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10
 11 IN THE UNITED STATES DISTRICT COURT
 12 FOR THE SOUTHERN DISTRICT OF CALIFORNIA

13 _____)
 14 UNITED BRANDS COMPANY, INC.)
 15 Plaintiff)
 16 v.)
 17 ANHEUSER-BUSCH, INC.)
 18 Defendant)
 19)
 20)
 21)
 22)
 23)
 24)
 25)
 26 _____)

Civil Action No. 3:10-cv-02281- BEN (WMc)
**MEMORANDUM OF POINTS AND
 AUTHORITIES IN SUPPORT OF MOTION
 TO DISMISS PLAINTIFF’S CLAIMS FOR
 FEDERAL TRADEMARK
 INFRINGEMENT, FEDERAL
 TRADEMARK DILUTION, CALIFORNIA
 STATUTORY TRADEMARK DILUTION,
 FEDERAL TRADE DRESS
 INFRINGEMENT, COPYRIGHT
 INFRINGEMENT, CALIFORNIA
 STATUTORY TRADEMARK
 INFRINGEMENT, CALIFORNIA
 STATUTORY UNFAIR COMPETITION,
 COMMON LAW TRADEMARK
 INFRINGEMENT, AND COMMON LAW
 UNFAIR COMPETITION**
 [Fed. R. Civ. Pro. 12(b)(6)]
 Hearing Date: January 18, 2011
 Time: 10:30am
 Judge: Hon. Roger T. Benitez
 Courtroom No.: 3

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1 **I. INTRODUCTION**

2 Anheuser-Busch, Inc. (“A-B”) sells a line of flavored beverages branded under the TILT®
3 trademark. United Brands Company (“UBC”) has a line of flavored malt beverages that are
4 caffeinated and are sold under the totally dissimilar JOOSE brand. While UBC’s Complaint is rife
5 with general and unsupported allegations that the parties’ package designs are confusingly similar, the
6 viability of Complaint must rest on its specific counts for federal, state, and common law trademark
7 infringement, dilution, and unfair competition. Each of these claims, when analyzed, is fatally flawed.

8 First, UBC’s federal trademark infringement claim (Count I) requires ownership of a federal
9 trademark **registration**. The only registrations asserted by UBC are for the word mark “JOOSE” and a
10 “JOOSE & Design” logo. Neither of those registrations covers a mark that is even remotely similar to
11 A-B’s TILT® mark and neither covers – or is alleged to cover – the overall appearance of a single
12 flavor of UBC’s JOOSE beverages called “Dragon Joose.” As a matter of law, there can be no
13 trademark infringement claim between the marks “JOOSE” and “JOOSE & Design” on the one hand,
14 and A-B’s challenged beverage can design (in its entirety) on the other hand.

15 UBC’s copyright claim (Count IV) is based on UBC’s ownership of two copyright
16 registrations. Although UBC’s complaint does not attach the designs that are actually covered by the
17 registrations, A-B has obtained and annexed them to this motion. Copyright infringement requires
18 “substantial similarity” between the protectable elements of the respective designs. The Court will
19 observe that the “JOOSE Design” and the “Joose and Dragon Design” in the copyrights are not
20 “substantially similar” to A-B’s line of TILT® beverage cans.

21 UBC’s California state trademark infringement claim (Claim VI) requires ownership of a state
22 trademark registration. None is pled (and none exists).

23 UBC’s federal and state dilution claims (Claims II and V) require a showing that UBC’s
24 “Dragon Joose” can design is famous – that it is “widely recognized by the general consuming public.”
25 Under the law, UBC’s threadbare and conclusory allegations fail to satisfy this incredibly high
26 standard.

27 The rest of UBC’s claims are ostensibly directed towards A-B’s TILT® can design, and the
28 purported similarity between that design and the product design of one of UBC’s JOOSE flavors called

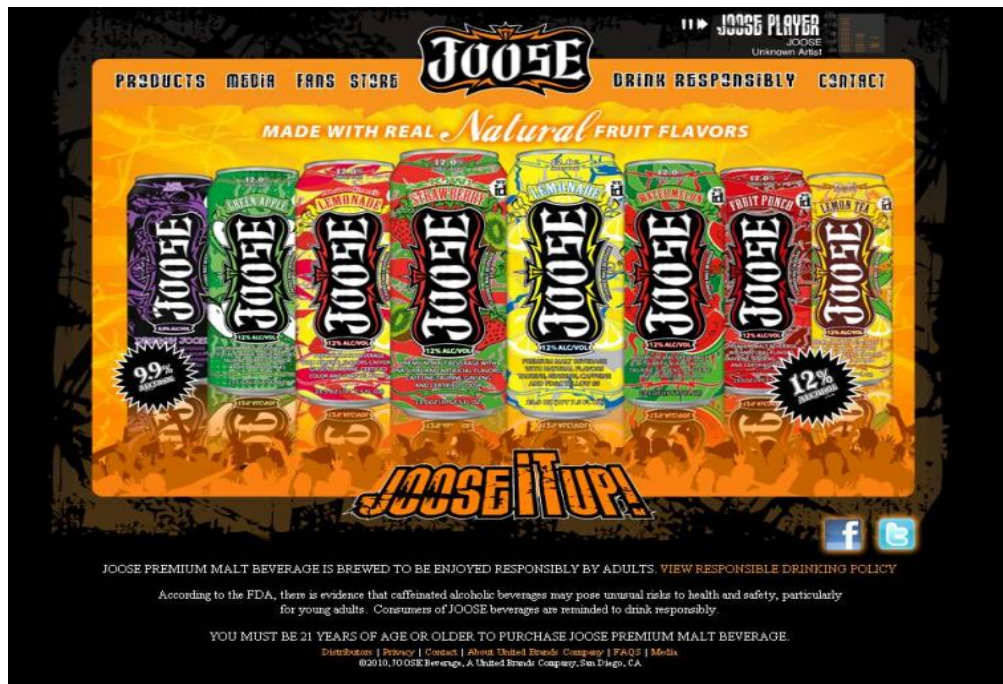
1 “Dragon Joose.” UBC does not own any federal trademark registration for this asserted “trade dress.”
2 The owner of an unregistered trade dress bears the burden of showing that the trade dress is inherently
3 distinctive or has acquired “secondary meaning” through advertising and public recognition. As
4 explained below, UBC’s complaint fails under Rule 12(b)(6) and the Supreme Court’s *Iqbal* decision
5 because UBC fails to plead facts sufficient to support its conclusory statement that its unregistered
6 “trade dress” is protectable. UBC attempts to, but cannot, bootstrap its sales and success of its *entire*
7 line of JOOSE products to support the recognition of its trade dress in only one of the JOOSE flavor
8 variations. UBC has not claimed, and cannot claim, that the can design for its single flavor of
9 DRAGON JOOSE (the only one on which its trade dress claims are based) has secondary meaning.

10 UBC’s remaining common law and unfair competition claims are doomed for similar reasons.
11 Accordingly, pursuant to Fed. R. Civ. P. 12(b)(6), the Court should dismiss UBC’s complaint in its
12 entirety for failure to state a claim. Dismissal should be with prejudice because the deficiencies cannot
13 be cured.

