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Filing date: **12/24/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056169
Party	Defendant Jason P. Barnes aka Jazan Wild
Correspondence Address	THEODORE F SHIELLS SHIELLS LAW FIRM PC 1201 MAIN STREET, SUITE 2470 DALLAS, TX 75202 UNITED STATES jazanwild@yahoo.com, tfshiells@shiellslaw.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Theodore F. Shiells
Filer's e-mail	tfshiells@shiellslaw.com, docket@blackhillsip.com
Signature	/Theodore F. Shiells/
Date	12/24/2012
Attachments	2012-12-24 WILD TTAB Reply re Motion to Suspend TTAB Cancelation with Ex 1-3 AS FILED.pdf (51 pages)(347425 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

HARPERCOLLINS PUBLISHERS, LLC

Petitioner,

v.

JASON P. BARNES, PKA JAZAN WILD

Registrant.

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§

Petition for Cancellation
No. 92056169

Mark: CARNIVAL OF SOULS

Reg. No. 3,921,658

Commissioner for Trademarks
Trademark Trial and Appeals Board
P.O. Box 1451
Alexandria, VA 22313-1451

**REGISTRANT’S REPLY IN FURTHER SUPPORT OF
MOTION TO SUSPEND FOR CIVIL ACTION**

I. INTRODUCTION.

The response of Petitioner HarperCollins Publishers, LLC (Petitioner) provides no basis for denial of Registrant’s motion to suspend this proceeding pursuant to Section 510.02(a) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP).

II. ARGUMENT.

Petitioner’s first argument, that Registrant’s inadvertently failed to serve it a copy of Registrant’s motion to suspend, by first class mail, is no basis for denial. The failure to serve a copy of the motion by first class mail occurred because Registrant’s counsel mistakenly believed that Petitioner would automatically receive a copy of the motion to suspend, by virtue of the TTAB ESTTA system, in a manner analogous to ECF filings in United States District Courts. Registrant’s counsel apologizes for his misunderstanding. However, that error was harmless,

since Petitioner did, in fact, obtain a copy of motion to suspend in sufficient time to submit a response.

Petitioner's counsel has since agreed that it is unnecessary for Registrant to re-file the Motion to Suspend.¹ See attached Exhibit 1, which is a copy of an email dated December 11, 2012 from Petitioner's counsel, Rollin Ransom, to this effect. Accordingly, Petitioner's first argument opposing Registrant's Motion to Suspend has been mooted.

Petitioner's second argument, that this Board should not suspend because the District Court may "defer" to the Board proceedings, is contrary to the Board's usual practice and particularly inapplicable in this case.

TBMP § 510.02(a) provides that, when a civil action is pending, "[o]rdinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board." *Id.* (Note 7). See, e.g., *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have a bearing on issues before the Board); *General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933 (TTAB 1992) (relief sought in federal district court included an order directing Office to cancel registration involved in cancellation proceeding).

In the Civil Action at issue here, not only are same trademark and parties involved, Petitioner HarperCollins has also requested cancellation of Registrant's trademark using the same alleged arguments presented before this Board. See Defendants HarperCollins Publishers LLC and Melissa Marr's Answer, Defenses and Counterclaim to Jazan Wild's First Amended Complaint, attached hereto as Exhibit 2 (Counterclaim, Count I, pars. 37-38). Thus, it is

¹ For good order, Registrant has since properly served a copy of the Motion to Suspend on Petitioner's counsel, by first class mail.

respectfully submitted that this is precisely the sort of case that this Board should suspend pending final determination of the civil action.

Petitioner's argument that the District Court will likely "defer" to this Board is meritless. Proceedings in the Civil Action are well underway. Indeed, the District Court judge has already entered an Order denying the major portions of a Motion to Dismiss brought by HarperCollins in the Civil Action, rejecting many of the same arguments made by HarperCollins' in the present proceedings before this Board. *See* Order dated November 29, 2012, Doc. 19, *Jazan Wild v. HarperCollins Publisher, LLC, et al.*, SACV 12-1191-JST (ANx), attached hereto as Exhibit 3.²

In any event, "[t]o the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court." TBMP § 510.02(a) (note. 2). *See also American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208 (D. Minn. 1986) (stay of the district court action is more likely to prolong the dispute than lead to its economical disposition and where the district court action includes claims which cannot be raised before the Board). Thus, the District Court judge in the present case is unlikely to stay proceedings in the Civil Action or defer to this Board.

III. CONCLUSION.

For the foregoing reasons, as the issues that are the subject of the Civil Action bear directly on the issues and allegations in this Cancellation Proceeding, and the parties are the same, Registrant respectfully requests that the Cancellation Proceeding be suspended pending the final determination of the civil action.

JAZAN WILD (FKA JASON P. BARNES)

² Registrant Jason Barnes and Plaintiff Jazan Wild in the Civil Action are one and the same person; Jazan Wild is Jason Barnes' new name, pursuant to a legal name change.

Date: December 24, 2012

/Theodore F. Shiells/
Theodore F. Shiells
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Ph: (214) 979-7312
Fax: (214) 979-7301
Email: tfshiells@shiellslaw.com

Attachments:

Exhibit 1: Email for Rollin Ransom to Theodore F. Shiells dated ____

Exhibit 2: Answer of HarperCollins Publisher LLC et al. to First Amended Complaint in *Jazan Wild v. HarperCollins Publisher, LLC, et al.*, Civil Action Case No. SACV 12-1191 JST (ANx).

Exhibit 3: Order dated November 29, 2012, Doc. 19, *Jazan Wild v. HarperCollins Publisher, LLC, et al.*, SACV 12-1191-JST (ANx).

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document was served by first class mail,
postage prepaid, to the attorney for Petitioner:

Rollin A. Ransom, Esq.
Sidley Austin LLP
555 West Fifth Street, Suite 4000
Los Angeles, California 90013

on this 24th day of December, 2012

/Theodore F. Shiells/
Theodore F. Shiells

Ted Shiells

From: Ransom, Rollin <rransom@Sidley.com>
Sent: Tuesday, December 11, 2012 1:47 PM
To: Ted Shiells
Subject: RE: Opposition to CARNIVAL OF SOULS Trademark Registration

Ted:

Sorry for the delay. We've obviously got your motion now, so I'm not sure what re-filing would accomplish. I think you should just file a reply to our opposition, if you are so inclined.

Rollin

Rollin A. Ransom
Sidley Austin LLP
555 West Fifth Street, Suite 4000
Los Angeles, California 90013
(213) 896-6047 (telephone)
(213) 896-6600 (facsimile)
rransom@sidley.com

From: Ted Shiells [mailto:tfshiells@shiellslaw.com]
Sent: Tuesday, December 11, 2012 11:40 AM
To: Ransom, Rollin
Subject: RE: Opposition to CARNIVAL OF SOULS Trademark Registration

Rollin,

This is just a quick follow up. Does your lack of response mean "no" or that you are still considering the question?

I would appreciate it if you could let me know one way or the other.

Ted

Theodore F. Shiells
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From: Ted Shiells [<mailto:tfshiells@shiellslaw.com>]
Sent: Monday, December 10, 2012 4:13 PM
To: 'Ransom, Rollin'
Subject: RE: Opposition to CARNIVAL OF SOULS Trademark Registration

Rollin,

Thank you. I also just received your response in U.S. mail.

It appears from your response that I misunderstood the TTAB electronic filing system as being analogous to the Court's ECF system. I apologize for that misunderstanding.

Since you did obtain a copy of the motion, will you stipulate to waive that basis of your opposition to the motion? If not, I will refile the motion. If you do agree to waive that basis for opposition, I will file a reply to your opposition.

Please let me know.

Ted

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From: Ransom, Rollin [<mailto:rransom@sidley.com>]
Sent: Monday, December 10, 2012 3:14 PM
To: Ted Shiells
Subject: RE: Opposition to CARNIVAL OF SOULS Trademark Registration

Attached. You will also be receiving a service copy by U.S. mail (sent out on December 5).

Rollin A. Ransom
Sidley Austin LLP
555 West Fifth Street, Suite 4000
Los Angeles, California 90013
(213) 896-6047 (telephone)
(213) 896-6600 (facsimile)
rransom@sidley.com

From: Ted Shiells [<mailto:tfshiells@shiellslaw.com>]
Sent: Monday, December 10, 2012 12:44 PM
To: Ransom, Rollin
Subject: Opposition to CARNIVAL OF SOULS Trademark Registration

Rollin,

I note on the USPTO website that you filed a brief in opposition to Registrant's motion to suspend, but there is a problem with the PDF that prevents viewing it. Could you please email me a PDF of your brief in opposition? Thank you.

Ted

Theodore F. Shiells
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From: Ransom, Rollin [<mailto:rransom@Sidley.com>]
Sent: Friday, November 02, 2012 5:39 PM
To: Ted Shiells
Subject: RE: Revisions to 26f Report

Ted:

I added Defendants' statement of the case. Your asterisk and comment are fine with me.

The only other change I made was in the schedule – I deleted the "16 - plaintiff" in the "Court's suggested dates" column after fact discovery, and just have "16" in that column after "Expert Discovery Cutoff", since we are agreed on the dates and are using the close of all discovery (fact and expert) for the 16-week trigger.

Rollin

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Sidley Austin LLP
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Los Angeles, California 90013
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From: Ted Shiells [<mailto:tfshiells@shiellslaw.com>]
Sent: Friday, November 02, 2012 2:58 PM
To: Ransom, Rollin
Subject: RE: Revisions to 26f Report

Rollin,

Attached is a revised draft, including Plaintiff's statement of the case. Please add Defendants' statement of the case.

Please note that I accepted Defendants' schedule in Exhibit A, with an asterisk for my comment regarding the mediation date. Please advise if my asterisk and comment are agreeable.

