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UNITED STATES DISTRICT COURT  
DISTRICT OF NEVADA

\* \* \*

BEAR OMNIMEDIA LLC,  
  
  Plaintiff,  
  
  v.  
  
MANIA MEDIA LLC dba "BEAR FILMS"  
and BEARFILMS.com; *et al.*,  
  
  Defendants.

Case No. 2:17-cv-01478-MMD-CWH  
  
ORDER

**I. SUMMARY**

This trademark case focuses on the use of, and rights to, the term "Bear" as used in niche parlance in the gay community. In the operative complaint before the Court (Third Amended Complaint ("TAC")) Plaintiff Bear Omnimedia LLC asserts claims of trademark infringement, trademark dilution, unfair competition, false description, violation of The Anticybersquatting Consumer Protection Act ("ACPA"), common law unfair competition, and common law injury to business reputation. Defendant Mania Media LLC dba "BEAR FILMS" and BEARFILMS.com ("Mania") moves to dismiss the TAC under Federal Rule of Civil Procedure 12(b)(6) ("Motion"). (ECF No. 116.) Having considered Plaintiff's response (ECF No. 117) and Mania's reply (ECF No. 118),<sup>1</sup> the Court will grant Mania's Motion in part and deny it in part.

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<sup>1</sup>In their respective motions, both Plaintiff and Mania provide summary-judgment-type arguments that the Court declines to consider at this stage.

1 **II. RELEVANT BACKGROUND**

2 The relevant facts are taken from the TAC (ECF No. 58), unless otherwise noted.

3 Plaintiff is the publisher of BEAR magazine and movies. Plaintiff claims that “BEAR”  
4 is *one of* the longest-established erotic periodical and movie brands specifically geared  
5 toward gay men. Plaintiff alleges it is the owner of three marks that use the terms  
6 “BEAR”—stylized or “BUTCH BEAR” conjointly. Plaintiff contends that Defendants have  
7 engaged in violative use of these marks. Particularly, Mania is alleged to have violated  
8 Plaintiff’s marks with the creation and use of the website or domain BearFilms.com

9 The United States Patent and Trademark Office recognizes Plaintiff’s marks  
10 respectively as follows<sup>2</sup>: (1) “**MARK:** BEAR (stylized and/or with design . . . The mark  
11 consists of An oval shape with the word “Bear” inside the design. The mark may be any  
12 color or size”;<sup>3</sup> (2) “**Word Mark** BUTCH BEAR . . . Color is not claimed as a feature of the  
13 mark. The mark consists of the wording ‘BUTCH BEAR’ inside a design of a square. The  
14 word ‘BUTCH’ appears stacked above the word ‘BEAR.’”<sup>4</sup>

15 **III. LEGAL STANDARD**

16 A court may dismiss a plaintiff’s complaint for “failure to state a claim upon which  
17 relief can be granted.” Fed. R. Civ. P. 12(b)(6). A properly pleaded complaint must provide  
18 “a short and plain statement of the claim showing that the pleader is entitled to relief.” Fed.  
19 R. Civ. P. 8(a)(2); *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). While Rule  
20 8 does not require detailed factual allegations, it demands more than “labels and  
21 conclusions” or a “formulaic recitation of the elements of a cause of action.” *Ashcroft v.*  
22 *Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 555.) “Factual allegations

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25 <sup>2</sup>The Court takes judicial notice of this information as matters of public record. See  
*Lee v. City of Los Angeles*, 250 F.3d 668, 689 (9th Cir. 2001) (quoting *Mack v. S. Bay*  
*Beer Distrib.*, 798 F.2d 1279, 1282 (9th Cir. 1986)); see also Fed. R. Evid. 201.

26 <sup>3</sup>(ECF No. 97-9 at 5, 7; ECF No. 97-10 at 5.)

27 <sup>4</sup>(ECF No. 97-11.)

1 must be enough to rise above the speculative level.” *Twombly*, 550 U.S. at 555. Thus, to  
2 survive a motion to dismiss, a complaint must contain sufficient factual matter to “state a  
3 claim to relief that is plausible on its face.” *Iqbal*, 556 U.S. at 678 (internal citation omitted).

