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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA, SANTA ANA DIVISION

JAZAN WILD, an individual, dba CARNIVAL COMICS,

Plaintiff,

vs.

HARPERCOLLINS PUBLISHERS, LLC and MELISSA MARR,

Defendants.

Case No. 8:12-cv-01191-JST-ANx

Assigned to: Hon. Josephine Staton-Tucker

DEFENDANTS HARPERCOLLINS PUBLISHERS, LLC AND MELISSA MARR'S NOTICE OF MOTION AND MOTION TO DISMISS FIRST AMENDED COMPLAINT; MEMORANDUM OF POINTS AND AUTHORITIES

[Filed concurrently with Defendants' Request for Judicial Notice In Support of Motion to Dismiss; Proposed Order on Motion to Dismiss; Notice of Manual Filing; and Notice of Lodging]

Date: November 16, 2012
Time: 2:30 p.m.
Place: Courtroom 10A

TO ALL PARTIES AND THEIR COUNSEL OF RECORD:

PLEASE TAKE NOTICE that on November 16, 2012, at 2:30 p.m. in Courtroom 10A of the above-entitled Court, located at 411 West Fourth Street, Santa Ana, California 92701, defendants HarperCollins Publishers, LLC ("HarperCollins") and Melissa Marr ("Marr," collectively with HarperCollins, "Defendants") will and hereby do move to dismiss each of the claims in the First Amended Complaint in this action pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, on the basis that the plaintiff's trademark is invalid and Defendants' uses are protected by the First Amendment, barring each of plaintiff's claims, and therefore the First Amended Complaint fails to state a claim upon which relief can granted.

This motion is based on this Notice of Motion and Motion, the Memorandum of Points and Authorities attached hereto, the Request for Judicial Notice submitted concurrently herewith, all pleadings and records on file in this case, and upon such evidence and argument as may be presented at or before the hearing on this Motion.

This motion was made following a conference of counsel pursuant to Local Rule 7-3, which was commenced by letter dated August 3, 2012.

Dated: September 11, 2012

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By: /s/ Rollin A. Ransom

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MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Plaintiff Jazan Wild ("Plaintiff" or "Wild") claims to possess the exclusive right to use the phrase "Carnival of Souls" in connection with comic books, graphic novels, and novels. On the basis of that claimed right, Wild has filed a First Amended Complaint ("FAC") challenging HarperCollins' release of a novel by author Melissa Marr entitled "Carnival of Souls." The FAC suffers from two fatal defects.

First, Wild does not possess a valid trademark – he has used the phrase "Carnival of Souls" as the title of a single work (offered in various formats), and the title of a single work cannot function as a trademark as a matter of law. *See* TMEP § 1202.08. His claims fail for this reason alone.

Second, HarperCollins' use of the phrase "Carnival of Souls" as *its* book title is protected by the First Amendment of the United States Constitution. In light of the public interest in free expression that underlies the First Amendment, courts have long recognized that a literary title is insulated against Lanham Act claims "'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 content of the work.'" *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)). This standard for First Amendment protection is readily satisfied here: Wild effectively concedes that the title of HarperCollins' work ("Carnival of Souls") has artistic relevance to that work (which Wild alleges involves a "includes a supernatural carnival [and] supernatural beings such as witches," FAC ¶ 132), and there is no allegation (nor could there be) that the title misleads – explicitly or otherwise – as to the source of the work.

Because his trademark is invalid and the challenged title is fully protected by the First Amendment, each of Wild's claims fails as a matter of law. Defendants therefore request that the FAC be dismissed with prejudice.

II. LEGAL STANDARD

"To survive a motion to dismiss, a complaint must contain 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 Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). Threadbare recitals of the elements of a cause of action supported by mere conclusory statements are insufficient. *Id.* Additionally, a complaint must allege a plausible claim for relief. *Id*. at 679. Where the complaint fails to plead facts which make Defendants' liability sufficiently plausible, it must be dismissed. *Twombly*, 550 U.S. at 570. And although material facts alleged in the complaint must be construed in the plaintiff's favor, *Coalition for ICANN Transparency, Inc. v. VeriSign, Inc.*, 611 F.3d 495, 501 (9th Cir. 2010), the court is not required to accept as true allegations that are contradicted by documents incorporated into the complaint or by facts that are properly subject to judicial notice, *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001).