14 **II. FACTUAL ALLEGATIONS**

15 In 2005, A-B began marketing various fruit-flavored alcoholic malt beverages under the brand
16 name TILT. (Complaint at ¶ 25.) UBC alleges that it sells various flavored alcoholic malt beverages
17 under the brand name JOOSE. (*Id.* at ¶¶ 1 and 10.) UBC also alleges that it gives each of its flavors in
18 the JOOSE line of beverages different names, one of which is Dragon JOOSE, the subject of UBC’s
19 complaint. (*Id.* at ¶¶ 1 and 28.) Each of UBC’s JOOSE flavors has a representative creature or other
20 design (*e.g.* panther (Panther Joose), snake (Mamba Joose), apple design (Green Apple Flavor)). (*See*
21 *id.* at ¶ 28); *see also* www.drinkjoose.com/miva/merchant.mvc and [www.crescentcrown.com/](http://www.crescentcrown.com/united.html)
22 [united.html](http://www.joose.com).¹ UBC displays eight of the flavors in its JOOSE line on its product website at
23 www.joose.com as depicted below:

24
25
26 ¹ A-B requests that the Court take judicial notice of the depictions of UBC’s other can designs on its
27 website and a distributor’s website. *See Mack v. South Bay Beer Distributors*, 798 F.2d 1279, 1282
28 (9th Cir. 1986) (on a motion to dismiss “court may properly look beyond the complaint to matters of
public record”).



16 A-B refers to each of the flavors in each TILT line by the brand name and color, e.g. TILT
 17 Green. See <http://www.anheuser-busch.com/brandPages/tilt.html>.² UBC alleges that it has sold its
 18 JOOSE line of beverages since 2006, and the Dragon JOOSE flavor as a part of that line since 2007.
 19 (Complaint at ¶ 10.)

20 Recently, A-B re-designed the can in which it sells its TILT beverages. Each of A-B's TILT
 21 product cans now feature a different color – red, blue, green or purple – (which designate the
 22 beverage's flavor, e.g. green is lime flavored, etc.). These colors are blended with a mottled black
 23 background. *Id.* at ¶ 27.

27 ² A-B requests that the Court take judicial notice of the name of its products in the TILT line as shown
 28 on its website as a matter of public record. *Id.*



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12 UBC's "Dragon Joose" beverage can uses an entirely black background with purple design
13 elements. (*Id.* at ¶ 1.) A-B's TILT can features two highly stylized dragons holding a crown. (*Id.* at ¶
14 26.) UBC's Dragon JOOSE can features a different, single stylized dragon surrounding the JOOSE
15 brand name, which is displayed vertically in white capital letters. From a visual standpoint, the
16 JOOSE brand is by far the prominent feature on the can. (*Id.* at ¶ 1.) In contrast, as shown above, A-
17 B's TILT can prominently features the TILT name in large lowercase letters displayed horizontally
18 beneath a the dragon on both sides of a large stylized letter "T" imprinted on a shield. *Id.* UBC's
19 JOOSE can does not contain any corresponding element.

20 As is common of many alcoholic beverage products, A-B and UBC's respective TILT and
21 JOOSE cans both display their alcoholic content as well as a brief description of the beverage. *See*
22 <http://www.anheuser-busch.com/beerVerified.html>.³ *See also* Cal. Bus. & Prof. Code § 25204(a); 27
23 C.F.R. § 7.71(a) (outlining requirement to identify alcohol content).

24 UBC asserts a variety of alleged intellectual property rights in its complaint. With regard to
25 trademark rights, UBC only owns federal trademark registrations of the word JOOSE in standard
26

27 ³ A-B requests that the court take judicial notice of the alcoholic content displayed on its various
28 alcoholic beverages as shown on its website as a matter of public record. *See Mack*, 798 F.2d at 1282.

1 characters and the word JOOSE in stylized letters surrounded by some ornamentation, shown directly
2 below. (Complaint at ¶ 16.)

3 JOOSE (word mark)



9 (JOOSE & Design)

10 UBC does not own or plead ownership of a federal or California state trademark registration for
11 any dragon design. (*See id.* at ¶ 16.) UBC does not own or plead ownership of a federal or California
12 state trademark registration for its asserted can design or trade dress.

13 UBC's copyright infringement claim (Claim IV) is grounded upon two copyright registrations
14 that it obtained on September 27, 2010. (*Id.* at ¶ 14.) Those registrations are limited to a depiction of
15 its dragon design alone and its dragon with JOOSE in stylized letters, as follows:



1 UBC's claims for state and common law trademark infringement and unfair competition
2 (Claims VI-IX) rely on the same set of allegations as its federal trademark infringement claim.

3 UBC has not alleged any facts regarding sales figures or advertising figures specific to its
4 "Dragon Joose" product. The only sales figures alleged by UBC in its complaint relate to its entire line
5 of JOOSE products. (Complaint at ¶ 19.) Additionally, UBC only alleges that it has spent substantial
6 dollars in promoting its JOOSE line of beverages, and does not indicate what portion of the alleged
7 substantial investment is for the "Dragon Joose" product. (*Id.* at ¶ 18.) Further, UBC only alleges that
8 the "Dragon JOOSE Marks" are prominently featured in advertisements and promotions, but does not
9 allege any facts relating to any reference or highlighting of any of the alleged elements of the Dragon
10 JOOSE trade dress. (*See id.*)

11 **III. ARGUMENT**

12 A. STANDARDS APPLICABLE TO RULE 12(b)(6) MOTION TO DISMISS FOR 13 FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

14 Rule 12(b)(6) authorizes this Court to dismiss a cause of action that fails to state a claim upon
15 which relief can be granted. Dismissal of a claim is proper if the complaint fails to allege an element
16 which is necessary to the relief sought. *Moore's Federal Practice* § 12.34[4][a]; *see also Bruns v.*
17 *NCUA*, 122 F.3d 1251, 1257 (9th Cir. 1997) (liberal interpretation of a complaint "may not supply
18 essential elements of the claim that were not initially pled").

19 For purposes of this motion, the Court must accept all factual allegations of the complaint as
20 true and construe them in favor of the non-moving party. *North Star Int'l v. Arizona Corp. Comm'n.*,
21 720 F.2d 578, 580 (9th Cir. 1983) (declining to consider hypothetical situation and issues without
22 foundation in complaint). However, "conclusory allegations of law and unwarranted inferences are
23 insufficient to defeat a motion to dismiss for failure to state a claim." *Anderson v. Clow (In re Stac*
24 *Elecs. Sec. Litig.)*, 89 F.3d 1399, 1403 (9th Cir. 1996).