Ted

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From: Ransom, Rollin [<mailto:rransom@Sidley.com>]
Sent: Friday, November 02, 2012 10:59 AM
To: Ted Shiells
Cc: Culbertson, Emily
Subject: Revisions to 26f Report
Importance: High

Ted:

Attached is a proposed revised draft of the Rule 26(f) Report. I've also attached a PDF showing the changes in redline. I still need to complete defendants' statement of the case, but as you note, that is individual to us – I propose that we each just drop in our respective statements of the case when the rest of this is complete, with the understanding that each side's statement will not exceed Judge Tucker's two-page limit. In that respect, note that I changed the font size to 14 pt, since that is the minimum size permitted by our local rules.

Please review the revised draft and let me know if you have any issues with the changes. I'd also like to discuss further the scheduling issue, to see if we can present one, agreed schedule to the court. I'm in the office, so let me know when you would like to talk.

Best regards.

Rollin

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From: Ted Shiells [<mailto:tfshiells@shiellslaw.com>]
Sent: Thursday, November 01, 2012 3:45 PM
To: Ransom, Rollin
Cc: Culbertson, Emily
Subject: RE: Proposed Language re Form of Production

Rollin,

I am enclosing a first draft of the Rule 26(f) Report.

This draft is still subject to amendment. I have not finished working on Plaintiff's statement of the case (so this is not included yet). Each side puts in their own statement of the case anyway. (You also know Plaintiff's position on the case by virtue of the pending motions).

Please double check the dates I put in for you in the schedule (Exhibit A) to make sure I put them in correctly.

Ted

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From: Ransom, Rollin [<mailto:rransom@Sidley.com>]
Sent: Thursday, November 01, 2012 1:39 PM
To: Ted Shiells
Cc: Culbertson, Emily
Subject: Proposed Language re Form of Production

The parties intend to produce documents in paper form to the extent practicable, but may produce documents electronically if necessary or desirable (*e.g.*, due to volume, page sizing issues, etc.). Either party may request that a document that was produced by the other party in paper form be produced in native format, and the parties agree to meet and confer in good faith regarding such requests.

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8 **555 West Fifth Street, Suite 4000**
9 **Los Angeles, California 90013**
10 **Telephone: (213) 896-6000**
11 **Facsimile: (213) 896-6600**

12 **Attorneys for Defendants HarperCollins**
13 **Publishers LLC and Melissa Marr**

14 UNITED STATES DISTRICT COURT
15
16 CENTRAL DISTRICT OF CALIFORNIA, SANTA ANA DIVISION
17

18 JAZAN WILD, an individual, dba
19 CARNIVAL COMICS,
20
21 Plaintiff and Counterclaim
22 Defendant,
23

24 vs.

25 HARPERCOLLINS PUBLISHERS
26 LLC and MELISSA MARR,
27
28 Defendants and
Counterclaim Plaintiffs.

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

) Assigned to: Hon. Josephine Staton-
Tucker

) **DEFENDANTS HARPERCOLLINS**
) **PUBLISHERS LLC AND MELISSA**
) **MARR'S ANSWER, DEFENSES,**
) **AND COUNTERCLAIM TO JAZAN**
) **WILD'S FIRST AMENDED**
) **COMPLAINT**

1 Defendants and Counterclaim Plaintiffs HarperCollins Publishers LLC
2 (“HarperCollins”) and Melissa Marr (“Marr”) (collectively, “Defendants”), for their
3 answer, defenses, and counterclaim to the First Amended Complaint filed herein by
4 Plaintiff and Counterclaim Defendant Jazan Wild (“Wild”), hereby state as follows:

5 **I. SUBJECT MATTER JURISDICTION**

6 1. Defendants admit that Plaintiff’s First Amended Complaint purports to
7 state a claim under the Lanham Act, 15 U.S.C. § 1051 et seq. and other California
8 state law claims. The Defendants deny the remaining allegations of paragraph 1.

9 2. Defendants admit that this Court has subject matter jurisdiction over the
10 claims under 15 U.S.C. § 1121, 28 U.S.C. § 1338(a) and (b), and 28 U.S.C. 1367.
11 The Defendants deny the remaining allegations of paragraph 2.

12 **II. THE PARTIES**

13 3. On information and belief, Defendants admit that Wild is a resident of
14 the State of California and this District, and he is the owner of a United States
15 Trademark Registration for the claimed mark CARNIVAL OF SOULS. Defendants
16 lack knowledge or information sufficient to form a belief as to the truth of the
17 allegation that Wild resides in Encino, California and does business under the name
18 Carnival Comics, and on that basis deny such allegation. Defendants deny the
19 remaining allegations in paragraph 3.

20 4. Defendants admit that HarperCollins is a limited liability company
21 organized and existing under the laws of the State of Delaware with a principal place
22 of business at 10 East 53rd Street, New York, New York, that HarperCollins has
23 offices in San Francisco at 353 Sacramento Street, STE 500 San Francisco, CA
24 94111-3653, and that HarperCollins is wholly owned by News Corporation, with an
25 office at 1211 Avenue of the Americas, New York, New York 10036. Defendants
26 lack knowledge or information sufficient to form a belief as to the truth of the
27 remaining allegations in paragraph 4, and on that basis deny such allegations.
28

1 5. Defendants admit that Marr is the author of a novel entitled “Carnival
2 of Souls” that has been published by HarperCollins. Defendants deny the remaining
3 allegations in paragraph 5.

4 **III. PERSONAL JURISDICTION AND VENUE**

5 6. Defendants admit that this Court has personal jurisdiction over
6 HarperCollins. Defendants lack knowledge or information sufficient to form a belief
7 as to the truth of the allegation that Wild is a resident of this state and District, and
8 on that basis deny such allegation. Defendants deny the remaining allegations in
9 paragraph 6.

10 7. Defendants admit that this Court has personal jurisdiction over Marr.
11 Defendants lack knowledge or information sufficient to form a belief as to the truth
12 of the allegation that Wild is a resident of this state and District, and on that basis
13 deny such allegation. Defendants deny the remaining allegations in paragraph 7.

14 8. Defendants admit the allegations in paragraph 8.

15 9. Defendants admit that venue is proper in this judicial district pursuant
16 to 28 U.S.C. § 1391(b). Defendants deny the remaining allegations in paragraph 9.

17 10. On information and belief, Defendants admit that Wild is the owner of
18 United States Trademark Registration No. 3,921,658, that Wild prosecuted the
19 application that led to such registration, and that Jason Barnes is Wild’s prior name.
20 Defendants lack knowledge or information sufficient to form a belief as to the truth
21 of the remaining allegations respecting United States Trademark Registration No.
22 3,921,658, and on that basis deny such allegations. Defendants deny the remaining
23 allegations in paragraph 10.

24 11. Defendants lack knowledge or information sufficient to form a belief as
25 to the truth of the allegations in paragraph 11, and on that basis deny such
26 allegations.

27 12. Defendants deny the allegations in paragraph 12.
28

1 13. Defendants deny the allegations in paragraph 13.

2 14. Defendants deny the allegations in paragraph 14.

3 15. Defendants deny the allegations in paragraph 15.

4 16. Defendants deny the allegations in paragraph 16.

5 17. Defendants deny the allegations in paragraph 17.

6 18. Defendants admit that the complaint purports to define the term “Wild’s
7 Trademarks” as referenced, but otherwise deny the allegations in paragraph 18.

8 19. Defendants deny the allegation that Wild published a “CARNIVAL OF
9 SOULS graphic novel series.” Defendants lack knowledge or information sufficient
10 to form a belief as to the truth of the remaining allegations in paragraph 19, and on
11 that basis deny such allegations.

12 20. Defendants deny that Wild owns a valid or enforceable trademark in
13 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient to
14 form a belief as to the truth of the remaining allegations in paragraph 20, and on that
15 basis deny such allegations.

16 21. Defendants deny that Wild owns a valid or enforceable trademark in
17 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient to
18 form a belief as to the truth of the remaining allegations in paragraph 21, and on that
19 basis deny such allegations.

20 22. Defendants deny that Wild has sold a “series of comic books, graphic
21 novels and publications . . . under the Wild Trademarks,” or that the claimed “Wild
22 Trademarks” are valid or enforceable. Defendants lack knowledge or information
23 sufficient to form a belief as to the truth of the remaining allegations in paragraph
24 22, and on that basis deny such allegations.

25 23. Defendants deny that Wild owns a valid or enforceable trademark in
26 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient to
27 form a belief as to the truth of the remaining allegations in paragraph 23, and on that
28 basis deny such allegations.

1 24. Defendants deny the allegation that Wild published a “CARNIVAL OF
2 SOULS series.” Defendants lack knowledge or information sufficient to form a
3 belief as to the truth of the remaining allegations in paragraph 24, and on that basis
4 deny such allegations.

5 25. Defendants lack knowledge or information sufficient to form a belief as
6 to the truth of the allegations in paragraph 25, and on that basis deny such
7 allegations.

8 26. Defendants deny that Wild owns a valid or enforceable trademark in
9 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient to
10 form a belief as to the truth of the remaining allegations in paragraph 26, and on that
11 basis deny such allegations.

12 27. Defendants deny that Wild owns a valid or enforceable trademark in
13 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient to
14 form a belief as to the truth of the remaining allegations in paragraph 27, and on that
15 basis deny such allegations.

16 28. Defendants lack knowledge or information sufficient to form a belief as
17 to the truth of the allegations in paragraph 28, and on that basis deny such
18 allegations.

19 29. Defendants lack knowledge or information sufficient to form a belief as
20 to the truth of the allegations in paragraph 29, and on that basis deny such
21 allegations.

22 30. Defendants lack knowledge or information sufficient to form a belief as
23 to the truth of the allegations in paragraph 30, and on that basis deny such
24 allegations.

25 31. Defendants lack knowledge or information sufficient to form a belief as
26 to the truth of the allegations in paragraph 31, and on that basis deny such
27 allegations.

