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

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

LEGAL STANDARD

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

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[1] The Court will continue to refer to Defendants' book, *Oh! The Places You'll Boldly Go!*, as "*Boldly*" 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.

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

ANALYSIS

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

I. Background

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

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

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

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

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

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

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

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

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

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