

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF KENTUCKY  
AT BOWLING GREEN

The Sporting Times, LLC; and  
Sporting Times Franchise, LLC

Plaintiffs,

v.

Orion Pictures, Inc.;  
Metro-Goldwyn-Mayer  
Studios Inc.; Podium Pictures, LLC;  
Rhino films, LLC; Filmbuff, and Gunpowder &  
Sky Distribution, LLC

Defendants.

CIVIL ACTION NO. 1:17-CV-33-GNS

**DEFENDANTS' MEMORANDUM OF LAW IN SUPPORT OF MOTION  
TO DISMISS FOR FAILURE TO STATE A CLAIM [FRCP 12(b)(6)]**

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## I. SUMMARY OF ARGUMENT

Plaintiffs cannot state a cognizable Lanham Act or state-law claim based on the fleeting use of their trademark THE SPORTING TIMES in Defendants’ motion picture *Spaceman*. Well-settled authority in the Sixth Circuit and other federal courts mandates dismissal of this suit because Defendants’ film used the mark in a “non-trademark” way – as the masthead of a fictional magazine appearing in a brief montage of media clippings featuring the title character. Indeed, federal courts have held repeatedly that a plaintiff cannot plausibly allege consumer confusion – and thus cannot state a claim for trademark infringement or false designation of origin – based on the unauthorized use of a mark in a film or other expressive work. In addition, Defendants’ use is protected independently by the First Amendment under the *Rogers v. Grimaldi* test adopted by the Sixth Circuit and other courts, which may be decided at the pleading stage. Under the *Rogers* test, Plaintiffs’ Lanham Act claims are barred because the use of *The Sporting Times* has artistic relevance to a film about a professional athlete, and the film does not mislead the public about its source or origin. Plaintiffs’ ancillary claims fare no better, as courts uniformly hold that dilution and disparagement claims do not apply to expressive works. Plaintiffs’ state-law claims therefore must be dismissed for the same reasons that their Lanham Act claims fail.

At bottom, Plaintiffs’ lawsuit is based on the false premise that the Lanham Act and analogous state consumer-protection statutes prohibit the use of their mark in the film without their authorization. But this theory defies overwhelming precedent and common sense. If Plaintiffs were correct, then a character in a film or other expressive work could not say “waiter, may I please have a Coke?”, exclaim that she was “going to Disneyland,” or ask a friend to “watch the Kentucky Derby,” unless the producer first obtained consent from trademark owners

at The Coca-Cola Company, The Walt Disney Company, or Churchill Downs. Nor could a filmmaker show an Apple logo on an iPhone, a Chevrolet nameplate on a car, or the McDonald's arches on a food wrapper without first obtaining those companies' approval. Happily for filmmakers and their audiences (and for the creators of other expressive works), the Lanham Act does not grant trademark owners such veto power over the content of expressive works.

## II. FACTUAL BACKGROUND

Defendants Podium Pictures and Rhino Films produced the feature film *Spaceman*, a biopic of iconoclastic Major League Baseball pitcher Bill "Spaceman" Lee, a star southpaw for the Boston Red Sox and Montreal Expos in the 1970s and early 1980s. *See* Declaration of Joel Beres ("Beres Decl.") Ex. A.<sup>1</sup> The 90-minute film focuses on Lee's release by the Expos in 1982 and its aftermath, as Lee struggles to adapt to life away from professional baseball. *Id.* Early in the film, a montage of news articles, clippings, and radio soundbites provides the audience with an overview of Lee's career and a sense of his quirky persona. *Id.*; Compl. ¶¶ 21-22. That montage initially included a nine-second shot of the cover of a fictional magazine entitled *The Sporting Times*, dated July 1976, with the headline "Boston's Bill 'Spaceman' Lee; In an Orbit All His Own" over a photo of Josh Duhamel, the actor who played Lee, in his pitching stance:

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<sup>1</sup> A subsidiary of MGM licensed *Spaceman* for distribution in Latin America and the Orion Pictures logo appears on a title card in the film. Neither MGM nor Orion Pictures distributed the film in the United States.



See Beres Decl., Exs. A, C.<sup>2</sup> The image shown in the film is not an actual copy of Plaintiffs' publication, which did not even exist until 2004 (Compl. ¶ 14), but rather a fictional publication created by the production. That is the only use of *The Sporting Times* in the film.

Approximately two seconds of this fleeting shot also appeared in the film's original trailer. Beres Decl., Ex. C, Compl. ¶ 21. The trailer and the film were released in the summer of 2016. Compl. ¶ 17, 20.

Plaintiffs did not obtain a trademark registration for THE SPORTING TIMES until 2008 (Compl. ¶ 13), more than three decades after the date on the fictional publication depicted in the film. In September 2016, Plaintiffs sent a letter to Orion Pictures objecting to the film's brief use of the mark. Compl. ¶¶ 13, 23. As a courtesy, and to avoid the burden and expense of meritless litigation, the image of *The Sporting Times* was promptly removed from the film and the trailer. Compare Beres Decl., Ex. A (at 0:02:23) with Ex. B (at 0:02:23) and Ex. C with Ex. D.

<sup>2</sup> The *Sporting Times* image appears beginning at 0:02:23 in the film, and at 0:07 in the trailer.