25 A dismissal under Rule 12(b)(6) can be based on either the lack of cognizable legal theory or
26 the lack of sufficient facts alleged under a cognizable legal claim. *SmileCare Dental Group v. Delta*
27 *Dental Plan*, 88 F.3d 780, 783 (9th Cir. 1996). "[O]nly a complaint that states a plausible claim for
28 relief survives a motion to dismiss." *Ashcroft v. Iqbal*, 556 U.S. ---, 129 S.Ct. 1937, 1950 (2009). *Id.*

1 at 1950. In order to state a plausible claim, the complaint must contain “factual content that allows the
2 court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Iqbal*,
3 129 S.Ct. at 1949. “Where a complaint pleads facts that are ‘merely consistent with’ a defendant’s
4 liability, it ‘stops short of the line between possibility and plausibility of entitlement to relief.’” *Id.* In
5 this respect, “[a] plaintiff’s obligation to provide the ‘grounds’ of his ‘entitlement to relief’ requires
6 more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will
7 not do.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). The Court need not accept as true
8 allegations that are conclusory, unwarranted deductions of fact, or unreasonable inferences. *Sprewell*
9 *v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001). “Threadbare recitals of the elements of a
10 cause of action, supported by mere conclusory statements” will not suffice. *Iqbal*, 129 S. Ct. at 1949;
11 *see also North Star Int’l*, 720 F.2d at 583 (dismissing complaint found to be “vague, conclusory, and
12 general” which did “not set forth any material facts in support of the allegations”).

13 Dismissal should be with prejudice and without leave to amend where any amendment would
14 prove futile. *Partington v. Bugliosi*, 56 F.3d 1147, 1162 (9th Cir. 1995) (denying motion to amend as
15 futile “[b]ecause it is clear that the deficiency in [] complaint could not have been overcome by
16 amendment). As explained below, the deficiencies in UBC’s complaint cannot be cured: it cannot
17 plead ownership of a relevant federal or state registration (*see* Claims I and VI); that its DRAGON
18 JOOSE “trade dress” is “famous among the general consuming public” (*see* Claims II and V), or
19 overcome the fundamental dissimilarity between the marks and designs at issue. *See, e.g., Campbell v.*
20 *Walt Disney Co.*, 718 F. Supp. 2d 1108, 2010 U.S. Dist LEXIS 67910 *18 (C.D. Cal. May 7, 2010)
21 (for a copyright infringement claim, lack of substantial similarity cannot be cured by amendment).

22 B. PLAINTIFF’S ALLEGATION OF FEDERAL TRADEMARK INFRINGEMENT
23 FAILS TO STATE A CLAIM FOR WHICH RELIEF CAN BE GRANTED (CLAIM I)

24 UBC’s federal trademark infringement claim (Claim I) is fundamentally flawed because the
25 trademarks JOOSE and JOOSE & Design, which are the subject of the only two federal trademark
26 registrations pleaded by UBC, are so fundamentally different from A-B’s accused TILT can design and
27 its mark TILT & Design that there cannot be any likelihood of confusion.

28

1 Section 32(1) of the Federal Trademark Act, 15 U.S.C. § 1114(1), imposes liability for
2 infringement of a federally registered mark, and specifically defines liability in terms of the
3 defendant’s “use in commerce [of] any reproduction, counterfeit, copy or colorable imitation of a
4 *registered mark . . .*” (Emphasis added). Accordingly, to state a claim for relief under § 32(1), the
5 complaint must allege that the defendant is using a mark which is confusingly similar to a mark which
6 is the subject of a federal registration owned by the plaintiff and pleaded in the complaint. *See* 6
7 *McCarthy on Trademarks and Unfair Competition* §32:3 (4th ed. 2010) (“it is clear on the face of the
8 statute that plaintiff must be the “registrant” of an already issued and outstanding registration” to bring
9 a § 32 infringement claim); *Wells Fargo & Co. v. Wells Fargo Express Co.*, 556 F.2d 406, 426 (9th
10 Cir. 1977) (“Lanham Act grants a *registrant* a civil right of action against ‘any person who shall . . .
11 use in commerce,’ in any improper manner detailed therein, a *registered* trademark”) (emphasis added)
12 (internal citation omitted); *Fila Sport, S.p.A. v. Diadora America, Inc.*, 141 F.R.D. 74, 80 (N.D. Ill.
13 1991) (granting motion to dismiss trademark infringement claim in absence of federal trademark
14 registration); *Herbert Products, Inc. v. S & H Industries, Inc.*, 1977 U.S. Dist. LEXIS 12153, *8
15 (E.D.N.Y. Dec. 28, 1977) (“registration is a procedural prerequisite to suit under 15 USC § 1114(1).”)

16 Paragraph 16 of UBC’s complaint alleges ownership of only two federal registrations of the
17 mark JOOSE as shown below:

- 18 (1) Registration No. 3,263,454

19 JOOSE
20

- 21 (2) Registration No. 3,465,813



1 Although Paragraph 16 also alleges ownership of Application Serial No. 85/139,185 for a “Dragon
2 Design” mark,⁴ a pending federal application cannot support a claim for infringement under § 32(1)
3 because it has not yet matured into a registration. *See, e.g., 3-11 Gilson on Trademarks* § 11.03 (2010)
4 (“The mere pendency of an application for federal trademark registration...is not sufficient for
5 jurisdiction under Section 32”); *Hosid Products, Inc. v. Masbach, Inc.*, 108 F. Supp. 753, 755
6 (N.D.N.Y. 1952) (pleading federal applications insufficient).

7 UBC’s claim for federal trademark infringement under § 32(1) is asserted in ¶¶ 53-57 of its
8 complaint and incorporates by reference ¶¶ 1-51. The complaint alleges that UBC is the owner of the
9 “federally registered JOOSE Marks listed above,” which refers to the two registrations identified in ¶
10 16 of the complaint shown above. (Complaint at ¶ 54.) The complaint next alleges that the trademark
11 and trade dress used by A-B in connection with its TILT product is “identical to and/or confusingly
12 similar to United Brands’ federally registered JOOSE marks.” (*Id.* ¶ 55.) The “federally registered
13 JOOSE marks” consist only of the word mark JOOSE and the stylized word mark JOOSE & Design
14 shown above, which are the subject of the two trademark registrations listed in ¶ 16 of the complaint.

15 “To maintain an action for trademark infringement under 15 U.S.C. § 1114...a plaintiff must
16 prove the defendant's use of the same or similar mark would create a likelihood of consumer
17 confusion.” *Murray v. Cable NBC*, 86 F.3d 858, 860 (9th Cir. 1996) (affirming dismissal of trademark
18 infringement claim on a motion to dismiss, finding no confusion based on marks and services). The
19 Ninth Circuit uses the eight factors set forth in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 599 (9th Cir.
20 1979), to analyze likelihood of confusion.⁵ The list of *Sleekcraft* factors “functions as a guide and is
21 neither exhaustive nor exclusive.” *Metro Pub. v. San Jose Mercury News*, 987 F.2d 637, 640 (9th Cir.
22 1993). The Ninth Circuit has “long cautioned that applying the *Sleekcraft* test is not like counting
23 beans. Some factors are much more important than others, and the relative importance of each

24 _____
25 ⁴ A true copy of the Dragon Design mark that is the subject of Application Serial No. 85/139,185 is
annexed hereto as Exhibit A.

