

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

**CIVIL MINUTES - GENERAL**

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Case No. CV 07-8185 DSF (MANx) Date 2-19-2008

Title Anthony Kiedis, et al. v. Showtime Networks, Inc., et al.

Present: The Honorable DALE S. FISCHER, United States District Judge

Yvette Louis

Not Present

Deputy Clerk

Court Reporter

Attorneys Present for Plaintiffs:

Attorneys Present for Defendants:

Not Present

Not Present

**Proceedings:** (IN CHAMBERS) ORDER REGARDING DEFENDANTS' MOTION TO DISMISS

Before the Court is Defendants' Motion to Dismiss for Failure to State a Claim, filed December 21, 2007. Plaintiffs filed their Opposition on January 18, 2008; Defendants filed their Reply on January 28, 2008. On January 29, 2008, the Court vacated the hearing set for February 4, 2008, and took the matter under submission; the Court now finds that the Motion is appropriate for decision without oral argument. See Fed. R. Civ. P. 78; Local Rule 7-15. Having considered the materials submitted by the parties and the case file, the Court DENIES Defendants' Motion to Dismiss in part and GRANTS it in part, as set forth below. Further, the Court DENIES Plaintiffs' Ex Parte Application for Leave to File a Sur-Reply, filed January 31, 2008.

**I. BACKGROUND**

According to the Complaint, plaintiffs Anthony Kiedis, Chad Smith, John Frusciante, and Michael "Flea" Balzary are members of the rock band known as the Red Hot Chili Peppers (collectively, "RHCP" or "Plaintiffs"). (Compl., ¶ 5.) The RHCP wrote and recorded a song entitled "Californication" (the "Song"), which was both released as a single and included on the band's 1999 album of the same name (the "Album"). (Id. at ¶¶ 12-13.) Since its release, the Album has enjoyed significant critical and commercial success, selling more than 14 million copies, and receiving Grammy nominations and numerous awards. (Id. at ¶¶ 14-16.) As a single, the song "Californication" received significant radio play and a Grammy nomination; in addition, its music video won a number of awards and received considerable publicity. (Id. at ¶¶ 17-18.) Plaintiffs therefore allege that the title "Californication" has acquired "secondary

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meaning,” closely connected with Plaintiffs, their Song, and their Album. (*Id.* at ¶ 25.)

In February 2006, the RHCP released a single entitled “Dani California,” from a subsequent album. (*Id.* at ¶ 20.) The song “Dani California” won multiple Grammy awards, and reached the number one position on several U.S. and international charts. (*Id.*) “Dani California” is also the name of a character who appears in that song, as well as in “Californication” and one other RHCP song. (*Id.*)

Defendant Tom Kapinos is the creator, writer, and executive producer of a television series entitled “Californication” (the “Series”). (*Id.* at ¶ 9.) Kapinos, Showtime Networks, Inc., Twilight Time Films, Inc., and Aggressive Mediocrity, Inc. (“Defendants”) produce and distribute the Series, which began airing on Showtime in late 2007. (*Id.* at ¶ 19.) A recurring character in the Series is named or referred to as “Dani California.” (*Id.* at ¶ 20.)

According to Plaintiffs, Defendants have promoted the Series using the internet, billboards, print media, and television, and have or will advertise the sale of DVD versions of the Series using the same media. (*Id.* at ¶ 21.) In addition, Defendants have distributed a music compilation album featuring songs used in the Series; this soundtrack album uses the word “Californication” in its title.<sup>1</sup> (*Id.* at ¶ 22.) Defendants’ soundtrack album, as well as the Song, the Album, and other music written and performed by the RHCP, are all available for sale on iTunes, an online music retail site. (*Id.* at ¶ 23.)

On November 19, 2007, Plaintiffs filed an action in Los Angeles County Superior Court, alleging that Defendants’ use of the word “Californication” as the title of the Series constitutes unfair competition, trademark dilution, and unjust enrichment under the Lanham Act and state law. (*Id.* at ¶¶ 24-52.) Defendants removed the case to this Court on December 17, 2007, on the basis of federal question jurisdiction. Plaintiffs have not contested removal, and the Court has jurisdiction over this case pursuant to 28 U.S.C. §§ 1331 and 1367. Defendants now move to dismiss the entire complaint, claiming that their use of the word “Californication” is protected by the First Amendment.

