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14 FILMS, INC.; AGGRESSIVE MEDIOCRITY,
15 INC.; and TOM KAPINOS

16
17 **UNITED STATES DISTRICT COURT**
18
19 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

20 ANTHONY KIEDIS; CHAD SMITH;
21 JOHN FRUSCIANTE; MICHAEL
22 "FLEA" BALZARY, dba RED HOT
23 CHILI PEPPERS,

24 Plaintiffs,

25 v.

26 SHOWTIME NETWORKS INC., a
27 Delaware corporation; TWILIGHT
28 TIME FILMS, INC., a California
corporation; AGGRESSIVE
MEDIOCRITY, INC., a California
corporation; TOM KAPINOS; DOES 1-
100,

Defendants.

CASE NO. CV 07-08185 DSF (FFMx)
Honorable Dale S. Fischer

**DEFENDANTS' NOTICE OF
MOTION AND MOTION TO
DISMISS FOR FAILURE TO STATE
A CLAIM; AND MEMORANDUM
OF POINTS AND AUTHORITIES**

[Request for Notice of Incorporated Documents and Request for Judicial Notice; Declarations of Frank Pintauro, William I. Fowkes, and Michael D. Roth; and Exhibits filed herewith]

Date: February 4, 2008
Time: 1:30 p.m.
Location: Courtroom 840
Roybal Federal Building
255 East Temple Street
Los Angeles, CA 90012

1 **TO ALL PARTIES AND THEIR COUNSEL OF RECORD:**

2 PLEASE TAKE NOTICE that on February 4, 2008, at 1:30 p.m., or as soon
3 thereafter as the matter may be heard in Courtroom 840 of the above-entitled Court,
4 located at 255 East Temple Street, Los Angeles, California, 90012, Defendants
5 Showtime Networks Inc., Twilight Time Films, Inc., Aggressive Mediocrity, Inc.,
6 and Tom Kapinos (collectively "Defendants") will and hereby do, move pursuant to
7 Federal Rule of Civil Procedure 12(b)(6) to dismiss the Complaint filed by Plaintiffs
8 Anthony Kiedis, Chad Smith, John Frusciante, and Michael "Flea" Balzary, dba Red
9 Hot Chili Peppers.

10 This Motion is made on the grounds that each cause of action alleged in the
11 Complaint fails to state a claim on which relief can be granted. Specifically:

- 12 • The first and second causes of action alleging unfair competition based
13 on false designation of origin under 15 U.S.C. § 1125(a) and California
14 Business & Professions Code § 17200 fail because Plaintiffs have not
15 pled, and cannot plead, that the title of Defendants' television series,
16 *Californication*, or the compilation soundtrack of music from the
17 series, *Temptation – music from the Showtime series Californication*,
18 have no artistic relevance to the underlying work or are explicitly
19 misleading as to source or content.
- 20 • Plaintiffs' third and fourth claims for trademark dilution under 15
21 U.S.C. § 1125(c) and California Business & Professions Code § 14330
22 fail because the television series and its soundtrack are noncommercial
23 works entitled to First Amendment protection and are thus expressly
24 exempted from the dilution statutes. *E.g.*, 15 U.S.C.
25 § 1125(c)(3)(C)(exempting "noncommercial uses" of a mark from the
26 dilution statute); *Panavision Int'l, L.P. v. Toepfen*, 141 F.3d 1316,
27 1324 (9th Cir. 1998) (holding that a state law dilution claim "is subject
28 to [the] same analysis" as a claim brought under federal law).

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1 **I. INTRODUCTION**

2 The term “Californication” is a play on words – a conflation of the words
 3 “California” and “fornication.” The term describes perfectly the critically-
 4 acclaimed¹ Showtime television series *Californication* (the “Series”), in which the
 5 lead character, a recently-transplanted New York novelist, engages in a series of
 6 empty sexual encounters in an attempt to compensate for his rage and frustration at
 7 his betrayal by the Hollywood studio who turned his work of serious literature into
 8 a cheesy film, his abandonment by his ex-girlfriend who has ended their
 9 relationship to marry another man, his struggle to raise his daughter as a part-time
 10 father, and his inability to comprehend the decadence and futility of the Southern
 11 California show business lifestyle. Because the title relates directly to the
 12 substance of the Series and is not explicitly misleading as to source or content, the
 13 use of the term “Californication” as the title of an expressive work is protected by
 14 the First Amendment. Accordingly, Plaintiffs cannot state a claim under trademark
 15 law and the Complaint must be dismissed.