26 ⁵ These factors are: (1) the strength of the plaintiff’s mark, (2) the proximity of the goods, (3) the
27 similarity of the marks, (4) any evidence of actual confusion, (5) marketing channels, (6) the degree of
care likely to be exercised by purchasers, (7) the defendant’s intent in selecting the challenged mark,
28 and (8) the likelihood of expansion of the parties’ product lines.

1 individual factor will be case-specific.” *One Indus., LLC v. Jim O’Neal Distrib.*, 578 F.3d 1154, 1162
2 (9th Cir. 2009) (citations omitted); *see also Murray*, 86 F.3d at 861 (affirming 12(b)(6) dismissal of a
3 trademark infringement claim on a small sub-set of *Sleekcraft* factors).

4 “The similarity of marks has always been considered a critical question in the likelihood-of-
5 confusion analysis.” *M2 Software, Inc. v. Madacy Entm’t*, 421 F.3d 1073, 1082 (9th Cir. 2005)
6 (citation omitted); *One Indus.*, 578 F.3d at 1162 (similarity of the marks factor “will always be
7 important”). The trademarks JOOSE and JOOSE & Design depicted on page 8 are so fundamentally
8 different from A-B’s TILT & Design mark and TILT beverage can shown in ¶ 26 of the complaint that
9 the concurrent use of these trademarks cannot result in any likelihood of confusion, which is a critical
10 element of a § 32(1) infringement claim. *See, e.g., Thane International, Inc. v. Trek Bicycle Corp.*,
11 305 F.3d 894, 900 (9th Cir. 2002) (The federal statute prohibiting trademark infringement requires a
12 trademark holder to prove that the alleged infringer’s use of a mark “is likely to cause confusion, or to
13 cause mistake, or to deceive.”); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1018 (9th
14 Cir. 2004) (“core element of trademark infringement is whether the similarity of the marks is likely to
15 confuse customers about the source of the products”).

16 “The confusion must be probable, not simply a possibility.” *Murray*, 86 F.3d at 861 (citation
17 omitted); *Nutrishare, Inc. v. BioRx, LLC*, 2008 U.S. Dist. LEXIS 86923, *5 (S.D. Cal. Oct. 23, 2008).
18 The Ninth Circuit has dismissed trademark infringement claims under Rule 12(b)(6) where the
19 allegations did not support any probable finding of likelihood of confusion. *E.g., Toho Co. v. Sears,*
20 *Roebuck & Co.*, 645 F.2d 788, 790 (9th Cir. 1981) (affirming Rule 12(b)(6) dismissal where facts
21 alleged, including dissimilarity of the marks, would not “permit a conclusion that consumers are likely
22 to be confused as to source or sponsorship”); *Murray*, 86 F.3d at 861; *see also Marvel Enterprises, Inc.*
23 *v. NCSoft Corp.*, 2005 U.S. Dist. LEXIS 8448 (C.D. Cal. Mar. 9, 2005) (granting 12(b)(6) motion to
24 dismiss where plaintiff did not own a registration for the image of the character and dissimilarity of the
25 word marks “Statesman” and “Captain America” was “self-evident”). Here confusion is not probable
26 or even possible because of the self-evident dissimilarity between JOOSE and TILT. Indeed, there are
27 no similarities between UBC’s “JOOSE” word mark and A-B’s “TILT” word mark. Further there are
28

1 no similarities between the stylization in UBC's JOOSE & Design mark shown in pleaded Registration
2 No. 3,465,813 and A-B's TILT can or TILT word mark.

3 Beyond that striking dissimilarity, UBC's failure to meet other *Sleekcraft* factors also warrants
4 a finding of no likelihood of confusion and thus dismissal. UBC's complaint does not identify the
5 class of purchasers other than the "consuming public" or describes the degree of care likely to be
6 exercised by such consumers. Consumers purchasing UBC's and A-B's alcoholic beverages are likely
7 to exhibit some degree of sophistication in their purchases and to identify the parties' products by their
8 respective names, JOOSE and TILT (a brand that UBC's complaint concedes has been on the market
9 since August 2005, prior to UBC's release of JOOSE), rather than their package design. UBC also has
10 not alleged that any instances of actual confusion have occurred. Where a plaintiff has made a weak
11 showing on other likelihood of confusion factors, "probably nothing short of a showing of actual
12 confusion would be strong enough to swing the case in its favor." *Oreck Corp. v. U.S. Floor Systems,*
13 *Inc.*, 803 F.2d 166, 173 (5th Cir. 1986). Here, the overwhelming dissimilarity of the marks in itself
14 dooms UBC's § 1114 claim, and the absence of other facts sufficient to overcome that dissimilarity
15 supports dismissal. "A trademark infringement suit may be dismissed on a 12(b)(6) motion if the
16 allegations are totally without a legal foundation that could lead to liability." *McCarthy* §32:121:25.
17 Accordingly, UBC's federal infringement claim (Claim I) must be dismissed with prejudice because it
18 cannot be cured.⁶

19
20
21 ⁶ As noted above, UBC does not own, or plead ownership of, a subsisting federal registration which
22 covers the Dragon Design mark shown in Application Serial No. 85/139,185 either alone or in
23 combination with the word mark JOOSE. See Exhibit A, which is a true copy of a print out of the
24 TARR Portal for Application Serial No. 85/139,185 taken from the website of the U.S. Patent and
25 Trademark Office. A-B respectfully requests the Court, in accordance with Fed. R. Evid. 201 take
26 judicial notice of the fact that this application was filed on September 27, 2010 and that no substantive
27 action has been yet been taken by a Trademark Examining Attorney in connection with this
28 application. *Even if* UBC did own a federal registration of the Dragon Design mark, this would not
alter the likelihood of confusion analysis because, as discussed *supra* in Section E with regard to
UBC's trade dress claim, UBC's and A-B's depictions of dragons on their cans show no similarity
beyond the fact that they both are dragons. As the Ninth Circuit has previously recognized the "mere
fact that the two companies are direct competitors and happen to use the same letter on their products
is not sufficient to show infringement." *One Indus.*, 578 F.3d at 1165. Accordingly, the presence of
dragons on A-B's TILT can cannot establish infringement.