28

1 32. Defendants deny that Wild owns a valid or enforceable trademark in
2 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient to
3 form a belief as to the truth of the remaining allegations in paragraph 32, and on that
4 basis deny such allegations.

5 33. Defendants deny the allegation that Wild published a “CARNIVAL OF
6 SOULS series” or “CARNIVAL OF SOULS books.” Defendants lack knowledge or
7 information sufficient to form a belief as to the truth of the remaining allegations in
8 paragraph 33, and on that basis deny such allegations.

9 34. Defendants deny the allegation that Wild published a “CARNIVAL OF
10 SOULS series.” Defendants lack knowledge or information sufficient to form a
11 belief as to the truth of the remaining allegations in paragraph 34, and on that basis
12 deny such allegations.

13 35. Defendants lack knowledge or information sufficient to form a belief as
14 to the truth of the allegations in paragraph 35, and on that basis deny such
15 allegations.

16 36. Defendants lack knowledge or information sufficient to form a belief as
17 to the truth of the allegations in paragraph 36, and on that basis deny such
18 allegations.

19 37. Defendants lack knowledge or information sufficient to form a belief as
20 to the truth of the allegations in paragraph 37, and on that basis deny such
21 allegations.

22 38. Defendants deny the allegation that Wild published “CARNIVAL OF
23 SOULS graphic novels.” Defendants lack knowledge or information sufficient to
24 form a belief as to the truth of the remaining allegations in paragraph 38, and on that
25 basis deny such allegations.

26 39. Defendants deny the allegation that Wild published “CARNIVAL OF
27 SOULS books.” Defendants lack knowledge or information sufficient to form a
28 belief as to the truth of the remaining allegations in paragraph 39, and on that basis

1 deny such allegations.

2 40. Defendants deny the allegation that Wild published “CARNIVAL OF
3 SOULS books.” Defendants lack knowledge or information sufficient to form a
4 belief as to the truth of the remaining allegations in paragraph 40, and on that basis
5 deny such allegations.

6 41. Defendants deny the allegations in paragraph 41.

7 42. Defendants deny the allegation that Wild published a “CARNIVAL OF
8 SOULS series” or “CARNIVAL OF SOULS books.” Defendants lack knowledge or
9 information sufficient to form a belief as to the truth of the remaining allegations in
10 paragraph 42, and on that basis deny such allegations.

11 43. Defendants deny the allegation that Wild published a “CARNIVAL OF
12 SOULS series.” Defendants lack knowledge or information sufficient to form a
13 belief as to the truth of the remaining allegations in paragraph 43, and on that basis
14 deny such allegations.

15 44. Defendants lack knowledge or information sufficient to form a belief as
16 to the truth of the allegations in paragraph 44, and on that basis deny such
17 allegations.

18 45. Defendants deny the allegation that Wild published a “CARNIVAL OF
19 SOULS” series. Defendants lack knowledge or information sufficient to form a
20 belief as to the truth of the remaining allegations in paragraph 45, and on that basis
21 deny such allegations.

22 46. Defendants deny the allegation that Wild published a “CARNIVAL OF
23 SOULS” series. Defendants lack knowledge or information sufficient to form a
24 belief as to the truth of the remaining allegations in paragraph 46, and on that basis
25 deny such allegations.

26 47. Defendants lack knowledge or information sufficient to form a belief as
27 to the truth of the allegations in paragraph 47, and on that basis deny such
28 allegations.

1 48. Defendants deny the allegation that Wild published a “CARNIVAL OF
2 SOULS” series. Defendants lack knowledge or information sufficient to form a
3 belief as to the truth of the remaining allegations in paragraph 48, and on that basis
4 deny such allegations.

5 49. Defendants deny the allegation that Wild published a “CARNIVAL OF
6 SOULS series.” Defendants lack knowledge or information sufficient to form a
7 belief as to the truth of the remaining allegations in paragraph 49, and on that basis
8 deny such allegations.

9 50. Defendants deny the allegation that Wild published a “CARNIVAL OF
10 SOULS” series or “CARNIVAL OF SOULS books.” Defendants lack knowledge or
11 information sufficient to form a belief as to the truth of the remaining allegations in
12 paragraph 50, and on that basis deny such allegations.

13 51. Defendants deny the allegation that Wild published “CARNIVAL OF
14 SOULS books.” Defendants lack knowledge or information sufficient to form a
15 belief as to the truth of the remaining allegations in paragraph 51, and on that basis
16 deny such allegations.

17 52. Defendants deny the allegation that Wild published a “CARNIVAL OF
18 SOULS” series. Defendants lack knowledge or information sufficient to form a
19 belief as to the truth of the remaining allegations in paragraph 52, and on that basis
20 deny such allegations.

21 53. Defendants deny that Wild owns a valid or enforceable trademark in
22 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient
23 to form a belief as to the truth of the allegations in paragraph 53, and on that basis
24 deny such allegations.

25 54. Defendants deny that Wild owns a valid or enforceable trademark in
26 “CARNIVAL OF SOULS,” and deny the allegation that Wild published a
27 “CARNIVAL OF SOULS series.” Defendants lack knowledge or information
28 sufficient to form a belief as to the truth of the remaining allegations in paragraph

1 54, and on that basis deny such allegations.

2 55. Defendants lack knowledge or information sufficient to form a belief as
3 to the truth of the allegations in paragraph 55, and on that basis deny such
4 allegations.

5 56. Defendants lack knowledge or information sufficient to form a belief as
6 to the truth of the allegations in paragraph 56, and on that basis deny such
7 allegations.

8 57. Defendants deny that Wild owns a valid or enforceable trademark in
9 “CARNIVAL OF SOULS,” and deny the allegation that Wild published a
10 “CARNIVAL OF SOULS series.” Defendants lack knowledge or information
11 sufficient to form a belief as to the truth of the remaining allegations in paragraph
12 57, and on that basis deny such allegations.

13 58. Defendants deny the allegations in paragraph 58.

14 59. Defendants deny the allegations in paragraph 59.

15 60. Defendants deny the allegations in paragraph 60.

16 61. Defendants deny the allegations in paragraph 61.

17 62. Defendant HarperCollins admits that it has described itself as being at
18 the forefront of innovation and technological advancement and as a leader in
19 digitizing content. Defendant HarperCollins lacks knowledge or information
20 sufficient to form a belief as to the truth of the remaining allegations in paragraph
21 62, and on that basis denies such allegations. Defendant Marr lacks knowledge or
22 information sufficient to form a belief as to the truth of the allegations of paragraph
23 62, and on that basis denies such allegations.

24 63. Defendants lack knowledge or information sufficient to form a belief as
25 to the truth of the allegations in paragraph 63, and on that basis deny such
26 allegations.

27 64. Defendant HarperCollins admits that, under appropriate circumstances
28 and subject to legal restrictions and requirements, the title of a series of books may

1 be subject to trademark protection, and that HarperCollins holds certain United
2 States Trademark registrations for series of books in International Class 16,
3 including “I CAN READ!,” United States Registration No. 4,163,122, “PONY
4 SCOUTS”, United States Trademark Registration No. 3,697,216, and at least certain
5 of the registrations listed in Exhibit 127. Defendant HarperCollins denies the
6 remaining allegations in paragraph 64. Defendant Marr lacks knowledge or
7 information sufficient to form a belief as to the truth of the allegations of paragraph
8 64, and on that basis denies such allegations.

9 65. Defendant HarperCollins admits that it has been represented by
10 experienced attorneys in connection with trademark matters, and that counsel
11 representing HarperCollins in this matter is also representing Marr in this matter.
12 Defendant HarperCollins denies the remaining allegations in paragraph 65.
13 Defendant Marr admits that that counsel representing HarperCollins in this matter is
14 also representing Marr in this matter. Defendant Marr lacks knowledge or
15 information sufficient to form a belief as to the truth of the remaining allegations of
16 paragraph 65, and on that basis denies such allegations.

17 66. Defendants lack knowledge or information sufficient to form a belief as
18 to the truth of the allegations in paragraph 66, and on that basis deny such
19 allegations.

20 67. Defendants deny that Wild owns a valid or enforceable trademark in
21 “CARNIVAL OF SOULS.” Defendants lack knowledge or information sufficient to
22 form a belief as to the truth of the remaining allegations in paragraph 67, and on that
23 basis deny such allegations.

24 68. Defendant HarperCollins admits that it is aware that information
25 respecting certain United States Trademark Registrations is publicly available for
26 free through uspto.gov. Defendant HarperCollins denies the remaining allegations
27 in paragraph 68. Defendant Marr lacks knowledge or information sufficient to form
28 a belief as to the truth of the allegations in paragraph 68, and on that basis denies

1 such allegations.

2 69. Defendant HarperCollins denies the allegations in paragraph 69.
3 Defendant Marr lacks knowledge or information sufficient to form a belief as to the
4 truth of the allegations in paragraph 69, and on that basis denies such allegations.

5 70. Defendants deny the allegations in paragraph 70.

6 71. Defendants deny the allegations in paragraph 71.

7 72. Defendants deny the allegations in paragraph 72.

8 73. Defendants deny the allegation that Wild published a "CARNIVAL OF
9 SOULS series of books." Defendants lack knowledge or information sufficient to
10 form a belief as to the truth of the remaining allegations in paragraph 73, and on that
11 basis deny such allegations.

12 74. Defendants lack knowledge or information sufficient to form a belief as
13 to the truth of the allegations in paragraph 74, and on that basis deny such
14 allegations.

15 75. Defendants deny the allegations in paragraph 75.

16 76. Defendants deny the allegations in paragraph 76.

17 77. Defendants deny the allegations in paragraph 77.

18 78. Defendants deny the allegations in paragraph 78.

19 79. Defendants deny the allegations in paragraph 79.

20 80. Defendants lack knowledge or information sufficient to form a belief as
21 to the truth of the allegations in paragraph 80, and on that basis deny such
22 allegations.