Here, the FAC incorporates and necessarily relies on the contents of the literary works of both Plaintiff and Defendants because: "(1) the complaint refers to the [works]; (2) the [works are] central to the Plaintiffs' claim; and (3) no party questions the authenticity of the [works]." *Marder v. Lopez*, 450 F.3d 445, 448 (9th Cir. 2006). The works that Wild places at issue are the following: the novel by Jazan Wild entitled "Carnival of Souls (The Novel)," attached to the Request for Judicial Notice ("RJN") as Exhibit A (hereinafter "Wild's Novel"), the graphic novel by Jazan Wild entitled "Carnival of Souls," attached to the RJN as Exhibit B (hereinafter, the "Wild's Graphic Novel"); "Jazan Wild's Carnival of Souls – Welcome to the Show," attached to the RJN as Exhibit C (hereinafter "Chapter 1"); "Jazan Wild's Carnival of Souls – Everyone Loves a Clown," attached to the RJN as Exhibit D (hereinafter "Chapter 2"); "Jazan Wild's Carnival of Souls – All Hell's Breaking Loose," attached to the RJN as Exhibit E (hereinafter "Chapter 3"); and the novel "Carnival of Souls" by Melissa Marr (hereinafter "Marr's Novel"), referenced in the RJN as Exhibit V and

lodged with the Court. Thus, this Court may properly consider the contents of Wild's Novel, Wild's Graphic Novel, Chapters 1, 2, and 3, and Marr's Novel in ruling on this motion to dismiss. *Knievel v. ESPN*, 393 F.3d 1068, 1076 (9th Cir. 2005) (recognizing the expansion of the "incorporation by reference" doctrine to "situations in which the plaintiff's claim depends on the contents of a document, the defendant attaches the document to its motion to dismiss, and the parties do not dispute the authenticity of the document, even though the plaintiff does not explicitly allege the contents of that document in the complaint").

In fact, another judge in this District has previously taken judicial notice of Wild's Graphic Novel and Chapters 1, 2, and 3. *See Wild v. NBC Universal, Inc.,* 788 F. Supp. 2d 1083, 1091 n.1 (C.D. Cal. 2011). In that action, the court relied upon the contents of Wild's Graphic Novel to dismiss Wild's claims against another defendant with prejudice. *See id.* at 1099-1100 (finding that Wild's claims in his complaint were "not supported by the content of *Carnival of Souls*"); *id.* at 1102 (finding Wild's complaint "seriously mischaracterizes" the contents of the works at issue); *id.* at 1103 (finding Wild's allegations in the complaint to be "not entirely accurate" and obfuscating); *id*. at 1105 (finding Wild's allegedly supporting exhibits "misleading").

III. FACTUAL BACKGROUND[1]

Just as in his original complaint, all of Wild's claims in the FAC arise principally from his alleged trademark in the phrase "Carnival of Souls": Claims One through Three, Five, and Six allege trademark infringement, unfair competition, false description, trademark dilution, and reverse confusion under the Lanham Act based on his claim of trademark ownership, *see* FAC ¶¶ 178-84, 187-191, and Claims Four and Seven allege common law injury to business reputation and common law trademark

[1] Defendants dispute the allegations of the FAC. However, in considering a Rule 12(b)(6) motion, the Court generally must accept as true all non-conclusory, factual allegations made in the complaint. *See Leatherman v. Tarrant Cnty. Narcotics Intelligence & Coordination Unit*, 507 U.S. 163, 164 (1993). Accordingly, Defendants provide the following summary of Plaintiff's allegations solely for purposes of this motion, and without conceding their accuracy.

infringement based on that same claim of trademark ownership, *see* FAC ¶¶ 185-186, 192-95. The trademark registration upon which Wild bases his claims is in International Class 16 for "Comic books; Graphic novels; Novels," and in International Class 41 for the "Multimedia publishing" of those publications. FAC ¶ 10; *id.* Ex. 1.[2]

