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IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

MANDO MORLOS, an individual,

Plaintiff,

v.

ST. FRANCIS HIGH SCHOOL – SALESIAN COLLEGE PREPARATORY, a private high school,

Defendant.

Case No.: 3:24-CV-1773-TLT

PLAINTIFF'S RESPONSE TO DEFENDANT'S NOTICE AND MOTION TO DISMISS PLAINTIFF'S CLAIM II FOR BREACH OF CONTRACT FOR FAILURE TO STATE A CLAIM UNDER RULE 12(b)(6)

Mando Morlos, for his Response to Defendant's Notice and Motion to Dismiss Plaintiff's Claim II for Breach of Contract for Failure to State a Claim Under Rule 12(b)(6), hereby states as follows:

Counsel for Defendant did not confer with Plaintiff's counsel as to the date or time of the hearing it noticed for July 30, 2024. Plaintiff respectfully requests that the Court vacate that hearing and deny Defendant's motion.

ADDITIONAL RELEVANT FACTS

In 2020, Morlos engaged in negotiations with St. Francis regarding his photography services and renewal of their contract. During this negotiation, St. Francis and Morlos agreed that St. Francis would evaluate Morlos's services during the fall of 2020 and decide whether to renew their photography contract in January, 2021. In January, 2021, St. Francis communicated to Morlos that it was pleased with his services. In doing so, St. Francis agreed to renew its contract with Morlos.

Acting on this, Morlos upgraded his equipment and informed St. Francis of his plans to support their school pursuant to the contract in the upcoming term. St. Francis responded to Morlos, again stating it was pleased he was taking these steps. However, in May, 2021, St. Francis informed Morlos that it did not intend to honor its contract with Morlos and that it had hired a different photographer. First Amended Complaint, ¶¶ 13–17. Thereafter, despite breaching its contract and secretly hiring a different photographer, St. Francis continued to use Morlos's photographs beyond the terms of their contract.

LAW AND ARGUMENT

Plaintiff's breach-of-contract-claim is qualitatively different than his copyright-infringement claim. As Defendant notes, federal copyright statutes can act to preempt some state law claims.[1] "To survive preemption, a state cause of action must assert rights that are qualitatively different from the rights protected by copyright." *Montz v. Pilgrim Films & TV, Inc.*, 649 F.3d 975, 979 (9th Cir. 2011). In contract cases, where the contract contains an additional promise or agreement, then the state cause of action is qualitatively different. *Id.* In this case, it is clear that Plaintiff's claim is not preempted because there are numerous different promises and agreements in his contract with Defendant.

Defendant promised to engage Plaintiff as its photographer for the 2021–2022 school year. However, Defendant then preemptively breached that contract and refused to use Plaintiff as its photographer. Defendant promised it would not use Plaintiff's photographs beyond the contract period. But Defendant then continued to use all of Plaintiff's photographs from prior years to market itself to parents, students, and donors. Defendant promised to only use Plaintiff's photographs in print materials and on its main website. But Defendant breached that agreement as well. Finally, when Plaintiff requested that Defendant stop or pay for use of the images, Defendant refused.

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[1] Defendant argues that a statute enumerated as "17 USC 310(a)" expressly preempts state claims "including state breach of contract claims." Def. Mt. at 4. However, there is no such statute. Defendant likely meant to cite 17 U.S.C. §301(a).

It is of course obvious that issues of copyright infringement are present in this case. However, there are significant and substantially different agreements and promises that are also included within the contract between Plaintiff and Defendant. First, Defendant refused to pay Plaintiff for services for the upcoming school year. Nothing about that agreement or Defendant's breach involves copyright infringement. Second, Defendant agreed to use what photographs it did have only in a limited manner and for a limited period of time. This is qualitatively different than simply infringing on a copyright. Here, Plaintiff must establish the scope of agreed upon usages and payment for these usages. In fact, the Montz Court notes that this is one circumstance where the breach of contract claim is not preempted. *Id.* ("Contract claims generally survive preemption because they require proof of such an extra element. The extra element, the implied agreement of payment for use of a concept, is a personal one, between the parties.") (internal citations omitted).

Ultimately, Plaintiff's breach-of-contract claim is qualitatively different because it contains several additional promises and agreements. As a result, Plaintiff's claim is not preempted and Defendant's motion should be denied.

CONCLUSION

WHEREFORE, Plaintiff prays this court DENY Defendant's motion, vacate the noticed hearing, any and all other relief as the Court deems just and proper.

Respectfully submitted,

Dated: July 5, 2024

By: */s/ Benjamin Owens-Filice*

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I hereby attest that I have on file all holographic signatures corresponding to any signatures indicated by a conformed signature (/S/) within this e-filed document.