Nevertheless, Plaintiffs filed this suit, asserting Lanham Act claims and vaguely-pleaded state-law claims for “false and misleading advertising,” “unauthorized commercial use” of *The Sporting Times* mark, and “commercial disparagement.” Compl. ¶¶ 32-40.

### III. ARGUMENT

#### A. Applicable Legal Standards on a Motion to Dismiss

To survive a motion to dismiss under Rule 12(b)(6), “a complaint must state sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). However, “[i]n reviewing a complaint in conjunction with a motion to dismiss, a district court is not required to accept a plaintiff’s legal conclusions as true.” *Winget v. JP Morgan Chase Bank*, 537 F.3d 565, 573 n.1 (6th Cir. 2008) (citing *Murphy v. Sofamor Danek Grp.*, 123 F.3d 394, 400 (6th Cir. 1997)). “A pleading that offers ‘labels and conclusions’ or ‘a formulaic recitation of the elements of a cause of action will not do.’ Nor does a complaint suffice if it tenders ‘naked assertion[s]’ devoid of ‘further factual enhancement.’” *Iqbal*, 556 U.S. at 678 (quoting *Twombly*, 550 U.S. at 555, 557).

In deciding this motion, the Court may consider not only the factual allegations in the complaint, but also the film and the trailer, which Defendants have attached as Exhibits A and C. The Sixth Circuit has adopted the incorporation-by-reference doctrine, which allows a district court weighing a Rule 12(b)(6) motion to “consider the Complaint and any exhibits attached thereto, public records, items appearing in the record of the case and *exhibits attached to defendant’s motion to dismiss so long as they are referred to in the Complaint and are central to the claims contained therein.*” *Bassett v. NCAA*, 528 F.3d 426, 430 (6th Cir. 2008) (citation omitted; emphasis added); *Gavitt v. Born*, 835 F.3d 623, 640 (6th Cir. 2016) (same); *Commercial*

*Money Ctr. v. Illinois Union Ins*, 508 F.3d 327, 335-336 (6th Cir. 2007) (same). Plaintiffs’ complaint refers to the film and the trailer more than a dozen times (*see* Compl. ¶¶ 17-22, 26-30, 43-44), and these works are unequivocally at the heart of Plaintiffs’ claims. Thus, the court should consider the film and trailer in connection with this motion.

**B. Because Plaintiffs Cannot Plausibly Allege Consumer Confusion, Their Lanham Act Claims Should Be Dismissed as a Matter of Law.**

**1. The Sixth Circuit Instructs Courts to Dismiss Lanham Act Claims at the Pleading Stage Where, as Here, the Defendant’s Use of the Mark Is Not a “Trademark Use.”**

Plaintiffs cannot plausibly allege that Defendants’ use of THE SPORTING TIMES mark would confuse viewers into believing that the film was produced or sponsored by Plaintiffs, and thus cannot state a claim for violation of the Lanham Act. The Sixth Circuit reiterated this rule less than two weeks ago in *Oaklawn Jockey Club v. Ky. Downs*, 2017 U.S. App. Lexis 7078 (6th Cir. April 19, 2017), *aff’g Oaklawn Jockey Club v. Ky. Downs*, 184 F. Supp. 3d 572 (W.D. Ky. 2016). There, the owners of famous horse-racing tracks alleged that the defendants infringed their trademarks by using the tracks’ names in a horse-racing video game used for pari-mutuel betting. 184 F. Supp. 3d at 574. This Court held that “there can be no finding of trademark infringement where the alleged offending party is not ‘using the challenged mark in a way that identifies *the source of their goods.*’” *Id.* at 575-576 (emphasis added). Because the plaintiffs’ complaint did not plausibly allege that consumers would be confused about the source or origin of the defendants’ gaming system merely because it included the names of the plaintiffs’ tracks, this Court found that the defendants’ use was a “non-trademark use,” and dismissed the lawsuit. *Id.* at 577, 580.

The Sixth Circuit affirmed, noting that “[g]enerally, we evaluate the likelihood of confusion through an eight-factor inquiry.” *Oaklawn Jockey Club* at \*7. “Before employing this

test, however, we ask whether Defendants are using Plaintiffs' trademarks to identify the source of Defendants' product." *Id.* "If defendants are only using [the] trademark in a 'non-trademark' way – that is, in a way that does not identify the source of a product – then trademark infringement and false designation of origin laws do not apply, and it is unnecessary to consider the eight-factor test." *Id.* (citations and internal quotes omitted). In assessing "whether Defendants' use of Plaintiffs' trademarks in the video recreations of the historic horse races constitutes a 'trademark use,'" the Sixth Circuit explained that the "inquiry focuses on 'whether a consumer is likely to notice [the plaintiff's trademark] ... and then think that the [defendant's product] may be produced by the same company[.]'" *Id.* The Sixth Circuit held that even if the defendants had used the plaintiffs' marks "to substantiate or legitimize" the gaming system, the plaintiffs had pleaded "no facts from which to infer that Defendants are engaging in a trademark use of Plaintiffs' trademarks." *Id.* at \*10, 11. Consequently, the Sixth Circuit held that the Lanham Act "claim was properly resolved on Defendants' motion to dismiss." *Id.* at 12.