1 C. PLAINTIFF'S ALLEGATION OF FEDERAL TRADEMARK DILUTION FAILS TO
2 STATE A CLAIM FOR WHICH RELIEF CAN BE GRANTED (CLAIM II)

3 1. UBC's § 43(c) Dilution Claim Cannot Be Based on Trade Dress Rights
4 in the "Dragon Joose" Packaging Because the Claim Fails to Allege
5 Sufficient Facts to Establish that Such Trade Dress Is Famous within the
6 Meaning of § 43(c)(2)(A)

7 A dilution claim can only be brought to protect a **famous** mark. Section 43(c)(2)(A) defines a
8 famous mark for dilution purposes as one that "is widely recognized by the general consuming public
9 of the United States as a designation of source of the goods or services of the mark's owner."
10 Examples of famous marks include COCA-COLA, INTEL, KODAK and BUDWEISER. To the
11 extent that UBC's § 43(c) dilution claim relies on its purported trade dress rights in the Dragon Joose
12 packaging (*e.g.* ¶ 30), it fails to state a claim upon which relief can be granted because the complaint
13 does not allege sufficient facts to establish that such trade dress is famous within the meaning of §
14 43(c)(2)(A), namely, that such trade dress is "widely recognized by the general consuming public in
15 the United States." Dilution is "reserved for a select class of marks -- those marks with such powerful
16 consumer associations that even non-competing uses can impinge their value." *Thane Intern.*, 305
17 F.3d at 907 (no dilution where plaintiff had not even made minimal showing of the required level of
18 fame among the general consuming public, as opposed to simply among bicycle enthusiasts); *Avery*
19 *Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999) ("to meet the 'famousness' element of
20 protection under the dilution statutes, a mark must be truly prominent and renowned"); *Planet Coffee*
21 *Roasters, Inc. v. Dam*, 2009 U.S. Dist. LEXIS 70775, *8-*9 (C.D. Cal. Aug. 12, 2009) ("[d]ilution
22 protection extends only to those whose mark is a 'household name.'")

23 Moreover, given the clear mandate of Fed. R. Civ. P. 11(b)(3) that all factual allegations in a
24 pleading must be based on a reasonable inquiry and have evidentiary support, it is difficult to see how
25 UBC could even amend its complaint to allege the necessary degree of public recognition prescribed
26 by § 43(c)(2)(A). In *Planet Coffee* the district court granted a Rule 12(b)(6) motion to dismiss the
27 dilution claim finding that "Plaintiff has not alleged facts sufficient to show that its mark is nationally
28 famous." 2009 U.S. Dist. LEXIS 70775 at *9. Similarly, UBC has not alleged facts, nor can it allege

1 facts, demonstrating national fame among the general public. Significantly, UBC’s purported trade
2 dress claims are based on its “Dragon Joose” product, which is only a *single* flavor in a line of
3 alcoholic beverages. (Complaint at ¶¶ 10, 15.)⁷ The JOOSE line of beverages only recently came into
4 existence in 2006, and the “Dragon Joose” flavor was not launched until 2007. (*Id.* ¶ 10.) The limited
5 time in which UBC has sold its “Dragon Joose” flavor is insufficient to make the design of the can
6 “truly prominent and renowned” or a “household name.” Additionally, the sales figures cited by UBC
7 relate to its *entire* line of Joose beverages (of which there are many) and is not limited to the “Dragon
8 Joose” flavor such that it is not possible to determine what percentage of those sales are even for
9 Dragon Joose, or whether UBC is even alleging that its “Dragon Joose” trade dress is “famous.”
10 Finally, a “lack of registration also weights heavily in favor of a finding that... [a] mark is not
11 famous.” *Network Automation, Inc. v. Hewlett-Packard Co.*, 2009 U.S. Dist. LEXIS 125835, *34
12 (C.D. Cal. Sept. 14, 2009) (granting summary judgment dismissing dilution claim). UBC does not
13 allege any federal registration for its alleged trade dress, nor does any exist. UBC’s claim for federal
14 dilution (Claim II) should be dismissed.

15 2. The Fundamental Differences Between Plaintiff’s Federally Registered
16 Marks JOOSE and JOOSE & Design and Defendant’s Mark TILT &
17 Design Precludes a Finding that Dilution Is Likely

18 One of the key elements in a federal trademark dilution claim, as set forth in § 43(c)(1), is that
19 the challenged use is likely to cause dilution by blurring of the distinctiveness of the plaintiff’s famous
20 mark. In considering whether such dilution is likely, the first factor (and one of most important)
21 considered by the courts pursuant to § 43(c)(2)(B)(i) is the “degree of similarity between the mark or
22 trade name and the famous mark.” The law is clear in the Ninth Circuit that the degree of similarity
23 must rise to the level of identical or nearly identical before likelihood of dilution can occur. *See*
24 *Playboy Enterprises, Inc. v. Welles*, 279 F.3d 796, 806 (9th Cir. 2002) (“PMOY” could not as a matter
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26
27 ⁷ Although the Complaint is curiously vague on this issue, the only “JOOSE” can that contains the
28 “Dragon Design” is the “Dragon Joose” flavor. None of UBC’s other JOOSE cans or flavors bear the
“Dragon design.”

1 of law dilute “Playmate of the Year” because terms were “not identical or nearly identical”); *Thane*
2 *Intern.*, 305 F.3d at 905; *Visa International Service Assoc. v. JSL Corp.*, 610 F.3d 1088, 1090 (9th
3 Cir. 2010) (granting summary judgment on a dilution claim because the marks were “effectively
4 identical”); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 2009 U.S. Dist. LEXIS 50542,
5 *19 (N.D. Cal. June 1, 2009) (Ninth Circuit “continues to recognize the ‘identical or nearly identical’
6 requirement” for dilution under the Trademark Dilution Revision Act of 2006⁸) (citation omitted);
7 *Planet Coffee Roasters*, 2009 U.S. Dist. LEXIS 70775 at *8-*9; *see also, EA Entertainment Television,*
8 *Inc. v. Entertainment One GP Ltd.*, 363 Fed. Appx. 510 (9th Cir. 2010) (unpublished) (party claiming
9 dilution “must demonstrate that the marks are ‘identical’ or ‘nearly identical’ so that a ‘significant
10 segment of the target group of customers sees the two marks as essentially the same’”) (citations
11 omitted). The similarity of the marks tests is “more stringent...in the dilution context than in the
12 infringement context.” *Thane Intern.*, 305 F.3d at 906.

13 To the extent that UBC’s allegation of trademark dilution under § 43(c) of the Federal
14 Trademark Act, 15 U.S.C. § 1125(c), relies on the pleaded federal trademark registrations identified in
15 ¶ 16 of the complaint, it fails to state a claim upon which relief can be granted because the trademarks
16 JOOSE and JOOSE & Design covered by those registrations are not identical or nearly identical to A-
17 B’s mark TILT & Design. (*See infra* Section B.) Nor is the alleged Dragon Design mark covered by
18 UBC’s application nearly identical to the two dragons depicted on A-B’s TILT can such that a
19 significant segment of the target group of customers would view the marks as essentially the same.
20 Having failed to meet the similarity requirement under a trademark infringement analysis, UBC cannot
21 even begin to establish the higher degree of dissimilarity required for a dilution claim. The
22 fundamental dissimilarity between these marks precludes any finding of likelihood of dilution, which
23 is a critical prerequisite for liability for dilution under § 43(c).

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27 _____
28 ⁸ Pub. L. No. 109-312, 120 Stat. 1730 (2006).