4 In *Iqbal*, the Supreme Court clarified the two-step approach district courts are to  
5 apply when considering motions to dismiss. First, a district court must accept as true all  
6 well-pleaded factual allegations in the complaint; however, legal conclusions are not  
7 entitled to the assumption of truth. *Id.* at 678–79. Mere recitals of the elements of a cause  
8 of action, supported only by conclusory statements, do not suffice. *Id.* at 678. Second, a  
9 district court must consider whether the factual allegations in the complaint allege a  
10 plausible claim for relief. *Id.* at 679. A claim is facially plausible when the plaintiff’s  
11 complaint alleges facts that allow a court to draw a reasonable inference that the  
12 defendant is liable for the alleged misconduct. *Id.* at 678. Where the complaint does not  
13 permit the court to infer more than the mere possibility of misconduct, the complaint has  
14 “alleged—but it has not show[n]—that the pleader is entitled to relief.” *Id.* at 679 (internal  
15 quotation marks omitted). When the claims in a complaint have not crossed the line from  
16 conceivable to plausible, the complaint must be dismissed. *Twombly*, 550 U.S. at 570. A  
17 complaint must contain either direct or inferential allegations concerning “all the material  
18 elements necessary to sustain recovery under *some* viable legal theory.” *Twombly*, 550  
19 U.S. at 562 (quoting *Car Carriers, Inc. v. Ford Motor Co.*, 745 F.2d 1101, 1106 (7th Cir.  
20 1989) (emphasis in original)).

21 While a court generally cannot consider matters beyond the pleadings on a motion  
22 to dismiss, the court may consider documents “properly submitted as part of the  
23 complaint” and “may take judicial notice of ‘matters of public record.’” *Lee v. City of Los*  
24 *Angeles*, 250 F.3d 668, 688–89 (9th Cir. 2001) (quotations omitted).

#### 25 **IV. DISCUSSION**

26 Mania’s Motion is generally premised on the argument that Plaintiff fails to plead  
27 plausible claims. The Court disagrees regarding all but Plaintiff’s trademark dilution and

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1 common law injury to business reputation claims, which the Court provides Plaintiff leave  
2 to amend.

3 **A. Trademark Infringement**

4 To state a claim for trademark infringement, a plaintiff must allege that (1) it has a  
5 trademark right; (2) that was used by defendant; (3) in a way that is likely to cause  
6 consumer confusion and thus infringe upon the trademark right. *Levi Strauss Co. v. Blue*  
7 *Bell, Inc.*, 778 F.2d 1352, 1354 (9th Cir. 1985). “The core element of trademark  
8 infringement is the likelihood of confusion, i.e., whether the similarity of the marks is likely  
9 to confuse customers about the source of the products.” *Abercrombie & Fitch Co. v. Moose*  
10 *Creek, Inc.*, 486 F.3d 629, 633 (9th Cir. 2007).

11 Mania seeks dismissal of Plaintiff’s infringement claim based on the general  
12 insufficient pleading argument and a specific contention that Plaintiff cannot establish a  
13 claim merely based on the use of the word “Bear” by Mania and other Defendants. At first  
14 glance, the Court was inclined to grant Mania’s Motion on the latter basis. However, the  
15 Court ultimately declines to do so and will allow the claim to proceed.

16 To be clear, Plaintiff alleges it is the owner of three marks that use or incorporate  
17 the term “BEAR” (See ECF No. 58 at 4–5, 13–19.) Plaintiff’s trademark registration  
18 specifically notes the BEAR mark as not being of “standard characters.” (ECF No. 97-9 at  
19 2; ECF No. 97-10 at 2.) “BUTCH BEAR” is also noted as “Mark Drawing Code (5) words,  
20 letters, and/or numbers in *stylized* formed.” (ECF No. 97-11 at 2 (emphasis added).)  
21 Plaintiff does not particularly own any *word* marks for the word “bear” standing alone or  
22 absent design. See *Pom Wonderful FFL v. Hubbard*, 775 F.3d 1118, 1125 (9th Cir. 2014)  
23 (indicating that marks like Plaintiffs are not standard character marks “that make no claim  
24 to any particular font style, color, or size of display,” and therefore Plaintiff’s marks do not  
25 cover “all design variations of the word[(s) used]”).