**2. Numerous Courts Have Applied the Same Rule to Dismiss Lanham Act Claims Arising from Unauthorized Uses of Marks in Films and Other Expressive Works.**

Federal courts consistently hold that the non-trademark use of a mark in a motion picture or in a trailer is insufficient to state a Lanham Act claim. In *Fortres Grand Corp. v. Warner Bros. Entm't*, 763 F.3d 696, 706 (7th Cir. 2014), for example, the trademark owner for a desktop management software system called "Clean Slate" sued Warner Bros. for trademark infringement and other claims after the studio featured a fictional malicious software program also called "Clean Slate" in its blockbuster motion picture *The Dark Knight Rises* and in promotions for the film. *Id.* at 698-700. The fictional "Clean Slate" software in the film had a sinister purpose: to enable persons to hack into databases and erase their criminal records. *Id.* at 699. Websites



advertising the film also “contained descriptions of the clean slate hacking tool and its operation and an image of a fictional patent.” *Id.* at 700. After the film’s release, the real-life Clean Slate software company alleged that its sales declined because consumers who saw the film or the websites believed that the software was “illicit” or had an illegitimate purpose. *Id.* But the Seventh Circuit emphasized that the plaintiff’s software and Warner Bros.’ film were quite dissimilar goods. *Id.* at 704. After reviewing the use of the plaintiff’s mark in the film and the promotional websites, the Seventh Circuit found that the plaintiff “alleged no facts that would make it plausible that a super-hero movie and desktop management software are goods related in the minds of consumers[.]” *Id.* at 704 (internal quotes omitted). Because the plaintiff’s Lanham Act theory was “too implausible to support costly litigation,” the Seventh Circuit affirmed the district court’s order granting the studio’s motion to dismiss. *Id.* at 705 (internal quotes omitted).

Likewise, in *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 635-636 (S.D.N.Y. 2008), the court dismissed the plaintiff’s claims that the unauthorized use of its pinball machines and marks in a few scenes (totaling three minutes) of the Mel Gibson film *What Women Want* infringed its trademarks and injured it by associating its products with Gibson’s anti-Semitic views. Noting that the Lanham Act is “not concerned with mere theoretical possibilities of confusion or de minimis situations,” the court found that the plaintiff’s “assertion that the appearance of its trademark in the film would confuse ordinarily prudent consumers as to the sponsorship or affiliation of its pinball machines is *simply not plausible.*” *Id.* at 635 (emphasis added) (citations and internal quotes omitted). Moreover, the court rejected as “absurd” “[t]he notion that any viewer of the film would think less of Gottlieb because its pinball machine appears briefly in the background in a romantic comedy featuring Mel Gibson.” *Id.*

And in *Eastland Music Group v. Lionsgate Entm't*, 707 F.3d 869, 871 (7th Cir. 2013), the court held that the title of the film *50/50* did not infringe on the trademark of a rap duo called Phifty-50. Affirming the district court's dismissal of the claims, the Seventh Circuit reiterated that "[o]nly a confusion about origin supports a trademark claim," and that the plaintiff's complaint "does not (and could not plausibly) allege that consumers treat it as the producer or source of the film *50/50*, or treat [the film producer] as the producer of the 2003 rap album." *Id.* at 872. See also *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 973 (C.D. Cal. 2007) (dismissing comedian Carol Burnett's Lanham Act claim against the producers of a television program that parodied her trademarked Charwoman character, holding there was "no likelihood of confusion" because the parody did "not explicitly mislead the viewer as to affiliation, connection, association with, or sponsorship or approval by plaintiffs," even though the use was "distasteful and bizarre, even outrageous and offensive") (emphasis added); *Sherwood 48 Assocs. v. Sony Corp.*, 213 F. Supp. 2d 376, 377 (S.D.N.Y. 2002) (dismissing plaintiff's Lanham Act claims because the mere fact that defendant digitally inserted images of plaintiff's Times Square buildings into a scene of the film *Spider-Man* did not indicate consumer confusion), *aff'd in part, vacated in part on other grounds*, 76 Fed. Appx. 389 (2d Cir. 2003).

Applying these authorities, Plaintiffs' allegations are doomed to fail as a matter of law. Here, Plaintiffs allege that "readers and potential franchisors are confused as to the content and nature of The Sporting Times® publication, which now seemingly sensationalizes and promotes drug and alcohol addiction and has-been middle-aged sports figures in interstate commerce." Compl. ¶ 30. Putting aside that the fictional *Sporting Times* magazine cover in the film is from 1976, at the height of Lee's stardom, and that it does not mention drug use or alcohol addiction, Plaintiffs allege no *facts* to support their hyperbole or to demonstrate how reasonably prudent

consumers would conclude that Plaintiffs produced or sponsored Defendants’ film. It strains credulity to suggest that a fictionalized magazine cover dated decades before Plaintiffs began publishing (*see* Beres Decl., Ex. A; Compl. ¶ 14), with the benign headline “Boston’s Bill ‘Spaceman’ Lee: In An Orbit All His Own,” which appeared for nine seconds in the film and two in its trailer, confused the public into believing that Defendant’s film was produced or sponsored by Plaintiffs. Because Plaintiffs cannot plausibly allege consumer confusion based on a “non-trademark use,” the Court should dismiss the Lanham Act claims with prejudice.<sup>3</sup>

