
**TWENTY-FIRST ANNUAL
PEPPERDINE UNIVERSITY CARUSO SCHOOL OF LAW
NATIONAL ENTERTAINMENT LAW
MOOT COURT COMPETITION**

BENCH BRIEF

INTRODUCTION

Thank you for volunteering to serve as a judge for the Twenty-First Annual Pepperdine University Caruso School of Law National Entertainment Law Moot Court Competition. This year's problem involves a fictional case before the United States Supreme Court. What follows is a brief introduction to the law and arguments that the teams will likely raise during the competition. We suggest you read the enclosed Competition Problem, *FarSky Studios v. Mouse House Inc.*, 980 F.3d 370 (16th Cir. 2021), before reading this bench brief. This bench brief does not exhaustively analyze the relevant issues; rather, it simply introduces the issues and provides summaries of some representative cases that the teams could utilize in their arguments. The teams may creatively use other cases and theories during their oral arguments.

ISSUES

Each team consists of two advocates, with each member arguing a separate issue. This year, the advocates will address the following issues:

1. Whether FarSky Studio's and Interstellar Entertainment's new video game, *Valkyrie: Mission Centauri*, is substantially similar to the movie *Aladar* to constitute copyright infringement?
2. Does FarSky Studio's and Interstellar Entertainment's use of the phrase "Discover Pantera," infringe on Mouse House Inc. and Cames Jameron's trademark for "Discover Pantora."

STANDARD OF REVIEW

These issues are subject to *de novo* review by the Supreme Court of the United States.

ISSUE I–OVERVIEW

COPYRIGHT INFRINGEMENT – SUBSTANTIAL SIMILARITY

The dispute in issue I will focus on is whether FarSky Studio’s and Interstellar Entertainment’s new video game is substantially similar to the movie *Aladar*. Mouse House Inc. and Jamie Jameson filed an action against FarSky Studios and Interstellar Entertainment for copyright infringement. The district court determined that the video game, *Valkyrie: Mission Centauri*, is substantially similar to the film, *Aladar*. As seen in the attached opinion, the appellate court for the Sixteenth Circuit reversed the district court’s decision and found that the video game is not substantially similar to the film.

The primary purpose of copyright law is to protect the author’s creativity and freedom of expression while also allowing new information and ideas to be available to the public. However, there needs to be a proper balance between the author’s rights and the interests of the public. To demonstrate copyright infringement, a plaintiff must show (1) ownership of a valid copyright, and (2) copying of constituent elements of that work that are original. *Feist Publ’ns, Inc. v. Rural Tel. Servs. Co.*, 499 U.S. 340, 361 (1991). The second element has two sub-elements: (1) access (2) substantial similarity. *Cavalier*, 297 F.3d at 822. Here, the original defendants did not dispute the ownership of a valid copyright or that they had access to the original plaintiffs copyrighted work. Thus, the only issue under copyright infringement is substantial similarity. The district court granted the original plaintiff’s motion for summary judgement.

Circuit Courts have adopted for substantial similarity, but this Circuit has used the Ninth Circuit’s two-part “Extrinsic/Intrinsic” test. Under the extrinsic test, the court must do a comparison of objective aspects of the plaintiff’s expression. This test “focuses on articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events in two works.” *Kouf*, 16 F.3d at 1045 (quotation marks and citation omitted). When applying the extrinsic test, this Circuit separates the protectable elements from non-protectable elements. Non-protectable elements such as familiar stock scenes, themes, historical events, and situations that flow naturally from the premise, are not protectable. The intrinsic test is a comparison of subjective aspects of the plaintiff’s expression.

Because this is on summary judgement, this Circuit will only consider the extrinsic test. If Mouse House Inc. and Jamie Jameson can demonstrate that there is a triable issue of fact under the extrinsic test, the intrinsic test should be left to the jury, and FarSky Studios and Interstellar Entertainment’s motion for summary judgment must be denied. *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994). If Mouse House Inc. and Jamie Jameson cannot show a triable issue of fact under the extrinsic test, FarSky Studios and Interstellar Entertainment would prevail on their summary judgment claim. The jury would not determine copyright infringement because there would be no substantial similarity without satisfying both extrinsic and intrinsic tests. *Id.*

**PETITIONER MOUSE HOUSE INC. AND JAMIE JAMESON'S ARGUMENT FOR
ISSUE I**

I. This Court should reverse the decision of the Sixteenth Circuit and find that *Valkyrie: Mission Centaur* is substantially similar to the film *Aladar*, and therefore constitutes copyright infringement.

A. Plot/Sequence of Events

a. The film and the videogame display several of the same basic plot premises and sequence of events.

i. In both:

1. Groups of humans travel to an alien moon where a military force attempts to collect a rare and valuable mineral.
2. Antagonist = a military force seeking money and power in the form of a mineral. Military force threatens the natives in order to obtain the mineral.
 - a. In the film, the REA is a military group that wants a monopoly of the rare and valuable mineral to sell it back on Earth.
 - b. In the videogame, The RC is a military extremist group who wants the mineral to sell it back on Earth.
3. Protagonist = gains the trust of the natives and helps them fight against the military force after they attempt to drive them from their home.
4. A large battle between the natives and the military takes place because the natives refused to leave.
5. The battle takes place at the most sacred and spiritual place on the moon.
6. The natives are outmatched by modern technology, but with help, they are able to defeat the military force.

B. Setting

a. Both works share similar settings.

i. In both:

1. Humans travel to an alien world.
2. Set in the future with superior technology, where humans have the ability to explore new worlds.
3. The Moons are in the Alpha Centauri system with similar names (Pantora and Pantera).
4. The moons share similarities with earth – jungles, mountains, volcanos, plains, and oceans. Both have land that is covered in lush trees and vegetation (jungle). The Plant life, natives, and creatures have bioluminescent qualities that create a glow of colors.
5. Both have a natural center where the natives and other life on the moon have a spiritual connection. The Tree of Soul and the

Well of Life are very similar. Even though one is a tree and the other is a well, they are described in a very similar way and have the same purpose.

C. Characters

a. There are several similarities between some of the characters from *Aladar* in the video game *Valkyrie: Mission Centauri*.

i. Natives - Nanki vs. Makai

1. Petitioners argue that there are several similarities between the natives in *Aladar* and the natives in *Valkyrie: Mission Centauri*.

2. In both:

- a. Human-like features with a slender build. They stand 10ft tall and have dark braided hair with beads and feathers intertwined.
- b. Stripes that cover most of their body.
- c. Blue elements to their skin.
- d. Hunter-gatherers, warriors, skilled in bows and arrows.
- e. Spiritual connection with the life on the moon and a deity or spiritual being that connects all living things.

ii. Creature – Mountain Banshee vs. Sea Basiliak

1. Petitioners argue that there are several key similarities between the Mountain Banshee from *Aladar* and the Sea Basilisk in *Valkyrie: Mission Centauri*.