26 The Court assumes without deciding that Plaintiff’s marks are specific design or  
27 logo marks. Nonetheless, Plaintiff asserts no discrete claim for violative use of its  
28 trademarked design or logo. (ECF No. 58.) Plaintiff’s entire TAC is essentially premised

1 on impermissible or infringing use of the word mark “Bear,” along with a likelihood of  
2 confusion. (*Id.*) Accordingly, this Court initially thought it would be most judicious to dismiss  
3 Plaintiff’s TAC for failure to state a protectable interest in the word “Bear” or ownership of  
4 a “Bear” word mark. *See, e.g., Rise Basketball Skill Dev. LLC v. K Mart Corp.*, No.16-cv-  
5 04895-WHO, 2017 WL 4865561, at \*3 (N.D. Cal. Oct. 27, 2017) (citing *Pom Wonderful*  
6 *FFL*, 775 F.3d at 1125) (“The ownership of a word mark entitles the owner exclusive rights  
7 in the word for the class of goods specified in the trademark. In contrast, ownership of a  
8 design [or logo] mark limits the owner’s rights exclusively to the specific design  
9 trademarked.”).<sup>5</sup>

10 But, the Ninth Circuit has also ruled that where words “are the most salient feature  
11 of [a] mark[,]” the mark’s holder may also be entitled to protection of the words. *KP*  
12 *Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 603–04 (9th Cir.  
13 2005). Because the words BEAR and BUTCH BEAR are the most salient features of  
14 Plaintiff’s marks, the Court declines to dismiss this claim, and others, for the single reason  
15 that Plaintiff is not the owner of a discrete “Bear” word mark.

16 The Court otherwise finds Plaintiff has sufficiently pleaded a claim of trademark  
17 infringement. Plaintiff alleges it is the owner of the protectable BEAR and BUTCH BEAR  
18 marks, that Mania has used Plaintiff’s “BEAR Marks” or a mark confusingly similar to  
19 Plaintiff’s marks, thereby infringing upon Plaintiff’s trademark rights. (ECF No. 58.) Plaintiff  
20 contends that confusion is likely because Mania provides goods and/or services in the  
21 same type of retail channels and to the same class of purchasers—“gay men who are –  
22 or who admire – masculine men with body or facial hair, poetically and fancifully referred

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24 <sup>5</sup>*See also Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1153 (9th Cir. 2002)  
25 (concluding “Although EMI has the exclusive right to use the trademark  
26 ‘ENTREPRENEUR’ to identify the products described in its regulation, trademark law does  
27 not allow EMI to appropriate the word ‘entrepreneur’ for its exclusive use. The descriptive  
28 nature and common necessary uses of the word ‘entrepreneur’ require that courts exercise  
caution in extending the scope of protection to which the mark is entitled”); *Gruner + Jahr*  
*USA Pub. v. Meredith Corp.*, 991 F.2d 1072, 1077 (2d Cir. 1993) (“[T]he trademark  
registration of the title PARENTS in its distinctive typeface did not confer an exclusive right  
to plaintiff on variations of the word ‘parent,’ such term being more generic than  
descriptive.”).

1 to as ‘bears’.” (*Id.* at 4.) Accepting Plaintiff’s allegations as true, the Court must allow this  
2 claim to proceed.

3 **B. Unfair Competition**

4 A claim of unfair competition under section 43(a) of the Latham Act essentially  
5 requires the same elements as the trademark infringement claim—that a defendant is  
6 using a mark confusingly similar to a plaintiff’s valid, protectable trademark. *See Brookfield*  
7 *Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1046 & n.6 (9th Cir. 1999).  
8 Accordingly, as with the infringement claim *supra*, the Court declines to dismiss this claim  
9 at this stage.