Although Wild claims that he "has published and sold a series of comic books, graphic novels, novels and multimedia publications under the trademark CARNIVAL OF SOULS," FAC ¶ 10, the FAC and attached exhibits support the existence of only the following works: (1) a single novel published under the title "Carnival of Souls (The Novel)," *see* FAC Ex. 37; (2) a single graphic novel published under the title "Carnival of Souls," *see* FAC Ex. 8 (referring to single "graphic novel"); *id.* Ex. 30 (same); and (3) three "comic books" that are simply serially-issued chapters of, and entirely subsumed in, Wild's Graphic Novel. Chapter 1 ("Welcome to the Show") can be found on pages 26 to 58 and 201 of Wild's Graphic Novel (RJN Exs. C, at 607-641 and B, at 431-63, 606); Chapter 2 ("Everyone Loves a Clown") can be found on pages 71 to 103 and 201 of Wild's Graphic Novel (RJN Exs. D, at 642-676 and B, at 467-508, 606); and Chapter 3 ("All Hell's Breaking Loose") can be found on pages 138 to 165 and 201 of Wild's Graphic Novel (RJN Exs. E, at 677-706 and B, at 543-570, 606). *See* FAC ¶ 23.

Wild alleges that HarperCollins' publication of Marr's novel "Carnival of Souls" – a book about "a supernatural carnival [and] supernatural beings such as witches" and a "fictitious place where supernatural beings hold a competition comprising fights among themselves to the death that is referred to as 'The Carnival of Souls'" – infringes his claimed trademark in the phrase "Carnival of Souls." FAC ¶¶ 110-11, 178-95.

[2] Plaintiff also claims "common law trademarks" in the phrases "Enter the Carnival" and "Enter the Carnival of Souls." FAC ¶¶ 13, 15. These alleged "common law trademarks" are also the subject of Claims Two through Four and Five through Seven.

IV. ARGUMENT

A. Wild's Claims Fail Because He Possesses No Trademark Rights.

Because Wild has used the title "Carnival of Souls" in connection with only single literary works, Wild cannot claim any trademark rights in that phrase. The function of a trademark is to identify the source of the product to which it is attached. *See New Kids on the Block v. News Amer. Publ'g, Inc.*, 971 F.2d 302, 305 (9th Cir. 1992). The title of a single book does not and cannot serve this function: such a title identifies the book, rather than its source. For this reason, courts have long recognized that the title of a single work does not and cannot function as a trademark as a matter of law. *See, e.g., Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002) (noting that "the title of a single book cannot serve as a source identifier"); *In re Cooper*, 254 F.2d 611, 615 (C.C.P.A. 1958) ("A book title . . . identifies a specific literary work . . . and is not associated in the public mind with the publisher, printer or bookseller . . . ."). As a result, the Trademark Manual of Examining Procedure ("TMEP") provides that "[t]he title of a single creative work is not registrable on either the Principal or Supplemental Register." TMEP § 1202.08 (available at http://tess2.uspto.gov/tmdb/tmep/1200.htm#_T120208).[3]

Wild contends that he falls within an exception to this general rule, in that he claims to have used the phrase "Carnival of Souls" in connection with a *series* of literary works. *See, e.g.*, TMEP § 1202.08(c) ("The name of a series of books or other creative works may be registrable if it serves to identify and distinguish the source of the goods."); *see also In re Scholastic*, 23 U.S.P.Q.2d 1774, 1777-78 (T.T.A.B. 1992) ("Where the designation THE MAGIC SCHOOL BUS has been used in each title of

[3] The court in *Herbko* suggested that, although titles of single works are not registrable, they may nonetheless be protected under section 43(a) of the Lanham Act if the plaintiff can prove secondary meaning. *See, e.g.*, *Herbko Int'l*, 308 F.3d at 1162 n.2 (citing cases). However, this proposition does not appear to have been adopted by the Ninth Circuit, and it is in all events inconsistent with the holding that the title of a single work "*cannot* serve as a source identifier," *id.* at 1162 – which is the function that a valid trademark (registered or unregistered) *must* serve, *see New Kids*, 971 F.2d at 305. Defendants therefore seek dismissal of all of Wild's claims on this basis.

each book of the series and also has come to represent a source to purchasers, the designation may be registered as a trademark since it functions as one."). However, the evidence establishes that Wild has not, in fact, used "Carnival of Souls" in a series of books; instead, he has used that phrase in connection with single literary works that have simply been issued in multiple formats.

