

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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ATLANTIC RECORDING CORPORATION, et al.,

No. 05 CV 9111 (LTS)(DFE)

Plaintiffs,

-against-

DOES 1-25,

Defendants.

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**MEMORANDUM OF LAW OF DEFENDANT “JOHN DOE” IN  
SUPPORT OF HIS MOTION TO VACATE *EX PARTE* ORDER WHICH  
GRANTED PLAINTIFFS' APPLICATION TO TAKE IMMEDIATE DISCOVERY**

**Preliminary Statement**

Defendant “John Doe” a/k/a Doe No. 8, by his attorneys Beldock Levine & Hoffman LLP, respectfully submits this memorandum of law in support of his motion for an Order vacating the Court’s October 27, 2005 *Ex Parte* Order which granted plaintiffs’ Application for Immediate Discovery. The relevant facts are set forth in the accompanying affidavits of Morlan Ty Rogers and Zi Mei.

**ARGUMENT**

**THE *EX PARTE* ORDER SHOULD BE VACATED BECAUSE  
PLAINTIFFS HAVE NOT MADE A CONCRETE EVIDENTIARY  
SHOWING OF A PRIMA FACIE CLAIM OF COPYRIGHT INFRINGEMENT**

Federal courts have long disfavored the use of unidentified “John Doe” defendants in complaints. Petway v. City of New York, 02 Civ. 2715, 2005 WL 2137805 at \*4 (E.D.N.Y. Sept. 2, 2005); In re Ticketplanet.com, 313 B.R. 46, 55 n.4 (Bankr. S.D.N.Y. 2004); Strauss v. City of Chicago, 760 F.2d 765, 770 n.6 (7<sup>th</sup> Cir. 1985). Moreover, as a general rule, discovery may take

place only after a defendant has been served. Columbia Insurance Co. v. Seescandy.com, 185 F.R.D. 573, 577 (N.D.Cal.1999). A plaintiff in a copyright infringement case who seeks discovery to uncover the identity of an unknown “John Doe” defendant must therefore make “a concrete showing of a prima facie claim of copyright infringement.” Sony Music Entertainment Inc. v. Does 1-40, 326 F.Supp.2d 556, 564-65 (S.D.N.Y. 2004). See Columbia Insurance Co., supra, 185 F.R.D. at 580 (to obtain discovery as to identity of John Doe defendant, plaintiff must make an evidentiary showing “that an act giving rise to civil liability *actually occurred* and that the discovery is aimed at revealing specific identifying features of the person or entity who committed that act”) (italics added).

To protect against an unjustified invasion of a John Doe defendant’s right to privacy and anonymity, a plaintiff seeking discovery to identify such a defendant must demonstrate “a real evidentiary basis for believing that the defendant has engaged in wrongful conduct.” Highfields Capital Management L.P. v. Doe, 385 F.Supp.2d 969, 970 (N.D. Cal. 2005). To satisfy this requirement, the plaintiff

must adduce *competent evidence* – and the evidence plaintiff adduces must address *all* of the inferences of fact that plaintiff would need to prove in order to prevail under at least one of the causes of action plaintiff asserts. In other words, the evidence that plaintiff adduces must, if unrebutted, tend to support a finding of *each* fact that is essential to a given cause of action.

Highfields Capital Management, supra, 385 F.Supp.2d at 975-76 (italics in original); Dendrite International, Inc. v. Doe No. 3, 342 N.J.Super. 134, 141, 157-59, 775 A.2d 756, 760, 771-72 (N.J. App. 2001) (affirming denial of plaintiff’s motion for expedited discovery to obtain identity of John Doe defendant; plaintiff failed to make evidentiary showing supporting each element of its prima facie case).

Here, the *Ex Parte* Order should be vacated since plaintiffs' application for expedited discovery clearly failed to make the requisite *prima facie* evidentiary showing. The complaint alleges in conclusory fashion three forms of activity purportedly constituting copyright infringement – (1) downloading copyrighted files, (2) distributing such files to the public, and/or (3) making such files *available* for distribution to others. However, a close review of the Declaration submitted by Jonathan Whitehead of the Recording Industry Association of America, Inc. ("RIAA") in support of plaintiffs' application (the "Whitehead Declaration") reveals that plaintiffs have no evidence at all for the first two of these categories. Neither the Whitehead Declaration nor the exhibits annexed thereto set forth evidence of any actual instances of illegal downloading of copyrighted files onto defendants' computers, nor do they demonstrate any instances of actual uploading, *i.e.*, distribution of copyrighted files from defendants' computers to the public.<sup>1</sup>