2. In both:

- a. Similar features to a dragon, with large wings, gill slits in their chest cavity for breathing, and large claws at the end of their wings.
- b. Similar colorful skin tones – yellow, orange, blue, green.
- c. Bioluminescent qualities on their wings.
- d. Eyes: two primary eyes and two secondary eyes.

D. Theme

a. The two works share a majority of the same themes. They have some differences, but they share more similarities.

- i.** Human exploitation of natives
- ii.** Indigeneity
- iii.** Spirituality
- iv.** Nature

SAMPLE QUESTIONS FOR PETITIONER ISSUE I

- 1.** Should this court provide higher protection for authors and their works? Or should the court ensure that enough ideas are available for the public in order to not hinder creativity?
- 2.** According to the evidence, the two works share several similar themes. But, isn't the main superseding theme in both works significantly different?
- 3.** Because the two works share the same premise, is it not surprising that they share similar plot elements and sequence of events?
- 4.** Was the court correct in applying the 9th Circuit's Extrinsic/Intrinsic Test? Should a different test be applied?

**RESPONDENT FARSKY STUDIOS AND INTERSTELLAR ENTERTAINMENT'S
ARGUMENT FOR ISSUE I**

I. This Court should affirm the decision of the Sixteenth Circuit and find that *Valkyrie: Mission Centauri* is not substantially similar to the film, *Aladar*, and therefore find that Respondent has not committed copyright infringement.

A. Plot/Sequence of Events

- a. Although the works have similar plot premises, the two are actually very different.
- b. Differences:
 - i. Protagonist = in the film, the protagonist is a paraplegic former marine who falls in love with a female Nanki. In the video game, the protagonist is the player. The player is a member of the Valkyrie (an all-female military squad).
 - ii. The REA, from the film, is a private military organization that wants a monopoly over the mineral to sell to the government. The RC, from the video game, is an extremist group who wants the mineral to sell it on the black market.
 - iii. During the final battle scene, in the film, the natives are helped by the creatures, whereas, in the video game, the Valkyrie are the ones who helped the natives win.
 - iv. In the film, the battle is primarily from the air with helicopters and bombers, whereas, in the video game, the battle is from the ground.
 - v. The film is primarily about the protagonist's inner battle between right and wrong. Whether to follow his military training and follow his superior's orders, or whether to do what he knows is right and protect the natives from being killed and driven from their home. The video game, on the other hand, has a strong aspect of female empowerment.
- c. Non-Parallels between the film and the video game.
 - i. In the film, a group of scientists create a hybrid of Nanki and Humans called "Aladar's." The video game does not have anything similar to this.
 - ii. The video game has levels, in which the player has to accomplish something before he/she can move on to the next level.

B. Setting

- a. The two works share similar settings, but that is because they share the same premise. Also, when you look closer, the settings are quite different.
 - i. The moon from the film, Pantora, is 80% jungle, whereas, the moon from the video game, Pantera, is only 27% jungle, with the other 73% covered in water. The moon from the video game is primarily covered in water, which is very similar to Earth.
 - ii. The Tree of Souls and Well of Life are very different.
 1. The Tree of Souls is a massive 200ft tall tree with roots that stretch all across the moon of Pantora. The Well of Life, on the

other hand, is 50ft wide and 100ft deep with water that branches out from the main pool into smaller streams that stretch out all over the moon until it reaches the ocean.

- iii. Unprotectable Elements – many of the similarities the Petitioner is going to argue are unprotectable.
 - 1. The fact that the moons are both from the Alpha Centauri system is unprotectable because the Alpha Centauri system is a real system, even if the moon itself is not a real moon in the system.
 - 2. The natural vegetation is also not protectable because it is similar to Earth's.
 - 3. Hundreds of films, television shows, and video games have taken place on a faraway alien world where humans have gained the capacity to travel in space.

C. Characters

- a. A close examination of the characters in the two works show that they are very different.
- b. Natives – Makai vs. Nanki
 - i. Nanki = “tree people”; Makai = “On the Sea.”
 - 1. The Nanki live in a lush forest surrounded by towering trees. The Makai, on the other hand, live on an island surrounded by the ocean.
 - ii. The Nanki have blue skin while the Makai have rich ebony skin, with blue stripes. The Makai's blue stripes have bioluminescent qualities, whereas the Nanki's bioluminescent quality follows their nervous system.
 - iii. The Nanki has several features similar to a feline, with long tails, pointed ears, triangular faces, flat noses, and large golden-yellow eyes. The Nanki also has a single long braid that drops to the small of their back.
 - iv. The Makai are more similar to humans with the only feline-like feature being stripes. The Makai also have features usually found on aquatic animals, such as webbed hands and feet.
- c. Creatures – Sea Basilisk vs. Mountain Banshee
 - i. Although these two creatures share several similarities, they are quite different in appearance and purpose.
 - ii. The Sea Basilisk shares features similar to a serpent and a dragon, whereas the Mountain Banshee has no serpent qualities and primarily has bird/dragon features.
 - 1. The Mountain Banshee has two large wings and two small wings, whereas the Sea Basilisk has two large wings.
 - 2. The claws at the end of their wings are used for two different purposes. The Mountain Banshee uses its claws to cling to the side of mountains, whereas the Sea Basilisk has webbed claws to help them move through water.
 - 3. Although the Sea Basilisk can spend a limited time in the air, it is primarily underwater.

4. Both creatures have very colorful skin tones, however, the Mountain Banshee's coloring depends on the gender.
 5. The pupils of their eyes are very different. The Sea Basilisks are similar to a snake or serpent, with slit pupils, while the Mountain Banshee's eyes are similar to a bird, with large round pupils.
- iii. Characters that do not have a parallel in the video game.
1. In the film, the protagonist is a paraplegic marine, whereas in the videogame, the protagonist is the player, a member of the Valkyrie. The protagonists do not share any similarities.
 2. Also, the scientists in the film do not have a parallel in the video game.

D. Theme

- a. Even though the two works share several of the same themes, the main theme in the video game is different from the film.
 - i. The central theme of the film is love. The protagonist's fight between right and wrong comes from his love for the Nanki as well as the love for Pantora.
 - ii. In the video game, the central theme is female empowerment. The chosen squad is an all-female team that has been entrusted with protecting and saving the natives from the military force.

SAMPLE QUESTIONS FOR RESPONDENT ISSUE I

- 1.** One of the main reasons for copyright law is to protect an author's expression ideas. Why should this court not favor the protection of an author's ideas and instead favor the protection of ideas available to the public?
- 2.** Based on the evidence, the two works share several of the same themes. Why should this court base its decision on the fact that they share a different main/central theme?
- 3.** Why should this court look not only at the similarities between the two works but the differences as well? Aren't similarities more important than differences?