10 **C. Trademark Dilution**

11 The Federal Trademark Dilution Act (“FTDA”) allows for injunctive relief by “the  
12 owner of a famous mark that is distinctive . . .” against others “who, at any time after the  
13 owner’s mark has become famous, commences use of a mark . . . in commerce that is  
14 likely to cause dilution . . . of the famous mark . . .” 15 U.S.C. § 1125(c)(1).

15 Plaintiff seeks permanent injunction based on alleged trademark dilution by Mania.  
16 (ECF No. 58 at 7–8.) Mania argues both that Plaintiff’s dilution claim is generally  
17 insufficiently pleaded and specifically that the claim fails to allege acts demonstrating the  
18 marks are famous within the meaning of the relevant statutes. (ECF No. 116 at 6–8; ECF  
19 No. 118 at 2–3.) The Court agrees this claim is insufficiently pleaded.

20 In the TAC, Plaintiff generally asserts that its “BEAR” marks are famous “within the  
21 meaning of the Anti-Dilution Act, 15 U.S.C. § 1125(c).” (ECF No. 58 at 7.) But, the bigger  
22 issue is that Plaintiff asserts only that the Defendants, including Mania, created infringing  
23 websites, etc., after Plaintiff registered its marks. Plaintiff thus asserts nothing to support  
24 the operative element—that dilution occurred *after the mark became famous*. The Court  
25 will dismiss this claim.

26 **D. False Description**

27 A defendant may be liable under section 1125(a) where it “(1) use[s] in commerce  
28 (2) any word, false designation of origin, false or misleading description, or representation

1 of fact, which (3) is likely to cause confusion or misrepresents the characteristics of his or  
2 another person's goods or services." *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 902  
3 (9th Cir. 2007) (citing 15 U.S.C. § 1125(a)).

4 Plaintiff has sufficiently pleaded this claim. Incorporating all of Plaintiff's averments,  
5 Plaintiff alleges that Defendants' use of the term "BEAR" on websites, etc., providing erotic  
6 film services to gay men, comprises a false description or representation of Plaintiff's  
7 business and merchandise, and such use is likely to create confusion about Plaintiff's  
8 business and merchandise. The Court will allow this claim to proceed.

9 **E. Violation of the ACPA**

10 The ACPA provides:

11 A person shall be liable in a civil action by the owner of a mark . . . if, without  
12 regard to the goods or services of the parties, that person (1) has a bad faith  
13 intent to profit from that mark . . . ; and (ii) registers, traffics in, or uses a  
domain name [that is confusingly similar to another's mark or dilutes  
another's famous mark].

14 *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 680 (9th Cir. 2005) (quoting 15 U.S.C. §  
15 1125(d)(1)(A) (2004)). Plaintiff has sufficiently pleaded this claim by alleging that  
16 Defendants, including Mania, have a bad faith intent to profit from its "BEAR Marks," by  
17 using domain names, pertinently BearFilms.com, in a way that is confusingly similar to  
18 Plaintiff's use of its marks, as previously noted.

19 **F. Common Law Unfair Competition**

20 In Nevada, a common law unfair competition claim is the state equivalent of the  
21 federal Latham Act claim. See *A.L.M.N., Inc. v. Rosoff*, 757 P.2d 1319, 1321 (Nev. 1988)  
22 (citation omitted) ("Common law tradename infringement falls within a broader category of  
23 prohibited unfair competition. '[Two questions are at the heart of this claim:] Has a  
24 protectable right been created? Has it been infringed?'). Accordingly, like its federal  
25 counterpart, this claim will also move forward.