Moreover, the limited evidence that plaintiffs have for the third category – that defendants allegedly made files *available* for distribution – is irrelevant and cannot support the *Ex Parte* Order because merely *offering* files or making them *available* for distribution to others is not

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<sup>1</sup>To the extent that plaintiffs claim that they (or their agents) viewed or downloaded actual copies of copyrighted recordings from defendants' computers, such activity still would not involve distribution or dissemination "to the public" and thus would not constitute copyright infringement. U.S. Naval Institute v. Charter Communications, Inc., 936 F.2d 692, 695 (2d Cir. 1991) ("It is elementary that the lawful owner of a copyright is incapable of infringing a copyright interest that is owned by him"); RSO Records v. Peri, 79 Civ. 5098, 1980 U.S. Dist. LEXIS 13490 at \*8 (S.D.N.Y. Sep. 5, 1980) (Appendix 1) (complaint alleging that plaintiffs participated in reproduction and distribution of infringing copies failed to state valid infringement claim against defendants; "a copyright owner cannot infringe his own copyright"); Higgins v. Detroit Education Television Foundation, 4 F.Supp.2d 701, 705 (E.D.Mich. 1998) ("[a] plaintiff may not claim to have been damaged by reason of a defendant's sale of alleged infringing copies if the copies were sold to plaintiff's agent because such a sale prevents the distribution of such copies to the general public").

a copyright infringement. In re Napster, Inc., 377 F.Supp.2d 796, 802, 805 (N.D.Cal. May 31, 2005) (granting summary judgment; although the copyrighted work was made available for distribution, there was no proof that copies of it were “actually disseminated” to members of the public); Arista Records, Inc. v. MP3Board, Inc., 00 Civ. 4660, 2002 U.S. Dist. LEXIS 16165 at \*13-14 (S.D.N.Y. Aug. 29, 2002) (Appendix 2) (posting on MP3Board website of links leading to infringing audio files does not establish unlawful dissemination of copies of such files to the public; “[i]nfringement of the distribution right requires an *actual dissemination* of ... copies”) (italics added). See also Obolensky v. G.P. Putnam’s Sons, 628 F.Supp. 1552, 1555-56 (S.D.N.Y.) (publisher did not infringe on copyright owner’s right of distribution of copyrighted book by listing the book in a trade publication as belonging to publisher where publisher neither copied the book nor sold any copies of the book; “there is no violation of the right to vend copyrighted works ... where the defendant offers to sell copyrighted materials but does not consummate a sale”), aff’d, 795 F.2d 1005 (2d Cir. 1986); National Car Rental System, Inc. v. Computer Associates International, Inc., 991 F.2d 426, 434 (8<sup>th</sup> Cir. 1993) (“[i]nfringement of [the distribution right] requires an *actual dissemination* of either copies or phonorecords”) (italics added) (citing 2 Nimmer on Copyright § 8.11[A], at 8-124); 2 Paul Goldstein, Copyright § 5.5.1, at 5:102 to 5-102-1 (2d ed. 2000 & Supp. 2005) (“an actual transfer must take place; a *mere offer for sale will not violate the right*”) (italics added); SBK Catalogue Partnership v. Orion Pictures Corp., 723 F.Supp. 1053, 1064 (D.N.J. 1989) (merely “authorizing” a third party to distribute copyrighted works without proof that the third party actually did so does not constitute copyright infringement); CACI Intern., Inc. v. Pentagen Technologies Intern., 93 Civ. 1631, 1994 U.S. Dist. LEXIS 21457 at \*12 (E.D.Va. Jun. 16, 1994) (Appendix 3) (marketing of software package without actually distributing it does not constitute copyright

infringement). Compare Hotaling v. Church of Jesus Christ of Latter-Day Saints, 118 F.3d 199 (4<sup>th</sup> Cir. 1997), where it was held that making *unauthorized* copies available for distribution could constitute an infringement. Here, however, the Whitehead Declaration is bereft of evidence that the copies of music files allegedly on defendants’ computers were unauthorized.

Clearly, plaintiffs have not made “a concrete showing of a prima facie claim of copyright infringement.” Indeed, there is no evidence at all in the record of any infringement.

Accordingly, there is no justification for exposing defendants to a meritless lawsuit that will invade their privacy, destroy their anonymity and force them to incur unwarranted expenses and legal fees. The Court should therefore vacate the *Ex Parte* Order.

### **CONCLUSION**

The Court should grant the within motion in all respects.

Respectfully submitted,

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