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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

DR. SEUSS ENTERPRISES, L.P.,

Plaintiff,

v.

COMICMIX LLC; GLENN HAUMAN;
DAVID JERROLD FRIEDMAN a/k/a
JDAVID GERROLD; and TY
TEMPLETON,

Defendants.

Case No.: 16-CV-2779-JLS (BGS)

**ORDER GRANTING IN PART
MOTION FOR PARTIAL
JUDGMENT ON THE PLEADINGS**

(ECF No. 54)

Presently before the Court is Defendants’ Motion for Partial Judgment on the Pleadings, (“MJP,” ECF No. 54). Also before the Court is Plaintiff’s Response in Opposition to the Motion, (“Opp’n,” ECF No. 60), and Defendants’ Reply in Support of the Motion, (“Reply,” ECF No. 62). The Court held oral argument on the motion on April 17, 2018. After considering the Parties’ arguments and the law, the Court rules as follows.

BACKGROUND

Due to the multiple orders in this case that adequately summarize the factual

1 background, the Court will not repeat the factual background here.¹ (*See* ECF No. 51, at
2 2–3.)² As to the procedural background, Plaintiff filed a Complaint against Defendants
3 for: (I) copyright infringement; (II) trademark infringement; and (III) unfair competition.
4 (“Compl.,” ECF No. 1.) Defendants filed a Motion to Dismiss the complaint. (ECF No.
5 8.) The Court granted in part and denied in part Defendants’ Motion. (“First MTD Order,”
6 ECF No. 38.) Specifically, the Court denied Defendants’ Motion to Dismiss Plaintiff’s
7 claim of copyright infringement (Count I) and granted Defendants’ Motion to Dismiss
8 Plaintiff’s claims of trademark infringement and unfair competition (Counts II and III).
9 (*Id.* at 20.) The Court granted Plaintiff leave to amend its Complaint and Plaintiff filed an
10 Amended Complaint, (“FAC,” ECF No. 39). Defendants again moved to dismiss the
11 Complaint, and the Court denied the motion. (“Second MTD Order,” ECF No. 51.)
12 Defendants then filed the present Motion seeking judgment on the pleadings as to
13 Plaintiff’s trademark and unfair competition claims.

14 LEGAL STANDARD

15 Any party may move for judgment on the pleadings “[a]fter the pleadings are
16 closed—but early enough not to delay trial.” Fed. R. Civ. P. 12(c). A motion for judgment
17 on the pleadings attacks the legal sufficiency of the claims alleged in the complaint. *See*
18 *Patel v. Contemporary Classics of Beverly Hills*, 259 F.3d 123, 126 (2d Cir. 2001). The
19 Court must construe “all material allegations of the non-moving party as contained in the
20 pleadings as true, and [construe] the pleadings in the light most favorable to the [non-
21 moving] party.” *Doyle v. Raley’s Inc.*, 158 F.3d 1012, 1014 (9th Cir. 1998). “Judgment on
22 the pleadings is proper when the moving party clearly establishes on the face of the
23 pleadings that no material issue of fact remains to be resolved and that it is entitled to
24 judgment as a matter of law.” *Hal Roach Studios, Inc. v. Richard Feiner & Co., Inc.*, 896
25 F.2d 1542, 1550 (9th Cir. 1990). “Analysis under Rule 12(c) is ‘substantially identical’ to
26

27 ¹ The Court will continue to refer to Defendants’ book, *Oh! The Places You’ll Boldly Go!*, as “*Boldly*”
28 and will refer to Plaintiff’s book, *Oh! The Places You’ll Go!*, as “*Go!*”

² Pin citations refer to the CM/ECF page numbers electronically stamped at the top of each page.

1 analysis under Rule 12(b)(6) because, under both rules, ‘a court must determine whether
2 the facts alleged in the complaint, taken as true, entitle the plaintiff to a legal remedy.’”
3 *Chavez v. United States*, 683 F.3d 1102, 1108 (9th Cir. 2012).

4 ANALYSIS

5 Defendants base their Motion on the Ninth Circuit opinion *Twentieth Century Fox*
6 *Television a Division of Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*,
7 875 F.3d 1192 (9th Cir. 2017), which was issued on November 16, 2017 and interprets and
8 applies the test from *Rogers v. Grimaldi*, 875 F.2d. 994 (2d Cir. 1989).

9 I. Background

10 In their first motion to dismiss, Defendants argued that Plaintiff’s trademark claims
11 should be dismissed because *Boldly* merits First Amendment protection under *Rogers v.*
12 *Grimaldi*. Under the *Rogers* two-prong test, the title of an expressive work does not violate
13 the Lanham Act “unless the title has no artistic relevance to the underlying work
14 whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the
15 source or the content of the work.” *Mattel Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902
16 (9th Cir. 2002) (internal quotation marks omitted) (quoting *Rogers*, 875 F.2d at 999). This
17 test “insulates from restriction titles with at least minimal artistic relevance that are
18 ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles
19 that are explicitly misleading as to source or content, or that have no artistic relevance at
20 all.” *Rogers*, 875 F.2d at 1000.