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<sup>1</sup>Per Defendants’ Request for Judicial Notice, the title of this compilation album is “Temptation – music from the Showtime series Californication.” (Defs.’ Request for Notice of Incorporated Docs. & Request for Judicial Notice in Supp. of Defs.’ Mot. to Dismiss (“RJN”), Ex. C.) Defendants’ RJN is granted as to Exhibits A, B, and C, but denied as to the remaining exhibits (D through I). Exhibits D through I may become relevant at the summary judgment stage, but they are not relevant to the issue currently before the Court.

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**II. LEGAL STANDARD**

A Rule 12(b)(6) motion tests the legal sufficiency of the claims asserted in a complaint. Fed. R. Civ. P. 12(b)(6). Rule 12(b)(6) must be read in conjunction with Rule 8(a), which requires a “short and plain statement of the claim showing that the pleader is entitled to relief.” Fed. R. Civ. P. 8(a)(2); 5A Charles A. Wright & Arthur R. Miller, Federal Practice and Procedure: Civil § 1356. A Rule 12(b)(6) dismissal is proper only where there is either a “lack of a cognizable legal theory” or “the absence of sufficient facts alleged under a cognizable legal theory.” Balistreri v. Pacifica Police Dept., 901 F.2d 696, 699 (9th Cir. 1988). To survive a Rule 12(b)(6) motion, a complaint “does not need detailed factual allegations,” but the “[f]actual allegations must be enough to raise a right to relief above the speculative level.” Bell Atl. Corp. v. Twombly, 127 S. Ct. 1955, 1964-65 (2007).

The Court must accept as true all material allegations in the complaint, as well as reasonable inferences to be drawn from them. Pareto v. F.D.I.C., 139 F.3d 696, 699 (9th Cir. 1998). Furthermore, the complaint must be read in the light most favorable to plaintiff. Id. However, the Court need not accept as true any unreasonable inferences, unwarranted deductions of fact, or conclusory legal allegations cast in the form of factual allegations. Id.; Western Mining Council v. Watt, 643 F.2d 618, 624 (9th Cir. 1981).

**III. DISCUSSION**

**A. Unfair Competition**

Plaintiffs have asserted two causes of action for unfair competition: one under federal law (section 43(a) of the Lanham Act, codified at 15 U.S.C. § 1125(a)), and one under state law (the California Unfair Competition Law (“UCL”), codified at California Business & Professions Code § 17200 et seq.). The generic concept of “unfair competition” is quite broad, but one common type of unfair competition claim -- and one of the few actionable under federal law -- is trademark infringement. International Order of Job’s Daughters v. Lindeburg & Co., 633 F. 2d 912, 915 (9th Cir. 1980). California’s UCL can encompass a much broader range of conduct, but Plaintiffs here do not set forth any basis for their state law unfair competition claim other than Defendants’ alleged misuse of Plaintiffs’ claimed trademark, “Californication.” Thus Plaintiffs’ UCL claim is subject to the same analysis as their federal trademark claim, and rises or falls with that claim.

A trademark is “a limited property right in a particular word, phrase, or symbol . . . that ‘is used to identify a manufacturer or sponsor of a good or the provider of a service.’” Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792, 806 n.12 (9th Cir.

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2003) (“Walking Mountain”) (quoting Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002) (“MCA”). There is no federal common law of trademark protection, but the Lanham Act “created a federal protection against two types of unfair competition, infringement of registered trademarks, 15 U.S.C. § 1114, and the related tort of false designation of the origin of goods, 15 U.S.C. § 1125(a).” Job’s Daughters, 633 F.2d at 915. Where section 1114 protects registered trademarks, section 1125(a) protects unregistered trademarks. Job’s Daughters, 633 F.2d at 917. “Both statutes preclude the use of another’s trademark in a manner likely to confuse the public about the origin of goods.” Id. This serves the “core purpose” of “avoiding confusion in the marketplace.” MCA, 296 F.3d at 900. However, while registered marks enjoy a presumption of validity, unregistered marks are protected only if they have acquired a “secondary meaning.” Toho Co. v. Sears, Roebuck & Co., 645 F.2d 788, 790 (9th Cir. 1981). Once a mark is deemed protected, though, whether by registration or the acquisition of secondary meaning, “the critical determination is ‘whether an alleged trademark infringer’s use of a mark creates a likelihood that the consuming public will be confused as to who makes what product.’” Jada Toys, Inc. v. Mattel, Inc., 496 F.3d 974, 979 (9th Cir. 2007) (quoting Brother Records, Inc. v. Jardine, 318 F.3d 900, 908 (9th Cir. 2003)).