Wild's trademark registration lists three categories of products in International Class 16: "comic books; graphic novels; novels." Taken in reverse order, Wild has submitted evidence of only one "novel" bearing the name "Carnival of Souls," namely, "Carnival of Souls (The Novel)." *See* FAC Ex. 37. This novel was apparently first published less than two months ago. *See* FAC Ex. 37 (identifying publication date of "July 4, 2012"). The "earlier issue" of "Carnival of Souls" described in FAC ¶ 12 is, in fact, this exact same novel. *Compare* Ex. 2 (referred to in FAC ¶ 12) *with* RJN, Ex. A, at 12, 13, 404, 15, 301, 302. The FAC does not identify any other novel by Wild featuring this title. In other words, this is indisputably a single work, not a "series" of novels. Wild's trademark registration is therefore invalid as to this category of goods, and he possesses no trademark rights in "Carnival of Souls" with respect to "novels."[4]

Similarly, Wild has identified only one "graphic novel" featuring the title "Carnival of Souls," which is attached as Exhibit B to the RJN. *See* FAC Ex. 30 (referring to single "graphic novel"); *id.* Ex. 8 (same). Like Wild's claim of use of "Carnival of Souls" with a "series" of novels, his claim that he has used "Carnival of Souls" with a "series" of graphic novels is entirely baseless, and refuted by the materials attached to and incorporated by reference into his complaint. *Id.*

Finally, Wild claims that he has used the title "Carnival of Souls" on a series of comic books. FAC ¶ 13. This, too, is false. In fact, Wild's "comic books" are

[4] Although Wild obtained a trademark registration for "Carnival of Souls," such a registration is merely prima facie evidence of the validity of Wild's mark, 15 U.S.C. § 1115(a), and is subject to both challenge and cancellation on the basis of "any legal or equitable defense or defect," *id.*

nothing more than individual chapters of Wild's Graphic Novel that are entirely subsumed into Wild's Graphic Novel: Chapter 1 ("Welcome to the Show") can be found on pages 26 to 58 and 201 of Wild's Graphic Novel (RJN Exs. C, at 607-641 and B, at 431-63, 606); Chapter 2 ("Everyone Loves a Clown") can be found on pages 71 to 103 and 201 of Wild's Graphic Novel (RJN Exs. D, at 642-676 and B, at 467-508, 606); and Chapter 3 ("All Hell's Breaking Loose") can be found on pages 138 to 165 and 201 of Wild's Graphic Novel (RJN Exs. E, at 677-706 and B, at 543-570, 606). In fact, another judge in this District has already acknowledged that Chapters 1, 2 and 3 are merely subparts of Wild's Graphic Novel. *Wild v. NBC*, 788 F.Supp.2d at 1089, 1090 (describing *Carnival of Souls* as "a three-part 'graphic novel'" and "a graphic novel consisting of three comic books"). It is well-established that "[c]reative works that are serialized, i.e., the mark identifies the entire work but the work is issued in sections or chapters, are still considered single creative works." TMEP § 1202.08(a). And as stated above, the titles of such single creative works do *not* serve a source-identifying function as a matter of law.

Although some of Wild's exhibits suggest the existence of additional "comic books," such as FAC Exhibit 40L, the five items listed there (#1, 2A, 2B, 3A, 3B, and 3C) are simply the same three works with different cover art. The descriptions of the five items in Exhibit 40L show that 2A and 2B have the same description ("While Jazan struggles to accept his fate among the carnival of the damned...") and items 3A, 3B, and 3C have the same description ("Is the past really the past? Can we ever be whole…"). And all of the images found in 40L are also found in Wild's Graphic Novel. *Compare* FAC, Ex. 40L *to* RJN, Ex. B, at 432, 476-77, 543-44, 431. Similarly, although Paragraphs 24 and 25 of the FAC, referencing Exhibits 3 and 4, describe "7 different issues" of three "Carnival of Souls" titles, these "issues" are the same Chapters 1, 2, and 3 described above. FAC Ex. 3 (listing at the bottom of the page "Variants of this issue" to include 1, 1A, and 1B, and the title at the top of each page describing "Jazan Wilds Carnival of Souls #1B," "#1A" or "#1"). In addition,

all of the images shown in Exhibits 3 and 4 are represented in Wild's Graphic Novel. *Compare* FAC, Ex. 3 *to* RJN, Ex. B, at 408, 464, 432, 476-77, 543-44; *compare* FAC, Ex. 4 *to* RJN, Ex. B, at 432, 476-77, 543-44, 431. Thus, all the "comic books" referenced in the FAC are simply serialized portions of, and subsumed within, Wild's Graphic Novel.

