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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

CROSSFIT, INC.,)	Case No. 13-3771 SC
)	
Plaintiff,)	ORDER GRANTING IN PART AND
)	DENYING IN PART MOTION TO
v.)	<u>DISMISS AMENDED COUNTERCLAIMS</u>
)	
JENNI ALVIES, and DOES 1-10,)	
)	
Defendants.)	
)	
AND RELATED COUNTERCLAIMS)	
)	
)	

I. INTRODUCTION

Plaintiff CrossFit, Inc. ("CrossFit") brings this action against Defendant Jenni Alvies ("Alvies") for trademark infringement, among other things. ECF No. 1 ("Compl."). Alvies has counterclaimed for (1) declaratory judgment; (2) violation of California's Unfair Competition Law ("UCL"), Cal. Bus. & Prof. Code. § 17200, et seq.; and (3) false advertising under the Lanham Act, 15 U.S.C. § 1125. ECF No. 16 (First Amended Counterclaims ("FACC")). CrossFit now moves to dismiss Alvies's counterclaims pursuant to Federal Rule of Civil Procedure 12(b)(6). ECF No. 24 ("MTD"). The motion is fully briefed, ECF Nos. 26 ("Opp'n"), 30

1 ("Reply"), and appropriate for determination without oral argument
2 per Civil Local Rule 7-1(b). For the reasons set forth below, the
3 motion is GRANTED in part and DENIED in part.

4
5 **II. BACKGROUND**

6 As it must on a Rule 12(b)(6) motion to dismiss, the Court
7 treats all well-pleaded allegations in the FACC as true.¹ CrossFit
8 has developed a fitness training regimen and provides a nationally
9 standardized certificate program to personal trainers who desire to
10 become licensed CrossFit affiliates. Compl. ¶¶ 9, 11. CrossFit
11 owns several registered United States trademarks and service marks
12 comprised of the word mark CROSSFIT, including a service mark for
13 use in connection with fitness training services. Compl. ¶ 10,
14 FACC ¶ 23. CrossFit has also filed trademark applications with the
15 United States Patent and Trademark Office ("PTO") for other uses of
16 the CROSSFIT mark on an "intent-to-use" basis, meaning that
17 CrossFit has yet to use the mark in commerce in connection with
18 those uses. FACC ¶ 24. The applications relate to nutritional
19 energy bars, computer software that tracks workouts, weight-loss
20 equipment, magazines, books, and sports bags. Id. ¶¶ 25-28.

21 In April 2011, Alvies, a stay-at-home mother of four children,
22 launched a blog at "crossfitmamas.blogspot.com." FACC ¶ 21.
23 Around the same time, Alvies created a "CrossFit Mamas" Facebook
24 page. Id. ¶ 48, Compl. ¶ 13. Alvies used the blog to post daily
25 high-intensity interval training routines. Id. ¶¶ 20-21. Readers

26
27 ¹ For background, the Court also refers to a number of allegations
28 from CrossFit's complaint. However, for the purposes of
adjudicating the instant motion, the Court only considers Alvies's
allegations.

1 of the blog use the comments section to post and track their
2 personal progress on certain exercises. Id. ¶ 21. In an effort to
3 recoup some money for her efforts, Alvies sold vitamin meal-
4 replacement shakes through the blog and added Google AdWords
5 advertising. Id. ¶ 22.

6 On May 9, 2013, a paralegal from CrossFit contacted Alvies and
7 demanded that Alvies stop using the CrossFit name on her blog and
8 affiliated Facebook page. Id. ¶ 48. CrossFit's paralegal also
9 began communicating with at least one reader of Alvies's blog about
10 the quality of Alvies's workouts. Id. ¶ 52. The paralegal stated
11 that she had "assessed a few days of [Alvies's] workouts" and
12 determined it was "bad programming." Id. The paralegal also
13 represented that a CrossFit trainer determined that Alvies's
14 workouts were "stupid and unsafe." Id.

15 CrossFit also requested that third parties remove Alvies's
16 Blog and sent a takedown notice to Facebook pursuant to the Digital
17 Millennium Copyright Act ("DMCA"). Id. ¶ 55. Alvies allegedly
18 reached an agreement with CrossFit's paralegal whereby she would
19 move her blog to the domains "califitmamas.com" and
20 "califitmamas.blogspot.com." Id. ¶ 49. The paralegal allegedly
21 asserted that Alvies could not use the term "CFMamas" because "CF"
22 is a common abbreviation of CrossFit. See id. ¶ 51.