In the typical trademark case, therefore, courts apply a “‘likelihood of confusion’ test that asks whether use of the plaintiff’s trademark by the defendant is ‘likely to cause confusion or to cause mistake, or to deceive as to the affiliation, connection, or association’ of the two products.” Walking Mountain, 353 F.3d at 806-07 (quoting Cairns v. Franklin Mint Co., 292 F.3d 1139, 1149 (9th Cir. 2002)). The Ninth Circuit’s “likelihood of confusion” test is an eight-factor test formulated in AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979). See Jada Toys, 496 F.3d at 979. The Sleekcraft factors “include: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines.” Id.

However, in cases involving the use of a trademark in works of artistic expression, such as movies or songs, the public’s interest in being free from confusion in the marketplace must be balanced against the artist’s First Amendment right to free expression. Rogers v. Grimaldi, 875 F.2d 994, 997-98 (2d Cir. 1989). Thus a trademark used on an ordinary commercial product may be vulnerable under the “likelihood of confusion” test, while use of the same mark would be protected if used as the title of an expressive work. MCA, 296 F.3d at 901-02. But expressive works are not immune from liability under the Lanham Act; on the contrary, “it is well established that where the title of a movie or a book has acquired secondary meaning -- that is, where the title is sufficiently well known that consumers associate it with a particular author’s work -- the

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holder of the rights to that title may prevent the use of the same or confusingly similar titles by other authors.” Rogers, 875 F.2d at 998. As the Second Circuit noted, “it would be ironic if, in the name of the First Amendment, courts did not recognize the right of authors to protect titles of their creative work against infringement by other authors.” Id. Consumers, too, benefit when titles receive some trademark protection; artistic works are commodities “sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern . . . . The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.” Id. at 997.

The Second Circuit has therefore rejected a rule “that the Lanham Act is inapplicable to all titles that can be considered artistic expression,” holding instead that the Act does apply to artistic works, but only “where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” Id. at 999. Normally, this balance will “not support application of the 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. The balance tips differently, however, and so this “limiting construction” of the Act will not apply, when the titles at issue 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.

In MCA, the Ninth Circuit discussed Rogers at length, expressly agreed with the Second Circuit’s analysis in that case, and adopted the Rogers standard as its own. MCA, 296 F.3d at 902. At issue in MCA was the song “Barbie Girl,” released in 1997 by the Danish band Aqua. Id. at 899. The song featured two band members singing as “Barbie” and “Ken,” id., and was essentially a parody of Barbie “and the values Aqua claims she represents,” id. at 902. Thus, MCA was not a case in which the title of an artistic work was claimed to be confusingly similar (much less identical) to the title of another artistic work. Accordingly, the Ninth Circuit recited only the relevant portion of the Rogers test: “Rogers concluded 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.’ [Rogers, 875 F.2d] at 999 (footnote omitted). We agree with the Second Circuit’s analysis and adopt the Rogers standard as our own.” MCA, 296 F.3d at 902. Under this standard, the Ninth Circuit found that Aqua’s use of the word “Barbie” in the title of their song was not an infringement of Mattel’s trademark, as the title of the song was not explicitly misleading as to the source of the work, and the use of “Barbie” in the song title was relevant to the song itself. Id.