21 The first *Rogers* prong requires that Defendants’ use of Plaintiff’s mark be relevant
22 to the underlying work. If this prong is satisfied, the second prong dictates that the use
23 may not explicitly mislead consumers about the source or content of the work. In their
24 prior motion, Defendants argued *Boldly*’s use of *Go!*’s title and “fonts and illustrations that
25 recall Dr. Seuss’s style” are “directly relevant to a creative work that addresses the
26 relationship between *Go!* and other Dr. Seuss works and the *Star Trek* universe.” (ECF
27 No. 8-1, at 29.) As to the second prong, Defendants argued there is nothing misleading
28 about *Boldly*. (*Id.*) In response, Plaintiff pointed to what it deemed “the most relevant

1 portion of *Rogers*”—footnote 5. This footnote states that the outlined “limiting
2 construction would not apply to misleading titles that are confusingly similar to other titles.
3 The public interest in sparing consumers this type of confusion outweighs the slight public
4 interest in permitting authors to use such titles.” *Rogers*, 875 F.2d at 999 n.5.

5 In its order on the motion to dismiss, this Court analyzed the *Rogers* test. As to the
6 first prong, it held there is no question that “Defendants’ invocation of Plaintiff’s alleged
7 trademarks is relevant to *Boldly*’s artistic purpose.” (First MTD Order 15.) As to the
8 second prong, the Court held that *Boldly* does not explicitly mislead as to its source or
9 content. (*Id.*) The Court then referenced the exception in footnote 5. (*Id.* at 17.) The
10 Court stated that the Ninth Circuit had not “directly addressed this exception,” but other
11 district courts have determined that the exception is applicable. The Court therefore held
12 it would not dismiss Plaintiff’s trademark claims on First Amendment grounds under
13 *Rogers*. (*Id.* at 17.) Defendants now argue the *Rogers* footnote has been disavowed by
14 the Ninth Circuit in *Empire Distribution* and *Boldly*’s use of Plaintiff’s pled trademark
15 claims “merits First Amendment protection under both prongs of the *Rogers* test.” (MJP
16 11.)

17 ***II. Twentieth Century Fox Television v. Empire Distribution, Inc.***

18 *Twentieth Century Fox Television a Division of Twentieth Century Fox Film Corp.*
19 *v. Empire Distribution, Inc.*, 875 F.3d 1192 (9th Cir. 2017) involved a dispute between
20 Empire Distribution (“Empire”), the well-known record label, and Twentieth Century Fox
21 Television and Fox Broadcasting Company (“Fox”). Fox premiered a television show
22 titled *Empire*, which portrays a fictional music label named “Empire Enterprises.” Fox
23 promoted the show and the music from the show through performances and goods bearing
24 the show’s “Empire” brand. Empire sent Fox a claim letter demanding Fox stop using the
25 Empire trademark. Fox filed suit, “seeking a declaratory judgment that the *Empire* show
26 and its associated music releases do not violate Empire Distribution’s trademark rights
27 under either the Lanham Act or California law.” *Empire*, 875 F.3d at 1195. Fox moved
28 for summary judgment, which the district court granted, and Empire appealed.

1 In analyzing the claim, the Ninth Circuit noted that when “the allegedly infringing
2 use is the title of an expressive work,” it applies the *Rogers* test rather than the likelihood-
3 of-confusion test. *Id.* at 1196. Expressive works are treated differently from other covered
4 works “because (1) they implicate the First Amendment right of free speech, which must
5 be balanced against the public interest in avoiding consumer confusion; and (2) consumers
6 are less likely to mistake the use of someone else’s mark in an expressive work for a sign
7 of association, authorship, or endorsement.” *Id.* Accordingly, “the title of an expressive
8 work does not violate the Lanham Act ‘unless the title has no artistic relevance to the
9 underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly
10 misleads as to the source or the content of the work.’” *Id.* (quoting *Rogers*, 875 F.2d at
11 999).

12 The Ninth Circuit first determined whether the *Rogers* test applied to the Empire
13 mark. Empire had argued that the limiting construction from *Rogers* would not apply due
14 to footnote 5. The Ninth Circuit stated that the footnote had only ever been cited once by
15 an appellate court, and even then the Second Circuit had rejected its applicability. *Id.* at
16 1197 (citing *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490
17 (2d Cir. 1989)). The Ninth Circuit stated “[t]he exception the footnote suggests may be ill-
18 advised or unnecessary” because identifying confusingly similar titles “has the potential to
19 duplicate either the likelihood-of-confusion test or the second prong of *Rogers*” and
20 “conflicts with our precedents, which ‘dictate that we apply the *Rogers* test in [Lanham
21 Act] § 43(a) cases involving expressive works.’” *Id.* (alternation in original) (quoting
22 *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241–42 (9th Cir. 2013)).

23 In sum, the court found the first *Rogers* prong is satisfied because it could not say
24 that Fox’s use of the “Empire” mark “has no artistic relevance to the underlying work
25 whatsoever.” *Id.* at 1198. The court noted there is no requirement that the junior work
26 refer to the senior work, i.e., the word “Empire” did not need to refer to Empire
27 Distribution. *Id.* The court also found the second prong is satisfied because Fox’s show
28 “contains no overt claims or explicit references to Empire Distribution” and is not explicitly

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