**C. The First Amendment Independently Bars Plaintiffs’ Claims.**

**1. The Film Is Entitled to Full First Amendment Protection.**

The Sixth Circuit has emphasized that the “protection of the First Amendment is not limited to written or spoken words, but includes other mediums of expression, including music, pictures, *films*, photographs, paintings, drawings, engravings, prints, and sculptures.” *ETW Corp. v. Jireh Publ’g*, 332 F.3d 915, 924 (6th Cir. 2003) (emphasis added). This constitutional protection applies with equal force whether an expressive work is labeled as news or entertainment. *Brown v. Entertainment Merchants Ass’n*, 564 U.S. 786, 790 (2011). The Supreme Court and the Sixth Circuit have upheld these First Amendment protections even where an expressive work is produced for profit. *See, e.g., Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (“[t]hat books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment”); *ETW*, 332 F.3d at 924-925 (“Speech is protected even though it is carried in a form that is sold for profit ... The fact that expressive materials are sold does not diminish the

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<sup>3</sup> As the court held in *Fortres Grand*, Plaintiffs’ inability to plausibly allege consumer confusion also defeats their ancillary state-law claims. 763 F.3d at 706. *See* Section III(E).

degree of protection to which they are entitled under the First Amendment.”) (collecting Supreme Court cases).

**2. Under the *Rogers* Test, the First Amendment Bars Plaintiffs’ Lanham Act and Related Claims.**

Over the past twenty-eight years, every federal circuit that specifically has addressed the issue – including the Sixth Circuit – has adopted the test from *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989), to decide whether the First Amendment defeats Lanham Act claims that target the use of marks in expressive works. In *Rogers*, iconic entertainer Ginger Rogers alleged that the use of her name in the title of the film *Ginger and Fred* violated the Lanham Act. Despite the title, the film was not about Rogers and Fred Astaire, but about two fictional Italian singers who had once imitated the famous pair. *Id.* at 996-997. The court warned that “overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values,” and held that Rogers’ Lanham Act claim must be dismissed unless the use of the mark “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.* at 998-999. The two-pronged *Rogers* test has become the constitutional threshold for Lanham Act claims arising from the unauthorized use of marks within expressive works. The Sixth Circuit adopted the test in *ETW*, explaining that “the principles identified in [*Rogers*] are generally applicable to all cases involving literary or artistic works where the defendant has articulated a colorable claim that the use of a [mark] is protected by the First Amendment.” 332 F.3d at 928 n.11.<sup>4</sup>

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<sup>4</sup> See also *Cliffs Notes v. Bantam Doubleday Dell Publ’g*, 886 F.2d 490, 495 (2d Cir. 1989) (applying *Rogers* to unauthorized use of mark on book cover); *Mattel v MCA Records*, 296 F.3d 894, 902 (9th Cir. 2002) (in song title) (“*MCA Records*”); *Mattel v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (in photographs) (“*Walking Mountain*”); *E.S.S. Entertainment 2000 v. Rock Star Videos*, 547 F.3d 1095, 1098-1101 (9th Cir. 2008) (in video game); *Univ. of Alabama Board of Trustees v. New Life Art*, 683 F.3d 1266, 1279 (11th Cir. 2012) (in works of

Courts routinely use the *Rogers* test to dismiss Lanham Act claims that are precisely analogous to Plaintiffs' claims based on alleged trademark use in films. In *Moore v. The Weinstein Company*, 2012 U.S. Dist. Lexis 72929, \*107 (M.D. Tenn. 2012), *aff'd* 545 Fed. Appx. 405, 407-408 (6th Cir. 2013), soul singer Sam Moore alleged that the movie *Soul Men* was based on his musical career as part of the duo Sam & Dave and violated his rights in unregistered trademarks, including "The Legendary Soul Man." 2012 U.S. Dist. Lexis 72929 at \*4-5. A federal district court in Tennessee applied the *Rogers* test and determined that Moore failed both prongs: the title was "of artistic relevance to the Movie ... which is about two male soul singers[,]" and neither the title nor any other materials "related to the movie *Soul Men* contained explicitly misleading statements about the content and source of the Movie." *Id.* at \*105. The court explained that the existence of "broad stock similarities between the *Soul Men* lead characters' musical styles and fashion styles to those utilized, at times, by Sam & Dave and/or Sam Moore ... does not even approach establishing that the Movie and the Soundtrack are *explicitly misleading* as to their content." *Id.* at \*106-107.<sup>5</sup>

The district court in *Fortres Grand* also applied *Rogers* to dismiss Lanham Act and state-law claims based on Warner Bros.' alleged use of the plaintiff's CLEAN SLATE mark in *The Dark Knight Rises* and online promotions for the film. 947 F. Supp. 2d at 929. The district court held that "there can be little doubt that Warner Bros. has satisfied both prongs of the *Rogers* test"

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visual art); *Brown v. Electronic Arts*, 724 F.3d 1235, 1248 (9th Cir. 2013) (in video game); *Fortres Grand*, 947 F. Supp. 2d 922, 931-932 (N.D. Ind. 2013) (in motion picture), affirmed on other grounds, 763 F.3d 696, 703 (7th Cir. 2014); *Louis Vuitton Mallatier S.A. v. Warner Bros. Entm't*, 868 F. Supp. 2d 172, 184 (S.D.N.Y. 2012) (in motion picture); *Dillinger, LLC v. Electronic Arts*, 2011 U.S. Dist. Lexis 64006, \*23 (S.D. Ind. June 16, 2011) (in video game); *Stewart Surfboards v. Disney Book Group*, 2011 U.S. Dist. Lexis 155444, at \*28 (C.D. Cal. May 11, 2011) (on book cover).