Wild also claims to have used the title on eBooks, cell phone apps, and the like. *See, e.g.*, FAC, Ex.40; *id.* ¶ 4 (registration for "[m]ultimedia publishing"). However, these uses do not reflect new works or the rendering of services under Wild's claimed mark, but merely multimedia versions of the same works discussed above. For example, every image in FAC Exhibits 40A to 40G and 40I to 40K also appears in Wild's Graphic Novel.[5] The eBooks and Kindle books described in the FAC are republications of the work in Wild's Graphic Novel. *Compare* FAC ¶¶ 19 to 21 and 35 to 38, Exs. 14-17 *to* RJN Ex. B, at 606, 435; *compare* FAC ¶ 21, Ex. 20 *to* RJN Ex. B, at 434; *compare* FAC ¶ 23, Ex. 30 *to* RJN Ex. B, at 406, 408, 431, 476, 543, 606; *see* FAC, ¶ 45, Ex. 23 (describing the apps as a "re-release"). The alleged existence of these multimedia versions of printed works are of no aid to Wild: merely publishing a single work in multiple different formats does not establish a "series" for trademark purposes. TMEP § 1202.08(c) ("A series is not established when only the format of the work is changed, *i.e.*, the same title used on a printed version of a book and a recorded version does not establish a series."); *In Re Posthuma*, 45 U.S.P.Q.2d 2011 (T.T.A.B. 1998) (holding invalid a trademark claim on the title of a live theater production, notwithstanding the publication of related tickets, playbills, advertisements, and soundtracks, and the fact that over time, performances of the production will vary); *Mattel, Inc. v. The Brainy Baby Company, LLC*, 101

[5] FAC Exhibit 40A shows images subsumed in Wild's Graphic Novel (RJN, Ex. B, at 442-43), as do Exhibits 40B (*id.* at 443, 445), 40C (*id.* at 443, 606), 40D (*id.* at 463, 452, 443, 449, 437), 40E (*id.* at 606), 40F (*id.* at 406, 431), 40G (*id.* at 406), 40I (*id.* at 437, 443, 448, 455, 435), 40J (*id.* at 431), 40K (*id.* at 435, 463), and 40L (*id.* at 432, 476-77, 543-44, 431).

U.S.P.Q.2d 1140 (T.T.A.B. 2011) (holding "extras" added from the VHS to DVD version of a program insufficient to transform them from a single work into a series).

Because Wild has merely published a single novel and a single (albeit serialized) graphic novel, he has failed to use the phrase "Carnival of Souls" as a trademark. As a result, his claims fail as a matter of law. *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002) (trademark holder must prove that it owns a valid mark, and thus has a protectable interest, to prevail on claims of infringement).

Wild's claims with respect to his unregistered, "common law trademarks" – "Enter the Carnival" and "Enter the Carnival of Souls" – fare no better. In fact, the "evidence" respecting these phrases affirmatively demonstrates that Wild has not used them as trademarks. Instead, in each instance, the phrase appears in text buried in Wild's marketing material, including in a description of Chapter 2 of his "Carnival of Souls" graphic novel and in other incidental references on websites. *See* FAC EX. 40B-40F, 40H-40I. Such non-prominent, textual use of these phrases fails to constitute a *trademark* use as a matter of law. *See, e.g.*, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3.3, at 3-6 – 3-9 (4th ed. 2012) (noting that "designation claimed as a protectable mark [must be] used in such a way as to make such a visual impression that the viewer would see it as a symbol of origin separate and apart from everything else"); *In re Morganroth*, 208 U.S.P.Q. 284, 288 (T.T.A.B. 1980) (affirming refusal of registration where slogan used in advertising copy was "so obfuscated in the whole scene that it [was] hardly likely to make any impact, much less a significant impression on the individual encountering the advertisement").