16 The term “Californication” has been around for decades. In 1972, Time
 17 magazine published a story entitled “The Great Wild Californicated West.”
 18 Request for Notice of Incorporated Documents and Request for Judicial Notice
 19 (“Notice”), Exh. I. At about the same time, cars sported bumper stickers
 20 proclaiming “Don’t Californicate Colorado.” *Id.* In the early 1980s, The J. Geils
 21 Band recorded a song by the title of “Californicatin’,” Notice, Exh. D, and there are
 22 at least three other registered copyrights for print and sound recordings from the
 23 1980s and 1990s that include a form of the word “Californication.” *See* Notice,
 24 Exhs. E-G. In 1999, Plaintiffs Anthony Kiedis, Chad Smith, John Frusciante, and
 25

26
 27 ¹ *Californication* was recently nominated for two Golden Globe awards:
 28 (1) Best Television Series – Comedy or Musical; and (2) Best Performance By An
 Actor In A Comedy Series – David Duchovny.

1 Michael “Flea” Balzary doing business as the “Red Hot Chili Peppers”
2 (collectively “Plaintiffs” or “RHCP”), *see* Compl., ¶ 5, used “Californication” as
3 the title of a song and album. Notice, Exh. H. And in 2007, Defendants Showtime
4 Networks Inc. used the term as the title of the Showtime television series
5 *Californication* (the “Series”).

6 Through their lawsuit, Plaintiffs now attempt to monopolize all uses of the
7 word “Californication,” which they did not coin and which has long been used in
8 the popular lexicon. Plaintiffs allege that Defendants Showtime Networks Inc.,
9 Twilight Time Films, Inc., Aggressive Mediocrity, Inc. and Tom Kapinos
10 (collectively “Defendants”) violated Plaintiffs’ purported trademark rights in the
11 word “Californication” by using it as the title of the Series and by referring to
12 “Californication” in the title of the compilation soundtrack from the Series,
13 *Temptation – music from the Showtime series Californication* (the “Soundtrack”).
14 When evaluated under the specialized body of trademark law that has developed
15 with respect to titles of artistic works, however, Plaintiffs’ claims fail as a matter of
16 law.

17 Plaintiffs have not alleged – and cannot allege – facts that would trump
18 Defendants’ First Amendment rights to use the term “Californication” as the
19 Series’ title. *Californication* is the story of Hank Moody, a writer who relocates
20 from New York to California so that his book can be adapted to the screen. It
21 follows his personal struggles with the evisceration of his novel by the studio that
22 adapted it, the shallowness of the Hollywood lifestyle, and his own writer’s block,
23 which he attempts to deal with through a series of empty sexual encounters with
24 beautiful women, all the while longing to reconcile with his ex-girlfriend and their
25 daughter. The Series thus concerns both California *and* fornication, and the
26 *Californication* title accurately reflects these themes. Similarly, the Soundtrack’s
27 title expressly states that the Soundtrack contains music from the Series. Because
28 both titles are artistically relevant to their underlying works and are not misleading

1 as to the source or content of those works, Plaintiffs cannot state a claim for
 2 trademark infringement. *See Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894,
 3 902 (9th Cir. 2002) (hereinafter “*Mattel*”).

4 Plaintiffs’ claims for trademark dilution under state and federal law also fail.
 5 The title of a television series is noncommercial expressive speech protected by the
 6 First Amendment and explicitly exempted from the Federal Trademark Dilution Act
 7 and its California state law counterpart. *See* 15 U.S.C. § 1125(c)(3)(C); *Panavision*
 8 *Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1324 (9th Cir. 1998) (holding that a state law
 9 dilution claim “is subject to [the] same analysis” as a claim brought under Federal
 10 law). Plaintiffs therefore cannot state a claim for trademark dilution based on
 11 Defendants’ use of “Californication” as the title of the Series or as part of the title of
 12 the Soundtrack.

13 Finally, Plaintiffs’ fifth claim for unjust enrichment is based entirely on
 14 Defendants’ alleged unfair competition and trademark dilution, *see* Compl., ¶¶ 51-
 15 52, and thus must be dismissed along with those claims.

16 **II. PLAINTIFFS’ FACTUAL ALLEGATIONS²**

17 In 1999, the RHCP authored a song entitled *Californication* (the “Song”).
 18 *Id.* at ¶¶ 12-13. The Song was released on an album of the same name (the
 19 “Album”) and later released as a single. *Id.* at ¶ 13. Plaintiffs allege that the Song
 20 and the Album have enjoyed extraordinary critical and commercial success. *Id.* at
 21 ¶¶ 14-18.

22 Plaintiffs further allege that, in late 2007, Defendants began producing,
 23 creating, distributing, and airing the Series. *Id.* at ¶ 19. They also allege that
 24 Defendants have created and distributed a musical compilation album of songs
 25
 26

27 ² Defendants accept Plaintiffs’ pretrial allegations as true solely for purposes
 28 of this Motion.

1 used on the Series that also contains the word “Californication” in the title. *Id.* at
2 ¶ 22.