<sup>5</sup> MGM was one of the prevailing defendants in *Moore*.

because (1) the film’s use of the term was relevant to Batman’s promise in the film to create software that would erase criminal backgrounds, and (2) there was no “affirmative statement of the plaintiff’s sponsorship or endorsement” of the film. *Id.* at 931-932.

Similarly, in *Louis Vuitton*, the district court dismissed the luxury-goods manufacturer’s Lanham Act claims based on the use of knock-off Louis Vuitton luggage and a verbal reference to the brand in the film *The Hangover Part II*. 868 F. Supp. 2d at 174-175. In granting Warner Bros.’s motion to dismiss the complaint with prejudice, the court applied *Rogers* to hold that the use in the film met the “purposely low” threshold for relevance, in that the marks were used to comedic effect by making a character look “socially inept and comically misinformed” because he owned Louis Vuitton luggage but could not correctly pronounce the name of the brand. *Id.* at 178. Nor was it explicitly misleading as to the source of the film; indeed, the court stated in a footnote that the plaintiff failed to provide any legal authority for the proposition that “a reference to a trademark made by ‘a fictional character in a creative work constitutes a legal representation of origin by the creators of the work.’” *Id.* at 182 n. 15, 183.

As these and other cases demonstrate, district courts should not hesitate to apply *Rogers* to grant a motion to dismiss. The court readily did so in *Rebellion Developments v. Stardock Entertainment*, 2013 U.S. Dist. Lexis 66131, at \*15 (E.D. Mich. May 9, 2013), striking a video game developer’s Lanham Act and state-law claims arising from the title of the defendants’ computer game. “[V]indicating First Amendment protections through early dispositive motions ... avoid[s] chilling speech,” the court explained, and it found “no persuasive basis to deny application” of the *Rogers* test “at this motion to dismiss stage of litigation.” *Id.* at 9-10, 12. In *Brown*, where a legendary football player sued over the use of his likeness in a video game about football, the Ninth Circuit applied the *Rogers* test and affirmed the district court’s dismissal with

prejudice of the plaintiff's Lanham Act claim, specifically rejecting the plaintiff's strenuous argument that applying the *Rogers* test at the pleading stage entailed improper factfinding. 724 F.3d at 1247-1248. *See also Louis Vuitton*, 868 F. Supp. 2d at 184 (“[i]n a case such as this one, *no amount of discovery will tilt the scales in favor of the mark holder at the expense of the public's right to free expression*”) (emphasis added); *Fortres Grand*, 947 F. Supp. 2d at 934 (applying *Rogers* and dismissing complaint). Because the defects in these claims typically are incurable, courts regularly dismiss them without leave to amend. *See, e.g., Brown*, 2009 U.S. Dist. Lexis 131387, at \*15 (C.D. Cal. Sept. 23, 2009), *aff'd* 724 F.3d at 1248; *Louis Vuitton*, 868 F. Supp. 2d at 174; *Stewart Surfboards*, 2011 U.S. Dist. Lexis 155444, at \*30.

The *Rogers* test applies to all types of uses of trademarks in the expressive context, regardless of whether the mark is widely known or obscure. *See, e.g., Louis Vuitton*, 868 F. Supp. 2d at 174; *E.S.S.*, 547 F.3d at 1100. Moreover, *Rogers* will operate to preclude a trademark claim even if the creator of the work did not mean to refer to the plaintiff's mark at all. *See, e.g., Rebellion Developments*, 2013 U.S. Dist. Lexis 66131, at \*12. Here, both prongs of the *Rogers* test are satisfied, thus shielding Defendants from claims based on the use of Plaintiffs' mark in *Spaceman*.

**a. The Film's Use of *The Sporting Times* Exceeds *Rogers*' Low Relevance Threshold.**

To satisfy the first prong of the *Rogers* test, “the level of artistic relevance of the trademark or other identifying material to the work *merely must be above zero*,” a “black-and-white rule” that has the “benefit of limiting [judges'] need to engage in artistic analysis in this context.” *Brown*, 724 F.3d at 1243 (emphasis added). Indeed, the relevance threshold “is purposely low and will be satisfied unless the use has *no artistic relevance to the underlying work whatsoever*.” *Louis Vuitton*, 868 F. Supp. 2d at 178 (emphasis added) (citations and

internal quotes omitted).