From this, Defendants argue that “[t]he law in the Ninth Circuit is clear -- the First Amendment shields creative titles from Lanham Act liability unless (1) the title has no

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artistic relevance to the underlying work whatsoever; or (2) if it has some artistic relevance, the title explicitly misleads as to the source or content of the work.” (Defs.’ Reply in Supp. of Their Mot. to Dismiss for Failure to State a Claim (“Reply”), at 1 (citing MCA, 296 F.3d at 902).) Defendants acknowledge that the Ninth Circuit adopted this test from the Second Circuit’s opinion in Rogers, but ignore the fact that Rogers exempted works with “confusingly similar” titles from this test. Thus Defendants do not attempt to argue that their use of exactly the same title as Plaintiffs’ Song is not “confusingly similar”; rather, they argue that any potential similarity, confusing or not, is irrelevant, since all that matters under the Ninth Circuit’s test is whether the title is artistically relevant and not explicitly misleading as to source or content. They go on to explain that the term “Californication” is a combination of the words “California” and “fornication,” and thus has a meaning separate and apart from any association it may have with Plaintiffs’ Song or Album. As the Series is set in California, and involves a rather noticeable amount of fornication, both “California” and “fornication” -- and hence their combination, “Californication” -- are artistically relevant to the Series. Since the title is not explicitly misleading as to the source of the Series (i.e., it is not, for example, “The Red Hot Chili Peppers’ Californication”), neither of the two MCA exceptions applies, and the title is absolutely shielded from Lanham Act liability. According to Defendants, then, their use of the word “Californication” as the title of the Series cannot possibly be an infringement of any trademark rights Plaintiffs may have in that word.<sup>2</sup>

Unfortunately for Defendants, however, the Ninth Circuit’s holding in MCA cannot be read so narrowly. As Plaintiffs point out, under Defendants’ interpretation of MCA there would be nothing to restrict an author from using the exact title of someone else’s earlier work as the title of a new work, so long as the words in that title had some relevance to the content of the new work. Thus, HBO or Cinemax could decide to produce another show also entitled “Californication”; and, so long as it took place in California and somehow involved fornication, Defendants would not be able to prevent it.<sup>3</sup> In response to this argument, Defendants claim that comparing two television shows with the same name is different than comparing a television show to a song with the same name, since the two television shows are “in direct competition” with each other. (Reply,

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<sup>2</sup>Defendants also question whether the term has acquired any “secondary meaning” in connection with Plaintiffs’ Song or Album, as well as whether Plaintiffs have standing to assert any claim stemming from such secondary meaning as the term may have acquired. However, Defendants do not currently move to dismiss on either basis.

<sup>3</sup>In theory, of course, a broadcast network could also produce such a show, but the amount of fornication involved would have to be considerably reduced from what is seen in Defendants’ version of the Series.

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at 9.) Nothing in MCA or any subsequent Ninth Circuit case, however, suggests that the two-part MCA test should be applied differently to a work that is in “direct competition” with an allegedly infringing work than to a work that is not. Instead, the language of MCA, at least as Defendants insist it should be read, is fairly absolute: any artistically relevant title that is not explicitly misleading as to source or content is immune from liability under the Lanham Act.

The better reading of the cases, however, suggests that when the Ninth Circuit is faced with a trademark case in which two artistic works with confusingly similar titles are at issue, the court will make clear that when it adopted the reasoning of Rogers, it adopted all of Rogers, and not just the part that was relevant to the decision in MCA. Or, if the Ninth Circuit were to find that it has not yet adopted the part of Rogers exempting competing artistic works with confusingly similar titles from the per se application of the two-part test otherwise adopted in MCA, it would do so when presented with an appropriate case. The overriding concern in Rogers, which the Ninth Circuit quoted with approval in MCA, is to strike an appropriate balance between consumer confusion and free expression. MCA, 296 F.3d at 901; Rogers, 875 F.2d at 999. There is no doubt that this balance changes somewhat when works with confusingly similar titles are involved. Rogers, 875 F.2d at 999 n.5. And certainly the potential for such confusing similarity exists when the titles are exactly the same, as here.

That is not to say that Defendants’ use of the word “Californication” is not entitled to any First Amendment protection. Defendants’ right to free expression, and the public’s interest in protecting that right, will still weigh heavily against any potential consumer confusion here. But as the risk of consumer confusion is higher when “confusingly similar” titles are involved, the Court cannot hold, as a matter of law, that Defendants are entitled to the across-the-board protection of the two-part test used in the MCA case. It may well be that, when the facts are fully developed, the two uses of “Californication” turn out not to be “confusingly similar” in the contexts in which they are found. Defendants’ assertion that two television shows with the same name may be more confusing than a television show and a song with the same name will undoubtedly be relevant to that question. But this is a factual issue not appropriate for resolution without examining the evidence. Instead, it is a decision best made within the framework of the standard “likelihood of confusion” factors used for decades in the Ninth Circuit<sup>4</sup>; factors which will be best considered in this case, at the earliest, at the summary judgment stage.