3 Plaintiffs contend that, by using the term *Californication* as the title of the
4 Series and by using the word “Californication” in the title of the Soundtrack,
5 Defendants have infringed Plaintiffs’ rights under the Lanham Act and state law.³
6 Plaintiffs assert claims for unfair competition under section 43(a) of the Lanham
7 Act and Business & Professions Code § 17200, trademark dilution under section
8 43(c) of the Lanham Act and California Business & Professions Code § 14330, and
9 unjust enrichment.⁴ Compl., ¶¶ 24-52.

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15 ³ Plaintiffs do not allege that they have registered “Californication” as a
16 federal trademark. Accordingly, serious questions exist as to whether Plaintiffs
17 have standing to allege *any* claims here as they do not allege ownership of any of
18 the musical compositions, rights that likely rest with their recording company and
19 music publishers. *See* Notice, Exh. G. Defendants recognize, however, that
20 unregistered marks may sometimes be protectible under section 43 of the Lanham
21 Act and state law. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763,
22 768 (1992); *Murray v. Cable Nat’l Broadcasting Co.*, 86 F.3d 858 (9th Cir. 1996).
Defendants therefore are not requesting that the Court address the issue of
Plaintiffs’ standing at this juncture, but reserve the right to challenge Plaintiffs’
standing in the future.

23 ⁴ The Complaint also alleges that “a recurring character in the Series is
24 named or nicknamed and/or referred to as ‘Dani California,’” the name of a
25 character in three RHCP songs and the title of one RHCP song. Compl., ¶ 20.
26 Plaintiffs do not, however, allege that the name “Dani California” has secondary
27 meaning or is famous, nor do they base any of their claims on Defendants’ alleged
28 reference to “Dani California.” *See* Compl., ¶¶ 25-26, 32-33, 39-41, 45-47 (basing
claims on use of “Californication”). Accordingly, these allegations are not further
addressed in this Motion.

1 **III. LEGAL STANDARD UNDER FEDERAL RULE OF CIVIL**
2 **PROCEDURE 12(B)(6)**

3 A motion to dismiss for failure to state a claim under Federal Rule of Civil
4 Procedure 12(b)(6) tests the legal sufficiency of a claim. *Conley v. Gibson*, 355
5 U.S. 41, 45-46 (1957), *abrogated on other grounds, Bell Atl. Corp. v. Twombly*, ___
6 U.S. ___, 127 S.Ct. 1955 (2007). Dismissal is appropriate where the claim lacks a
7 cognizable legal theory or where insufficient facts are alleged to support the theory
8 on which it is based. *Balistreri v. Pacifica Police Dep't*, 901 F.2d 696, 699 (9th
9 Cir. 1990). Although a complaint need not contain detailed factual allegations, the
10 plaintiff must plead more than “labels and conclusions” or “formulaic recitation[s]
11 of the elements of a cause of action” in order to survive a motion to dismiss. *Bell*,
12 127 S.Ct. at 1964-65 (citations omitted). The complaint must plead “enough facts
13 to state a claim to relief that is plausible on its face.” *Id.* at 1974. If a complaint is
14 vague and conclusory or if it fails to set forth sufficient material facts in support of
15 the allegations, dismissal is appropriate. *See North Star Int'l v. Arizona Corp.*
16 *Comm'n*, 720 F.2d 578, 583 (9th Cir.1983); *see also Murray v. Cable Nat'l*
17 *Broadcasting Co.*, 86 F.3d at 860-61 (court is not precluded from determining
18 likelihood of confusion as a matter of law); *Toho Co., Ltd. v. Sears, Roebuck &*
19 *Co.*, 645 F.2d 788, 790-91 (9th Cir. 1981) (finding no likelihood of confusion as a
20 matter of law); *Burnett v. Twentieth Century Fox Film Corp.*, 491 F.Supp.2d 962
21 (2007) (Pregerson, J.) (granting motion to dismiss because there was no likelihood
22 viewers would be confused and because television show was noncommercial
23 speech not subject to trademark dilution claim).

24 Although a court ruling on a 12(b)(6) motion cannot ordinarily consider
25 material outside the complaint, the court may consider exhibits submitted with the
26 complaint. *Branch v. Tunnell*, 14 F.3d 449, 453-54 (9th Cir. 1994), *overruled on*
27 *other grounds by Galbraith v. County of Santa Clara*, 307 F.3d 1119, 1127 (9th
28 Cir. 2002). The court may also consider documents that are not physically attached

1 to the complaint but on which the complaint relies if the document is central to the
 2 plaintiff's claim and the authenticity of the document is not questioned. *Sanders v.*
 3 *Brown*, 504 F.3d 903, 910 (9th Cir. 2007). Accordingly, the Court can consider the
 4 DVDs depicting the content of the Series as well as the Soundtrack artwork, as
 5 those documents underlie Plaintiffs' claims, are repeatedly referenced in the
 6 Complaint, and their authenticity cannot reasonably be questioned.⁵ *See* Compl.,
 7 ¶¶ 19-23, 26-28, 32-35, 40-41, 46-47, 51 and Defendants' Request for Notice of
 8 Incorporated Documents and Request for Judicial Notice ("Notice") filed
 9 concurrently herewith. The Court may also consider matters subject to judicial
 10 notice under Federal Rule of Evidence 201. *Swartz v. KPMG LLP*, 476 F.3d 756,
 11 763 (9th Cir. 2007).