In *ETW*, for example, the Sixth Circuit easily found that Tiger Woods' image was relevant to the defendant's depiction of him on the golf course in a painting commemorating his victories at the Masters. 332 F.3d at 937. In *Brown*, the Ninth Circuit just as readily concluded that football star Jim Brown's likeness was sufficiently relevant to a video game that aimed to recreate historic NFL teams, including Brown's championship 1965 Cleveland Browns. 724 F.3d at 1243. But the expressive work need not be *about* the plaintiff's mark to satisfy this prong, as the Ninth Circuit explained in *E.S.S. Entertainment*, 547 F.3d at 1100, in which it held that an incidental rendering of the plaintiff's Los Angeles strip club was sufficiently relevant to *Grand Theft Auto: San Andreas*'s fictionalized version of the entire city. Likewise, when the defendant in *Rebellion Developments* named its computer game *Sins of a Solar Empire: Rebellion*, or *Rebellion* for short, it apparently had no intention of referring to the plaintiff's video-game company, Rebellion Developments. 2013 U.S. Dist. Lexis 66131 at \*9. Noting that *Rogers* does not include any "referential requirement," the court determined that the word "Rebellion" bore the requisite minimal relevance to a game in which "players may choose to align with 'loyalist' or 'rebel' factions in the context of a civil war." *Id.* at \*9, 12.

*Rogers* protects even a use with nominal relevance – "regardless of how necessary, important, or meaningful the use of the mark is to the underlying work" – for an important reason:

An artistic use of a trademark that is only minimally relevant to the underlying work is nonetheless an expressive use. Requiring that use to have more than minimal relevance to the underlying work to pass the "artistic relevance" prong of the *Rogers* test would subject some expressive speech to the traditional likelihood-of-confusion test that does not adequately account for First Amendment interests ... Moreover, courts are ill-equipped to make the artistic judgments as to precisely how important the use of a mark is to the message



conveyed.

*Stewart Surfboards*, 2011 U.S. Dist. Lexis 155444 at \*18-19. Even where only a “superficial and attenuated” connection exists between the plaintiff’s name and the defendant’s work, the court’s role is not to “determine how meaningful the relationship between a trademark and the content of a literary work must be; consistent with *Rogers*, any connection whatsoever is enough[.]”

*Dillinger*, 2011 U.S. Dist. Lexis 64006 at \*14-15.<sup>6</sup>

The brief use of *The Sporting Times* as the name of a fictitious sports-themed publication in the film unquestionably exceeds the above-zero artistic relevance threshold. The film is based on the life of a quirky baseball star who fell out of the limelight after drawing media scrutiny for much of the 1970s. To inform viewers about the arc of Lee’s career, the film includes a montage of news articles and radio soundbites describing his achievements and his antics. The original version of the film included a fictional magazine entitled *The Sporting Times* in that sequence, with a photo of the actor playing Lee on the cover and a fictional headline. The title *Sporting Times* plainly has relevance to the film’s subject matter: a star athlete who received considerable media attention during his career. That artistic relevance explains why the film used an image of the actor as Lee on the cover of *The Sporting Times* in the montage, and not on the cover of *Popular Mechanics* or *Architectural Digest*. Thus, the use easily satisfies the first prong of the *Rogers* test.

**b. The Film Does Not Explicitly Mislead the Public as to Its**

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<sup>6</sup> The Sixth Circuit also applied the *Rogers* test to the use of civil rights icon Rosa Parks’ name in the title of a hip hop song. *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003). Relying heavily on a statement by one of the song writers that Parks’ name had nothing to do with the content of the song, the court held that a genuine issue of material fact existed as to whether the use of her name as a title and on the album cover was artistically relevant to it. *Id.* at 452-453, 458. That case is readily distinguishable from this one, where the *Sporting Times* mark obviously is relevant to a film about a Major League Baseball player.

### Source or Content.

The second prong of the *Rogers* test asks courts to determine whether the use of the mark “explicitly mislead[s] as to the source” or the content of the work. *ETW*, 332 F.3d at 937. “To be ‘explicitly misleading,’ the defendant’s work must make some affirmative statement of the plaintiff’s sponsorship or endorsement, beyond the mere use of plaintiff’s name or other characteristic.” *Dillinger*, 2011 U.S. Dist. Lexis 64006 at \*18. As the Ninth Circuit has explained, this prong “points directly at the purpose of trademark law, namely to avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner.” *E.S.S.*, 547 F.3d at 1100 (internal quotation marks and citation omitted). By narrowly framing the inquiry as a search for an “explicit indication,” “overt claim,” or “explicit misstatement” that could cause such consumer confusion, *Rogers* ensures that courts do not unduly intrude on creative expression. *Rogers*, 875 F.2d at 1001.

Courts conclude that the second prong has been satisfied where there is no explicit indication that the plaintiff endorsed or sponsored the defendant’s work. *See, e.g., Univ. of Alabama*, 783 F.3d at 1279 (defendant’s football-themed paintings bore no statement that they were “endorsed” or “sponsored” by the University); *The Romantics v. Activision Publishing*, 574 F. Supp. 2d 758, 769 (E.D. Mich. 2008) (“[n]either the [defendant’s video game] nor any of its promotional materials contains [any] explicit indication that [Plaintiffs] endorsed the [Game] or had a role in producing it”); *Stewart Surfboards*, 2011 U.S. Dist. Lexis 155444 at \*26 (defendant’s book cover did not say “anything like ‘Brought To You By Stewart Surfboards’ or ‘Presented By Stewart Surfboards’[.] ... To the contrary, the book jacket and spine include the Disney logo, the ‘Disney Press’ logo, and the Disney channel logo.”).