23 81. Defendants deny the allegations in paragraph 81.

24 82. Defendants deny the allegations in paragraph 82.

25 83. Defendants deny the allegations in paragraph 83.

26 84. Defendants deny the allegations in paragraph 84.

27 85. Defendants deny the allegations in paragraph 81.

28

1 86. Defendants deny the allegations in paragraph 86.

2 87. Defendants deny the allegations in paragraph 87.

3 88. Defendants deny the allegations in paragraph 88.

4 89. Defendants deny the allegations in paragraph 89.

5 90. Defendants deny the allegations in paragraph 90.

6 91. Defendants deny the allegations in paragraph 91.

7 92. Defendants deny the allegations in paragraph 92.

8 93. Defendants deny the allegations in paragraph 93.

9 94. Defendants deny the allegations in paragraph 94.

10 95. Defendants admit that Exhibit 130 reflects the following quoted text in
11 paragraph 95: "I wanted to kindly make you aware of the fact that I "Jazan Wild"
12 and Carnival Comics have a trademark "CARNIVAL OF SOULS" in the following
13 categories;" that the Exhibit also depicts an image of Wild's claimed trademark
14 registration, and a link to the harperteen.com website. Defendants deny the
15 remaining allegations in paragraph 95.

16 96. Defendants admit that Fabio Bertoni communicated with Jazan Wild on
17 June 19, 2012, and that a copy of Mr. Bertoni's e-mail is attached to the complaint
18 as Exhibit 131. Defendants deny the remaining allegations in paragraph 96.

19 97. Defendants deny the allegations in paragraph 97.

20 98. Defendants admit that Wild communicated with Mr. Bertoni on June
21 19, 2012, that a copy of Wild's e-mail is attached to the complaint as Exhibit 132,
22 and that Exhibit 132 reflects the text quoted in paragraph 98. Defendants deny the
23 remaining allegations in paragraph 98.

24 99. Defendants admit that Wild communicated with HarperCollins on June
25 20, 2012, that a copy of Wild's e-mail is attached to the complaint as Exhibit 133,
26 and that Exhibit 133 reflects the text quoted in paragraph 99. Defendants deny the
27 remaining allegations in paragraph 99.

28

1 100. Defendants deny the allegations in paragraph 100.

2 101. Defendants admit that Exhibit 134 reflects the text quoted in paragraph

3 101. Defendants deny the remaining allegations in paragraph 101.

4 102. Defendants admit that Exhibit 135 reflects the text quoted in paragraph

5 102. Defendants lack knowledge or information sufficient to form a belief as to the

6 truth of the remaining allegations in paragraph 102, and on that basis deny such

7 allegations.

8 103. Defendants admit that Exhibit 136 reflects the text quoted in paragraph

9 103. Defendants lack knowledge or information sufficient to form a belief as to the

10 truth of the remaining allegations in paragraph 103.

11 104. Defendants admit that Dale Cendali, in her capacity as legal counsel to

12 HarperCollins, communicated with Wild on June 22, 2012, and that a copy of Ms.

13 Cendali's letter is attached to the complaint as Exhibit 118. Defendants deny the

14 remaining allegations in paragraph 104.

15 105. Defendants deny the allegations in paragraph 105.

16 106. Defendants deny the allegations in paragraph 106.

17 107. Defendants deny the allegations in paragraph 107.

18 108. Defendants deny the allegations in paragraph 108.

19 109. Defendants deny the allegations in paragraph 109.

20 110. Defendants admit that they have promoted their novel "Carnival of

21 Souls," including on the Internet, in live events, and by printing promotional

22 material. Defendants deny the remaining allegations in paragraph 110.

23 111. Defendants deny the allegations in paragraph 111.

24 112. Defendants deny the allegations in paragraph 112.

25 113. Defendants deny the allegations in paragraph 113.

26 114. Defendants deny the allegations in paragraph 114.

27 115. Defendants admit that Exhibit 39B shows pictures of a book signing for

28 "Carnival of Souls" by Marr. Defendants lack knowledge or information sufficient

1 to form a belief as to the truth of the allegation that the book signing was on June 5,
2 2012, and on that basis deny such allegation. Defendants deny the remaining
3 allegations in paragraph 115.

4 116. Defendants deny the allegations in paragraph 116.

5 117. Defendants deny the allegations in paragraph 117.

6 118. Defendants deny the allegations in paragraph 118.

7 119. Defendants admit that Exhibit 101 depicts a page from Marr's website,
8 that Exhibits 119 and 138 depict Twitter postings by Marr, and that the quoted text
9 attributed to Exhibits 101, 119, and 138 appears in those exhibits. Defendants deny
10 the remaining allegations in paragraph 119.

11 120. Defendants admit that Exhibit 39A reflects postings by Marr, depicts an
12 image from the printed "Carnival of Souls" novel, and reflects the text quoted in
13 paragraph 120. Defendants deny the remaining allegations in paragraph 120.

14 121. Defendants admit that Exhibit 38 reflects the text quoted in paragraph
15 121. Defendants deny the remaining allegations in paragraph 121.

16 122. Defendants admit that Exhibit 119 reflects the text quoted in paragraph
17 122. Defendants deny the remaining allegations in paragraph 122.

18 123. Defendants deny the allegations in paragraph 123.

19 124. Defendants admit that the quoted text attributed to Exhibits 104 and 116
20 appears in those exhibits. Defendants deny the remaining allegations in paragraph
21 124.

22 125. Defendants deny the allegations in paragraph 125.

23 126. Defendants admit that the lyrics of a song entitled "Far From Home" by
24 the band "Five Finger Death Punch," which include the line "another day in this
25 carnival of souls," was the inspiration for Marr's novel and the source of the title for
26 the novel. Defendants also admit that the song lyrics were "the spark" that started
27 her "dive into this book," and that in the "Acknowledgements" page of Marr's
28 "Carnival of Souls" novel, she expresses gratitude to Five Finger Death Punch for

1 the phrase “carnival of souls” and includes the quoted text in paragraph 126.

2 Defendants also admit that Wild and his work are not mentioned anywhere in Marr’s
3 novel, including in the Acknowledgements page. Defendants deny the remaining
4 allegations in paragraph 126.

5 127. Defendants deny the allegations in paragraph 127.

6 128. Defendants deny the allegations in paragraph 128.

7 129. Defendants deny the allegations in paragraph 129.

8 130. Defendants deny the allegations in paragraph 130.

9 131. Defendants deny that Wild owns a valid or enforceable trademark in
10 “CARNIVAL OF SOULS,” that Wild published “comic books, graphic novels, and
11 novels” under the title “Carnival of Souls,” and that Wild’s work is targeted
12 primarily at a young adult audience, comprised of members of both genders.
13 Defendants admit that Wild’s work includes a traveling supernatural carnival,
14 supernatural beings, and extensive graphic violence. Defendants lack knowledge or
15 information sufficient to form a belief as to the truth of the remaining allegations in
16 paragraph 131, and on that basis deny such allegations.

17 132. Defendants admit that Marr’s “Carnival of Souls” novel includes a
18 venue described as the “carnival of souls,” includes witches, includes love story
19 elements and certain elements of violence, and is generally characterized as falling
20 within the “young adult” market. Defendants deny the remaining allegations in
21 paragraph 132.

22 133. Defendants deny the allegations in paragraph 133.

23 134. Defendants admit that Exhibit 114 reflects the text quoted in paragraph
24 134. Defendants deny the remaining allegations in paragraph 134.

25 135. Defendants deny the allegations in paragraph 135.

26 136. Defendants lack knowledge or information sufficient to form a belief as
27 to the truth of the allegations in paragraph 136, and on that basis deny such
28 allegations.

1 137. Defendants deny the allegations in paragraph 137.

2 138. Defendants admit that Barnes and Noble sells novels, comic books, and
3 graphic novels. Defendants lack knowledge or information sufficient to form a
4 belief as to the truth of the allegations in paragraph 138, and on that basis deny such
5 allegations.

6 139. Defendants admit that Marr had a book signing event in the Los
7 Angeles area. Defendants deny that Marr is a Washington, D.C. resident.
8 Defendants lack knowledge or information sufficient to form a belief as to the truth
9 of the remaining allegations in paragraph 139, and on that basis deny such
10 allegations.

11 140. Defendants admit the allegations in the first sentence of paragraph 140.
12 Defendants lack knowledge or information sufficient to form a belief as to the truth
13 of the remaining allegations in paragraph 140, and on that basis deny such
14 allegations.

15 141. Defendant HarperCollins admits that HarperCollins promoted its
16 “Carnival of Souls” novel at the 2012 “Comic Con” convention, including by giving
17 away advance copies of the novel at its booth, and that Exhibit 102 relates to such
18 promotion. Defendant HarperCollins lacks knowledge or information sufficient to
19 form a belief as to the truth of the allegations respecting Exhibit 105 and respecting
20 Wild’s promotion at Comic Con, and on that basis denies such allegations.
21 Defendant Marr lacks knowledge or information sufficient to form a belief as the
22 truth of the allegations respecting Comic Con, Exhibit 102, and Exhibit 105, and that
23 basis denies such allegations. Defendants deny the remaining allegations in
24 paragraph 141.

25 142. Defendants deny the allegations in paragraph 142.

26 143. Defendants deny the allegations in paragraph 143.

27 144. Defendants deny the allegations in paragraph 144.

28

145. Defendants deny the allegations in paragraph 145.

146. Defendants deny the allegations in paragraph 146.

147. Defendants deny the allegations that Wild published a “CARNIVAL OF SOULS series,” that the identification of Marr as the author of Defendants’ novel and/or use of HarperCollins’ name as publisher is insufficient to identify the source of the novel, that HarperCollins’ name is not used on the cover of Defendants’ novel, and that there is any likelihood of confusion. Defendants lack knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 147, and on that basis deny such allegations.