12 **IV. EACH OF PLAINTIFFS' CLAIMS FAILS AS A MATTER OF LAW**

13 **A. *The First Amendment Prohibits the Use of Trademark Claims To*** 14 ***Quash Communication of Ideas or Points of View***

15 Although trademark protection may exist when a term is used to identify a
 16 manufacturer or service provider of specific goods, that protection does not entitle
 17 the owner of a mark "to quash an unauthorized use of the mark by another who is
 18 communicating ideas or expressing points of view." *Mattel*, 296 F.3d at 900
 19 (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987));
 20 *see Cohen v. California*, 403 U.S. 15, 26 (1971) (holding, in free speech context:

21
 22 ⁵ Concurrent with this Motion, Defendants have also filed a Request for
 23 Notice of Incorporated Documents and Request for Judicial Notice ("Notice").
 24 Attached as Exhibits to the Notice are (1) a DVD containing an eight-minute
 25 promotional compilation of clips from the television series *Californication* (Exh.
 26 A); (2) a complete set of the first season of *Californication* on DVDs (Exh. B); and
 27 (3) a printout of the Soundtrack's cover art from iTunes. Exh. C. As set forth in
 28 the Notice, under the "incorporation by reference doctrine" recognized by the
 Ninth Circuit, the Court may consider the DVDs and the title of the Soundtrack in
 ruling on this Motion to Dismiss.

1 “[W]e cannot indulge the facile assumption that one can forbid particular words
2 without also running a substantial risk of suppressing ideas in the process.”).
3 Accordingly, trademark law must be narrowly construed to avoid intrusion on First
4 Amendment values. *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989).
5 Otherwise, trademark rights would soon swallow up constitutionally-protected
6 expressive conduct.

7 ***B. Plaintiffs’ Claims Based on False Designation of Origin Fail***
8 ***Because Defendants’ Use Is Protected by the First Amendment***

9 Plaintiffs’ Complaint represents precisely the kind of impermissible effort to
10 quash expressions of ideas that the Ninth Circuit prohibited in *Mattel*. Plaintiffs’
11 first and second causes of action allege unfair competition based on false
12 designation of origin under section 43(a) of the Lanham Act (15 U.S.C. § 1125(a))
13 and section 17200 of the California Business & Professions Code. Section 43(a)
14 prohibits any person from using any word, term, name or symbol or any false
15 designation of origin in connection with goods or services that is likely to cause
16 confusion or to deceive as to the affiliation, connection, origin or sponsorship of
17 such goods. 15 U.S.C. § 1125(a). Section 17200 prohibits “unlawful, unfair, or
18 fraudulent business practices and unfair, deceptive, untrue or misleading
19 advertising.” Bus. & Prof. Code § 17200; *Blank v. Kirwan*, 39 Cal.3d 311, 329
20 (1985).

21 As discussed below, these statutes must be narrowly construed in the context
22 of creative expression to avoid intrusion on First Amendment values. *Rogers*, 875
23 F.2d at 998. Applying this narrowed construction, each of Plaintiffs’ claims fails
24 as a matter of law.

1 **1. Expressive Titles Are Not Actionable Unless the Title Has**
2 **No Relevance to the Underlying Work or Is Explicitly**
3 **Misleading as to the Source or Content of the Work**

4 Movies, plays, books and songs are all works of artistic expression entitled
5 to First Amendment protection. *Rogers*, 875 F.2d at 998. Titles serve a dual
6 purpose: combining artistic expression and commercial promotion. *Id.* “The title
7 of a movie may be both an integral element of the film-maker’s expression as well
8 as a significant means of marketing the film to the public.” *Id.*

9 “Consumers of artistic works [also] have a dual interest: They have an
10 interest in not being misled and they also have an interest in enjoying the results of
11 the author’s freedom of expression.” *Id.* “Consumers expect a title to
12 communicate a message about the book or movie, but they do not expect it to
13 identify the publisher or producer.” *Mattel*, 296 F.3d at 902. Accordingly,
14 although consumers may look to the title of a work to determine what it is about,
15 they do not regard titles of artistic works in the same way they do the names of
16 ordinary commercial products. *Id.* Thus, the concerns that drive the ordinary false
17 designation of origin case do not apply in the case of literary titles in the same way:
18 “[M]ost consumers are well aware that they cannot judge a book solely by its title
19 any more than by its cover.” *Id.*

20 In *Rogers*, the Second Circuit devised a test that balances the right of the
21 trademark owner to prevent confusion against the free speech rights of the creator
22 of an expressive work. 875 F.2d at 999. In *Rogers*, actress Ginger Rogers brought
23 suit against the producers and distributors of the movie *Ginger and Fred*, which
24 told the story of two fictional Italian cabaret dancers who imitated Rogers and her
25 long-time professional partner Fred Astaire and became known in Italy as “Ginger
26 and Fred.” *Id.* at 996-97. Rogers argued that the film’s title created the false
27 impression that she was associated with the film. *Id.* at 997.