All seven of the claims in the FAC arise from, and are dependent upon, Wild's claim that he possesses valid and enforceable rights in his alleged trademarks. Because the FAC fails to allege a claim of *valid* trademark ownership that is plausible on its face, entirety of the FAC should be dismissed with prejudice. *See* Fed. R. Civ. P. 12(b)(6); *Iqbal*, 556 U.S. at 678.

B. HarperCollins' Book Title Is Protected By The First Amendment.

Each of Wild's causes of action must also be dismissed because the title of Marr's Novel is protected by the First Amendment. In *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the Second Circuit addressed the interplay between the Lanham Act and the First Amendment with respect to titles of artistic works. On the one hand, the court acknowledged that consumers have an interest in not being misled as to the origin of such works; on the other hand, it recognized that artistic titles perform an expressive function that is at the core of the First Amendment, and that "overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values." *Id.* at 998. Accordingly, the court articulated a test that balanced these considerations:

> [M]ost consumers are well aware that they cannot judge a book solely by its title any more than by its cover…. Where a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act.

Id. at 1000.

This test was then expressly adopted by the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (quoting and "adopt[ing] the *Rogers* standard as our own"). In reaching this conclusion, the Ninth Circuit repeated and embraced the logic underlying the Second Circuit's decision:

> A title is designed to catch the eye and to promote the value of the underlying work. Consumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer…. A title tells us something about the underlying work but seldom speaks to its origin ….

Id. (citation omitted). Since *MCA Records*, the Ninth Circuit has reaffirmed its adoption of this test on multiple occasions. *See, e.g.*, *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003), *E.S.S. Entertainment 2000, Inc.*

v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008).

Here, the title "Carnival of Souls" clearly has artistic relevance to Marr's Novel. This is a "low threshold": "the level of relevance merely must be above zero." *E.S.S.*, 547 F.3d at 1100. In all events, Wild's own complaint establishes that this threshold has been surmounted. As Wild alleges, the subject matter of Marr's Novel "includes a supernatural carnival [and] supernatural beings such as witches." FAC ¶ 132. Because Wild concedes that Marr's Novel involves a "carnival" of "souls" (*i.e.*, supernatural beings), the artistic relevance of the title to the novel is self-evident, and greater in this case than in other cases finding the First Amendment defense satisfied. *See, e.g.*, *E.S.S. Entertainment*, 547 F.3d at 1100 (depiction of strip club featuring variation on plaintiff's trademark in video game had artistic relevance to game, which depicted urban neighborhood); *Stewart Surfboards, Inc. v. Disney Book Group, LLC*, Case No. 2:10-cv-02982-GAF-SSx, 2011 U.S. Dist. LEXIS 155444, at *13-14 (C.D. Cal. May 11, 2011) (depiction of plaintiff's trademark for surfboards on cover of novel involving television character Hannah Montana had artistic relevance to book, where book featured surfing competition).

Second, the title "Carnival of Souls" is not misleading as to either the source or the content of Marr's Novel. As the Ninth Circuit has held, "the mere use of a trademark alone cannot suffice to make such use explicitly misleading." *E.S.S. Entertainment*, 547 F.3d at 1100; *see also MCA Records*, 296 F.3d at 902 (noting that "if [use of a confusingly similar mark] were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity"). Instead, *Rogers* provides illustrations of "explicitly misleading" uses:

> [S]ome titles – such as "Nimmer on Copyright" and "Jane Fonda's Workout Book" – explicitly state the author of the work or at least the name of the person the publisher is entitled to associate with the preparation of the work. Other titles contain words explicitly signifying endorsement, such as the phrase in a subtitle "an authorized biography."

> If such explicit references were used in a title and were false as applied to the underlying work, the consumer's interest in avoiding deception would warrant application of the Lanham Act, even if the title had some relevance to the work.

Rogers, 875 F.2d at 999.

