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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

1 misleading. *Id.* The court thus affirmed the district court’s grant of summary judgment
2 in favor of Fox for the trademark infringement, trademark dilution, unfair competition, and
3 false advertising claims.

4 **III. Discussion**

5 The Court now evaluates Plaintiff’s trademark claims under the *Rogers* test as it has
6 been interpreted by the Ninth Circuit.

7 **A. First Rogers Prong**

8 As to the first *Rogers* prong, “only the use of a trademark with ‘no artistic relevance
9 to the underlying work whatsoever’ does not merit First Amendment protection. In other
10 words, the level of relevance merely must be above zero.” *E.S.S. Entm’t 2000, Inc. v. Rock
11 Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008). “A mark that has no meaning
12 beyond its source-identifying function is more likely to be used in a way that has ‘no artistic
13 relevance to the underlying work whatsoever,’ [citation] because the work may be ‘merely
14 borrow[ing] another’s property to get attention,’ [citation].” *Id.* at 1198 (quoting *Mattel*,
15 296 F.3d at 901–02; and citing *Dr. Seuss Ents., L.P. v. Penguin Books USA, Inc.*, 109 F.3d
16 1394, 1401 (9th Cir. 1997)).

17 This Court previously found that Defendants’ invocation of Plaintiff’s alleged
18 trademarks is relevant to *Boldly*’s artistic purpose. (First MTD Order 15.) Plaintiff argues
19 the title of *Boldly* was not chosen for artistically relevant reasons but was chosen to “borrow
20 from the rights holder or avoid the drudgery of creating something fresh.” (Opp’n 16
21 (citing *Empire*, 875 F.3d at 1198 and *Penguin*, 109 F.3d at 1401).) The Court disagrees.
22 As mentioned above, the “artistic relevance” test is a low bar—the level must merely be
23 “above zero.” *Brown*, 724 F.3d at 1243. It cannot be said that the title of *Boldly* is not at
24 all relevant to the content of the book. As well-put by the court in *CI Games S.A. v.
25 Destination Films*, No. 2:16-cv-5719-SVW-JC, 2016 WL 9185391 (C.D. Cal. Oct. 25,
26 2016): “It is clear to the Court that the artistic relevance prong of the *Rogers* test is meant
27 to ensure that the title in question uses the potential trademark to express or describe its
28 own content rather than merely to attract notoriety using a trademark in its title that is

1 irrelevant to the underlying work.” *Id.* at *6. This Court agrees and finds the title of *Boldly*,
2 while obviously also referring to and using the title of *Go!*, describes and is relevant to its
3 own content. This prong is met.

4 ***B. Second Rogers Prong***

5 The second prong of the *Rogers* test requires a junior user to show that its work does
6 not explicitly mislead as to the source or content of the work. *Mattell*, 296 F.3d at 902. “It
7 is well established that the use of a mark alone is not enough to satisfy this prong of the
8 *Rogers* test.” *Brown*, 724 F.3d at 1245. The question is “whether there was an ‘explicit
9 indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused . . . consumer confusion.”
10 *Id.* (quoting *Rogers*, 875 F.2d at 1001). The Ninth Circuit has held that even if a party
11 produces survey evidence that shows consumers believed that the trademark owner
12 endorsed the allegedly infringing work, this would not be enough to support a claim of
13 explicit misleading. *Id.* at 1245–46. “To be relevant, evidence must relate to the nature of
14 the behavior of the identifying material’s user, not the impact of the use.” *Id.* at 1246. For
15 example, if a party produced evidence of “statements made in materials” accompanying
16 the allegedly infringing work that explicitly mislead consumers, this may be sufficient. *Id.*

17 Here, if Defendants had included a leaflet or a statement within *Boldly* that stated
18 Plaintiff endorsed or was involved in the production of *Boldly*, this may be sufficient.
19 There is no such statement, in fact, the opposite is true. *Boldly*’s copyright page states that
20 “[t]his is a work of parody, and is not associated with or endorsed by CBS Studios or Dr.
21 Seuss Enterprises, L.P.,” and includes the following text: “Copyright Disclaimer under
22 section 107 of the Copyright Act 1976, allowance is made for ‘fair use’ for purposes such
23 as criticism, comment, news reporting, teaching, scholarship, education, research, and
24 parody.” (MJP 5–6.) Although the effectiveness of these disclaimers is disputed by
25 Plaintiff, what cannot be disputed is that there is no statement in *Boldly* to the contrary, i.e.,
26 that the work *is* associated with or endorsed by Plaintiff.