1 The Second Circuit rejected Rogers' argument, holding that the Lanham Act
2 applied only where the public interest in avoiding consumer confusion outweighs
3 the public interest in free expression. *Id.* at 999. To achieve that balance, the court
4 held that *literary titles do not violate the Lanham Act* unless (1) the title has no
5 artistic relevance to the underlying work whatsoever; or (2) if it has some artistic
6 relevance, the title explicitly misleads as to the source or content of the work. *Id.*
7 The Second Circuit thus held that the use of "Ginger and Fred" in the film's title
8 was artistic expression protected by the First Amendment because (1) the title had
9 "genuine relevance" to the contents of the film (and was not simply chosen "to
10 exploit the publicity value of [the characters'] real life counterparts") and (2) the
11 title contained no explicit indication that Rogers endorsed the film or had any role
12 in producing it. *Id.* at 1001.

13 The Ninth Circuit has expressly adopted the two-part *Rogers* analysis for
14 literary titles. *Mattel*, 296 F.3d at 902; *see also Twin Peaks Prods., Inc. v.*
15 *Publications Int'l, Ltd.*, 996 F.2d 1366, 1370, 1379 (2d Cir. 1993) (applying
16 *Rogers* analysis to title of television program). In *Mattel*, the maker of the Barbie
17 doll sued the music companies that had produced, marketed and released the song
18 "Barbie Girl" by the band Aqua. *Mattel* alleged that use of the famous Barbie doll
19 trademark in the title of the song constituted trademark infringement and diluted
20 the Barbie mark. 296 F.3d at 899, 901. Applying *Rogers*, the Ninth Circuit first
21 held that the title of the song was clearly relevant to the song, which poked fun at
22 Barbie and the values that the band contended she represented. *Id.* at 902. The
23 court also held that the title did not explicitly mislead as to the source of the work;
24 the title did not suggest, explicitly or otherwise, that it had been produced or
25 sponsored by *Mattel*. *Id.* The only indication that *Mattel* might be associated with
26 the song was the use of "Barbie" in the title, which the court held was simply not
27 enough to satisfy *Rogers*. *Id.* Accordingly, the defendants' use of the Barbie mark
28 did not infringe *Mattel's* trademark.

1 **2. Plaintiffs Have Not, and Cannot, Allege that Californication**
 2 **Has No Artistic Relevance or That it is Explicitly Misleading**

3 Here, Plaintiffs have made no effort to plead any facts that would justify
 4 trampling on Defendants' First Amendment rights of creative expression. They do
 5 not allege that the title *Californication* lacks artistic relevance to the Series or that
 6 it is explicitly misleading as to the Series' source or content. *See* Compl., ¶¶ 25,
 7 32. Instead, Plaintiffs simply allege, in conclusory terms, that the Series and the
 8 Soundtrack have caused "a likelihood of confusion, mistake, and deception as to
 9 source, sponsorship, affiliation, and/or connection in the minds of the public."⁶
 10 Compl., ¶¶ 26-27, 33-34. These allegations are insufficient as a matter of law.
 11 "[W]hen First Amendment interests are implicated, the *Rogers* 'explicitly
 12 misleading' standard applies, not the traditional 'likelihood of confusion' test."
 13 *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 444 F.Supp.2d 1012,
 14 1045 (C.D. Cal. 2006) (Morrow, J.) (citation omitted). Because the Lanham Act
 15 does not apply *unless* the title lacks any artistic relevance to the work or is
 16 explicitly misleading as to the source or content of the work, Plaintiffs' failure to
 17 plead such facts are fatal to Plaintiffs' claims. *See Rogers*, 875 F.2d at 999; *Mattel*,
 18 296 F.3d at 902; *see also Bell*, 127 S.Ct. at 1964-65 (plaintiff must plead "more
 19 than labels and conclusions, and a formulaic recitation of the elements of a cause of
 20 action will not do") (citations omitted).

21
 22
 23 ⁶ Plaintiffs also allege that "Californication" is inherently distinctive and
 24 famous and that it is immediately associated with the RHCP, the Song and the
 25 Album. Compl., ¶¶ 25, 32. While Defendants accept this allegation as true for
 26 purposes of this Motion only, given the origin, history and past uses of the term,
 27 Defendants dispute that the word "Californication" has acquired secondary
 28 meaning or that it is immediately associated with the Song, the Album or the
 RHCP. *See Miller v Glenn Miller Prods., Inc.*, 454 F.3d 975, 991 (9th Cir. 2006)
 (defining secondary meaning).