AUTHORITY FOR ISSUE I

STATUTES:

17 U.S.C.A. § 102 (Copyright Act of 1976)

(a) Copyright protection subsists, in accordance with this title in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”

CASES:

United States Supreme Court

***Feist Publ'ns, Inc. v. Rural Tel. Servs. Co.*, 499 U.S. 340 (1991).**

Facts: Rural Telephone Service Company (plaintiff) sued Feist Publications (defendant) for copyright infringement regarding the defendant's use of plaintiff's directory of white and yellow pages. Plaintiff issues an annual telephone directory which generates revenue from advertisements in their yellow pages. Defendant is a publishing company with a directory that covers a larger than average range. Defendants telephone books are free of charge, and like plaintiff, they receive revenue through advertising in their yellow pages. Plaintiff refused to give a license to defendant for the use of the phone numbers in the area, so defendant used them without the proper consent.

Holding: The judgment of the Court of Appeals is *Reversed*. The Supreme Court concluded that the names, towns, and telephone numbers copied by Feist were not original to Rural and therefore not protected.

Rationale: According to the Supreme Court in this matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity, and because Rural's white pages are limited to basic subscriber information and arranged

alphabetically, it falls short of protection. Also, Rural's white pages lack the requisite originality, required under 17 U.S.C. § 101, and therefore Feist's use of the listings cannot constitute infringement.

Circuit Court Decisions

***Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002)**

Facts: Plaintiffs, Wanda and Christopher Cavalier, wrote children's stories about a character named Nicky Moonbeam. In one illustration, a star is shown lounging on a cloud during the daytime. In another, a star is being polished by the main character. The book also included a night-light built into the back cover, with a smiling moon surrounded by stars and a power switch to the lower right. The general theme of the stories included traveling through the night sky and speaking with the moon and stars. The Cavaliers submitted the stories to Random House, the defendant, but they were rejected. Later, Random House published two very similar books called *Good Night, Ernie* and *Good Night, Elmo*. These books involved Ernie and Elmo traveling through the night sky with the moon. They also included illustrations similar to that of plaintiff's books, such as stars lounging on clouds and stars being polished. These books also included a night light. The Cavaliers sued Random House, for copyright infringement. The defendants filed a motion for summary judgment. The district court granted the motion. The Cavaliers appealed the decision.

Holding: Ninth Circuit affirmed the district court's grant of summary judgment on substantial similarity as to the literary works as a whole, affirm the district court's grant of summary judgment on all the Lanham Act claims, but REVERSED its grant of summary judgment against plaintiffs' copyright claim with respect to the "moon night light" cover and the "illustration of stars relaxing on clouds".

Rationale: The court applied the two-part extrinsic/intrinsic test to determine whether the two works are substantially similar. The Cavaliers alleged that eight elements of *Good Night, Ernie*, and four elements of *Good Night, Elmo* were copied by Random House. The court compared the literary works as a whole under the extrinsic test. The works share the same general premise of a child who is invited by a moon-type character to take a journey through the night sky. However, the court found that basic plot themes were not protectable. The works do not share a similar sequence of events, the setting – night sky – are similar but flow from the basic premise, the mood, pace, dialogue, and theme are also different. With this, the court determined that the works as a whole are not substantially similar.

***Skidmore as Trustee for Randy Craig Wolfe Trust v. Zeppelin*, 952 F.3d 1051 (9th Cir. 2020).**

Facts: Randy Wolfe was a guitarist for the band Spirit and wrote the instrumental for the song Taurus. Wolfe entered into an exclusive agreement with Hollenbeck Music, in which Hollenbeck registered the copyright to the unregistered composition of Taurus with Wolfe listed as author. Around the same time, Led Zeppelin released a new album with the song Stairway to Heaven. Wolfe passed away and his mother established his trust and serves as trustee. After she passed, Skidmore became co-trustee and filed a copyright infringement suit 43 years later. Skidmore

claims that the opening notes of *Stairway to Heaven* are similar to a passage of *Taurus*. During the substantial similarity analysis, both parties presented expert musicologists. Skidmore's expert determined that the elements were copied because they are what make *Taurus* memorable and unique to the audience. Led Zeppelin's expert testified the opposite, claiming that the two are completely different. And that the elements that are claimed to be similar are unprotectable common musical elements. Jury returned a verdict in favor of Led Zeppelin. A panel of the court amended the judgement in part and remanded for a new trial. The court of appeals granted a rehearing en banc.

Holding: The district court did not err in refusing to instruct the jury on the inverse ratio rule, which states that a work with a higher degree of access means the court can find a lesser degree of similarity.

Rationale: One of Skidmore's key arguments was that Led Zeppelin had access to the recording of *Taurus* before creating *Stairway to Heaven*. Skidmore proposed that the court adopt the inverse ratio rule, however this court denied this argument stating that this rule creates uncertainty. The court then overruled prior Ninth Circuit decisions that adopted this rule. There is nothing in copyright law that suggests that a work deserves more protection because it is more popular or has a high degree of access.

***Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994).**

Facts: Kouf submitted a screenplay titled "The Formula" to Disney which Disney rejected. A few years later, Disney released a film called "Honey, I Shrunk the Kids." Kouf argues that Disney took his idea without paying him and sued alleging copyright infringement. Disney did not contend that Kouf owned the copyright to "The Formula," nor that they had access, however they contend that the film is not substantially similar to the screenplay. The district court granted Disney's summary judgement. Kouf appealed this decision.

Holding: The district court was correct in granting summary judgement in favor of Disney.

Rationale: This court applied the two-part extrinsic/intrinsic test to determine substantial similarity between the two works. The two works displayed substantially different plots, themes, and sequence of events. "Honey, I Shrunk the Kids" portrays a celebration of family values, whereas "The Formula" is about the triumph of good over evil. In both, the characters are shrunk (1/4 and 1ft). One by a ray gun machine and the other by a liquid formula. In one the characters were shrunk by accident and the other was for evil purposes. In "Honey, I Shrunk the Kids," one of the main characters, "Thompson," is a father and neighbor, but in "The Formula," he is a gangster. Also, the mood setting and pace between the two works are very different. "Honey, I Shrunk the Kids," is a fun family-friendly story that takes place in a family home within 24 hours. "The Formula" is a dark story that is spread out over several days and takes place in many locations.

***Berkic v. Crichton*, 761 F.2d 1289, 1294 (9th Cir. 2002).**

Facts: Berkic wrote a treatment called *Reincarnation, Inc.* and gave the treatment to a literary agent to ask for help in getting interest from a studio. The agent suggested Berkic collaborate with Michael Crichton and do a film with “shared-credit.” Berkic declined this offer. Later, defendants released the movie *Coma*, which was written and directed by Crichton and based on the novel *Coma* by Robin Cook. Berkic claims that both the book and the movie copied his treatment for *Reincarnation*. The district court dismissed a portion of the copyright claim based on a time issue and later disposed of the remainder of the copyright claim stating that there was no substantial similarity.

Holding: This court agreed with the district court and found that there was no similarity between the two works. And that scenes that flow naturally from the plot premise are not protectable elements.