There are no such claims made here. Defendants have made no reference to Wild or his comic books. On the contrary, Defendants have clearly and exclusively identified HarperCollins as publisher, and Melissa Marr as author, of Marr's Novel – notably, Wild knew exactly whom to contact regarding his claim, and knew exactly whom is identified as the author of Marr's Novel. *See, e.g.*, FAC ¶¶ 5, 95-96. Moreover, as discussed above, the title is directly relevant to (and descriptive of) the content of the novel, and therefore not misleading in that respect either. Indeed, the only ostensible basis for Wild's claim that the "Carnival of Souls" title is misleading is the title itself. However, as the Ninth Circuit has made clear, the mere use of another's trademark in a title does not, as a matter of law, satisfy the second *Rogers* exception. *E.S.S. Entertainment*, 547 F.3d at 1100; *MCA Records*, 296 F.3d at 902.[6] In sum, neither of the two limited exceptions applies, and HarperCollins' use of "Carnival of Souls" is therefore entitled to full First Amendment protection.[7]

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[6] In a footnote in the *Rogers* decision, the Second Circuit suggested that its "limiting construction" would "not apply to misleading titles that are confusingly similar to other titles." 875 F.2d at 999 n.5. This qualification has not been expressly adopted by the Ninth Circuit, which instead routinely articulates the general *Rogers* test as the governing law. *See MCA Records*, 296 F.3d at 902; *Walking Mountain Prods.*, 353 F.3d at 807; *E.S.S.*, *Entertainment*, 547 F.3d at 1099. In any event, even the Second Circuit's exception requires the use by a defendant of a "misleading" title, and as set forth above, there is nothing misleading – explicitly or otherwise – about Defendants' descriptive title of their novel.

[7] As noted above, Wild also challenges HarperCollins' use of the phrases "Enter the Carnival" and "Enter the Carnival of Souls" in connection with its novel. Like the literary title "Carnival of Souls," these phrases are directly and artistically relevant to the HarperCollins novel, and are not misleading as to either the content or source of that work. The *Rogers* test therefore insulates this literary material as well. Moreover, even before *Rogers*, the Ninth Circuit recognized that First Amendment protections extend beyond literary material to *advertising* in support of protected literary materials. *Cf. Cher v. Forum Int'l Ltd.*, 692 F.2d 634, 639 (9th Cir. 1982).

Such protection is particularly appropriate on the facts presented here. The phrase "Carnival of Souls" is not a unique creation of Wild. Instead, this phrase has a robust history – both before Wild's claimed adoption of it and after – in connection with the titles of artistic works. These uses include without limitation the following:

Carnival of Souls (1962) film directed by Herk Harvey

Carnival of Souls (1980) comic book in *Marvel Team-Up* series

Carnival of Souls (1994) comic book in *Warlock and the Infinity Watch* series

Carnival of Souls (1996) album by The Wishing Tree

Carnival of Souls: The Final Sessions (1997) album by Kiss (indeed, it was this use by the band Kiss that inspired Wild's adoption of the phrase, *see* FAC ¶ 165)

Carnival of Souls (1997) comic book in *Curse of Spawn* series

Wes Craven's Carnival of Souls (1998) film

Carnival of Souls (2000) album by Miranda Sex Garden

Carnival of Souls (2005) graphic novel by Michael H. Price

Carnival of Souls (2006) novel in the *Buffy the Vampire Slayer* series

Carnival of Souls (2006) novel by Neal Holland Duncan

Carnival of Souls (2009) eBook by Crymsyn Hart

Carnival of Souls (2010) novel by Ron Mace

Carnival of Souls Volumes One through Eight (2011) books by Mark Philip Ley

Carnival of Souls (2011) song title on album *Violence Begets Violence* by Jedi Mind Tricks

Carnival of Souls Volumes Nine and Ten (2012) books by Mark Philip Ley

Carnival of Souls (2012) release of script written by Jesse Russell and Ronald Cohn

See RJN Exs. F-U; *see also* FAC ¶ 96 & Ex. 131 (acknowledging multiple uses of "Carnival of Souls" by third parties). Granting Wild exclusive rights to the phrase "Carnival of Souls" in connection with literary works would thus run directly counter

to the First Amendment. It would limit authors and other artists, depriving them of a phrase that has long been used for its expressive qualities, and would likewise withhold from readers a title that may enhance their understanding and appreciation of the underlying artistic works. For all of these reasons, it is imperative that the First Amendment considerations reflected in *MCA Records*, *Walking Mountain*, and *E.S.S. Entertainment* be embraced fully here.