1 F.Supp.2d at 1041-42 (rejecting infringement claims of strip club owner and
2 holding that defendants' use of the plaintiffs' trade dress and mark in a video game
3 had some "artistic relevance to defendants' twisted, irreverent image of urban Los
4 Angeles").

5 Viewed in the context of these cases, there can be no question that
6 Defendants' use of "Californication" satisfies the artistic relevance prong of the
7 *Rogers* test. The Series is the story of Hank Moody, a writer who suffers an
8 existential and moral crisis after relocating from New York to Los Angeles.
9 Moody engages in a series of empty sexual encounters as he struggles with his
10 hatred of the film adaptation of his novel, his ensuing writers' block, his
11 relationship with his daughter and his attempt to reconcile with his ex-girlfriend,
12 the mother of his child. The title is a play on words, combining "fornication," an
13 activity in which the lead character is depicted on a regular basis, and "California,"
14 the show's geographical and moral backdrop. *See* Notice, Exhs. A, B. The title is
15 thus clearly relevant to the underlying work. *See also, No Fear, Inc. v. Imagine*
16 *Films, Inc.*, 930 F.Supp. 1381, 1384 (C.D. Cal. 1995) (Real, J.) (holding first prong
17 of *Rogers* satisfied where it was "evident and undisputed" that film entitled *No*
18 *Fear* related to content of film).

19 Likewise, the title of the Soundtrack, which contains the term
20 "Californication" is an accurate description of the work. Indeed, there would be no
21 way *other* than to use "Californication" to describe the compilation of music used
22 in the Series. *See* Notice, Exh. C; Compl., ¶ 22. The Soundtrack's title:
23 *Temptation – music from the Showtime series Californication* is thus "artistically
24 relevant" to the Soundtrack and is also protected under the *Rogers* test. *See*
25 *Rogers*, 875 F.2d at 1001.

1 **b) The Title Is Not Misleading as to the Source or**
2 **Content of the Work**

3 Because the title *Californication* is artistically relevant to the substance of
4 the Series, the title is protected by the First Amendment unless the title is *explicitly*
5 misleading as to the source or content of the work. *Rogers*, 875 F.2d at 999.
6 *Californication* is not misleading. To the contrary, it is an accurate reflection of
7 the Series' themes. It does not suggest – explicitly or otherwise – that the Series is
8 about the RHCP, the Song or the Album. *See e.g., Rogers*, 875 F.2d at 1000
9 (noting that “*The True Life Story of Ginger and Fred*” would be misleading as to
10 story about two fictional Italian cabaret dancers). Nor does it signal endorsement
11 by or even association with the RHCP. *See E.S.S. Entertainment*, 444 F.Supp.2d at
12 1045 (holding that video game did not include any explicit indication that
13 trademark owner endorsed the work or had any role in producing it).

14 The District Court's decision in *Burnett*, is instructive. In *Burnett*, actress
15 Carol Burnett brought an action against Fox arising from the depiction in an
16 episode of the animated television series, *Family Guy*, of a “charwoman” character
17 similar to the character created by Burnett. 491 F.Supp.2d at 966. Burnett alleged
18 claims under the Lanham Act and argued that use of the character was likely to
19 cause confusion or to deceive the public as to Ms. Burnett's affiliation with Fox or
20 the *Family Guy* program. *Id.* at 972. In granting the network's motion to dismiss,
21 the court held, as a matter of law, that “the nature of the use does not explicitly
22 mislead the viewer as to affiliation, connection, association with, or sponsorship or
23 approval by plaintiffs.” *Id.* at 973. Because no reasonable viewer would be
24 confused as to source or origin, dismissal was appropriate. *Id.*; *see also Toho*, 645
25 F.2d at 790-91 (court can decide likelihood of confusion as a matter of law);
26 *Murray*, 86 F.3d at 860-61 (same).

27 In this case, *Californication* accurately reflects the substance of the Series
28 and thus, as in *Burnett*, is protected expression not subject to the Lanham Act.

1 Likewise, the title of the Soundtrack, *Temptation – music from the Showtime series*
 2 *Californication*, also makes clear that it is a compilation of music from the Series.
 3 The mere fact that RHCP once used the word as the title of a song and album is not
 4 sufficient, particularly where, as in this case, the word has been a part of the social
 5 lexicon for decades. *See Mattel*, 296 F.3d at 902 (quoting *Rogers*, 875 F.2d at
 6 1000) (noting that “most consumers are well aware that they cannot judge a book
 7 solely by its title any more than by its cover”). Indeed, as the Ninth Circuit held in
 8 *Mattel*, if Plaintiffs’ allegations were sufficient, the *Rogers* test itself would be
 9 rendered a nullity. *See id.* Whatever the minor risk that a few consumers might
 10 initially be under the impression that the Series was somehow connected to the
 11 RHCP, that risk is substantially outweighed by the danger of restricting artistic
 12 expression protected by the First Amendment. *See Rogers*, 875 F.2d at 1000.