23 Thereafter, CrossFit continued to demand that Alvies disable
24 her Google AdWords and cease selling the vitamin shakes. CrossFit
25 also allegedly reneged on the deal struck by its paralegal,
26 demanding that Alvies cease using the domain "califitmamas.com."
27 Alvies subsequently moved her blog to "hiitmamas.blogspot.com."
28 After the second move, CrossFit repeatedly demanded that Alvies

1 delete over two years of blog posts. Alvies alleges that
2 CrossFit's demands constitute "an improper effort to eradicate all
3 Internet evidence of Alvies's prior use in commerce of marks
4 subject to the Intent-to-Use Applications regarding nutritional
5 shakes, computer software to track workouts, and others." Id. ¶
6 64.

7 In August 2013, CrossFit filed the instant action against
8 Alvies in federal court, asserting causes of action for trademark
9 infringement, false designation of origin, trademark dilution, and
10 cyberpiracy. Alvies counterclaims for (1) declaratory judgment,
11 (2) violation of the UCL, and (3) false advertising under the
12 Lanham Act. CrossFit now moves to dismiss all three counterclaims.

13 14 **III. LEGAL STANDARD**

15 A motion to dismiss under Federal Rule of Civil Procedure
16 12(b)(6) "tests the legal sufficiency of a claim." Navarro v.
17 Block, 250 F.3d 729, 732 (9th Cir. 2001). "Dismissal can be based
18 on the lack of a cognizable legal theory or the absence of
19 sufficient facts alleged under a cognizable legal theory."
20 Balistreri v. Pacifica Police Dep't, 901 F.2d 696, 699 (9th Cir.
21 1988). "When there are well-pleaded factual allegations, a court
22 should assume their veracity and then determine whether they
23 plausibly give rise to an entitlement to relief." Ashcroft v.
24 Iqbal, 556 U.S. 662, 679 (2009). However, "the tenet that a court
25 must accept as true all of the allegations contained in a complaint
26 is inapplicable to legal conclusions. Threadbare recitals of the
27 elements of a cause of action, supported by mere conclusory
28 statements, do not suffice." Id. (citing Bell Atl. Corp. v.

1 Twombly, 550 U.S. 544, 555 (2007)).

2
3 **IV. DISCUSSION**

4 **A. Declaratory Relief**

5 Alvies seeks declaratory judgment on a number of grounds.
6 CrossFit moves to dismiss with respect to only one aspect of
7 Alvies's counterclaim. Specifically, CrossFit targets Alvies's
8 claim that CrossFit violated 17 U.S.C. § 512(f) by making material
9 misrepresentations in the DMCA takedown notice it submitted to
10 Facebook. MTD at 6-8. The DMCA targets the circumvention of
11 digital walls guarding copyrighted material, but does not provide
12 remedies for trademark infringement. See 17 U.S.C. § 502. Alvies
13 asserts that CrossFit's invocation of the DMCA was improper and
14 misleading since CrossFit's claims are based on the assertion of
15 trademark rights, not copyrights. FAC ¶ 72. Under the DMCA,
16 specifically 17 U.S.C. 512(f), any person who knowingly materially
17 misrepresents that material infringes on a copyright shall be
18 liable for damages incurred by the alleged infringer.

19 CrossFit argues that Alvies's claim is implausible because
20 Facebook allows trademark takedown notices as well as DMCA
21 copyright takedown notices. MTD at 7. This argument lacks merit.
22 As an initial matter, it is unclear why the Court should take
23 judicial notice of Facebook's internal compliance procedures. This
24 is simply not a fact that "is generally known within the trial
25 court's jurisdiction," or that "can be accurately and readily
26 determined from sources whose accuracy cannot reasonably be
27 questioned." Fed. R. Evid. 201(b)(1), (2). Even if judicial
28 notice were appropriate, Alvies has plausibly alleged that CrossFit

1 materially misrepresented that Alvies's Facebook page infringed on
2 a copyright, since CrossFit's claims are based only on its asserted
3 trademark rights. Whether CrossFit may have been able to convince
4 Facebook to remove Alvies's page on some other ground has no
5 bearing on CrossFit's compliance with the DMCA.