Because HarperCollins' challenged activities are protected by the First Amendment, all of Wild's claims must be dismissed. The Ninth Circuit has applied the First Amendment to bar claims for trademark infringement, claims under section 43(a) of the Lanham Act, and claims for state law unfair competition. *See E.S.S. Entertainment*, 547 F.3d at 1098, 1101 (applying First Amendment test to preclude section 43(a) claim and state law unfair competition claim); *MCA Records*, 296 F.3d at 902 (applying First Amendment test to preclude trademark infringement claim). Accordingly, Wild's First Claim (Trademark Infringement), Second Claim (Unfair Competition Under Lanham Act § 43(a)), Third Claim (False Description Under Lanham Act § 43(a), Fourth Claim (Common Law Injury to Business Reputation), Sixth Claim (Reverse Confusion Under Lanham Act § 43(a)), and Seventh Claim (Common Law Unfair Competition) must all be dismissed.[8] Similarly, another judge within this district has applied this First Amendment test to bar dilution claims under the Lanham Act. *See Roxbury Entertainment v. Penthouse Media Group, Inc.*, 669 F. Supp. 2d 1170, 1173-1176 (C.D. Cal. 2009). Wild's only other claim – his Fifth Claim for Trademark Dilution Under Lanham Act § 43(c) – must therefore be

[8] Although Wild's Fourth Claim is denominated a claim for "injury to business reputation," it is in essence a claim for unfair competition that is wholly derivative of Wild's trademark infringement claims. *See* FAC ¶¶ 185-86. As such, it is subject to the First Amendment analysis. *See E.S.S. Entertainment*, 547 F.3d at 1101 (noting that "First Amendment defense applies equally to [plaintiff]'s state law claims as to its Lanham Act claim"); *Roxbury Entertainment v. Penthouse Media Group, Inc.*, 669 F. Supp. 2d 1170, 1174-1176 & n.7 (C.D. Cal. 2009) (applying First Amendment defense to unjust enrichment claim that was "wholly derivative" of other federal and state claims).

dismissed as well.

Even if this First Amendment test did not apply to Wild's dilution claim under section 43(c) of the Lanham Act, that claim must still be dismissed. Section 43(c) excludes from its scope "[a]ny noncommercial use of a mark." 15 U.S.C. § 1125(c)(3)(c). In *MCA Records*, the Ninth Circuit interpreted this phrase to include any "speech [that] is not 'purely commercial' – that is, [speech that] does more than propose a commercial transaction." *MCA Records*, 296 F.3d at 906. Because, as discussed above, HarperCollins' use of the challenged phrases have "artistic relevance" to the underlying novel, they are not purely commercial. *See Stewart Surfboards*, 2011 U.S. Dist. LEXIS 155444, at *29 (noting that "artistic trademark uses are protected from trademark dilution liability for similar reasons" to those underlying the First Amendment test, and holding that defendant's use of a trademark that had "some artistic relevance" to defendant's work therefore constituted "noncommercial use of a mark;" dilution claim dismissed).

C. Wild's Claims Must All Be Dismissed With Prejudice

Moreover, Wild's claims should be dismissed with prejudice. Nothing that Wild could allege in an amended complaint would overcome the facts establishing the absence of a valid trademark and Defendants' First Amendment defense. Because any amendment would therefore be futile, the Court can and should finally resolve Wild's claims at this juncture. *See Stewart Surfboards*, 2011 U.S. Dist. LEXIS 155444 at *29-30 (dismissing complaint with prejudice because "[n]o amendment [could] overcome" facts establishing First Amendment protection for defendant's work); *Gordon v. City of Oakland*, 627 F.3d 1092, 1094 (9th Cir. 2010) (court need not grant plaintiff leave to amend where amendment would be futile).

V. CONCLUSION

For the reasons set forth above, HarperCollins respectfully requests that the Court dismiss Wild's First Amended Complaint with prejudice.

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Respectfully submitted,

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