Rationale: This court used the two-part extrinsic/intrinsic test to determine substantial similarity. Both works deal with criminal organizations that murder young, healthy people and sell their organs to wealthy people in need of transplants. But substantial similarity cannot be found in the basic plot premise. People cannot own a general idea. Therefore, the court must look at the extrinsic test, similarity between the objective details of the works, the plot, theme, dialogue, mood, setting, pace, and sequence of events. The characters in the two works share very little similarities. One is driven by personal experience and the other is seeking to advance his career. The setting of *Coma* is a large metropolitan hospital, and only a few minor scenes in *Reincarnation* take place in a hospital. A romantic relationship between characters is a major part of *Reincarnation*. *Coma*, however, does not have romance as a major component to the story, and it primarily concentrates on societal concerns. The court found that there were some similarities between the two works but also determined that situations and incidents that flow naturally from the premise are not protectable.

Narell v. Freeman, 872 F.2d 907, 910-11 (9th Cir.1989).

Facts: Narell is the author of *Our City: The Jews of San Francisco*, which describes the movement of Jewish immigrants from Europe to San Francisco, the creation of Jewish owned businesses, their involvement in civil and cultural affairs, and the stories of immigrant families. Freeman is the author of *Illusions of Love*, which tells a story of an heir of a wealthy Jewish family. Portions of this book are based on historical events, and Freeman admits that she consulted and used Narell’s book to prepare hers. Narell filed for copyright infringement. However, the district court granted defendants motion for summary judgement. Narell appealed the district court’s decision to grant summary judgement to Freeman. Narell claims that Freeman copied portions of Narell’s work.

Holding: This court affirmed the grant of summary judgement finding that Freeman’s work was not substantially similar to Narell’s work because historical facts are not protectable.

Rationale: The court implemented the two-part extrinsic/intrinsic test and compared the similarities between the works plot, theme, dialogue, mood, setting, pace, characters, and sequence of events. *Our City* focuses on the Jewish community that immigrated to San Francisco, while *Illusions* is a romance novel based on the story of three fictional characters. A

portion of Illusions details the family's journey to San Francisco; however, this is not enough to constitute substantial similarity. The mood, pace, and sequence of events were not similar, and the use of historical facts is not protectable.

***Olson v. Nat'l Broad. Co.*, 855 F.2d 1446, 1451-53 (9th Cir. 1988).**

Facts: There, the author of the television series "Cargo," brought a copyright infringement claim against NBC, contending that the television series "The A-Team" was substantially similar. The district court granted judgment notwithstanding the verdict in favor of defendants. Olson appealed.

Holding: The Court of Appeals held that "Cargo" and "The A-Team" were not substantially similar.

Rationale: There is little similarity between "The A-Team" and "Cargo" in terms of the plot, sequence of events, dialogue, and setting. In "Cargo," the team is coerced by DEA agents to break up a drug-smuggling ring. The "A-Team," on the other hand, is hired by a reporter to find a missing reporter in Mexico. Although some of the episodes from "The A-Team" share a similar plot to "Cargo," the similarities were not sufficient enough. No evidence was brought to demonstrate similar dialogue, and the settings were too dissimilar. The court did find that there were similarities between the work in terms of theme, mood, pace, and characters. Both shows' primary theme is action and have a similar comedic mood. Because both works are action, they both have a quick pace. However, these similarities are common to action-adventure shows, and therefore cannot solely constitute substantial similarity. Olson claims that its strongest comparison of the shows is between the characters. However, the court found that the characters differed in significant ways. The characters in "Cargo" are "lightly sketched" and depicted in only three or four lines.

District Court Decisions

***Crane v. Poetic Prods. Ltd.*, 593 F. Supp. 2d 585, 590 (S.D.N.Y. 2009)**

Facts: Crane filed an action against Poetic Products for a declaratory judgement that his play did not infringe the copyright of the defendant's book. Defendant filed a counterclaim alleging copyright infringement under the "Copyright Act." Plaintiff moved for summary judgement. Crane is the author of *The Last Confession*, a fictional play based on the historical events surrounding the death of Pope John Paul I. The Defendant Poetic Products owns the copyright for *In God's Name: An Investigation into the Murder of Pope John Paul I*. This book is a factual investigation of the death of Pope John Paul I.

Holding: The two works are not substantially similar to support a finding of copyright infringement. Historical facts are not protectable under copyright infringement.

Rationale: Substantial similarity must be between protectable elements. This court compared the dialogue, plot, theme, and total concept and feel between the two works. Poetic Products put forth evidence of seven line-by-line comparisons of dialogue from the book to the play. The

court found that all but one failed to show substantial similarity. The court found that Crane had his own unique style and wording and that copyright protection should not extend to the presentation of historical facts in the order in which they took place.

ISSUE II—OVERVIEW

TRADEMARK INFRINGEMENT

The Lanham Act is the federal statute that governs trademarks and defines a trademark as “any word, name, symbol, or device, or combination thereof” that is used “to identify and distinguish ... goods ... from those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. § 1127. The primary basis of a trademark infringement claim is the likelihood of confusion. If the goods are unrelated, there is no infringement because there would be no likelihood of confusion. However, when the accused work directly competes with the trademark, infringement will generally be found. But, when the goods are related but do not directly compete, several factors need to be considered by the court.

This Circuit has followed the eight-factor *Sleekcraft* test used in the Ninth Circuit which includes: (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; (8) likelihood of expansion of the product lines. 599 F.2d at 348-49. This list of factors is not exhaustive, and no single factor is dispositive and does not require a positive finding on the majority of the factors listed above.

Here, only three factors are at issue: (1) Strength of the Mark; (2) Proximity of the Goods; and, (3) Similarity of the Marks. The other five factors have been conceded or sufficiently pleaded and are not at issue.

(1) Strength of the Mark

Under trademark law, the stronger the mark the greater the protection it is afforded. There are two ways the court must look at to determine the strength of the mark. The first is conceptual strength, which is the classification of the mark as generic, descriptive, suggestive, arbitrary, or fanciful. In order, from strongest to weakest protection:

(a) Fanciful Marks – made-up words that were invented to function as a trademark or service mark. Strongest Protection.

(b) Arbitrary Marks – Existing words that have no clear relation to the goods and services being offered. Strong Protection.

(c) Suggestive Marks – Words that imply, but do not directly relate or state, something about the goods and services being provided. Adequate level of protection.

(d) Descriptive Marks – Clearly describe the goods and services being provided through function, quality, ingredient, etc. Weak, cannot receive protection without showing secondary meaning (consumers recognize the mark with a specific producer, rather than the product itself).

(e) Generic – A mark that, due to its popularity or significant use, has become a generic term for a class of products or services.

Mouse House Inc. and Jamie Jameson argued that its trademarked phrase, “Discover Pantora,” is an arbitrary mark and thus entitled to strong protection. The district court disagreed, concluding that the mark is suggestive. The circuit court agreed with the district court that the mark is not arbitrary, but still wasn’t sure it agreed with the district court that it was a suggestive mark. Therefore, the circuit court began its analysis by distinguishing suggestive from descriptive. The most important criteria here is the thought process from the mark to the product. In other words, how easy and fast can a consumer connect the mark to the product. Looking at the phrase as a whole, it would be difficult to conclude whether a consumer would think of the movie *Aladar*, or even Mouse House Inc, when they see or hear the phrase “Discover Pantora. Other images could pop-up in the consumer's mind, including Pantora the jewelry store, or Pantora the music streaming service. Because the word “Pantora” is used by other big-name companies, it would be difficult for the court to find that consumers would think of the movie when they hear the entire trademarked phrase.

