, JENNIFER WALKER, an
20 individual, JENNA BULIS, an
21 individual, MARTHA THOMPSON, an
22 individual, and
23 BREAKINGCODESILENCE, INC., a
24 Florida corporation

25 Defendants.

Case No.: 21-cv-0918-BAS (DEB)

**DEFENDANT JENNIFER
WALKER'S REPLY BRIEF IN
SUPPORT OF MOTION TO
DISMISS PURSUANT TO
FEDERAL RULE OF CIVIL
PROCEDURE 12(b)(6)**

Date: September 13, 2021
Dept.: 4B
Judge: Hon. Cynthia A. Bashant

**NO ORAL ARGUMENT UNLESS
REQUESTED BY THE COURT**

1 Plaintiff's opposition to defendant Jennifer Walker's motion to dismiss this
 2 action as against herself misses the mark. Plaintiff spends much of its time
 3 reminding the Court about what the standard of review is on a motion to dismiss,
 4 rather than rebutting the simple fact: a co-owner of a trademark cannot be sued for
 5 infringement. Plaintiff **never rebuts this.** This is, legally, the end of the case,
 6 irrespective of how the Court is obligated to "accept as true" the allegations of the
 7 complaint.

8 Plaintiff also **admits** that trademark registration is "normally [a] proper
 9 subject[] of judicial notice." Objec. to Motion to Dismiss, p. 4 (Dkt 40). There are
 10 no "factual interpretations" to be made regarding whose name is on the list of
 11 registration applicants. There is no "question of fact" regarding who applied for the
 12 trademark. It's a list. Plaintiff does not assert that its members did not apply for
 13 the trademark with Walker or that the list is fraudulent. It simply wants the Court
 14 to look past a fact: Plaintiff and Walker applied for the mark together.

15 That Plaintiff spends the majority of its argument requesting that the Court
 16 ignore judicially noticeable documents, and ignore even the exhibits Plaintiff
 17 attached to its own complaint speaks to its lack of legal merit. The defect cannot
 18 be cured, because co-owners simply cannot sue each other for infringement, as
 19 Walker stated in her moving papers:

20 A leading trademark treatise broadly concludes that "[w]hen parties
 21 are co-owners of a mark, **one party cannot sue the other for**
 22 **infringement.** A co-owner cannot infringe the mark it owns." 2 J.
 23 McCarthy on Trademarks and Unfair Competition § 16:40 (4th ed.
 24 2015). The Court has been unable to identify any cases in which a
 plaintiff stated a trademark infringement claim against a defendant co-
 owner with unlimited and equal rights to the trademark.

25 *Piccari v. GTLO Prods., LLC*, 115 F.Supp.3d 509, 516 (E.D.Pa. 2015)(emphasis
 26 added). None of the multiple users has standing to bring an action for
 27 infringement. *Wilson v. RSM Management, Inc.*, 187 F.3d 651, 651 (9th Cir. 1999);
 28

1 *Upper Deck Company v. Panini America, Inc.*, 2021 WL 1388630, at p. 4 (S.D.
2 Ca. 2021). Plaintiff wholly fails to address these cases. Because they are
3 determinative.

4 The judicially-noticeable documents from TESS show no abandonment by
5 the applicants; if there were, Plaintiff would have attached it. This fact is so
6 damning that Plaintiff avoided arguing against it at all. It is fatal.

7 Plaintiff also attempts to distinguish controlling precedent by asserting that it
8 was for a different proceeding: a preliminary injunction. *Brookfield Cmmc's, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1046-47 (9th Cir. 1999). This has no
9 bearing on who owns a trademark.
10

11 While the “burden” is “low” at this stage of the proceedings (Opp. at 7 [Dkt.
12 42]), allegations which run directly contrary to exhibits attached to the complaint,
13 and which run directly contrary to judicially noticeable documents, cannot stand.
14 In other words, the Court cannot “presume the truth” of facts which run contrary to
15 public records and a plaintiff’s own attached documents.

16 Plaintiff’s opposition runs directly contrary to its own allegations, as
17 pointed out in Walker’s moving papers:

18 ¶24: Defendants Papciak, Walker, Bulis and Thompson were involved with
19 BCS from 2019 through early 2021. In or around February and March of
20 2021 these Defendants publicly separated themselves from BCS and **no**
21 **longer actively participate in the organization.**

22 This, too is enough, on its face, to grant Walker’s motion to dismiss. Exhibit F
23 confirms it. Walker is not “inserting” additional facts regarding her involvement
24 (Opp. at 9); Plaintiff itself pleads that Walker left the organization before it was
25 formed, and attached the exhibit which confirms it. There being no ongoing
26 dispute because Walker and the other defendants publicly broke ranks with
27
28

1 Plaintiff, any claim for declaratory relief must fail because there is no actual case
2 or controversy.

3 Plaintiff also admits that it has no prior rights, which are required. The
4 marks, under Plaintiff's allegations, were created in 2018, 2019, and 2020. The
5 judicially-noticeable exhibits show that defendant Walker, among others, applied
6 for registration of the mark in 2020. One splinter of the application group did not
7 apply for a subsequent, and identical, registration until 2021. Under *Brookfield*, a
8 plaintiff must establish that it has a legally protectible mark. Plaintiff's allegations
9 here do not establish that; they establish the opposite. *Herbko Int'l v. Kappa*
10 *Books*, 308 F.3d 1156, 1162 (Fed. Ct. 2002) ("These proprietary rights may arise
11 from a *prior* registration, *prior* trademark or service mark use, *prior* use as a trade
12 name, *prior* use analogous to trademark or service mark use, or any other use
13 sufficient to establish proprietary rights.").

14 Plaintiff's failure to attach the actual assignment it alleges exists, at this
15 point, when it has already faced one motion to dismiss and has had two
16 opportunities to amend its complaint, is additional evidence (by omission) that no
17 valid assignment exists.

18 There are no "questions of fact" regarding who applied for the trademark
19 together in October, 2020. Plaintiff does not deny that its members all applied for
20 the mark together. Co-owners of a mark cannot sue each other for infringement.
21 Plaintiff admits, and attaches evidence, that Walker was not involved with the
22 organization even before it was formed, and there is no evidence that Walker has
23 taken any action in contravention of that public statement that she was done.

24 Because Plaintiff agrees that PTO applications are properly the subject of
25 judicial notice, and Plaintiff does not dispute the accuracy of the applicants'
26 names, the exhibits accompanying Walker's request for judicial notice should not
27 be struck and should be considered.

1 These defects cannot be cured. The motion should be granted in its entirety,
2 without leave to amend.

3 Walker respectfully asks the Court to grant her motion to dismiss the
4 complaint without leave to amend as it relates to claims against her.

5 Dated: September 7, 2021

Respectfully Submitted,
LAW OFFICES OF MICHAEL W.
JACOBS

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7 By:

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