Importantly, *Rogers* equally applies where a plaintiff's mark appears in promotional materials for an expressive work, such as a movie trailer or advertisement; absent an explicitly misleading statement of sponsorship or endorsement in such materials, the First Amendment protects the use. In *Mil-Spec Monkey v. Activision Blizzard*, 74 F. Supp. 3d 1134, 1143 (N.D. Cal. 2014), for example, the plaintiff argued that it ought to prevail on *Rogers*' second prong because its trademarked "'angry monkey' design briefly appears in the pre-release trailer for" the video game *Call of Duty*. The court rejected that argument, finding that the use of the mark in the trailer did nothing to "diminish its artistic relevance within the game"; the video-game company had not "affirmatively purported in any way to share a relationship with" the plaintiff, either in the trailer or the game itself, and instead was "very clear as to its origin and source, prominently bearing the title Call of Duty, identifying its creator as Activision, and boasting to be 'the best selling first person action franchise of all time.'" *Id.* at 1143, 1144. Similarly, in *Fortres Grand*, the district court held that the First Amendment protected the use of the plaintiff's CLEAN SLATE mark, even in what were alleged to be websites designed to promote the film. 947 F. Supp. 2d at 933-934. *See also Dillinger*, 2011 U.S. Dist. Lexis 64006 at \*8, 19 (same; plaintiff's mark used in press releases for video game); *Wham-O v. Paramount Pictures*, 286 F. Supp. 2d 1254, 1258, 1264-1265 (N.D. Cal. 2003) (protecting use of plaintiff's mark in film trailers on other grounds; denying motion for temporary restraining order).

The fleeting use of *The Sporting Times* in the film and the trailer does not in any way constitute an "explicit," "affirmative statement" that Plaintiff, whose publication focuses on local youth sports, sponsors or endorses Defendants' nationally released, feature-length film. As in *Stewart Surfboards*, there are no statements in the trailer or the film itself like "Brought To You By *The Sporting Times*," or "Presented By *The Sporting Times*."

Because both prongs of the *Rogers* test are satisfied here, the First Amendment defeats Plaintiffs' Lanham Act and related state-law claims. Defendants' motion should be granted for this independent reason.

**D. Because the Film Is an Expressive Work, Not Commercial Speech, Defendants' Use of the Mark Does Not Give Rise to a Dilution Claim.**

The federal anti-dilution statute explicitly exempts noncommercial speech from its reach. 15 U.S.C. § 1125(c)(3)(C); *Smith v. Wal-Mart Stores*, 537 F. Supp. 2d 1302, 1339 (N.D. Ga. 2008) (“[a] claim of dilution applies only to purely commercial speech”). As one court addressing the collision of First Amendment rights and trademark interests warned: “[i]f the anti-dilution statute were construed as permitting a trademark owner to enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct.” *L.L. Bean, Inc. v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987). “The Constitution does not, however, permit the range of the anti-dilution statute to encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial or artistic context.” *Id.*

Analyzing the anti-dilution statute in *MCA Records*, the court found that the song “Barbie Girl” was noncommercial speech, and, accordingly, was exempt from liability for dilution under the statute. 296 F.3d at 905-907. The song was noncommercial even though it clearly “used Barbie’s name to sell copies of the song,” because the court held that the statute only implicates “purely commercial” speech, which does no more than propose a commercial transaction. *Id.* at 906-907.<sup>7</sup>

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<sup>7</sup> *MCA Records* has been cited with approval by the Sixth Circuit and by district courts in the Sixth Circuit. Despite this, one district court has stated that because the Sixth Circuit summarily

Following *MCA Records*, the district court in *Stewart Surfboards* ruled that the use of the plaintiff's mark on the cover of a book was not purely commercial speech because it had "some artistic relevance." 2011 U.S. Dist. Lexis at \*29. This was true even though the use was on the back cover, not on the inside of the book. *Id.* at \*11. See also *Smith*, 537 F. Supp. 2d at 1339 (holding that merchandise, such as t-shirts, which contained parodies of the plaintiff's marks, was not purely commercial speech even though the defendant may have had a commercial motive when selling them); *Universal Commun. Sys. v. Lycos, Inc.*, 478 F.3d 413, 422-425 (1st Cir. 2007) (holding that the First Amendment forbids enforcement of state anti-dilution statute to block Internet service provider from naming Internet message boards after the plaintiff's company even though the defendant Internet service provider made money on the web pages, because they were a non-commercial use); *Burnett*, 491 F. Supp. 2d at 973-974 (holding that 18-second appearance of Carol Burnett's trademark Charwoman in the television program *Family Guy* was noncommercial and therefore did not constitute dilution).

Here, the use of *The Sporting Times* in the film was unquestionably noncommercial. *Spaceman* is clearly an expressive work, regardless of whether the film's producers had a profit motive. See cases cited at Section III(C)(1). The trailer, which itself is an expressive work (see *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001)), also is noncommercial to the extent that it is promoting a constitutionally protected expressive work. See, e.g., *Groden v.*

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found that fair use barred the plaintiff's dilution claim in *ETW*, 332 F.3d at 923, "the Sixth Circuit had an opportunity to limit dilution claims to pure commercial speech, and they did not do so. Therefore, the lone ground asserted by the defendants to dismiss this claim is not viable, and the claim will not be dismissed." *Moore v. Weinstein Co. LLC*, 2010 U.S. Dist. Lexis 112587, at \*35 (M.D. Tenn. May 12, 2010). The fact that the Sixth Circuit chose one ground upon which to dismiss the plaintiff's dilution claim does not mean that alternative grounds to do so were not viable; rather, the *ETW* court simply did not see a need to engage in unnecessary analysis after it disposed of the dilution claim.