Along with the conceptual strength of the mark, the court must look at the commercial strength of the mark, which is when advertising of the mark can transform it from a suggestive mark into a strong mark. Mouse House Inc. and Jamie Jameson argue that their extensive advertisement of the mark strengthens its protection. Based on the above analysis and the district court's findings, the court of appeals concluded that the mark is suggestive because of the mental leap from phrase to good, however, the court believes it is still a weak mark and only entitled to a limited range of protection. Therefore, only if the court finds in favor of Mouse House Inc. and Jamie Jameson for the next two elements, Proximity of the Goods and Similarity of the Marks, will they find infringement.

(2) Proximity of the Goods

If goods are related and share similar aspects, there is a danger that consumers will be confused as to the source of one product versus another. There are three factors to consider determining the proximity of the goods: (1) complementary; (2) sold to the same class of purchasers; and (3) similar in use and function.

The district court concluded that the degree of care likely to be exercised by a purchaser is relatively low. Had the consumers exercised a high degree of care and the advertisements were clear and distinct, the proximity of the goods would be less important. The price of the goods, the similar value, and the fact that the goods are advertised in similar mediums, the degree of care taken by a consumer of the film is low, and thus, it is possible that the consumer could confuse the two products.

The district court also believes that movies and video games are very similar, especially with the creation of new technology. The court of appeals disagreed with this conclusion finding that the two goods are very distinct. Mouse House Inc. primarily creates movies, television shows, and memorabilia. However, they do have a presence in the video game industry. Given their diverse range of products, the circuit court concluded that Mouse House Inc.’s intended audience is everyone, whereas FarSky Studios and Interstellar Entertainment primarily target gamers. Video

games are highly interactive and are created for the purpose of enhancing the player's experience. Films are made to create emotions, and to be watched, with no interaction.

Thus, the circuit court found that this factor was in favor of FarSky Studios and Interstellar Entertainment.

(3) Similarity of the Marks

The similarity between the two marks is a big issue when determining trademark infringement. Similarity of the marks is tested by three factors: sight, sound, and meaning. There are several similarities in the look of the two marks. The district court found that the only difference was a single letter. FarSky Studios and Interstellar Entertainment argued that the distinctive way the mark is advertised and presented should negate the similarity. The circuit court agreed with this argument. "Discover Pantora" is displayed at the bottom with Jake Scully pictured in-between in his Avatar body. This is what the font and writing appear like:



The video game displays the words in a similar manner, "Discover Pantera" at the bottom with a Valkyrie warrior holding a sword and shield.



The font from *Aladar* appears more organic, which appropriately fits with the story. On the other hand, the font and look of *Valkyrie: Mission Centauri* screams outer space. Even though there are similarities in sight when the two phrases are looked at side-by-side, when looked at in advertisements and the way the phrase is presented, the two look very different. This is what the circuit court concluded. The second factor to be considered is sound. The circuit court agreed with the district court's conclusion that when spoken in conjunction with one another, the two marks sound very similar and are hard to distinguish. Therefore, the similarity of the marks depended on the circuit court's conclusion of the final factor. The circuit court concluded that the two marks have two different meanings that were intended and conveyed by the Petitioners and Respondents. Mouse House Inc. and Jamie Jameson used the word "Pantora" to mean "hope." And "Discover Pantora" is speaking to fans of the film to explore the new theme park land. On the other hand, "Discover Pantera" is speaking directly to the new player, inviting them to buy and play the new videogame. Also, according to the creators, the word "Pantera" is used in the native language to mean "faith," referencing their strong spirituality and connection to life on the moon. The district court argued that "faith" is a synonym of "hope" and therefore convey the same meaning, but the circuit court disagreed.

Therefore, the circuit court concluded that the two marks are not similar despite the district court's finding.

PETITIONER'S ARGUMENT OF ISSUE II

I. This Court should reverse the decision of the Sixteenth Circuit and find that Respondent committed trademark infringement by causing a likelihood of confusion between the two marks.

A. Strength of the Mark

a. Advocates for Petitioner (Mouse House Inc. and Jamie Jameson) will disagree with the Appellate court and argue that the mark has both a high degree of conceptual strength, as well as commercial strength

i. Conceptual Strength

1. Advocates for petitioners will likely argue that the mark, "Discover Pantora," is suggestive, and therefore deserves strong protection.

a. Although the circuit court concluded that the mark is suggestive, they also concluded that it was a weak mark and thus relied on the other two factors to determine infringement.

b. Advocates will likely argue that suggestive marks are strong and should be afforded a wide range of protection because of the mental leap required.

ii. Commercial Strength

1. Advocates will argue that petitioner's extensive advertising expenditures should transform the suggestive mark into a strong protectable mark.

a. Even though the theme park and merchandise using the mark has not been released to the public, Mouse House Inc. has done extensive advertising using the phrase "Discover Pantora."

b. Advocates will argue that because Mouse House Inc.'s advertisements reached a broader audience and began several months prior to Respondent's advertisements, when people search for the mark, they are looking for Mouse House Inc.'s goods and services.

i. Mouse House Inc. and Jamie Jameson have spent more than 10 million on commercials, internet ads, and billboards. They began releasing advertisements on February 1st, 2020 and an expert witness testified that the advertisements reached 150 million people (10% margin of error).

- ii. Respondents have spent 8 million in advertising on commercials, internet ads, and billboards. Respondents started releasing its advertisements on April 1st, 2020, and reached over 120 million people, according to their expert witness (10% margin for error).

B. Proximity of the Goods

- a. Advocates for Petitioner will argue that the proximity of the goods is so close in proximity that advertisements would cause a likelihood of confusion to consumers.
 - i. The district court concluded that the degree of care likely to be exercised by a purchaser is relatively low due to the low price of the products and advertised in similar mediums.
 1. Thus, when unsophisticated consumers are presented with an advertisement from *Valkyrie: Mission Centauri* with the words “Discover Pantera,” they will become confused as to the source of the good due to its substantial similarity with *Aladar’s* advertisements.
 - ii. There is a thin line between movies and videogames.
 1. Both display graphic moving pictures.
 2. Both are divisions within the entertainment and media/audiovisual industry.
 3. Even though Mouse House Inc. primarily produces films, television shows, and merchandise, they also produce video games based on its other film or television products.