27 Plaintiff argues that Defendants have taken more than just the mark because they
28 used the title *Oh! The Places You’ll Go!* and copied the lettering and font of the title and

1 many of the illustrated characters. (Opp'n 21.) Indeed, this Court has found that "[t]he
2 look of the lettering is unquestionably identical on both books, down to the shape of the
3 exclamation point." (Second MTD Order 21.) But, Defendants' use of the text and design
4 of *Go!*'s title is not enough to be an "explicit misstatement." *See Rogers*, 875 F.2d at 999
5 (giving as examples of "explicit" endorsement the phrases "an authorized biography" or
6 "Jane Fonda's Workout"); *see also Brown*, 724 F.3d at 1246 ("The risk of
7 misunderstanding, not engendered by any explicit indication on the face of the [work], is
8 so outweighed by the interest in artistic expression as to preclude application of the
9 [Lanham] Act." (quoting *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003))).

10 Plaintiff has not pointed to, and is not able to point to, any evidence that the title of
11 *Boldly* explicitly misleads as to the source of the work, thus, the second prong of *Rogers* is
12 satisfied. Because both *Rogers* prongs are satisfied, Defendant is entitled to judgment on
13 the pleadings as to Plaintiff's trademark claims.

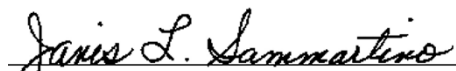
14 **CONCLUSION AND ORDERS**

15 With this finding, the Court now clarifies which claims are to be dismissed. As
16 noted in the prior order, Plaintiff has pled trademark rights in the title of, fonts on and
17 within, and illustrations within *Go!*. The Court stated it was unnecessary to determine at
18 that time "whether Plaintiff may claim trademark rights in the fonts used on covers of books
19 other than *Go!* or the font used within *Go!*." (Second MTD Order 14.) The Court
20 determined the title *Go!* is a protectable trademark and analyzed Defendants' "use of *Go!*'s
21 title (the words of the title and the title's design on the book covers)." (*Id.*) The Court also
22 found it could not say at the motion to dismiss stage that Plaintiff's asserted general
23 "illustration style" is a protectable trademark but it did not find that the illustrations within
24 *Go!* are precluded from trademark protection. (*Id.* at 15.) Therefore, the Court has not
25 held whether or not Plaintiff has protectable trademark rights in the font and illustration
26 style of *Go!* and the Court has only analyzed the title of *Go!* as it appears on the cover of
27 the book. In this order, the Court is only finding that the title of *Boldly* does not violate the
28 Lanham Act. Thus, the Court **GRANTS** Defendants' Motion for Judgment on the

1 Pleadings as to Counts II and III of the First Amended Complaint as they relate to the title
2 of *Boldly*. Further, as the Court stated previously, “if claims relying on the exact same
3 factual conduct are validly dismissed under the Lanham Act, they should also be dismissed
4 under California Unfair Competition law.” (First MTD Order 19 (citing *E.S.S. Entm’t*, 547
5 F.3d at 1101).) Because Plaintiff’s unfair competition claims are based on the same factual
6 conduct as its trademark claims, the Court **GRANTS** Defendants’ Motion for Judgment on
7 the Pleadings as to Count IV of the First Amended Complaint as it relates to the title of
8 *Boldly*.

9 **IT IS SO ORDERED.**

10 Dated: May 21, 2018


11 Hon. Janis L. Sammartino
12 United States District Judge
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