148. Defendants deny the allegations in paragraph 148.

149. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 149, and on that basis deny such allegations.

150. Defendants admit that HarperCollins has published one or more books authored or co-authored by Stefan Petrucha and that HarperCollins’ website contains a biography of Stefan Petrucha. Defendants deny the remaining allegations in paragraph 150.

151. Defendants admit that the HarperCollins website includes a link to Stefan Petrucha’s web site. Defendants deny the allegations in paragraph 151.

152. Defendants deny the allegations that Wild published a “CARNIVAL OF SOULS series.” Defendants lack knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 152, and on that basis deny such allegations.

153. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 153, and on that basis deny such allegations.

154. Defendants deny the allegations in paragraph 154.

155. Defendants deny the allegations in paragraph 155.

156. Defendants deny the allegations in paragraph 156.

157. Defendants admit the allegations in paragraph 157.

158. Defendants deny the allegations in paragraph 158.

159. Defendants admit the allegations in paragraph 159.

160. Defendants deny the allegations in paragraph 160.

161. Defendants deny the allegations in paragraph 161.

162. Defendants deny the allegations in paragraph 162.

163. Defendants admit that the lyrics of a song entitled “Far From Home” by the band “Five Finger Death Punch,” which include the line “another day in this carnival of souls,” were the inspiration for Marr’s novel and the source of the title for the novel. Defendants deny the remaining allegations in paragraph 163.

164. Defendants deny that Wild owns a valid or enforceable trademark in “CARNIVAL OF SOULS” and that Wild published “comic books, graphic novels, and novels” under the title “Carnival of Souls.” Defendants lack knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 164, and on that basis deny such allegations.

165. Defendants deny that Wild owns a valid or enforceable trademark in “CARNIVAL OF SOULS” and that Wild published a series under the title “Carnival of Souls.” Defendants lack knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 165, and on that basis deny such allegations.

166. Defendants deny the allegations in paragraph 166.

167. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations respecting Sharon Barnes’ purchases from Amazon.com, and on that basis deny such allegations. Defendants deny the remaining allegations in paragraph 167.

1 168. Defendants lack knowledge or information sufficient to form a belief as
2 to the truth of the allegations respecting Sharon Barnes' purchases from
3 Amazon.com, and on that basis deny such allegations. Defendants deny the
4 remaining allegations in paragraph 168.

5 169. Defendants lack knowledge or information sufficient to form a belief as
6 to the truth of the allegations in the first sentence of paragraph 169, and on that basis
7 deny such allegations. Defendants deny the remaining allegations in paragraph 169.

8 170. Defendants deny the allegations in paragraph 170.

9 171. Defendants lack knowledge or information sufficient to form a belief as
10 to the truth of the allegations in paragraph 171, and on that basis deny such
11 allegations.

12 172. Defendants deny the allegations in paragraph 172.

13 173. Defendants deny the allegations in paragraph 173.

14 174. Defendants deny the allegations in paragraph 174.

15 175. Defendants deny the allegations in paragraph 175.

16 176. Defendants deny the allegations in paragraph 176.

17 177. Defendants deny the allegations in paragraph 177.

18 **FIRST CLAIM**

19 **TRADEMARK INFRINGEMENT UNDER LANHAM ACT § 32**

20 178. Defendants repeat and reallege their responses to paragraphs 1 through
21 177.

22 179. Defendants deny the allegations in paragraph 179.

23 180. Defendants deny the allegations in paragraph 180.

24 **SECOND CLAIM**

25 **UNFAIR COMPETITION UNDER LANHAM ACT § 43**

26 181. Defendants repeat and reallege their responses to paragraphs 1 through
27 180.

182. Defendants deny the allegations in paragraph 182.

THIRD CLAIM

FALSE DESCRIPTION

183. Defendants repeat and reallege their responses to paragraphs 1 through 182.

184. Defendants deny the allegations in paragraph 184.

FOURTH CLAIM

COMMON LAW INJURY TO BUSINESS REPUTATION

185. Defendants repeat and reallege their responses to paragraphs 1 through 184.

186. Defendants deny the allegations in paragraph 186.

FIFTH CLAIM

TRADEMARK DILUTION - 15 U.S.C. 1125 (c)

187. No response to paragraph 187 is required, in light of the Court's order dated November 29, 2012, dismissing this claim. To the extent a response is required, Defendants repeat and reallege their responses to paragraphs 1 through 186.

188. No response to paragraph 188 is required, in light of the Court's order dated November 29, 2012, dismissing this claim. To the extent a response is required, Defendants deny the allegations in paragraph 188.

SIXTH CLAIM

REVERSE CONFUSION UNDER THE LANHAM ACT

189. Defendants repeat and reallege their responses to paragraphs 1 through 188.

190. Defendants deny the allegations in paragraph 190.

191. Defendants deny the allegations in paragraph 191.

SEVENTH CLAIM

COMMON LAW TRADEMARK INFRINGEMENT

192. Defendants repeat and reallege their responses to paragraphs 1 through 191.

193. Defendants deny the allegations in paragraph 193.

194. Defendants deny the allegations in paragraph 194.

195. Defendants deny the allegations in paragraph 195.

DEFENSES

Without conceding that they bear the burden of proof or persuasion as to any of these defenses, Defendants allege the following defenses to the allegations set forth in the First Amended Complaint:

FIRST DEFENSE - FAILURE TO STATE A CLAIM

The First Amended Complaint and each and every purported claim therein fails to state a claim upon which relief can be granted.

SECOND DEFENSE - NO LIKELIHOOD OF CONFUSION

There is no likelihood of confusion between parties' respective uses of the phrases "Carnival of Souls," "Enter the Carnival," or "Enter the Carnival of Souls."

THIRD DEFENSE - NO USE AS A MARK

Wild has not used the phrases "Carnival of Souls," "Enter the Carnival," or "Enter the Carnival of Souls," or any of them, as a trademark or service mark.

FOURTH DEFENSE - INVALIDITY

Wild's claimed marks, including without limitation Wild's claimed registered mark, are invalid, including without limitation because he has not used any of them in connection with a series of literary works, because he has not used any of them as a service mark, and because he improperly obtained registration of an incomplete mark.

FIFTH DEFENSE – GENERICNESS OR DESCRIPTIVENESS

The phrases "Carnival of Souls," "Enter the Carnival," and "Enter the

Carnival of Souls” are, at best, either generic or merely descriptive of the goods and services offered by Wild, and are thus incapable of functioning as a trademark or service mark for such goods.

SIXTH DEFENSE – UNCLEAN HANDS

Wild’s claims are barred, in whole or in part, by the doctrines of unclean hands and *in pari delicto*.

SEVENTH DEFENSE – LACHES

The First Amended Complaint and each and every purported claim therein is barred by the doctrine of laches, including without limitation to the extent Wild seeks injunctive relief.

EIGHTH DEFENSE – FAIR USE

Defendants’ use of the each of phrases “Carnival of Souls,” “Enter the Carnival,” and “Enter the Carnival of Souls” constitutes a use, otherwise than as a mark, of a term or device which is descriptive of and used fairly and in good faith to describe Defendants’ goods.

NINTH DEFENSE – FAILURE TO MITIGATE

To the extent Wild has suffered any damages (which Defendants expressly deny), Wild has failed to take reasonable steps to mitigate those purported damages.

TENTH DEFENSE – INNOCENT INFRINGEMENT

While expressly denying any liability, if Defendants are found to have infringed any enforceable right or interest held by Wild, Defendants did so without any knowledge or intent.

ELEVENTH DEFENSE – SCOPE OF INJUNCTIVE RELIEF

Wild is not entitled to the injunctive relief sought to the extent it exceeds the authority set forth in 15 U.S.C. § 1118.

TWELFTH DEFENSE – ADDITIONAL DEFENSES

Defendants presently have insufficient knowledge or information upon which to form a belief whether they may have additional, unstated defenses. On that basis,

1 Defendants reserve the right to amend this answer to assert additional defenses in the
2 event discovery indicates that additional defenses are appropriate.

3 **COUNTERCLAIM**

4 Defendants, for their counterclaim against Wild, hereby allege as follows:

5 1. Defendants' counterclaim arises under the Lanham Act, 15 U.S.C. § 1051
6 et seq.

7 2. The jurisdiction of this Court is invoked pursuant to 15 U.S.C. § 1121
8 and 28 U.S.C. §§ 1331 and 1338. Venue is proper under 28 U.S.C. § 1391.

9 **PARTIES**

10 3. HarperCollins is a limited liability company organized under the laws of
11 the State of Delaware, with a principal place of business at 10 East 53rd Street, New
12 York, New York.

13 4. Marr is an individual who resides in the State of Virginia.

14 5. HarperCollins is informed and believes that Wild is an individual who
15 resides in the State of California. HarperCollins is further informed and believes that
16 Wild is the owner of United States Trademark Registration No. 3,921,658 (the
17 "Registration"), which Registration is the subject of this cancellation petition, and that
18 Wild (acting under the name Jason Barnes) prosecuted the application that led to such
19 Registration.

20 **PROSECUTION HISTORY OF THE ALLEGED MARK**

21 6. The Registration is for the alleged mark CARNIVAL OF SOULS (the
22 "Alleged Mark"), in International Class 16 for "Comic books; Graphic novels;
23 Novels," and in International Class 41 for the "Multimedia publishing of books,
24 magazines, journals, software, games, and electronic publications."

25 7. On or about December 4, 2009, the Examining Attorney at the United
26 States Patent and Trademark Office issued an Office Action, refusing registration of
27 the Alleged Mark with respect to the International Class 16 goods. In the Office
28 Action, the Examining Attorney stated that the specimen submitted with Wild's

1 application showed use of the Alleged Mark “only as the title of a single creative
2 work,” and that it therefore “[did] not function as a trademark to identify and
3 distinguish applicant’s goods from those of others and to indicate the source of
4 applicant’s goods.” A true and correct copy of the Examining Attorney’s Office
5 Action, dated December 4, 2009, is attached hereto as Exhibit A.