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1           **G. Common Law Injury to Business Reputation**

2           Plaintiff asserts what it characterizes as a claim for “common law injury to business  
3 reputation.” (ECF No. 58 at 9.) Neither Plaintiff nor Mania present any authority indicating  
4 that injury to business reputation is an independent common law cause of action in  
5 Nevada. (See ECF Nos. 58, 116, 117, 118.) To the extent an independent cause of action  
6 for the claim exists, this Court concludes that Plaintiff fails to plausibly plead it. The Court  
7 finds guidance in *Kische USA, LLC v. Simsek*, No. C16-0168JLR, 2016 WL 6273261, \*7  
8 (D. W.D. Wash. June 29, 2016).

9           In *Kische*, the plaintiff alleged:

10           Defendants' wrongful *use of* KISCHE's trademarks causes injures [sic] to  
11 and creates a likelihood of injury to KISCHE's business reputation because  
12 persons encountering KISCHE and its brands and services will believe that  
13 KISCHE is affiliated with or related to or has the approval of Defendants, and  
any adverse reaction by the public to Defendants and the quality of its [sic]  
products and the nature of its business will injure the business reputation of  
KISCHE and the goodwill that it enjoys in connection with its marks.

14           *Id.* The court concluded that even if such a claim existed in Washington common  
15 law it was insufficiently pleaded because “[i]njury to a business’s reputation or  
16 goodwill generally constitutes special damages and, as such must be pleaded with  
17 particularity pursuant to Federal Rule of Civil Procedure 9(g).” *Id.*

18           Here, in substance, Plaintiff’s pleading mirrors the *Kische* plaintiff’s  
19 insufficient pleading<sup>6</sup>:

20           Defendants’ use of Plaintiff’s trademark inures and creates a likelihood of  
21 injury to Plaintiff’s business reputation because persons encountering  
22 Plaintiff and its products and services will believe that Plaintiff is affiliated  
23 with or related to or has the approval of Defendants, and any adverse  
reaction by the public to Defendants and the quality of its products and the  
nature of its business will injure the business reputation of Plaintiff and the  
goodwill that it enjoys in connection with its BEAR trademark.

24           (ECF No. 58 at 9–19.) Accordingly, as the *Kische* court did, this Court will dismiss  
25 this claim as implausibly pleaded.

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28           <sup>6</sup>Although the TAC “incorporates the allegations in the preceding paragraph as if  
fully set forth herein[,]” the Court cannot decipher what more particularized allegations  
would go to this claim as against Mania.



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**H. Leave to Amend**

Plaintiff has requested that that the Court provide it another opportunity to amend its complaint should the Court conclude its claims against Mania needs additional specificity. (ECF No. 117 at 13.) The Court would ordinarily decline to grant such a request considering the prior amendments. However, the policy favoring amendment must be applied with “extreme liberality.” *Eminence Capital, LLC v. Aspeon, Inc.*, 316 F.3d 1048, 1051 (9th Cir. 2003); *see also* Fed. R. Civ. P. 15(a)(2) (“The court should freely give leave [to amend] when justice so requires.”). Having considered the relevant factors, the Court provides Plaintiff another chance to amend its complaint because amendment is appropriate and would not be clearly futile. *See Foman v. Davis*, 371 U.S. 178, 182 (1962) (providing factors for denying an amendment). Plaintiff has leave to amend only the trademark dilution and common law injury to business reputation claims.

**V. CONCLUSION**

The Court notes that the parties made several arguments and cited to several cases not discussed above. The Court has reviewed these arguments and cases and determines that they do not warrant discussion as they do not affect the outcome of the motion before the Court.

It is therefore ordered that Mania’s motion to dismiss (ECF No. 116) is granted in part and denied in part. It is denied as to all but Plaintiff’s trademark dilution and common law injury to business reputation claims. These two claims are dismissed with leave to amend.

It is further ordered that Plaintiff has fifteen days from the date of this order to amend the complaint to address the noted deficiencies, and the complaint must be entitled anew “Fourth Amended Complaint.” Failure to address the TAC’s deficiencies within the prescribed time will result in prejudicial dismissal of Plaintiff’s trademark dilution and common law injury to business reputation claims.

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DATED THIS 17<sup>th</sup> day of October 2018.



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MIRANDA M. DU  
UNITED STATES DISTRICT JUDGE