1 D. PLAINTIFF'S ALLEGATION OF STATE TRADEMARK DILUTION FAILS TO
2 STATE A CLAIM FOR WHICH RELIEF CAN BE GRANTED (CLAIM V)

3 UBC's claim for California Statutory Dilution under Cal. Bus. & Prof. Code § 14247 fails for
4 the same reasons as its federal dilution claim. *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1324
5 (9th Cir. 1998) (state dilution analysis same as federal dilution); *Jarritos, Inc. v. Los Jarritos*, 2007
6 U.S. Dist. LEXIS 32245, *55-56 (N.D. Cal. May 2, 2007) reversed on other grounds, *Jarritos v. Reyes*,
7 345 Fed. Appx. 215 (9th Cir. 2009) (unpublished); *Nike, Inc. v. Nikepal Int'l, Inc.*, 2007 U.S. Dist.
8 LEXIS 66686, *15 n. 7 (E.D. Cal. Sept. 7, 2007). Under Section 14247, "a mark is famous if it is
9 *widely recognized by the general consuming public of this state*, or by a geographic area of this state,
10 as a designation of source of the goods or services of the mark's owner." UBC's complaint alleges that
11 its "line of JOOSE flavored malt beverages, including DRAGON JOOSE, has been tremendously
12 successful both nationally and in California" (at ¶82) and summarily concludes that the "DRAGON
13 JOOSE Marks have become famous, and became famous prior to the acts of Defendants." (*Id.* at ¶
14 83.) As explained in Section C, UBC has not and cannot plead that its "Dragon Joose" trade dress is
15 famous among the general consuming public and its threadbare and conclusory allegations is hardly
16 sufficient. Accordingly, UBC's Claim V should be dismissed.

17 E. PLAINTIFF'S ALLEGATION OF FEDERAL TRADE DRESS INFRINGEMENT
18 AND FALSE DESIGNATION OF ORIGIN FAILS TO STATE A CLAIM FOR
19 WHICH RELIEF CAN BE GRANTED (CLAIM III)

20 In order to state a claim for trade dress infringement under § 43(a) of the Federal Trademark
21 Act, 15 U.S.C. § 1125(a), UBC must demonstrate that its asserted trade dress: (1) is nonfunctional; (2)
22 is either inherently distinctive or has acquired a secondary meaning; and (3) is likely to be confused
23 with the design of A-B's TILT product by members of the consuming public. *One Indus.*, 578 F.3d at
24 1166. Just as UBC's trademark infringement claim fails due to the dissimilarity of the marks, so does
25 its trade dress claim, as the additional allegations of background elements on UBC's Dragon Joose
26 product cannot support a finding of likelihood of confusion.

27 A simple comparison of UBC's and A-B's cans for their products reveals that the elements
28 UBC alleges as similarities are either not in fact similar or consist of commonplace or functional

1 elements for beverage cans that cannot form the basis for a trade dress claim. Functional or
2 commonplace elements that UBC attempts to assert rights in include white lettering, centering the
3 name of the product on a can, using a dark background with colored elements,⁹ placing a description of
4 the product in plain font on the can, displaying the alcohol volume content (as required by law) and
5 offering product in a 24 ounce can. (Complaint at ¶¶ 30-31.) The respective dragon designs, fonts and
6 overall can design used by each party are different. *See Toho*, 645 F.2d at 790 (affirming 12(b)(6)
7 dismissal of § 1125(a) claim based on no likelihood of confusion where parties used different
8 representations of a creature). Although UBC asserts that it uses a “crown” design, the stylization
9 around the JOOSE design is not readily discernable as a “crown” and in any case is different from the
10 crown used by A-B.

11 UBC alleges that its trades dress is both product design and product packaging and that its trade
12 dress is inherently distinctive. (Complaint at ¶ 65.) However, the Supreme Court has held that trade
13 dress is either product design or product packaging, it cannot be both, and if a trade dress is product
14 design it can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S.
15 205, 214-15 (2000). Accordingly, if UBC alleges its trade dress is product design, it has not alleged
16 secondary meaning for its trade dress (and cannot do so) and thus fails to allege an essential element of
17 the claim.

18 In contrast, if UBC alleges its trade dress is product packaging its claim fails because it has not
19 alleged facts showing that consumers recognize the “Dragon Joose” packaging, separate and apart
20 from the JOOSE trademark, as an indication of source. *See Wal-Mart Stores*, 529 U.S. at 214-15
21 (“where it is not reasonable to assume consumer predisposition to take...packaging as indication of
22 source ... inherent distinctiveness will not be found”). As shown on page 3 above, the “Dragon Joose”
23

24 ⁹ “The two trade dresses are similar in overall appearance only to the extent that they both feature
25 “aggressive” graphics and bold accent colors against dark backgrounds. However, these elements are
26 widely employed in the crowded energy drink market and are therefore unlikely to lead to confusion as
27 to source.” *Hansen Beverage Co., v. National Beverage Corp.*, 493 F.3d 1074, 1079 (9th Cir. 2007)
28 *vacated by, appeal dismissed by* 499 F.3d 923 (9th Cir., Aug. 17, 2007). Although the Ninth Circuit
vacated its opinion in *Hansen* due to the mootness of the dispute because the parties settled before the
opinion issued, the Ninth Circuit’s finding about the color scheme of beverage can is still noteworthy
and persuasive.

1 beverage, which is the only beverage that bears the asserted trade dress, is one of at least 8 beverage
2 designs used by UBC to sell its JOOSE products. There is no consistency between these beverage can
3 designs from which one could conclude that the “Dragon Joose” can design serves as a source
4 identifier. Rather, it is the prominently placed JOOSE and TILT word marks that serve the source
5 identification for the parties’ products and the differences in these marks preclude any confusion.¹⁰
6 *See Trovan Ltd. v. Pfizer, Inc.*, 107 Fed. Appx. 788, 790 (9th Cir. 2004) (unpublished) (similarity
7 reduced where defendant used its housemark in conjunction with the sale of its product); *Aurora*
8 *World, Inc. v. TY Inc.*, 2009 U.S. Dist. LEXIS 129128 (C.D. Cal. Dec. 15, 2009) (“presence of such a
9 prominent tag bearing Ty's logo negates a claim of confusion”).

10 F. PLAINTIFF’S ALLEGATION OF COPYRIGHT INFRINGEMENT FAILS TO
11 STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED (CLAIM IV)

12 In order to state a cognizable copyright infringement claim, UBC must allege ownership of a
13 valid copyright, and the copying of constituent elements of the work that are original to it. *Feist*
14 *Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). The copying element requires proof of
15 access to the copyrighted work and a showing that the allegedly infringing work is *substantially*
16 *similar* to the protected elements of the copyrighted work. UBC has alleged ownership of two
17 copyright registrations, but its complaint does not plead what designs are actually covered by those
18 copyright registrations. Further, beyond making a conclusory allegation that the “new TILT Design
19 looks substantially similar” to UBC’s copyrights, UBC alleges no facts identifying elements of the
20 TILT can that are substantially similar to its copyrighted designs.

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24 _____
25 ¹⁰ “The appearance of the competing trade dress speaks for itself. Monster products are distinguishable
26 from the other energy drinks on the market largely because the word ‘Monster’ and a large ‘M’ are
27 prominently displayed on the cans. Freek's trade dress does not feature either of these source-
28 identifying marks; instead, it displays prominently its own trade name (‘Freek’) along with a
distinctive depiction of a distorted and frightening face (the so-called ‘Freek Man’). These very
significant differences weigh heavily against a finding that consumer confusion is likely to result from
the overall look of the packaging.” *Hansen Beverage*, 493 F.3d at 1079.