6 CrossFit also contends that Alvies's claim fails because she
7 was not injured by the DMCA takedown notice. MTD at 7. CrossFit
8 argues that if it had not submitted a DMCA takedown notice, it
9 could have submitted a trademark takedown notice that would have
10 had the same effect. Id. Essentially, CrossFit is asking the
11 Court to find that (1) Alvies's Facebook page infringed on
12 CrossFit's trademarks, and (2) had CrossFit submitted a trademark
13 takedown notice, Facebook would have removed Alvies's page. This
14 is asking too much. The Court cannot adjudicate CrossFit's
15 trademark claims on a motion to dismiss Alvies's counterclaim, let
16 alone hypothesize about what Facebook would or would not have done
17 if it had received a trademark takedown notice regarding Alvies's
18 Facebook page. The Court limits its analysis to the allegations in
19 Alvies's pleading. Those allegations indicate that Alvies derived
20 at least some income from her blog and that the blog was associated
21 with the Facebook page that CrossFit caused to be removed through
22 an improper DMCA takedown notice.

23 Alvies's counterclaim for declaratory relief remains
24 undisturbed.

25 **B. UCL**

26 Alvies's UCL claim is premised on the theory that CrossFit has
27 engaged in harassing conduct in an effort to eradicate all evidence
28 of Alvies's prior use of marks that are subject to CrossFit's

1 intent-to-use applications with the PTO. FACC ¶ 75. The UCL
2 counterclaim targets CrossFit's efforts to delete Alvies's blog and
3 Facebook page and to stop Alvies from selling vitamin shakes. Id.
4 The UCL prohibits any business act or practice that is unlawful,
5 unfair, or fraudulent. Cal. Bus. & Prof. Code § 17200. Alvies
6 asserts claims under all three prongs. FACC ¶¶ 76-78.

7 CrossFit argues that Alvies lacks standing because she has
8 failed to plead an economic injury. Mot. at 8-9. The Court
9 disagrees. Alvies alleges that her blog and affiliated Facebook
10 page generated at least a modicum of revenue through the sale of
11 vitamin shakes and Google AdWords, and that CrossFit wrongfully
12 caused those pages to be removed. Thus, it is plausible that
13 CrossFit's alleged misconduct resulted in economic injury to
14 Alvies.

15 However, a private plaintiff's remedies under the UCL "are
16 generally limited to injunctive relief and restitution." Cel-Tech
17 Commc'ns, Inc. v. Los Angeles Cellular Tel. Co., 20 Cal. 4th 163,
18 179 (Cal. 1999). Alvies's prayer for relief is vague with respect
19 to the UCL. She merely asks that the Court enter judgment that
20 CrossFit violated the statute. FACC p. 17. There is no indication
21 that Alvies is seeking injunctive relief. Moreover, under the UCL,
22 a plaintiff cannot recover restitution unless that plaintiff had an
23 "ownership interest in the money or property sought to be
24 recovered" and the defendant "acquired the plaintiff's money or
25 property by means of . . . unfair competition." Shersher v. Super.
26 Ct., 154 Cal. App. 4th 1491, 1494 (Cal. Ct. App. 2007) (internal
27 quotations omitted). Here, it is unclear how CrossFit could have
28 acquired the lost revenue alleged by Plaintiff.

1 Accordingly, the Court DISMISSES Alvies's UCL claim with leave
2 to amend.

3 **C. False Advertising under the Lanham Act**

4 The Lanham Act prohibits "false representations in the
5 advertising and sale of goods and services. Jack Russell Terrier
6 Network of N. Ca. v. Am. Kennel Club, Inc., 407 F.3d 1027, 1036
7 (9th Cir. 2005). To prevail on a false advertising claim under the
8 Lanham Act, a plaintiff must show, inter alia, "a false statement
9 of fact by the defendant in a commercial advertisement about its
10 own or another's product." Southland Sod Farms v. Stover Seed Co.,
11 108 F.3d 1134, 1139 (9th Cir. 1997). The injury alleged must be
12 "competitive or harmful to the plaintiff's ability to compete with
13 the defendant." Jack Russell, 407 F.3d at 1027 (quotations
14 omitted).