6 8. On or about December 10, 2009, Wild responded to the Office Action,
7 submitting various specimens that he claimed showed use of the Alleged Mark in “an
8 on-going series.” A true and correct copy of Wild’s response to the Office Action
9 (including exhibits), dated December 10, 2009, is attached hereto as Exhibit B.

10 9. On the basis of Wild’s representations, the Examining Attorney
11 ultimately allowed registration of the Alleged Mark.

12 **BASES FOR CANCELLATION OF THE REGISTRATION**

13 **A. The Specimens Submitted In Connection With The Application Do** 14 **Not Support Use Of The Alleged Mark.**

15 10. Although the Registration is for CARNIVAL OF SOULS, the specimens
16 submitted by Wild do not reflect use of the Alleged Mark that is depicted in the
17 drawing submitted with the underlying application, and reflected in the Registration.

18 11. Instead, the phrase identified in every specimen that Wild submitted to
19 the Trademark Office in connection with the application was “Jazan Wild’s Carnival
20 of Souls.” A true and correct copy of the specimen submitted with Wild’s application
21 to register the Alleged Mark is attached hereto as Exhibit C. *See also* Exhibit B.

22 12. 37 C.F.R. § 2.51(a) provides that “the drawing of the mark [submitted
23 with the application] must be a substantially exact representation of the mark as used
24 on or in connection with the goods and/or services.”

25 13. Section 807.12(d) of the Trademark Manual of Examining Procedure
26 provides as follows: “In an application under §1 of the Trademark Act, the mark on
27 the drawing must be a complete mark, as evidenced by the specimen. When the
28 representation on a drawing does not constitute a complete mark, it is sometimes

1 referred to as a ‘mutilation’ of the mark. This term indicates that essential and integral
 2 subject matter is missing from the drawing. An incomplete mark may not be
 3 registered.”

4 14. Wild’s failure to include the phrase “Jazan Wild’s” as part of the drawing
 5 of the Alleged Mark renders the Alleged Mark an incomplete mark. Accordingly,
 6 registration of the Alleged Mark should have been refused pursuant to 37 C.F.R. §
 7 2.51(a) and T.M.E.P. § 807.12.

8 15. Defendants are informed and believe that Wild was fully aware,
 9 throughout the time he was prosecuting the application that led to the Registration,
 10 that his works published prior to the issuance of the Registration consistently used the
 11 phrase “Jazan Wild’s Carnival of Souls,” and not merely “Carnival of Souls.” Wild
 12 had this awareness as the claimed author or co-author of these works.

13 16. Defendants are informed and believe, on the basis of the foregoing
 14 allegations, that Wild knowingly failed to disclose material information to the United
 15 States Patent and Trademark Office – namely, that the Alleged Mark was, in fact, a
 16 mutilation of the complete phrase used in connection with his works – and further that
 17 he intended to deceive the United States Patent and Trademark Office in this regard.

18 **B. Wild Has Not Used The Alleged Mark On A Series Of Literary**
 19 **Works.**

20 17. Although Wild claims to have used the Alleged Mark in connection with
 21 an ongoing series, HarperCollins is informed and believes that he has used the Alleged
 22 Mark only in connection with single works, none of which can support registration of
 23 the Alleged Mark in connection with the goods identified in Class 16.

24 18. With respect to “Novels,” Defendants are informed and believe that Wild
 25 has used the phrase “Carnival of Souls” in connection with only one “novel,” namely,
 26 “Carnival of Souls (A Novel by Jazan Wild).” The Trademark Manual of Examining
 27 Procedure (“TMEP”) provides that “[t]he title of a single creative work is not
 28 registrable on either the Principal or Supplemental Register.” TMEP § 1202.08.

1 19. Defendants are further informed and believe that the above-referenced
2 novel was not published until July 4, 2012, when it was made available “exclusively”
3 on amazon.com. Accordingly, this use cannot in any event support the Registration,
4 which issued over sixteen months earlier.

5 20. Similarly, with respect to “Graphic novels,” HarperCollins is informed
6 and believes that Wild has used the phrase “Carnival of Souls” in connection with
7 only one “graphic novel,” namely, “Jazan Wild’s Carnival of Souls.”

8 21. For the reasons discussed above, the title of this graphic novel does not
9 support registration of the Alleged Mark, because the inclusion of “Jazan Wild’s” in
10 the title of the graphic novel renders the Alleged Mark an incomplete mark with
11 respect to these goods. Separate and apart from that failing, because Wild has used
12 the title “Jazan Wild’s Carnival of Souls” only in connection with a single graphic
13 novel, such use cannot support registration of the title in any event. TMEP § 1202.08.

14 22. Finally, with “Comic books,” Defendants are informed and believe that
15 Wild has used the title “Jazan Wild’s Carnival of Souls” in connection with three so-
16 called comic books; however, these three “comic books” are nothing more than
17 serialized chapters of the single graphic novel described above.

18 23. In fact, a judge in the United States District Court has already
19 acknowledged that these so-called comic books are merely serialized subparts of
20 Wild’s graphic novel. *See Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1089-
21 90 (C.D. Cal. 2011) (describing Carnival of Souls as “a three-part ‘graphic novel’”
22 and “a graphic novel consisting of three comic books”).

23 24. For the reasons discussed above, the title of these “comic books” does
24 not support registration of the Alleged Mark, because the inclusion of “Jazan Wild’s”
25 in the title of each of them renders the Alleged Mark an incomplete mark with respect
26 to these goods. Separate and apart from that failing, section 1202.08(a) of the
27 Trademark Manual of Examining Procedure provides that “[c]reative works that are
28 serialized, i.e., the mark identifies the entire work but the work is issued in sections or

1 chapters, are still considered single creative works.” Accordingly, Wild’s so-called
2 “comic books” cannot support the Registration either.

3 25. Wild’s failure to use the Alleged Mark in connection with a series of
4 literary works renders the Alleged Mark unregistrable.

5 26. Defendants are informed and believe that Wild was fully aware,
6 throughout the time he was prosecuting the application that led to the Registration,
7 that he had not used the Alleged Mark in connection with a series of literary works.
8 Wild had this awareness as the claimed author or co-author of these works.
9 Defendants are further informed and believe, on the basis of the foregoing allegations,
10 that Wild knowingly made a false, material representation to the United States Patent
11 and Trademark Office – namely, that he had used the Alleged Mark in connection
12 with a series of literary works – and further that he intended to deceive the United
13 States Patent and Trademark Office in this regard.

14 27. Alternatively, Defendants are informed and believe that Wild was fully
15 aware, throughout the time that he was prosecuting the application that led to the
16 Registration, that he had not used the Alleged Mark in connection with “novels” prior
17 to the issuance of the registration. Defendants are further informed and believe, on the
18 basis of the foregoing allegations, that Wild knowingly made a false, material
19 representation to the United States Patent and Trademark Office – namely, that he had
20 used the Alleged Mark in connection with “novels” – and further that he intended to
21 deceive the United States Patent and Trademark Office in this regard.

22 **C. Wild Has Not Used The Alleged Mark In Connection With The**
23 **Identified Services.**

24 28. The Registration also purports to cover the following services in
25 International Class 41: “Multimedia publishing of books, magazines, journals,
26 software, games, and electronic publications.

27 29. Defendants are informed and believe that Wild has never used the
28 Alleged Mark as a service mark in connection with the services identified above.

1 Instead, Defendants are informed and believe that Wild has merely offered the novel
2 and graphic novel identified above (or serialized parts of such graphic novel) through
3 various media.

4 30. In fact, the information submitted by Wild in responding to an Office
5 Action confirms that his sole use of the Alleged Mark in connection with the
6 identified services was to offer literary publications bearing the phrase “Jazan Wild’s
7 Carnival of Souls” through various media, including “a comic book website,” as an
8 “ebook/electronic publication,” and on “mobile phones.” In these publications, the
9 phrase “Carnival of Souls” was not used to identify a publisher or provider of media;
10 rather, it was used to identify the underlying work. Indeed, this evidence further
11 establishes that “Carnival Comics” is actually the publisher of the referenced
12 materials, and that “Carnival of Souls” was merely one of two books that were “being
13 offered” through the media services.

14 31. Section 1301.02(a) of the Trademark Manual of Examining Procedure
15 provides that “[a] term that is used only to identify a product, device, or instrument
16 sold or used in the performance of a service rather than to identify the service itself
17 does not function as a service mark.”

18 32. Here, because Wild has not used the Alleged Mark to identify the service
19 itself (as distinct from the product sold through various media,” Wild has not used the
20 Alleged Mark as a service mark.

21 33. Defendants are informed and believe that Wild was fully aware,
22 throughout the time he was prosecuting the application that led to the Registration,
23 that he had not used the Alleged Mark in connection with the identified services.
24 Wild had this awareness as the claimed provider of the services. Defendants are
25 further informed and believe, on the basis of the foregoing allegations, that Wild
26 knowingly made a false, material representation to the United States Patent and
27 Trademark Office – namely, that he had used the Alleged Mark in connection with the
28 identified services – and further that he intended to deceive the United States Patent

1 and Trademark Office in this regard.

2 **D. HarperCollins Will Be Damaged By The Registration.**

3 34. HarperCollins is the publisher of a novel by best-selling author Marr that
4 is entitled "Carnival of Souls." This novel was made available in wide release in
5 bookstores on September 4, 2012.

6 35. Wild has accused HarperCollins and Marr of infringing the Registration.
7 In addition, in reliance on the Registration, Wild has engaged in a public relations
8 campaign against HarperCollins and Marr, accusing them of willful infringement; he
9 has also sent cease and desist notices to reviewers of Defendants' novel, likewise
10 asserting "willful and malicious" infringement of the Registration.