C. Similarity of the Marks

- a. Advocates for Petitioner will argue that the marks share several similarities in sight, sound, and meaning to cause a likelihood of confusion.
 - i. Sight
 1. “Discover Pantora” and “Discover Pantera” are virtually Identical.
 2. The only difference is a single letter and are positioned similarly on the advertisements, at the bottom.
 3. The look and appearance of the mark on the advertisement shouldn’t negate the similarity between the two marks.
 - ii. Sound
 1. The two marks sound the same when spoken, with the only difference being a single syllable in “Pantora” and “Pantera.”
 - iii. Meaning
 1. “Pantora” is in reference to the first woman of Greek Mythology who unleashed evil onto the earth. However, she was able to save one evil from being released, “Hopelessness.”
 - a. Jamie Jameson stated: “[w]e decided on the name ‘Pantora’ because it demonstrates that even with all the

evils in the world, humans can always succeed if they have hope. And the primary conflict our protagonist faces is the battle between good and evil.”

2. “Pantera” means “faith” which is a synonym of “hope.”
3. The word “Discover” in conjunction with “Pantora” is for fans of the film as well as the theme park, inviting them to experience the new land. And, “Discover Pantera” is similar in that it is for the player of the game to explore the land in the videogame.

SAMPLE QUESTIONS FOR PETITIONER ISSUE II

1. Respondents’ did extensive advertising for its new video game, spending millions of dollars and reaching millions of people. Why should this court find that the strength of the mark is increased due to the slight variations in advertising?
2. According to the evidence before us, you, the petitioner, did not present any evidence of actual confusion by consumers, doesn’t this weaken the argument of the close proximity of the goods?

RESPONDENT'S ARGUMENT FOR ISSUE II

I. This Court should affirm the decision of the Sixteenth Circuit and find that the mark would not cause a likelihood of confusion, and therefore does not constitute trademark infringement.

A. Strength of the Mark

a. Advocates for Respondent (FarSky Studios and Interstellar Entertainment) will argue that the mark is suggestive but still weak, so it only deserves a narrow range of protection.

i. Conceptual Strength

1. Even though the mark is registered, the word "Pantora" is also registered with two other well known companies.
2. Pantora is not a made-up word and is therefore not arbitrary or fanciful. As Jamie Jameson states, he named the moon after the first woman in Greek mythology.
3. Some imagination is required to connect product with source, but because the word "Discover" is common and used often, and "Pantora" is well known as a name for other companies, as well as its significance in Greek mythology.

ii. Commercial Strength

1. The difference between advertisement expenditures and the amount advertised is minimal.
 - a. Mouse House Inc. and Jamie Jameson has spent more than 10 million on commercials, internet ads, and billboards. They began releasing advertisements on February 1st, 2020 and an expert witness testified that the advertisements reached 150 million people (10% margin of error).
 - b. Respondents have spent 8 million in advertising on commercials, internet ads, and billboards. Respondents started releasing its advertisements on April 1st, 2020, and reached over 120 million people, according to their expert witness (10% margin for error).

B. Proximity of the Goods

a. Advocates will argue that the products are not close in proximity to cause a likelihood of confusion among consumers.

- i. Even though the district court has concluded that the degree of care likely to be exercised by a purchaser is relatively low due to the low price, similar value, and similar mediums used to advertise, this does

not mean that consumers are going to associate the video game with Mouse House Inc.

- ii. Mouse House Inc. primarily sells movies, television shows, and memorabilia. Their videogame presence is very small compared to FarSky Studios and Interstellar Entertainment.
 1. Also, because Mouse House Inc. creates several different products and goods, their intended audience is everyone, whereas Respondent's intended audience is gamers.
- iii. There are several differences in use and function that separate movies and film from video games
 1. Video games are interactive and designed to enhance the player's experience. A film, on the other hand, is created around a story intended to evoke emotions in its viewers.
 2. In video games, a player can team up with friends and family to fight battles, compete in sporting events, and play puzzle games. The only social interaction with films is going to a movie theater or watching with friends and family.

C. Similarity of the Marks

- a. Advocates for Respondents will argue that the works are not similar in sight, sound, or meaning.
 - i. Sight
 1. Advocates for Respondents will argue that even though there are clear similarities, the distinction between the two marks when presented in advertisements should negate any similarity found.
 2. The marks are similar in spelling, but they differ extensively when viewed on advertisements.
 - a. The font *Aladar* appears more organic, and handwritten, which appropriately fits with the story. Also, "Discover Pantora" is in a single line.
 - i. The font of "Discover Pantera" from *Valkyrie: Mission Centauri* feels like it's from outer space. "Discover Pantera" is arranged one on top of the other.
 - b. The advertisement for "Discover Pantora" is always featured with Jake Scully in his blue Aladar body, whereas the video game features a Valkyrie warrior with a sword and shield.
 - ii. Sound
 1. The two marks sound the same when spoken, with the only difference being a single syllable in "Pantora" and "Pantera."
 - iii. Meaning
 1. Advocates will argue that the two marks are not similar in meaning.

- a. Mouse House Inc. and Jamie Jameson used the word “Pantora” to reference the first woman of Greek Mythology who unleashed all evils on the world except for hopelessness.
 - i. Jamie Jameson: “We decided on the name ‘Pantora’ because it demonstrates that even with all the evils in the world, humans can always succeed if they have hope. And the primary conflict our protagonist faces is the battle between good and evil.”
- b. The word “Pantera” is a word used by the natives in the video game and it means “faith.”
- c. “Discover Pantora” is for fans of the film to go to the theme park, whereas, Respondent’s mark “Discover Pantera” is speaking directly to the player of the game.
- d. The two words have different meanings and definitions:
 - i. **Faith:** “allegiance to duty or a person” or “belief and trust in and loyalty to God.” “faith.” Merriam-Webster Online Dictionary. 2020. <https://www.merriam-webster.com/> (Aug. 21, 2020).
 - ii. **Hope:** “to cherish a desire with anticipation: to want something to happen or be true.” “hope.” Merriam-Webster Online Dictionary. 2020. <https://www.merriam-webster.com/> (Aug. 21, 2020).

SAMPLE QUESTIONS FOR RESPONDENT ISSUE II

1. A suggestive mark is not far behind an arbitrary mark in strength. Are you suggesting that a mark must be arbitrary to have conceptual strength?
2. Don’t film and videogames serve the same purpose, to provide entertainment, making a stronger argument for likelihood of confusion?
3. Because this court has to look at the mark as a whole, shouldn’t we ignore the fact that the word “Pantora” is already used by a jewelry company and a music streaming company?

AUTHORITY FOR ISSUE II

STATUTES:

15 U.S.C. §§ 1114

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive [...]

15 U.S.C. § 1127

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, 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.

CASES:

Circuit Court Decisions

AMF Inc. v. Sleekcraft Boats, (“*Sleekcraft*”) 599 F.2d 341 (9th Cir. 1979).