13 **C. Plaintiffs’ Trademark Dilution Claims Fail Because Titles of**
 14 **Television Series Are Noncommercial Speech Exempted from the**
 15 **Trademark Dilution Statutes**

16 Because Defendants’ use of the word “Californication” as the title of the
 17 Series is artistic expression protected by the First Amendment, it also is not
 18 actionable under the express terms of the Federal Trademark Dilution Statute
 19 (“FTDA”), 15 U.S.C. § 1125(c) and its California equivalent, California Business
 20 & Professions Code § 14330. *See* 15 U.S.C. § 1125(c)(3)(C); *Panavision*, 141
 21 F.3d at 1324 (holding that a state law dilution claim “is subject to [the] same
 22 analysis” as a claim brought under Federal law).

23 **1. Noncommercial Uses Are Not Actionable Under Federal or**
 24 **State Anti-Dilution Laws**

25 The doctrine of trademark dilution exists to protect trademarks from uses
 26 that “whittle[] away . . . the value of a trademark’ by ‘blurring [its] uniqueness
 27 and singularity’ or by ‘tarnishing [it] with negative associations.” *Walking*
 28 *Mountain*, 353 F.3d at 812 (quoting *Mattel*, 296 F.3d at 903). “By contrast to

1 trademark infringement . . . dilution usually occurs when consumers *aren't*
2 confused about the source of a product.” *Mattel*, 296 F.3d at 903 (emphasis in
3 original).

4 When Congress enacted the FTDA, it expressly exempted noncommercial
5 uses of a mark from the dilution statute. 15 U.S.C. § 1125(c)(3)(C) (listing “any
6 noncommercial use of a mark” as among the uses that are not “actionable” under
7 the dilution statute); *Mattel*, 296 F.3d. at 904 (“though potentially dilutive,”
8 noncommercial uses are not actionable); *Burnett*, 491 F.Supp.2d at 973-74
9 (concluding on a 12(b)(6) motion that noncommercial use in television program is
10 not actionable as dilution). The noncommercial use exemption ensures that
11 expression protected by the First Amendment is excluded from the reach of the
12 FTDA. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003)
13 (discussing H.R.Rep. No. 100-1028 (1988) and H.R. 1295, 104th Cong., 1st Sess.);
14 *Mattel*, 296 F.3d at 906 (“the House and Senate . . . relied on the ‘noncommercial
15 use’ exemption to allay First Amendment concerns”). Plaintiffs’ “state law dilution
16 claim is subject to the same analysis as [their] federal claim,” *Panavision*, 141 F.3d
17 at 1324, and the First Amendment considerations apply equally to their dilution
18 claims under California law. See *New Kids on the Block v. News Am. Publ’g, Inc.*,
19 745 F.Supp. 1540, 1542 n.1 (C.D. Cal. 1990) (Rea, J.), *aff’d* 971 F.2d 302 (9th Cir.
20 1992); see also *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32 (1st Cir.
21 1987) (holding that “[i]t offends the [United States] Constitution to invoke [a state]
22 anti-dilution statute as a basis for enjoining the noncommercial use of a trademark
23 by a defendant engaged in a protected form of expression.”).

24 **2. Television Series and Album Titles Are Noncommercial** 25 **Uses and Are Not Actionable Under the Anti-dilution Laws**

26 The noncommercial use exemption was expressly intended to ensure that the anti-
27 dilution laws did not offend the First Amendment. *Mattel*, 296 F.3d. at 906.

28 Accordingly, the Court looks to First Amendment jurisprudence to determine

1 whether speech falls within the exemption. *Id.* “[T]he ‘core notion of commercial
2 speech’ is that it ‘does no more than propose a commercial transaction.’” *Id.*
3 (quoting *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir.
4 1990)); *Walking Mountain*, 353 F.3d at 812 (“artistic and parodic work is
5 considered noncommercial speech”). Speech that does more than propose a
6 commercial transaction is therefore entitled to full protection under the First
7 Amendment and is not actionable under the dilution statutes:

8 If speech is not “purely commercial” – that is, if it does
9 more than propose a commercial transaction – then it falls
10 squarely within the exemption of § 1125(c)(4)(B) [now, §
11 1125(c)(3)(C)] and is not actionable under the federal
12 dilution laws no matter how dilutive its effect.

13 *American Family Life Ins. Co. v. Hagan*, 266 F.Supp.2d 682, 696 (N.D. Oh. 2002)
14 (quoting *Mattel*, 296 F.3d at 905-06).