11 36. Defendants believe that they will be damaged by the Registration, both as
12 a result of the public relations campaign described above (which is based largely on
13 the existence of the Registration), and to the extent that Wild is permitted to enforce
14 such Registration in this or any other judicial proceeding.

15 **COUNTERCLAIM COUNT I – CANCELLATION**

16 37. Defendants repeat and hereby incorporate herein by reference, as though
17 specifically pleaded herein, the allegations of paragraphs 1 through 32 of their
18 counterclaim.

19 38. The Registration must be cancelled, in whole or in part, because: (a)
20 Wild has improperly obtained registration of an incomplete mark; (b) Wild has not
21 used the Alleged Mark on a series of literary works (and the Alleged Mark is therefore
22 generic and unregistrable for such goods); (c) Wild has not used the Alleged Mark in
23 connection with the identified services; and (d) Wild committed fraud on the United
24 States Patent and Trademark Office in prosecuting the application that led to the
25 Registration.

26 WHEREFORE, Defendants pray for the following relief:

27 A. that Wild take nothing on its First Amended Complaint and that
28

1 judgment be entered in favor of the Defendants;

2 B. that judgment be entered in favor of the Defendants and against Wild
3 the Defendants' counterclaim;

4 C. that the Court order the cancellation of U.S. Trademark Registration
5 No. 3,921,658;

6 D. that, due to the exceptional nature of this action, the Court award
7 Defendants their reasonable attorney's fees pursuant to 15 U.S.C. § 1117(a) or as
8 otherwise permitted by law;

9 E. that the Court award Defendants their costs incurred in connection with
10 this action; and

11 F. that the Court award or order such other relief as the Court may deem
12 just and equitable.

13
14 Dated: December 13, 2012

Respectfully submitted,
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Date: November 29, 2012

Title: Jazan Wild v. HarperCollins Publishers, LLC, et al.

Present: **Honorable JOSEPHINE STATON TUCKER, UNITED STATES DISTRICT JUDGE**

Ellen Matheson
Deputy Clerk

N/A
Court Reporter

ATTORNEYS PRESENT FOR PLAINTIFF: ATTORNEYS PRESENT FOR DEFENDANT:

Not Present

Not Present

**PROCEEDINGS: (IN CHAMBERS) ORDER GRANTING IN PART AND
DENYING IN PART DEFENDANTS' MOTION TO DISMISS (Doc.
18)**

Before the Court is a Motion to Dismiss Plaintiff's First Amended Complaint ("Motion") filed by Defendants HarperCollins Publishers, LLC ("HarperCollins") and Melissa Marr ("Marr") (collectively, "Defendants"). (Mot., Doc. 18.) Plaintiff Jazan Wild, dba Carnival Comics ("Plaintiff" or "Wild") filed an opposition (Opp'n, Doc. 35), and Defendants replied. (Reply, Doc. 40.) Having heard oral argument and having taken the matter under submission, and for the reasons stated below, the Court GRANTS in part and DENIES in part Defendants' Motion.

I. Background

The following facts are drawn from Plaintiff's First Amended Complaint ("FAC"), and for purposes of a motion to dismiss we assume them to be true. *See Hemi Grp., LLC v. City of New York*, 130 S. Ct. 983, 986-87 (2010). Since 2004, Plaintiff has published and sold a series of comic books, graphic novels, novels, and multimedia publications under the trademark "Carnival of Souls." (FAC ¶ 10.) Through extensive promotion and use of Plaintiff's Carnival of Souls trademark, the public has come to know Wild as the exclusive source of such works. *Id.* Wild is the owner of United States Trademark Registration No. 3,921,658, granted by the U.S. Patent and Trademark Office ("USPTO") on February 22, 2011, for use of the mark "Carnival of Souls" in International Class 16

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for “comic books; graphic novels; [and] novels” and in International Class 41 for “multimedia publishing of books, magazines, journals, software, games, and electronic publications.” (FAC Ex. 1, Doc. 16-1.) Plaintiff further asserts that he has common law trademarks in the phrases “enter the carnival” and “enter the carnival of souls.” (FAC ¶¶ 13-18.) Plaintiff’s works are famous in the United States and abroad. (FAC ¶¶ 32, 39.) Plaintiff asserts in his FAC that Carnival Comics has had “over 1 million books downloaded on Nokia, Blackberry, Android, iPhone and iPad devices, most of which were published and sold by Carnival Comics under the trademark ‘Carnival of Souls.’” (FAC ¶ 20.) As one example of Plaintiff’s fame and the distinctiveness of his marks, Plaintiff asserts that his books have frequently reached the # 1 spot on Amazon Kindle’s digital bookstore.¹ (FAC ¶ 53.) Plaintiff also cites prominent celebrity promotions, favorable publicity, and popular signings at well-known comic book stores. (FAC ¶¶ 19-45.) Plaintiff states that he launched the latest novel in his series on July 4, 2012. (FAC ¶ 57.)

Meanwhile, in the summer of 2012, Defendants promoted and HarpersCollins published a book authored by Marr entitled “Carnival of Souls.” (*See, e.g.*, FAC ¶ 124.) On June 18, 2012, upon learning of the alleged infringement, Plaintiff contacted HarperCollins. (FAC ¶ 95.) On June 19 and June 20, 2012, Plaintiff sent HarperCollins two cease and desist letters. (FAC ¶¶ 98-99.) On August 28, 2012, Plaintiff filed a First Amended Complaint (“FAC”), asserting federal claims for (1) trademark infringement, (2) unfair competition, (3) false description, (4) reverse confusion, and (5) trademark dilution arising under §§ 32 and 43 of the Lanham Act, 15 U.S.C. § 1141(1), and 15

¹ Plaintiff attaches Amazon.com printouts of Amazon Kindle rankings in the category “comics and graphic novels.” (*See* FAC Ex. 30, Doc. 16-2.) In Defendants’ Second Request for Judicial Notice, Defendants request that the Court take judicial notice of (1) Amazon.com printouts containing the Amazon.com Kindle ranking for each of Plaintiff’s works in Amazon’s uncategorized bestseller list, and (2) Mattel’s registered trademark for “Barbie goods and services.” (Doc. 42.) This matter comes to the Court as a 12(b)(6) motion to dismiss, and the Court does not intend to convert it to a motion for summary judgment based on competing printouts from the Internet. Accordingly, the Court denies Defendants’ request, and treats Plaintiff’s complaint as containing allegations only, not evidence.

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U.S.C. § 1125(a). Plaintiff asserts California state law claims for (1) unjust enrichment and injury to business reputation, and (2) common law trademark infringement. In particular, Plaintiff alleges that Defendants willfully infringed Plaintiff's trademark in order to target the same young adult audience using identical subject matter ("a supernatural carnival, supernatural beings such as witches, and . . . love story elements and violence"). (FAC ¶¶ 131-32.)

Defendants move to dismiss the FAC with prejudice on the basis that (1) Wild's claims fail because he possesses no valid trademark rights, and (2) HarperCollins' book title is protected by the First Amendment.

II. Legal Standard

A motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) tests the legal sufficiency of the claims asserted in the complaint. *See Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Rule 12(b)(6) is read in conjunction with Federal Rule of Civil Procedure 8(a), which requires only "a short and plain statement of the claim showing that the pleader is entitled to relief." Fed. R. Civ. P. 8(a)(2). When evaluating a Rule 12(b)(6) motion, the district court must accept all material allegations in the complaint as true and construe them in the light most favorable to the non-moving party. *See Moyo v. Gomez*, 32 F.3d 1382, 1384 (9th Cir. 1994). To survive a motion to dismiss, a plaintiff must allege "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). "The plausibility standard is not akin to a 'probability requirement,' but it asks for more than a sheer possibility that a defendant has acted unlawfully." *Iqbal*, 556 U.S. at 678 (quoting *Twombly*, 550 U.S. at 556).

III. Discussion

A. Request for Judicial Notice ("RJN")

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Defendants ask the Court to take Judicial Notice of (1) Complete copy of the novel by Jazan Wild entitled “Carnival of Souls,” downloaded from Amazon.com on September 7, 2012; (2) Complete copy of the graphic novel by Jazan Wild entitled “Carnival of Souls,” downloaded from Amazon.com on August 31, 2012; (3) Complete copy of “Jazan Wild’s Carnival of Souls – Welcome to the Show,” downloaded from Amazon.com on August 31, 2012; (4) Complete copy of “Jazan Wild’s Carnival of Souls – Everyone Loves a Clown,” downloaded from Amazon.com on August 31, 2012; (5) A complete copy of “Jazan Wild’s Carnival of Souls – All Hell’s Breaking Loose,” downloaded from Amazon.com on August 31, 2012; and (6) Complete copy of Melissa Marr’s novel, “Carnival of Souls.” (RJN Exs. A-E, V, Doc. 19.) In a Rule 12(b)(6) motion to dismiss, a court “may consider evidence on which a complaint necessarily relies if: (1) the complaint refers to the document; (2) the document is central to the plaintiff’s claim; and (3) no party questions the authenticity of the copy attached to the 12(b)(6) motion. The court may treat such a document as part of the complaint, and thus may assume that its contents are true for purposes of a motion to dismiss under Rule 12(b)(6).” *Marder v. Lopez*, 450 F.3d 445, 448 (9th Cir. 2006) (citations and quotation marks omitted). As the parties’ works are central to Plaintiff’s claims of trademark infringement and no party questions the authenticity of the documents, the Court grants Defendants’ request with respect to Exhibits A-E.²

B. Validity of Plaintiff’s Trademarks

Defendants assert that Plaintiff’s claims must be dismissed in their entirety because the FAC fails to allege a claim of valid trademark ownership that is plausible on its face. (Mot. at 9 (citing *Iqbal*, 556 U.S. at 678).) Because different presumptions apply to registered and unregistered trademarks, the Court will consider each in turn.