Facts: AMF owns the trademark to the name “Slickcraft” since April 1, 1969, and the mark has been used continuously for a line of recreational boats. Slickcraft boats are sold, distributed, and advertised nationally, and are sold by over one hundred retail outlets. AMF has spent, on average, \$200,000 annually on promoting the Slickcraft boats, with a gross sale of \$50,000,000. Appellee, Nescher, uses the name “Sleekcraft,” at the Nescher trademark. Sleekcraft was selected without knowledge of AMF’s use of “Slickcraft,” and after AMF notified Nescher of the trademark infringement, Nescher adopted a distinctive logo and the phrase “Boats by Nescher.” Popularity of Sleekcraft grew over the years with promotion costs increasing from \$6,800 in 1970 to \$126,000 in 1974. Gross sales of Sleekcraft also increased from \$331,000 in 1970 to \$6,000,000 in 1975. Nescher sells his boats through local dealers and advertises through

publications for boat racing enthusiasts and at boat shows. Slickcraft boats are primarily advertised in magazines of general circulation and at boat shows, some at the same show as Sleekcraft. The district court found that AMF has a valid trademark, but that Nescher did not infringe on that trademark.

Holding: The circuit court concluded that Nescher has infringed the Slickcraft mark due to the likelihood of confusion.

Rationale: In their analysis, the circuit court used an eight-part test to determine whether confusion between related goods is likely: **(1) Strength of the mark** – the court found that from the word Slickcraft, people might conjure up the image of appellant’s boats, but other images might also come up. However, the circuit court believes that buyers will understand that Slickcraft is a trademark because it is used in conjunction with the mark AMF. The court held that the mark is suggestive, but it is still a weak mark entitled to a narrow range of protection. Thus, infringement will be found, only if the marks are found to be similar and the goods closely related. **(2) Proximity of the goods** – The product lines are not competing but are close in use and function. Both boats are used for recreational purposes and are designed for water skiing and speedy cruises. They also have similar functions with fiberglass bodies, outboard motors, and open seating. However, Sleekcraft boats are for high speed recreation . The district court found that they are closely related and therefore a diminished standard of similarity is applied. **(3) Similarity of the marks** – Tested on sight, sound, and meaning. Sight: Sleekcraft and Slickcraft are the same except for two letters in the middle of the first syllable. Nescher argues that the distinctive logo should negate the similarity. The circuit court agrees with this argument, but also found that the logo is often absent. Nescher also argued that the court should disregard the suffix “craft” because it is common and just compare Slick and Sleek. The court disagreed with this argument, stating that they must consider the entire mark. Sound: They are distinguishable but only by a small part of a single syllable. Meaning: Nescher argues that they are different in meaning. However, the circuit court disagreed concluding that the words are virtual synonyms. **(4) Evidence of actual confusion** – AMF provided evidence that confusion occurred in the trade as well as the mind of the buying public. District court found that the amount of past confusion was negligible. Circuit court could not say that this was clearly erroneous. **(5) Marketing channels used** – No evidence that both boats were sold under the same roof – except at boat shows – otherwise, normal marketing channels were used by both parties. **(6) Type of goods and the degree of care likely to be exercised by the purchaser** – Both boats are high quality and expensive, thus buyers are generally more thoughtful and careful about their purchase. Also, when the good are generally of equal quality, there is little harm to the reputation of the trademarked goods. **(7) Defendant’s intent in selecting the mark** – No evidence of bad faith nor that Nescher was aware of AMF’s use of the Slickcraft mark. Also, after notification by AMF, Nescher designed a distinctive logo. **(8) Likelihood of expansion of the product lines** – Both parties are diversifying their model lines creating the potential that they will enter into each other’s submarkets.

Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 191 (9th Cir. 1963).

Facts: James Buchanan & Company manufactured “Black & White” Scotch whiskey. Buchanan owns a trademark for “Black & White” for whiskey. Fleischmann Distilling Corp. imported

“Black & White” Scotch whiskey into the United States. Maier Brewing began to produce and sell a beer called “Black & White.” Buchanan and Fleischmann sued for trademark infringement. The district court concluded that there was no competition between the two products.

Holding: The lower court erred in denying the injunction. Buchanan and Fleischmann have established a claim for trademark infringement.

Rationale: The appellate court does not need to follow the conclusion of the trial court if it finds the underlying facts to be clearly erroneous. Beer and whiskey are not directly competitive, but they are both types of alcohol which are generally sold together. Thus, it is likely that a consumer could be confused as to the source of the product.

A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 237 F.3d 198 (3rd Cir. 2000).

Facts: A&H Sportswear, Inc created and owned a registered trademark for a swimsuit line called “Miraclesuit.” Victoria Secret had a lingerie line called “The Miracle Bra,” and later created a swimsuit line under the same name. Victoria Secret has a housemark which it used as a general manufacturing mark for all its products. The Miracle Bra Swimsuit line included this housemark along with a disclaimer that The Miracle Bra was unrelated to the Miraclesuit. A&H sued for trademark infringement. The district court concluded that the use of a disclaimer weighed against a finding of consumer confusion.

Holding: The district court was correct in finding that Victoria Secret’s disclaimer defeated a direct-confusion claim. However, they were wrong to dismiss the claim. Therefore, the decision regarding direct-confusion is affirmed, the reverse-confusion claim is vacated, and the case is remanded for further proceedings.

Rationale: This is a reverse confusion claim which occurs if consumers incorrectly think a junior trademark user is the source of the senior. This occurs if the junior user is larger or better known than the senior user. The reverse confusion claim will require a different analysis from a direct-confusion claim. Analyzing under a reverse-confusion claim, a junior user's disclaimer will usually have little impact on consumer confusion when they see the senior user’s product.

Brookfield Commc’ns Inc. v. West Coast Ent. Corp., (“*Brookfield*”), 174 F.3d 1036, 1058 (9th Cir. 1999).

Facts: **Brookfield** Communications created a software program that had a database of entertainment industry information. The software was called MovieBuff, which Brookfield registered as a trademark under federal and state law. Brookfield attempted to register the domain name for moviebuff.com but found that it had already been taken by West Coast Entertainment, who intended to use the domain name to launch its own entertainment database. Brookfield sued for trademark infringement and sought an injunction that would prohibit West Coast from using moviebuff.com. The trial court denied this motion and Brookfield appealed.

Holding: The similarities between the two marks will cause a likelihood of confusion for potential consumers attempting to purchase Brookfield’s software.

Rationale: The MovieBuff mark and moviebuff.com are virtually identical given the fact that web addresses are not case-sensitive. Also, the use of .com is irrelevant given it's the age of the internet and the products they offer are very similar. Both use the internet to advertise and sell their product. Thus, these similarities will cause a likelihood of confusion for potential customers of Brookfield.

Zobmondo Ent., LLC v. Falls Media, LLC, 602 F.3d 1108, 1115 (9th Cir. 2010).

Facts: Falls Media published books that featured the phrase "WOULD YOU RATHER...?". Defendant, Zobmondo, dolls board games and books using the phrase "WOULD YOU RATHER...?". Falls Media then began selling board games using the same phrase. Zobmondo brought suit, and Falls Media then sued Zobmondo for trademark infringement. The district court concluded that "WOULD YOU RATHER...?" is not protectable under trademark law because it is descriptive.