1 Even barring UBC's deficient pleading, UBC's claim also should be dismissed because it
2 cannot prove substantial similarity as a matter of law.¹¹ The Ninth Circuit has found that "[t]here is
3 ample authority for holding that when the copyrighted work and the alleged infringement are both
4 before the court, capable of examination and comparison, non-infringement can be determined on a
5 motion to dismiss." *Christiansen v. West Pub Co.*, 149 F.2d 202, 203 (9th Cir. 1945) (affirming
6 12(b)(6) dismissal of copyright infringement claim where only similarities between maps was the
7 outline of the United States and the manner of grouping, neither of which was original to plaintiff or
8 protectable under copyright law). "To constitute infringement there must be a substantial copy of the
9 whole or of a material part of the copyrighted work." *Id.* Courts have routinely granted Rule 12(b)(6)
10 motions to dismiss for copyright infringement where, as here, the requisite substantial similarity is not
11 present. *E.g.*, *Campbell*, 2010 U.S. Dist LEXIS 67910 at *18; *Capcom Co. v. MKR Group, Inc.*, 2008
12 U.S. Dist. LEXIS 83836, *2 (C.D. Cal. Oct. 10, 2008); *Thomas v. Walt Disney Co.*, 2008 U.S. Dist.
13 LEXIS 14643, *17 (N.D. Cal. Feb. 14, 2008); *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1138
14 (C.D. Cal. Dec. 18, 2007); *Identity Arts v. Best Buy Enterprises Services, Inc.*, 2007 U.S. Dist. LEXIS
15 32060, *82 (N.D. Cal. Apr. 18, 2007); *Lake v. Columbia Broadcasting System, Inc.*, 140 F. Supp. 707,
16 709 (S.D. Cal. Jan. 5, 1956).

17 In order to prove copying sufficient to withstand a Rule 12(b)(6) motion to dismiss, UBC must
18 show that A-B's TILT can is substantially similar to protected elements alone of UBC's copyrighted
19 designs; non-protectable ideas or uncopyrightable elements of UBC's design may not be considered.
20 *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002). The Ninth Circuit uses the

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23 ¹¹ In order to conduct a substantial similarity analysis, A-B requested and obtained copies of the
24 deposit material from UBC for its asserted copyrights, Registration Nos. VA 1-736-747 and VA 1-737-
25 466 which are attached hereto as Exhibits B and C respectively. "Documents whose contents are
26 alleged in a complaint and whose authenticity no party questions, but which are not physically attached
27 to the pleading, may be considered in ruling on a Rule 12(b)(6) motion to dismiss" without converting
28 the motion to dismiss into a motion for summary judgment. *Branch v. Tunnell*, 14 F.3d 449, 454 (9th
Cir. 1994). Moreover, under Fed. R. Evid. 201, a court may take judicial notice of "matters of public
record." *Mack*, 798 F.2d at 1282. The deposit material for UBC's copyright registrations are both
documents whose contents are alleged in the complaint and matters of public record and thus may be
considered on the motion to dismiss.

1 extrinsic test to evaluate substantial similarity which examines specific criteria including “the type of
2 artwork involved, the materials used, the subject matter, and the setting for the subject.” *Sid & Marty*
3 *Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (noting
4 that substantial similarity “may often be decided as a matter of law). “[E]xpressions that are standard,
5 stock, or common to a particular subject matter or medium are not protectable under copyright law.”
6 *Satava v. Lowry*, 323 F.3d 805, 810 (9th Cir. 2003). Further, where there is only a narrow range of
7 expression then copyright protection is “thin” and “protects against only virtually identical copying.”
8 *See Satava*, 323 F.3d at 810 (finding that realistic depictions of live animals entitled to thin copyright
9 protection).

10 UBC’s copyrighted designs contain *only* the dragon design element from its can. Any design
11 elements that are standard or commonly used to depict a dragon are not protectable under copyright
12 law, and further UBC’s design is of such a type that copyright protection is thin. Thus, UBC must
13 show virtual identical copying and it cannot meet this standard or the more lenient substantial
14 similarity standard.

15 Based on a facial comparison of the copyrighted designs with A-B’s TILT can (as is the proper
16 comparison), the overall designs, including the depicted dragons, are different. A-B’s TILT can
17 features the side view of two dragons facing each other in a crest-like formation, while UBC’s JOOSE
18 can depicts the front view of a single dragon, which is difficult to perceive. A-B’s dragons are more
19 stylized and appear to form a wreath-like design around a stylized letter “T” while UBC’s dragon
20 appears to be rendered in a more life-like manner. A-B’s dragon design clearly depicts the wings on
21 both dragons; UBC’s dragon does not appear to have any wings. UBC’s dragon is posed surrounding
22 the JOOSE name, A-B’s dragons are posed on other side of a crown. One of UBC’s copyrighted
23 designs prominently features its JOOSE mark surrounded by its dragon design, A-B’s dragon designs
24 are separated from its distinctly different TILT mark.

25 The mere fact that UBC depicts a dragon on its can does not prevent A-B from depicting a
26 different dragon on its product and such limited similarity is insufficient to meet the substantial
27 similarity required for copyright infringement as a matter of law. *See Aliotti v. R. Dakin & Co.*, 831
28 F.2d 898, 901 (9th Cir. 1987) (cannot rely “upon any similarity in expression resulting from either the

1 physiognomy of dinosaurs or from the nature of stuffed animals); *Aurora World*, 2009 U.S. Dist.
2 LEXIS 129128 at *49 (cannot claim infringement based on the fact that defendant sells a toy depicting
3 the same animal as plaintiff’s toy); *see also Toho*, 645 F.2d at 790 (on a 12(b)(6) motion no likelihood
4 of confusion where parties used different representations of a creature). Similarly, in *Cory Van Rijn,*
5 *Inc. v. California Raisin Advisory Bd.*, 697 F. Supp. 1136, 1144 (E.D. Cal. 1987), the court dismissed a
6 copyright infringement claim on a 12(b)(6) motion finding that there were no extrinsic similarities
7 between the works except for the presence of a raisin shaped body and head, which merely resulted
8 from “the common idea of an anthropomorphic raisin”, and these elements were totally dissimilar in
9 appearance such that without being told “it could just as easily be concluded that one is a prune and the
10 other is a potato.”

11 To the extent that UBC alleges any similarity in the typefaces or fonts on the cans, Congress
12 has expressly considered and declined to grant copyright protection to typeface and the Copyright
13 Office has denied registration to “mere variations in typographic ornamentation or lettering.” *See* H.R.
14 Rep. No. 1476, 94th Cong., 2d Sess. 55 to 56 (1976); 2 *Patry on Copyright* § 4:19 (2010). As such,
15 similarity in the fonts used for the lettering on the cans, if any, cannot be considered in a copyright
16 infringement analysis.