The First Amendment concerns in this case modify the standard likelihood of

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<sup>4</sup>In fact, the “type of goods” at issue (i.e., whether television show or song), which Defendants insist must be considered, is one of the standard Sleekcraft factors. See Jada Toys, 496 F.3d at 979.

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confusion test somewhat, in that a weak level of potential confusion, even if proven, could nonetheless be outweighed by the need to protect Defendants' right to free expression. But Defendants are not entitled to absolute protection from liability under the Lanham Act, or its state law equivalent, simply because they have created an "artistic" work. See Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1403-04 (9th Cir. 1997) (applying the Sleekcraft test to parody of O.J. Simpson trial entitled "The Cat NOT in the Hat!"); Twin Peaks Prods., Inc. v. Publications Int'l, Ltd., 996 F.2d 1366, 1379 (2d Cir. 1993) (finding that "likelihood of confusion" factors must be applied before the Rogers determination could be made, and noting that "the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in Rogers").

Accordingly, Defendants' Motion to Dismiss Plaintiffs' Lanham Act unfair competition claim must be DENIED. In addition, as the Ninth Circuit has held that the "likelihood-of-confusion test also governs . . . state law claims of unfair competition," MCA, 296 F.3d at 902 n.2, the Motion must be DENIED with respect to Plaintiffs' 17200 claim as well.

**B. Trademark Dilution**

In addition to the two claims for unfair competition, Plaintiffs assert two claims for trademark dilution: one under federal and one under state law. Defendants point out, however, that "noncommercial" trademark uses are expressly exempted from the federal dilution statute. 15 U.S.C. § 1125(c)(3)(C); MCA, 296 F.3d at 904. Further, the Ninth Circuit has made clear that a "noncommercial use" is any use that "is not 'purely commercial.'" MCA, 296 F.3d at 906. Thus, any use of a mark that "does more than propose a commercial transaction . . . is entitled to full First Amendment protection." Id. Not unexpectedly, Defendants contend that their use of the term "Californication" is just such a protected, non-commercial use.

In response, Plaintiffs attempt to distinguish between works that comment on or parody a trademark or earlier work, and those that simply use the trademark of another without commenting on it. The parties here do not dispute that Defendants' use of the term "Californication" is not a parody of or comment on Plaintiffs' earlier use of that term, or that the Series in fact has nothing to do with the RHCP or their music. However, Plaintiffs' argument that only parodies or commentaries can be considered non-commercial speech is not well-taken. The Court has no doubt that the title "Californication," as used by Defendants, has sufficient artistic qualities to take it out of the realm of purely commercial speech.

Accordingly, and because Plaintiffs do not contest Defendants' argument that the state law dilution claim should be governed by the same standard as the federal claim, the

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Court GRANTS Defendants' Motion to Dismiss as to Plaintiffs' Third and Fourth Causes of Action, with prejudice. Although Plaintiffs have requested leave to amend, they do not suggest how this legal defect could be remedied. No possible amendment could cure the problem underlying these claims.

**C. Unjust Enrichment**

Defendants' sole basis for moving to dismiss Plaintiffs' Fifth Cause of Action for unjust enrichment is that it is entirely derivative of Plaintiffs' unfair competition and trademark dilution claims. As those claims fail, so must the claim for unjust enrichment. By Defendants' own logic, therefore, the fact that Plaintiffs' unfair competition claims survive must mean that their unjust enrichment claim survives as well, at least for now. Defendants' Motion to Dismiss is therefore DENIED as it relates to Plaintiffs' Fifth Cause of Action.

**IV. CONCLUSION**

For the reasons set forth above, Defendants' Motion to Dismiss is hereby DENIED as to Plaintiffs' First, Second, and Fifth Causes of Action, and GRANTED WITH PREJUDICE as to Plaintiffs' Third and Fourth Causes of Action.

IT IS SO ORDERED.

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