Holding: The phrase "WOULD YOU RATHER..." is a descriptive term and is thus not protectable without secondary meaning. Thus, the summary judgement in favor of Zobmondo is reversed and remanded for trial.

Rationale: A descriptive trademark requires a secondary meaning in order for it to be protected under trademark law. If a mark or term is suggestive, then it is entitled to a degree of protection. The court first reviewed the imaginativeness a consumer must use to connect the mark to the product. If the mark describes the product then a consumer is not required to use imagination to connect the two. "WOULD YOU RATHER...?" is not in the dictionary and requires some imagination to figure out the board game will ask questions. There is also no evidence on how consumers would interpret or understand the phrase. Next, the court analyzed whether competitors of the trademark owner need the mark to describe competing products. If the competitor cannot describe the product without using the mark, then the mark is most likely descriptive. But if a competitor can describe the product without using the mark, then the mark is suggestive. Here, competitors would not need to use the phrase to sell competing board games.

Network Automation, Inc. v. Advanced Systems Concepts, Inc., 638 F.3d 1137, 1150 (9th Cir. 2011).

Facts: Advanced Systems owned the trademark registration for the term ActiveBatch, which it used as its name for its job scheduling and management software. Network Automation, competitor of Advanced Systems, created its own job scheduling and management software and marketed it to the same customers and used the same marketing channels. Google provided a program that allows advertisers to purchase key words that would provide customers with a link to the advertiser's products. Network purchased the keyword ActiveBatch so that Advanced Systems advertisements would return customers to the Network website. Advanced Systems sent cease-and-desist letters to Network to stop using their trademark. Network, in turn, filed a suit seeking a declaratory judgement of non-infringement. The court granted the preliminary injunction and held that there was a likelihood of confusion.

Holding: The district court incorrectly applied the likelihood of confusion test. Thus, the injunction is reversed, and the case is remanded.

Rationale: This court determined that the most important factors to be considered are: (1) the strength of the mark, (2) the evidence of actual confusion, (3) the type of goods and the carefulness of likely consumers, and (4) the context of the advertising and appearance on the user's screen. First, ActiveBatch is not a descriptive term because consumers searching for ActiveBatch are likely looking for Advanced Systems products. No evidence of actual confusion was presented, but it is not required and will not be given weight. This court then concluded that internet consumers are sophisticated and the high cost of the product decreases the likelihood of confusion. Network's advertisements are not labeled by source, which decreases the likelihood of confusion.

GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1206 (9th Cir. 2000).

Facts: GoTo.com is an internet-based company who alleges that Walt Disney infringed its trademarked logo. The GoTo logo consists of the words "Go" and "To" in white font and stacked vertically within a green circle. And the green circle is often seen displayed against a square yellow background. To the right of the word "To" is ".com," which spills out of the green circle and onto the background color. Disney hired a design firm called CKS to create a logo for its website, Go Network. The logo was supposed to look like a traffic light. It contains a green circle within a yellow square, with lenses and details similar to a traffic light. Within the green circle is the word "GO" which is in white font. Next to the traffic light is the word "Network," which is in black font. The district court granted GoTo.com's motion for a preliminary injunction which prohibited Disney from using the mark. Disney appealed the decision.

Holding: There is a likelihood of confusion between the two marks, therefore the district court's decision is affirmed, and the injunction is reinstated.

Rationale: Disney's logo is very similar to GoTo.com's mark and both are displayed on the internet and used commercially. Both have white capital letters with similar font inside a green circle, and the circle has a square yellow background. Both operate as search engines. The mark has also been displayed and advertised billions of times. Because the internet is more common, it is unconvincing that internet users are any more careful when online.

J. B. Williams Co., Inc. v. LeConte Cosmetics, Inc., 523 F.2d 187, 192 (9th Cir. 1975).

Facts: J.B. Williams produces hand soaps and shampoos using the trademark "Conti." Le Conte Cosmetics markets its line of cosmetics and hair products under the mark "Le Conte." J.B. Williams filed a complaint against Le Conte Cosmetics for trademark infringement. Both parties filed motions for summary judgement.

Holding: There was no likelihood of confusion, thus this court granted the motion for summary judgement in favor of LeConte Cosmetics.

Rationale: First, the court analyzed whether the mark seeking protection is strong or weak. “Conti” is an unknown made-up word and is therefore considered a strong mark. Their appearance is similar, but neither mark has any meaning in English. It was also determined that Americans would pronounce “Le Conte” with a French accent on the final syllable. There are several similarities between the two products and are similarly marketed.

Rockwood Chocolate Co. v. Hoffman Candy Co., 372 F.2d 552, 555 (C.C.P.A. 1967)

Facts: Rockwood sought to register “BAG-O-GOLD” as a mark for candy and asserted ownership of the mark “ROCKWOOD BAG-O-GOLD,” also for candy. Hoffman brought an opposition against the trademark application for “BAG-O-GOLD” and a petition to cancel the registration of the mark “ROCKWOOD BAG-O-GOLD.” Hoffman claimed it would cause the likelihood of confusion with its own mark, “CUP-O-GOLD,” which is also used for candy.

Holding: Hoffman has failed to establish a likelihood of confusion between the two marks.

Rationale: Between the marks “BAG-O-GOLD” and “CUP-O-GOLD,” the only difference between the two marks is a three-letter word used as a prefix suggestive of the container used to sell the candy. And even though “O-GOLD” is a suffix, the entire mark has to be considered on a question of similarity. However, there are differences if the word “ROCKWOOD” is included.

Survivor Media, Inc. v. Survivor Productions, 406 F.3d 625, 633 (9th Cir. 2005)

Facts: Surfivor sells a variety of Hawaiian beach themed products which it adorns with the “Surfvivor” mark. Surfivor owns three trademarks for the mark “Surfvivor,” which is an amalgamation of the words “surf” and “survivor.” About 30% to 50% of the Plaintiff’s products include the mark, with the remaining products adorning a tiny surfivor mark along with a third-party logo. The mark is the term “Surfvivor” in block or cursive writing and is often accompanied by a graphic such as a sun or surfer. Several years after Surfivor registered its name, Defendants began broadcasting the reality show Survivor. Defendant’s mark consists of the word “Survivor” in block letters and is often accompanied by other words like “outwit, outplay, and outlast.”

Holding: There is no likelihood of confusion between the two marks.

Rationale: This is a reverse confusion claim, which occurs when consumers who are doing business with the senior mark holder believe they are doing business with the junior one. The same eight factors from *Sleekcraft* are applied. “Surfvivor” is a coined term but does not rise to the protection of the fanciful. “Surfvivor” informs its consumers that their products are beach related. But, because some imagination is required to associate the company with beach products, it is a suggestive mark worthy of a certain amount of protection. The goods are not related enough so that consumers believe that the products come from the same source. The two marks look very similar, but “Survivor” is often accompanied by “outwit, outplay, and outlast.” They both sound very similar, but the meaning of the two works is very different. One is in reference to surfing or beach products, and the other is about “continue to exist or live.”