*Random House*, 61 F.3d 1045, 1049 (2d Cir.1995) (collecting cases). Accordingly, because the film and its trailer are not purely commercial, they are exempt from liability for trademark dilution.<sup>8</sup>

**E. Plaintiffs’ Purported Claim for “Commercial Disparagement” also Fails.**

It is unclear what cause of action Plaintiffs assert by their claim for “commercial disparagement” under the “Lanham Act” and “state law.” Compl. ¶ 39. If this claim is yet another species of trademark infringement, it is barred by the First Amendment defense under *Rogers* and its progeny and by the other defenses discussed in Sections III(B)-(D). If Plaintiffs are attempting to allege some type of a defamation or trade libel claim, such a claim of commercial disparagement is not recognized under Kentucky law. *Fieldturf, Inc. v. Southwest Rec. Indus.*, 235 F. Supp. 2d 708, 734 n. 26 (E.D. Ky. 2002) vacated in part, remanded in part, on jurisdictional grounds, 357 F.3d 1266 (Fed. Cir. 2004) (“Commonwealth common law does not recognize a separate cause of action for ‘commercial disparagement’”).

**F. The Same Defenses that Defeat Plaintiffs’ Lanham Act Claims also Bar Their State-Law Causes of Action.**

When a court dismisses Lanham Act claims arising from the use of a mark in an expressive work, it also should dismiss simultaneous state-law false advertising and unfair-

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<sup>8</sup> The Lanham Act provides an additional defense to an infringement or dilution claim where the use of the mark “is a use, otherwise than as a mark ... which is descriptive of and used fairly and in good faith only to describe the goods ... of such party[.]” 15 U.S.C. § 1115(b)(4). In *ETW*, the Sixth Circuit held that the use of the “Tiger Woods” mark in connection with a print was a fair use because the use had artistic relevance, there was nothing to indicate the mark was used in bad faith, and the source of the print was clearly identified as someone other than Woods. 332 F.3d at 921. Similarly, in *Oaklawn*, the Court found that even if there was a plausible case made for likelihood of confusion, the use of plaintiff’s mark as a mere descriptive identifier was a fair use. 184 F. Supp. 3d at 577-580. Here, there is no allegation that Defendants used *The Sporting Times* as a mark. Nor is there any allegation that the use was animated by bad faith. Rather, Defendants used the phrase to describe the name of a publication within the Film. Compl. ¶¶ 21-23; Beres Decl., Exs. A, C. This is a fair use, and thus is not actionable.

competition claims. *See, e.g., Louis Vuitton*, 868 F. Supp. 2d at 184 (ruling that “Louis Vuitton’s pendant state law claim under New York’s anti-dilution statute and its common law claim of unfair competition are likewise dismissed because they are based on the same permissible conduct as its Lanham Act claim”). As one court after another has held, “the same First Amendment considerations that limit a cause of action under the Lanham Act apply also to a cause of action under [state] law.” *Yankee Publ’g v. News America Publ’g*, 809 F. Supp. 267, 282 (S.D.N.Y. 1992). Where “the First Amendment applies to protect titles and works from federal claims of confusion and dilution, it also extends to state-based claims of infringement, dilution, and unfair competition.” *Rin Tin Tin, Inc. v. First Look Studios*, 671 F. Supp. 2d 893, 902 (S.D. Tex. 2009) (ruling that a federal fair-use defense to trademark infringement also barred similar state-law claims). *See also E.S.S.*, 547 F.3d at 1101 (“[s]ince the First Amendment defense applies equally to [plaintiff’s] state law claims as to its Lanham Act claim, the district court properly dismissed the entire case”).

Similarly, failure to plausibly allege confusion also bars simultaneous state-law claims. *See, e.g. Fortres Grand*, 763 F.3d at 706; *Perfetti Van Melle v. Cadbury Adams USA*, 732 F. Supp. 2d 712, 718 (E.D. Ky. 2010) (noting that the Lanham Act and Kentucky unfair competition laws apply the same likelihood-of-confusion test); *Thoroughbred Legends v. Walt Disney Co.*, 2008 U.S. Dist. Lexis 19960, at \*30 (N.D. Ga. Feb. 12, 2008) (state-law claim dismissed on same grounds as Lanham Act claims).

Accordingly, the same defenses that defeat Plaintiffs’ Lanham Act claims also require dismissal of their state-law claims.

#### **IV. CONCLUSION**

Plaintiffs may be unhappy that their mark appeared for nine seconds in the film. But

neither the Lanham Act nor state consumer-protection statutes provide Plaintiffs any viable cause of action against Defendants. And even if they did, the First Amendment would bar any such claim. Any other result would impermissibly allow trademark owners to interfere with the creation of motion pictures, television shows, books, and other expressive works.

For these reasons, and relying on the well-settled case law discussed in this memorandum, Defendants respectfully request that the Court grant this motion and dismiss Plaintiffs' claims in their entirety, with prejudice.

DATED this 1st day of May 2017.

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing electronically filed document has been served via a “Notice of Electronic Filing” through the Court’s CM/ECF System to all parties of record on May 1, 2017.

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