² Defendants also ask the Court to take judicial notice of 16 printouts from Amazon.com showing books, movies, songs, and albums, including comic books and a graphic novel, titled “carnival of souls.” Because these documents do not meet the requirements of the 3-part *Marder* test, the Court denies Defendants’ request.

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1. Plaintiff's Registered Mark

Plaintiff's registered "Carnival of Souls" trademark is "prima facie evidence of validity," and the burden shifts to Defendants to rebut Plaintiff's prima facie case. *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002) ("[T]he plaintiff in an infringement action with a registered mark is given the prima facie or presumptive advantage on the issue of validity, thus shifting the burden of production to the defendant to prove otherwise.").

Defendants argue that Plaintiff's "Carnival of Souls" trademark is invalid because Plaintiff cannot, as a matter of law, trademark "a single novel and a single (albeit serialized) graphic novel." (Mot. at 9.) According to Defendants, Plaintiff uses his trademark in connection with the following: (1) a single novel published under the title "Carnival of Souls"; (2) a single graphic novel published under the title "Carnival of Souls,"; and (3) three comic books "that are simply serially-issued chapters of, and entirely subsumed in, Wild's Graphic Novel."³ (*Id.* at 4.)

The USPTO does not register trademarks for the title of a single work. Trademark Manual of Examining Procedure ("TMEP") § 1202.08 ("The title of a single creative work is not registrable on either the Principal or Supplemental Register."). *See also* Application of Cooper, 254 F.2d 611 (1958) (holding that the title of a single book cannot be registered). However, "the title of a *series* of related works may be granted protection . . . because it often designates a particular publishing house, editor, or author." Callmann on Unfair Comp., Tr. & Mono. § 18:72 (4th Ed.) (emphasis added). *See also In re*

³ Plaintiff's comic book "Welcome to the Show" can be found on pages 26 to 58 and 201 of Wild's Graphic Novel, (*see* RJN Exs. C, at 607-641; B, at 431-63, 606); Plaintiff's comic book "Everyone Loves a Clown" can be found on pages 71 to 103 and 201 of Wild's Graphic Novel, (*see* RJN Ex. D, at 642-676; Ex. B, at 476-508, 606); and Plaintiff's comic book "All Hell's Breaking Loose" can be found on pages 138 to 165 and 201 of Wild's Graphic Novel, (*see* RJN Ex. E, at 677-706; Ex. B, at 543-570, 606).

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Appleby, 159 USPQ 126 (TTAB 1968) (title of a series of records can function as a trademark); *In re Scholastic, Inc.*, 23 USPQ 2d 1774 (TTAB 1992) (title of series of children's books "The Magic School Bus" registrable because the title, "as used on books, would be recognized as a trademark identifying a series of children's books emanating from applicant"). The TMEP distinguishes the title of a series from a title of a single work as follows:

Generally, any creative work will not be considered a single creative work if evidence exists that it is part of a series (e.g., the work is labeled "volume 1," "part 1," or "book 1") or is a type of work in which the content changes with each issue or performance. For example, single creative works do not include periodically issued publications, such as magazines, newsletters, comic books, comic strips, guide books, and printed classroom materials, because the content of these works changes with each issue.

A book with a second or subsequent edition in which the content changes *significantly* is not regarded as a single creative work.

TMEP §§ 1202.08(b) (7th ed. 2011).

The USPTO has explained that the titles of a series can be afforded trademark protection because "[t]he name for a series, at least while it is still being published, has a trademark function in indicating that each book of the series comes from the same source as the others. The name of the series is not descriptive of any book and each book has its individual name or title." *In re Scholastic Inc.*, 23 USPQ 2d at 1776.

Defendants do not dispute that federal trademark registration is available for the title of a series, (*see* Mot. at 5-6), and the Court will not conclude, as a matter of law, that Plaintiff's works are "single" or "serialized." Because Plaintiff has pleaded facts sufficient to show that his work is a series, Defendants' Motion to Dismiss on the basis of trademark invalidity is denied.

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2. Validity of Plaintiff's Claimed Common Law Trademarks

“A trademark is defined in 15 U.S.C. § 1127 as . . . ‘any word, name, symbol, or device or any combination thereof’ used by any person ‘to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.’” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (quoting 15 U.S.C. § 1127). Unregistered marks can be protected under section 43(a) of the Lanham Act, but they are not entitled to a presumption of validity. *See Toho Co., Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788, 790 (9th Cir. 1981). It is settled that “courts look to the general principles qualifying a mark for registration . . . when determining whether an unregistered mark is protectable.” *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n.7 (9th Cir. 1998). “In order to be registered, a mark must be capable of distinguishing the applicant’s goods from those of others.” *Two Pesos*, 505 U.S. at 768 (citing 15 U.S.C. § 1052). Marks are often classified in order of increasing distinctiveness as: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. *See id.* “Suggestive, arbitrary, and fanciful marks are considered inherently distinctive and are automatically entitled to federal trademark protection . . .” *Zobmondo Entm’t, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir. 2010) (internal quotation marks omitted). Generic marks are not eligible for trademark protection. *Id.* Descriptive marks are entitled to protection if they have “acquired distinctiveness ‘as used on or in connection with the applicant’s goods in commerce.’” *Id.* (citing 15 U.S.C. § 1052(f)).

Here, Plaintiff claims unregistered trademarks in the phrases “enter the carnival” and “enter the carnival of souls”—phrases which appear on Plaintiff’s website and comic book cover art in connection with his “Carnival of Souls” works. (*See, e.g.*, RJN Ex. 40A-E; Ex. 153, Doc. 30-7; Ex. 156, Doc. 30-9.) Defendants argue that Plaintiff’s unregistered marks are invalid as a matter of law and asked the Court to dismiss Plaintiff’s claims on this basis. However, “the issue of trademark validity is considered ‘an intensely factual issue,’ and “[w]hich category a mark belongs to is a question of fact,” not law. *Zobmondo*, 602 F.3d at 1113 (citations omitted). Accordingly, the

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validity of Plaintiff's unregistered marks is not a matter that the Court will resolve on a motion to dismiss. The Court denies Defendants' Motion to Dismiss the claims in Plaintiff's FAC that are based on Plaintiff's unregistered marks.

C. The First Amendment

Defendants argue that Plaintiff's claims must be dismissed because Marr's book title is protected by the First Amendment. The Ninth Circuit has held that the "likelihood-of-confusion test generally strikes a comfortable balance between the trademark owner's property rights and the public's expressive interests. But when a trademark owner asserts a right to control how we express ourselves—when we'd find it difficult to describe the product any other way (as in the case of aspirin), or when the mark (like Rolls Royce) has taken on an expressive meaning apart from its source-identifying function—applying the traditional test fails to account for the full weight of the public's interest in free expression." *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (citation omitted).

Defendants rely on *Mattel* for the proposition that "literary titles do not violate the Lanham Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work." *Id.* at 902 (adopting the standard in *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)). In *Rogers*, the Second Circuit stated:

We believe that in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic

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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.

Rogers, 875 F.2d at 998.

The *Rogers* court added the express qualification that “[t]his limiting construction would not apply to misleading titles that are confusingly similar to other titles. The public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.” *Id.* at 999 n.5 (emphasis added). Plaintiff alleges that Defendants deliberately chose a confusingly identical title for its competing book in the same genre. As noted in *Rogers*: “Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection. Nonetheless, they are also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some government regulation.” *Id.* at 997.

Here, there is a factual question as to whether Defendants’ book is likely to confuse consumers as to the origin of its source. The Court cannot determine, as a matter of law, that it does not.

D. Defendants’ Motion to Dismiss Plaintiff’s Fifth Claim for Trademark Dilution

Defendants argue that Plaintiff’s claim for trademark dilution under § 43(a) of the Lanham Act must be dismissed because trademark dilution claims are not actionable against “[a]ny noncommercial use of a mark,” 15 U.S.C. § 1125(c)(3), such as the title of Marr’s “Carnival of Souls” novel. (Mot. at 15.) Plaintiff did not address this aspect of Defendants’ Motion in his Opposition and the Court agrees with Defendants that the claim must be dismissed.

When Congress amended the Lanham Act by enacting the Federal Trademark Dilution Act, it created a federal cause of action for trademark dilution that specifically

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exempted “noncommercial use.” *Mattel*, 296 F.3d at 903. Borrowing the Supreme Court’s definition of commercial speech in the context of the First Amendment, the Ninth Circuit has held that the trademark dilution noncommercial speech exemption applies to speech that “is not purely commercial” in that it “does more than propose a commercial transaction.” *Id.* at 906. In *Mattel*, the Ninth Circuit found that although the popular song “Barbie Girl” by the Danish pop band Aqua was sold commercially, the song was not “purely commercial” because it “also lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents.” *Id.* at 906-907. Similarly, Marr’s “Carnival of Souls” novel clearly has an artistic component and “does more than propose a commercial transaction” despite the fact that it is sold commercially. The inside jacket of Marr’s book cover describes “a city of Daimons” where “rigid class lines separate the powerful from the power-hungry. And at the heart of The City is the Carnival of Souls, where both murder and pleasure are offered up for sale.” (RJN Ex. V.) Because the title of Marr’s novel is a “noncommercial use of a mark,” the Court grants Defendants’ Motion to Dismiss Plaintiff’s fifth claim for trademark dilution.

IV. Conclusion

For the foregoing reasons, the Court DENIES Defendants’ Motion to Dismiss Plaintiff’s (1) federal claims for trademark infringement, unfair competition, false description, and reverse confusion; and (2) Plaintiff’s state law claims for unjust enrichment and injury to business reputation and common law trademark infringement. The Court GRANTS Defendants’ Motion to Dismiss Plaintiff’s fifth claim for trademark dilution under 15 U.S.C. § 1125.

Initials of Preparer: enm