15 Alvies claims that CrossFit violated the Lanham Act by making
16 false and misleading representations to readers of her blog
17 regarding her workout regimens. FACC ¶ 83. Specifically, Alvies
18 targets the CrossFit paralegal's representations to a blog reader
19 that Alvies's workouts are "bad," "stupid," or "unsafe." Id.
20 Alvies further alleges that CrossFit's representations have
21 irreparably injured her goodwill and reputation. Id. ¶ 84.

22 CrossFit argues that Alvies lacks standing to assert a false
23 advertising Lanham Act claim because the parties are not direct
24 competitors. MTD at 17. CrossFit reasons that it is "one of the
25 largest fitness training companies in the country," while Alvies is
26 merely a "blogger who . . . sells Google AdWords and . . . vitamin
27 shakes." Id. The argument lacks merit. Both parties offer
28 fitness training services. See Compl. ¶ 9; FACC ¶ 18. Their

1 business models differ, but they offer similar services to
2 consumers. That Alvies earns revenues through advertisements and
3 vitamin shake sales rather than a nationally standardized
4 certificate program does not mean that she does not compete with
5 CrossFit. Moreover, nothing in the Lanham Act suggests that
6 differences in size preclude a finding of competition.

7 Next, CrossFit argues that Alvies fails to allege her Lanham
8 Act counterclaim with sufficient particularity. MTD at 18. To the
9 extent that CrossFit contends that Alvies's Lanham Act claim fails
10 to meet the pleading requirements of Rule 9(b), its argument lacks
11 merit. Alvies has pleaded sufficient facts to put CrossFit on
12 notice of the allegedly false statement that forms the basis of her
13 Lanham Act claim. Alvies's pleading identifies who made the
14 statement, to whom the statement was made, the exact contents of
15 the statement, why the statement is false, and the approximate time
16 of the statement.

17 However, the Court agrees that Alvies has pleaded insufficient
18 facts to establish that the conduct alleged constitutes advertising
19 for the purposes of the Lanham Act. Under the Act's false
20 advertising provisions, statements are only actionable if they
21 constitute "commercial advertising or promotion," which has been
22 defined as "(1) commercial speech; (2) by a defendant who is in
23 commercial competition with plaintiff; (3) for the purpose of
24 influencing consumers to buy defendant's goods or services."
25 Coastal Abstract Serv., Inc. v. First Am. Title Ins. Co., 173 F.3d
26 725, 735 (9th Cir. 1999) (quoting Gordon & Breach Sci. Publishers
27 v. Am. Inst. of Physics, 859 F. Supp. 1521 (S.D.N.Y. 1994)).
28 "While the representations need not be made in a 'classic

1 advertising campaign,' but may consist instead of more informal
2 types of 'promotion,' the representations (4) must be disseminated
3 sufficiently to the relevant purchasing public to constitute
4 'advertising' or 'promotion' within that industry." Id.
5 "Representations that are commercial advertising or promotion under
6 the Lanham Act must be part of an organized campaign to penetrate
7 the market, rather than isolated disparaging statements." eMove
8 Inc. v. SMD Software Inc., CV-10-02052-PHX-JRG, 2012 WL 1379063, at
9 *5 (D. Ariz. Apr. 20, 2012).

10 Alvies's pleading targets a single, isolated email from a
11 CrossFit paralegal to a reader of Alvies's blog. This hardly
12 constitutes "an organized campaign to penetrate the market." See
13 id. Without more, the Court cannot conclude that Alvies's Lanham
14 Act counterclaim concerns commercial advertising or promotion.
15 Accordingly, the Lanham Act counterclaim is DISMISSED with leave to
16 amend. The amended pleading should identify CrossFit's allegedly
17 disparaging statements and explain how they were disseminated to
18 the purchasing public.

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1 **V. CONCLUSION**

2 For the foregoing reasons, CrossFit's motion to dismiss is
3 GRANTED in part and DENIED in part. Alvies's counterclaim for
4 declaratory relief remains undisturbed. Her counterclaims for
5 violations of the UCL and the Lanham Act are DISMISSED with leave
6 to amend. Alvies shall file an amended pleading within thirty (30)
7 days of the signature date of this Order. Failure to do so may
8 result in dismissal with prejudice of her UCL and Lanham Act
9 counterclaims.

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11 IT IS SO ORDERED.

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13 January 22, 2014

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UNITED STATES DISTRICT JUDGE

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