17 Beyond the dissimilarity to the limited material covered by UBC’s copyright registrations,
18 other extrinsic material on A-B’s TILT can further underscores the dissimilarity between A-B’s TILT
19 product and UBC’s copyrighted material. *See Identity Arts*, 2007 U.S. Dist. LEXIS 32060 at *82
20 (granting 12(b)(6) motion where “there is no underlying group of elements or source of information”
21 that was “plainly identical” to plaintiff’s work). As previously noted, each of the parties’ respective
22 products prominently features their distinctly different brand names, JOOSE and TILT® and use
23 various design schemes, including different colored text. *See Christiansen*, 149 F.2d at 203 (in
24 affirming 12(b)(6) dismissal of copyright infringement claim court noted “entirely different color
25 scheme” and “numerous other dissimilarities”). Accordingly, UBC’s copyright infringement claim
26 should be dismissed.

27
28

1 G. PLAINTIFF'S ALLEGATION OF CALIFORNIA STATUTORY TRADEMARK
2 INFRINGEMENT UNDER CALIF. BUS. & PROF. CODE § 14245 FAILS TO
3 STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED (CLAIM VI)

4 UBC's Complaint, at ¶¶ 90-98, purports to assert a claim for California statutory trademark
5 infringement under Calif. Bus. & Prof. Code § 14245. UBC has failed, however, to allege an essential
6 element of such a cause of action, namely, ownership of a California state registration, which requires
7 dismissal pursuant to Rule 12(b)(6).

8 A claim for trademark infringement under Calif. Bus. & Prof. Code § 14245 requires that the
9 plaintiff plead ownership of a California state registration of the mark which is allegedly infringed.
10 Specifically, § 14245(a)(1) defines infringement as follows:

- 11 (a) A person who does any of the following shall be subject to a civil action by the
12 owner of the *registered mark*, and the remedies provided in Section 14250:
- 13 (1) Uses, without the consent of the registrant, any reproduction, counterfeit,
14 copy, or colorable imitation of a *mark registered under this chapter* in
15 connection with the sale, distribution, offering for sale, or advertising of
16 goods or services on or in connection with which the use is likely to
17 cause confusion or mistake, or to deceive as to the source of origin of the
18 goods or services. (Emphasis added.)

19 Thus, ownership of a California state trademark registration is an essential element of a claim
20 for infringement under § 14245. Where a plaintiff fails to plead facts establishing its ownership of a
21 California state registration of the allegedly infringed mark, a § 14245 infringement claim will be
22 dismissed pursuant to Rule 12(b)(6). *E.g., Dream Marriage Group, Inc. v. Anastasia International,*
23 *Inc.*, 2010 U.S. Dist. LEXIS 120543 (C.D. Cal. Oct. 27, 2010); *see also Builders Square, Inc. v.*
24 *Wickes Cos.*, 1985 U.S. Dist. LEXIS 16256, *13 (C.D. Cal. Sept. 4, 1985) (“[p]ursuant to Cal. Bus. &
25 Prof. Code § 14320(a) [now 14245(a)(1)], a civil action may be brought by the owner of a *registered*
26 *mark*”).

27 UBC's complaint does not plead ownership of a California state registration of the Dragon
28 Design shown in federal Application Serial No. 85/139,185, either alone or in combination with the
word JOOSE. The simple reason for that critical omission is that UBC does not own such a
registration.

1 Accordingly, UBC has failed to allege a claim for infringement under Calif. Bus. & Prof. Code
2 § 14245 upon which relief can be granted. That omission cannot be corrected by an amendment under
3 Fed. R. Civ. P. 15 because, as indicated above, UBC does own a subsisting California state registration
4 of any trademark that would provide a basis for the claim in question.

5
6 H. PLAINTIFF’S ALLEGATIONS OF UNFAIR COMPETITION AND COMMON
7 LAW INFRINGEMENT FAIL TO STATE A CLAIM UPON WHICH RELIEF CAN
8 BE GRANTED (CLAIMS VII-IX)

9 The analysis of UBC’s common law infringement and common law and statutory unfair
10 competition claims is guided by the same analysis applicable to its federal trademark infringement
11 claim, discussed in Sections A and E above. *See Walter v. Mattel*, 210 F.3d 1108, 1111 (9th Cir. 2000)
12 (analysis of common law infringement and unfair competition claims guided by same analysis as
13 federal trademark infringement). Thus, these ancillary claims should be dismissed, as well.

14 Independently, an additional basis for dismissal of UBC’s common law unfair competition
15 claim and partial dismissal of UBC’s statutory unfair competition claim is preemption under the
16 Copyright Act. A state law claim is preempted by the Copyright Act if a plaintiff asserts rights under
17 state law “that are equivalent” to those protected by the Copyright Act and the work falls within the
18 “subject matter” of the Copyright Act as set forth in 17 U.S.C. §§ 102 and 103. 17 U.S.C. § 301(a);
19 *Kodadek v. MTV Networks*, 152 F.3d 1209, 1212 (9th Cir. 1998). The Ninth Circuit has held that
20 claims under Calif. Bus. & Prof. Code § 17200 are preempted where the basis for the claim is the
21 copying and sale of a product that allegedly infringes plaintiff’s copyrighted work. *Id.* at 1212-1213.
22 UBC’s entire common law unfair competition claim and part of its statutory unfair competition claim
23 is based on A-B’s alleged sale of beverages in cans that infringe its copyrighted works. *See id.* (noting
24 that plaintiff’s “unfair competition claim incorporates by reference paragraphs from the copyright
25 infringement claim” in finding preemption). As such, UBC’s state law claims are preempted, and
26 should be dismissed.

27 ///

28 ///

1 **IV. CONCLUSION**

2 For the above-stated reasons, the entirety of UBC's Complaint should be dismissed pursuant to
3 Rule 12(b)(6) for failure to state claims upon which relief may be granted. Because UBC cannot cure
4 the deficiencies in its Complaint, the dismissal should be with prejudice.

5 Dated: December 10, 2010

Respectfully submitted,

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21 Attorneys for Defendant
22 Anheuser-Busch, Inc.
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Thank you for your request. Here are the latest results from the TARR web server.

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Serial Number: 85139185 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark



Standard Character claim: No

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2010-09-30

Filing Date: 2010-09-27

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

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Current Location: 042 -New Application Processing

Date In Location: 2010-09-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. United Brands Company

Address:

United Brands Company
10940 Wilshire Boulevard, Suite 1600
Los Angeles, CA 90024
United States

**EXHIBIT A
PAGE 1**

Legal Entity Type: Corporation
State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 033
Class Status: Active
alcoholic beverages produced from a brewed malt base with natural juice flavorings
Basis: 1(a)
First Use Date: 2008-06-00
First Use in Commerce Date: 2008-06-00

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Description of Mark: The mark consists of a stylized image of a dragon.

Design Search Code(s):
04.05.01 - Dragons; Griffons
26.11.21 - Rectangles that are completely or partially shaded
26.11.25 - Rectangles with one or more curved sides

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-10-01 - Notice Of Design Search Code Mailed

2010-09-30 - New Application Office Supplied Data Entered In Tram

2010-09-30 - New Application Entered In Tram

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EXHIBIT A
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DRAGON JOOZE