15 In *Mattel*, for example, the Ninth Circuit concluded that, despite the obvious
16 commercial purpose of the song *Barbie Girl*, the use of the Barbie trademark in the
17 song and song title had an expressive purpose as well and was thus noncommercial
18 use not actionable under the FTDA. *Id.* at 906-07 (“Barbie Girl is not purely
19 commercial speech, and is therefore fully protected.”) Indeed, art and
20 entertainment—including television programs—are generally fully protected under
21 the First Amendment, *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65
22 (1981), and courts have repeatedly recognized the expressive qualities of artistic
23 titles. *See Twin Peaks Prods.*, 996 F.2d at 1379 (recognizing “an author's
24 significant First Amendment interest in choosing an appropriate title for his or her
25 work”); *Rogers*, 875 F.2d at 998 (“Film-makers and authors frequently rely on
26 word-play, ambiguity, irony, and allusion in titling their works.”); *Parks v. LaFace*
27 *Records*, 329 F.3d 437, 449 (6th Cir. 2003) (“The names artists bestow on their art
28 can be part and parcel of the artistic message.”). *Mattel* itself explained the

1 expressive qualities of a title: “The title conveys a message to consumers about
2 what they can expect to discover in the song itself.” *Mattel*, 296 F.3d at 901.

3 **3. Defendants’ Noncommercial Use Of The Word**
4 **“Californication” Is Not Actionable**

5 Because, as a title, Defendants’ use of “Californication” has both
6 commercial and expressive purposes, it is not purely commercial speech.
7 Accordingly, this use is fully protected by the First Amendment and is expressly
8 exempt under the FTDA and California’s anti-dilution provision. *See* 15 U.S.C. §
9 1125(c)(3)(C); *Panavision*, 141 F.3d at 1324.

10 As a title, *Californication* conveys a message to consumers regarding the
11 content and setting of the television program. The Series is set in California and
12 revolves, in part, around the protagonist’s attempt to compensate for his
13 disappointment and frustration with his life in Hollywood through a series of
14 empty sexual encounters. *See* Exhs. A, B. The word “Californication” in the
15 Series’ title is not being used as a reference to the Red Hot Chili Peppers; rather, it
16 is being used in terms of its primary meaning—a portmanteau of the words
17 “California” and “fornication.” This is simply not a case where the title of the
18 Series is divorced from its content; instead, the title itself *is* an expression of the
19 Series’ content.

20 Similarly, as Plaintiffs concede in their Complaint, the use of the word in the
21 Soundtrack’s title *Temptation – music from the Showtime series Californication*,
22 expressly denotes for consumers the source of the music – i.e., this soundtrack
23 contains songs from the series *Californication*. *See* Compl., ¶ 22 (“compilation
24 album[] consist[s] only of songs used on the Show.”). Indeed, there could not be a
25 more descriptive reference – the title explicitly expresses what the consumer
26 should expect to hear on the soundtrack: namely, music heard in the Series.

27 Like the use of “Barbie” in a song title in *Mattel*, each use of
28 “Californication” here is an explicit expression of the artistic content that a

1 consumer can expect to receive: in the first instance, a Series set in California that
2 depicts, within the story line, the main character's various sexual encounters; in the
3 second instance, a soundtrack that includes the songs used in that Series. *See*
4 Notice, Exhs. A-C. Accordingly, the uses of the word "Californication" in the
5 Series' title and its Soundtrack both do more than merely propose a commercial
6 transaction. They are noncommercial, artistic expression that falls squarely within
7 the First Amendment and Section 1125(c)(3)(C) of the FTDA and thus are not
8 actionable under the FTDA or California's anti-dilution statute. *See also*
9 *Panavision*, 141 F.3d at 1324.

10 Finally, not only should this Court dismiss the third and fourth causes of
11 action, such dismissal should be without leave to amend because no amendment
12 will change the fact that Defendants used the word "Californication" in a
13 noncommercial manner protected by the First Amendment. *See Albrecht v. Lund*,
14 845 F.2d 193, 195 (9th Cir. 1988) (noting that leave to amend need not be granted
15 if amendment of the complaint would be futile).

16 **D. Unjust Enrichment**

17 Plaintiffs' fifth claim, which alleges that Defendants have been unjustly
18 enriched as a result of their wrongful conduct, is entirely derivative of Plaintiffs'
19 unfair competition and trademark dilution claims. Compl., ¶¶ 51-52. Because – as
20 set forth above – these claims fail as a matter of law, Plaintiffs' claim for unjust
21 enrichment necessarily also fails. *See, e.g., Melchior v. New Line Prods., Inc.*, 106
22 Cal.App.4th 779, 793 (2003) (rejecting claim for unjust enrichment where court
23 had dismissed substantive claims based upon the same conduct).

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